O-098-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 84663
BY ASPEN GLOBAL INCORPORATED FOR REVOCATION OF
REGISTRATION NO. 730598 IN THE NAME OF
MERCURY PHARMA GROUP LIMITED**

BACKGROUND

1. Registration No. 730598 for the trade mark **ELTROXIN** was applied for on 25 May 1954 in the name of Glaxo Laboratories Ltd; the registration procedure was completed in September 1954. The trade mark is registered for: "All goods included in Class 5". Following a number of assignments in the intervening years, the trade mark now stands in the name of Mercury Pharma Group Limited ("the proprietor").

2. On 6 February 2013, Aspen Global Incorporated ("the applicant") applied for revocation of this registration under the provisions of section 46(1)(b) of the Trade Marks Act 1994 ("the Act"). The applicant indicates that revocation in sought in respect of all the goods for which the mark is registered: "with the exception of pharmaceutical preparations for use in the treatment of thyroid disorders". The applicant asks for the registration to be revoked with effect from 11 August 2011.

3. On 9 April 2013, the proprietor filed a form TM8 and counterstatement. In its counterstatement it stated:

> "3. [The proprietor] has, prior to, during and after the 5 – year period of 11 August 2006 and 10 August 2011...put the trade mark to genuine use in the United Kingdom.
>
> 4. The genuine use in the United Kingdom to which [the proprietor] has put the trade mark is for pharmaceutical preparations. Pharmaceutical preparations is a fair specification having regard to the use made and the respective interests of [the proprietor], other traders and the public, the relevant trade. It is how the average consumer would fairly describe the goods in relation to which the trade mark has been used and the nature of the goods, the circumstances of the trade, and the breadth of use."

4. Both parties filed evidence. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing.

EVIDENCE

The proprietor's evidence

5. This consists of two statutory declarations from Robert James Sully, both dated 30 May 2013. Mr Sully is the General Counsel of Amdipharm Mercury Company Limited ("Amdipharm"). He explains that he was previously Director of Legal and Corporate Affairs at the proprietor, adding that the proprietor is now a group company of Amdipharm.

6. Exhibit RS1 consists of what Mr Sully describes as:

> "4...two sets of sales figures [for the proprietor's] ELTROXIN products between 2005 and 2012. These figures show sales in the United Kingdom...The first set of figures is from

[the proprietor's] own sales records. The second set of sales figures is compiled by IMS Health."

7. Mr Sully explains, and exhibit RS2 confirms, that IMS Health is an independent provider of information and services for the healthcare industry. Although it is not absolutely clear (to me at least) where "the first set of figures" ends and "the second set of figures" begins, I note that the first page of the exhibit is entitled "Sales Data for Eltroxin". It relates to sales of the Eltroxin product in the UK in 25, 50 and 100mcg tablet form. Although it is not made clear, as the sales figures relate to the UK, I have inferred that they are in £ Sterling. The consolidated figures are as follows:

Period	**Volume**	**Sales**
2011-2012	1,792,061	1,694,827
2010-2011	1,867,260	1,672,654
2009-2010	1,405,135	1,252,315
2008-2009	859, 042	683,444
2007-2008	886,773	728,844
Total	**6,810,271**	**6,032,084**

8. Mr Sully states:

"5. I confirm that [the proprietor's] ELTROXIN products are distributed throughout the United Kingdom".

Exhibit RS3 is described as a "third set of sales figures", this time produced independently by Primary Care Trusts ("PCT"), details of which are provided as exhibit RS4. Mr Sully explains that PCTs are part of the National Health Service in England adding that they commission and manage many of the healthcare services provided under the NHS. He states:

"5...The sales figures at RS3 are itemised by regional sales in the United Kingdom. These PCT sales figures show that [the proprietor's] ELTROXIN products are widely sold throughout many regions in the UK."

Mr Sully states that the proprietor distributes its ELTROXIN products through pre-wholesale distributors; its current pre-wholesale distributor being UniDrug Distribution Group Limited. ELTROXIN products, states Mr Sully, are distributed to healthcare professional and patients throughout the UK.

9. Whilst the image quality of exhibit RS3 is poor, it appears to refer to the period January 2011 to April 2012 and contains references to a wide range of geographical locations throughout the UK. Mr Sully states that the proprietor operates a website at www.mercurypharma.com. Prior to its change of name (to Mercury Pharma) in 2012, it website was at www.goldshieldgroup.com. Exhibit RS5 consists of pages taken from the first website mentioned above dated 1 June and 23 July 2012. Also included in the exhibit are pages obtained using the internet archive waybackmachine from 2009 and 2010 which relate to the second website mentioned above. Mr Sully states:

> "7...I confirm that the extracts taken from the website [at exhibit RS5] were previously available in the same form at www.goldshieldgroup.com."

I note that page 33 of the exhibit (dated 23 July 2012), contains the following text:

> "Mercury Pharma Announces The Launch Of Eltroxin® (Levothyroxine) Oral Solution in A Range of Three Strengths.
>
> Hot on the heels of World Thyroid Day (May 26th), a day which promoted global awareness and understanding of thyroid health, Mercury Pharma is pleased to announce the extension of its range of Eltroxin ® (levothyroxine) presentations to include new oral solutions in three strengths 25, 50 and 100mcg.
>
> Added to Mercury Pharma's matching strengths of Eltroxin ® tablets, now no other equivalent thyroid medication has such an extensive range.
>
> Eltroxin ® is licensed for the treatment of congenital or acquired hypothyroidism; diffuse non topic...; ... associated with Hashimoto's thyroiditis, and for suppression therapy in thyroid carcinoma.
>
> The availability of Eltroxin ® oral solution in three strengths (including 100mcg) will allow prescribers to more carefully tailor the levothyroxine dose more precisely, and in line with the patient's THS levels."

Page 38 of the same exhibit (dated January 2010) contains the following text:

> "Our product portfolio includes products such as.....Eltroxin® (indicated for the control of hypothyroidism, congenital hypothyroidism and juvenile myxoedama)..."

10. Mr Sully states:

> "8. The summary of product characteristics for [the proprietor's] ELTROXIN products is available at www.medicinesorg.uk... These summaries of product characteristics provide information for healthcare professionals and patient guidelines for [the proprietor's] ELTROXIN products. These summaries of product characteristics for [the proprietor's] ELTROXIN products have been available [at the above website] since 4 December 2009 and they were available to healthcare professional prior to that date."

11. Exhibit RS6 consists of what appears to be undated pages taken from the website mentioned for the proprietor's Eltroxin products i.e. 25, 50 and 100mcg tablets; the Marketing Authorisation Holder is shown as Goldshield Group Limited and Goldshield Pharmaceuticals Ltd. In relation to "Therapeutic indications" the text reads:

> "Recommended clinical indications: Control of hypothyroidism, congenital hypothyroidism and juvenile myxoedama".

12. Exhibit RS7 consists of a patient information leaflet for "Eltroxin® 25 micrograms Tablets". Under the heading:

> "1. What Eltroxin Tablets are and what they are used for",

there appears the following text:

> "Eltroxin contains levothyroxine sodium which is a synthetic form of the hormone thyroxine. Thyroxine is normally in the body produced by the thyroid gland in the neck. It controls many bodily functions, mainly to do with growth and energy. Eltroxin is used to treat an under active thyroid which is not producing thyroxine."

The page provided bears the legend: "Proof 1 12/3/12" the Marketing Authorisation Holder is shown as Mercury Pharmaceuticals Ltd which Mr Sully explains is a group company of the proprietor.

13. Exhibit RS8 consists of samples of packaging of which Mr Sully states:

> "10...The packaging samples...show the packaging for [the proprietor's] ELTROXIN products sold in the United Kingdom now, and the packaging in which [the proprietor's] ELTROXIN products were sold prior to 12 August 2011 under its former names Goldshield Group Ltd and its trading name Goldshield Pharmaceuticals...I confirm these are a true and accurate representation of the packaging for [the proprietor's] ELTROXIN products in the United Kingdom between 2001 and today."

All of the packaging provided bears, inter alia, the word Eltroxin and relates to Levothyroxine Sodium.

The applicant's evidence

14. This consists of a witness statement form Bernadette Walsh, a trade mark attorney and the managing director of MacLachlan & Donaldson (Ireland), the applicant's professional representatives before the Office for Harmonisation in the Internal market ("OHIM"). Having provided background to the dispute between the parties, Ms Walsh notes that in a letter to the OHIM dated 8 August 2012 provided as exhibit BW1, the proprietor's professional representatives, Baker Botts UK LLP, stated:

> "ELTROXIN is a sign used in the United Kingdom and is an unregistered trade mark or other sign used in Ireland by Mercury Pharma to denote its products in the UK and Ireland. The product concerned is the hydrated form of levothyroxine sodium and is a pharmaceutical product for the treatment of hypothyroidism. It is sold in the United Kingdom and Ireland by Mercury Pharma under the brand name ELTROXIN."

15. Ms Walsh states:

> "3. The evidence adduced on behalf of [the proprietor] in these proceedings indicates that the only product for which the ELTROXIN trade mark has been used during the relevant five year period is a product containing the active ingredient levothyroxine..."

Exhibit BW2 consists of what appears to be an undated extract obtained from www.netdoctor.co.uk in relation to "Eltroxin (levothyroxine)". It indicates that it is used for "underproduction of thyroid hormones by the thyroid gland (hypothyroidism)". Exhibit BW3 consists of what appears to be an undated extract from www.mims.co.uk which, under the heading "Drugs by Name" contains the following text:

> "Eltroxin (Levothyroxine) Endocrine – Thyroid disorders".

Ms Walsh concludes that:

> "5...the registration should be cancelled in respect of all the goods for which it is registered other than pharmaceutical preparations for use in the treatment of thyroid disorders."

Proprietor's evidence-in-reply

16. This consists of a witness statement from Neil Coulson, a solicitor and special counsel at Baker Botts. Mr Coulson states:

> "4. The criteria used by the Medicines and Healthcare Products Regulatory Agency ("MHRA") in assessing the suitability of invented names for use in relation to medicines is set out in the MHRA Guidelines for the Naming of Medicinal Products and Braille Requirements for Name of Label ("the Guidelines")...
>
> 5. Under the Guidelines, the MHRA will not approve the name of a medicinal product if it is liable to create confusion in print, handwriting or speech with the name of another medicinal product.
>
> 6. It is submitted that since the MHRA does not permit the use of confusingly similar names in relation to different medicinal products, a specification of "pharmaceutical preparations" is fair and reasonable in all the circumstances."

Exhibit NC1 consists of the guidelines mentioned.

17. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

The Law

18. Section 46 of the Act reads as follows:

> "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 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)…..
>
> (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."

Section 100 of the Act is also relevant and reads:

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

The relevant five year period

19. The application for revocation is based upon section 46(1)(b) of the Act, with a revocation date of 11 August 2011 sought. The relevant period is therefore: 11 August 2006 to 10 August 2011.

The authorities on genuine use

20. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (CJEU) in relation to genuine use of a trade mark:

"In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07*Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider* v *OHIM* [2006] ECR I-4237):

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

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]"".

21. The proprietor's mark is currently registered for: "All goods in Class 5". The applicant seeks revocation in respect of all of these goods: "with the exception of pharmaceutical preparations for use in the treatment of thyroid disorders." In its counterstatement, the proprietor accepts that its registration should be revoked, but submits that it should remain registered in respect of "pharmaceutical preparations". The relevant period for the assessment is: 11 August 2006 to 10 August 2011. I should begin by saying that the quality of reproduction of large parts of the proprietor's evidence leaves a lot to be desired and some of the explanations provided by it are, to me at least, somewhat unclear. However, the applicant has not challenged the proprietor's evidence and accepts that the mark has been used; what it does not accept is that it should remain registered for pharmaceutical preparations at large.

22. The proprietor's evidence indicates that in the period 2007-2012 (some of which will be after the relevant period), it has used the mark the subject of these proceedings. Although the mark is registered in upper case and the use that has been shown is overwhelmingly in title case (there are some examples in the evidence of the mark used in upper case), this minor variation in presentation does not even begin to engage the considerations contained in section 46(2) of

the Act. In the period mentioned above, the proprietor has sold some 6.8m tablets under the mark (the oral solution, it appears, was not introduced until after the relevant period) with sales (which have been made throughout the UK) in the same period amounting to some £6m. Although some of the sales mentioned above relate to a period after the relevant period, I note that volume and sales in the period 2007-2011 (i.e. within the relevant period) amounted to some 5 million tablets and £4.3m. On the basis of the totality of the proprietor's evidence, I have no hesitation concluding that in the relevant period the proprietor has made genuine use of its ELTROXIN mark. However, as the applicant submits, the evidence provided indicates that all of this use has (to use the proprietor's own words) been in relation to pharmaceutical products for the treatment of hypothyroidism i.e. an underactive thyroid. In its counterstatement, the proprietor stated:

> "4. The genuine use in the United Kingdom to which [the proprietor] has put the trade mark is for pharmaceutical preparations. Pharmaceutical preparations is a fair specification having regard to the use made and the respective interests of [the proprietor], other traders and the public, the relevant trade. It is how the average consumer would fairly describe the goods in relation to which the trade mark has been used and the nature of the goods, the circumstances of the trade, and the breadth of use."

23. This view is repeated by Mr Sully in his declaration and by Mr Coulson in his witness statement. However, insofar as Mr Coulson relies upon the content of the MHRA's Guidelines for the naming of medicinal products, I am not, in these proceedings, concerned with the issue of confusion. All that I am concerned with is whether the proprietor has made genuine use of its mark (which I have concluded it has) and what, having reached that conclusion, constitutes a fair specification.

24. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 the court stated in relation to determining what constitutes a fair specification:

> "29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in Decon suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

In *Animal Trade Mark* [2004] FSR 19, Mr Justice Jacob stated:

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

In *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03 the Court of First Instance (now the General Court stated:

"45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify

within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

Finally, In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL-O-345/10, Mr Geoffrey Hobbs Q.C., sitting as the appointed person stated:

> "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 Page 17 of 35 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 reaching a conclusion, I also note the comments of the General Court in, inter alia, *GlaxoSmithKline SpA and others v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Cases T-493/07, T-26/08, T-27/08 and *Kureha Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-487/08. In the first of these cases, the court stated:

> "35 In the present case, it must be noted that, as is apparent from the case-law, the category of pharmaceutical preparations is sufficiently broad for it to be possible to identify within it various sub-categories capable of being viewed independently (Case T-483/04 Armour Pharmaceutical v OHIM – Teva Pharmaceutical Industries(GALZIN) [2006] ECR II-4109, paragraph 28, and Case T-256/04 Mundipharma v OHIM – Altana Pharma(RESPICUR) [2007] ECR II-449, paragraph 26).

> 36 The concept of pharmaceutical preparation covers goods which are sufficiently different in their intended purpose and end consumers, according to their specific therapeutic indications, and in their channels of distribution, depending on whether they are available on medical prescription or over the counter, for it to be possible to identify within it various sub-categories (GALZIN, paragraph 28).
>
> 37 In addition, the criterion of the purpose or intended use of the product or service in question is of fundamental importance in the definition of a sub-category of goods or services, and the purpose and intended use of a therapeutic preparation are expressed in its therapeutic indication (RESPICUR, paragraphs 29 and 30)."

In *Kureha*, the court stated:

> "59 In that context, it is important to underline, first, that the criterion of the purpose or intended use of the product is of fundamental importance in the definition of a sub-category of goods and, second, that the purpose and intended use of a therapeutic preparation are expressed in its therapeutic indication. It must also be noted that a given medical condition can often be treated using a number of types of medication in various pharmaceutical forms containing different active ingredients, some of which are available over-the-counter whilst others are available only on prescription and must be administered by medical staff (see, to that effect, RESPICUR, paragraph 56 above, paragraphs 29 to 31).
>
> 60 In the light of the considerations set out in paragraphs 56 to 59 above, it is clear that the sub-category of goods suggested by the applicant, namely 'a sterile solution of adenosine for use in the treatment of a specific heart condition, being for intravenous administration in hospitals' cannot be accepted. That definition is not compatible with the case-law cited above, since, in giving not only the therapeutic indication but also the pharmaceutical form (liquid), the active substance (adenosine) and the method and place of administration (intravenous in a hospital), that definition encompasses only goods which are almost identical to those covered by the intervener's trade mark and does not correspond to a category or to a sub-category of goods.
>
> 61 By contrast, the sub-category of goods identified by the Opposition Division and confirmed by the Board of Appeal, that is 'pharmaceutical preparations for the treatment of the heart', must be approved insofar as, first, it is based on the therapeutic indication of the goods at issue and, second, it is sufficiently broad not to undermine the intervener's legitimate interest in being able, in future, to extend its range of goods or services while enjoying the protection which registration of that trade mark confers on it."

26. The evidence provided shows that during the relevant period all of the proprietor's goods sold under its ELTROXIN mark have been in tablet form and have been for the treatment of an underactive thyroid. The evidence (albeit from after the relevant period) also shows that the proprietor's goods have been made available in the form of an oral solution. Applying the proprietor's own test (outlined in paragraph 22 above), the average consumer of the goods at issue (be it a healthcare professional such as a doctor or pharmacist or a member of the public

as a patient), will, in my view, describe the use the proprietor has made of its mark in the manner in which the applicant submits. The phrase: "Pharmaceutical preparations for use in the treatment of thyroid disorders" is based upon the therapeutic indication of the proprietor's ELTROXIN product, is a sufficiently broad term, and, in my view, represents a fair specification based upon the use the proprietor has shown it has made of its ELTROXIN mark.

Conclusion

27. The application succeeds under section 46(1)(b) of the Act. The proprietor's mark is to be revoked with effect from 11 August 2011 in respect of all of the goods for which it is registered save for:

"Pharmaceutical preparations for use in the treatment of thyroid disorders".

Costs

28. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the proprietor's statement:	£200
Preparing evidence and considering the proprietor's evidence:	£500
Application fee:	£200
Total:	**£900**

29. I order Mercury Pharma Group Limited to pay to Aspen Global Incorporated the sum of **£900**. 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 4th day of March 2014

C J BOWEN
For the Registrar
the Comptroller-General