

O-167-19

INTERIM DECISION

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 3190706
IN THE NAME OF SHADAB DIN
IN RESPECT OF THE TRADE MARK:**

NOVALIN

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 501858 BY SOPHARMA AD**

Background and pleadings

1. The trade mark **NOVALIN** stands registered in the name of Shadab Din (“the proprietor”). It was applied for on 12 October 2016 and entered in the register on 10 February 2017. Following a request filed on 25 July 2018 to partially surrender the registration, the specification now reads as follows:

Dietary fibre; dietary supplemental drinks; dietary supplements and dietetic preparations; dietary supplements consisting of vitamins; dietetic foods adapted for invalids; dietetic foods adapted for medical purposes; dietetic foods adapted for medical use; dietetic foods for use in clinical nutrition; dietetic sugar for medical use; dietetic sugar substitutes for medical use; food for medically restricted diets; food supplements; food supplements for medical purposes; food supplements for non-medical purposes; mineral dietary supplements for humans; mineral drinks (medicated-); mineral nutritional supplements; nutraceuticals for use as a dietary supplements; powdered fruit-flavoured dietary supplement drink mix; powdered nutritional supplement drink mix; vitamin drinks.

2. On 2 November 2017, Sopharma AD (“the applicant”) filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The relevant provisions read as follows:

“47(2) 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

(b)...

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

(2A) But 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) within the period of five years ending with the date of the application for the declaration the earlier trade mark has 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, 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered,

(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.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

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.

.....

(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.”

And:

“5 (2) 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.

(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

3. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

4. The opposition under both grounds is based upon European Union Trade Mark (“EUTM”) registration no. 3983426 for the trade mark **NIVALIN** which has a filing date of 10 August 2004, was entered in the register on 9 November 2006 and which is registered for the following goods in class 5:

Pharmaceutical preparations, namely drugs for treatment of the degenerative and functional diseases of central and peripheral nervous system.

5. The applicant states that its earlier trade mark has been used in relation to all the goods upon which it relies. It claims that the competing trade marks are “...visually, phonetically and conceptually, overall...very similar to a reasonably high level”. On the basis of the specification of the proprietor’s trade mark that was registered at the time of the filing of the application (shown in the annex to this decision), it states that the competing goods were “identical or highly similar”, the above factors combining to give rise to objection under section 5(2)(b) of the Act.

6. Insofar as its objection based upon section 5(3) of the Act is concerned, in addition to claiming the similarity between the competing trade marks will lead the relevant public to believe that the competing trade marks are used by the same or economically related undertakings, the applicant further claims that:

“12...Use of the later mark therefore rides on the distinctive character and/or coat-tails of the earlier registration such that there is a risk of detriment and tarnishment to the earlier mark’s distinctive character and repute...”

And:

“15...which risks the dilution and tarnishment of the distinctive character of the earlier highly similar mark in existence, to unfairly impair the distinctive character of the earlier mark.”

7. The proprietor filed a counterstatement in which the basis of the application is denied and in which the applicant is asked to make good its claim to having used the earlier trade mark upon which it relies.

8. Inter alia, the following points emerge from Mrs Din’s counterstatement:

(i) “NOVALIN is NOT a pharmaceutical preparation, but rather a thickener for food and liquids (and therefore classified as a food substance)”;

(ii) “Novalin is translated as “New Food”;

(iii) “The industry in which the NOVALIN trade mark will be used will be the food/nutrition/dietetics industry...”;

(iv) “Novalin food and drink thickener” will only be available to the end consumer after it is prescribed by a qualified, trained and registered healthcare professional in the UK and only after it is on a specific prescribing protocol”;

(v) “Novalin Food and Drink Thickener” will not be promoted to, or available to buy over the counter to the general public as per the UK regulations”;

(vi) “NIVALIN (galantamine hydrobromide) does not have marketing authorisation in the UK. A marketing application for selling NIVALIN in the UK

has already been rejected by the UK licensing authority based on patent/data exclusivity infringement. This decision has subsequently been upheld by the High Court of Justice for England and Wales. There is therefore no possibility of the applicants product NIVALIN being sold in the UK and there absolutely no danger to the public in believing that the NOVALIN food product is in any way related to the applicants product which is not available.”

9. In these proceedings, the applicant is represented by IPTTogether Limited; the proprietor represents herself. Both parties filed evidence, the applicant’s evidence-in-chief was accompanied by written submissions. The matter came before me at a hearing held on 29 January 2019, at which Mrs Din was represented in person by Mr Shah Tahir and her husband, Mr Yasser Din. Although the applicant was not represented at the hearing, it filed skeleton arguments in lieu of attendance.

The applicant’s evidence-in-chief

10. This consists of two witness statements. The first, is from the applicant’s Director of Intellectual Property, Rumiana Peycheva, a position she has held since 2000. Ms Peycheva explains that the applicant has been operating since 1933. She provides references to two websites i.e. www.sopharma.bg and www.sopharmagroup.com but does not provide any pages from these websites. She states:

“3. My Company has used [the trade mark upon which it relies]...in Bulgaria, Poland, Romania, Latvia, Lithuania, Estonia within the EU.

4. The trade mark NIVALIN is further protected in over twenty countries...Much expense has gone into making this mark well known and invested in as a Trade Mark and Brand.”

11. Ms Peycheva states that the NIVALIN trade mark is one of her company’s:

“7...original phyto-preparation product developed by Sopharma's own research team and produced with an original technology for extraction of the

alkaloid Galantamine from the bulbs of the plant snowdrops (*Leucojum aestivum*). Galantamine is the active ingredient of NIVALIN”.

12. Exhibit 1, is said to consist of: “press coverage supporting the widely known publicity to strengthen the reputation of the NIVALIN trade mark and branded products”. It consists of pages obtained from three distinct sources. The first, is from nivalin.com. Although the pages were printed on 24 March 2018 they bear the following “Copyright © 2016-2017 BPG Ltd/Biogenic Stimulants, Inc.” Under the word “Order”, there appears the following “”\$0.00”. The pages provided contain the following:

“Nivalin, Galantamine mechanism of action

Nivalin is a competitive reversible inhibitor of Acetylcholinesterase (AChE) and prolongs the hydrolysis of endogenous mediator acetylcholine, thereby increasing its accumulation in the choline sensitive postsynaptic membranes.

Adaption of nicotine cholinesterase transmission for account of the blockage of AChE and the sensibilization of nicotine acetylcholine receptors (nAChR).

Nivalin Anticholinesterase activity

Nivalin inhibits reversibly brain, erythrocytic, muscle and serum cholinesterase. Its effect on brain cholinesterase is 10-12 times as potent, compared to physostigmine, since Nivalin crosses the blood-brain barrier. Nivalin increases the intensity of nerve impulses leading to the muscle tissues, increases muscle contractions and their duration. Nivalin antagonizes the effect of nondepolarizing neuromuscular blocking drugs. The antagonistic effect develops 20-30 s following parenteral administration and continues 30 to 60 minutes. Nivalin stimulates the frequency and tone of the gastrointestinal muscle contraction. Nivalin possesses mild hypotensive effect when administered in small or medium doses and in higher doses has two-phase action.

Nivalin, Galantamine is applicable in:

To abolish the effects of nondepolarizing neuromuscular blockers and to treat postoperative paresis and bladder complications. In some forms of impotence. In mental retardation. In poisoning with morphine and its analogues. In functional diagnostics of the gastrointestinal tract (cholecystography and cholangiography. In electrophoresis in neuritis of the auditory, facial and other nerves; neuritis, neuropathy, endarteritis obliterans, angioneurosis, acrocyanosis, dyshidrosis and neurodermitis.

A treatment course continues for 1- 2 months and in degenerative diseases of the Central Nervous System up to one year. Nivalin is a preparation with low toxicity, soft and stable action and possesses wide spectrum of application for therapeutic purposes. Nivalin is very well tolerated and despite that fact should not be prescribed in conditions of bronchial asthma, bradycardia, angina pectoris, heart failure, epilepsy, hyperkinetic dyskinesia

Nivalin in neurology is applicable in:

Poliomyelitis (immediately after the febrile period and during the recovery and residual period. Neuritis, myopathies, myasthenia, progressive muscular dystrophy, cerebral paralysis in childhood, cerebral palsy in neonates. Enuresis nocturna. Residual paresis following haemorrhagic stroke. Alzheimer's disease in light and medium stages.”

It further explains that “Sopharma offers Nivalin” as ampoules and tablets (in varying concentrations).

13. The second source consists of pages obtained from Karger.com (which appears to be a publisher of journals, books etc); the article appears to date from 1986. it relates to a study the title of which was:

“Pharmacokinetics of Galanthamine Hydrobromide (Nivalin®) following Single Intravenous and Oral Administration in Rats.”

It appears the study was conducted in Bulgaria.

14. The final article is from psoriasisdietplan.com from January 2015. The article is entitled “Galantamine May Cure Psoriasis”. Although the word “nivalis” has been highlighted, as far as I can tell, the article does not mention the applicant or NIVALIN. Although in her statement Ms Peycheva provides details of two further websites i.e.

[http://www.bgbilka.com/3455/%D0%BD%00%B8%00%82%D0%80%D0%BB%00%88%00%8D-%D0%BA%D0%BE%D0%BA%D0%B8%D1%87%D0%85-nivalin/;](http://www.bgbilka.com/3455/%D0%BD%00%B8%00%82%D0%80%D0%BB%00%88%00%8D-%D0%BA%D0%BE%D0%BA%D0%B8%D1%87%D0%85-nivalin/)

and:

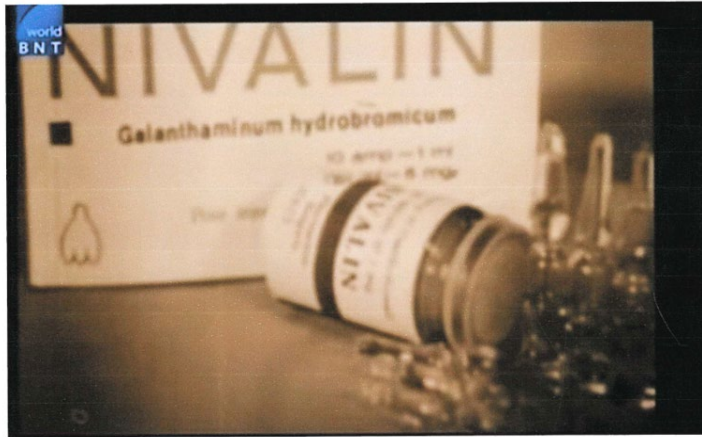
[https://en.wikipedia.org/wiki/Galantamine,](https://en.wikipedia.org/wiki/Galantamine)

no pages from these websites have been provided.

15. Exhibit 2 consists of two YouTube videos relating to what Ms Peycheva explains is the Nivalin product and its inventor Professor Pascov. In her statement (see below), Ms Gakpetor states:

“7....although the videos are in Bulgarian language clearly evidences the historic pride, notoriety, goodwill and publicity attached to the NIVALIN trade mark of the Cancellation Applicant and the continued importance of this trade mark NIVALIN being highly distinctive trade mark.”

16. In addition to the two videos, exhibit 2 contains three screengrabs from the videos; examples are shown below:



17. As one can see, the word NIVALIN appears on the product packaging and on the bottle in which the tablets are dispensed. In addition, on the second screengrab the year 2000 can be discerned. Having reviewed the two videos (which are largely duplicative), I note that, inter alia, they are (i) in the Bulgarian language, (ii) contain text primarily in what I assume to be Cyrillic script and (iii) with the exception mentioned above, are impossible to date. As a consequence, they have minimal evidential value.

18. Having explained that the NIVALIN trade mark is registered in Bulgaria as a well-known trade mark and that products sold under the NIVALIN trade mark are sold by prescription, Ms Peycheva states that the “approximate annual turnover figures for

sales of products under NIVALIN” in the EU (expressed in Bulgarian Leva) are as follows:

Year	Amount (BGN) leva
2012	4 281 668
2013	4 110 235
2014	4 778 352
2015	4 715 183
2016	3 011 708
2017	3 230 932
Total	24,128,078

19. Ms Peycheva further states that “the approximate national advertising/promotional spend figures for the products under this brand...” were as follows:

Year	Amount (BGN) thousands of leva
2012	968
2013	755
2014	927
2015	790
2016	514
2017	487
Total	4,441,000

20. There is no indication provided of (i) to which jurisdictions the figures in paragraph 19 relate, or (ii) the value of the Bulgarian Leva in relation to, for example, Euros during the periods in question.

21. Ms Peycheva states:

“14...I believe that consumers on seeing the NOVALIN used on prescribed medicine, thus a pharmaceutical product, will be confused into believing that the goods are related to or produced by my company...”

22. The second statement comes from Gifty Gakpetor, a trade mark attorney in the employ of IPTogether Limited. Exhibit 1, consists of pages obtained from the applicant's website on 14 April 2018 in which the Nivalin product is listed and which provides general information on the nature of the applicant's business. I note that under the heading "Products", the words "Food supplements" has been highlighted. Exhibit 2, consists of (i) what appears to be undated pages obtained from the website of the BDA i.e. The Association of UK Dieticians entitled "Practice Guide for Dietetic Supplementary Prescribers" and (ii) a page obtained on 14 April 2018 from the website of the World Health Organisation entitled "Pharmaceutical products." I have read these documents and will keep their contents in mind when reaching a conclusion.

The proprietor's evidence

23. This consists of a witness statement from Mrs Din, accompanied by five exhibits. Although I do not intend to summarise this statement here, I confirm I have read it and the associated exhibits and will refer to them, if necessary, later in this decision.

The applicant's evidence-in-reply

24. This consists of a further statement from Ms Peycheva, accompanied by three exhibits. As above, I have read this statement and the associated exhibits and will refer to them, if necessary, later in this decision.

25. That concludes my summary of the evidence filed to the extent I consider it necessary.

DECISION

Proof of use

26. At the hearing, I explained that as the applicant was relying on an EUTM (as opposed to a UK national trade mark), it was not necessary for it to have used its trade mark in the UK to satisfy the proof of use requirement. Having done so, I asked Mr Din if the proprietor accepted that within the relevant period (see below) the applicant had made genuine use of its NIVALIN trade mark in the EU in relation to the goods for which it stands registered and upon which it relies; Mr Din explained that on the basis of the evidence filed by the applicant, the proprietor did not accept that genuine use had been established.

27. That being the case, in reaching a conclusion I must apply the same factors I would as if I were determining an application for revocation based upon non-use. The relevant period is the five year period ending with the date the application for cancellation was filed i.e. 3 November 2012 to 2 November 2017.

28. I begin by reminding myself that the applicant's EUTM is registered in respect of:

Pharmaceutical preparations, namely drugs for treatment of the degenerative and functional diseases of central and peripheral nervous system.

29. The addendum to the Trade Mark Registry's Classification Guide contains the following:

"Including, for example, namely, as well as, in particular, specifically i.e.

While not desirable in specifications since it encourages tautology, such wording should usually not be changed. Such terms are not allowable in Class 35 (with the exception of "namely" see below) for specifications covering retail services as they do not create the legal certainty that is required. However, in other class the terms may be allowed. For example we would allow:

Biocides including insecticides and pesticides Paper articles of stationery in particular envelopes Dairy products namely cheese and butter

Note that specifications including “namely” should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above “dairy products namely cheese and butter” would only be interpreted as meaning “cheese and butter” and not “dairy products” at large. This is consistent with the definitions provided in Collins English Dictionary which states “namely” to mean “that is to say” and the Cambridge International Dictionary of English which states “which is or are”.

30. In view of the above guidance, the applicant’s specification is to be interpreted as only covering: “drugs for treatment of the degenerative and functional diseases of central and peripheral nervous system”; it is on that basis I shall proceed.

31. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He stated:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in 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 that Order has been persuasively analysed by

Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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]; *Centrotherm* at [71]; *Leno* 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]; *Centrotherm* at [71]; *Leno* at [29].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(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]; *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].”

32. As the applicant’s trade mark is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are relevant, in which the Court noted:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

33. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in

more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

34. The General Court ("GC") restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

35. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown.

36. At the hearing, Mr Din explained that in support of its claim to have used the NIVALIN trade mark in the EU countries claimed, the proprietor expected to see evidence showing it appearing in, for example, formularies of the type used in the United Kingdom. I note that collinsdictionary.com defines “formulary” as a “book containing a list of pharmaceutical products, with their formulas and means of preparation.” He explained that the fact that such information ought to be so readily available to the applicant but was not provided, led the proprietor to question the applicant’s claims. Mr Din’s comments find an echo in the decision of Mr Daniel Alexander Q.C. acting as the Appointed Person in *Awareness Limited v Plymouth City Council* (Case BL O/236/13), in which he stated:

“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.”

37. The decision of Mr Geoffrey Hobbs Q.C. (again as the Appointed Person) in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13 is also relevant, when he stated:

“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.”

38. The applicant’s evidence comes from Ms Peycheva. As the Director of Intellectual Property at the applicant since 2000 she is well placed to speak to its use of its trade mark. She explains that the applicant has used its NIVALIN trade mark in Bulgaria, Poland, Romania, Latvia, Lithuania and Estonia and provides turnover figures for the period 2012 to 2017. As the relevant period runs from 3 November 2012 to 2 November 2017 (and proceeding on the assumption that the

figures provided are for calendar years), not all of the turnover figures can be taken into account.

39. However, during that period, Ms Peycheva states that turnover in excess of 24 million Bulgarian Leva was achieved under the NIVALIN trade mark in the EU. Although no conversion rates are provided, a “rough and ready” conversion on the basis of the exchange rate at the date of issuing this decision, suggests that 24 million Bulgarian Leva equates to approximately €12.2m. That is by any standards a not insignificant turnover. In terms of promotional spend, the same considerations in relation to dates apply, in addition to which, it is unclear to what extent the 4.4m Bulgarian Leva (i.e. approximately €2.2m) applies to promotion in the EU. However, given the range of EU countries to which Ms Peycheva refers, combined with the fact that one of those countries is Bulgaria (where the applicant is domiciled), leads me to conclude that it is far more likely than not that a not insignificant portion of this promotional spend applies to the EU.

40. As to the form in which the trade mark has been used, the pages in exhibit 1 from nivalin.com which mention the applicant and which bear a copyright date of 2016-2017 show the mark being used in upper and title case i.e. NIVALIN and Nivalin and when it appears on product packaging with, it appears, the letter “V” presented in what appears to be in a slightly stylised script (although the images are small and indistinct). Although only one page can be dated (from 2000), the screenshots provided in exhibit 2 to Ms Peycheva’s statement show the word NIVALIN in upper case. The pages from the applicant’s website provided as exhibit 1 to Ms Gakpetor’s statement are from after the relevant date. They do, however, show the NIVALIN trade mark being used in the same format as that shown in exhibit 1 to Ms Peycheva’s statement.

41. As to the goods upon which the NIVALIN trade mark has been used, I have reproduced above extracts from the applicant’s website showing the nature of the goods and the uses to which it is put; I am not, of course, a medical expert. Although in her counterstatement and evidence the proprietor took issue with the applicant’s use not being in the UK and at the hearing Mr Din adopted the position mentioned in paragraph 36 above, as far as I can tell, at no point has the proprietor taken issue

with the fact that the specification for which the NIVALIN trade mark is registered does not fairly reflect the uses to which NIVALIN may be put.

42. As Mr Alexander made clear in *Awareness Limited v Plymouth City Council*, in order to demonstrate genuine use “it is not strictly necessary to exhibit any particular kind of documentation”. However, as he also made clear, “That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself.” The applicant’s evidence provided to demonstrate genuine use is, in my view, poor. There is, for example, (i) very little datable evidence of the use of the NIVALIN trade mark within the relevant period, (ii) no evidence of the NIVALIN trade mark appearing in the type of formularies mentioned by Mr Din at the hearing, (iii) no evidence of the number or type of customers the applicant has for its NIVALIN product, (iv) no examples of invoices sent to such customers and (v) the size of the market for the applicant’s NIVALIN product in the EU is not explained; such information would, I have no doubt, be well-known to the applicant and ought, in my view, to have been relatively easy to provide.

43. However, the turnover for goods sold under the NIVALIN trade mark is significant and even though the promotional figures have not been split by jurisdiction, it is not unreasonable to assume (given the turnover figures provided), that a proportion of the €2.2m would have related to promotion in the EU countries mentioned.

44. Having weighed the various “pros and cons” of the applicant’s evidence in light of the guidance provided in the case law mentioned above, I am satisfied that when considered as a totality, it is sufficient to demonstrate that within the relevant period the applicant made genuine use of its NIVALIN trade in the EU in relation to the goods for which it stands registered i.e. “drugs for treatment of the degenerative and functional diseases of central and peripheral nervous system” and it is on that basis I intend to proceed.

Section 5(2)(b) – case law

45. The following principles are gleaned from the decisions of the courts of the European Union 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.

The principles:

(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 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 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

46. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 them, 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.”

47. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The comparison is between:

Applicant’s trade mark	Proprietor’s trade mark
NIVALIN	NOVALIN

48. Both parties’ trade marks consist of a single word presented in block capital letters; they have no distinctive and dominant components, the overall impression they convey and their distinctiveness lying in the trade marks as a whole.

The visual, aural and conceptual comparison

49. The competing trade marks are both seven letters long and differ only in their second letters i.e. “I” and “O”. That results in a high degree of visual and aural similarity between them. Although the proprietor indicates that her trade mark means “new food”, as I explained at the hearing, as that meaning is unlikely to be known to the average consumer, it does not assist her. As neither parties’ trade mark is likely to convey any concrete conceptual message to the average consumer, the conceptual position is neutral.

Distinctive character of the earlier trade mark

50. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to

identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

51. The applicant's trade mark consists of an invented word. Absent use, it enjoys a high degree of inherent distinctive character. As the applicant has not used its trade mark in the UK, it cannot benefit from an enhanced distinctive character.

The average consumer and the nature of the purchasing act

52. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

53. In her evidence, Ms Psycheva explains that the applicant's NIVALIN product is only available on prescription. Although that limitation is not reflected in the applicant's specification, given the nature of the goods for which it stands registered, that is, in my view, unsurprising.

54. In her counterstatement, Ms Din refers to the manner in which her NOVALIN product will be made available to the end user i.e.

“...after it is prescribed by a qualified, trained and registered healthcare professional in the UK and only after it is on a specific prescribing protocol. After being prescribed, this will further be checked by a qualified and trained pharmacist before being dispensed to the end user...”

55. Like the applicant’s specification, Ms Din’s specification is not limited in any way. However, unlike the applicant’s specification, as it is not self-evident the goods will be made available in the manner Mrs Din suggests, it is on the basis of the words as they appear in her specification I must proceed.

56. In *Mundipharma AG v OHIM*, Case T-256/04, the GC accepted that there were two groups of relevant consumers for a pharmaceutical product, professional users and the general public. That applies to the applicant’s specification and, notwithstanding Ms Din’s explanation, also to her goods.

57. Irrespective of the absence of a limitation to the applicant’s specification, given the purpose of their goods, they are most likely to be prescribed by, for example, a doctor, with any resulting prescription likely to be fulfilled by a pharmacist. As such professional users are likely to select such goods from, for example, formularies of the type mentioned by Mr Din, bespoke documentation in both printed and electronic form and following face-to-face discussions with, for example, those representing undertakings trading in such goods, it points to a mixture of visual and aural considerations being involved. As a member of the general public is likely to be exposed to the trade mark in, for example, discussions with professional users and on prescriptions and product packaging, that conclusion also applies to them.

58. Although Mrs Din indicates her goods will be made available on the basis indicated above (in relation to which similar conclusions to the manner in which the applicant’s goods are selected would apply), given the unlimited nature of her specification, I see no reason why her goods could not also be made available through conventional retail channels, such as on the shelves of pharmacies, supermarkets or retail outlets specialising in such goods or from the websites of such undertakings. As the goods may be self-selected, visual considerations will play an important role in the selection process. However, as such goods may also be the

subject of, for example, enquiries to sales staff in a bricks and mortar retail setting or by telephone, aural considerations will also play their part, albeit, in my view, to a much lesser extent than visual considerations.

59. In *Bayer AG v EUIPO*, Case T-261/17, the GC held that the average consumer pays a heightened level of attention when selecting pharmaceutical products, including such products available without a prescription (paragraph 33 of the judgment refers). Although that conclusion was reached in the context of pharmaceutical products and applies to the applicant’s goods, as Mrs Din’s goods are, for the most part, dietary foods products or supplements which will be selected to cater for specific dietary needs, I am led to conclude that both sets of average consumers will pay a high degree of attention to their selection.

Comparison of goods

60. The competing goods are as follows:

Applicant’s goods	Proprietor’s goods
Pharmaceutical preparations, namely drugs for treatment of the degenerative and functional diseases of central and peripheral nervous system.	Dietary fibre; dietary supplemental drinks; dietary supplements and dietetic preparations; dietary supplements consisting of vitamins; dietetic foods adapted for invalids; dietetic foods adapted for medical purposes; dietetic foods adapted for medical use; dietetic foods for use in clinical nutrition; dietetic sugar for medical use; dietetic sugar substitutes for medical use; food for medically restricted diets; food supplements; food supplements for medical purposes; food supplements for non-medical purposes; mineral dietary supplements for humans; mineral drinks

	(medicated-); mineral nutritional supplements; nutraceuticals for use as a dietary supplements; powdered fruit-flavoured dietary supplement drink mix; powdered nutritional supplement drink mix; vitamin drinks.
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61. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment 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”.

62. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

63. In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

64. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

65. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that "complementary" means:

“...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”.

66. Although Mrs Din explains how she intends to use her trade mark, I remind myself that in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

67. At the hearing, Mr Din explained that Mrs Din’s goods are powders designed to act as thickeners to increase the viscosity of water and other drinks. While I note the word “powdered” does qualify some of the goods in her specification, it does not qualify them all.

68. The applicant’s evidence shows that its goods are provided in ampoules and in tablet form; that is their nature. Some of Mrs Din’s goods are, as Mr Din argued, described as being provided in the form of powder (and are, as a consequence, of a different nature to the applicant’s goods); others are described in such a manner as to make it very unlikely they have the same nature as the applicant’s goods i.e. they are unlikely to be provided in tablet form or for injection. However, I see no reason why some of her goods may not be provided in, inter alia, tablet form, “dietary supplements and dietetic preparations” being one example.

69. Insofar as method of use is concerned, the applicant’s goods are provided in ampoules to be injected whereas its goods sold in tablet form will be ingested by swallowing; all of Mrs Din’s goods will be ingested by swallowing.

70. As described in her specification, the intended purpose of Mrs Din's goods is, broadly speaking, to assist those with specific dietary requirements/deficiencies. However, throughout her evidence and submissions, she has described the goods of interest to her as a "food and drink thickener" and, in my view, it is likely that a number of the terms within her specification would be broad enough to include goods which contain that characteristic. As to the applicant, I have described the various uses to which its goods may be put when I summarised its evidence earlier in this decision, one of which is the treatment of the "light and medium" stages of Alzheimer's disease. In its submissions filed in lieu of a hearing, the applicant argues:

"The Hearing Officer will note that, Sopharma AD's NIVALIN trade mark covers "Pharmaceutical preparations, namely drugs for treatment of the degenerative and functional diseases of central and peripheral nervous system". Sopharma AD submits that, "Degenerative diseases" include conditions such as Alzheimer's dementia, as well as diseases related to the natural processes of aging in humans where therapy includes helping a person to swallow food and drink.

Additionally, the term "Functional diseases" also, under NIVALIN trade mark, include neurodegenerative diseases and diseases of the locomotory system. The term "functional" is used in the medicinal field to indicate that the body is not functioning quite as it should. Such a condition includes "negative" symptom such as loss of sensation which can come on quite suddenly. People can wake and find that they cannot feel part of their body properly and may fear they have had a stroke and will need medication enabling ease of swallowing."

71. On a plain reading of the words in the competing specifications, I have found it very difficult to detect any meaningful degree of similarity of intended purpose between the competing goods. I do, however, note that the applicant's goods are used in the treatment of Alzheimer's i.e. a degenerative disease and from my own experience, I am aware that difficulty in swallowing is an issue for, inter alia, those suffering from such a disease. However, even if some of Mrs Din's goods may have

thickening as a characteristic, the fact remains that the primary intended purpose of her goods is to assist those with specific dietary requirements/deficiencies.

72. As to trade channels, it is not inconceivable that the competing goods may, for example, be wholesaled by undertakings specialising in, broadly speaking, goods for the treatment of human ailments and be available (even if on prescription) in the same pharmacies.

Likelihood of confusion

73. In determining whether there is a likelihood of confusion, 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 trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the applicant's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.

74. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

75. Having concluded that the applicant's evidence was sufficient to establish genuine use, I went on to find that: (i) the competing trade marks are visually and aurally similar to a high degree and conceptually neutral, (ii) the average consumer of the goods consists of professional users and members of the general public who are likely to select the goods using a mixture of visual and aural considerations (but in which visual considerations are likely to dominate) and who will pay a high degree of attention during that process and (iv) the applicant's earlier trade mark enjoys a

high degree of inherent distinctive character which has not been enhanced by the use that has been made of it, none of which has been in the UK. Finally, I found that there were various similarities in, for example, the nature and method of use of the competing goods, but crucially, in my view, the intended therapeutic purpose of the goods is different.

76. The interdependence principle indicates that a lesser degree of similarity in the competing goods may be offset by a greater degree of similarity in the competing trade marks. In reaching a conclusion, I begin by reminding myself of (i) the high degree of visual and aural similarity in the competing trade marks and the lack of any conceptual hook to assist the average consumer in recalling the competing trade marks, (ii) the competing goods may be provided in tablet form, (iii) the average consumers may coincide, (iv) the competing goods may move through similar trade channels and (v) the average consumer will pay a high degree of attention during the selection process (thus making them less prone to the effects of imperfect recollection).

77. However, if there is any similarity in the intended therapeutic purpose of the competing goods (which is crucial), it is, in my view, theoretical, rather than real.

78. This is an unusual case in which despite a range of factors apparently pointing to the likelihood of confusion (particularly the similarity in the competing trade marks), in my view, the lack of any meaningful similarity in the competing goods points the other way. While this has not been an easy decision to reach, having balanced all the relevant factors, I find there is no likelihood of confusion and the application based upon section 5(2)(b) fails and is dismissed accordingly.

The opposition based upon section 5(3) of the Act

79. I can deal with this ground of objection quite briefly. In its evidence, the applicant explains that it has made use of its trade mark in Bulgaria, Poland, Romania, Latvia, Lithuania and Estonia. Consequently, I shall proceed on the basis most favourable to the applicant, i.e. that its evidence is sufficient to establish a reputation in the

European Union (*Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07 refers). However, in *China Construction Bank Corporation v Groupement Des Cartes Bancaires*, (Case BL O/281/14), Mr Purvis Q.C. again acting as the Appointed Person, stated:

“40. ...I believe that the ultimate decision under s5(3) was nonetheless correct. In order to succeed under s5(3), the opponent has to show either that the distinctive character or repute of its earlier mark would be damaged by reasonable and fair use of the mark applied for, or that such reasonable and fair use would take unfair advantage of the reputation of its earlier mark. The reasonable and fair use of the mark applied for can only be use in the United Kingdom, since this is the entire territorial scope of the application.

41. If the reputation of the earlier mark does not extend to the United Kingdom, it is difficult to see how (at least in the usual case) it could be damaged by use of a mark in the United Kingdom, or that such use could be said to take unfair advantage of the earlier mark. For one thing, the necessary ‘link’ between the marks in the mind of the average consumer which must be established in any case which relies on the extended protection (see *Adidas-Salomon v Fitnessworld* [2004] ETMR 10) would not exist. **There is certainly no evidence in the present case which explains how any ‘link’ could be made in the UK absent a reputation here.**”(my emphasis).

80. As the passage I have highlighted applies with equal force to these proceedings, the absence of the necessary “link” is fatal to the opponent’s case, and the objection fails accordingly.

Overall conclusion

81. The application has failed and, subject to any successful appeal, Mrs Din’s trade mark will remain registered.

Costs

82. Following a request from the applicant, the tribunal, in an official letter dated 14 May 2018, indicated in relation to costs:

“...the parties will be given opportunity to file submissions following the substantive decision.”

83. In view of the above, **the parties are allowed 14 days from the date of this interim decision** to provide any comments they may have on the matter of costs. Insofar as Mrs Din is concerned, that should include reviewing the costs proforma sent by her to the tribunal on 13 November 2018. At the conclusion of that period, I will review any submissions the parties may make and issue a supplementary decision, in which I will deal with costs and set the period for appeal.

29th March 2019

C J BOWEN

For the Registrar

The Comptroller-General

Proprietor's specification when the application for invalidity was filed**Class 5**

Bread (Diabetic -) adapted for medical use; Bread products for diabetics; Candy for medical purposes; Candy, medicated; Capsules for pharmaceutical purposes; Cellulose for pharmaceutical purposes; Central nervous system stimulants; Chemical preparations for medical purposes; Chemical preparations for pharmaceutical purposes; Chemical preparations for testing blood for medical purposes; Chemical preparations for the diagnosis of diabetes; Chemicals for pharmaceutical use; Chemico-pharmaceutical preparations; Cod liver oil ;Cold cream for medical use; Cough syrups; Creams (Medicated -) for application after exposure to the sun; Diabetic bread adapted for medical use; Diagnostic agents for pharmaceutical use; Diagnostic preparations; Diarrhea medication; Diet capsules; Dietary and nutritional supplements; Dietary fiber; Dietary fiber to aid digestion; Dietary fibre; Dietary food supplements; Dietary supplemental drinks; Dietary supplements; Dietary supplements and dietetic preparations; Dietary supplements consisting of vitamins; Dietary supplements consisting primarily of calcium; Dietary supplements consisting primarily of iron; Dietary supplements consisting primarily of magnesium; Dietary supplements for humans; Dietary supplements for humans not for medical purposes; Dietary supplements for medical use; Dietary supplements for pets in the nature of a powdered drink mix; Dietetic beverages adapted for medical purposes; Dietetic beverages for babies adapted for medical purposes; Dietetic confectionery adapted for medical purposes; Dietetic food adapted for medical use; Dietetic food adapted for veterinary use; Dietetic food preparations adapted for medical purposes; Dietetic food preparations adapted for medical use; Dietetic foods adapted for invalids; Dietetic foods adapted for medical purposes; Dietetic foods adapted for medical use; Dietetic foods for medicinal purposes; Dietetic foods for use in clinical nutrition; Dietetic foodstuffs for medical purposes; Dietetic infusions for medical use; Dietetic preparations adapted for medical use; Dietetic products for invalids; Dietetic products for medical purposes; Dietetic substances adapted for medical use; Dietetic substances adapted for veterinary use; Dietetic sugar for medical use; Dietetic sugar substitutes for medical use; Digestants; Digestive enzymes; Digestives for pharmaceutical purposes; Diuretic preparations; Diuretics; Drinks (Medicinal -);Ferments (Milk -) for pharmaceutical purposes; Fiber (Dietary -); Fibre (Dietary -);Fish oil for medical purposes; Food for diabetics; Food for medically restricted diets; Food supplements; Food supplements consisting of amino acids; Food supplements consisting of trace elements; Food supplements for dietetic use; Food supplements for medical purposes; Food supplements for non-medical purposes; Foodstuffs for diabetics [specially made for];Ginseng for medicinal use; Glucose dietary supplements; Glucose for medical purposes; Glucose for use as an additive to foods for medical purposes; Glucose preparations for medical purposes; Herbal medicine; Homeopathic pharmaceuticals; Homeopathic supplements; Magnesium salts for pharmaceutical use; Magnesium sulphate for pharmaceutical use; Malt for pharmaceutical purposes; Malted milk beverages for medical purposes; Medicated food supplements; Medicated isotonic drinks; Medicinal tea; Menthol; Milk sugar;

Milk sugar for pharmaceutical purposes; Mineral dietary supplements for humans; Mineral drinks (Medicated -); Mineral food preparations for medical purposes; Mineral food supplements; Mineral nutritional supplements; Mixed vitamin preparations; Multivitamin preparations; Nutraceuticals for therapeutic purposes; Nutraceuticals for use as a dietary supplement; Nutritional additives to foodstuffs for animals, for medical purposes; Nutritional supplements; Nutritional supplements consisting primarily of calcium; Nutritional supplements consisting primarily of iron; Nutritional supplements consisting primarily of magnesium; Nutritional supplements consisting primarily of zinc; Pain relief preparations; Pharmaceutical preparations for the prevention of allergies; Pharmaceutical preparations for the treatment of gout; Pharmaceutical preparations for the treatment of kidney disorders; Powdered fruit-flavored dietary supplement drink mix; Powdered nutritional supplement drink mix; Sugar for medical purposes; Vitamin and mineral supplements; Vitamin drinks; Vitamin supplements.