

BL O/0358/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. 3627608

BY U.G.A. NUTRACEUTICALS S.R.L.

TO REGISTER THE TRADE MARK:

OMEGOR

IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 427788

BY BASF AS

AND

IN THE MATTER OF UK TRADE MARK REGISTRATION NO. 800934400

IN THE NAME OF BASF AS

FOR THE TRADE MARK:

OMACOR

IN CLASS 5

AND

AN APPLICATION FOR REVOCATION THEREOF

UNDER NO. 504580

BY U.G.A. NUTRACEUTICALS S.R.L.

Background and Pleadings

1. On 16 April 2021, U.G.A. NUTRACEUTICALS S.R.L. (hereinafter I shall refer to this company as 'U.G.A.')

applied to register in the UK the trade mark shown on the cover page of this decision, under number 3627608 ('the contested mark'). The application, which is effectively a re-filing of a pending European Union ("EU") registration, was filed pursuant to Article 59 of the Withdrawal Agreement between the UK and the EU (hereinafter referred to as "Article 59"). The EU filing date was 22 February 2017 and so, in accordance with Article 59, the contested mark is deemed to have the same filing date as the corresponding EU application. The UK application was published in the Trade Marks Journal for opposition purposes on 19 November 2021, in respect of goods in Class 5 (see "Annex" for the full list of goods).

2. On 27 October 2021, BASF AS (hereinafter I shall refer to this company as 'BASF') filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 ('the Act') and is directed against all the goods in the application.

3. BASF relies upon the following United Kingdom Trade Mark ('UKTM') and comparable UKTMs:¹

(i) UKTM no. 1537600 for the trade mark 'OMACOR' which was applied for on 04 June 1993. However, the application has a priority date of 17 December 1992.² The trade mark was entered in the register on 01 September 1995, in respect of the following goods:

Class 5 Pharmaceutical products; all in the form of Omega-3 fatty acids; all included in Class 5.

¹ On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM or IR(EU). As a result of the opponent's EUTM number 001414531 and IR(EU) number W00934400 being registered as at the end of the Implementation Period, comparable UK trade marks were automatically created. The comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original EUTM and IR(EU) filing dates remain.

² Norway

(ii) UKTM no. 901414531 for the trade mark **OMACOR** which was applied for on 08 December 1999, and which was entered in the register on 02 March 2005, in respect of the following goods:

Class 5 Pharmaceutical products in the form of Omega-3 fatty acids.

(iii) UKTM no. 800934400 for the trade mark 'OMACOR' which was applied for on 27 June 2007, and which was entered in the register on 09 March 2009, in respect of the following goods:

Class 5 Pharmaceutical preparations; dietetic substances adapted for medical use; food supplements; vitamins.

4. Under Section 5(2)(b), BASF claims that there is a likelihood of confusion on the basis that the marks at issue are highly similar and that the goods are either identical or highly similar. In accordance with section 6A of the Act, all of the earlier marks are subject to proof of use; BASF made a statement of use in relation to all the goods relied upon.

5. U.G.A. filed a defence and counterstatement denying the grounds of opposition and requesting that BASF provides proof of use of all the marks and goods relied upon.

6. In addition, on 11 February 2022, U.G.A. sought revocation of BASF's earlier registration, UKTM no. 800934400, based on the following:

i) Under section 46(1)(a) of "the Act, on the basis of non-use in the five-year period following the date on which the mark was registered, namely 9 March 2009. It seeks revocation from 10 March 2014.

ii) Under 46(1)(b), on the basis that the mark has not been used during the following period: 12 February 2017 to 11 February 2022. The date on which it wants revocation to take effect is 12 February 2022.

7. In response BASF filed a defence denying the claims made. Furthermore, they submit that whilst the relevant periods under 46(1)(a) and 46(1)(b) are noted, by demonstrating use in the relevant period under 46(1)(b), this will negate the requirement to show use in the first relevant period under 46(1)(a). Accordingly, BASF submits that its defence will concentrate on the relevant period set under 46(1)(b), namely 12 February 2017 to 11 February 2022.

8. On 4 May 2022, the Tribunal wrote to the parties informing them of the consolidation of the revocation action no. 504580 and the opposition no. 427788.

9. BASF is represented by Hogan Lovells International LLP and U.G.A. is represented by Potter Clarkson LLP. Both parties filed evidence. Both parties were given the option of an oral hearing but neither requested to be heard on this matter. Only U.G.A. filed written submissions in lieu. This decision is taken following a careful review of the papers.

EVIDENCE AND SUBMISSIONS

10. With regards to the opposition proceedings, BASF filed evidence in the form of the first witness statement of Morten Kvalvik, dated 11 March 2022, and his corresponding five exhibits (MK1-MK5). Furthermore, with regard to the revocation proceedings, BASF filed evidence in the form of the second witness statement of Morten Kvalvik, dated 27 April 2022, and the same corresponding five exhibits (MK1-MK5).

11. Mr Kvalvik is the Global Key Account Manager at BASF, the opponent company, a position held since January 2013. Mr Kvalvik states that he has been assisted in the preparation of his witness statements by Siv Karin Førde of BASF and Hogan Lovells International LLP, BASF's legal representative.

12. U.G.A filed evidence in the form of the witness statement of Giovanni Zenoni, dated 01 September 2022, and his corresponding eleven exhibits (GZ01-GZ11). Mr Zenoni, a Trade Mark Attorney at Potter Clarkson LLP, is authorised to make the statement as the legal representative for U.G.A.

13. In response to U.G.A.'s evidence BASF filed further evidence in the form of the witness statement of Dr Mirko Vianello, dated 28 October 2022, and his corresponding one exhibit (MV1). Dr Vianello is the Senior Legal Counsel for Global Intellectual Property at BASF, a position held since 2014.

14. On 18 January 2023 U.G.A. filed written submissions in lieu.

15. Whilst I do not propose to summarise the evidence and submissions here, I have taken them into consideration and will refer to them below where necessary.

DECISION

Relevance of EU law

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

The Revocation

17. I shall address the revocation first as the outcome of this action will determine the goods for which BASF must show use on in the opposition proceedings. If the revocation succeeds in its entirety, the opposition will fall away in respect of the UKTM no. 800934400.

Legislation

18. Section 46 of the Act states:

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

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

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

[...]

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

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

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

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

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

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

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

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

19. As the earlier mark is a comparable mark, paragraph 8 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

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

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

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

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

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

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

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

20. Accordingly, the earlier mark will be treated as an EUTM for any and all parts of the relevant periods which fall prior to IP completion day (i.e. 31 December 2020) and, as such, use in the EU may be sufficient.

21. Section 100 is also relevant, which reads:

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

22. Consequently, the onus is upon BASF to prove that genuine use of the registered trade mark was made within the relevant territory in the relevant periods, and in respect of the goods as registered.

Relevant case law

23. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v*

Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky' [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does

not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de*

minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

24. There are two relevant periods for assessing genuine use in the revocation proceedings: 10 March 2009 to 09 March 2014 under section 46(1)(a) (“the first relevant period”) and 12 February 2017 to 11 February 2022 under Section 46(1)(b) (“the second relevant period”).

25. Whilst BASF note the relevant periods, they submit that by demonstrating use in the second relevant period this will negate the requirement to show use in the first relevant period. It is correct that by virtue of section 46(3) I need only consider the second relevant period to begin with. It is only if no use is shown in the second relevant period that it will be necessary for me to refer to the first relevant period.

26. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander QC (as he then was) as the Appointed Person stated that:

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

And further at paragraph 28:

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

27. I also note Mr Alexander’s comments in *Guccio Gucci SPA v Gerry Weber International AG*,³ where he stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round – or lose it”.”

28. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person stated that:

³ Case BL 0/424/14

“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.”

29. Accordingly, whilst there is no requirement to produce any specific form of evidence, I must consider what the evidence as a whole shows me and whether on

this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the mark.

Form of the mark

30. Before I consider whether BASF has shown sufficient use in relation to its mark, I will first consider the marks shown within the evidence, and if I consider this to be use of the mark as registered, or to be an acceptable variant of the same.

31. BASF's registration is for the word only mark 'OMACOR'. Where it has used its registration as registered, that will clearly be use on which they can rely. In addition, it is noted from the evidence that BASF has also used its registration in the following way:

OMACOR 

32. Section 6A(4)(a) of the Act enables an opponent to rely on use of a mark "in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered". In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, the Court of Justice of the European Union ("CJEU") found that "use of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark", but that "a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)".

33. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold QC (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

"33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period..."

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

34. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

35. As the registered trade mark is in word only format the distinctive character of the mark resides in the word 'OMACOR'. As shown above, the signs presented as trade marks in BASF's evidence includes a figurative mark, incorporating a device and stylised font. However, I bear in mind that as the registered trade mark is a word mark, fair and notional use of the mark allows it to take on a different presentation, such as a different font or letter case,⁴ and therefore, on this basis, in accordance with *Colloseum*, I consider the mark shown above, is an example of use of BASF's registration as registered.

36. Whilst I acknowledge that the registration is for the word 'OMACOR' and there is use of this word in a different letter case and with a figurative device I am of the view that the mark as registered will still be perceived as indicative of the origin of the goods. Furthermore, I find that in accordance with *Nirvana* (cited above), the differences in the presentation of the above mark, does not affect the distinctive character of the registered mark given that overall, it will still be perceived and referred to as 'OMACOR'. As such, I find that the distinctive character of the registered word is not affected by presenting it in a different letter case, font, or

⁴ *Bentley Motors Limited v Bentley 1962 Limited* (BL O/158/17).

adding the figurative element. Accordingly, I find that the above mark is an acceptable variant of BASF's registration.

Genuine use

37. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue during the relevant five-year period. Given that the earlier mark is a comparable mark, the relevant territory during the second relevant period is the UK, though use in the EU before IP completion day may be sufficient. In making the 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 for which use has been shown;
- iv) The nature of those goods and the market(s) for them; and
- v) The geographical extent of the use shown.

38. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁵

39. BASF claims to have used its earlier mark between 12 February 2017 and 11 February 2022 in relation to the following goods:

Class 5 Pharmaceutical preparations; dietetic substances adapted for medical use; food supplements; vitamins.

40. In his witness statement, Mr Kvalvik gives evidence that BASF was originally called Pronova Biopharma, and was acquired by BASF in 2013, stating that the company is now named BASF AS. Mr Kvalvik states that BASF has been producing

⁵ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

pharma Omega3 API (Active Pharmaceutical Ingredients) for almost 25 years, adding that this product is sold under different trade marks namely, Omacor, Dualtis, Zodin, Seacor, Esapent or Eskim.

41. Mr Kvalvik, states that BASF is a pioneer in the pharmaceutical use of Omega-3, providing world-leading expertise, experience and support for the analysis, regulatory control, production and supply of such goods. Mr Kvalvik states that the OMACOR brand is one of BASF's key brands for pharmaceutical preparations of Omega-3 fatty acids and was launched in Norway in 1996, and in the United Kingdom in 2002.

42. Furthermore, Mr Kvalvik states that today OMACOR branded goods are available in more than 80 countries in the world, and in all European Member States, except Sweden, Denmark and Finland. Mr Kvalvik adds that BASF has made intensive use of the OMACOR mark across the UK (and EU) for many years, including during the relevant period of the present revocation proceedings.

43. It is noted from the witness statement that the total turnover figures (shown in US dollars) in respect of products sold in the UK under the 'OMACOR' mark between 2016 and 2021 are as follows:

Year	Product description	Turnover (at least)	Label
2016	Omega3 EE 90	\$3 million	Omacor
2017	Omega3 EE 90	\$3 million	Omacor
2018	Omega3 EE 90	\$2 million	Omacor
2019	Omega3 EE 90	\$1 million	Omacor
2020	Omega3 EE 90	\$2 million	Omacor
2021	Omega3 EE 90	\$2 million	Omacor

44. Furthermore, in his witness statement, Mr Kvalvik states that the total number of 'capsules' of 'OMACOR' goods sold in the UK between 2016 and 2021 are as follows:

Year	Product description	Capsules sold (at least)	Label
2016	Omega3 EE 90	9 million	Omacor
2017	Omega3 EE 90	8 million	Omacor
2018	Omega3 EE 90	8 million	Omacor
2019	Omega3 EE 90	7 million	Omacor
2020	Omega3 EE 90	8 million	Omacor
2021	Omega3 EE 90	7 million	Omacor

45. Exhibit MK1 shows examples of the pharmaceutical packaging and inserts relating to the pharmaceutical products as they were sold in the UK, as detailed in the table above, between the period of 2017 and 2019. The earlier mark, including the acceptable variant of the mark, as previously discussed, are clearly visible on the packaging and inserts. Furthermore, it is clear from the examples that the products relate to Omega-3 capsules.

46. It is noted that BASF's name does not appear on the examples however the name 'Mylan' does. Nevertheless, I note from Mr Kvalvik's witness statement that 'Mylan' are a global healthcare company and partner of BASF and are contractually responsible to BASF for the promotion of the 'OMACOR' trade mark in the UK, along with the distribution of 'OMACOR' products in the UK and Europe.

47. Exhibit MK2 shows excerpts from the Medicines and Healthcare products Regulatory Agency (MHRA) website (www.mhra.gov.uk), showing the search results for the medical product 'OMACOR' in 2019 and 2022. In his witness statement Mr Kvalvik's states that the MHRA regulates medicines, medical devices and blood components for transfusion in the UK. The excerpts clearly show the earlier mark 'OMACOR'.

48. Exhibit MK3 relates to invoices provided by 'Mylan' demonstrating the sale and shipment of 'OMACOR' products to several UK customers. The four invoices are dated between 2017 and 2020. By examining these invoices, I am satisfied that there have been sales to the UK between 2017 and 2020 for 'OMACOR' Omega 3 products. Furthermore, the earlier mark is visible on all of the invoices and as such I am satisfied that the sale of these goods was made under that mark.

49. Exhibit MK4 relates to press articles published in the Scottish Daily Mail on 25 March 2021, Scrip Pharma Intelligence on 08 January 2020, M2 PressWIRE on 12 May 2017, and the Daily Mail on 10 May 2016. Each article demonstrates use of the mark 'OMACOR' in relation to pharmaceutical drugs containing Omega 3.

50. Exhibit MK5 relates to a screenshot obtained from 'The Wayback Machine', (a digital archive website) showing 'Omacor Capsules 1000mg' available on www.chemistdirect.co.uk in August 2020. In his witness statement, Mr Kvalvik states that Chemist Direct is a leading UK-based online pharmacy providing medical products and over-the-counter medication to UK consumers.

51. It is noted that BASF's name does not appear on the featured 'Omacor Capsules' packaging, but rather the name 'Abbott' does. However, there is no mention of Abbott's relationship with BASF in Mr Kvalvik's witness statement or accompanying exhibits.

52. With regards to the promotion of the mark, it is noted from the witness statement that BASF's partners, including Mylan, are contractually responsible to BASF for the promotion of the 'OMACOR' mark in the United Kingdom, and that the 'OMACOR' products are marketed in a number of different ways, including through promotional material aimed at doctors, pharmacists and patients with relevant medical needs, through activities of a dedicated sales force, and through online advertisements and lectures. However, in his witness statement, Mr Kvalvik states that BASF's partners do not share details of the promotional and advertising spend with them.

53. As the earlier mark is a comparable mark it is treated as an EUTM for the part of the relevant period which falls prior to IP completion day. However, I bear in mind 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, even where there are no special factors, such as the market for the goods being limited to that area of the Union.⁶ I consider the use shown in the UK to be sufficient for this purpose.

⁶ *TVR Automotive Ltd v OHIM* T-398/13

54. I remind myself that use does not have to be quantitatively significant to be genuine. On balance, I find that the evidence demonstrates that BASF has used the mark at issue in relation to pharmaceutical goods containing Omega-3 and that these goods have been available to purchase in the UK. Therefore, BASF has demonstrated genuine use of its mark during the second relevant period.

Fair specification

55. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods relied upon. *In Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC as the Appointed Person summed up the law as being:

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

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

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

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the

services in relation to which the trade mark has been used; *Thomas Pink* at [53].

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

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

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

57. BASF relies upon the following goods:

UKTM no. 800934400

Class 5 Pharmaceutical preparations; dietetic substances adapted for medical use; food supplements; vitamins.

58. There is no evidence of use of the mark in relation to any pharmaceutical products or preparations, dietetic substances adapted for medical use, food supplements or vitamins, other than Omega-3 capsules. Therefore, it is deduced from the evidence that the goods where use has been demonstrated would be fairly described by the average consumer as *pharmaceutical preparations in the form of Omega-3 fatty acids*.

59. Since BASF has not shown use of its entire specification in the second relevant period, it would ordinarily be necessary to consider the first relevant period to determine at which point the mark should be revoked for the relevant goods. However, no evidence of use has been filed in relation to the first relevant period.

Outcome of the revocation

60. Accordingly, I find that BASF may maintain its protection for the following goods under its mark, UKTM no. 800934400:

Class 5 Pharmaceutical preparations in the form of Omega-3 fatty acids.

61. The mark will therefore be revoked in respect of the remaining goods as of 10 March 2014.

The Opposition

Proof of use of the earlier marks

62. In respect of the opposition based on section 5(2)(b) of the Act, U.G.A. has requested that BASF prove use of all three of its earlier registrations in relation to the goods relied upon.

63. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier marks is the five-year period ending with the date of the application in issue. Since the filing date of the application is deemed to be the same as that of the EUTM on which it is based, the relevant period for BASF to prove

use of its three earlier marks for this opposition is 23 February 2012 to 22 February 2017.

64. I have already considered the extent to which BASF has used its mark, UKTM no. 800934400 in relation to the revocation above and as the effective date of revocation was 10 March 2014, BASF are entitled only to rely upon *pharmaceutical preparations in the form of Omega-3 fatty acids* as at the application date.

65. I remind myself that an assessment of genuine use is a global assessment, which involves looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁷

66. It is noted that the evidence submitted in the revocation proceedings by BASF, in the form of exhibits MK1-MK5, is identical to its evidence submitted in respect of the opposition proceedings. However, it has to be reiterated that the relevant period for the opposition proceedings is 23 February 2012 to 22 February 2017.

67. In its submissions in lieu, U.G.A. criticised BASF's evidence as follows:

“As for proof of use evidence that was filed, this was submitted in the form of 2 Witness Statements of Morten Kvalvik dated 11 March 2022 and 27 April 2022 respectively. The 11 March Witness Statement was intended to show proof of use for the Opposition Relevant Period and the 27 April Witness Statement was intended to show proof of use for Relevant Period (B).⁸ Despite relating to distinct relevant periods, covering different periods of time (overlapping by a period of only 10 days), the Opponent has made identical statements on the 'use of the OMACOR Mark in the UK' and has filed the same accompanying exhibits.

It is respectfully submitted these Witness Statements fail to demonstrate proof of use for the Earlier Registrations during the Opposition Relevant Period.

⁷ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

⁸ Cancellation relevant period (12 February 2017 to 11 February 2022).

[...]

It is respectfully submitted that the Opponent has failed to satisfy the evidential burden, for demonstrating proof of use, within the Opposition Relevant Period. As such the opposition should be dismissed, in its entirety.”

68. I agree with U.G.A.’s points outlined above. As can be seen from the evidence summary in the revocation proceedings, the majority of the evidence is dated outside of the relevant period for the opposition proceedings and therefore I find that the evidence does not assist BASF in proving use of its marks during the relevant period.

69. It is noted from the witness statement that the total turnover figures (shown in US dollars) in respect of products sold in the UK under the ‘OMACOR’ mark relate to the period between 2016 and 2021 and therefore, in terms of the proof of use proceedings only the 2016 figure of \$3 million can be taken into account as the remaining turnover falls outside the relevant period.

70. Likewise, it is noted from the witness statement that the total number of ‘capsules’ of ‘OMACOR’ goods sold in the UK relate to the period between 2016 and 2021, and therefore again, in terms of the proof of use proceedings, only the 2016 figure of 9 million can be considered as the remaining sales fall outside the relevant period.

71. The examples of the pharmaceutical packaging and inserts relating to the pharmaceutical products as they were sold in the UK contained in exhibit MK1, are dated from March 2017, outside the relevant date for these proceedings. Therefore, this evidence does not assist BASF in proving use of the mark in the relevant period.

72. The excerpts from the Medicines and Healthcare products Regulatory Agency (MHRA) website (www.mhra.gov.uk), contained in exhibit MK2, showing the search results for the medical product ‘OMACOR’ are dated 2019 and 2022, and therefore fall outside the relevant date for these proceedings. Consequently, this evidence does not assist BASF in proving use of the mark in the relevant period.

73. The four invoices contained in exhibit MK3, demonstrating the sale and shipment of 'OMACOR' products to several UK customers are dated between 22 November 2017 and 01 April 2020, fall outside the relevant date for these proceedings. Accordingly, this evidence does not assist BASF in proving use of the mark during the relevant period.

74. Exhibit MK4 relates to press articles published in the Scottish Daily Mail on 25 March 2021, Scrip Pharma Intelligence on 08 January 2020, M2 PressWIRE on 12 May 2017, and the Daily Mail on 10 May 2016, and therefore, in terms of the proof of use proceedings, only the 'Daily Mail' press article can be taken into account as the remaining press articles fall outside the relevant period.

75. The screenshot obtained from 'The Wayback Machine', (a digital archive website), contained in exhibit MK5, showing 'Omacor Capsules 1000mg' available on www.chemistdirect.co.uk is dated 10 August 2020, and therefore falls outside the relevant date for these proceedings. Accordingly, this evidence does not assist BASF in proving use of the mark during the relevant period.

76. It is important to recall that the onus is on BASF to provide 'sufficiently solid' evidence in order to prove use. However, as detailed above, I find that there are numerous deficiencies within BASF's evidence provided.

77. Accordingly, while I acknowledge that the use of a mark does not have to be quantitatively significant to be genuine, I have not been persuaded that BASF's evidence satisfies the criteria of genuine use of its mark. If the mark had been put to genuine use on the goods relied on in the UK and within the relevant period, then it should not have been a difficult matter for BASF to show it. However, it did not.

78. Accordingly, I find that BASF's evidence is insufficiently solid to adequately demonstrate that there has been genuine use of the marks in relation to the goods at issue within the relevant period.

CONCLUSION

Revocation

79. The registration UK800934400 in the name of BASF AS will be revoked for the following goods:

Class 5 Pharmaceutical preparations; dietetic substances adapted for medical use; food supplements; vitamins.

80. The effective date of revocation is 10 March 2014.

81. The registration UK800934400 in the name of BASF AS will remain registered from 10 March 2014 for the following amended specification:

Class 5 Pharmaceutical preparations in the form of Omega-3 fatty acids.

Opposition

82. BASF has failed to establish genuine use of its earlier marks within the relevant period. Accordingly, the opposition falls at the first hurdle and is dismissed accordingly. Subject to appeal, the application will proceed to registration.

COSTS

83. Within the revocation proceedings both parties have achieved a relatively equal level of success, and as such I make no cost award in respect of this element of the proceedings.

84. In respect of the opposition proceedings, U.G.A. has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. I award U.G.A. the sum of £1,100, as a contribution towards the cost of proceedings, calculated as follows:

Considering the Notice of Opposition and preparing a counterstatement	£200
Preparing evidence and considering the other side's evidence	£600
Preparing submissions in lieu of a hearing	£300
Total	£1,100

85. I therefore order BASF AS to pay U.G.A. NUTRACEUTICALS S.R.L. the sum of £1,100. This sum should 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 12th day of April 2023

Sam Congreve
For the Registrar

Annex

U.G.A.'s goods

Class 5 Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; nutritional supplements; albumin dietary supplements; alginate dietary supplements; casein dietary supplements; dietary supplements for animals; enzyme dietary supplements; flaxseed dietary supplements; flaxseed oil dietary supplements; glucose dietary supplements; lecithin dietary supplements; linseed dietary supplements; linseed oil dietary supplements; mineral food supplements; pollen dietary supplements; propolis dietary supplements; protein dietary supplements; protein supplements for animals; royal jelly dietary supplements; wheat germ dietary supplements; yeast dietary supplements; dietary fiber; dietary fibre; food for babies; dietetic foods adapted for medical purposes; dietetic beverages adapted for medical purposes; starch for dietetic or pharmaceutical purposes; by-products of the processing of cereals for dietetic or medical purposes; dietetic substances adapted for medical use; infant formula; powdered milk for babies; candy, medicated; dressings, medical; amino acids for medical purposes; chewing gum for medical purposes; drugs for medical purposes; gum for medical purposes; pearl powder for medical purposes; pomades for medical purposes; malted milk beverages for medical purposes; pharmaceutical preparations; veterinary preparations; vitamin preparations; preparations of trace elements for human and animal use.