

O/0850/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3790454
BY APPLIED NUTRITION LIMITED**

TO REGISTER:

TEST-X

AS A TRADE MARK IN CLASSES 5, 29 & 32

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 435515 BY
LABORATORIO FARMACEUTICO S.I.T. SPECIALITÀ IGIENICO
TERAPEUTICHE s.r.l.**

BACKGROUND AND PLEADINGS

1. On 20 May 2022, Applied Nutrition Limited (“the applicant”) applied to register **TEST-X** as a trade mark in the United Kingdom in respect of the following goods:

Class 5

Protein supplements; protein dietary supplements; vitamins and vitamin preparations; vitamin drinks, drops, supplements and tablets; vitamin and mineral supplements and preparations; vitamin and mineral food supplements; meal replacement powders; nutritional supplement meal replacement bars for boosting energy; nutritional drink mix for use as a meal replacement; dietary supplements; dietary supplements containing CBD oil; food supplements consisting of amino acids; edible fish oils for medical purposes; protein, vitamin, dietary, and nutritional supplements in powder, tablet, gel and drop form; protein, vitamin, dietary and nutritional supplements all being for the purpose of sports performance and enhancement, weight loss, weight gain and the improvement of health.

Class 29

Meat, fish, poultry and game; yoghurt and milk products; edible oils and fats; edible oils derived from fish; eggs; jellies and jams; wheys; milk shakes; protein and vitamin enriched milkshakes, yoghurts and milk based products.

Class 32

Non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other non-alcoholic preparations for making beverages; isotonic sports drinks; energy drinks; vitamin enriched drinks; energy drinks containing caffeine; whey beverages.

2. On 11 August 2022, the application was opposed by Laboratorio Farmaceutico S.I.T. Specialità Igienico Terapeutiche S.r.l. (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and concerns all the goods for which registration is sought. The opponent relies on UK Trade Mark No. 908349193, **TESTEX**, which is a UK comparable mark with a filing date of 9 June 2009

and a registration date of 24 December 2009. The opponent is relying on the following goods:

Class 5

Pharmaceutical and veterinary preparations; dietetic substances adapted for medical use.

3. The opponent claims that the marks are similar and that the goods covered by the marks are either identical or similar. It also claims that the distinctive character of the earlier mark has been enhanced through use. Consequently, there exists a likelihood of confusion on the part of the relevant public in the UK.

4. The applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of use of the earlier mark for the goods relied on. It claims that the marks and goods are dissimilar and that there is therefore no likelihood of confusion.

5. Both parties filed evidence, which I briefly summarise below. The applicant also filed written submissions dated 14 March 2023.

6. Neither side requested a hearing. The opponent and applicant filed final written submissions on 7 June 2023 and 8 June 2023 respectively.

7. In these proceedings, the opponent is represented by Bird & Bird LLP and the applicant by Wilson Gunn.

EVIDENCE

8. The opponent's evidence comes from Lamberto Matteo Pedrotti Catoni, Legal Representative at the opponent. He confirms that he has been in this position since 4 September 2017. His witness statement is dated 21 December 2022 and is accompanied by 9 annexes adduced to prove the use that has been made of the earlier mark.

9. The applicant's evidence comes from Andrew Marsden, Chartered Trade Mark Attorney at the applicant's legal representatives, Wilson Gunn. His witness statement is dated 17 March 2023 and is a vehicle for exhibiting three articles on testosterone propionate, the active ingredient in a pharmaceutical preparation the opponent sells under the mark.

DECISION

Proof of Use

10. Section 6A of the Act is as follows:

“(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in sections 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section '*the relevant period*' means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the relevant period 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) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

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

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

[(5) Repealed]

(6) 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.

...”

11. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It is as follows:

“(1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the ‘five-year period’) has expired before IP completion day-

- (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
- (b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

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

- (a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and
- (b) the references in section 6A to the United Kingdom include the European Union.”

12. Section 100 of the Act is as follows:

“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.”

13. The relevant period for the purposes of the proof of use assessment is the five years ending with the date of application for the contested mark. It is therefore 21 May 2017 to 20 May 2022. For the part of this period that falls before IP completion day (31 December 2020), the relevant territory is the EU; for the period thereafter, it is the UK.

14. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):¹

¹ 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to refer to the trade mark case-law of EU courts, although the UK has left the EU.

“114. *The law with respect to genuine use.* 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 *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 Bundersvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno 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 *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].

15. The opponent is a producer of medicines, cosmetics, food supplements and medical surgical devices. It claims that the mark has been used for “*an injectable ingestible pharmaceutical preparation containing the active ingredient testosterone propionate*”.² This preparation is marketed by Desma Laboratorio Farmaceutico SL (“Desma”), a wholly owned subsidiary of the opponent.³ Annex G contains a distribution contract dated 1 November 2017 between the opponent and Desma covering the territory of Spain. Article 11 states that the contract is for an indefinite period of time.

16. I have been given sales data for this product from the UK and Spain, as shown in the table below. The figures are in euros.⁴

² Witness statement of Lamberto Matteo Pedrotti Catoni, paragraph 8.

³ Annex A.

⁴ Witness statement, paragraph 12, and Annex D.

Country	Year	TESTEX 25	TESTEX 100	TESTEX 250
United Kingdom	2019	720.00	600.00	636.00
	2020	720.00	11,400.00	6,360.00
	2021	16,290.00	21,650.40	29,990.40
Spain	2018	10,446.05	91,066.87	957,301.86
	2019	9,774.76	136,676.65	1,190,993.75

17. These figures are supplemented by 26 invoices recording sales to the UK between 29 November 2019 and 28 October 2021, and 40 invoices recording sales to Spanish customers between 26 October 2017 and 23 November 2020.⁵ The relevant products are listed on the invoices as “TESTEX 25MG”, “TESTEX PROLONGATUM 100MG” and “TESTEX PROLONGATUM 250MG”. All the UK invoices are addressed to Galenic Laboratories Limited. Annexes E and F contain official documentation concerning authorisation for the importation of the goods from Spain into the UK. They show the use of the same terms for the products as can be seen on the invoices.

18. The applicant submits that the evidence is insufficient to show that the mark has genuinely been used. In particular, it notes that there are no exhibits showing the mark in connection with the goods. It is true that there are no images of the products, but Mr Catoni has included a screenshot from Desma’s website dated 19 April 2021 listing TESTEX 25MG as an available product.⁶ It is also relevant to note that, in the UK at least, these were products that had not been licensed by the Medicines and Healthcare Products Regulatory Agency and so permission for their importation appears to have needed to have been sought for each consignment of goods.⁷ The absence of UK-focused advertising material is therefore unsurprising.

19. Nevertheless, I accept on the basis of the sales figures, invoices and the import documents that a genuine effort was made to create and maintain a market for the pharmaceutical preparations sold under the mark within the EU before IP completion day and in the UK thereafter and that this use was made by Desma with the consent

⁵ Annexes B and C.

⁶ Witness statement, paragraph 19.

⁷ See Annex F.

of the opponent. I consider that the use in Spain and the UK up to 31 December 2020 is sufficient to constitute use in the territory of the EU. The courts have held that it is not impossible that use in a single Member State might be sufficient: see *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, paragraphs [36] and [50]. Both Spain and the UK are (or, in the case of the UK, were) among the larger Member States of the EU and there is a pattern of increasing sales over the whole period.

20. I am satisfied that use of “TESTEX PROLONGATUM” is also genuine use of the earlier mark. The Court of Justice of the European Union (“CJEU”) stated in *Colloseum Holdings AG v Levi Strauss & Co*, Case C-12/12 at paragraphs [32]-[36] that use of a mark encompasses use of that with, or as part of, another mark, so long as it continued to be perceived as indicative of the origin of the goods or services at issue. In my view, “TESTEX” has an independent distinctive role in the variant “TESTEX PROLONGATUM” and so passes the test set out in *Colloseum*.

21. The opponent submits that it has shown proof for *Dietetic substances adapted for medical use* because

“testosterone propionate is an injectible [sic] ingestible substance which is used to improve testosterone levels in the receiver as detailed in the Opponent’s Witness Statement. As dietetics is the science of how nutrition affects our health and testosterone is impacted by nutrition, testosterone propionate is a dietetic substance adapted for medical use as it is a substance designed to tackle low levels of testosterone, which can result from poor nutrition.”⁸

22. I agree that dietetics is the science of how nutrition affects health. In my understanding, therefore, a dietetic substance adapted for the purpose of tackling low levels of testosterone would be a foodstuff, beverage or food supplement that had been created or modified to contain a particular combination of vitamins, minerals, proteins and so on, in order to raise levels of testosterone. The applicant’s evidence shows that that is not what testosterone propionate is. Rather, it is a derivative of

⁸ Written submissions of the opponent, paragraph 15.

testosterone and has no nutritional purpose. I find that use has not been shown for *Dietetic substances adapted for medical use*.

23. I have found that the opponent has shown use in relation to a single range of pharmaceutical products. I must therefore determine what would be a fair specification. The applicant invites me to find that the opponent can only rely on *Pharmaceuticals namely testosterone propionate*. In *Euro Gida Sanayi ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, at [10]-[11], Mr Geoffrey Hobbs QC, sitting as the Appointed Person, summed up the law as follows:

“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.”

24. In *Property Renaissance t/a Titanic Spa v Stanley Dock Hotel Ltd t/a Titanic Hotel Liverpool & Ors* [2016] EWHC 3103 (Ch), Carr J provided more detailed guidance at paragraph [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.”

25. I consider that it would not be fair for the opponent to be able to rely on a specification of *Pharmaceutical and veterinary preparations*. First, the products are not designed for use with animals, so I can immediately remove the veterinary preparations. Secondly, *Pharmaceutical preparations* is a very broad term, covering a wide range of different products for different medical purposes. The opponent has used the mark for a specific medication that is produced in three different strengths. That said, I do not think that the average consumer, whether they are a medical professional or a member of the public, would consider that “testosterone propionate” is a distinct subcategory. I have noted that the Wikipedia article adduced by the applicant in Exhibit

AM1 states that, although the drug is mainly used to treat low testosterone levels, it has also been used to treat breast cancer in women. There is a reference to a review article from 2005, but there is nothing in the evidence to suggest this is a common use of the drug. Consequently, in my view, a fair specification would be *Pharmaceutical preparations for the treatment of low levels of testosterone*.

Section 5(2)(b)

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

“A trade mark shall not be registered if because—

...

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

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

27. In considering the opposition, I am guided by the following principles, gleaned from the decisions of the CJEU 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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; and

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 goods

28. It is settled case law that I must make my comparison of the goods on the basis of all relevant factors. These include the nature of the goods, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296].

29. The goods to be compared are shown in the table below:

Contested goods	Earlier goods
<u><i>Class 5</i></u> <i>Protein supplements; protein dietary supplements; vitamins and vitamin preparations; vitamin drinks, drops, supplements and tablets; vitamin and mineral supplements and preparations; vitamin and mineral food supplements; meal replacement powders; nutritional supplement meal replacement bars for boosting energy; nutritional drink mix for use as a meal replacement; dietary supplements; dietary supplements containing CBD oil; food supplements consisting of</i>	<u><i>Class 5</i></u> <i>Pharmaceutical preparations for the treatment of low levels of testosterone.</i>

Contested goods	Earlier goods
<p><i>amino acids; edible fish oils for medical purposes; protein, vitamin, dietary, and nutritional supplements in powder, tablet, gel and drop form; protein, vitamin, dietary and nutritional supplements all being for the purpose of sports performance and enhancement, weight loss, weight gain and the improvement of health.</i></p>	
<p><u>Class 29</u> <i>Meat, fish, poultry and game; yoghurt and milk products; edible oils and fats; edible oils derived from fish; eggs; jellies and jams; wheys; milk shakes; protein and vitamin enriched milkshakes, yoghurts and milk based products.</i></p>	
<p><u>Class 32</u> <i>Non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other non-alcoholic preparations for making beverages; isotonic sports drinks; energy drinks; vitamin enriched drinks; energy drinks containing caffeine; whey beverages.</i></p>	

30. The purpose of the opponent's goods is to increase levels of testosterone. The users are most likely to be men, although I note from the applicant's evidence that they may also be used to treat symptoms of the menopause.⁹ The drugs may be supplied

⁹ Exhibit AM1, page 3.

in tablet or capsule form, as a gel or patch for use on the skin, or in a liquid form to be injected.¹⁰ They are likely to be obtained under prescription from a pharmacy.

31. Turning to the contested goods, I shall group them together where I deem this to be appropriate: see *SEPARODE Trade Mark*, BL O-399-10, paragraph [5].

Class 5

32. The first goods I shall consider are *Protein supplements; protein dietary supplements; food supplements consisting of amino acids; protein ... supplements in powder, tablet, gel and drop form; protein ... supplements all being for the purpose of sports performance and enhancement, weight loss, weight gain and the improvement of health*. These goods are used by people who wish to increase their protein intake in order to build or maintain muscle mass and keep their body functioning healthily. There may be some overlap in the users of the respective goods. Anabolic steroids, such as the opponent's testosterone propionate, are sometimes used (without medical advice) to increase muscle mass.¹¹ In practice, therefore, there is likely to be some overlap in the purpose for which the goods are used. I consider that there will also be some overlap in nature and method of use, as the applicant's goods will mainly be in a form that can be taken orally. I have noted that the opponent's goods are generally available only on prescription, but the pharmacies from which the users would obtain those products would also sell the applicant's supplements. Any competition is likely to be at a low level. The goods are not complementary. Taking all these factors into account, I consider that there is a low degree of similarity between the goods.

33. The next group comprises *Vitamins and vitamin preparations; vitamin drinks, drops, supplements and tablets; vitamin and mineral supplements and preparations; vitamin and mineral food supplements; dietary supplements; dietary supplements containing CBD oil; vitamin, dietary, and nutritional supplements in powder, tablet, gel and drop form; ... vitamin, dietary and nutritional supplements all being for the purpose of sports performance and enhancement, weight loss, weight gain and the*

¹⁰ Exhibit AM1, pages 4-6.

¹¹ Exhibit AM2, page 14.

improvement of health. These encompass products that may be used for a wide variety of purposes, from improving general health to ameliorating specific conditions or problems. The applicant's evidence indicates that some of the side effects of low levels of testosterone include fatigue and depression, as well as low sex drive and erectile dysfunction.¹² An individual suffering from these symptoms might choose to take particular vitamin and mineral supplements or seek hormone treatment via a medical professional. In relation to the supplements designed to improve sports performance and enhancement, weight loss and weight gain, I consider that these goods may be used for the same purposes as the unsupervised use of anabolic steroids that I referred to in the previous paragraph. There is therefore a degree of competition between the goods. As with the previous comparison, I consider that the goods would be sold through some of the same outlets, and that there is an overlap in nature, method of use, purpose and user. The goods are not complementary. Overall, I consider that there is a low degree of similarity between the goods.

34. I have been given no specific submissions on the applicant's *meal replacement powders; nutritional supplement meal replacement bars for boosting energy; nutritional drink mix for use as a meal replacement*. I understand them to be used either by people seeking to lose weight or by people who struggle to eat normally, for example the frail and elderly. If there is any overlap in users between these goods and those of the opponent, it is likely to be very small. The purposes of the goods are different, as is their physical nature. The goods are not in competition, nor are they complementary. While I accept that the pharmacies from which the opponent's prescribed goods are obtained are also likely to sell these contested goods, this is not sufficient for me to find similarity between the goods.

35. The final goods are *Edible fish oils for medical purposes*. I have been provided with no information to tell me the medical purposes for which these goods might be efficacious. The goods come in the form of a liquid or a capsule containing the oil and are taken orally. The physical nature is therefore different from that of the opponent's goods. I cannot see that the goods are in competition or complementary. They may have a small overlap in users and be sold through some of the same trade channels,

¹² Exhibit AM3, page 19.

but taking account of all the factors I find that these similarities are not sufficient for me to find that overall the goods are similar.

Classes 29 and 32

36. These goods are foodstuffs and beverages. The opponent's submissions that these are similar to its own goods are predicated on the assumption that *Dietetic substances adapted for medical use* survived the proof of use assessment. It did not. I see no reason why there is any similarity between these goods and the opponent's *Pharmaceutical preparations for the treatment of low levels of testosterone*. The purpose, physical nature and trade channels are different, and the goods are not in competition or complementary. I accept that there will be some users in common and that the goods may all be consumed orally, but overall I find that the applicant's goods in Classes 29 and 32 are dissimilar to the opponent's goods.

Summary

37. Where there is no similarity between the goods, there can be no likelihood of confusion under section 5(2)(b) of the Act: see *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA at paragraph [49]. The opposition therefore fails in respect of all goods in Classes 29 and 32 and the following goods in Class 5:

Meal replacement powders; nutritional supplement meal replacement bars for boosting energy; nutritional drink mix for use as a meal replacement; edible fish oils for medical purposes.

Average consumer and the purchasing process

38. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik*, paragraph 26.

39. There are two types of average consumer for the opponent's goods: the medical professional and the end user, who is prescribed the drug. The courts have found that where the goods in question are medicinal or pharmaceutical products, both sets of average consumer would pay a high degree of attention: see *Olimp Laboratories sp. z o.o. v European Union Intellectual Property Office (EUIPO)*, Case T-817/19, paragraphs [39]-[42]. With respect to the applicant's goods, the average consumer is a member of the general public. As they will be purchasing the goods to improve their own health and wellbeing and will ingest them into their bodies, I consider that they will be paying an above average degree of attention during the purchasing process.

40. The purchasing process for both parties' goods will largely be visual, although the average consumer may also receive assistance from sales staff or pharmacists. The aural aspects of the mark will therefore also play a role in the purchasing process.

Comparison of marks

41. It is clear from *SABEL* (particularly paragraph [23]) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, artificially to dissect the 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 created by the marks: see *Bimbo*, paragraph [34].

42. The respective marks are shown below:

Contested mark	Earlier mark
TEST-X	TESTEX

43. Both marks are plain word marks. The earlier mark is a single word "TESTEX" and the overall impression of that mark lies in the word itself. The average consumer will,

in my view, perceive this as an invented word, although in the context of the goods on which the opponent may rely “TEST” is mildly allusive of testosterone. The contested mark is the word “TEST” followed by the letter “X” with these two parts separated by a hyphen. The overall impression of this mark lies in the combination of these elements with no part playing a dominant role.

44. The first four letters and the final letter of the marks are identical, with the only visual difference being the letter “E” or hyphen before the “X”. I find that the marks are visually highly similar.

45. Both marks would be pronounced as “TEST-EX” and so are aurally identical.

46. I noted that the average consumer would believe the earlier mark to be invented and, if it has a concept at all, it would lie in the mild allusion to testosterone. I agree with the applicant that the contested mark is most likely to bring to mind a test called X. Consequently, I find the marks to be conceptually dissimilar.

Distinctive character of the earlier mark

47. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive,

geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

48. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. I have found that “TESTEX” is an invented word, but that also that it is mildly allusive to testosterone, the increasing of which is the purpose of the opponent’s goods. Balancing these two factors, I find that the earlier mark has a medium degree of distinctive character.

49. The opponent has claimed that this distinctive character has been enhanced through use. However, while I was satisfied that the evidence was sufficient to show genuine use of the mark, it falls short of what would be required to show enhanced distinctive character. In particular, there is no evidence of how it has been marketed to the medical professionals who would take the decision on which pharmaceutical preparation to prescribe, or evidence that indicates the level of awareness among the relevant public.

Conclusions on likelihood of confusion

50. There is no arithmetical formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa. I keep in mind 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 they have in their mind.

51. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph [16].

52. I found the marks to be highly visually similar, aurally identical and conceptually dissimilar. I also found that both visual and aural aspects of the mark would play a role in the purchasing process. In *Ruiz-Picasso & Ors v EUIPO*, Case C-361/04, the CJEU said:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

53. In the judgment under appeal, the Court of First Instance had found that the sign “PICASSO” was particularly well known to the relevant public as being the name of the Spanish painter Pablo Picasso. It went on to say in paragraph [57] that the reputation of Picasso was such that, in the absence of evidence to the contrary, it was not plausible to conclude that the sign PICASSO as a trade mark for motor vehicles would override the name of the painter in the perception of the average consumer.

54. Where does this leave us with TESTEX and TEST-X? While I found that the average consumer was most likely to perceive the contested mark as meaning a test called X, I do not consider that the meaning is so clear and specific that it would be immediately grasped by the average consumer.

55. The marks are, in my view, so similar visually and aurally that the average consumer would mistake one for the other and be directly confused, even where the

goods are similar to only a low degree and the attention being paid is above average. In coming to this finding, I have been guided by the interdependency principle and also by the established case law that holds that the average consumer remembers marks only imperfectly.

56. The opposition succeeds under section 5(2)(b) in relation to those goods still in play.

OUTCOME

57. The opposition has been partially successful and, subject to a successful appeal, Application No. 3790454 will proceed to registration for the following goods:

Class 5

Meal replacement powders; nutritional supplement meal replacement bars for boosting energy; nutritional drink mix for use as a meal replacement; edible fish oils for medical purposes.

Class 29

Meat, fish, poultry and game; yoghurt and milk products; edible oils and fats; edible oils derived from fish; eggs; jellies and jams; wheys; milk shakes; protein and vitamin enriched milkshakes, yoghurts and milk based products.

Class 32

Non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other non-alcoholic preparations for making beverages; isotonic sports drinks; energy drinks; vitamin enriched drinks; energy drinks containing caffeine; whey beverages.

58. Registration is refused for the following goods:

Class 5

Protein supplements; protein dietary supplements; vitamins and vitamin preparations; vitamin drinks, drops, supplements and tablets; vitamin and mineral

supplements and preparations; vitamin and mineral food supplements; dietary supplements; dietary supplements containing CBD oil; food supplements consisting of amino acids; protein, vitamin, dietary, and nutritional supplements in powder, tablet, gel and drop form; protein, vitamin, dietary and nutritional supplements all being for the purpose of sports performance and enhancement, weight loss, weight gain and the improvement of health

COSTS

59. Both parties have enjoyed some success in these proceedings, with the greater part going to the applicant. In the circumstances, I consider that it is fair to award the applicant a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 2/2016, reduced by a third to reflect the relative share of success. The award is calculated as follows:

<i>Preparing a statement and considering the other side's statement</i>	<i>£140</i>
<i>Preparing evidence and considering and commenting on the other side's evidence</i>	<i>£500</i>
<i>Preparation of written submissions in lieu of a hearing</i>	<i>£200</i>
TOTAL	£840

60. I therefore order Laboratorio Farmaceutico S.I.T. Specialità Igienico Terapeutiche s.r.l. to pay Applied Nutrition Limited the sum of £840. This sum should be paid within 21 days of the expiry of the appeal period or, if there is no appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 8th day of September 2023

Clare Boucher

For the Registrar,

Comptroller-General