

O/0617/24

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001683481

DESIGNATING THE UK

IN THE NAME OF BIONOTE, INC.

FOR THE FOLLOWING TRADE MARK:

Vcheck C

IN CLASSES 5, 10 AND 44

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 438729 BY

GUANGZHOU DECHENG BIOTECHNOLOGY CO., LTD

BACKGROUND AND PLEADINGS

1. International registration no. 1683481 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is BIONOTE, INC. The IR is registered with effect from 19 July 2022. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder claims a priority date of 6 July 2022 and seeks protection for the goods and services set out in paragraph 32 below.

2. On 20 January 2023, Guangzhou Decheng Biotechnology Co., Ltd (“the opponent”) opposed the protection of the IR in the UK based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade marks:

DốChek

UKTM no. 3744238

Filing date 18 January 2022; registration date 15 April 2022

(“the First Earlier Mark”)

V-CHEK

UKTM no. 3744542

Filing date 18 January 2022; registration date 29 July 2022

(“the Second Earlier Mark”)

(together “the earlier marks”)

3. The opponent relies upon all goods for which the earlier marks are registered as set out in the Annex to this decision. The opponent claims that the marks are similar, and the goods are identical or similar, with the result that there is a likelihood of confusion.

4. The holder filed a counterstatement denying the claims made.

5. Neither party requested a hearing and neither party filed written submissions in lieu. This decision is taken following a careful consideration of all the papers on file.

REPRESENTATION

6. The holder is represented by Murgitroyd & Company.

7. The opponent is represented by Appleyard Lees IP LLP.

SUBMISSIONS

8. Neither party filed evidence.

9. The opponent filed submissions by email on 28 September 2023.

10. The holder filed submissions dated 27 November 2023.

RELEVANCE OF EU LAW

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

12. Section 5(2)(b) of the Act reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(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.”

13. 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.”

14. Given their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had not completed their registration process more than 5 years prior to the designation date of the IR in issue, they are not subject to the use provisions of section 6A of the Act. Consequently, the opponent can rely upon the full breadth of its specification.

15. 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 greater 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.


Comparison of trade marks


16. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

17. 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.

18. The respective trade marks are shown below:

Opponent’s trade marks	The IR
	Vcheck C

<p>(the First Earlier Mark)</p>  <p>(the Second Earlier Mark)</p>	
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Overall Impression

19. The First Earlier Mark consists of the conjoined words DO and CHEK, presented in a fairly standard italicised font. Above the letter O is a small device. The words form a unit and play the greater role in the overall impression, with the device playing a lesser role due to its small size. The font used plays an even lesser role.

20. The Second Earlier Mark consists of the hyphenated letter/word V-CHEK presented in a fairly standard font. The letter V is slightly larger than the word CHEK. In my view, the overall impression of the mark lies in the combination of these elements, although they do not come together to form a unitary meaning. The letter V is the more distinctive element as the word CHEK is likely to be recognised as a misspelling of the word CHECK which will be low or non-distinctive for the goods relied upon.

21. The IR consists of the word/letters Vcheck C. There are no other elements to contribute to the overall impression, which lies in the word/letters, themselves. The word CHECK will be low or non-distinctive for the same reasons given above.

Visual Comparison

22. The First Earlier Mark and the IR coincide in the presence of the letters CHEK. However, they differ in the presence of the word DO at the beginning of the First Earlier Mark and the letter V at the beginning of the IR. They also differ in that the IR also contains the letter C in between the letters E and K. The device in the First Earlier Mark also has no counterpart in the IR. I bear in mind that the IR is a word only mark

that could be used in any font. In my view, the marks are visually similar to a low degree.

23. The Second Earlier Mark and the IR both begin with the letter V and include the letters CHEK. They differ in that the letter V is conjoined with the word CHECK in the IR, but is hyphenated in the Second Earlier Mark. Further, there is a letter C between the letters E and K in the IR, which is absent from the Second Earlier Mark, as well as an additional letter C at the end of the IR. Again, I bear in mind that the IR is a word only mark that could be used in any font. I also bear in mind that the beginnings of marks tend to make more of an impact than the ends.¹ Taking all of this into account, I consider the marks to be visually similar to between a medium and high degree.

Aural Comparison

24. The words CHECK and CHEK in the First Earlier Mark and the IR will be pronounced identically. The word DO and the letter V at the start of the marks will be points of aural difference, as will the letter C at the end of the IR. Consequently, I consider the marks to be aurally similar to between a low and medium degree.

25. The same is true of the words CHECK and CHEK in the Second Earlier Mark and the IR. Further, the letter V at the start of both marks is a point of aural similarity. The only point of aural difference is the letter C at the end of the IR. Consequently, I consider the marks to be aurally similar to between a medium and high degree.

Conceptual Comparison

26. The words CHECK and CHEK in the First Earlier Mark and the IR will be understood as referring to the process of confirming that something is correct or satisfactory. The letters V and C in the IR do not convey any particular meaning. The combination of the word DO with the word CHEK will be understood as a unit i.e. instructing someone to check (e.g. “do check that’s correct”). Overall, the marks are conceptually similar to a medium degree.

¹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

27. As above, the words CHECK and CHEK in the Second Earlier Mark and the IR will convey the same conceptual meaning. The letters V and C in the IR do not convey any conceptual message. Consequently, to the extent that any conceptual message is conveyed by the marks overall, it will be the same. However, it is not a particularly distinctive one given the goods and services in issue.

28. As the Second Earlier Mark is the closest in terms of similarity with the IR, I will consider the opposition on the basis of that mark. I will return to the First Earlier Mark only to the extent that it is necessary to do so.

Distinctive character of the earlier trade mark

29. 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-2779, 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).”

30. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

31. The opponent has not filed evidence of use. Consequently, I have only the inherent position to consider. The word CHEK in the Second Earlier Mark has a descriptive or allusive quality in relation to the goods relied upon, which are for detection/diagnostic purposes. This is because it will be understood as a misspelling of the word CHECK. The independent letters V and C at the beginning and end have no meaning in relation to the goods relied upon, but neither are they particularly distinctive being single letters. Given that the stylisation is minimal, I do not consider that it materially increases the distinctiveness of the mark as a whole. In my view, the Second Earlier Mark is inherently distinctive to between a low and medium degree.

Comparison of goods and services

32. The competing goods and services are as follows:

Opponent’s goods	Holder’s goods and services
<p>Second Earlier Mark</p> <p><u>Class 5</u></p> <p>Medical reagent paper used for detection of drugs and COVID-19.</p>	<p><u>Class 5</u></p> <p>Veterinary preparations for diagnosing tuberculosis; veterinary vaccines; veterinary diagnostic reagents for immunization disease; adjuvants for use with veterinary vaccines; veterinary substances and preparations; reagents for use in veterinary genetic testing; antibodies for veterinary purposes;</p>

chemical reagents for veterinary purposes; reagents for veterinary use; diagnostic reagents for veterinary purposes; biological preparations for veterinary purposes; ferments for veterinary use; reagents and media for veterinary diagnostic purposes; drugs for veterinary purposes; veterinary clinical diagnostic reagents; pre-filled cartridges containing diagnostic testing preparations for veterinary purposes; veterinary diagnostic test strips.

Class 10

Veterinary apparatus and instruments for DNA analysis; veterinary apparatus and instruments for RNA analysis; bacteria and virus testing apparatus; cell testing apparatus for medical purposes; veterinary apparatus and instruments; immunoassay apparatus for veterinary purposes; immunofluorescence analysis apparatus for veterinary purposes; apparatus for use in veterinary analysis; veterinary diagnostic imaging apparatus; genetic testing apparatus for veterinary purposes; veterinary apparatus; diagnostic testing cartridges for veterinary purposes; diagnostic apparatus for veterinary purposes; veterinary ultrasonic diagnostic equipment; miniaturized sensors for use in gene analysis and diagnosis; medical

apparatus and instruments other than for dental purposes; apparatus for use in medical analysis; apparatus for blood tests [for veterinary use]; immunoassay apparatus for diagnosis; blood analysis apparatus for diagnosis; in vitro diagnostic devices for medical purposes; filters for blood and blood components; blood analysis equipment; apparatus for blood analysis; in vitro diagnostic devices for veterinary purposes; medical diagnostic test strips (the products not included test reagents).

Class 44

Veterinary assistance; veterinary hospitals; genetic testing of animals; laboratory analysis services relating to the treatment of animals; laboratory analysis services relating to the treatment of persons; veterinary services and providing information relating thereto; veterinary services; medical analysis services for cancer diagnosis and prognosis; pharmacy services; drug testing for substance abuse; provision of genetic testing for medical (treatment) purposes; medical examination services; medical diagnostic services; veterinary diagnostic services; veterinary analysis for diagnostic and treatment purposes of animals; veterinary information services provided via the internet; clinical

	pathology examination; medical testing for diagnostic or treatment purposes.
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33. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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 are complementary.”

34. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

35. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

36. I bear in mind that it is permissible to group goods together for the purposes of assessment.²

Chemical reagents for veterinary purposes; reagents for veterinary use.

37. These terms in the holder’s specification could include medical reagent paper for detection of drugs. Consequently, the goods are identical on the principle outlined in *Meric*.

Veterinary preparations for diagnosing tuberculosis; veterinary diagnostic reagents for immunization disease; veterinary substances and preparations; reagents for use in veterinary genetic testing; diagnostic reagents for veterinary purposes; reagents and media for veterinary diagnostic purposes; veterinary clinical diagnostic reagents; pre-filled cartridges containing diagnostic testing preparations for veterinary purposes; veterinary diagnostic test strips.

38. To my knowledge, animals are not tested for Covid-19 and I have no evidence to suggest otherwise. Insofar as the opponent’s goods relate to testing for drugs, I do not consider this to be a ‘diagnosis’ as such, which would relate to the detection of a medical condition rather than a substance. Consequently, I do not consider that these goods overlap in their specific purpose with the opponent’s goods, although the general purpose of testing will be the same. The goods will overlap in nature and method of use as they are all (or may include) types of reagents. There may be an overlap in trade channels, as the same businesses are likely to sell different types of

reagents. The user will plainly overlap. Consequently, I consider the goods to be highly similar.

Biological preparations for veterinary purposes.

39. It is my understanding that reagents can be biological products. Consequently, these goods are identical on the principle outlined in *Meric* to the opponent's goods. If I am wrong in that finding, they will be highly similar for the same reasons set out above in paragraph **38**.

Veterinary vaccines; adjuvants for use with veterinary vaccines; antibodies for veterinary purposes; drugs for veterinary purposes; ferments for veterinary use.

40. These are all types of goods that are used by veterinarians. Whilst the opponent's goods might also (in some cases) be used by veterinarians, they otherwise differ in nature, method of use and purpose. I have no evidence before me to suggest that there would be an overlap in producer, nor do I consider it likely. I accept that there may be an overlap in trade channels at a very broad level where large retailers sell a range of veterinary items to professionals. However, I have no reason to believe that these goods would be sold in proximity to each other, given their differences. There is no competition (given the differing purposes), nor complementarity (as one is not important or indispensable for the other).² Consequently, I consider the goods to be dissimilar. If I am wrong in this finding, then they will be similar to only a very low degree.

Class 10

41. The high point of the opponent's case in relation to these goods is that both parties' goods might be purchased by veterinary professionals. I accept that that might be the case. I have no evidence before me to suggest an overlap in producers, nor do I consider it likely. There might be some overlap in trade channels at a very general

² *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

level in that large retailers might sell a range of veterinary goods. However, given their differences, they are unlikely to be sold in proximity. There is no obvious overlap in nature or method of use. I have no evidence before me to suggest that there would be an overlap in purpose. Even if the holder's class 10 goods might be used in the process of detecting drugs in animals, there is nothing before me to suggest that the goods are 1) in competition with each other or 2) important or indispensable for each other. Consequently, there is no competition or complementarity. In my view, the goods are dissimilar. If I am wrong in this finding, the goods are similar to a very low degree.

Class 44

Laboratory analysis services relating to the treatment of animals; laboratory analysis services relating to the treatment of persons; drug testing for substance abuse; medical testing for diagnostic or treatment purposes.

42. Plainly, these services differ in nature and method of use to the opponent's goods. However, there may be an overlap in purpose. Similarly, the users may be the same. I also accept that the same businesses that offer laboratory testing for drugs and/or Covid-19 might also provide kits (including reagents) for veterinarians/doctors to use on patients to then be sent off to the laboratory for testing. Consequently, there is an overlap in trade channels. There might also be an element of complementarity. In my view, the goods and services are similar to a medium degree.

Medical diagnostic services.

43. For the same reasons set out above, I accept that there might be an overlap in trade channels with the opponent's goods insofar as they relate to the diagnosis of Covid-19. The user would also overlap. There may also be complementarity. Consequently, I consider the goods and services to be similar to a medium degree.

Veterinary diagnostic services; veterinary analysis for diagnostic and treatment purposes of animals.

44. I accept that these might include laboratory analysis services for diagnosing conditions in animals. However, as I noted above, I have no evidence before me to suggest that animals suffer from (or are tested for) Covid-19. I do not consider testing for drugs to be a 'diagnostic' service, which would relate to the diagnosis of a condition rather than the presence of a drug. Consequently, I do not consider it likely that these goods and services would overlap in trade channels. The nature, method of use and purpose of the goods and services would differ. They are not in competition or complementary.³ Consequently, they are dissimilar. If I am wrong in this finding, they are similar to only a very low degree.

Veterinary assistance; veterinary hospitals; veterinary services and providing information relating thereto; veterinary services; pharmacy services; medical examination services; veterinary information services provided via the internet; clinical pathology examination.

45. These are various medical services aimed at the care of humans or animals. I have no evidence before me to suggest that the same businesses would also sell the opponent's goods and I consider it unlikely. Plainly, the nature, method of use and purposes of the goods are different. The user is also unlikely to be the same as the opponent's goods are likely to be purchased by professionals, whereas the holder's services would be purchased by members of the general public. There is no competition or complementarity. In my view, the goods and services are dissimilar.

Genetic testing of animals; medical analysis services for cancer diagnosis and prognosis; provision of genetic testing for medical (treatment) purposes.

46. These services are testing services for conditions other than the presence of drugs/Covid-19. Consequently, I have no reason to believe that there would be an overlap in trade channels with the opponent's goods, nor do I have any evidence to suggest that there would be. The user might overlap. The method of use, nature and purpose of the goods clearly differ. There is no competition or complementarity.

³ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

Consequently, I consider the goods to be dissimilar. If I am wrong in this finding, the goods and services are similar to only a very low degree.

47. As some degree of similarity between the goods and services is required for a successful claim under section 5(2)(b), the opposition must fail in respect of those goods and services that I have found to be dissimilar.⁴

The average consumer and the nature of the purchasing act

48. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

49. The average consumer for the goods and services will be predominantly veterinary or other medical professionals. They will consider factors such as reliability, suitability for particular requirements and customer service standards. Consequently, I consider that at least a medium degree of attention is likely to be paid during the purchasing process. However, given that the average consumer is likely to be concerned with the wellbeing of their patients, they are, in my view, most likely to pay a higher-than-average degree of attention.

⁴ *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

50. The goods are likely to be purchased from retail outlets (whether physical, online or in catalogue form). The services are likely to be purchased following perusal of signage on physical premises or websites. Consequently, the purchasing process will be predominantly visual. However, I do not discount an aural component to the purchase given that word-of-mouth recommendations may play a part.

Likelihood of confusion

51. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between them and the goods and services down to the responsible undertaking being the same or related. 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 goods/services may be offset by a greater degree of similarity between the marks, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Second Earlier Mark, the average consumer for the goods/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 trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

52. I have found as follows:

- a) The goods/services vary from being identical to similar to a very low degree (except where I have found them to be dissimilar).
- b) The average consumer for the goods/services is predominantly a veterinary or other medical professional, who will pay at least a medium degree (but most likely, higher than medium degree) of attention during the purchasing process.
- c) The purchasing process is predominantly visual, although I do not discount an aural component to the purchase.

- d) The Second Earlier Mark and the IR are visually and aurally similar to between a medium and high degree. To the extent that either mark conveys any conceptual meaning it will be the same, although not a particularly distinctive one.
- e) The Second Earlier Mark is inherently distinctive to between a low and medium degree.

53. Taking all of the above factors into account, and bearing in mind the visual and aural similarities between the Second Earlier Mark and the IR, I consider it likely that they will be mistakenly recalled or misremembered as each other where they are used on goods and services that are similar to a medium degree or higher. Consequently, I consider there to be a likelihood of direct confusion. Where the goods are only similar to a very low degree, the distance between the goods/services will be sufficient to offset the similarity of the marks and there will be no likelihood of confusion.

54. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr 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)".

55. I accept the holder's submission that the common element (being CHECK/CHEK) is of no or low distinctiveness for the relevant goods and services. The mere common presence of this word would not, in my view, be sufficient to result in the average consumer assuming an economic connection between the users of the marks. However, the use of the common elements V and CHECK or V and CHEK are, in my view, likely to be mistakenly recalled as each other. The hyphenation (or lack of) is likely to be overlooked. If the presence of the letter C at the end of the IR is recalled, it is most likely to be viewed as a sub-brand (such as being part of a product range designated by different letters A, B, C etc.). Consequently, I consider there to be a likelihood of indirect confusion in relation to all goods and services that I have found to be similar to a medium degree or higher. Where the goods and services are similar to only a very low degree, the similarity of the marks will be offset by the distance of the goods/services and there is no likelihood of confusion.

56. For the avoidance of doubt, with regard to the First Earlier Mark, even if I had found the parties' respective goods and services to be identical, I would have found no likelihood of direct or indirect confusion. This is because the differences between the marks, combined with the non-distinctiveness/low distinctiveness of the common element (CHECK/CHEK) would mean that the average consumer would not mistake one mark for the other, nor would they assume that the same undertaking was responsible for both. Consequently, the opposition based upon the First Earlier Mark would not have put the opponent in any stronger position.

CONCLUSION

57. The opposition is successful in relation to the following goods and services for which, subject to any successful appeal, the application is refused:

Class 5 Veterinary preparations for diagnosing tuberculosis; veterinary diagnostic reagents for immunization disease; veterinary substances and preparations; reagents for use in veterinary genetic testing; chemical reagents for veterinary purposes; reagents for veterinary use; diagnostic reagents for veterinary purposes; biological preparations for veterinary purposes; reagents and media for veterinary diagnostic purposes; veterinary clinical diagnostic reagents; pre-filled cartridges containing diagnostic testing preparations for veterinary purposes; veterinary diagnostic test strips.

Class 44 Laboratory analysis services relating to the treatment of animals; laboratory analysis services relating to the treatment of persons; drug testing for substance abuse; medical diagnostic services; medical testing for diagnostic or treatment purposes.

58. The opposition is unsuccessful in relation to the following goods and services for which, subject to any successful appeal, the application may proceed to registration:

- Class 5 Veterinary vaccines; adjuvants for use with veterinary vaccines; antibodies for veterinary purposes; ferments for veterinary use; drugs for veterinary purposes.
- Class 10 Veterinary apparatus and instruments for DNA analysis; veterinary apparatus and instruments for RNA analysis; bacteria and virus testing apparatus; cell testing apparatus for medical purposes; veterinary apparatus and instruments; immunoassay apparatus for veterinary purposes; immunofluorescence analysis apparatus for veterinary purposes; apparatus for use in veterinary analysis; veterinary diagnostic imaging apparatus; genetic testing apparatus for veterinary purposes; veterinary apparatus; diagnostic testing cartridges for veterinary purposes; diagnostic apparatus for veterinary purposes; veterinary ultrasonic diagnostic equipment; miniaturized sensors for use in gene analysis and diagnosis; medical apparatus and instruments other than for dental purposes; apparatus for use in medical analysis; apparatus for blood tests [for veterinary use]; immunoassay apparatus for diagnosis; blood analysis apparatus for diagnosis; in vitro diagnostic devices for medical purposes; filters for blood and blood components; blood analysis equipment; apparatus for blood analysis; in vitro diagnostic devices for veterinary purposes; medical diagnostic test strips (the products not included test reagents).
- Class 44 Veterinary assistance; veterinary hospitals; genetic testing of animals; veterinary services and providing information relating thereto; veterinary services; medical analysis services for cancer diagnosis and prognosis; pharmacy services; provision of genetic testing for medical (treatment) purposes; medical examination services; veterinary diagnostic services; veterinary analysis for diagnostic and treatment purposes of animals; veterinary information services provided via the internet; clinical pathology examination.

COSTS

59. The holder has enjoyed the greater degree of success and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I have applied what I consider to be an appropriate reduction for the only partial success. With that in mind, I award the holder the sum of **£450**, which is calculated as follows:

Considering the Notice of opposition and preparing a counterstatement	£200
Written submissions	£250
Total	£450

60. I therefore order Guangzhou Decheng Biotechnology Co., Ltd to pay BIONOTE, INC the sum of **£450**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 28th day of June 2024

S WILSON

For the Registrar

ANNEX

First Earlier Mark

Class 5

Diagnostic biomarker reagents for medical purposes; chemical reagents for medical or veterinary purposes; chemical preparations for the diagnosis of pregnancy; diagnostic preparations for medical purposes; reagent paper for medical purposes; biological preparations for medical purposes; dietetic foods adapted for medical purposes; dietetic substances adapted for medical use; diagnostic preparations for veterinary purposes; reagent paper for medical or veterinary purposes.

Class 10

Blood testing apparatus; medical apparatus and instruments; veterinary apparatus and instruments; apparatus for use in medical analysis; diagnostic apparatus for medical purposes; apparatus for DNA and RNA testing for medical purposes; body composition monitors; cholesterol meters; glucometers; analyzers for bacterial identification for medical purposes; body fat monitors; surgical robots.

Second Earlier Mark

Class 5

Medical reagent paper used for detection of drugs and COVID-19.