

O/0091/2X

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK NOS.
UK00003272409 AND UK00917506346
IN THE NAME OF LIVING ASSISTANCE SERVICES, INC.

AND IN THE APPLICATIONS FOR DECLARATIONS OF INVALIDITY
UNDER NOS. 503556, 503753 AND 504338
BY BLUEBIRD CARE SERVICES LIMITED
AND BLUEBIRD CARE FRANCHISES
LIMITED

AND

IN THE MATTER OF TRADE MARK NO. UK00002401120
IN THE NAME OF BLUEBIRD CARE SERVICES LIMITED
AND IN THE APPLICATION FOR REVOCATION THEREOF UNDER NO. 503680
BY LIVING ASSISTANCE SERVICES, INC.

AND IN THE MATTER OF TRADE MARK NO. UK0000912421269
IN THE NAME OF BLUEBIRD CARE FRANCHISES LIMITED
AND IN THE APPLICATION FOR REVOCATION THEREOF UNDER NO. 503898
BY LIVING ASSISTANCE SERVICES, INC.

BACKGROUND AND PLEADINGS

1. These are consolidated proceedings between Living Assistance Services, Inc. (“LAS”) on one side and Bluebird Care Services Limited (“BC1”) and Bluebird Care Franchises Limited (“BC2”) on the other side. I set out below the background regarding the parties’ marks and the basis of each parties’ respective proceedings.

LA’s trade marks

2. LAS is the owner of the two trade marks shown below:

- i. UK00003272409 (“the ‘2409 mark”)



Filing date: 22 November 2017; Registration date: 23 March 2018.

Class 44: *Medical care; nursing care; ambulant medical care; consulting services relating to healthcare; home-visit nursing care; home health care services; geriatric nursing; advice relating to the medical needs of elderly people.*

Class 45: *Providing non-medical assisted living home care, namely emotional or personal support services, chaperoning, companionship services; companionship services for the elderly and disabled.*

- ii. UK00917506346 (“the ‘6346 mark”)



Filing date: 22 November 2017; Registration date: 6 March 2018

Class 44: *Medical care; nursing care; ambulant medical care; consulting services relating to healthcare; home-visit nursing care; home health care*

services; geriatric nursing; advice relating to the medical needs of elderly people.

Class 45: *Providing non-medical assisted living home care; companionship services for the elderly and disabled.*

BC1's trade mark

3. BC1 is the owner of the trade mark shown below:

- i. UK00002401120 ("the '1120 mark")



Filing date: 08 September 2005; Registration date: 24 March 2006

Class 44: *Medical services, veterinary services, hygienic and beauty care for human beings or animals, agriculture, horticulture and forestry services.*

BC2's trade mark

4. BC2 is the owner of the trade mark shown below:

- ii. UK00912421269 ("the '1269 mark")



Mark Description/Limitation: Bird in circle device. Colour Claimed: Blue "Pantone process blue, (C=100 M=10 Y=0 K=10)".

Filing date: 11 December 2013; Registration date: 01 May 2014

Class 10: *Medical devices; physical therapy equipment; orthopaedic and mobility medical furniture and bedding; equipment for moving patients.*

Class 44: *Provision of staff for nursing, healthcare, hospice, therapy and non-medical home care.*

BC1's application for invalidity no. 503556 and BC2's application for invalidity no. 503753 against LAS's '2409 mark

5. On 11 January 2021, BC1 and BC2 filed two separate applications for invalidation against LAS's '2409 mark. Both applications for invalidity are based upon Section 5(2)(b) of the Trade Mark Act ("the Act) with BC1 relying on its earlier '1120 mark insofar as it covers *Medical care and hygienic and beauty care for human beings* (Class 44) and BC2 relying on its earlier '1269 mark insofar as it covers *Provision of staff for nursing, healthcare, hospice, therapy and non-medical home care* (Class 44).

6. In their statements of grounds, BC1 and BC2 claim that the respective marks are similar and that the respective services are identical or similar leading to a likelihood of confusion.

7. In response, LAS denies that there is a likelihood of confusion between the marks in both cases.

8. The trade marks upon which BC1 and BC2 rely in their respective invalidity actions qualify as earlier trade marks because they were applied for at an earlier date than LAS's '2409 mark pursuant to Section 6 of the Act. Both earlier marks are subject to the proof of use requirements as they have been registered for five years or more before the filing date of the TM26(l) forms by BC1 and BC2 as per Section 47(2B) of the Act, with BC1's '1120 mark also having been registered for more than 5 years before the filing date of LAS's '2409 mark. In its counterstatement, LAS requests that BC1 and BC2 provide proof of use for their marks and points out that the services "*medical care*" are not covered as such by the list of services of BC1's registration, which covers "*Medical services, veterinary services, hygienic and beauty care for human beings or animals, agriculture, horticulture and forestry services*".

BC2's application for invalidity no. 504338 against LAS's '6346 mark

9. On 11 November 2021, BC2 filed an application for invalidation against LAS's '6346 mark, on the basis of its earlier '1269 mark and pursuant to the provisions of Sections 5(2)(b) and 5(3) of the Act. Under both grounds, BC2 relies on some of the goods and services for which its mark is registered, namely *Medical devices* (Class 10) and *Provision of staff for nursing, healthcare, hospice, therapy and non-medical home care* (Class 44).

10. Under Section 5(2)(b), BC2 claims that the respective marks are similar and that the respective goods and services are identical or similar leading to a likelihood of confusion.

11. Under Section 5(3), BC2 claims that its network of homecare providers has been consistently utilising, using and promoting a flying bird device with the words Bluebird Care since at least 2004-2005, that in 2006 the Bluebird Care's business model was expanded by franchising and that, at the time the application for invalidity was filed, the Bluebird Care network had 200 franchisees across the UK. BC2's case on Section 5(3) is that there will be unfair advantage as a result of, effectively, a likelihood of confusion. It states:

"It is submitted that the distinctive character of the earlier mark includes the flying bird device in particular and as a dominant and memorable element thereof. Further and in any event the bird device is an outstanding and memorable feature that would tend to draw the consumer's attention, and/or is readily described as a "bird", "flying bird" and/or "bird in flight" etc, if and insofar as is described orally. The later mark is also utilised by "Vising Angels" through the network of franchisees providing homecare services which is in close parallel to the business model of Bluebird and therefore provides a background factual matrix of identity of business model, target market, target pool of potential employees etc thus providing an overlap which will be likely to contribute to the risk of mis-association and/or confusion of which complaint is made and which is identified herein by Bluebird Care. Accordingly it is submitted that there is at least a likelihood of mis-association and/or confusion,

in particular that the relevant trade and/or public will consider that there is some business, trading and/or economic connection between the parties using the earlier and later trade marks, contrary to the fact”.

12. LAS filed a counterstatement denying the claims made and putting BC2 to proof of use in respect of its earlier mark. Although the relevant dates in this application for invalidation are different from the relevant dates in the other invalidity actions (as set out above), BC2's earlier '1269 mark is also subject to proof of use in this invalidity because it has been registered for five years or more before the filing date of the TM26(I) form by BC2 as per Section 47(2B) of the Act.

LAS's revocation actions nos. 503680 and 503898

13. In response to BC1 and BC2's applications for invalidity, LAS launched two revocation actions against BC1's '1120 mark and BC2's '1269 mark on 1 March 2021 and 7 June 2021 respectively (revocations nos. 503680 and 503898 respectively).

14. LAS claims that BC1 and BC2's earlier marks were not put to genuine use within five years of the completion date of the registration procedure (Section 46(1)(a)) seeking revocation from 25 March 2011 (revocation no. 503680) and 2 May 2019 (revocation no. 503898), respectively. Additionally, LAS claims under Section 46(1)(b) that use of BC1 and BC2's marks has been suspended for an uninterrupted period of five years (a) between 29 February 2016 and 28 February 2021 and 5 November 2015 and 4 November 2020 seeking revocation from 1 March 2021 and 5 November 2020, respectively (revocation no. 503680) and (b) between 7 June 2016 and 6 June 2021 and 5 November 2015 and 4 November 2020, seeking revocation from 7 June 2021 and 5 November 2020, respectively (revocation no. 503898).

15. BC1 admits within its counterstatement that genuine use of its '1120 mark has not been made in the UK for some of the registered services, namely *veterinary services, hygienic and beauty care for animals, agriculture, horticulture and forestry services*, but defends its registration for *Medical services, medical care services, hygienic and beauty care for human beings* (Class 44) in relation to which it claims that the mark has been used in the UK within the relevant periods. Likewise, BC2 admits within its

counterstatement that genuine use of its '1269 mark has not been made in the UK for some of the registered goods, namely *physical therapy equipment; orthopaedic and mobility medical furniture and bedding; equipment for moving patients* (Class 10) but defends its registration for *Medical devices* (Class 10) and *Provision of staff for nursing, healthcare, hospice, therapy and non-medical home care* (Class 44) in relation to which it claims that the mark has been used in the UK within the relevant periods.

Representation and evidence

16. LAS is represented by Owen White Limited, whereas BC1 and BC2 are both represented by Bird & Bird LLP.

17. All parties provided evidence. BC1 and BC2 are part of the same group of companies and filed the same evidence in these proceedings. This consists of five witness statements from the following individuals: (a) a witness statement from Wayne Smith dated 10 May 2021 and accompanied by 6 exhibits (WS1 to WS6). Mr Smith is the director of finance and operations for the Bluebird Care group of companies; (b) a witness statement from Alicia West dated 11 May 2021 and accompanied by 11 exhibits (AW1 to AW11). Ms West is a solicitor with the firm Owen White Limited, who represents BC1 and BC2 in these proceedings and (c) three witness statements from Hannah Banfield, dated 10 May 2021, 13 December 2021 and 16 May 2022, respectively. Ms Banfield is the marketing and communication director for the Bluebird Care group of companies and her witness statements are accompanied by 63 exhibits in total (HB1 to HB63).

18. LAS's evidence is provided by Daniel Robert Jon Archer, who is the managing director of LAS, and Roberto Pescador, who is a trade mark attorney with Bird & Bird LLP, the firm representing LAS in these proceedings. Mr Archer's witness statement is dated 14 February 2022 and is accompanied by 12 Exhibits (DA1 to DA3 and DA5 to DA13). Mr Pescador's witness statement is also dated 14 February 2022 and is accompanied by 1 Exhibit (RP 1).

19. A hearing was held before me, by video conference, on 10 October 2022. BC1 and BC2 were represented by Ms Denise McFarland, of Counsel, instructed by Owen White Limited. LAS was represented by Mr Roberto Pescador of Bird and Bird LLP Solicitors. At the hearing it became apparent that there had been a misunderstanding due to the fact that BC2's application for invalidity no. 504338 had not been listed in the papers sent with the notification of the hearing, causing the relevant submissions for that case to be omitted from Ms McFarland's skeleton argument. On that basis, I allowed both parties to file supplemental skeleton arguments in relation to invalidity no. 504338, which I have now received¹.

Relevance of EU law

20. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

My approach

21. There are two revocation actions in these consolidated proceedings, one against BC1's earlier mark (which is relied upon in one of the invalidity actions against one of LAS's marks) and one against BC2's earlier mark (which is relied upon in two separate invalidity actions against LAS's two marks).

22. In the event that LAS's application for revocation no. 503680 against BC1's '1120 mark is successful, BC1's mark might be revoked with an effective date (i.e. 25 March 2011) preceding the filing date of LAS's '2409 mark (i.e. 22 November 2017). In these circumstances, BC1's mark will not have been a valid registration at the filing date of the '2409 mark in invalidity no. 503556. As a result, BC1's application for invalidation based upon Section 5(2)(b) of the Act will inevitably fail (if the mark is revoked in its

¹ Both parties' supplementary submissions are limited to the Section 5(3) grounds only.

entirety). Consequently, I find it convenient to first deal with LAS's application for revocation before considering BC1's application for invalidation.

23. Although, in his skeleton argument, Mr Pescador does not differentiate between the two revocation actions and states that *"given that if the Earlier Registrations are expunged from the registry on the grounds of non-use the Invalidity Actions would lack any basis"*, the effective revocation dates sought in revocation no. 503898 against BC2's '1269 mark (i.e. 2 May 2019, 7 June 2021 and 5 November 2020) are later than the filing dates of LAS's '2409 and '6346 marks (i.e. 22 November 2017). This means that even in the event that the revocation action against BC2's '1269 mark is successful, BC2 will still be able to rely on its mark in the invalidation actions nos. 503753 and 504338 against LAS's '2409 and '6346 marks. Nevertheless, since the evidence filed by BC2 is the same as that filed by BC1, and BC2 is also required to show genuine use in both invalidity actions, I find it convenient to consider the evidence of use in both revocation actions together, before turning to the applications for invalidity.

LAS's revocation actions nos. 503680 and 503898

24. Section 46 of the Act states:

"46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

25. Since the '1269 mark is a comparable mark, paragraph 8 of part 1, schedule 2A is relevant. It reads:

“8.— Non-use as defence in infringement proceedings and revocation of registration of a comparable trade mark (EU)

(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the "five-year period") has expired before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.

(3) Where [IP completion day]² falls within the five-year period, in respect of that part of the five-year period which falls before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM ; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union”.

26. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

27. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29];

Centrotherm at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at

[22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

28. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

29. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends

who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

The undefended goods and services

30. Both BC1 and BC2 have admitted in their counterstatements that their marks have not been used in relation to some of the registered goods and services.



31. BC1’s ‘1120 mark is registered for *Medical services, veterinary services, hygienic and beauty care for human beings or animals, agriculture, horticulture and forestry services* (Class 44). Since BC1 has admitted that there has been no use of its ‘1120 mark in the UK for *veterinary services, hygienic and beauty care for animals, agriculture, horticulture and forestry services*, BC1’s mark will be revoked in relation to these services from the earliest possible date (i.e. 25 May 2011). My assessment of the revocation action no. 503680 will therefore be limited to the question of whether there has been genuine use of the mark ‘1120 in relation to the defended services, namely *Medical services, hygienic and beauty care for human beings*.

32. Similar considerations apply to the revocation action against BC2’s ‘1269 mark. This mark is registered for *Medical devices; physical therapy equipment; orthopaedic and mobility medical furniture and bedding; equipment for moving patients* (Class 10) and *Provision of staff for nursing, healthcare, hospice, therapy and nonmedical home*

care (Class 44). Given BC2's admission that no use of its '1269 mark has been made in the UK for *physical therapy equipment; orthopaedic and mobility medical furniture and bedding; equipment for moving patients* (Class 10), BC2's mark will be revoked in relation to these goods from the earliest possible date (i.e. 2 May 2019). My assessment of the revocation action no. 503680 will therefore be limited to the question of whether there has been genuine use of the mark '1269 in relation to the defended goods and services, namely *Medical devices* (Class 10) and *Provision of staff for nursing, healthcare, hospice, therapy and non-medical home care* (Class 44).

Form of the marks

33. Mr Pescador argued that the marks that appear in the evidence are those shown below and that such use does not constitute use of the earlier registrations. According to Mr Pescador, the marks shown in evidence are significantly different from the registered marks and alter their distinctive character. In relation to BC1's '1120 mark, Mr Pescador produces the following comparisons and states as follows:

Registered mark	Marks in the evidence
	

“As can be seen, the representation of the bird has changed significantly, as it is in a different position, with a different overlapping of the wings and a “less stylised” figure. Additionally, it is surrounded by two circles instead of one and the words BLUEBIRD CARE are in a distinctive font that is different from that used in the representations found in the evidence. Finally, the word CARE appears in a different position. The changes are significant.”

The purpose of the provision at section 46(2) is to avoid imposing strict conformity between the used form of the trademark and the form in which the mark was registered, allowing its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. Given the above differences, however, that is not the case here. The distinctive character of the registered mark lays with the combination of the bird device within two circles and the words BLUEBIRD CARE in a particular font. The variation of each of those elements, as mentioned above, do alter the distinctive character of the mark and, as indicated in Nirvana, that is the case even if the average consumer was not to register the differences at all.”

34. Similar observations were made in relation to BC2’s ‘1269 mark:

Registered mark	Marks in the evidence
	

“In the case of the newer registration (no. 912421269) the distinctiveness of the protected mark is not only provided by the figurative and verbal elements of the mark, but also by its colour. As can be seen in the details of the registration in the UKIPO’s database, the mark claims a particular colour, namely “Blue Pantone process blue, (C=100 M=10 Y=0 K=10)”, which restricts the scope of the mark to that particular colour. That is the effect of a colour claim/limitation.

The Common Communication of the European Trade Mark and Design Network on the Common Practice of the Scope of Protection of Black and White

Marks of 15 April 2014, of which UKIPO took part, established as a principle that use of a colour version of a trade mark registered in black & white/greyscale (or vice-versa) would not alter the distinctive character of the trade mark, as long as the following requirements are met:

- a) the word/figurative elements coincide and are the main distinctive elements;*
- b) the contrast of shades is respected;*
- c) colour or combination of colours does not possess distinctive character in itself and;*
- d) colour is not one of the main contributors to the overall distinctiveness of the mark.*

Given the colour claim within the mark registered, the requirements at c) and d) are not met by the use of the representations in the evidence, which differ from that registered in a particular colour.

As a result, the evidence has not shown any genuine use of the marks subject of the Earlier Registrations”.

35. Ms McFarland's position was rather that although there are some differences between the marks that are registered and the marks that have been used, they do not materially impact on the operation of the marks as a badge of origin and do not alter the distinctive character of the marks as registered.

36. The case-law establishes that use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it is registered.² This requires a three-stage inquiry: (i) what is the distinctive character of the registered trade mark (ii) what are the points of difference between the mark as used and the mark as registered are and (iii) whether those differences alter the distinctive character of the mark as registered. It follows that variations in use may take the trade mark outside of the specific parameters detailed in the registration and may expose the mark to revocation for non-use.

² *Nirvana Trade Mark* (BLO/262/06)

The '1269 mark

37. In relation to the '1269 mark, the main issue relates to the effects of the colour clause detailed in the registration. This is because the figurative elements and the contrast of colours of one of the marks shown in evidence are identical to those of the registered mark, the only difference being that the mark is presented in a different shade of blue. The '1269 mark is a comparable mark deriving from an EUTM registration. The colour clause states:

*"Mark Description/Limitation: Bird in circle device. Colour Claimed: Blue
"Pantone process blue, (C=100 M=10 Y=0 K=10)".*

38. The EUIPO's website contains the following guidance:³

"Can I claim colour for a figurative mark?"

No. As from 1 October 2017, EUIPO does not accept any trade mark description for figurative marks. Likewise, indications of colour will not be taken into account for figurative EUTMs and have no role to play in the EUTM application process. This is in line with the "what you see is what you get" character of the abolition of the graphical representation requirement, which aims to make the trade mark entries on the EUTM Register clearer, more accessible and easier to search for.

As some countries require an indication of colour in writing for the purposes of claiming priority, EUIPO will provide an optional field in the e-filing form where colours can be listed. This description will be visible in the EUTM application form so that users may use it in the countries in question but it will not be examined by the EUIPO nor will it be added to EUTM Register."

39. There is no guidance as to whether an indication of colour for a figurative EUTM filed before 1 October 2017 (as it is the case here) will limit the owner's right to using

³ <https://euipo.europa.eu/ohimportal/en/eu-trade-mark-regulation-faqs-2017#cicc>

the mark only in the specific colour described or claimed in the application. Nevertheless, given:

- (a) the absence of a specific norm providing that if colour was claimed in the moment of filing for a figurative EUTM, the mark will be registered and protected only for the exact colour in which it has been presented limiting the owner's right to using the mark only in that particular colour;
- (b) that the option to claim colour for EUTM figurative marks exists only for priority purposes;
- (c) that the '1269 mark is a figurative mark that has been filed in colour and is not a registration of a colour per se;

40. I am reluctant to accept that the limitation included in the '1269 registration means that use of the mark in a (even slightly) different shade of colour must be considered use of a different mark for the purpose of assessing a claim for revocation for non-use.

41. In reaching this decision I am supported by the view of Mummery LJ in *Nestlé SA's Trade Mark Application* in particular the following portion of the judgement:

“A requirement that the elements of colour and size should be included in the mark in order to make it distinctive and therefore registrable, does not, in our judgment, fall within the provisions of s.13(1) that the applicant ‘may agree that the rights conferred by the registration shall be subject to a specified limitation.’ The required inclusion of the colour and size elements is not a specified limitation on ‘the rights conferred by the registration’ of the mark identified in the application. The requirements of colour and size do not limit ‘the rights’, which could have been acquired on registration without including them. The requirements relate to the inclusion of essential ingredients in the content of the mark in order to make it distinctive, thus satisfying the requirements for registration of the mark and thereby obtaining the rights conferred by it.”

42. Mr Mummery LJ essentially referred to Section 13 of the 1994 Act which provides that where the registration of a trade mark is subject to a disclaimer or a limitation the rights conferred by Section 9 are restricted accordingly and stated that the inclusion of the colour and size elements in a mark does not fall within the provisions of Section 13 and does not give rise to a limitation on “the rights conferred by the registration”.

43. Further, until March 2016, disclaimers, but not limitations, were available under the EUTM Regulation. If limitations did not exist at EU level when the mark was filed, then the colour clause contained within the EUTM from which the ‘1269 mark derives, is not a limitation for the purpose of Section 13 of the Act and cannot be interpreted as having the effect of limiting ‘the rights conferred by the registration’.

44. Consequently, I find that the colour clause in the ‘1269 mark is not a limitation for the purpose of Section 13 of the Act.

45. The next issue is to what extent the fact that the mark has been filed in colour affects the protection conferred by the registration.

46. At the hearing Mr Pescador argued that the colour is a main contributor of the overall distinctiveness of the mark, otherwise BC2 would not have requested the registration in colour and it would have registered the mark in black and white. I disagree. Even if the inclusion of the colour in the registration means that the colour is a distinctive element of the mark, that does not necessarily mean that colour is a main contributor to the overall distinctiveness of the mark and/or that actual use of the mark in a different colour would automatically alter the distinctive character of the mark – and, as such, it would not be an acceptable variant of the registered mark.

47. The Common Communication to which Mr Pescador referred was adopted at EU level in the context of the Convergence Programme through the European Trade Mark and Design Network and reflects a common practice for use by national offices. This was implemented in the UK on 15 July 2014. The practice relates to, inter alia, use of a colour version of a trade mark registered in black and white/greyscale (or vice-versa), but does not cover the issue, that is relevant to these proceedings, of use of a mark filed in colour in a different colour and/or colour scheme. In any event, to the

extent that the Common Communication establishes that a logo trade mark filed in black and white or grey will protect the mark in a colour version to the extent that colour is not one of the main contributors to the overall distinctiveness of the mark, it does not depart from the relevant test that use of a registered mark covers acceptable variants that do not alter the distinctive character of the mark as a whole.

48. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under Section 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or

it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

49. In this case, one of the marks used is essentially the same as the registered mark, the only difference being that it is presented in a different shade of blue. The combination of figurative and word elements defines the overall impression of the mark. Although the registered mark is filed in a specific shade of blue, the public would see it as nothing more than a blue colour uniformly applied to the logo that reinforces the message conveyed by the words ‘Bluebird’, as opposed to something that has its own independent distinctive role and contributes significantly to the distinctive character of the mark. Further, although the shade of blue shown in evidence is slightly lighter than that shown in the registration, it is very similar, and it is still a shade of blue, which means that the change of colour does not affect the relatedness between the words and the figurative element of the mark. On that basis, I find that use of one of the marks shown in evidence (i.e. the mark presented in blue against a white background) counts as use of an acceptable variant of the ‘1269 mark under Section 46(2) of the Act.

50. The other mark shown in evidence is ‘reversed’ and appears as white against a blue background. In her witness statement, Ms West relied on the decision O-383-16, in which Mr Allan James, as the Hearing Officer, considered whether use of a reverse

version of a mark depicting a black griffin counted as an acceptable variant of the mark as registered. The relevant part of the decision is as follows:

“49. As the UK is a party to the Common Communication it is necessary to take it into account and apply it in a way that is consistent with the case law. Adopting this approach, I find that use of the “reversed out” version of the registered mark does respect the contrast of shades in the registered mark. This is because the reversal of the colours black and white maintains the contrast between the colour used for the griffin compared to the colour used for the background. To put it another way, whether the griffin is white or black affects the colour used, but not the contrast between the griffin and the background. Consequently, applying the Common Communication consistently with the case law, I find that use of the “reversed out” version of the contested mark also counts as genuine use of the trade mark as registered. If I am wrong about that, I find that it counts as use of an acceptable variant of the registered mark under s.46(2) of the Act. This is because the distinctive character of the ‘reversed out’ mark is manifestly the same as the mark as registered.

50. I should add that if I had been unable to apply the Common Communication in a way that is compatible with the case law, I would have been required to follow the case law. This is because (a) the Common Communication is not legally binding on this tribunal, (b) the case law of the Court of Appeal represents that court’s interpretation of the CJEU’s judgment in *Specsavers*, which is binding on this tribunal, and (c) neither the judgment of the General Court in *Pico Food*, nor in the *MAD* case mentioned in the Common Communication itself, compel me to apply *Specsavers* in a different way, at least so far as the question of genuine use is concerned.”

51. Although Mr James’ decision was appealed, having upheld the decision on one of the grounds raised, the Appointed Person decided that it was not necessary to consider Mr James’ decision on the reversed sign.

52. Mr Pescador did not contend that Mr James’ decision is incorrect, and he did not point me to any authority which would state the contrary of what Mr James had found.

Mr Pescador's argument was rather that the case at hand is not on all fours with the case Mr James had decided. He stated:

“Then my learned colleague referred to the Marriott case where we are talking about a trade mark which says in black and white and it will encompass the use of that particular mark on [any] colour; it does not really matter what colour. That is totally correct, but this is not the case here. We have two different earlier trade marks which are the subject of the cancellation actions and are the basis of the invalidity. In the first case we are talking about the black and white logo and we submit that the Marriott case is different because on that particular case we are talking about a trade mark which is registered in black and white and the same identical trade mark, the only difference that was happening there was there was use in colour. That is absolutely fine but that is not the case here. The logo is different. What we have seen in the evidence has been used is different to the logo that is registered. Whether those differences are material or immaterial is a matter for an assessment and I am going to submit why we consider that they are not the same and the differences are material. It will be for you, madam, to assess whether they are material or not, but not the same case as the Marriott one. Similarly, on the blue logo, the second registration by Bluebird, that registration is in blue. It has a limitation because it is actually a colour claim, and it claims a particular pantone. So, the fact that it is used in a different colour in that particular case is relevant because it is not registered in black and white, it is registered in a particular colour so therefore they claim in a nothing and nothing else”.

53. As I have said, the ‘1269 mark is identical to the mark that has been used, the only difference being that the shade of blue shown in evidence is slightly different from the colour in which the mark was filed. Having found that use of the mark in a different shade of blue is acceptable use, I also find that use of the reverse version is an acceptable variant of the mark as registered.

The '1120 mark

54. BC1's submissions on whether the mark used is an acceptable variant of the '1120 mark are contained within Ms West's witness statement – as referred to by Ms McFarland at the hearing - and are as follows:

“It will be seen from the evidence of use contained in the Witness Statement of Ms Banfield and Mr. Smith that the marks used by the applicant to cancel during the relevant periods were not always identical with the registered mark (UK2401120).

Under Section 47 (2C) of the 1994 Trade Marks Act, the genuine use conditions required to succeed in an invalidity (cancellation) action can be met by the use of a variant form of the earlier registered trade mark provided the variant form differs in elements which do not alter the distinctive character of the earlier mark as registered.

Bearing those conditions in mind, let us compare the two variant forms that have been in use in the UK with the registered mark (UK2401120).

The blue mark on a white background variant form

The differences compared with the registered mark are as follows:

- *The mark in use is coloured blue and white rather than black and white;*
- *There is only one circle surrounding the mark rather than two concentric circles, one thick, one thin;*
- *The bird device in use has been very slightly redrawn so that one of its wings is closer to the surrounding circle; and*
- *The capital letters of the words Bluebird and Care have been replaced in the mark in use, by lower case letters b and c.*

Now, it is submitted that the distinctive character of the earlier mark (UK2401120) consists of the flying bird device and the words Bluebird Care. These are the outstanding and memorable features that would tend to draw the consumer's attention. Both of these elements are present in the blue and white mark in use.

It is further submitted that the only difference between the registered mark and the mark in use that would catch the eye of the average member of the relevant public is that the registered mark is in black and white whilst the mark in use is coloured blue and white. It is long established practice under UK trade mark law that registration of a mark in black and white covers the use of the mark in colour, see Specsavers at the European Court (C 252/12) and Phones 4U in the Court of Appeal (2006 EWCA Civ 244), as well as Mr. Allan James' decision in UKIPO Opposition No. 0-383-16 (Marriott Worldwide Corporation v Dr Sascha Salomonowitz). Mr. James' decision, which is attached at Exhibit AW3, was confirmed on appeal to the Appointed Person (O-549-17).

Taking the above into account and bearing in mind that UK trade mark practice should now be dictated by UK case law, it is strongly submitted that the use of the blue mark on a white background variant form of the registered mark (UK2401120) during the relevant period should count as genuine use in the UK.”

55. The form of use of the registered mark must be assessed in the light of its distinctive character, in order to ascertain whether that distinctive character has been altered. For the purposes of that verification, account must be taken, in particular, of the greater or lesser degree of distinctive character of the mark at issue. The weaker the distinctive character, the easier it will be to alter it by adding an element that is itself distinctive. In *Hyphen GmbH v EU IPO*, Case T-146/15, the General Court held that use of the mark shown on the left below constituted use of the registered mark shown on the right. The court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered.



56. The court set out the following approach to the assessment of whether the addition of additional components is likely to alter the form of the registered mark to a material extent.

“28. ..a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, *ATLAS TRANSPORT*, T-482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, *Maestro de Oliva*, T-4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, *Borrajo Canelo v OHIM — Tecnoazúcar (PALMA MULATA)*, T-381/12, not published, EU:T:2014:119, paragraph 30).

29 For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, *Klement v OHIM — Bullerjan (Form of an oven)*, T-317/14, not published, EU:T:2015:689, paragraph 33).

30 It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, *Sabores de*

Navarra v OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA), T-46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31 It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, *Fruit of the Loom v OHIM — Blueshore Management (FRUIT)*, T-514/10, not published, EU:T:2012:316, paragraph 38).

32 It is in the light of those considerations that it must be determined whether the Board of Appeal was correct in finding, in paragraph 9 of the contested decision, that it had not been proven that the European Union trade mark rights had been used in a manner so as to preserve them either in the form registered or in any other form that constituted an allowable difference in accordance with the second subparagraph of Article 15(1)(a) of Regulation No 207/2009.”

57. These findings indicate that the relative distinctiveness of the registered mark and the components added to (or omitted from) it in use are relevant factors to take into account in the required assessment. In this instance the addition of a circle around the registered mark was not sufficient to alter the distinctive character of the registered mark.

58. Further the court held that, although it was relatively more distinctive than the registered mark, the addition of the word ‘Hyphen’ to the registered mark in a circle (“sign No.3”) did not alter the distinctive character of the registered mark either. In this connection, the court stated that:

“57 It must borne in mind in that regard that, where several signs are used simultaneously, steps must be taken to ensure that, for the purposes of the application of the second subparagraph of Article 15(1)(a) of Regulation No 207/2009, such use does not alter the distinctive character of the registered sign, having regard inter alia to business practices in the relevant sector

(judgment of 24 September 2015, *Form of an oven*, T-317/14, not published, EU:T:2015:689, paragraph 31; see also, to that effect, judgment of 8 December 2005, *CRISTAL CASTELLBLANCH*, T-29/04, EU:T:2005:438, paragraphs 33 and 34).

58 The joint use of a figurative element and a word element on the same textile or clothing item does not undermine the identification function of the registered mark; it is not unusual in the clothing sector to juxtapose a figurative element with word element linked to the designer or manufacturer, without the figurative element losing its autonomous identification function in the overall impression. This finding extends to all the goods and services referred to in paragraph 6 above.

59 Thus, in sign No 3, the target consumer's attention will be drawn to both the word element and the figurative element.

60 It follows that, in sign No 3, the mere addition of the word element 'hyphen c' does not alter the distinctive character of the registered mark, as found, in essence, by the Board of Appeal in paragraph 29 of the contested decision."

59. In *Menelaus BV v EUIPO*, Case T-361/13, the General Court found that use of the marks shown on the left and middle below constituted use of the registered mark on the right.



60. The court held that the word VIGAR was the dominant and distinctive element of all the marks. As regards the other features, the court held that:

"73 [The first sign] sign differs from the earlier mark as registered only in the ascending orientation of its oval background, the use of standard lower-case

instead of standard capital letters and the replacement of the crown element by a sequence of three dots. As the Board of Appeal rightly found, a different orientation of the same background, the use of upper-case or lower-case letters when they are standard letters which reproduce the same term, or the substitution of an ornamental element (the sequence of dots) for a laudatory element when both of those elements serve to reinforce the term ‘vigar’, are minor differences that do not alter the distinctive character of the earlier Community trade mark as it was registered.

74 That finding is not called into question if the second form of use, reproduced in paragraph 63 above, is taken into account inasmuch as, even though, in that case, the basic background disappears and the word ‘spain’ is present, the latter will be understood as a merely descriptive addition.”

61. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Professor Phillip Johnson, sitting as the Appointed Person, upheld the Hearing Officer’s decision that the signs shown in the middle and right below were not acceptable variants of the sign shown on the left:



62. Mr Johnson agreed with the Hearing Officer that the phrase “SERIOUSLY STRONG CHEDDAR” would be seen as descriptive unit indicating the strength and the nature of the Cheddar. As the distinctiveness of the registered mark was in the overall get-up of the mark rather than in the words alone, it followed that the omission of a distinctive part of the mark meant that the forms used were not acceptable variants.

63. In *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, Professor Philip Johnson, as the Appointed Person, found that the use of the mark shown below qualified as use of the registered word-only mark DREAMS. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.

dreams

64. Admittedly, the figurative elements of marks used are not identical to those of the '1120 mark, as shown below:



65. Mr Pescador submitted that the marks in the form submitted differ from the mark protected by the '1120 registration by significant variations in the stylisation of the bird, the position of the letters, the use of a different font, typeface and colour and the removal of a circle. Ms McFarland maintained that the slight changes from the registered mark did not lead to use in a form differing from the mark as registered and did not alter the distinctive character of that mark.

66. The '1120 mark as registered consists of a figurative element representing the silhouette of a bird and the words 'Bluebird Care', with both elements being surrounded by two circles that are discontinued when they meet the letters. The shape of the bird and the words Bluebird Care are the dominant and distinctive elements of the registered mark, and the mark has a normal degree of distinctive character.

67. Although the shape of the silhouette of the bird of the registered mark is not the same as that of the mark as used, they are nearly identical. On a close visual inspection, the form submitted in evidence differs from the form protected by the registered mark in that the head of the bird appears slightly higher, the wings appear slightly more opened, and both ends of the tail touch the circle. However, none of these variations are, in my view, significant. The shape and the proportion of the birds is so similar that it is practically impossible that the relevant public, consisting of the public at large, would perceive the differences relied upon by Mr Pescador given that they are difficult to perceive unless one embarks on a forensic comparison of the marks with, as Ms McFarland said, a magnifying glass. Therefore, despite these differences, the shape of the bird in the marks as used will be perceived by the relevant public as identical to the form protected by the mark as registered. As to the removal of one circular line, applying the guidance from *Hyphen*, I find that it is merely a banal surrounding for the registered mark and its removal does not alter the distinctive character of the mark as registered. Likewise, applying the guidance from *Menelaus* and *Dreamersclub*, I find that the use of a different typeface and font and the slightly different positioning of the letters introduce minor differences that do not alter the distinctive character of the mark as it is registered since the word element 'BLUEBIRD CARE' is entirely reproduced in the form used. At the hearing Mr Pescador relied on the fact that in her witness statement Ms West said that the distinctive character of the '1120 earlier mark lies with both the actual logo and the words 'Bluebird Care'. However, this is a misreading of what Ms West said in her statement, because she did not say that the distinctiveness of the mark lies in the way the words are presented. Finally, I agree with Ms McFarland's submission that registration of the '1120 mark in black and white covers the use of the mark in colour.

68. In the light of all of the above and taking into account the normal distinctive character of the registered mark, I find that the differences between the mark as used and the mark as registered do not alter the distinctive character of the mark for the purposes of Section 46(2) and give rise to use of that mark in an acceptable variant.

69. Finally, in relation to the reverse version of the mark, I accept that this is not simply a question of use of a reversed version of the same mark, as the mark that has been used is slightly different from the one that appears on the register. However, given

what I have said above about the blue-against-white- background-version of the mark being an acceptable variant of the mark as registered, I do not think that the presentation of the same logo in white against a coloured background takes the mark outside the boundaries of acceptable use. I therefore consider this mark to also be an acceptable variant of the registered mark.

Sufficient use

70. The evidence is that BC1 and BC2 are part of the same group of companies, Bluebird Care Group Limited (hereinafter “Bluebird Care”)⁴. Bluebird Care has been operating since 2005 as a care at home business. The business delivers care and support at home services to patients throughout the UK. This includes domiciliary and companionship services, personal care services, medication management services, services with people with disabilities plus care for those with more complex care needs. These services are delivered by trained care assistants who visit the patients’ homes each day.⁵

71. According to Ms Banfield,⁶ Bluebird Care was founded in 2004 by Paul and Lisa Tarsey as a local care provider in Petersfield, Hampshire. The name Bluebird was chosen by the founders because of a family connection with Sir Malcom Campbell and his son Donald, both holders of the world land and speed records from the 1920s to the 1960s. The records set by Sir Malcom and his son were accomplished using vehicles called Blue Bird or Bluebird. In 2005, a local design agency created Bluebird Care logo which, with minor variations, has been used as Bluebird Care’s brand since 2005.

72. The Bluebird Care franchised network of homecare providers is said to employ over 1,000 people in the UK and to have a total turnover of £200 million in the UK overseen by over 200 franchisees, conducting nearly 8 million home care visits a day and visiting over 9,500 patients a day. A non-exhaustive list of UK locations with a


⁴ Mr Smith’s witness statement, page 4

⁵ Mr Smith’s witness statement

⁶ Ms Banfield’s first witness statement

Bluebird Care franchised operation is provided, showing nearly 50 different locations across the UK.⁷

73. According to Mr Smith, Bluebird Care is, at the time of his witness statement, the largest home care provider in the UK with a market share of around 1.9% of “the total UK independent homecare and supported living providers market in the country”. To support this statement, Mr Smith includes within the body of his witness statement the following table:

 UK Independent homecare and supported living providers by market share Most recent data at November 2020					
Operator	Activity type	Sector	Latest annual revenue ¹ , £m	Market share %	Cumulative market share %
City & County Healthcare (est. run rate in 2019/20 after acquisitions of Carewatch and Human Support Group)	Homecare	For-profit	295	3.2%	3.2%
Lifeways Group (est. excl. care home revenue)	Supported living	For-profit	218	2.4%	5.6%
Dimensions UK (est. excl. care home revenue)	Supported living	Not-for-profit	180	1.9%	7.5%
Bluebird Care (franchisor)	Homecare	For-profit	176	1.9%	9.4%

74. Mr Smith states that the table is an extract from the 2020 Laing Buisson report which, he explains, is an independent company that provides market intelligence in the care and healthcare sector.

75. Mr Smith gives the following annual turnover for the period 2016-2020:

Year	Bluebird Care’s annual turnover (£)
2016	8.6million
2017	9.3million
2018	9.8million
2019	10.3million
2020	11.5million
Total	49.5million

⁷ Mr Smith’s witness statement, page 5

76. He also says that the first Bluebird Care franchise was granted in 2006 and the total income from franchising the brand since 2006 is over £78million.

77. According to Mr Smith, the amount spent by the central Bluebird Care franchisor on advertising its franchised care services nationally throughout the UK from 2006 to the date of his witness statement was over £800,000 with the annual spend for the five-year period 2016-2020 being as follows:

Year	Bluebird Care's annual advertising spend (£)
2016	48,190
2017	78,806
2018	71,364
2019	72,754
2020	77,080
Total	348,194

78. WS5 consists of a selection of 20 invoices sent by BC2 to its franchisees during the period 2013-2020, although the identity of the franchisees has been redacted for confidentiality reasons. Mr Smith explains that term MSF on the invoices stands for Management Services Fees, which include monthly fees paid by each franchisee to Bluebird Care for know-how, procedures and other assistance as well as for the use of the '1120 mark. Other invoices – dated 5 December 2013, 5 November 2014, 12 December 2014, 27 August 2015, 30 September 2015 and 27 April 2018 – have also been provided⁸ showing money paid by Bluebird Care for personal care services provided by care workers.

79. Screenshots of the website www.bluebirdcare.co.uk in different points of time are also produced covering the years 2011-2021.⁹

80. Evidence is also filed of:

⁸ WS6

⁹ HB2-4 and HB16-17

- Bluebird Care being awarded The British Franchise Associations Franchise of the Year in 2017;¹⁰
- Copies of Care Quality Commission (CQC) Reports issued in relation to Bluebird Care facilities in various UK locations in 2017, 2018 and 2018;¹¹
- Online articles about Bluebird Care providing JET (Joint Emergency Team) services (see below);¹²
- Examples of Bluebird Care brochures (undated);¹³
- Examples of publications that refer to Bluebird Care dated on various dates between 2015 and 2021;¹⁴
- Examples of promotional material dated on various dates between 2014 and 2019;¹⁵
- Copies of pages from Bluebird Care’s websites and social media accounts;¹⁶
- Extracts from Bluebird Care’s Operation Manual (dated 2015) which is provided to all of its franchisees and care staff;¹⁷

81. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹⁸

82. The evidence shows that Bluebird Care provides its services to the public as a homecare agency employing care workers and arranging for them to visit people at home to provide care services. The business has been operating since 2005 providing its services across the country through more than 200 franchisees, conducting nearly 8 million home care visits a day and visiting over 9,500 patients a day. An independent report from 2020 indicates that Bluebird Care has a market share of nearly 2% of the homecare services market and was awarded “The British Franchise Associations Franchise of the Year” award in 2017. The business generated a turnover of nearly 50 million in the five-year period 2016-2020 and spent over £348,000 in promoting its

¹⁰ HB5

¹¹ HB7

¹² HB8

¹³ HB9

¹⁴ HB10 and HB34-41

¹⁵ HB10

¹⁶ HB11-12

¹⁷ HB42-43

¹⁸ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

services nationally in the same period. Although the turnover and advertising spend recorded from the inception of the business are higher, being £78million and £800,000 respectively, they are not broken down by year. Further, the unchallenged turnover and marketing figures¹⁹ are supported by corroborating samples of invoices dated on various dates between 2013 and 2020.

83. Given Ms Banfield's narrative evidence that BC1 is a sister company to BC2 which in the past has provided care services to customers and was independently registered with the CQC and the evidence that:

- (a) BC2, as a main franchisor, does not directly provide care services and is not registered with CQC;
- (b) BC2 can grant licenses to its franchisees under the term of the franchise agreement;
- (c) Since November 2021, BC2 has a licence to use BC1's marks and prior to this, it utilised BC1's trade marks on an informal basis but with BC1's permission;

84. I am satisfied that use of the variant marks by the franchisees is use with BC1 and BC2's consent and is sufficient to constitute use by BC1 and BC2 (i.e. the proprietors themselves) for the purposes of Section 46.

85. Further, I am also satisfied that the marks have been used to identify services provided through a franchise business operating across the UK, and that the scale, frequency and territorial extent of the use made amounts to genuine use in the sense that it is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question. Although the '1269 mark is a comparable mark deriving from an EUTM - which means that I must consider the EU as the market in which the proprietor is required to show genuine use up to 31 December 2020 – and the evidence is all directed towards use in the UK, I consider that use in the UK prior to IP completion day, is genuine use in the EU for the purpose of Section 46.

¹⁹ Although LAS request to cross examine Ms Banfield and the request was refused (with no further challenge), the request was directed as evidence relating to instances of confusion, not to the evidence of use.

86. Given that annual turnover and advertising figures are provided for the period 2016-2020, the evidence is sufficient to demonstrate that BC1 and BC2 have put their marks to genuine use in the UK during the most recent relevant period, namely between 29 February 2016 and 28 February 2021 and 5 November 2015 and 4 November 2020 (in revocation no. 503680 against the '1120 mark) and between 7 June 2016 and 6 June 2021 and 5 November 2015 and 4 November 2020 (in revocation no. 503898 against the '1269 mark) respectively. This would be enough to save the '1120 mark even if there was not sufficient use during the earliest relevant period, i.e. 24 March 2006 - 25 March 2011, since, in such case, the position would be restored by virtue of Section 46(3).

Fair specification

87. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

88. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

89. The defended services are as follows:

- The '1120 mark - Class 44: *Medical services, hygienic and beauty care for human beings.*

- The ‘1269 mark – Class 10: *Medical devices*; Class 44: *Provision of staff for nursing, healthcare, hospice, therapy and non-medical home care.*

90. At the hearing, Mr Pescador contended that the use shown is only in relation to something which he characterised as social care in a very generic sense. He suggested that there is no evidence of personal care, beauty treatments and/or of anything pertaining to medical support and medical treatments.

91. All of the evidence points in one direction, namely, that Bluebird Care is a provider of homecare services. I agree with Mr Pescador that there is no evidence of use in relation to medical devices. For there to be use in relation to medical devices, Bluebird Care would need to show that it uses its mark as a badge of origin in relation to medical devices it manufactures and sells. There is nothing in the evidence to show that. At the hearing Ms McFarland referred me to some evidence showing a Facebook post whereby Bluebird Care provides advice on how to keep vulnerable people safe at home by installing some safety equipment to avoid accidents when nobody is able to visit. She stated that this is part of the package of trying to keep people out of hospital and assist patients with what she described as medical devices or machinery. She also referred to use of images of lifts and various equipment in training material as well as in promotional material. I think that it is farfetched. There is no evidence of use of the mark as a badge of origin in relation to medical devices and, in any event, there is no indication of any turnover generated by the sale of these goods. Taking all of the above into account, I am not satisfied that BC2 has demonstrated genuine use of the ‘1269 for medical devices.

92. Turning to the services in class 44, whilst Mr Pescador accepted that the evidence clearly reflects that the business of Bluebird Care consists in the provision of home care to individuals that require attention for several reasons (elderly, incapacitated, etc.), he argued that this is not use in relation to the registered services. He stated:

“Those services are not, however, what they are covered by the Earlier Registrations. For instance, the “medical services” and “medical care services” covered by [‘1120] are not the same as those provided by Party A – these services are required to be provided by specifically qualified doctors and

nurses, which is not the case according to the evidence. The fact that in the process of providing the home care services a carer might ensure that it looks after an individual to, for example, ensure that it takes its medication as prescribed by a doctor cannot be equated to the actual provision of medical services.

28. Similarly, the services covered by [‘1269] identified as “provision of staff for nursing, healthcare, hospice, therapy and non-medical home care” are not apparently provided by Party A. It is not apparent in the evidence that Party A acts as a human resources provider that allocates workers to hospitals, other similar establishments or even personal to third parties for them to provide home care services. Party A itself provides home care services (even if this is done through a franchise system), which is distinct from the facilitating of personnel to third parties for those third parties to provide the services. The actual services provided by Party A are specific to class 45 and can be identified in the specification of services covered by the registrations for the Dove Mark by Party B in said class.

29. Finally, there is no evidence of the provision of hygienic and beauty care for human beings ...”

93. Screenshots from Bluebird Care’s website describe the categories of services provided as “homecare and support services”, “specialist care services” and “extra care to live life your way” with the subcategories of “homecare and support services” being listed as “dementia care”, “Alzheimer disease care”, “live in care”, “learning disabilities care”, “physical disabilities care”, “respite care”, “end of life care”, “care for children” and the subcategories of “specialist care services” being listed as “diabetes care”, “high blood pressure care”, “joint replacement care”, “Huntington disease care”, “palliative care”, “arthritis care”, “dementia care”, “acquired brain injury care”, “Parkinson disease care”, “multiple sclerosis care”, “MND care”, “spinal injuries care”, “stroke care”. Other webpages from the same website describe the homecare and support services offered as including: (a) helping the user to get up, wash, shower or bathe, dress and have breakfast; (b) remind or assist the user to take their medicines and collect or return medication from pharmacy or dispensing GP surgery; (c) prepare

meals and assist the user at mealtimes; (d) collect the user's pension with them or for them; (e) assist the user with shopping; (f) help the user with laundry, ironing and cleaning; (g) assist the user with social activities such as going out for a walk, attending a day centre, visiting friends or family, going to church or clubs; (h) getting the user ready for bed; (i) overnight sleeper or walking support, respite care or a 24 hour live in service. Another webpage talks about specialist care services and says that Bluebird Care's trained staff can respond to needs arising from many physical and mental conditions, as those listed above, whilst the "*extra care to live life your way*" services appear to be essentially homecare companionship services.

94. Although Bluebird Care's website refers to different care types, none of the services listed involve medical treatments of the type provided by doctors, nurses and/or health professionals. The 2020 Laing Buisson report also refers to Bluebird Care as a UK independent homecare and supported living provider, and the only services listed on the invoices are described as "personal care". Although there is a reference on the website to Bluebird Care staff assisting users with taking their medications, there is no evidence that the services are provided by qualified nurses or that the assistance provided involve any medical tasks in dosing or administering the drug. Further the website refers Bluebird Care being "*well positioned to provide homecare and support that people need now and in the future to maintain their independence and lifestyle, and most importantly, remain in the comfort and security of their homes*" which again, are non-medicated personal care services. Overall, the evidence does not support the conclusion that the services provided by Bluebird Care staff are medical home-care services as opposed to non-medical/personal home care services.

95. Whilst Ms McFarland pointed out that Bluebird Care's business is subject to checks by the CQC, which is the body that regulates all health and social care services in the England, there is nothing in the reports produced in evidence which would suggest that a business subject to a CQC's inspection necessarily provides healthcare and medical services. On the contrary:

- The CQC’s reports describe the Bluebird Care business as homecare agencies and states that the inspection team included two adult social care (not healthcare) inspectors only;
- The reports are said to have been carried out according to Section 60 of the Health and Social Care Act 2008 and Section 9 of the same act draws a distinction between health and social care. It states:

“Health or social care”

(1) This section has effect for the interpretation of this Part.

(2) “Health care” includes all forms of health care provided for individuals, whether relating to physical or mental health, and also includes procedures that are similar to forms of medical or surgical care but are not provided in connection with a medical condition.

(3) “Social care” includes all forms of personal care and other practical assistance provided for individuals who by reason of age, illness, disability, pregnancy, childbirth, dependence on alcohol or drugs, or any other similar circumstances, are in need of such care or other assistance.

(4) “Health or social care” means health care or social care.”

96. It is therefore apparent that the services provided by Bluebird Care fall within the definition of social care services set out at paragraph (3) above, namely personal care and other practical assistance provided for individuals who by reason of age, illness, disability, or any other similar circumstances, are in need of such care or other assistance.

97. Finally, Ms Banfield refers to the evidence that in 2017 Bluebird Care started providing JET Service, a service *“designed to help keep people out of hospital in the first instance by putting emergency care in place in the community where patients would otherwise be admitted to hospitals”*. The various online articles that mention Bluebird Care JET state that it was a joint effort, explaining that Bluebird Care and local health care professionals such as GPs and district nurses joined together to deliver the same level of care to patients’ own home and that the services were

provided by Bluebird Care working alongside NHS. The articles also explain that patients with acute illnesses were referred by GPs, district nurses and community care teams to Bluebird Care Jet who then assessed the patient within a few hours immediately putting in place emergency care in their own home. Accordingly, as I read this evidence, it is wholly inconsistent with any understanding that Bluebird Care provided medical services or that Bluebird Care supplied the healthcare staff, e.g. GPs and the nurses, who provided the medical services. Likewise, at the hearing Ms McFarland refers to the evidence²⁰ that in 2019 Bluebird Care started providing a “Heath and wellbeing check” service, which include a 30-minute visit once a week to monitor the user’s vital sign, including breathing and oxygen saturation, alertness and general wellbeing. Once again, whilst carers who provide the services might have been trained to understand what a normal result of oxygen saturation checks would be, it does not mean that they provide medical or healthcare services because such services can only be provided by qualified doctors, nurses or healthcare workers. This is all of the more so, since the same evidence indicates that if the results of the checks are not satisfying Bluebird care would refer the user to a GP to take the appropriate action.

98. I am fortified in this conclusion by Ms Banfield’s own evidence which shows Bluebird Care’s staff being described as care worker,²¹ and the job description being as follows: *“it is sometimes difficult to generalise what the role of a care worker is. The best way of summing it up is that we might perform the tasks carried out by a close friend or relative but in a trained, professional and knowledgeable way”*.

99. Taking into account all of the above my conclusion is that there is no evidence of use of the ‘1120 mark for *Medical services* in class 44.

100. Likewise, whilst there is evidence that Bluebird Care staff assist users with washing, showering/bathing and dressing, that would not be a beauty care services, as I would consider the latter to involve some form of treatment to improve someone's beauty such as a facial, manicure or depilation.

²⁰ HB44

²¹ HB17

101. The last term covered by the registration is *hygienic care for human beings*. I consider that the meaning of *hygienic care for human beings* would cover some of the care and personal services provided by Bluebird Care and I find that there has been genuine use in relation to these services.

102. For similar reasons, I find that there has been genuine use in relation to *Provision of staff for non-medical home care*, but not for the remaining *Provision of staff for nursing, healthcare, hospice, therapy*. In this connection, I reject Mr Pescador's point that the term 'provision of staff' would only cover the provision of staff to third parties (similar to an employment agency) who would provide the services to the end-users. In my view, the term is broad enough to cover both the provision of care-workers directly to the end-users and to home-care agencies (but in any event the business is described as "homecare agencies" in the CQC report).

Outcome of the revocation action

103. The applications nos. 503680 and 503898 under Section 46(1)(a) and (b) of the Act have been partially successful.

104. The '1120 mark (UK00002401120) will be revoked in part and the rights of BC1 (i.e. the proprietor) in that regard are deemed to have ceased from the earliest possible date, namely **25 March 2011**. The registration shall be reduced to cover only the following services:

Class 44: *Hygienic care for human beings*.

105. The '1269 mark (UK00912421269) will be revoked in part and the rights of BC2 (i.e. the proprietor) in that regard are deemed to have ceased from the earliest possible date, namely **2 May 2019**. The registration shall be reduced to cover only the following services:

Class 44: *Provision of staff for non-medical home care*.

BC1 and BC2's applications for invalidity nos. 503556, 503753 and 504338

106. As BC1's earlier '1120 mark has been partially revoked from a date (25 March 2011) which is earlier than the date LAS' mark no. '2409 was filed (22 November 2017), it might still be relied upon by BC1 in its application for invalidity against the '2409 mark but only insofar as it covers the surviving specification (because this was the valid specification at the time the contested mark no. '2409 was filed). Conversely, as BC2's earlier '1269 mark has been partially revoked from a date (2 May 2019) which is subsequent to the date LAS's marks nos. '2409 and '6346 were filed (22 November 2017), it can theoretically be relied upon for all the goods and services for which it was registered at that point in time (which is prior to the revocation taking effect). I say theoretically, because LAS requested BC2 to provide proof of use in both invalidity proceedings.

107. The relevant statutory provisions in all of the invalidity proceedings at issue are as follows:

"47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

...

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

....

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services.

...

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

...

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

108. As the earlier mark ‘1269 is a comparable mark, paragraph 9 of part 1, Schedule 2A of the Act is relevant. It reads:

“9.— (1) Section 47 applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 47(2A)(a) and 47(2B) (the "five-year period") has expired before IP completion day —

- (a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
- (b) the references in section 47 to the United Kingdom include the European Union.

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

- (a) the references in section 47(2B) and (2E) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
- (b) the references in section 47 to the United Kingdom include the European Union”.

Proof of use

109. In invalidity no. 503556, BC1 relies on its earlier ‘1120 mark insofar as it covers *Medical care and hygienic and beauty care for human beings* (Class 44).

110. In invalidity no. 503753, BC2 relies on its earlier ‘1269 mark insofar as it covers *Provision of staff for nursing, healthcare, hospice, therapy and non-medical home care* (Class 44).

111. In invalidity no. 504338, BC2 relies on the same earlier '1269 mark, but on a broader specification, namely *Medical devices (Class 10)* and *Provision of staff for nursing, healthcare, hospice, therapy and non-medical home care (Class 44)*.

112. I have already gone through the evidence of use of the earlier marks '1120 and '1269. The same evidence is relied upon by BC1 and BC2 for the purpose of establishing genuine use of their marks in the invalidity proceedings.

113. Although the relevant periods for the purpose of establishing genuine use of the '1120 mark in the invalidity proceedings no. 503556 are slightly different from the periods in relation to which I have assessed the revocation action against the '1120 mark (the relevant periods in the invalidity are (i) the 5 year period ending with the date of application for the declaration, i.e. 10 January 2016 - 11 January 2021 and (ii) the five year period ending with the date of filing of the application for registration of the later trade mark, i.e. 21 November 2012 - 22 November 2017) the outcome of the proof of use assessment is the same. This is because the turnover and marketing figures that have been provided (which are for the years 2016-2020) cover the first relevant period and at least 2 years of the second (less recent) relevant period and there is evidence of use of the mark since at least 2006.

114. For similar reasons to those I have set out above, I therefore consider that there has been genuine use of the '1120 mark for *hygienic care for human beings* in the relevant periods and that BC1 can rely on this specification in the invalidity no. 503556.

115. Similar considerations apply to BC2's '1269 mark. Here the relevant periods for proof of use are:

- in invalidity no. 503753: (i) 10 January 2016 - 11 January 2021 and (ii) 21 November 2012 - 22 November 2017;
- in invalidity no. 504338: (i) 10 November 2016 - 11 November 2021.

116. For similar reasons to those I have set out above, I consider that there has been genuine use of the '1269 mark for *Provision of staff for non-medical home care* in the

relevant periods and that BC2 can rely on this specification in the invalidity nos. 503753 and 504338.

Section 5(2)(b)

117. Section 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because-

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

118. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

119. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of services

120. Section 60A of the Act states that:

“(1) For the purposes of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

121. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary.”

122. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281. At [296], he identified the following relevant factors:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

123. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa.

124. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

125. The services to be compared are as follows:

LAS's services	BC1 and BC2's services
<p>The '2409 mark</p> <p>Class 44: <i>Medical care; nursing care; ambulant medical care; consulting services relating to healthcare; home-visit nursing care; home health care services; geriatric nursing; advice relating to the medical needs of elderly people.</i></p> <p>Class 45: <i>Providing non-medical assisted living home care, namely emotional or personal support services, chaperoning, companionship services; companionship services for the elderly and disabled.</i></p>	<p>The '1120 mark (503556)</p> <p>Class 44: <i>hygienic care for human beings</i></p> <p>The '1269 mark (503753)</p> <p>Class 44: <i>Provision of staff for nonmedical home care.</i></p>
<p>The '6346 mark</p> <p>Class 44: <i>Medical care; nursing care; ambulant medical care; consulting services relating to healthcare; home-visit nursing care; home health care services; geriatric nursing; advice relating to the medical needs of elderly people.</i></p> <p>Class 45: <i>Providing non-medical assisted living home care; companionship services for the elderly and disabled.</i></p>	<p>The '1269 mark (504338)</p> <p>Class 44: <i>Provision of staff for nonmedical home care.</i></p>

Class 45

126. In relation to the contested services in class 45 Mr Pescador stated:

“...in relation to the remaining services in class 45 covered by the Dove Mark registrations, any level of similarity between them and the goods and services covered by the Earlier Registrations is, in the best-case scenario for the Applicant for Cancellation, similar to a very low degree. The nature of the services is very different, effectively healthcare services provided by hospitals, doctors clinics, etc. on the one hand, and providing non-medical home care and companionship on the other. The purpose is different. The methods of use are different. The services do not compete and are not provided through the same channels of trade.”

127. It is not clear what services Mr Pescador was comparing, but it seems to me that he might have been comparing the earlier *medical services* (in the ‘1120) and *Provision of staff for nursing, healthcare* (in the ‘1269 mark) on one side, with LAS’s non-medical homecare services in class 45. However, the earlier registrations in class 44 were not limited to these services but included services related to non-medical home care - which are the only services that have survived the proof of use assessment. It is possible that Mr Pescador might have overlooked these services, nevertheless it seems obvious to me that although the competing services are in different classes, the earlier *Provision of staff for nonmedical home care* in class 44 is sufficiently broad to encompass LAS’ services in class 45, namely *Providing non-medical assisted living home care, namely emotional or personal support services, chaperoning, companionship services; companionship services for the elderly and disabled* (in the ‘2409 mark) and *Providing non-medical assisted living home care; companionship services for the elderly and disabled* (in the ‘2409 mark). The same goes for the earlier *hygienic care for human beings* (in the ‘1120 mark) which is encompassed by LAS’s services in class 45. **These services are identical on the principle outlined in *Meric*.** If not identical, the services are highly similar as they target the same users, have the same nature, i.e. personal services, and purpose, are likely to be provided through the same channels and are competitive and complementary.

Class 44

128. In her submissions, Ms McFarland stated that the competing services are identical. Mr Pescador agreed that the services in class 44 are identical or at least similar.²² However, Mr Pescador's admission was made on the basis of the earlier marks' registered specifications which included, inter alia, *medical services* and *provision of staff for nursing, healthcare* but these services can no longer be relied upon following my assessment of proof of use.

129. Comparing LAS's later specifications with the earlier survived specifications, I find that the earlier *hygienic care for human beings* and *provision of staff for nonmedical home care* are types of personal and social care services rendered by others to meet the needs of individuals who are elderly, disabled or otherwise unable to care for themselves. The services include tasks which provide assistance with essential everyday activities such as washing, dressing, cleaning, laundry, meal preparation and feeding, and other day-to-day duties to keep a person living well in the comfort of their own home. The evidence filed support this interpretation of the registered services.

130. LAS's *Medical care; nursing care; ambulant medical care; consulting services relating to healthcare; home-visit nursing care; home health care services; geriatric nursing; advice relating to the medical needs of elderly people* (in the '2409 mark) and *Medical care; nursing care; ambulant medical care; consulting services relating to healthcare; home-visit nursing care; home health care services; geriatric nursing; advice relating to the medical needs of elderly people* (in the '6346 mark) are all medical and nursing services which are either limited or cover services specifically provided to elderly people. Although the competing services differ in nature and purpose (medical versus non-medical services), they target the same users and can both be provided in the form of domiciliary care delivered at the user's home. As regards to trade channels, Ms McFarland argued that contrary to Mr Pescador's position, the evidence supports the conclusion that trade channels coincide, although she did not refer to any specific piece of evidence which show that homecare

²² Skeleton argument, paragraph 36

companies provide both domiciliary medical and non-medical care services. There is admittedly some evidence which provides an overview of the home care market, namely (a) an article titled “Care home in the UK” which draws a distinction between care homes described as “*homes that provide living accommodation, meals and help with personal care*” and nursing home which also provide nursing care; (b) an article from a provider of residential care titled “*Residential care homes*” which states: “*Care homes were traditionally referred as residential homes and nursing homes. Today the most common term is care home. This umbrella term refers to all homes that provide both personal and nursing care*”. Although the domiciliary care market is not the same as the home care market (in relation to which there is evidence that the trade channels coincide), the markets are very similar, as they both provide the same services to identical users. In addition, elderly people and people with disabilities who require domiciliary medical and nursing assistance are also likely to require personal home care assistance. Consequently, I find that the services are complementary to a certain degree in the sense that one service is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking. Finally, the fact that the same services have converged in the market in the context of services provided in care homes, are subject to checks by the same public body, i.e. CQC, and are governed by the same legislation, reinforces the conclusion that the services are actually complementary. **In my view these services are similar to a low to medium degree.**

Average consumer

131. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well

informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

132. Mr Pescador submitted that services are selected with a good deal of consideration because the individuals who select them will do so either for themselves or for their family and loved ones and will want to ensure that the services are adequate for the care needs of the recipients.

133. Ms McFarland in her observations submitted that the recipients of care services are, in the main, those from the senior element of society, and may suffer impairments (physically or mentally) which may impact on their recollective processes and/or assessments of what they see or process in terms of distinctive and memorable elements. I am not sure how this submission sits with the case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. If what Ms McFarland meant is that I should assess the likelihood of confusion from the perspective of an average consumer who suffers from a cognitive decline, that is not the correct test to be applied.

134. Ms McFarland also referred to Ms Banfield’s statement that Bluebird’s consumer base may be *“more mature less digitally savvy...tending to be more heavily reliant on personal and word of mouth recommendations”*. This statement is not really supported by any evidence and if the conclusion I am invited to draw is that aural considerations are more important than visual ones, I reject it. As Ms Banfield herself stated in her witness statement: *“Bluebird Care attracts its customers through a variety of marketing medium. In today’s digital world, we often attract customers thanks to our online digital footprints through clear and consistent content, advertising (on mainstream UK websites and across social media platforms such as Facebook and Instagram)”*.

135. The average consumer of the parties’ home care services is person seeking personal assistance at home or a person acting on their behalf. The services at issue are specialised and will be selected with a medium to high level of attention taking into






account factors such as the reputation and reliability of the provider, the accessibility of the services based on geographical location, the price, terms and conditions of the services purchased/provided, especially taking into account that they can affect the safety, health and wellbeing of their end-users. The services will be selected visually, from marketing material and websites, although I do not discount the impact of aural considerations, in the form of, for example, word-of-mouth recommendations.

Comparison of marks

136. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

137. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The respective marks are shown below:

LAS's marks	BC1 and BC2's earlier marks
<p data-bbox="204 253 432 282">The '2409 mark</p> 	<p data-bbox="810 253 1038 282">The '1120 mark</p>  <p data-bbox="810 539 1038 568">The '1269 mark</p> 
<p data-bbox="204 813 424 842">The '6346 mark</p> 	<p data-bbox="810 813 1038 842">The '1269 mark</p> 

The parties' submissions

138. At the hearing, Ms McFarland contended that (a) the marks are visually highly similar because they incorporate a device consisting of a bird in flight with upraised wings facing the same way; (b) average consumers are unlikely to notice any anatomical difference between the birds depicted in the respective marks; (c) aurally, since there is no verbal element in LAS's marks, they will be described in an identical (or closely similar) manner and the average consumers will refer to the figurative elements of the mark as "the bird", "the bird in a circle" or "bird in a hoop" or "bluebird"; (d) in terms of a conceptual comparison, the marks are conceptually identical or highly similar because the shared bird image will inevitably bring to mind the identical concept of a bird in broadly the same pose and profile. Notwithstanding that there may be very small visual differences, both marks contain a strikingly similarly posed blue bird that will convey the same conceptual idea (an idea which is reinforced in the earlier mark by the word "Bluebird"), whilst the word "Care" has little or no material impact or distinctiveness due to its descriptive connotations.

139. Mr Pescador states that the marks are aurally different and conceptually different because although both devices represent a bird, they do so in a different manner and “no business can claim a monopoly over any potential depiction of a bird”. In relation to the visual comparison, Mr Pescador’s submissions taken from his skeleton argument are as follows:

“The only shared factor is that the respective marks feature a representation of a bird. That, in itself, cannot and is not sufficient to find a likelihood of confusion. The Dove Mark represents a dove in green or turquoise colour with the very small visible part of the interior of the right wing represented in blue, all within an incomplete ellipse in blue colour. There is a clear contrast between the parts in blue within the Dove Mark and the main representation of the dove which is in a green/turquoise colour, which helps to identify the main colour significantly away from “blue”. Further, the wings of the dove are spread towards the back of the device, taking a central presence within the device and positioning them on top of the tail of the dove.

On the other hand, the Earlier Marks feature a bluebird (and the recognition of the type of bird is reinforced by the presence of the word BLUEBIRD within the marks). In both cases, the bluebird is enclosed within a circle which is only broken in the right-hand side by the appearance of the very prominent words BLUEBIRD CARE. As per the actual depiction of the figurative elements, whilst one is more stylised than the other, both feature the wings in a position towards the left of the device and on top of the head and upper side of the body of the animal, as opposed to the Dove Mark which features the wings on top of the tail end of the animal. The animal representation in the Dove Mark occupies much more space in the depiction of the mark than the bluebird does in the Earlier Marks, which feature the words BLUEBIRD CARE in a prominent manner.”

Overall impression

LAS’s mark

140. LAS's mark is a figurative mark which consists of the silhouette of a flying bird incorporated within a circle. The bird is depicted with open wings, facing left. At the hearing Mr Pescador referred to the bird as a 'dove' and to the colour of the bird as green. Mr Archer, one of LAS' witnesses, provided evidence that the professional designer who was commissioned to refresh the original logo used in the USA for the UK launch stated that she added more yellow to the original aqua colour – which she described as being exactly mid-way between green and blue - taking the colour towards the green end of the spectrum. Mr Archer also produced copy of an email from what appears to be a printing company that looks after LAS's branding which says that that the pantone colours used for LAS's logo are green 7472 and Blue 660. I put very little weight on this evidence. First because it is hearsay and was sought by LAS after any relevant dates in these proceedings – which raises questions about the independence of this evidence. Second, because the perception of tertiary colours (these are combinations created by from colour mixing) can be quite subjective due to their compound nature. In my view the colour of the bird in LAS's mark can be described as turquoise, which the Collins online dictionary describes as follows:

“Turquoise or **turquoise blue** is used to describe things that are of a light greenish-blue colour.”

141. This in my view is also how most average consumers will describe the colour of LAS's mark, although I accept that there might be a fairly mixed reaction with some consumers seeing more blue than green and others seeing more green than blue.

142. As regards the distinctiveness of the bird element, Mr Archer states in his evidence that *“a bird themed logo is hardly a rarity in the home care sector in the UK”* and exhibits printouts from six providers of homecare services showing use of bird or a dove in their logos. Whilst I note this evidence, I do not find it helpful because: a) it is dated after the relevant dates; (b) the image of a bird is neither descriptive nor allusive of the services. I therefore reject LAS's submission that birds are frequently employed in the homecare market and are rather weak in relation to the parties' services.

143. The main component of LAS's mark is the depiction of a bird, with the circle and the colour contributing to a lesser extent to the overall impression.

BC1 and BC2's marks

144. Both marks consist of the depiction of a bird incorporated within a circle with the words Bluebird Care. One of the marks is presented in blue, whilst the other being registered in black and white covers use in any colour, including blue. Both elements, the bird and the words, reinforce each other and contribute equally to the overall impression.

Visual similarity

145. As BC1's '1120 mark is registered in black and white, notional and fair use covers use in any colour, including the same shade of turquoise used in the contested mark, but not in the colour split with the blue.

146. Whilst Mr Pescador's submissions were highly detailed in terms of the differences that exist between the two devices, the difficulty with his approach is that it does not pay sufficient regard to the fact that the average consumer has a tendency to form overall impressions of trade marks based on their dominant and distinctive components. Rather it assumes that consumers will examine the various details of the marks engaging in a detailed analysis. Looking at the matter in the correct way, I find that the average consumer is unlikely to register all of the differences listed by Mr Pescador, including the point that in BC1 and BC2's mark the wings appear in a position towards the left of the device and on top of the head and upper side of the body of the animal, as opposed to LAS's mark which features the wings on top of the tail end of the animal.

147. The depiction in the competing marks of the silhouette of a flying bird facing left presented in the same shade of turquoise (in BC1's mark) or even in a darker shade of blue (in BC2's mark), within a circular interrupted line and with the same relative proportion of the size of the bird within the circle, will create a similar impression. Admittedly, the depictions of the birds in the respective marks present some visual

differences and BC1' mark presents two circular lines rather than one, however, these differences do not make the figurative elements of the marks drastically different. Taking into account all of the relevant features of the marks, including the impact of the colour, I find that the figurative elements of the marks are visually similar to a medium to high degree (in the comparison with BC1's mark) and to a medium degree (in the comparison with BC2's mark).

Aural similarity

148. As LAS's marks contain no words, they cannot be pronounced. At the very most, the visual and conceptual content can be described orally. According to Ms McFarland, both descriptions of marks in this case would be of a 'blue bird'. However, in my view it is more appropriate to assess the significance of this under the heading of conceptual similarity rather than as a matter of aural similarity. This is because devices are not capable of being compared aurally²³ and although I accept that it is of course possible that some consumers will attempt to articulate the mark on the basis of the concept of a turquoise/blue/green bird or a flying bird, which I will bear in mind, I found that it is the visual impact of the marks which will take on primary significance. On a conventional aural comparison, BC1 and BC2' marks will be articulated as 'Bluebird Care' and LAS's mark will not be articulated so the marks are aurally different.

Conceptual similarity

149. Turning to the conceptual comparison, Ms McFarland submitted that the marks are conceptually identical or highly similar. Mr Pescador said that the marks are conceptually different although he accepted that there was some conceptual similarity at the general level on the basis that all marks represent a bird.

150. The central concept of all the marks is a flying bird depicted within an interrupted circle in a blue or turquoise colour. Although Mr Pescador says that the bird in LAS'

²³ GC in Case T-424/10, *Dosenbach-Oschner AG v OHIM*, paragraph 46: "A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks."

mark is likely to be perceived as a dove, i think this is unlikely given that doves are white. In my view, the figurative elements of the marks create a high degree of conceptual similarity. To the extent that the words 'BLUEBIRD' in BC1 and BC2's marks reinforce what the eyes see, i.e. a blue bird, and the word 'CARE' is descriptive of the services, they do not introduce a strong conceptual difference.

Distinctive character of earlier mark

151. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

152. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character,

such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

153. From an inherent point of view, the image of a bird is neither descriptive nor suggestive of any characteristic of the services. Evidence has been presented to suggest that the distinctive character of the bird element of the earlier marks is weak. However, I have already rejected it. Further, the particular graphic representation of the bird adds to its distinctiveness. Although the circular device is a simple shape, it has a visual impact because it links the various elements of the mark giving it a distinctive presentation. The words 'Bluebird Care' are also distinctive, but because they have no verbal counterpart in LAS's mark, they do not add any distinctiveness that increases the likelihood of confusion. All things considered, the earlier mark has in my view a medium to high degree of distinctive character.

154. At the hearing Ms McFarland stated that because of the use made, the distinctive character of the earlier marks has been enhanced. Mr Pescador contended that the pleading did not contain a claim that the earlier marks enjoy an enhanced distinctiveness and that *"no evidence has been filed to suggest that, so, in the best-case scenario [...] the earlier marks must be taken to have an ordinary level of distinctiveness."*

155. The fact that the pleading did not contain a claim to enhanced distinctiveness would not prevent me from finding that the distinctiveness of the earlier marks has been enhanced if evidence of use has been filed, as the approach of this Tribunal is that there is no need for a party to specifically plead enhanced distinctiveness. In BL-O- O-379-19, the Hearing Officer stated:

"In my view, and whilst I accept the general point that pleadings should be as full as possible so as to set out the scope of the dispute, the absence of any specific reference in the pleadings to enhanced distinctiveness is not fatal to the opponent's case. This is because the assessment of distinctiveness is one of the fundamental factors that needs to be assessed in every case and, as is clear from the case-law, this can come from either the inherent nature of the mark, its use, or indeed a combination of both. Therefore, if evidence has been

filed, which it has in the case before me, it is incumbent upon me to factor that evidence into the assessment to decide upon the overall distinctiveness of the earlier mark. It would be perverse to do otherwise, as it would require a pretence as to the true level of distinctiveness on the part of the average consumer, based on a technicality.”

156. The evidence shows:

- That between 2006 and 2020 Bluebird Care generated a significant turnover and invested heavily in marketing – turnover is nearly £80million in the period 2006-2020 and nearly £50 million in the period 2016-2020, marketing is over £800,000 in the period 2006-2020 and nearly £350,000 in the period 2016-2020;
- That there is long-standing use, as the Bluebird Care business has been operating in the UK for over 15 years;
- That Bluebird Care owns a share of nearly 2% of the relevant market for the services at issue;
- That Bluebird Care was awarded The British Franchise Associations Franchise of the Year in 2017;

157. I am content that the earlier marks have a reputation for home care services and the distinctiveness of the earlier marks has been enhanced to a high degree in relation to these services.

Likelihood of confusion

158. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for goods and services and the nature of the purchasing process.

In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

159. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

160. Earlier in this decision, I found that:

- the services are either identical or similar to a low to medium degree;
- the average consumer will select the services visually, although I do not discount aural considerations completely. The services will be selected with a medium to high degree of attention;
- the competing marks are visually similar to a medium and medium to high degree, aurally different and conceptually similar to a high degree;
- the earlier marks are inherently distinctive to a medium to high degree and their distinctiveness has been increased to high through use.

161. Notwithstanding the medium to high level of attention consumers will pay when they select the services, I must also bear in mind the concept of imperfect recollection. This is important because the degree to which the average consumer can fix a particular image and accurately recall it has limitations. The average consumer does not have a photographic memory, even when paying an above medium degree of attention. I also consider that although there are differences in the devices, the word “Bluebird” does not add a sufficient point of difference, given that the later mark could also be seen as a blue bird and the birds in the marks are all encompassed within a circle and all the circles in the marks have a broken line. Further, the colours of the marks are similar or identical, the size of the birds and their position within the circle is similar and the birds are all represented in a similar pose and facing the same direction.

162. When weighing all of the relevant factors, I consider that there is a likelihood direct and indirect confusion on the basis that the devices in the marks may be misremembered/mis-recalled for each other. Given the visual and conceptual similarity between the marks, I consider it likely that the average consumer encountering LAS’s mark will mistakenly recall the earlier marks with the blue bird in a circle. In this connection I have already rejected LAS’s submission that the colour of

its mark will be seen as a shade of green (rather than blue) and I found that most consumers would describe the colour as turquoise, whilst perceiving turquoise as a shade of blue.

163. In any event, since BC1's earlier mark could be used in the same colour as LAS's mark, even consumers who would have a tendency to see more green than blue in the turquoise colour used in LAS's mark, having previously seen BC1's mark presented in the same turquoise colour, will have understood the word 'Bluebird' in BC1's mark as describing the device of the bird presented in turquoise and, faced with LAS's mark, would also identify it as a blue bird and mistakenly recall it as the device of BC1's mark.

164. Given my conclusion that the average consumer will directly mistake the devices in the respective marks, the absence of the verbal element in LAS's mark is not sufficient to avoid confusion, because consumers are accustomed to see logos associated with brand or business names used independently from the brand or business name, so once the consumer has mistaken the devices for one other, even if he were to notice the absence of the verbal element, he would put it down to use of a variant mark, even in relation to the services which I found to be similar to a low to medium degree.

165. My conclusion is therefore that there is a likelihood of confusion in relation to all of the services for which LAS's marks are registered.

166. For the sake of completeness, I should say that Ms Banfield's evidence includes instances of confusion and that Mr Archer's evidence makes the opposite point that the respective businesses have coexisted in the market without instances of confusion. I did not find any of the evidence helpful. This is because:

- the evidence of confusion filed by Ms Banfield consists of a few emails sent by Bluebird Care's franchisees after the proceedings at issue had begun.²⁴ The emails reported that some customers and members of staff were confused with

²⁴ HB46-47

the respective branding. Aside from the fact that very little details were provided about the individuals and facts reported, this is hearsay evidence dated after the relevant date. Hence, I placed no weight on it;

- In his witness statement Mr Archer makes the point that both parties attended an exhibition in Glasgow in 2016 and that although two of LAS's franchisees located in the UK are located close to Bluebird Care's franchisees, they never experienced any instance of confusion since they started trading in 2019. First, attendance at a trade exhibition is not the same as trading (and Ms Banfield said that at the time of the exhibition they had no concerns about LAS's mark because LAS had no business in the UK). Second, 2 years of trading is hardly long-standing coexistence in the marketplace, and third, whilst LAS obtained registration for figurative marks, the evidence shows that it uses the device together with the name 'Visiting Angels' in the form shown below, which is obviously a different mark from that at issue:



167. The three invalidity actions under Section 5(2)(b) of the Act are all successful.

Section 5(3)

168. BC2's application for invalidity no. 504338 against LAS's '6346 mark is based on both Section 5(2)(b) and 5(3). I can deal with the additional ground under Section 5(3) very briefly.

169. I have already found that BC2's earlier mark would have benefited from a qualifying reputation at the relevant date and that there is a likelihood of confusion between the marks under Section 5(2)(b). Since BC2's pleaded unfair advantage case is predicated on a likelihood of confusion, having found that there is a likelihood of confusion, I also find that a perceived trade connection with BC2's earlier mark would

give the contested marks an unfair advantage. BC2's invalidation no.504338 is also successful under Section 5(3).

OVERALL OUTCOME

170. LAS's revocation actions nos. 503680 and 503898 are partially successful. UK00002401120 will be revoked in part from the earliest possible date, namely 25 March 2011. The registration shall be reduced to cover only Class 44: *Hygienic care for human beings*. UK00912421269 will be revoked in part from the earliest possible date, namely 2 May 2019. The registration shall be reduced to cover only Class 44: *Provision of staff for non-medical home care*.

171. BC1 and BC2's invalidity actions nos. 503556, 503753 and 504338 are successful in their entirety in respect of all of the services as registered, and subject to a successful appeal, the trade marks UK00003272409 and UK00917506346 will be invalidated in their entirety. Under Section 47(6) of the Act, the registrations are deemed never to have been made.

COSTS

172. As both parties have been partially successful in relation to the revocation actions, I order that each party bear their own costs. However, BC1 and BC2 are entitled to costs in relation to the invalidity actions nos. 503556, 503753 and 504338 they brought against LAS's trade marks UK00002401120 and UK00912421269, which have been successful.

173. Although BC1 and BC2 are part of the same group of companies and the proceedings have been consolidated, they are different companies. I will therefore make two separate awards of costs splitting the costs between the two, to reflect the fact that there was only one set of evidence and submissions filed and one representation at the hearing. I will also discount any additional costs incurred by LAS after the hearing in relation to the supplementary submissions filed, as they became necessary through no fault of LAS.

174. In the circumstances, in accordance with Tribunal Practice Notice (“TPN”) 2/2016, I award BC1 the sum of £1,200 as a contribution towards the cost of the proceedings, calculated as follows:

Filing an application for invalidation (official fee):	£200
Filing application for invalidity and considering the other party’s response:	£250
Filing evidence and considering the other party’s evidence:	£500
Attending a hearing:	£500
Reduction:	£250
Total:	£1,200

175. I award the same sum to BC2 but with an additional £200 (because it filed two invalidity actions) and an additional £250 (for the filing and consideration of the pleading forms in the second invalidity) for a total of £1,650.

176. I order Living Assistance Services, Inc. to pay BLUEBIRD CARE SERVICES LIMITED and BLUEBIRD CARE FRANCHISES LIMITED the sums of £1,200 and 1,650 respectively. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of January 2023

Teresa Perks

For the Registrar

Teresa Perks