

**O/1121/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION UK00002576114**

**IN THE NAME OF NOVA BIO-PHARMA TECHNOLOGIES LIMITED**

**AND**

**APPLICATION 505109**

**BY FISHER & PAYKEL HEALTHCARE**

**TO REVOKE REGISTRATION UK00002576114**

**AND**

**APPLICATION FOR PROTECTION IN THE UK**

**OF INTERNATIONAL REGISTRATION WO0000001611613**

**BY FISHER & PAYKEL HEALTHCARE**

**AND**

**OPPOSITION 433137**

**BY NOVA BIO-PHARMA TECHNOLOGIES LIMITED**

## **Background and Pleadings**

1. On 28 July 2021, Fisher & Paykel Healthcare Limited ('FPH') applied for protection in the UK for the following International Registration:

WO0000001611613:

# NOVA

International Registration date: 28 July 2021

Designation date: 28 July 2021

Priority date: 5 July 2021 (New Zealand)

For the following goods:

Class 10:

*Medical respiratory masks for use in treating obstructive sleep apnea; nasal masks for use in treating obstructive sleep apnea; parts and fittings for all the aforementioned goods.*

2. On 3 May 2022, the application was opposed by Nova Bio-Pharma Technologies Limited ('NBT') under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). In the opposition, NBT relies on the following earlier registration, comprising a series of two marks:

UK00002576114

**Nova**  
**Nova**

Filing date: 23 March 2011

Date of entry in register: 2 September 2011

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; dietetic substances adapted for medical use; 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:

*Scientific and technological services; scientific research services; scientific services, technological services, scientific research services; process and formulation development; QC testing; engineering support services; labelling services; logistics services; aseptic production services; vial/ampoule filling and syringe filling services ; spray drying services; lyophilisation; emulsion manufacturing ; medical device assembly services; live biologics; industrial analysis and research services; information, advisory and consultancy services in relation to all the aforesaid services.*

For the purposes of the Opposition, NBT relies upon its goods in classes 5 and 10 only.

3. NBT claims that FPH's applied-for mark is similar to NBT's earlier mark and for identical and highly similar goods and that there will therefore be a likelihood of

confusion between the parties' marks.<sup>1</sup> The Opposition is directed against all of the goods in respect of which UK protection is sought by FPH.

4. FPH filed a Defence and Counterstatement in which it denied the claim against it in its entirety.
5. On 25 October 2022, FPH sought revocation of NBT's registration UK00002576114, on the grounds of non-use. Under section 46(1)(a) of the Trade Marks Act 1994 ('the Act'), FPH alleges non-use in the five-year period following the date on which the contested mark was registered, i.e. 3 September 2011 to 2 September 2016, with an effective revocation date of 3 September 2016. Under section 46(1)(b) of the Act, FPH alleges non-use in respect of the contested mark for the five-year period 12 July 2017 to 11 July 2022, with an effective revocation date of 12 July 2022. Non-use is claimed in respect of all of the goods and services in respect of which NBT's mark is registered.
6. NBT filed a counterstatement defending its registration and denying the revocation claim against it in its entirety.
7. NBT is represented by Forresters IP LLP and FPH is represented by Serjeants LLP.

### **Evidence and submissions**

8. Both parties filed evidence.

NBT's evidence comes from:

- i. Roger Stanforth, 'Head of Group Finance and Company Secretary of Nova Laboratories Ltd'.<sup>2</sup> Mr Stanforth's Witness Statement is dated 16 January 2023, and is accompanied by five exhibits.

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<sup>1</sup> NBT's Statement of Grounds, at Q5.

<sup>2</sup> I note that 'Nova Laboratories Ltd' is a different entity to the Registered Proprietor of the contested mark in the revocation proceedings, Nova Bio-Pharma Technologies Limited. However, I note from Companies House records that Mr Stanforth is an officer of both companies; his role in NBT commenced 23 November 2016. I therefore accept that Mr Stanforth is an appropriate person to provide a Witness Statement for NBT's case.

and

- ii. Karen Leishman, 'Group Accountant' of NBT. Ms Leishman's Witness Statement is dated 17 May 2023, and is accompanied by two exhibit.

FPH's evidence comes from Janette Hamer, Chartered Trade Mark Attorney and Partner at FPH's representative. Ms Hamer's Witness Statement is dated 17 March 2023, and is accompanied by one exhibit.

9. Both parties filed written submissions in the evidence round. FPH's submissions are dated 17 March 2023; NBT's submissions are dated 17 May 2023.
10. A hearing was neither requested nor considered necessary. Both parties filed written submissions in lieu of a hearing, both dated 21 July 2023.

### **Relevance of EU law**

11. 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**

12. The revocation proceedings will be addressed first because the mark for which revocation is sought is the earlier mark upon which NBT seeks to rely in the related opposition proceedings.

#### The revocation action

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The fact that he refers to his role in Nova Laboratories Ltd rather than to his role in NBT is, in my view, of no real consequence for the present proceedings.

13. Section 46 of the Act is relevant to the revocation proceedings, and 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”.

14. Section 100 of the Act provides that:

“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.”

15. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J 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*

Bunderversvereinigung 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 P Reber Holding & Co KG v 6 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 7 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]."

16. 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 or services protected by the mark" is not, therefore, genuine use.

17. As noted above, the relevant periods are 3 September 2011 – 2 September 2016 ('the First Relevant Period') and 12 July 2017 – 11 July 2022 ('the Second Relevant Period').

### **NBT's evidence**

18. I note the following from NBT's evidence:

(a) Mr Staniforth states that the slides from 'various seminars and presentations' that have been provided over the years 'contain the NOVA mark as standard and have done since we first registered the mark'.<sup>3</sup> I note that the content of the slides adduced at exhibit RS1 is focused on the manufacturing capabilities and facilities offered by 'Nova Laboratories Ltd', which is a different entity to NBT. No information had been provided on: the dates when the slides were presented; the locations where the seminars were given (if physical events); or the audiences to which the slides were presented. The subject and tenor of the material presented indicates that the target audience is likely companies requiring manufacturing services in order to produce their products. I note the following from Exhibit RS1:

- One of the slides shows images of what appear to be pharmaceutical preparations; the bottles bearing the name 'Xaluprine' prominently across the top of the label, with the mark 'nova' visible in a smaller font at the foot of the label on the left-hand side. The following text appears underneath 'Xaluprine': '20 mg/ml, oral suspension mercaptopurine'. It is my understanding that 'mercaptopurine' is the name of the drug and 'Xaluprine' is a brand name for it.
- There are references to the following services: 'aseptic spray drying; 'in-house QC services'; 'Biological Product manufacture'; 'aseptic filling, assembly and packaging all under one roof'; 'lysophilisation'. There are

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<sup>3</sup> Witness Statement of R. Staniforth, at [4].

also references to 'liquid formulation, fill including emulsions (water-in-oil/oil-in-water) and 'Live biologics filling facility'.

- One of the slides features a pie-chart showing the 'business split' as follows: '36% Bone Cement; 25% Sterile & Contract manufacturing; 18% Non-sterile manufacturing; 12% Licensed products; 9% Other'.
- A slide headed 'Non sterile manufacturing' states that all products are manufactured in-house in 'our state of the art facilities' and that there are 'over 10,000 formulations'. A UK email address is provided by way of contact details for a 'dedicated Customer Services team':  
sales@novalabs.co.uk.
- The following excerpt from an article published in 'Chemistry World' is included:

*"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

- (b) At Exhibit RS2, Mr Staniforth has stated that the following appears in the letter head that is used 'on all documents':



A screen-shot of the list of electronic files indicates that the file in which this image is stored was last modified on 4 July 2008.

Mr Staniforth states that the following two examples appear at the footer of 'our website':

**Nova Bio-Pharma Holdings Ltd**

**Nova**  
Laboratories Ireland Ltd

It is presumed that the former example relates to the footer of NBT's website, whereas the latter example relates to the website of another entity 'Nova Laboratories Ireland Ltd'. Some documentary evidence of examples of dated correspondence and archived webpages<sup>4</sup> showing NBT's mark would have been helpful.

(c) Examples of labels from pharmaceutical preparations and their corresponding printing proofs:<sup>5</sup>

- Three labels for 'oral solution hydroxycarbamide' whose brand name appears to be 'Xromi' owing to the prominence and positioning of this mark at the top of the label. 'Nova' features in a much smaller font and appears to indicate the undertaking responsible for the manufacturing of the drug. The address for 'Nova Laboratories Limited' appears alongside the 'nova' mark. The corresponding printing proof is dated 3 November 2020.

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<sup>4</sup> Prints of archived pages from the 'Wayback Machine' or other such web archiving services.

<sup>5</sup> Exhibit R3.

- Label for ‘mercaptapurine monohydrate’ as an oral liquid suspension, whose brand name appears to be ‘Allmercap’ owing to the prominence and positioning of this mark at the top of the label. ‘Nova’ features in a much smaller font at the foot of the label beneath which is the text ‘Manufactured by Nova Laboratories Ltd, Leicester, UK’. I note that the label indicates that the sponsors are based in Australia and New Zealand. The corresponding printing proof is dated 20 November 2020.
- Two labels for ‘mercaptapurine’ oral suspension, whose brand name appears to be ‘Xaluprine’ owing to the prominence and positioning of this mark at the top of the label. ‘Nova’ features in a much smaller font at the foot of the label. The corresponding printing proof is dated 3 November 2020.
- Two labels for ‘mercaptapurine’ oral suspension, whose brand name appears to be ‘Purixan’ owing to the prominence and positioning of this mark at the top of the label. ‘Nova’ features in a much smaller font at the foot of the label. The corresponding printing proofs are dated 15 and 16 October 2020.

I note that the labels indicate that ‘bottle adaptors [sic]’ and ‘dosing syringes’ are included with the medicines. I also note that the ‘customer name’ for the printing proofs is ‘Nova Labs, Leicester’.

(d) Thirteen ‘Wayback’ prints of webpages from the website of ‘Nova Laboratories Ltd’, for an evenly-spaced range of dates from 10 April 2009 to 28 November 2020.<sup>6</sup> The ‘Nova’ mark has a prominent position at the ‘header’ of each web page, on the left-hand side. I note that the pages consistently bear the text: ‘Nova Laboratories is one of the UK’s leading independent suppliers of both ‘Specials’ and clinical trials medicines to healthcare professionals...’. The webpages also consistently indicate that ‘Nova Laboratories Ltd’ offers the following services: ‘Specials Manufacturing’ and ‘Aseptic manufacturing’.

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<sup>6</sup> Exhibit RS4.

Several of the webpages feature what might be described as a 'news bulletin' type feature which highlights various activities from Nova Laboratories:

- '27/11/2008 – Nova has signed a new contract worth in excess of 10 million.'
- '21/09/2010 – Nova Laboratories was pleased to be asked to contribute to a recent BBC investigation into the rising cost of "Specials" within the NHS.'
- '4/05/2011 – When Leicester Royal Infirmary were looking for a company to supply materials for their ground breaking clinical trial into the treatment of bowel cancer, they turned to Nova..'
- '20/07/2012 – 'Xaluprine', a liquid form of childhood leukaemia drug Mercaptopurine, will be distributed to hospital pharmacies across Europe after being granted an exclusive licence as an 'orphan' product by the European Commission'

(e) Three examples of quotes have been provided in respect of manufacturing services which entail the provision of large batches of pharmaceuticals for clinical trials. The 'nova' mark appears prominently at the header of each. The customer names and costings have been redacted, but the documents itemise various aspects of the service, which includes, *inter alia*: pre-treatment and sterilization of disposables; Aseptic filling of the vials; Standard identifier labelling (during inspection) and secondary packaging. I note that certain items are explicitly excluded from the quotes, e.g. 'starting materials specific to your product'. The quotes indicate that the services provided involve the preparation of several thousands of individual vials of pharmaceutical preparations. Only one of the quotes is dated: 28 August 2012. No corresponding invoices have been provided to reconcile with the quotes.

(f) Six invoices have been provided, to various UK healthcare providers, including: Stryker Howmedica Osteonics; Alder Hey Children Hospital; Great

Ormond Street Hospital; Royal Victoria Infirmary, Newcastle; and The Royal Oldham Hospital.<sup>7</sup> The 'nova' mark appears prominently at the header of each invoice. I note the following:

- Invoice dated 28 November 2002 – for 2,066 units of [details redacted] in the sum of GBP [redacted]. I note that the date of this invoice falls outside of either of the relevant five-year periods.
- Invoice dated 31 July 2012 – for 100 morphine syringes in the sum of GBP [redacted].
- Invoice dated 3 July 2017 – for 2 units of 'sucralfate Susp 1g/5ml' in the sum of GBP [redacted]. I note this date falls after the initial relevant five-year period but precedes the most recent relevant five-year period.
- Invoice dated 30 July 2021 – for 8 'packs' of Xaluprine in the sum of GBP [redacted].
- Invoice dated 20 July 2022 – for 5,739 items of [redacted] in the sum of GBP [redacted]. This invoice post-dates the end of the Second Relevant Period by a few days, although it does not fall within the three-month period preceding the institution of the revocation action on 25 October 2022.
- Invoice dated 26 July 2022 – for the following goods: quantities of 'Acetazolamide Susp.' And 'Xromi Oral Solutio' in the sum of GBP [redacted]. This post-dates the end of the Second Relevant Period by a few days and falls within the three-month period preceding the institution of the revocation action on 25 October 2022.

(g) Ms Leishman has introduced screenshots of the website for 'Nova Laboratories Ltd' and states that are dated 'between 2015 and 2021',

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<sup>7</sup> Exhibit RS5. A seventh invoice provided is addressed to Nova Laboratories Ltd and appears to relate to rental of a premises.

although there are not dates visible on screenshots themselves.<sup>8</sup> ‘Wayback’ prints would have been helpful. The ‘Nova’ mark is visible in the ‘header’ of each webpage. The resolution of the images is very poor, but I am able to see several mentions of the pharmaceutical product which has the brand name ‘Xaluprine’, and it is apparent that ‘Nova Laboratories Ltd’ is holding itself out as a manufacturer of this product. I note references to ‘Hypodermic Rehydration Injection System’ on several of the pages.

(h) Fourteen invoices have been provided, all of which are dated within the Second Relevant Period.<sup>9</sup> The ‘Nova’ mark appears prominently in the header of each. The customers comprise hospitals, pharmacies and distributors of healthcare goods based in the UK, and repeat custom is apparent. The goods sold comprise pharmaceutical preparations, including: ‘Hydroxycarbamide liquid’, ‘Glycopyrrolate Oral Solution’, ‘Griseofulvin Suspension’, ‘Acitretin’, ‘Potassium Iodide Oral Solution’, ‘Dimethyl Sulfoxide’, ‘Phenobarbital Sod.’, ‘Riboflavin Susp.’, ‘Clozapine Susp’, ‘Acetic Acid Solution’, ‘Xaluprine’ and ‘Xromi’. Screenshots from the website of Nova Laboratories demonstrate that the product ‘Xaluprine’ is a childhood leukaemia drug. While the evidence does not demonstrate the specific purposes of the remainder of the aforementioned pharmaceutical preparations, I have no reason to doubt that they are pharmaceutical preparations for human use.

19. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>10</sup>

20. FPH has submitted that evidence of use of the contested mark is by the company ‘Nova Laboratories Ltd’, a different entity to NPT, the Registered Proprietor of the mark and, that, therefore, such evidence should be disregarded.<sup>11</sup> It was confirmed in *Ansul BV v Ajax Brandbeveiliging*<sup>12</sup> that ‘genuine use’ included use

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<sup>8</sup> Exhibit RS6.

<sup>9</sup> Exhibit RS7.

<sup>10</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

<sup>11</sup> Written submissions of FPH, dated 17 March 2023, at [10].

<sup>12</sup> Case C-40/10, at [37].

by a third party with authority to use the mark. I have already noted that Mr Stanforth is a director of both Nova Laboratories Ltd and NPT. Both entities include the element 'Nova' in their names. It would, in my view, be implausible for Mr Stanforth to give evidence featuring examples of use of the contested mark to which his own company had not consented. I have no reason to find that the examples of use by a third party that have been presented in NPT's evidence have been non-consensual.

21. FPH has further submitted that the examples of packaging provided by NPT demonstrate use of the NOVA name 'merely to denote the entity which manufactured the product' and that this does not constitute 'use as a trade mark in respect of the product itself'.<sup>13</sup> While this is noted, the fact that a mark denoting the manufacturer of a drug might appear on the same packaging as another mark denoting the brand name of the drug does not necessarily indicate that use of the manufacturer's mark is not genuine use of the mark in respect of that particular good. I bear in mind the case of *Colloseum*<sup>14</sup> in which it was held that "the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark'. It accords with my own experience of receiving prescribed medicines that the pharmaceutical sector often uses manufacturer's marks in conjunction with other product/drug names.<sup>15</sup>

Second Relevant Period: 12 July 2017 to 11 July 2022.

22. NPT has not provided any sales figures or information on marketing expenditure in relation to products sold under the 'Nova' mark. Given the duration of use claimed by NPT, this information would not, in my view, have been onerous to obtain. That said, it is clear from the evidence provided that Nova Laboratories Ltd has held itself out as a manufacturer of pharmaceutical products and pharmaceutical manufacturing services under the 'Nova' mark. 'Wayback' prints from its website providing information on particular services offered cover dates

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<sup>13</sup> Written submissions of FPH, dated 17 March 2023, at [10].

<sup>14</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, at [32].

<sup>15</sup> For example, both the well-known drug brand name 'Panadol' and the mark for the manufacturer, GlaxoSmithKline, appear on the same packaging.

up to 28 November 2020. Further ‘Wayback’ prints for a selection of dates covering the remainder of the Second Relevant Period (i.e. December 2020 – July 2022) would have been helpful. Examples from the website of the particular goods in respect of which the contested mark is registered would also have bolstered NPT’s case. The quotes provided for various services in relation to the preparation of pharmaceuticals for clinical trials are, bar one, undated.<sup>16</sup> There are fourteen invoices for pharmaceutical goods (various medicines and syringes) falling within the Second Relevant Period, which cover a fairly evenly-spaced range of dates from 13 July 2018 to 11 July 2022. Collectively, these fourteen invoices amount to £3080.42 worth of goods sold. I note that no invoices have been provided for the first year of that period. However, there is an invoice dated 3 July 2017, although it precedes the commencement of the Second Relevant Period by a week or so. Invoices for dates falling between 12 July 2017 and 12 July 2018 would unlikely have been onerous to obtain. Ms Leishman has given narrative evidence that screenshots provided at Exhibit RS6, which show use of the ‘Nova’ mark in relation to the pharmaceutical product ‘Xaluprine’, are dated between 2015 and 2021, although the screenshots themselves are undated. Considering the totality of evidence available to me, I have no reason to doubt whether the contested mark was used for the first year of the Second Relevant Period, despite the absence of invoices for that portion of time.

23. I now consider for which of the terms in the specification for the contested mark there has been genuine use. The goods and services in respect of which the mark is registered are set out above at [2].

#### Fair Specification

24. 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

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<sup>16</sup> One is dated within the First Relevant Period.

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.”

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

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

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

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

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

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

### **Class 5**

26. NBT has clearly shown sales of various pharmaceutical preparations to UK customers ('Hydroxycarbamide liquid', 'Glycopyrrolate Oral Solution', 'Griseofulvin Suspension', 'Acitretin', 'Potassium Iodide Oral Solution', 'Dimethyl Sulfoxide', 'Phenobarbital Sod.', 'Riboflavin Susp.', 'Clozapine Susp', 'Acetic Acid Solution', 'Xaluprine' and 'Xromi'). Examples of the packaging (e.g. for the drug mercaptopurine, for which Xaluprine is a brand name) indicate that a bottle adaptor and dosing syringes are included in the product. I have no reason to doubt that bottle adaptors and/or dosing syringes are included in other of the medicines sold.
27. I find that NBT has provided sufficient evidence to demonstrate genuine use of its mark in relation to the following of its class 5 terms:
- Pharmaceutical preparations; except pharmaceutical preparations for dermatology and medical products for dermatology.*
28. The body of evidence available to me does not, in my view, demonstrate genuine use of the contested mark in respect of the following of its class 5 terms:

*Pharmaceutical compositions and products; veterinary compositions, preparations and products; vaccines for human and animal use;<sup>17</sup> compositions for veterinary use;<sup>18</sup> compositions for medicinal or veterinary use comprising any biological and/or pharmaceutical ingredient;<sup>19</sup> sanitary preparations for medical purposes;<sup>20</sup> dietetic substances adapted for medical use; plasters, materials for dressings; parts and fittings for all the aforesaid goods; except pharmaceutical preparations for dermatology and medical products for dermatology.*

### **Class 10**

29. I find that NBT has provided sufficient evidence to demonstrate genuine use of its mark in relation to the following of its class 10 terms:

*syringes and injectors for medical purposes*

30. The body of evidence available to me does not, in my view, demonstrate genuine use of the contested mark in respect of the following of its class 10 terms:

*Apparatus for use in the delivery of pharmaceutical materials and drugs;<sup>21</sup> 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**

31. Although I accept that NBT has held itself out as a supplier of pharmaceutical manufacturing services, the evidence adduced in support is surprisingly scant, given the manufacturing capabilities of Nova Laboratories Limited and the 'news updates' showcased on its webpages. Although some examples of quotes for such services have been provided, no corresponding invoices have been produced, nor any sales figures. I may only base my findings on the material

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<sup>17</sup> It is not possible to discern which, if any, of the goods featured in the evidence constitute a vaccine, whether for human or animal use.

<sup>18</sup> It is not possible to discern which, if any, of the goods featured in the evidence are for veterinary use.

<sup>19</sup> As above.

<sup>20</sup> I understand these goods to cover items for cleaning the person, such as, *inter alia*, soaps and toothpastes.

<sup>21</sup> The evidence does not, in my view, demonstrate use of the mark for the breadth of this wide term, although use has been demonstrated for specific items such as syringes.

presented to me in evidence. The body of evidence available to me does not, in my view, demonstrate genuine use of the contested mark in respect of any of the class 42 terms:

*Scientific and technological services; scientific research services; scientific services, technological services, scientific research services; process and formulation development; QC testing; engineering support services; labelling services; logistics services; aseptic production services; vial/ampoule filling and syringe filling services; spray drying services; lyophilisation; emulsion manufacturing; medical device assembly services; live biologics; industrial analysis and research services; information, advisory and consultancy services in relation to all the aforesaid services.*

First Relevant Period: 3 September 2011 – 2 September 2016

32. In order to determine the earliest possible revocation date for the contested mark in respect of the terms for which NBT has failed to demonstrate genuine use during the Second Relevant Period, it is necessary for me to determine whether there has been genuine use in respect of those terms for the First Relevant Period. For ease of reference, I set out those terms again here:

Class 5:

*Pharmaceutical compositions and products; veterinary compositions, preparations and products; vaccines for human and animal use; compositions for veterinary use; compositions for medicinal or veterinary use comprising any biological and/or pharmaceutical ingredient; sanitary preparations for medical purposes; dietetic substances adapted for medical use; 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; 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:

*Scientific and technological services; scientific research services; scientific services, technological services, scientific research services; process and formulation development; QC testing; engineering support services; labelling services; logistics services; aseptic production services; vial/ampoule filling and syringe filling services; spray drying services; lyophilisation; emulsion manufacturing; medical device assembly services; live biologics; industrial analysis and research services; information, advisory and consultancy services in relation to all the aforesaid services.*

33. The evidence pertinent to the First Relevant Period has been scant. It is clear from the 'Wayback' prints that Nova Laboratories Ltd has at least held itself out as a manufacturer of pharmaceutical products and provider of pharmaceutical manufacturing services under the 'Nova' mark for the duration of the First Relevant Period. The quote dated 28 August 2012 is a specific example of a package of services offered. However, my view is that the totality of evidence provided is insufficient to support a finding that there has been genuine use in respect of the terms set out above at [32].

### **Conclusion in respect of the revocation action**

34. The application for revocation of registration UK00002576114 has succeeded in respect of the following terms only:

Class 5:

*Pharmaceutical compositions and products; veterinary compositions, preparations and products; vaccines for human and animal use; compositions for veterinary use; compositions for medicinal or veterinary use comprising any biological and/or pharmaceutical ingredient; sanitary preparations for medical purposes; dietetic substances adapted for medical use; 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; 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:

*Scientific and technological services; scientific research services; scientific services, technological services, scientific research services; process and formulation development; QC testing; engineering support services; labelling services; logistics services; aseptic production services; vial/ampoule filling and syringe filling services; spray drying services; lyophilisation; emulsion manufacturing; medical device assembly services; live biologics; industrial analysis and research services; information, advisory and consultancy services in relation to all the aforesaid services.*

Subject to any successful appeal, the mark will be revoked for the above-mentioned terms with an effective revocation date of 3 September 2016. This date precedes the date upon which FPH applied for protection in the UK of the registration to which the related opposition proceedings relate (28 July 2021). Consequently, NBT may not rely upon its registration as an earlier mark, in respect of the above-mentioned terms, for the purpose of the opposition.

35. The application for revocation of registration UK00002576114 has failed in respect of the following terms only:

Class 5:

*Pharmaceutical preparations; except pharmaceutical preparations for dermatology and medical products for dermatology.*

Class 10:

*syringes and injectors for medical purposes*

36. NBT may therefore rely on their registration UK00002576114 in respect of the above-mentioned terms as an earlier mark in the related opposition proceedings.

### The opposition

#### **Evidence from FPH**

37. The only evidence that is relevant for the purpose of the Opposition is that filed by Ms Hamer, which goes to the similarity of the competing goods and services. Ms Hamer's evidence focuses on a number of aspects of the goods in respect of which FPH is seeking UK protection for its mark. Ms Hamer states in her Witness Statement that FPH's masks 'for the treatment of obstructive sleep apnea' are prescription-only goods which can only be purchased from outlets such as 'pharmacies, specialist sleep stores or clinics or durable medical equipment suppliers'.<sup>22</sup> Exhibited to Ms Hamer's Witness Statement are prints-outs of what appear to be pages from an online catalogue featuring images of the masks being worn, together with product information.<sup>23</sup>

38. Section 5(2)(b) of the Act is relevant to the opposition proceedings, and states:

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

(a) ...

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

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<sup>22</sup> Witness Statement of Janette Hamer, at [5] – [6].

<sup>23</sup> Exhibit JCH1.

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

39. Section 6A of the Act provides that where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the application for protection in the UK of the opposed mark, the Opponent may be required to prove use of the earlier mark. In the instant case, section 6A is engaged, because the earlier mark had been registered for more than five years on the date on which FPH sought UK protection for its mark. The matter of genuine use was determined in the related revocation action and my conclusion is set out above at [34] to [36].

40. The following principles are derived from the decisions of the Court of Justice of the European Union<sup>24</sup> (“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 B.V.* 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 C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the

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<sup>24</sup> 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 Trade Marks Act relied on 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.

chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **Comparison of goods and services**

41. Section 60A of the Act provides:

(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the 'Nice Classification' means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.

42. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties' goods and services must be taken into account:

"[23] In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

43. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281<sup>25</sup>, identified the following factors for assessing similarity of the respective goods and services:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and, in particular, whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

44. Goods (or services) may be grouped together for the purposes of assessment, as Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said in *Separode Trade Mark* BL O-399-10:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

45. In making an assessment between the competing goods and services, I bear in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation*

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<sup>25</sup> *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

*in the Internal Market.*<sup>26</sup> The General Court held to the effect that goods and services can be considered as identical when the goods and services designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

46. Case law establishes that “... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise” but “Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”<sup>27</sup>

47. The goods to be compared are as follows:

NBT’s earlier mark:	FPH’s applied-for mark:
<p>Class 5: <i>Pharmaceutical preparations; except pharmaceutical preparations for dermatology and medical products for dermatology.</i></p> <p>Class 10: <i>syringes and injectors for medical purposes</i></p>	<p>Class 10: <i>Medical respiratory masks for use in treating obstructive sleep apnea; nasal masks for use in treating obstructive sleep apnea; parts and fittings for all the aforementioned goods.</i></p>

Contested goods: *Medical respiratory masks for use in treating obstructive sleep apnea; nasal masks for use in treating obstructive sleep apnea; parts and fittings for all the aforementioned goods.*

<sup>26</sup> Case T-133/05

<sup>27</sup> *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch).

48. FPH has submitted that its masks are intended to be used by sufferers of the medical condition sleep apnea, and function by assisting with the flow of oxygen while the user is asleep. <sup>28</sup> In my view, bearing in mind the purposes, users, trade channels, physical natures, methods of use, and whether or not the parties' goods are competitive or complementary, I do not find any level of similarity between the respective goods. I recognise that there may be overlaps in users and trade channels, however, these factors, without more, are insufficient to support a finding of similarity between the parties' goods. I also bear in mind that the Opponent's *pharmaceutical goods* would encompass medicines related to sleep apnea, should such medicines exist. However, no evidence has been provided to indicate that sleep apnea is a condition treated with medicines. All things considered, I find the parties' goods to be dissimilar.

49. Some similarity between the parties' goods and services is essential in order to find a likelihood of confusion between the parties' marks. In the case of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

'49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity'.

50. The Opposition therefore fails at this point. It is therefore unnecessary to proceed to compare the parties' marks.

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<sup>28</sup> Written submissions of FPH, 21 July 2023, at [44] – [45].

## Outcome

51. The opposition has failed in its entirety and the contested registration may, subject to a successful appeal, proceed to be given protection in the UK for all of the goods in respect of which it is registered.

## Costs

52. Both parties enjoyed a measure of success in the Revocation proceedings. Costs will therefore be awarded in respect of the Opposition proceedings only. FPH is the successful party and is entitled to a contribution its costs based upon the scale published in Tribunal Practice Notice 2/2016, calculated as follows:

Consideration of Opposition pleadings and preparation of Defence and Counterstatement	£200
Preparation of written submissions in lieu of a hearing	£300
<b>Total:</b>	<b>£500<sup>29</sup></b>

53. I therefore order Nova Bio-Pharma Technologies Limited to pay to Fisher & Paykel Healthcare Limited the sum of £500. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 27th day of November 2023**

**N. R. Morris**

**For the Registrar,  
the Comptroller-General**

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<sup>29</sup> I have not awarded a sum in respect of evidence filed by FPH because the evidence provided was very scant and, strictly speaking, unnecessary.