

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 1100805
IN THE NAME OF ABBOTT LABORATORIES**

**AND THE APPLICATION FOR REVOCATION THERETO
UNDER NO 12284
BY DCS EUROPE PLC**

TRADE MARKS ACT 1994

**In the matter of registration no 1100805
of the trade mark:**



**in the name of Abbott Laboratories
and the application for revocation thereto
under no 12284
by DCS Europe Plc**

Background

1) On 12 February 2001 DCS Europe Plc filed an application for the revocation of trade mark registration no 1100805 standing in the name of Abbott Laboratories (Abbott). The trade mark was registered on 9 November 1979 in respect of:

“pharmaceutical, veterinary and sanitary preparations and substances; infants’ and invalids’ foods”

The goods are in class 5 of the International Classification of Goods and Services. The specification has not been amended since registration. The trade mark was registered with the following disclaimer: “Registration of this mark shall give no right to the exclusive use of the word “Ensure””.

2) On 21 May 2001 the registered proprietor filed a counterstatement contesting the application for revocation. He also furnished evidence in order to show use of his trade mark. The registered proprietor states that if it is found that the trade mark in suit has not been put to genuine use in respect of the contested goods he will show proper reasons for this non-use.

3) The applicant states that the registered proprietor has not used the trade mark in suit in respect of *“pharmaceutical, veterinary and sanitary preparations and substances”* and *“infants’ foods”* for an uninterrupted period of five years and three months prior to the filing of the application for revocation and that there are no proper reasons for non-use. The applicant requests, under the provisions of section 46(1)(b) of the Trade Marks Act 1994, that the registration in suit is revoked in respect of *“pharmaceutical, veterinary and sanitary preparations and substances”* and *“infants’ foods”*.

4) Both parties seek an award of costs.

5) Both parties filed evidence.

6) The matter came to be heard on 20 September 2002 when the applicant was represented by Mr Dunlop of Wynne-Jones, Lainé & James and the registered proprietor was represented by Ms McFarland of counsel, instructed by Page White & Farrer.

The registered proprietor's evidence

7) This consists of a statutory declaration made by David John Richards. Mr Richards is a chartered patent attorney and registered trade mark attorney. Mr Richards by way of his declaration brings in a statutory declaration by Philip Beattie and extracts from websites of the registered proprietor.

8) Mr Beattie's declaration was originally part of opposition proceedings between the parties. Mr Beattie is finance director of Abbott Laboratories Limited (ALL) which he states is a wholly owned United Kingdom subsidiary of the registered proprietor. Mr Beattie states that ALL is responsible for the sale, marketing and distribution of all Abbott's products throughout the United Kingdom and Europe. He states that among Abbott's products are a range of medical and nutritional products which are sold and distributed through a division of ALL which trades as Abbott Nutrition Division (Nutrition). Mr Beattie states that among the products sold by Nutrition are the ENSURE and ENSURE PLUS medical nutritional products.

9) Mr Beattie states that ALL has sold nutritional products for medical use under the trade mark ENSURE since 1981 and under the trade mark ENSURE PLUS since 1984. The ENSURE product is in the form of a liquid and a bar and the ENSURE PLUS product is a liquid based product in the style of a milk shake. Mr Beattie states that both products have been approved by the Advisory Committee on Borderline Substances (ACBS) and are sold mainly through pharmacists to patients requiring nutritional supplements. Mr Beattie gives the following figures for sales of the products:

Year	ENSURE sales £ millions	ENSURE PLUS sales £ millions	Total £ millions
1995	6	10	16
1996	6	12	18
1997	5	14	19
1998	5	16	21
1999	5	19	24

10) Mr Beattie exhibits at PB1 a sample ENSURE bar and sample packaging for ENSURE and ENSURE PLUS products, which he states is typical of that used over the past five years. (The declaration was sworn on 8 March 2001.) I cannot see that any of the packaging reproduces the registered trade mark. ENSURE and ENSURE PLUS appear but not in the form of the trade mark in suit. They do not appear directly with the

stylised 'a' device. The 'a' does appear on certain of the packaging but well away from the words ENSURE and ENSURE PLUS. I cannot see that this exhibit shows use of the trade mark in suit.

11) Mr Beattie goes on to state that ENSURE and ENSURE PLUS products are the leading medical nutritional/dietary supplement products in their category in the United Kingdom and are actively marketed throughout the United Kingdom. He states that ALL spends in an average year approximately £1.5 million on advertising the ENSURE and ENSURE PLUS products. Mr Beattie exhibits at PB2 samples of promotional material, information and advertisements. He states these samples are typical of the promotional material which has been distributed over the past five years. This material shows no use of the trade mark in suit or the use of ENSURE or ENSURE PLUS in proximity with the 'a' device. Where the 'a' device does appear it is at a considerable distance from the words ENSURE or ENSURE PLUS and used with the words Abbott nutrition.

12) Mr Beattie ends his declaration with comments in relation to likelihood of confusion, which I do not consider to be relevant to revocation proceedings.

13) Exhibit DJR2 to the declaration of Mr Richards consists of printouts from Abbott's web site. The printouts indicate that they were downloaded on 21 May 2001, which is after the relevant date. There is no indication that the site is for United Kingdom use, indeed the front page states the information is intended for United States residents only. The trade mark in suit does not appear on any of the printouts.

Applicant's evidence

14) This consists of a witness statement by Brian Kenneth Charles Dunlop. Mr Dunlop is a chartered patent attorney and registered trade mark agent.

15) Mr Dunlop comments on the reference by Mr Beattie to Nutrition and to the packaging referring to Ross Products Division. He notes that the proprietor is the parent company, Abbott. He states that unless there are licences or agreements clearly transferring goodwill in the trade mark back to the parent company, then there is no link between the use by the Abbott subsidiaries and the proprietor. The proprietor would not appear to be using the trade mark in suit in the United Kingdom.

16) Mr Dunlop states that the sales figures given by Mr Beattie do not indicate if they relate to sales in the United Kingdom only. Mr Dunlop agrees that the trade mark in suit is being used on some invalids' foods. He states that the evidence of Abbott indicates that the goods are not for use by infants. He also exhibits at BKCD1 a printout from the Abbott website which states that ENSURE is really formulated for the nutritional needs of an adult. Mr Dunlop states that the evidence of Mr Beattie shows that ENSURE products are used as part of a convalescence regime. He states that there is no evidence to show that ENSURE or ENSURE PLUS goods could be classed as pharmaceutical preparations or substances; the possibility of them being sold in chemists would not lead to them being classified as pharmaceuticals. Mr Dunlop exhibits at BKCD2 a printout

from the Abbott's website showing that in the United States ENSURE products can be bought in food stores, pharmacies and discount stores and over the Internet. Mr Dunlop states that there is no mention of animal health and no evidence has been supplied to show use of the ENSURE or ENSURE PLUS trade marks on veterinary substances and preparations. He states that "sanitary substances and preparations" covers goods relating to the maintenance of "hygiene". All of the evidence supplied shows use on invalids' foods, no use of the ENSURE or the ENSURE PLUS trade marks has been given for sanitary preparations and substances.

17) Mr Dunlop states that there is no use of the stylised 'a' with the trade marks ENSURE or ENSURE PLUS, as shown in registration nos 1100805 and 1132516. He states, therefore, that no use of these trade marks is shown in the form as registered for any of the goods which are the subject of the revocation actions.

Further evidence of the registered proprietor

18) This consists of a further statutory declaration by Philip Beattie.

19) Mr Beattie exhibits at PB1 samples of ENSURE products. These consist of three tins and one bar. Two of the tins indicate they contain liquid nutrition the other that it contains a nutritional supplement. The tins bear the word ENSURE boldly, this is not in proximity to a stylised letter 'a'. On another plane of the tin, and at the bottom there appears a stylised letter 'a', not particularly largely, next to either the name and address of Ross Products Division or Abbott Nutrition. The wrapping of the bar states that it is complete balanced nutrition. The bar bears the word ENSURE boldly twice, this is not in proximity to a stylised letter 'a'. The stylised letter 'a' appears on a separate face of the wrapping, not particularly largely, above the name and address of Ross Products Division. Mr Beattie considers that these samples show use of the trade mark in suit. One tin indicates that it is food for special medical purposes. The bar indicates that it is for use under medical supervision. Mr Beattie states that the products are highly nutritive and can be obtained in the United Kingdom on prescription from pharmacies. He states that this is because the product is designed for alleviating malnutrition and under-nutrition. Mr Beattie states that the products are for those who cannot digest commonplace foodstuffs or who cannot get full nutritional benefit from such foodstuffs. He states that it was for such patients that the goods were specifically designed, for consumption as a sip feed and gastro-enterally. Mr Beattie states that it is because the product is so sophisticated that it falls within the remit of the ACBS.

20) Mr Beattie exhibits at PB2 an extract from "The Quango Website" which states the ACBS is:

"To advise whether particular substances, preparations or items should or should not be treated as drugs under the NHS (General Medical Services) Regulations 1992; and to ensure that substances, preparations or items which have a

therapeutic use in the treatment of disease can be provided as economically as possible under the NHS.”

Mr Beattie exhibits at PB3 an extract from the website of the United Kingdom Prescription Pricing Authority. He specifically refers to page 5 of the printout. This page includes the following:

“The products that GPs prescribe on FP10 do not have to have product licences to be considered as drugs. Some patients will require unlicensed medicines. There are also patients who need products where it is borderline whether the product is a drug or something else such as a food or cosmetic. Whether a product is allowed as a drug on an FP10 may depend on the particular circumstances in which the product is used e.g. it may be considered a drug when used for treating a specific condition. The Advisory Committee on Borderline Substances advises as to the circumstances in which some foods and toilet preparations may be regarded as drugs. The ACBS recommendations can be found in Part XV of the Drug Tariff. If a GP prescribes one of these substances, he or she should endorse the FP10 with "ACBS". When the PPA receives FP10s containing items that would not normally be considered as drugs and which are not recommended by the ACBS, the dispensing contractor will be reimbursed for the item. However the FP10 is sent to the GP's primary care trust and the primary care trust may question whether the GP has breached his or her terms of service by prescribing something that is not a drug.”

21) Mr Beattie exhibits at PB4 an extract from “Drug Tariff” for December 2001, compiled on behalf of the Department of Health by the Prescription Pricing Authority. Included in the list of borderline substances are ENSURE, ENSURE POWDER, ENSURE BAR, ENSURE PLUS LIQUID FEED and ENSURE PLUS YOGHURT STYLE. The various products are described as being a sole source of nutrition and/or a nutritional supplement prescribed on medical grounds. The list states that none of the products, with the exception of ENSURE BAR, should be prescribed to children under one year of age. ENSURE BAR is not to be prescribed to children under two years of age. It is indicated that all of the products should be used with caution for children up to five years of age.

22) Mr Beattie exhibits at PB5 an extract from the “British National Formulary” dealing with borderline substances. This extract includes the following:

“In certain conditions some foods (and toilet preparations) have characteristics of drugs and the Advisory Committee on Borderline Substances advises as to the circumstances in which such substances may be regarded as drugs. Prescriptions issued in accordance with the Committee’s advice and endorsed ‘ACBS’ will not normally be investigated.

General Practitioners are reminded that the ACBS recommends products on the basis that they may be regarded as drugs for the management of specified conditions. Doctors should satisfy themselves that the products can safely be

prescribed, that patients are adequately monitored and that, where necessary, expert hospital supervision is available.”

The extract also shows listings for ENSURE and ENSURE PLUS.

23) Mr Beattie exhibits at PB6 an extract from the “Community Services Pharmacy News” of South Thames & North Thames Regional Drug Information Service. The extract deals with sip feeds, being enteral nutrition. It lists ENSURE PLUS and ENSURE (tins) amongst various commonly used sip feeds. The extract includes the following:

“Enteral nutritional supplements are medical foods, which are used to supplement the diet, as sip feeds and/or as tube feeds. They supply some or all of the macronutrients – energy, protein, fat, carbohydrate- and micronutrients- vitamins and trace elements – and are available on prescription. They are not simply vitamin and mineral supplements. Each type of supplement is suitable for different types of patients.”

24) Mr Beattie states that all ENSURE products can be prescribed by doctors and purchased on prescription and are thus perceived by their users as pharmaceutical preparations. He exhibits at PB7 an extract from a website giving information about cancer to people in the United Kingdom. Included in this is the following:

“Ready to drink/use supplements

You may find it easier to buy a ready to drink, flavoured supplement from your chemist. Your doctor can also offer you a prescription for them. Supplements such as Fortisip, Fortifresh, Ensure Plus and Entera, or Fortijuice, Enlive and Provide Xtra are nutritionally balanced, so occasionally you can have one of them instead of a meal if you do not feel like eating.”

25) Mr Beattie exhibits at PB8 a copy of the data sheet for ENSURE. The sheet was prepared in August 2001. It runs to six pages, the trade mark in suit does not appear upon any of them. The sheet advises upon the uses of the product and for what illnesses and incapacities it is particularly designed.

26) Mr Beattie goes on to deal with the issue of the use of ENSURE for children. He exhibits at PB9 a printout from the website of the children’s hospital in Westmead, Australia. It includes references, under the heading “tube feeds”, to ENSURE and ENSURE PLUS. Exhibited at PB10 is a letter from Jane Little who is the head of Nutrition and Dietetics at The Queen Elizabeth Hospital. She states the ENSURE products are widely used for patients of all ages. She lists the conditions for which the products are used. Exhibited at PB11 is a letter from the nutrition and dietetic services manager of Gloucestershire Royal NHS Trust, Ann McArley. The letter states that ENSURE PLUS is used widely across Gloucestershire in both the hospital and community and is used with all age groups from children through to older people.

27) Exhibited at PB12 is an extract from a copy of “The Shorter Oxford Dictionary” which gives a definition of infant – “a child during the earliest period of life (or still unborn); esp. a child in arms; often, any child under seven years of age”.

28) Exhibited at PB13 is a group of articles from the Internet in relation to the use of ENSURE PLUS for animals and birds. None of the web pages would appear to emanate from the United Kingdom; none of them are from Abbott or indicate that they were authorised by Abbott.

29) Mr Beattie exhibits at PB14 and PB15 the decisions in the Jardex and Black Magic cases. These were both opposition cases under the 1938 Act. I do not see that they have a bearing upon a revocation for non-use case under the 1994 Act and so will say no more about them here.

30) Mr Beattie states that ALL and Abbot Laboratories (Ireland) Limited are subsidiaries of Abbott and that Ross Products Division is a division within ALL. He states that Ross Products Division changed its name to Abbott Nutrition Division in 2001. He states that the use of the trade mark ENSURE by the subsidiaries is use by “his company”. The use of the product in the United Kingdom has at all times been under the control of “his company”. Previously Mr Beattie identified “his company” as ALL not as Abbott. I am not sure if the references to “his company” is, therefore, a simple error and if he meant Abbott rather than ALL. Mr Beattie exhibits at PB16 a brochure from March 2001 produced by Nutrition.

31) Mr Beattie confirms that the sales figures in his earlier declaration were for the United Kingdom. He goes on to make various comments about the witness statement of Mr Dunlop and various other comments; these can best be described as representing submissions rather than evidence of fact. As such I see no reason to rehearse the comments here but take them on board and will consider them in reaching a decision. He exhibits various documents. None of them show the trade mark in suit in use and several of them deal with the issue of likelihood of confusion; I do not consider that these documents have a bearing upon these proceedings. Mr Beattie exhibits at PB20 an extract from “The Shorter Oxford English Dictionary” which defines sanitary as “of or pertaining to the conditions affecting health esp. with ref. to cleanliness and precautions against infection etc.; pertaining to or concerned with sanitation”.

Applicant’s evidence in reply

32) This consists of a further witness statement by Mr Dunlop. Much of what Mr Dunlop states represents submissions rather than evidence of fact. I take on board these statements in reaching my decision but will say no more about them here. I will only deal with what can be broadly considered to be evidence of fact.

33) Mr Dunlop exhibits at BKCD1 a printout from the Internet. This is an article by Julia Stanford, who is described as the head of nutritional services at Ross Products. Mr Dunlop states that Ms Stanford highlights that ENSURE is a nutritional supplement and

that in the last paragraph of page 1 of the printout it is described as a medical food (not a pharmaceutical or medical treatment) which is used to supplement the diet.

34) Mr Dunlop exhibits at BKCD2 is an extract from the “Oxford Reference Concise Medical Dictionary” which defines infant as “a child incapable of any form of independence from its mother, a child under one year of age, especially a premature or new-born child. In legal use the term denotes a child up to the age of seven years.” Also exhibited at BKCD2 are “The Infant Formula and Follow-on Formula Regulations 1995”. In the definitions of this document an infant is defined as being a child under the age of twelve months. At BKCD3 Mr Dunlop exhibits an extract from “The New Penguin English Dictionary” where invalid is defined as “suffering from disease or disability” and “designed for use by disabled people”.

Decision

35) The ground for revocation is under section 46(1)(b) of the Act. Section 46 of the Act reads as follows:

“(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) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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 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.

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

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

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

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

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

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

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

36) Consideration has to be taken, also, of section 100 of the Act which states:

“100. 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.”

37) Consequent upon section 100 the onus is upon the registered proprietor to prove that he has made genuine use of the trade mark in suit, or that there are proper reasons for non-use.

38) At the outset of the hearing Mr Dunlop stated that he would not be pursuing the line of argument that any use shown was not use by or with the consent of the proprietor. I am grateful for this concession which I find helpful. I will say no more about this issue.

39) I can find no evidence of use of the trade mark as registered. Ms McFarland could direct me to none. She stated that use of a trade mark included oral use. She then submitted that in oral use the trade mark could only be referred to by its word element. The stylised “a” could not be referred to. Hence, she argued, oral use of the trade mark in

suit would be use of the trade mark as registered. I concur with Ms McFarland that use includes oral use; section 103(2) of the Act supports this proposition:

“References in this Act to use (or any particular description of use) of a trade mark, or of a sign identical with, similar to, or likely to be mistaken for a trade mark, include use (or that description of use) otherwise than by means of a graphic representation.”

However, oral use of the trade mark in suit is not use of the trade mark as registered. It is use of only part of it. Consequently in relation to oral use the registered proprietor will need to rely on use of the trade mark in a form differing in elements which do not alter the distinctive character of the trade mark as registered.

40) The issue of use of a trade mark in a form other than which it has been registered has been dealt with in several cases: *R v Bud and Budweiser Budbräu Trade Marks* [2002] RPC 38, *Elle Trade Marks* [1997] FSR 529, *Arnold Trade Mark* BL 0/474/01 and *Dialog Trade Mark* BL 0/084/02. The latter two cases are decisions of the appointed person and have not been reported.

41) In *R v Bud and Budweiser Budbräu Trade Marks* [2002] RPC 38 Mr Simon Thorley QC, sitting as a deputy judge of the High Court held:

“Of more importance is the reference in section 46(2) to distinctive character. If a trade mark is devoid of any distinctive character, it cannot be registered as a trade mark (see section 3(1)(b)). This distinctive character can either be inherent in the nature of the mark itself or can be acquired by reason of use made of the mark prior to the application for registration (see the proviso to section 3(1)). It is accordingly not possible to state in general terms what it is that gives any particular mark its distinctive character. The elements of each mark must be assessed separately. In making an assessment for the purposes of registration the registrar has significant experience in determining, on the basis of evidence filed, if necessary, the elements which do contribute to distinctive character and in assessing, having regard to the Act and the Rules, whether sufficient distinctive character has been acquired.

In my judgment this is indicative that the subsection is of narrow scope. Alterations which would be immaterial for the purpose of infringement, in that the alleged infringing mark was confusingly similar to the registered mark, are irrelevant. It is thus necessary for any tribunal seeking to apply section 46(2) to determine what is the distinctive character of the mark and which are the elements that, in combination, contribute to that distinctive character. Thereafter it must enquire whether any alteration to any of those elements is of sufficient immateriality as not to alter that overall distinctive character. In this way the objective of the Directive will be met. In the light of the 8th recital, it cannot be the intention to clutter up the register with a number of marks which differ from each other in very minor respects because the proprietor of an

earlier mark has subsequently seen fit to change that mark only in some minor way which nonetheless preserves its distinctive character. There should be no need to reapply for a further mark in those circumstances. On the other hand, where a proprietor wishes to alter his mark or believes that his mark has become sufficiently distinctive in a different form to be registrable in that form, it is right that he should register it in that form and allow the former unused registration to lapse.”

In *Dialog* Mr David Kitchin QC, sitting as the appointed person, confirmed this position in the following terms:

“I believe that the correct approach under section 46(2) is to consider the mark which is being used and the elements which render it different from the mark which is registered, and seek to determine whether or not those elements do alter the distinctive character of the mark which is registered. If the distinctive character of the mark is altered, then section 46(2) cannot avail the proprietor. Accordingly I agree with Mr. Thorley, Q.C. that the sub-section is of relatively narrow scope.”

42) Before deciding on whether the use of the trade mark in suit is the sort of use that section 46(2) envisages I need to consider when the issue should be judged. Should it be at the point of application or some later date? The issue before me relates to use after registration. I consider that the use, therefore, must be considered in relation to the questioned period of use. In this case that is from 12 November 1995 to 12 February 2001; the date of filing and the date five years and three months prior to this. (The applicant has chosen a period of five years and three months rather than five years.) It is not really practical to consider the distinctive elements of a trade mark in a continuum. I have nothing before me to suggest that there would have been any great difference between the perception of the trade mark’s distinctive elements on 12 November 1995 and on 12 February 2001, or on any date in between. I will view the position as of 12 February 2001, I cannot see that the registered proprietor would be in any better position if I chose an earlier date.

43) The trade mark in suit was registered under the 1938 Trade Marks Act and exclusive use of the word element is disclaimed. Taking 12 February 2001 as the date for consideration I do not consider that the disclaimer has a bearing on my consideration under section 46(2). I am considering the trade mark in suit, not testing it. I do not consider that the disclaimer issue in revocation for non-use cases is on a par with the position in relation to section 5 objections (see *Paco/Paco Life of Colour* [2000] RPC 451). Disclaimers were entered for a variety of reasons under the 1938 Act and often the elements disclaimed might be considered distinctive nowadays.

44) In this case there is a stylised “a” device and the word ENSURE. I consider that this word at the date of the application for revocation was reasonably distinctive, despite the disclaimer. However, that it is reasonably distinctive does not take me very far. I have to

consider all the elements of the trade mark in suit as registered and how they contribute to the distinctive character of the trade mark as a whole.

45) There is no evidence to show use of the word ENSURE in any proximity to the stylised letter “a”. This letter “a” does appear on the product but on a different visual plane. It is well away from the word ENSURE. The stylised letter “a” is also very much smaller than the word ENSURE. In the registered trade mark it is the stylised “a” which is dominant. It dwarfs the word element. In the use shown it is the word ENSURE that dominates. The space between the word ENSURE and the “a” is so great that I do not consider that they would be seen to form a single trade mark. The use separates the two elements and uses them very much as separate trade marks, rather than as the one trade mark.

46) Mr Thorley and Mr Kitchin both consider section 46(2) to be of a limited scope. I do not consider that the use shown is of sufficient immateriality as not to alter the overall distinctive character of the trade mark as registered. Indeed, I find the very opposite. I consider that the use represents a massive alteration; the essence of the trade mark as registered is lost.

47) I find that the registered proprietor has not shown use of the trade mark in suit either in the form as registered or in a form which complies with section 46(2) of the Act.

Proper reasons for non-use

48) In Ms McFarland’s skeleton argument she dealt with proper reasons for non-use by a reference to “Kerly’s Law of Trade Marks and Trade Names – 13th Edition”. She did not elucidate further as to the basis of the claim that the registered proprietor had proper reasons for non-use.

49) Proper reasons for non-use have been dealt with in *Philosophy Inc v Ferretti Studio SRL* [2002] EWCA Civ921 and *Magic Ball Trade Mark* [2000] RPC 439. In *Magic Ball Park J* stated:

“As regards the new Act, there has been no discussion yet in the High Court or above of the words "proper reasons". There is one earlier decision of a hearing officer in *Invermont Trade Mark* [1997] R.P.C. 125. The officer, in a passage cited and relied on by his colleague who decided the present case, said this: "... bearing in mind the need to judge these things in a business sense, and also bearing in mind the emphasis which is, and has always been placed on the requirement to use a trade mark or lose it, I think the word proper, in the context of section 46 means: apt, acceptable, reasonable, justifiable in all the circumstances. I do not think that the term "proper" was intended to cover normal situations or routine difficulties. I think it much more likely that it is intended to cover abnormal situations in the industry or the market, or even perhaps some

temporary but serious disruption affecting the registered proprietor's business. Normal delays occasioned by some unavoidable regulatory requirement, such as the approval of a medicine, might be acceptable but not, I think, the normal delays found in the marketing function. These are matters within the businessman's own control and I think he should plan accordingly."

I have no disagreement with anything which the hearing officer said in the INVERMONT case. I would only add the comment that, while the adjectives which he puts forward--"apt, acceptable, reasonable, justifiable in all the circumstances"--seem to me to be well chosen, it must not be forgotten that the statutory word which falls to be applied is "proper", not any of the near-synonyms which the hearing officer suggested."

50) Both Park J and Gibson LJ in *Philosophy* point out that the issue of non-use has to be considered in the context of article 19 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). This article states:

"1. If use is required to maintain a registration, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reasons based on the existence of obstacles to such use are shown by the trademark owner. Circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions on or other government requirements for goods or services protected by the trademark, shall be recognized as valid reasons for non-use."

The registered proprietor needs to show that there have been exceptional circumstances for the non-use of the trade mark in suit, moreover circumstances that arise independently of his own will. The facts of this case militate against any finding in favour of the proprietor in relation to proper reasons for non-use. He has had a considerable period of time since registration to use his trade mark. There is no evidence that he has ever used it.

51) In his evidence the proprietor seems to base his claim that there are proper reasons for the non-use of the trade mark in suit on the basis that the goods sold under it are sanctioned by the ACBS for prescription. Such a sanctioning still does not deal with explaining why the trade mark has not been used. The ACBS sanctions goods so that they can be prescribed under the NHS. The ACBS is not equivalent to the Medicines Control Agency. (I deal further with the "ACBS issue" below.)

52) The proprietor has put forward no evidence nor cogent argument as to why the trade mark has not been used. Indeed, in the face of his claim that it has been used it would be difficult for him to muster a compelling argument. He seems to have chosen, for whatever reason, to use a trade mark other than which has been registered.

53) I find that there are no proper reasons for non-use of the trade mark in suit.

54) As I have found that the trade mark in suit has not been used and that there are no proper reasons for non-use the application succeeds completely. However, in the event that I am wrong in the above, I will deal with claims of the proprietor that the use he has made is use in respect of all the goods of the specification of the trade mark in suit.

55) The use shown, if not in relation to the trade mark in suit, is for several food products. They are either nutritional supplements or supply a complete nutritional intake. The labelling of the goods and the documentation in relation to them shows that the goods are designed for those who are suffering from a serious illness or recovering from a serious illness. I have no doubt that such goods fall within the category of *invalids' foods*; goods which the applicant has not attacked in this action.

56) The proprietor considers that this use is also use in relation to "*pharmaceutical, veterinary and sanitary preparations and substances; infants' foods*".

57) In considering these matters I follow the finding of Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 where he stated:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor."

I give the words in the specification their natural meaning, but within the context that they appear in a specification derived from the International Classification of Goods and Services.

58) In his submissions Mr Dunlop stated that "use is what you do in the market". I consider that this reflects the correct position. A revocation action for non-use is about the reality of use, it is not a hypothetical and/or theoretical exercise.

59) Ms McFarland included dictionary definitions with her skeleton arguments in relation to the various terms in the specification. The definition of *pharmaceutical* is no different to what I consider is the natural meaning; relating to medicinal drugs. None of the goods for which use has been shown can be defined, in any normal sense, as drugs either medicinal or otherwise. In the proprietor's evidence the argument is put forward that his goods can be described as *pharmaceutical preparations and substances* as they are approved by the ACBS. He argues that they are treated as drugs and therefore are drugs. For the goods to be treated as drugs means that they are not drugs, or else there would be no need to treat them as drugs. They would be drugs. This is enough for the argument of the proprietor to fall. However, I do not consider that the products are actually treated as drugs in any meaningful sense.

60) I have read the details from the extract from the website of the United Kingdom Prescription Pricing Authority, which was furnished by the proprietor. I have also read the NHS (General Medical Services) Regulations 1992. The NHS (General Medical Services) Regulations 1992 amongst many other topics deal with what can be prescribed and what cannot for purposes of NHS reimbursement. Certain products are neither medicines nor appliances and so normally the NHS would not cover their prescription. However, a practitioner might consider they would be of assistance to his patient. If the product is approved by the ACBS the practitioner writes the letters ACBS on the prescription and there will be no query as to the NHS allowing the prescription. If the product is not a product approved by the ACBS the prescription will be referred to a Family Health Services Authority who will then consider whether the prescription was appropriate. Approval by the ACBS does not indicate that the product is a drug or equivalent to a drug. The ACBS approval is simply an administrative way of allowing for patients to receive products which would be beneficial to their health through the NHS. It is a mechanism of the NHS, nothing more and nothing less. Being approved by the ACBS is not an indication that a product is a drug. In fact the opposite is the case, approval by the ACBS is for products that are not drugs.

61) Based upon the evidence before me I do not consider that there has been use in relation to *pharmaceutical preparations and substances*.

62) I turn now to *veterinary preparations and substances*. The claim to use in relation to these goods is based upon printouts from websites in the United States of America, none of which seem to have any relationship with the proprietor. There has been no indication that the goods have been used for animals in the United Kingdom. More importantly there is no evidence that the goods have been targeted or designed for species other than humans. The use must be based upon the reality of that use. I might throw bread to ducks in the park, that I do this does not mean that a claim can be made that the trade mark for the bread has been used in relation to animal foodstuffs. If the producer of the bread specifically targeted the bread to feeding animals that would be a different matter; the reality of the market place would show that he is trading in animal foodstuffs.

63) Based upon the evidence before me I do not consider that there has been use in relation to *veterinary preparations and substances*.

64) Ms McFarland, based on her dictionary definition, concluded that *sanitary preparations and substances* would be included in the goods for which use has been shown as they all assist in the health of a person. The natural meaning of *sanitary preparations and substances* is I believe goods such as disinfectants and antiseptics. In the context of International Classification of Goods and Services it might also be considered to encompass sanitary towels, tampons and the like goods. Certainly not the goods for which the proprietor has shown use. *Sanitary preparations and substances* is not the easiest term to which a definition can be given. It is easier to say what it does not cover. It does not cover, in my view, nutritional products for the sick.

65) Based upon the evidence before me I do not consider that there has been use in relation to *sanitary preparations and substances*.

66) The parties have put in evidence to define what an infant is. They have also argued their cases. Mr Dunlop argues that an infant is a child under one year of age. Ms McFarland considers that the final age range goes much further. It would appear that the English version of the International Classification of Goods, from which the wording of the specification would appear to have been taken, is not a direct translation of the original French which is *aliments pour bébés*. So, in the French the goods are foods for babies rather than infants. If I took that as the starting point I would then be left with defining a baby rather than an infant, so I would not be helped greatly. I certainly do not consider, in natural usage, that at the age of one year an infant ceases to be an infant and becomes something else. Mr Dunlop referred me to regulations relating to infant formula and the definition of an infant there. The definition in a piece of government legislation is for its own purposes. It does not define the word infant definitively and in all contexts. Mr Dunlop clearly considered his preferred definition important as the guidance for usage of the proprietor's products states that they are not for use for children under one year of age.

67) I do not consider that there is a clear and definitive definition of an infant. I accept that it is used in relation to a young child. I am not convinced that at the age of one a child ceases to be an infant. From all the evidence before me, the submissions I have heard and my own experience and knowledge I consider that an infant is a young child; a young child that could be more than a year of age.

68) Having considered all the evidence I am of the view that the goods have been used for persons over one year of age and under five years of age; whether they are described as infants, toddlers or children. That a nutritional foodstuff may be taken by a child, within the context of the International Classification of Goods and Services, does not mean that it will be defined as *infants' foods*. In the context I am of the view that *infants' foods* means foods that are specifically designed and marketed for infants; not foods that can be taken by infants as well as all other age ranges. I have often seen young children/infants eating packets of crisps. That they eat crisps does not mean that the crisps are *infants' foods*, rather that they are foods that might be eaten by infants. The goods in question are for all age ranges above one; the caution that has to be used in relation to children between the age of one and five indicates that this age group does not represent the main target population. The purpose, the nature, the marketing of the goods of the proprietor are all for foods for the ill; not foods for infants. Whoever ingests these goods does not change the reality of the evidence.

69) Based upon the evidence before me I do not consider that there has been use in relation to *infants' foods*.

Conclusion

70) I have decided above that the registered proprietor has failed on three counts in relation to proof of use; the first two of which are fatal to his case. In the relevant period he has shown no use of the trade mark as registered. His evidence, indeed, does not deal with the registered trade mark but with the trade mark ENSURE. That is not the trade mark that he has registered. This case is an example, I believe, of what Mr Thorley was referring to in *Bud* when he stated:

“On the other hand, where a proprietor wishes to alter his mark or believes that his mark has become sufficiently distinctive in a different form to be registrable in that form, it is right that he should register it in that form and allow the former unused registration to lapse.”

71) As Advocate General Colomer stated in *Ansul BV contra Ajax Brandbeveiliging BV* genuine use of a trade mark requires use of the trade mark in the form that it was accepted and registered with all the elements that compose it, except where the difference lies in elements that do not alter the distinctive character of the trade mark:

“Por la misma razón, la idea de «uso efectivo» exige la utilización del signo, tal y como fue concedido e inscrito, con todos los elementos que lo compongan, salvo que, por excepción, la diferencia estribe en elementos que no alteren el carácter distintivo de la marca «en la forma bajo la que haya sido registrada».”

There has been no use of the trade mark as registered and so there can have been no genuine use of it.

72) In the recitals to the Directive the following is stated:

“it is essential to require that registered trade marks must actually be used, or if not used be subject to revocation”.

That essential requirement demands that I revoke the registration to the full extent of the application.

73) Section 46(6) of the Act states that:

“(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 existed at an earlier date, that date.”

In this case the applicant specified the period of non-use as being five years and three months prior to his application. No use has been shown in this period. Consequently, I am satisfied that the grounds for revocation existed at least three months before the date of the application.

74) It is my decision, therefore, that the registration in suit should be revoked in respect of all the contested goods with effect from 12 November 2000. The specification will, therefore, be limited to *invalids' foods* with effect from 12 November 2000.

75) The applicant for revocation is entitled to a contribution towards his costs. I, therefore, order the registered proprietor to pay him the sum of £1200. This sum takes into account that this is one of two parallel cases for which the bulk of the evidence and the argument was the same. Consequently, all the costs, with the exception of the revocation fee, have been split between the two cases. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26 day of September 2002

**D.W.Landau
For the Registrar
the Comptroller-General**