

O/868/21

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF REGISTRATION NO. UK0000645168
IN THE NAME OF ERNEST JACKSON & CO. LIMITED
IN CLASS 5**

**AND AN APPLICATION FOR REVOCATION
UNDER NO. 503392
BY SOHO FLORDIS UK LIMITED**

AND

**IN THE MATTER OF REGISTRATION NO. UK00003017684
IN THE NAME OF ERNEST JACKSON & CO. LIMITED
IN CLASS 5**

**AND AN APPLICATION FOR REVOCATION
UNDER NO. 503393
BY SOHO FLORDIS UK LIMITED**

BACKGROUND AND PLEADINGS

1. The following trade marks stand registered in the name of Ernest Jackson & Co. Limited (“the proprietor”):

a) UK registration no. 645168

POTTER'S.

Filing date: 22 February 1946

Publication date: 26 February 1947

Registration date: 22 February 1946

Goods

Class 5: Pharmaceutical preparations and substances, medicated and tonic foods for infants and invalids, insecticides, antiseptics and disinfectants.

(“the first registration”)

b) UK registration no. 3017684



Filing date: 10 August 2013

Publication date: 6 September 2013

Registration date: 15 November 2013

Goods

Class 5: Medicated confectionery, including diabetic chocolate and chocolate products, preparations and substances for medical or therapeutic use, pastilles, lozenges, chewing gum and dental gum.

(“the second registration”)

2. Soho Flordis UK Limited (“the applicant”) seeks revocation of the first registration under section 46(1)(b) of the Trade Marks Act 1994 (“the Act”) and the second registration under sections 46(1)(a) and (b) of the Act. The applicant’s claims are directed against all the goods for which the marks are registered, save for ‘*pastilles*’.¹

3. Revocation of the first registration is sought under section 46(1)(b) as a result of alleged non-use of the registration during the following five-year periods:

- Between 19 November 1986 and 18 November 1991, seeking an effective revocation date of 19 November 1991;
- Between 19 November 1991 and 18 November 1996, seeking an effective revocation date of 19 November 1996;
- Between 20 October 2015 and 19 October 2020, seeking an effective revocation date of 20 October 2020;

4. As for the second registration, revocation is sought under section 46(1)(a) as a result of alleged non-use in the five-year period immediately following the date on which the mark was registered, i.e. 16 November 2013 to 15 November 2018. The applicant requests an effective date of revocation of 16 November 2018. In addition, revocation is sought under section 46(1)(b) due to alleged non-use in the five-year period between 20 October 2015 and 19 October 2020, seeking an effective revocation date of 20 October 2020.

5. The proprietor filed counterstatements defending a) the first registration for some of the goods for which it is registered, namely, ‘*pharmaceutical preparations and substances*’ and b) the second registration for some of the goods for which it is registered, those being ‘*medicated confectionery, preparations and substances for medical or therapeutic use, pastilles, lozenges*’. The proprietor claims that the

¹ Although this term does not appear within class 5 of the first registration, the applicant concedes that it has been used in relation to these goods, and that they fall somewhere within the specification. More shall be said about this later in this decision.

registered marks have been used in relation to these goods. No claim is made to there being any proper reasons for non-use.

6. By letter dated 27 April 2021, the proceedings were consolidated pursuant to rule 62(g) of the Trade Marks Rules 2008.

7. Both parties filed evidence in chief, which will be summarised to the extent that it is considered necessary. The proprietor did not file evidence in reply. A hearing took place before me, by video conference, on 12 October 2021. The applicant was represented by Mr Tom St Quintin of counsel, instructed by JOSHI-IP.LAW; the proprietor was represented by Ms Charlotte Blythe of counsel, instructed by Wilson Gunn. Both parties filed skeleton arguments in advance of the hearing.

EVIDENCE

The proprietor's evidence

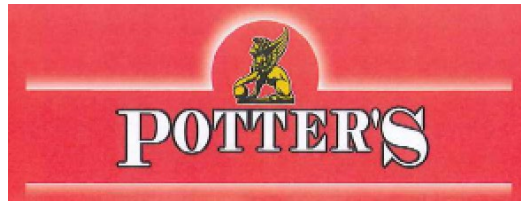
8. The proprietor's evidence consists of the witness statements of Mr David Mark Walter, dated 26 February 2021 and 30 March 2021, together with Exhibit DMW01. The purpose of these statements is to introduce into the evidence the proprietor's proof of use evidence from a prior dispute between the parties before this Tribunal, under opposition number 412928. I note that the first registration was subject to proof of use in those proceedings. Mr Walter's evidence comprises a copy of his own witness statement, dated 25 June 2019, and Exhibits DMW01 to DMW03.

9. Mr Walter confirms that he has been employed by the proprietor for 15 years and has been its Managing Director since his appointment in 2007.² He explains that 'POTTER'S' has been used in respect of, inter alia, catarrh pastilles since the early 19th century, though he outlines that his evidence is to establish genuine use of the mark during the five-year period preceding 30 March 2018.³

² Witness statement of Mr David Mark Walter, dated 25 June 2019, §2

³ Walter, §4

10. According to Mr Walter, the proprietor produces and sells a range of pastilles for the treatment of catarrh, coughs and colds.⁴ He provides copies of advertising posters dated 11 July 2013 to 15 July 2013 and 3 October 2013, respectively.⁵ The following figurative mark can be seen at the top of the posters:



11. This figurative mark can also be seen on the exterior of boxes of various pastilles for the treatment of catarrh, coughs and colds. The plain word 'Potter's' is also visible in the posters. Artwork proofs dated 14 July 2015 and 7 April 2016 have also been evidenced.⁶ The artwork relates to cough pastille packaging designs by a third party. The second registration forms part of the designs.

12. Mr Walter states that, between 2013 and 2018, the proprietor sold more than 6.5m packs of 'POTTER'S' pastilles in the UK.⁷ Annual sales in respect of these products are provided as follows:

| Year | Units sold |
|-------------|-------------------|
| 2013 | 1,109,796 |
| 2014 | 875,118 |
| 2015 | 904,464 |
| 2016 | 1,288,422 |
| 2017 | 1,124,244 |
| 2018 | 1,243,902 |
| Total | 6,545,946 |

⁴ Walter, §5

⁵ Exhibit DMW01

⁶ Exhibit DMW01

⁷ Walter, §6

13. I note that corresponding turnover figures are included in Mr Walter's statement but have been redacted.

14. Sample invoices dated between 7 July 2013 and 21 March 2018 have been exhibited.⁸ These demonstrate the sale of pastilles to a number of third-party retailers, including, inter alia, Tesco, ASDA, Boots, and Savers. 'POTTERS' in word-only format can be seen throughout the invoices. I note that the unit prices have all been redacted.

15. Annual expenditure in relation to the advertising, marketing and promotion of 'POTTER'S' pastilles is given as follows:⁹

| Year | Advertising Expenditure |
|-------------|--------------------------------|
| 2013 | £11,303 |
| 2014 | £14,333 |
| 2015 | £48,809 |
| 2016 | £13,228 |
| 2017 | £14,895 |
| Total | £102,568 |

16. Copies of flyers, an advertisement and an advertorial are evidenced.¹⁰ The flyers are identical to the posters discussed above at paragraphs 10 and 11. The advertisement is for cough pastilles. The second registration is visible towards the top of the page, as well as in the images of product packaging. There is no information about the circulation of the advertisement. It is also undated, though a handwritten note indicates that it is from 2016. The advertorial is on the topic of seasonal colds and flu. The proprietor's cough pastilles feature among the recommended products. The plain word 'POTTER'S' is used in the advertorial and the second registration can be seen in an image of product packaging. Neither the date nor the provenance of the advertorial is clear, though a handwritten note on the same states "TESCO MAGAZINE 2015". Within the promotional materials, there are references to the

⁸ Exhibit DMW02

⁹ Walter, §8

¹⁰ Exhibit DMW03

proprietor's goods being "the leading cough and cold pastille range", "the No.1 Cough and Cold Pastille" and "the fastest-growing cough pastille brand".

17. In his later statements, Mr Walter says that the registrations have been in continuous use since the date of his earlier statement.¹¹

The applicant's evidence

18. The applicant's evidence consists of the witness statement of Mr Manish Joshi, dated 16 June 2021. Mr Joshi confirms that he is the applicant's representative in these proceedings. His statement contains written submissions, rather than evidence of fact, and will be treated as such. While I do not propose to summarise his submissions here, I have taken them into account and will refer to them below, as and where necessary.

DECISION

The law

19. Section 46 of the Act 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;

¹¹ Witness statements of Mr David Mark Walter, dated 26 February and 30 March 2021, §2

(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 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 existing at an earlier date, that date”.

20. Section 100 of the Act is also relevant, which reads:

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

21. 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 on in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

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

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v 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 Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

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

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

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to

create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

My approach

23. There is much common ground between the parties. At the hearing, Mr St Quintin and Ms Blythe were in agreement that the proprietor's registrations have been put to genuine use in respect of pastilles. Moreover, there is no dispute as to whether the form in which the marks have been used differ to the marks as registered. Finally, both parties agree that to the extent to which revocation is ordered, it is to be ordered from the earliest dates claimed.

24. Therefore, it is not necessary for me to assess whether the proprietor has demonstrated genuine use of its registrations, or whether the evidenced marks are acceptable variant uses of the registrations. The matter firmly in issue is the extent to which the proprietor's marks have been genuinely used, i.e. whether the use shown goes above and beyond the goods for which genuine use has been conceded by the applicant. As such, my assessment will focus upon framing a fair specification for the registrations based upon the evidence before me and all the parties' submissions.

Fair specification

25. 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 in relation to fair specification as being:

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

26. 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 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.”

27. At the hearing, both Mr St Quintin and Ms Blythe submitted that the correct approach to be adopted in determining a fair specification is as summarised in *Asos*¹² and *Merck*¹³. In particular, I was referred to the following paragraphs of Kitchin LJ’s judgement in *Merck*:

“245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at

¹² *Maier v Asos Plc* [2015] EWCA Civ 220

¹³ *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834

a fair specification of goods or services having regard to the use which has been made of the mark.”

[...]

250. We are concerned in this case with pharmaceutical substances and preparations. In my view it is now well established that this category of goods is sufficiently broad for it to be possible to identify within it a number of subcategories of goods which are capable of being viewed independently. Further, the purpose and intended use of a pharmaceutical substance or preparation are important in identifying the relevant subcategory to which it belongs; and here therapeutic indication is of particular significance: see, for example, Case T-256/04 *RESPICUR* (supra) at paragraphs [26] to [31]; Case T-483/04 *Armour Pharmaceutical Co v OHIM (GALZIN)* [2006] ECR II-4109 at paragraphs [28] to [29]; Cases T-493/07, T-26/08 and T-27/08 *GlaxoSmithKline and Ors v OHIM (FAMOXIN)* EU:T:2009:355 at paragraphs [35] to [37]; Case T-487/08 *Kureha Corpn. v OHIM (KREMIZIN)* EU:T:2010:237 at paragraphs [56] to [61]; and Case T-258/08 *Matthias Rath v EUIPO* (supra) at paragraph [36].”

28. Mr St Quintin referred me to the decision issued in a prior dispute between the parties, in which the Hearing Officer found that the proprietor had demonstrated genuine use of *‘medicated preparations in the form of pastilles for human use in the treatment of catarrh, coughs and colds’*.¹⁴ I acknowledge the findings of the Hearing Officer in that decision. I also accept that the issue of genuine use was determined on the basis of the same evidence in that case. However, I am not bound by that decision, which Mr St Quintin recognised at the hearing.

29. In relation to the first registration, Mr St Quintin accepted (for the purposes of these proceedings) that the goods shown in evidence fall within *‘pharmaceutical preparations and substances’*. He argued that, within this category, the average consumer will perceive a number of subcategories which are capable of being viewed

¹⁴ BL O/296/20, §20

independently, and that those subcategories must be specified by reference to their therapeutic indication. In this regard, Mr St Quintin contended that the goods for which the proprietor has shown use will, themselves, be perceived as a subcategory of *'pharmaceutical preparations and substances'*, capable of being viewed independently. As for the second registration, Mr St Quintin argued that the use proven by the proprietor falls within *'pastilles'*, which, in his submission, is capable of subdivision by therapeutic indication. The applicant's position is, therefore, that a fair specification for both registrations should be *'pastilles for human use in the treatment of catarrh, coughs and colds'*. Mr St Quintin added that this would not deprive the proprietor of protection for goods that are not in essence different from those for which use has been proven, only those which differ in their essence because they treat other conditions or the same conditions in a different way.

30. In contrast, Ms Blythe submitted that it would be wrong to strictly limit the specification of either registration to *'pastilles'*. She argued that, although the proprietor has only sold products in this form, the key matter to be determined is not the form of the goods but, rather, their therapeutic indication. Ms Blythe argued that the particular form of the product will be far less important to consumers than the condition it treats. Accordingly, while the proprietor accepts there must be some limitation to its specifications, she contended that this should be based solely on the therapeutic indication. Ms Blythe argued that a fair specification of the first registration should be *'pharmaceutical preparations and substances for use in the treatment of catarrh, coughs and colds'*, whereas that of the second registration should be *'medicated confectionary for use in the treatment of catarrh, coughs and colds; pastilles'*. According to Ms Blythe, to limit the specifications as suggested by the applicant would strip the registrations of protection for goods which, although not identical to pastilles, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

The first registration

31. Mr Walter's evidence demonstrates use of the registration exclusively in relation to pastilles for the treatment of catarrh, coughs and colds. Further, the evidence indicates that these goods are solely for human use.

32. I remind myself that the first registration has been defended in respect of *'pharmaceutical preparations and substances'*. This, on any view, is a broad category of goods which encompasses a number of subcategories capable of being viewed independently by consumers.

33. Although the evidence establishes that the registration has been used in respect of one particular kind of product within this broad category, I am mindful that fair protection is not to be achieved by identifying particular examples of goods for which there has been genuine use or by describing that use in the narrowest possible terms.

34. In my view, reducing the specification to *'pastilles for the treatment of catarrh, coughs and colds'* would exclude from protection other goods which, although not the same as pastilles, are not in essence different from them and can only be distinguished from them in an arbitrary way. For instance, lozenges for use in the treatment of the same ailments are not in essence different from the goods shown in evidence and can only be distinguished from them by reference to very specific physical properties, e.g. that one is typically softer than the other. To my mind, this is an arbitrary distinction. I do not consider the fact that the proprietor may have only provided pastilles since the 19th century alters that view. While I acknowledge Mr St Quintin's submissions on the point, the test is not to limit protection to the precise goods for which use has been proven, irrespective of how longstanding that use has been, unless that is what the average consumer would do. Further, I do not agree with his argument that pastilles must constitute an identifiable subcategory of goods because they are in a convenient form. They may, indeed, be a convenient means of delivery. However, other types of pharmaceuticals are also available in convenient forms and, to my mind, they would not all be viewed by consumers as independent subcategories purely on this basis.

35. Nevertheless, I am also unable to accept Ms Blythe's submission that protection ought to be retained for the broad category of *'pharmaceutical preparations and substances'*, only limiting that protection by reference to the therapeutic indication. Although therapeutic indications are of great importance in identifying relevant subcategories of pharmaceutical products, I do not understand the above case law to have established that protection can only be reduced by reference to the same. That

is also true of the decisions of the General Court (“GC”) to which Ms Blythe referred, namely, *Famoxin*, Case T-493/07, *Kremezin*, Case T-487/08, and *Respicur*, Case T-256/04. The *Famoxin* decision is consistent with the approach adopted in *Merck* in stating that the purpose or intended use of the product is of fundamental purpose in the definition of a subcategory of goods, and that these are expressed in its therapeutic indication. This was repeated in the *Kremezin* decision, in which the suggested subcategory ‘*a sterile solution of adenosine for use in the treatment of a specific heart condition, being for intravenous administration in hospitals*’ was not accepted. However, I do not consider this to be of assistance to the proprietor. The rationale against permitting the limitation in that case was because in giving not only the therapeutic indication but also the pharmaceutical form, the active substance and the method and place of administration, it would have restricted protection to only goods which were almost identical to those covered by the trade mark. It was on this basis that the GC held that it did not correspond to a category or subcategory of goods. In addition, I do not consider the circumstances of that case to be sufficiently comparable to the instant case. In *Respicur*, the suggested subcategory ‘*multi-dose dry powder inhalers containing corticoids, available only on prescription*’ was not accepted by the GC as it did not specify any therapeutic indication. Further, as the limitation contained the dosage form, active ingredient and an obligation to obtain a prescription, it was held to be inappropriate for defining a subcategory of goods. Again, these circumstances are plainly not consistent with the present case.

36. Turning back to the instant case, I do not consider use in relation to ‘*pastilles for the treatment of catarrh, coughs and colds*’ sufficient to retain protection for ‘*pharmaceutical preparations and substances for the treatment of catarrh, coughs and colds*’. This would encompass other goods which are in essence different from pastilles, such as, inter alia, cough syrups, nasal sprays and topical medicines, albeit used for the treatment of the same ailments.

37. In consideration of all the above, I find that a fair specification for the first registration is as follows:

Class 5: Medicated confectionery for human use for the treatment of catarrh, coughs and colds.

The second registration

38. As noted above, the evidence demonstrates use of the registration in relation to pastilles for human use for the treatment of catarrh, coughs and colds.

39. Although the proprietor initially defended the second registration in respect of *'medicated confectionery, preparations and substances for medical or therapeutic use, pastilles, lozenges'*, at the hearing, Ms Blythe submitted that a fair specification should read *'medicated confectionery for use in the treatment of catarrh, coughs and colds; pastilles'*. As a result, the proprietor conceded that there has been no use in relation to *'preparations and substances for medical or therapeutic use, lozenges'*. These terms will, therefore, be removed from the specification.

40. To my mind, the limitation proposed by Ms Blythe in relation to the term *'medicated confectionery'*, namely, *'for use in the treatment of catarrh, coughs and colds'*, is consistent with the evidence, the previous decision and the therapeutic indication of the products for which use has been shown. However, as the evidenced goods are solely for human use, I find that *'medicated confectionery for human use for the treatment of catarrh, coughs and colds'* represents an appropriate subcategory of goods.

41. The term *'pastilles'* did not form the subject of the applicant's claim of non-use. As such, it may remain in the specification of the second registration, without any amendment.

42. A fair specification for the second registration is, therefore:

Class 5: Medicated confectionery for human use for the treatment of catarrh, coughs and colds; pastilles.

CONCLUSION

43. The application against the first registration under section 46(1)(b) has been successful in part, resulting in the partial revocation of the proprietor's class 5 specification. As a consequence, that specification will be amended to read:

Class 5: Medicated confectionery for human use for the treatment of catarrh, coughs and colds.

44. The remaining goods in class 5 will be revoked from the earliest date requested under section 46(1)(b), namely, 19 November 1991.

45. Furthermore, the application against the second registration under sections 46(1)(a) and (b) has been partially successful, resulting in the partial revocation of the proprietor's class 5 specification. As a result, the specification will be amended to the following:

Class 5: Medicated confectionery for human use for the treatment of catarrh, coughs and colds; pastilles.

46. The remaining goods in class 5 will be revoked from the earliest date requested, that is from 16 November 2018.

COSTS

47. Costs in proceedings before the Tribunal are usually awarded in accordance with the scale published in Tribunal Practice Notice ("TPN") 2/2016. However, in his skeleton arguments, Mr St Quintin invited me to depart from that scale, submitting that:

"26.1. In issuing these proceedings, [the applicant] made clear that it accepted that use had been made of the Marks for pastilles.

26.2. The application was defended, but only on the basis of use of pastilles, while seeking to maintain a specification of such width that it could never have been justifiable.

26.3. This is not the first occasion on which exactly the evidence of use submitted by [the proprietor] in this dispute has been considered by the tribunal. That evidence was considered in opposition 412928, for which it was originally prepared. That decision, which as reference O-296-20, assessed that evidence and considered the fair specification of the Word Mark to be (its paragraph 20) “*Medicated preparations in the form of pastilles for human use in the treatment of catarrh, coughs and colds*”. That, if anything, is narrower than the specification sought in this revocation action, because it is also limited to “*medicated preparations*”. While [the applicant] does not suggest that decision has any binding effect, it demonstrates the inappropriateness of [the proprietor] seeking in this dispute a much broader specification.”

48. At the hearing, Mr St Quintin explained that his skeleton arguments had been prepared before he had sight of Ms Blythe’s, i.e. on the basis that the proprietor maintained the position that it took in its defences. He stated that the hearing was also prepared for on that basis. He outlined, however, that upon receipt of Ms Blythe’s skeleton arguments it became clear that the proprietor recognised that its position was unsustainable. Whilst he welcomed the narrowing of the issues in these proceedings, he argued that this particular dispute should never have been in issue. Moreover, according to Mr St Quintin, the proprietor ought to have anticipated some narrowing of its specifications due to the prior decision involving the same evidence. This, in his view, adds to the unsustainability of the proprietor’s position in its defences. For these reasons, Mr St Quintin contended that off-scale costs were appropriate for the preparation of the hearing.

49. In contrast, Ms Blythe confirmed that the proprietor was content for costs to be awarded from the scale. In response to the applicant’s request for off-scale costs, she submitted that off-scale costs are unusual in proceedings before the Tribunal and are applicable when a party has behaved in an extremely unreasonable manner or repeatedly breached the rules in a way that has caused another party excessive

wasted costs. Ms Blythe contended that the behaviour in this case was nowhere near that threshold. Furthermore, Ms Blythe submitted that it is not uncommon for parties to narrow issues in advance of a hearing and that this approach should be welcomed.

50. I note that the applicant sought total revocation of both registrations, save for '*pastilles*'. I further note that the proprietor defended its registrations for '*pharmaceutical preparations and substances*' and '*medicated confectionery, preparations and substances for medical or therapeutic use, pastilles, lozenges*'. I have found that the proprietor may retain its registrations for '*medicated confectionery for human use for the treatment of catarrh, coughs and colds*' and '*medicated confectionery for human use for the treatment of catarrh, coughs and colds; pastilles*'. In consideration of the above, the parties have achieved what I would regard as a roughly equal measure of success. I therefore direct that both parties should bear their own costs. For the avoidance of doubt, even if I had made an award of costs in favour of the applicant, having considered the conduct of proceedings, I would have rejected its request for off-scale costs. My reasons follow.

51. Rule 67 of the Trade Marks Rules 2008 provides that "the registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and what parties they are to be paid."

52. TPN 4/2007 indicates that the Tribunal has a wide discretion when it comes to the issue of costs, including making awards above or below the published scale where the circumstances warrant it. The TPN stipulates that costs off the scale are available "to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour". The applicant has not argued that the proprietor has breached any rules or utilised delaying tactics. Therefore, the matter would have been whether the proprietor's conduct in seeking narrower specifications at the hearing than in its defences, as well as the position it originally took in those defences, should be considered unreasonable behaviour, particularly in the knowledge of the prior decision.

53. I agree with Ms Blythe insofar as the narrowing of issues in proceedings before this Tribunal is certainly to be encouraged where appropriate. I have some sympathy with Mr St Quinin in that the proprietor maintained its defence of a wider specification until shortly before the hearing; its concession could have been made at an earlier stage in the proceedings. However, while it may not be entirely desirable, the proprietor's approach does not strike me as an abuse of process or otherwise unreasonable behaviour. A party is able to narrow the issues, or make concessions, as desired at any stage in proceedings, including when preparing for a hearing. I am also unconvinced that the position taken by the proprietor in its defences, notwithstanding the findings in the prior decision, constitutes an abuse of process or unreasonable behaviour. The proprietor could have certainly foreseen some narrowing of its specifications in light of that decision, having filed the same evidence in these proceedings. Nevertheless, it remained open to the proprietor to defend its registrations to the extent that it saw fit.

Dated this 29th day of November 2021

James Hopkins

For the Registrar

The Comptroller-General