O/1078/23

TRADE MARKS ACT 1994

AND IN THE MATTER OF REGISTRATION NO. UK00801096246

IN THE NAME OF NOVA LABORATORIES LTD

FOR THE FOLLOWING TRADE MARK:

Nova

IN CLASSES 5, 10 AND 42

AND AN APPLICATION FOR REVOCATION THERETO

UNDER NO. 505110

BY FISHER & PAYKEL HEALTHCARE LIMITED

BACKGROUND AND PLEADINGS

1. The trade mark shown on the cover page of this decision ("the Contested Mark") stands registered in the name of Nova Laboratories Ltd ("the proprietor"). The Contested Mark was filed on 22 September 2011 and registered on 05 September 2013 and claims a priority date of 23 March 2011. The Contested Mark stands registered for the following goods and services:

> **Class 5:** *Pharmaceutical and veterinary compositions, preparations and products; vaccines for human and animal use; compositions for medicinal or veterinary use; compositions for medicinal or veterinary use comprising any biological and/or pharmaceutical ingredient; sanitary preparations for medical purposes; plasters, materials for dressings; parts and fittings for all the aforesaid goods; except pharmaceutical preparations for dermatology and medical products for dermatology.*
>
> **Class 10:** *Apparatus for use in the delivery of pharmaceutical materials and drugs; syringes and injectors for medical purposes; filled syringes; injectors and delivery devices for medical purposes containing pharmaceuticals; surgical, medical, dental and veterinary apparatus and instruments; suture materials; parts and fittings for all the aforesaid goods.*
>
> **Class 42:** *Process and formulation development; QC testing; engineering support services; labelling services; logistics services; non-sterile and aseptic production services; vial/ampoule filling and syringe filling services; spray drying services; lyophilisation; emulsion manufacturing; medical device assembly services; live biologics; information, advisory and consultancy services in relation to all the aforesaid services.*

2. On 12 July 2022, FISHER & PAYKEL HEALTHCARE LIMITED ("the applicant") sought revocation of the Contested Mark on the grounds of non-use. Under Section 46(1)(a) of the Trade Marks Act 1994 ("the Act") the applicant claims non-use in the five-year period following the date on which the Contested Mark was registered, i.e. 06 September 2013 to 05 September 2018, with an effective date of revocation of 6

September 2018. Under Section 46(1)(b) of the Act, the applicant claims non-use in respect of the Contested Mark for the period between 12 July 2017 to 11 July 2022, with an effective date of revocation of 12 July 2022 being the date of the application at issue.

3. The proprietor filed a counterstatement defending its registration in respect of all of the goods and services covered by it.

4. The proprietor is represented by Serjeants LLP, and the applicant is represented by Forresters IP LLP.

5. Only the proprietor filed evidence. The applicant filed written submissions during the evidence rounds. Neither party requested a hearing, but they both filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

6. The proprietor filed evidence-in-chief in the form of the witness statement of Roger Staniforth dated 16 January 2023, which is accompanied by 5 exhibits marked RS1-RS5. Mr Staniforth is Head of Group Finance and Company Secretary of the proprietor's company.

7. The applicant filed written submissions during the evidence rounds dated 2 June 2023.

RELEVANCE OF EU LAW

8. 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.

DECISION

9. Section 46 of the Act is relevant to the revocation proceedings which states:

> "46. - (1) The registration of a trade mark may be revoked on any of the following grounds-
>
> (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
>
> (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
>
> (c) […]
>
> (d) […]
>
> (2) For the purpose of subsection (1) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
>
> (3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as 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) […]

(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".

10. As the Contested Mark is a comparable mark, the proprietor can rely upon use of the mark in the EU for any and all parts of the relevant periods which fall prior to IP Completion Day (i.e. 31 December 2020) pursuant to paragraphs 7 and 8 of Part 1, Schedule 2A of the Act.

11. 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."

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

"114. […] The CJEU has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV*

[2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

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

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

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or

services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

13. Proven use of a mark which fails to establish that "*the commercial exploitation of the mark is real"* because the use would not be *"viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark"* is not, therefore, genuine use.

14. As noted above, the relevant periods are 06 September 2013 to 05 September 2018 ("the first relevant period") and 12 July 2017 to 11 July 2022 ("the second relevant period").

15. Mr Staniforth claims that the mark is in use and has been in use throughout the relevant periods. In support of his statement, he provides the following:

- **Exhibit RS1:** this exhibit contains slides from what Mr Staniforth describes as *"various seminars and presentations that [the proprietor] [has] done over the years".* Mr Staniforth simply points out that *"all the slides contain the NOVA mark as standard and have done since [the proprietor] first registered the mark"* and states *"this is the house style that we use on all external documents".* The slides are undated, and no information is provided about when the slides were used, to whom they were presented and whether the presentations which were allegedly carried out resulted in any contract, or in the proprietor receiving any order for the supply of the registered goods and services. Mr Staniforth provides no narrative, commentary or description of any slide, but the following information can be extrapolated from the slides:

1. The proprietor's company was established in 1994 by ex-NHS professionals. The initial focus was *"to supply sterile and non-sterile compounded medicines ('specials')".* The business later *"diversified into manufacture of aseptically filled or assembled medicinal products (using gassed isolator technology), and later bone cement".* In order to achieve this, a wide range of isolators were purpose-built to aseptically manufacture clinical and commercial products;

2. The proprietor's company employed 175 members of staff, including 84 in production (with 18 clinical trial production staff and 38 bone cement operatives), 25 in quality control, 16 in quality assurance, 14 in logistics, 24 in development, technical and engineering support and 12 in administration and finance;

3. One of the slides is headed *"What makes us different"* and states under three bullet points: (i) *"Diverse manufacturing capabilities: non-sterile, sterile, contract and commercial manufacture, licensed products",* (ii) *"Full service capability: aseptic assembly and packaging all under one roof"* and (iii) "*Pioneer in novel technologies: Aseptic spray drying"* – this is described in another slide as aseptic spray drying for production of sterile, injectable material, suitable for human use - "*World's first fully validated cGMP facility"* and "*Patented drug delivery and stabilisation technology available to clients"*;

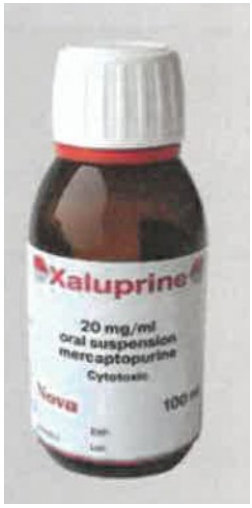
4. The proprietor's facilities included 6 buildings (A, B, C, D, E, F) organised as follows: (A) one building for sterile and non-sterile specials, labs for analytical and microbiology, and warehousing; (B) one building for cytotoxic facility; (C) one building for live biologics; (D) one bone cement facility; (E) one sampling area and (F) a spray dry facility;

5. The proprietor had a number of licenses including commercial manufacturing licence (MIA) since 1996 and an investigational medicinal product license (IMP) since 2004;

6. One of the slides includes a chart showing that the proprietor's business was split in the following areas: 36% bone cement, 25% sterile and contract manufacturing, 18% non-sterile manufacturing, 12% licensed products and 9% others;

7. A slide headed *"Non-sterile manufacturing*" states under various bullet points that this area "*originated from within the NHS, now supplying all UK & Ireland*", it "*shares NHS ethos and values", "all products are manufactured in-house"* and there are *"over 10,000 formulations".* The slide also displays a UK email address for contact at sale@novalabs.co.uk.

8. One of the slides contains an example of a licensed product, which display the trade mark NOVA, as shown below:



The slide explains that Xaluprine is *"Nova's first licensed product, developed from one of [their] existing 'specials' products*" and used to treat lymphoblastic leukaemia. The product has a 10-year EU license, and the slides refers the proprietor having recently filed an application to the FDA (which I understand is The United States Food and Drug Administration agency). Another slide states that the product was launched in 2012 in the UK and Ireland;

9. Under the heading "*what we offer"* a slide lists *"thermo-stable, ready to use formulations"* and "*Full-service capability: drug delivery devices filled and assembled at our cGMP sterile manufacturing unit".* Another slide refers to the proprietor using a hypodermic rehydration injection system for the delivery of drugs and vaccine as shown below:

- Product mixed with sugars to form glass sheaths
- Glass sheaths dried onto a proprietary fibrous membrane encased within custom-designed housing with ports at either end
- Standard needle and syringe attached to ports allowing device to be flooded and vaccine/drug product reconstituted before being injected into patient
- Rehydration and delivery of drug/vaccine achieved in a single action

Nova Laboratories Ltd

10. Another slide reproduces an extract from an article publish on Chemistry World in 2013 which refers to the proprietor being a UK formulation company, as shown below:

"Half the vaccines in the world are destroyed because they haven't been stored properly", says Sam de Costa from Nova Laboratories, a UK formulation company. *"What we are trying to do is make products that can be stored at ambient temperature anywhere in the world".*

Nova has developed a way to store desiccated products protected by a mixture of amorphous, glassy sugars. It works by drying a mixture of the active ingredient and the sugar blend onto a filter paper-like membrane, which is then packaged in a plastic case with ports for a needle and syringe. As the liquid from the syringe floods the device, it reconstitutes the dried material and can then be injected directly into the patient.

CHEMISTRY WORLD
April 2013

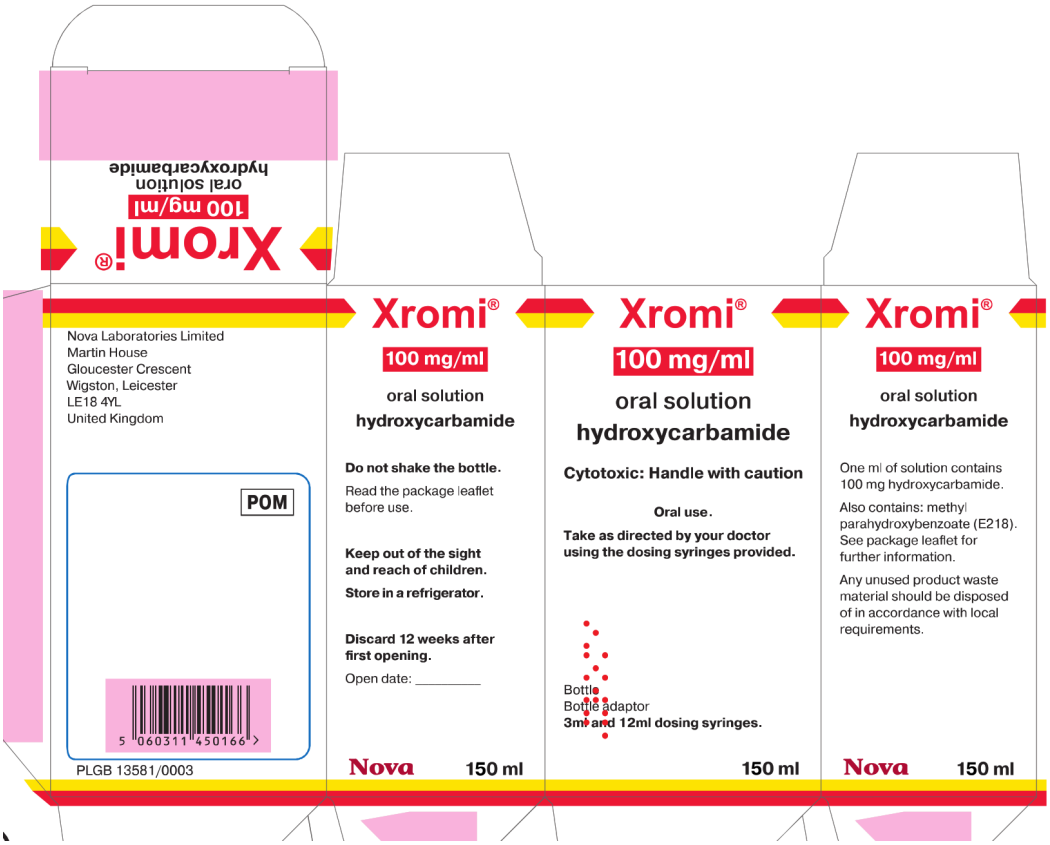
11. One of the slides explains that "*Specials manufacture"* includes a *"wide range of pharmaceutical dosage forms with over 10,000 formulations, including solutions and suspensions, creams, capsules, suppositories, cytotoxic products and pre-filled syringes;*

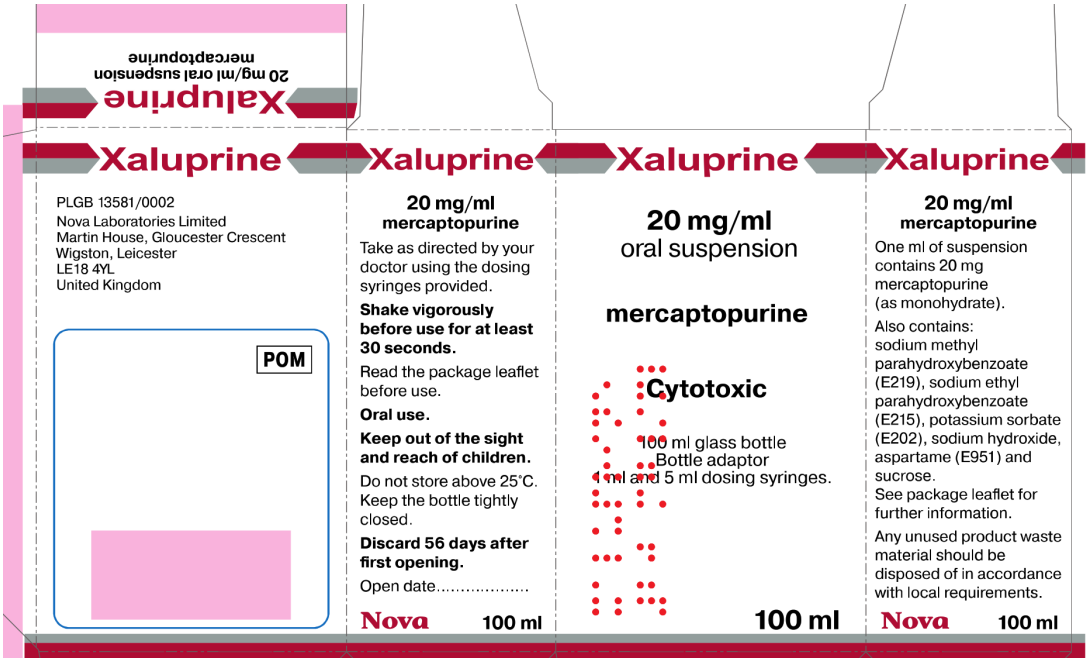
- **Exhibit RS2:** this exhibit contains examples (undated) of the letter heads that the proprietor uses on all documents, as shown below:

Nova
Laboratories Ltd

Nova
Laboratories Ireland Ltd

- **Exhibit RS3:** this exhibit shows use of the mark 'Nova' on packaging that Mr Staniforth says is supplied to customers throughout the UK (shown below). The dates of the packaging vary between October and November 2020 (i.e. within the second relevant period). The packaging relates to pharmaceutical products sold under various names (or trade marks) all of which display the trade mark 'Nova' on the packaging, including the following: (i) an oral solution containing hydroxycarbamide sold under the sign 'Xromi' – the label says that the relevant market is the UK; (ii) an oral suspension containing mercaptopurine monohydrated sold under the sign 'Allmercap' - the label says that the relevant market is Australia and New Zealand; (iii) an oral suspension containing mercaptopurine sold under the sign 'Xaluprine' – the label says that relevant market is the UK; (iv) an oral suspension containing mercaptopurine sold under the sign 'Purixan' - the label says that the relevant market is the USA:


Xromi®
100 mg/ml
oral solution
hydroxycarbamide
Nova Laboratories Limited
Martin House
Gloucester Crescent
Wigston, Leicester
LE18 4YL
United Kingdom
POM
PLGB 13581/0003
Xromi®
100 mg/ml
oral solution
hydroxycarbamide
Do not shake the bottle.
Read the package leaflet before use.
Keep out of the sight and reach of children.
Store in a refrigerator.
Discard 12 weeks after first opening.
Open date: _____
Nova
150 ml
Xromi®
100 mg/ml
oral solution
hydroxycarbamide
Cytotoxic: Handle with caution
Oral use.
Take as directed by your doctor using the dosing syringes provided.
Bottle
Bottle adaptor
3ml and 12ml dosing syringes.
150 ml
Xromi®
100 mg/ml
oral solution
hydroxycarbamide
One ml of solution contains 100 mg hydroxycarbamide.
Also contains: methyl parahydroxybenzoate (E218). See package leaflet for further information.
Any unused product waste material should be disposed of in accordance with local requirements.
Nova
150 ml


Xaluprine
20 mg/ml oral suspension
mercaptopurine
PLGB 13581/0002
Nova Laboratories Limited
Martin House, Gloucester Crescent
Wigston, Leicester
LE18 4YL
United Kingdom
POM
Xaluprine
20 mg/ml
mercaptopurine
Take as directed by your doctor using the dosing syringes provided.
Shake vigorously before use for at least 30 seconds.
Read the package leaflet before use.
Oral use.
Keep out of the sight and reach of children.
Do not store above 25°C. Keep the bottle tightly closed.
Discard 56 days after first opening.
Open date.....
Nova
100 ml
Xaluprine
20 mg/ml
oral suspension
mercaptopurine
Cytotoxic
100 ml glass bottle
Bottle adaptor
1 ml and 5 ml dosing syringes.
100 ml
Xaluprine
20 mg/ml
mercaptopurine
One ml of suspension contains 20 mg mercaptopurine (as monohydrate).
Also contains: sodium methyl parahydroxybenzoate (E219), sodium ethyl parahydroxybenzoate (E215), potassium sorbate (E202), sodium hydroxide, aspartame (E951) and sucrose.
See package leaflet for further information.
Any unused product waste material should be disposed of in accordance with local requirements.
Nova
100 ml

Notably, the examples of packaging states "*Manufactured by Nova Laboratories Ltd, Leicester LE18 4YLT"* which is the name and address of the proprietor's company;

- **Exhibit RS4:** this exhibit shows extracts from the proprietor's website www.novalabs.co.uk acquired from the internet archive facility, the Wayback Machine, and dated between April 2009 and November 2020, all showing the mark 'Nova' on the top right-hand corner of the website as shown below:

Nova
Laboratories Ltd

The webpages dated 2009-2014, 2016 and 2019 show for each year the following text *"Nova Laboratories is one of the UK's leading independent suppliers of both 'Specials' and clinical trial medicines to healthcare professionals"* with the ones dated 2009-2012 also supplying the following information:

1. The webpages from 2009-2012 state that for over 10 years Nova Labs (i.e. the proprietor) has been *"at the forefront of developing the use of*

gassed isolator technology and in partnership with its clients has utilised the technology for a wide range of novel applications" and that *"it has the capacity to provide Aseptic processing services for both clinical trial materials and commercial supplies as well as fill finish contract services for Proteins, Peptides, Antibodies and Plasmids amongst others, including medical devices. It also has fully validated, dedicated and separate facilities for Aseptic Spray Drying and the fill finish of live biologics".* The same webpages refer to the proprietor employing 140 (April 2009) and 150 (November 2010, July 2011 and August 2012) highly qualified staff. They also contain a number of posts outlining the proprietor's achievements including:

1a. 27/11/2008: Nova signed a new contract worth in excess of 10 million;

1b. 21/09/2010: Nova Laboratories was pleased to be asked to contribute to a BBC investigation into the raising costs of specials within the NHS;

1c. 4/05/2011: When Leicester Royal Infirmary were looking for a company to supply materials for the ground-breaking clinical trial into the treatment of bowel disease, they turned to Nova;

1d. 20/07/2012: Xaluprine a liquid form of leukaemia drug will be distributed to hospital pharmacies across Europe after being granted an exclusive license as an 'orphan' product by the EU.

- **Exhibit RS5:** this exhibit contains invoices/quotations featuring the Contested Mark in the same form as that shown above, i.e. in red with the words "Laboratories Ltd" underneath it. Some of the details on the invoices/quotations are redacted, but at the least the following can be established:

1. On 28 November 2002 (before the relevant periods) the proprietor issued a sale invoice to a medical company based in Limerick (Ireland) for 2,066 items of [details redacted] for a total of GBP [details redacted];

2. On 20 July 2022 (after the relevant periods) the proprietor issued a sale invoice to the same medical company based in Limerick for 5,739 items of [details redacted] for a total of GBP [details redacted];

3. On 24 September 2018 (within the second relevant period) the proprietor issued an invoice to Martin House Properties Ltd at Martin House, Gloucester Crescent, Wigston Leicester LE18 4YL for *"rent for Bedford Road"* for two periods in 2018. As the proprietor's address is Martin House, Gloucester Crescent, Wigston Leicester LE18 4YL, this seems to be an invoice for rent paid by the proprietor for the rental of premises located on a different road;

4. On 26 July 2022 (after the relevant periods) the proprietor issued a sale invoice to the pharmacy department (NHS) of Alder Hey Children Hospital in Liverpool for the following: (i) 3, Acetazolamide Suspension 250mg/5, unit of measure 200 (reported twice), (ii) 14, Xromi oral solution 100mg/1ml, unit of measure 150 (refrigerated item), and (iii) 1, Xromi Coolbox charge, for a total of GBP [details redacted]. Admittedly, by redacting all the pricing data in relation to the products sold, it is not easy to understand the number of goods sold, because the invoice contains two numbers, one referring to the "quantity" and one referring to the "unit of measure" as shown below:

No.	Batch No.	Description	Shipment Date	Quantity	Unit of Measure	Unit Price	VAT Identifier	Amount
G002893	SCPK3932	Acetazolamide Susp 250mg/5	26/07/22	3	200	[redacted]	STANDARD	[redacted]
G002893	SCPK3933	Acetazolamide Susp 250mg/5	26/07/22	3	200	[redacted]	STANDARD	[redacted]
0001308	1308PK122	Xromi 100mg/1mL Oral Solutio REFRIGERATED ITEM	26/07/22	14	150	[redacted]	STANDARD	[redacted]
		Xromi Coolbox charge	26/07/22	1		[redacted]	STANDARD	[redacted]
							Total GBP Excl. VAT	[redacted]
							20% VAT	[redacted]
							Total GBP Incl. VAT	[redacted]

It is unclear whether the proprietor sold 3 big boxes each containing 200 products, or 200 small boxes each containing 3 products, but in any event the total would be the same, that is to say 600 products. Given that there are two batches of the same product, I conclude that this invoice demonstrates sale of 1,200 units of Acetazolamide Suspension 250mg/5. The same goes for the other product on the invoice, and I conclude that this invoice demonstrates sale of 2,100 units of Xromi oral solution 100mg/1ml.

5. On 30 July 2021 (within the second relevant period) the proprietor issued a sale invoice to the pharmacy department (NHS) of Great Ormond Street Hospital in London, for the following: 8, Xaluprine 200mg, unit of measure 100, for a total of GBP [details redacted]. Applying the same method I have adopted above, that would amount to 800 units sold;

6. On 3 July 2017 (within the first relevant period) the proprietor issued a sale invoice to the pharmacy department (NHS) of Royal Victoria Infirmary Dispensary in Newcastle for the following: 2, sucralfate suspension 1gr/5mg, unit of measure 250, for a total of GBP [details redacted]. Applying the same method, I have adopted above, that would amount to 500 units sold;

7. On 31 July 2012 (before the relevant periods) the proprietor issued a sale invoice to the pharmacy department (NHS) of the Royal Oldham Hospital in Lancashire for the following: 100, morphine syringe 50mg/50ml, unit of measure 1, for a total of GBP [details redacted]. Applying the same method, I have adopted above, that would amount to 100 units sold;

16. The exhibit also contains the following quotations: (i) a quotation dated 28 August 2012 (before the relevant periods) to a customer in Cambridge [details redacted] for: *"Sterile Fill and Finish (8 Gloves Isolator)" - "Sphere Cal Solution 1 up to 2,400 x 10 ml vials" - "Sphere Cal Solution 2 up to 2,400 x 10 ml vials"*; (ii) a quotation, undated - safe for the quotation reference number which

incorporates the date 1 November 2012 (before the relevant periods) - with no customer details for *"Immune Targeting System- Sterile Fill and Finish (8 Gloves Isolator)" - "L-Histidine Formulation, Fill and Finish – Up to 4,000 x 2 ml vials"*; (iii) a quotation, undated, to a customer in Staffordshire [details redacted] for various services, including decontamination study to demonstrate virus inactivation, provision including automated vial filler, and commercial manufacturing of batches of products.

Assessment

Form of the mark

17. The applicant argues that some of the exhibits do not display the Contested Mark and show the names of companies such as Nova Laboratories Ireland Ltd whose connection to the proprietor (i.e. Nova Laboratories Ltd) has not been explained. I do not think there is anything in these criticisms. There are plenty of examples of use of the Contested Mark throughout the evidence, and the mark appears to be used consistently on the invoices and quotations, on the website, on an email address and on packaging. Although the mark appears mostly in red and with the words Laboratories Ltd underneath it, neither the addition of the colour nor the use in conjunction with descriptive words (which are part of the proprietor's company name) alter the distinctiveness of the mark, and I consider that those uses are acceptable variants of the Contested Mark as registered.[1]

18. The applicant also argues that use of the Contested Mark on packaging for products sold under other brand names such as Xromi, Allmercap, Xaluprine and Purixin denotes the entity which manufactured the product, and it is not use as a trade mark in respect of the product itself. I disagree. All medicines have the name of the medicine displayed on the labelling and in this case the words Xromi, Allmercap, Xaluprine and Purixin identify the names of the medicines. Whether the proprietor had also registered these names as trade marks is irrelevant. Further, the argument that the Contested Mark used in relation to medicines marketed under other names is not

[1] *Lactalis McLelland Limited v Arla Foods AMBA,* BL O/265/22

use as a trade mark is mistaken because: (a) it contradicts the applicant's own argument that the contested mark will be understood as denoting the manufacturer of the goods - if a sign is used to denote the manufacturer of the goods, it also denotes the origin of the goods and denoting origin is the primary purpose of trade marks and (b) there is clear case-law which indicate that use of one mark with, or as part of, another mark, counts towards genuine use[2] if the mark continues to be perceived as indicative of the origin of the product, such as in this case.

Genuine use

19. Whilst the evidence is scant, I think it just suffices to allow me to find that the proprietor is an established UK formulation company which has been trading continuously under the brand 'Nova' since at least the date the contested mark was registered on 5 September 2013. But in fact, the evidence goes even further than that, showing as it does that the proprietor was established in 1994 and that it had a fully working website targeting the UK since at least 2009.

20. Admittedly, there are no turnover and/or marketing figures which I would expect any proprietor defending a revocation for non-use (as I would expect the proprietor in this case) to file. The absence of such information is particularly surprising given that the evidence as a whole paints a picture of a sizeable business which employed between 150 and 175 members of staff (at least in the years between 2009 and 2013) and had 70,200 square feet (ft²) of operational units comprising laboratories, warehousing, a cytotoxic facility, a live biologics facility, a bone cement facility, a sampling area and a spray dry facility.

21. It is true that these facts were not provided in the form of a narrative within Mr Staniforth's witness statement but were contained in the exhibits he introduced. However, insofar as these facts were provided, they were within exhibited documentation identified by Mr Staniforth, and I do not consider that there is any reason for me to disbelieve the accuracy and truth of the information contained within

[2] Colloseum Holdings AG v Levi Strauss & Co., Case C-12/12

the exhibits, especially given that the witness statement introducing them was accompanied by a sworn statement of truth.

22. Whilst some of the facts that it is reasonable and proportionate to expect to be provided by way of narrative are absent from the witness statement – such as, for example, a background history of the proprietor's company and a description and explanation of the proprietor's business – they are before me by way of exhibits, which means that they are in evidence properly adduced during the course of the evidence rounds. The fact that they have not been discussed in the witness statement does not mean to say that I should disregard them. Further, in order to decide whether there has been genuine use of a trade mark it is necessary to consider the evidence as a whole, piecing together the evidence from the witness statements and the exhibits. This is not an exercise of running through information on exhibits to see whether they are present in, or absent from, the witness statement. The aim of the assessment is to paint a picture from the information contained in the witness statement and in the exhibits which can only be appreciated by standing back and making an appreciation of the whole. Consequently, I will approach the evidence as a whole, using the information from both the exhibits and the witness statement, insofar as there is no inconsistency.

23. Undoubtedly, the slides provide a better overview of the proprietor's business than Mr Staniforth's witness statement. The applicant did not challenge the content of the slides and whilst criticising the limits of this evidence – in the sense that it does not say when the slides were used and to whom they were presented – the applicant accepted that they "*simply indicate the capabilities of the proprietor".*

24. Although the slides are undated, some report that the last "*MHRA compliance audit was performed in 2013"* with the outcome being *"no critical findings with risk rating III"* and that there was a *"FDA Inspection expected during 2013*", from which it is can be conclude that the slides were dated between the beginning and the end of 2013. This means that by 2013, i.e. the start of the first relevant period, the proprietor was an established business with 70,200 square feet (ft^2) of operational units, 175 members of staff, a fully working website targeting the UK (www.novalabs.co.uk), a UK telephone contact and a dedicated UK email address for sales (sale@novalabs.co.uk).

25. The slides also indicate that prior to 2013 the proprietor had obtained an EU license for a pharmaceutical product named Xaluprine which was launched in 2012 and distributed to hospital pharmacies in the UK and the EU. Further, the slides mention that in 2013, 12% of the proprietor's business related to the manufacture of licensed products, that the proprietor supplied the NHS and that its products included approximately 10,000 formulations. The evidence also indicates that after 2013 the business kept going, showing updated pages from the proprietor's website as well as examples of packaging dated from 2020, including of the product launched in 2012.

26. That is all well and good, and the proprietor has probably sold more than what is shown by the invoices during the relevant periods, given that it supplies the NHS and describes itself as *"one of the UK's leading independent suppliers of both 'Specials' and clinical trial medicines to healthcare professionals"* on its website. However, that does not help the proprietor here because I cannot assume things the proprietor has not established by way of evidence. For example, I cannot assume that throughout the relevant periods, the proprietor's business stayed exactly the same size as it was in 2013 in terms of staff and operational units; or having made that assumption, I cannot further assume that that size necessarily resulted in a significant volume of sales; or having made that assumption, I cannot further assume that most of the assumed sales were made in the UK (rather than, for example, in the USA or other non-EU countries).

27. The invoices show the following sales within the relevant periods:

- On 30 July 2021 (within the second relevant period) the proprietor sold 800 units of Xaluprine 200mg to the pharmacy department (NHS) of Great Ormond Street Hospital in London;

- On 3 July 2017 (within the first relevant period) the proprietor sold 500 units of sucralfate suspension to the pharmacy department (NHS) of Royal Victoria Infirmary Dispensary in Newcastle.

28. In *Naazneen Investments Ltd v OHIM*, Case T-250/13, the General Court ("GC") upheld a decision by the OHIM Board of Appeal that the sale of EUR 800 worth of

non-alcoholic beverages under a mark over a 5 year period, which had been accepted was not purely to maintain the trade mark registration, was insufficient, in the economic sector concerned, for the purposes of maintaining or creating market share for the goods covered by that Community trade mark. The use was therefore not genuine use. The relevant part of the judgment of the GC is as follows:

> "46. In the fifth place, the applicant argues that, in accordance with the case-law cited in paragraph 25 above, use of a trade mark is to be regarded as token if its sole purpose is to preserve the rights conferred by the registration of the mark. It claims that the Board of Appeal contradicted itself by stating, on the one hand, in paragraph 31 of the contested decision, that the total amount of transactions over the relevant period seemed to be token, and by stating, on the other hand, in paragraph 42 of the contested decision, that it did not doubt the intention of the proprietor of the mark at issue to make real use of that mark in relation to the goods in question.
>
> 47. In this connection, suffice it to point out that the applicant's argument is based on an incorrect reading of the contested decision. The Board of Appeal used the term 'token' to describe the total amount of transactions, approximately EUR 800, and not to categorise the use of the mark at issue.
>
> 48. In the sixth place, the applicant claims that the Board of Appeal, by relying solely on the insufficient use made of the mark at issue, did not comply with the case-law according to which there is no quantitative threshold, determined a priori and in the abstract, that must be chosen in order to determine whether use is genuine. The Board of Appeal also failed to comply with the case-law according to which even minimal use may be sufficient in order to be deemed genuine.
>
> 49. According to the case-law, the turnover achieved and the volume of sales of the goods under the mark at issue cannot be assessed in absolute terms but must be assessed in relation to other relevant factors, such as the volume of commercial activity, the production or marketing capacities or the degree of diversification of the undertaking using the trade mark and the characteristics of

the goods or services on the relevant market. As a result, use of the mark at issue need not always be quantitatively significant in order to be deemed genuine (see, to that effect, judgments in *VITAFRUIT*, cited in paragraph 25 above, EU:T:2004:225, paragraph 42, and *HIPOVITON*, cited in paragraph 27 above, EU:T:2004:223, paragraph 36). Even minimal use can therefore be sufficient in order to be deemed genuine, provided that it is warranted, in the economic sector concerned, to maintain or create market shares for the goods or services protected by the mark. Consequently, it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine. A de minimis rule, which would not allow OHIM or, on appeal, the General Court, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order of 27 January 2004 in *La Mer Technology*, C-259/02, ECR, EU:C:2004:50, paragraphs 25 and 27, and judgment of 11 May 2006 in *Sunrider* v *OHIM*, C-416/04 P, ECR, EU:C:2006:310, paragraph 72).

50. In the present case, contrary to what the applicant claims, the Board of Appeal did not determine a minimum threshold ‘a priori and in the abstract’ so as to determine whether the use was genuine. In accordance with the case-law, it examined the volume of sales of the goods in question in relation to other factors, namely the economic sector concerned and the nature of the goods in question.
51. The Board of Appeal accordingly took the view that the market for the goods in question was of a significant size (paragraph 28 of the contested decision). It found also that the goods in question, namely non-alcoholic beverages, were for everyday use, were sold at a very reasonable price and that they were not expensive, luxury goods sold in limited numbers on a narrow market (paragraph 29 of the contested decision). Furthermore, it took the view that the total amount of transactions over the relevant period, an amount of EUR 800, seemed to be so token as to suggest, in the absence of supporting documents or convincing explanations to demonstrate otherwise, that use of the mark at issue could not be regarded as sufficient, in the economic sector concerned, for the purposes of maintaining or creating market shares for the goods covered by that mark (paragraph 31 of the contested decision).

52. It is therefore apparent, contrary to what the applicant claims, that it was in accordance with the case-law cited in paragraph 49 above that the Board of Appeal took the view that, in the present case, minimal use was not sufficient to be deemed genuine."

29. As it can be seen, whilst the GC upheld the finding that the sale of EUR 800 worth of non-alcoholic beverages was insufficient to establish genuine use, significantly, it indicated that consideration must be given to other relevant factors, such as the volume of commercial activity, the production or marketing capacities or the degree of diversification of the undertaking using the trade mark and the characteristics of the goods or services on the relevant market. In other decisions, applying the same approach, despite there being low volumes of sales, other factors meant that the use was sufficient to constitute genuine use of the trade mark. In *Masterbuilders, Heiermann, Schmidtmann GbR v EUIPO*, T-76/21, for example, the GC held that relatively low sales volumes of timers and downloadable application software in class 9 were sufficient to be genuine use of the trade mark. Approximately 2,700 timers had been sold during the five-year period, some by the unit (with or without an accompanying book), the majority in crates of eight. There was also evidence that 970 items, totalling EUR 28,000, had been sold via an e-commerce platform in 23 Member States during the relevant period. Although this volume was not very significant, the goods were not everyday consumer goods and the sales volume had been achieved in the first few years of the goods being marketed. In addition, the sales covered a wide territory. The Court held that these factors offset the low volume of sales. In respect of downloadable application software, there had been 1,621 downloads of the software, 99% of which were in the EU. The Court said that the number of downloads was not particularly significant but not token either, and that it was sufficiently significant to demonstrate the frequency and territorial scope of the use of the mark at issue in the marketing of the application, particularly in circumstances where the application had been available for download for less than six months at the end of the relevant period. Although this case was decided after the end of the Brexit transition period and is not binding, it has persuasive value.

30. See also *Industria de Diseño Textil, SA (Inditex) v EUIPO*, T-467/20. In that case, the GC held that representative invoices showing sales of pasta in Italy totalling

something over €40,000 were sufficient to show genuine use in the EU, when taken together with marketing material and evidence of regular use over the relevant period.

31. As I have said earlier, having evaluated the overall effect of the various pieces of evidence, the sales figures established by the invoices, amounting to a total of 800 and 500 units of medicines during the second and first relevant period respectively, appear to be very low compared to the proprietor's capabilities and the continuity of the use established by the slides, the webpages, the sample of packaging, and the other invoices and quotations, which together cover the twenty-year period 2002-2022. The evidence also refers to the proprietor's products including 10,000 formulations and includes examples of labels for other medicine dated within the relevant periods, some of which appear to be for the UK market.

32. Crucially, I also regard as a factor in favour of the proprietor that the proprietor obtained an exclusive EU license for one of the products sold during the second relevant period, namely Xaluprine, which the slides describe as a drug used to treat acute lymphoblastic leukaemia. The first thing I would say, is that I would expect the process of obtaining an exclusive EU license for a pharmaceutical product used to treat a severe illness to have required a significant investment in terms of time and resources on the part of the proprietor who had to ensure that the medicine met the safety requirements necessary to obtain the approval to be marketed and made available to patients. Second, the evidence indicates that Xaluprine was first distributed in the UK and the EU in 2012 and shows that in 2021 the proprietor was still supplying the product to Great Ormond Street Hospital in London, one of the most reputable children's hospitals in the UK.

33. This leads me to the next step in the analysis, namely whether the fact that Xaluprine is effectively a medicine that is used to treat a serious (and rare) illness and is offered in a niche market for children's hospitals, overcome the low sale figures of 800 units sold during the second relevant period.

34. In accordance with the case-law referred to above, when assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real,

including in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of the goods or services at issue, and the characteristics of the market.

35. In this case, taking into account the characteristics of the market and of the goods in respect of which use has been proved, namely that they relate to a license medicine used in children hospitals, and are highly specialised goods for the healthcare industry which are part of a niche market for the treatment of a serious illness, I conclude that in the context of an overall assessment of the evidence and of the relevant factors, the proprietor has proved that the Contested Mark has been used in the UK during the second relevant period and that that use is sufficient to be deemed to be genuine use in the EU and the UK. Similar considerations apply in my view to the sale of 500 units of sucralfate suspension during the first relevant period.

Fair specification

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

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

37. 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 Pl*c [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."

38. Clearly, the proprietor has shown sales of at least two types of drugs during the relevant periods. One of the drugs sold was used to treat lymphoblastic leukaemia,

i.e. Xaluprine; in relation to the other one, I note that the current Collins English dictionary indicates that sucralfate is used to treat ulcers of the stomach and duodenum.

39. The proprietor has also produced examples of labels, dated within the second relevant period, for another drug called 'Xromi' destined for the UK market which is described as cytotoxic – this means that it is used in the treatment of the same illness as Xaluprine[3] - and has produced invoices demonstrating sale of this products after the relevant periods. Section 46(3) provides:

> "(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five-year period and before the application for revocation is made.
>
> Provided that any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made."

40. Here, the evidence of use which post-dates the expiry of the five-year period is dated within 3 months of the application date. Even if the sales which are outside the relevant periods cannot be factored in in terms of numbers, they corroborate the overall conclusion that there has been a genuine effort on the part of the proprietor to create or preserve an outlet for a variety of pharmaceutical products. I therefore consider that the proprietor can retain the term *pharmaceutical preparations*.

41. As regard the remaining goods and services, whilst the evidence indicates that the proprietor's business is reasonably diversified and covers other goods and services listed in the registered specification - for example, non-sterile and aseptic production services; vial/ampoule filling and syringe filling services; spray drying services - the

[3] Collins English dictionary

complete absence of evidence of any sale in relation to these goods and services, means that the proprietor has failed to establish genuine use in relation to them. Consequently, the Contested Mark will be revoked in relation to these goods and services from the earliest possible date, that being 6 September 2018.

42. It seems to me that overall, the proprietor and its legal representative have taken an altogether too casual approach to this case. Insofar as the mark will be revoked, whilst the outcome might not reflect the use actually made, it is the result of the evidence filed.

43. Consequently, I consider a fair specification to be:

> **Class 5:** *Pharmaceutical preparations*

CONCLUSION

44. The application for revocation of registration UK00801096246 fails in relation to *pharmaceutical preparations* in class 5, for which the mark will remain registered.

45. The application for revocation of registration UK00801096246 has succeeded in relation to the following goods and services. Subject to any successful appeal, the mark will be revoked for the following goods and services in respect of which it is registered, with an effective revocation date of 6 September 2018:

> ***Class 5:*** *Pharmaceutical and veterinary compositions, and products; veterinary preparations; vaccines for human and animal use; compositions for medicinal or veterinary use; compositions for medicinal or veterinary use comprising any biological and/or pharmaceutical ingredient; sanitary preparations for medical purposes; plasters, materials for dressings; parts and fittings for all the aforesaid goods; except pharmaceutical preparations for dermatology and medical products for dermatology.*
>
> **Class 10:** *Apparatus for use in the delivery of pharmaceutical materials and drugs; syringes and injectors for medical purposes; filled syringes; injectors and*

delivery devices for medical purposes containing pharmaceuticals; surgical, medical, dental and veterinary apparatus and instruments; suture materials; parts and fittings for all the aforesaid goods.

Class 42: *Process and formulation development; QC testing; engineering support services; labelling services; logistics services; non-sterile and aseptic production services; vial/ampoule filling and syringe filling services; spray drying services; lyophilisation; emulsion manufacturing; medical device assembly services; live biologics; information, advisory and consultancy services in relation to all the aforesaid services.*

COSTS

46. The applicant has enjoyed a greater degree of success and, consequently, is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I have borne the only partial success in mind. I award the applicant the sum of £2,000, calculated as follows:

Preparing the notice of cancellation and considering the proprietor's counterstatement: £400

Considering the proprietor's evidence: £1,000

Written submissions; £400

Official fee: £200

Total: £2,000

47. I therefore order Nova Laboratories Ltd to pay FISHER & PAYKEL HEALTHCARE LIMITED the sum of £2,000. 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 14th day of November 2023

Teresa Perks

For the Registrar