

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3,790,454 IN THE NAME OF APPLIED NUTRITION LIMITED

AND IN THE MATTER OF AN OPPOSITION UNDER NUMBERS 435,515 IN THE NAME OF LABORATORIO FARMACEUTICO S.I.T. SPECIALITÀ IGIENICO TERAPEUTICHE S.R.L.

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF CLARE BOUCHER (O/850/23) DATED 8 SEPTEMBER 2023

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DECISION

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**Introduction**

1. This is an appeal from the decision of Ms Clare Boucher, for the Registrar, dated 8 September 2023 (O/850/23). Laboratorio Farmaceutico opposed the registration of Applied Nutrition Limited to register the trade mark, TEXT-X (No 3,790,454) under section 5(2)(b) of the Trade Marks Act 1994. The opposition met with mixed success and Applied Nutrition appeals the decision so far as they were unsuccessful.
2. The application for TEXT-X was for goods in Classes 5, 28 and 32. It was allowed for some goods in Class 5 and for all the goods in Classes 28 and 32. This appeal is only concerned with the following goods in Class 5 which the Hearing Officer refused:

Protein supplements; protein dietary supplements; vitamins and vitamin preparations; vitamin drinks, drops, supplements and tablets; vitamin and mineral supplements and preparations; vitamin and mineral food supplements; dietary supplements; dietary supplements containing CBD oil; food supplements consisting of amino acids; protein, vitamin, dietary, and nutritional supplements in powder, tablet, gel and drop form; protein, vitamin, dietary and nutritional supplements all being for the purpose of sports performance and enhancement, weight loss, weight gain and the improvement of health

3. Laboratorio Farmaceutico opposed the application for these goods based on its earlier mark TESTEX (No 908,349,193). The Respondent was required to prove use and the Hearing Officer found that the mark had been used only on “Pharmaceutical preparations for the treatment of low levels of testosterone”. It was accepted by both parties that TESTEX’s use of the mark had been confined to use of an injectable form of the medication and that the medication had been supplied only on prescription.

**Standard of appeal**

4. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion nor a belief that the Hearing Officer has reached the wrong decision will suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. The principles to be applied were summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch) at [24]. When considering this appeal, and applying these principles, it is important to remember the high bar set.

### **Grounds of appeal**

5. The Appellant challenges the Hearing Officer's decision on three grounds. First, the Appellant submits that the finding of use should have been narrowed to cover the medication only in an injectable form and when supplied on prescription. Secondly, the Appellant submits that it was improper for the Hearing Officer to include persons who misuse anabolic steroids as representative of the average consumer. Finally, there was a general challenge to Hearing Officer's findings as to the similarity of goods. I will consider each ground in turn.

### **The extent of use proved**

6. The Appellant submits that, because the Respondent proved use only in relation to "Pharmaceutical preparations for the treatment of low levels of testosterone" that were injectable and supplied on prescription, these factors should have been part of the "fair specification". The principles that should be applied when determining the fair specification were set out by the Hearing Officer (Decision, [23 to 24]), and in particular she set out the summary by Henry Carr J (citations omitted) in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool)* [2016] EWHC 3103 (Ch) at [47(iii) to (vii)]:

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....

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...

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. ...

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. ...

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...

7. When determining what amounts to the fair specification for pharmaceutical products there is also some guidance from what is now the General Court in T-256/04 *Mundipharma AG v OHIM (RESPICUR)* [2007] ECR II-449, [29 to 31]:

The Court notes in this respect that, since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the product or service in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a sub-category of goods or services.

The purpose and intended use of a therapeutic preparation are expressed in its therapeutic indication. However, the definition employed by the Board of Appeal is not based on that criterion as it does not state that the goods in question are intended for the treatment of health problems and does not specify the nature of those problems.

Moreover, the criteria chosen by the Board of Appeal, namely the dosage form, the active ingredient and the obligation to obtain a doctor's prescription, are, as a rule, inappropriate for defining a sub-category of goods as contemplated in *ALADIN* [T-126/03 *Reckitt Benckiser v OHIM* [2005] ECR II-2861], as the application of those criteria does not fulfil the abovementioned criteria of purpose and intended use of the goods. In fact, a given medical condition can often be treated using a number of types of medication with different dosage forms and containing different active ingredients, some of which are available over-the-counter whilst others are available only on prescription.

8. The Court of Justice in C-31/14 *OHIM v Kessel MEDintim GmbH*, EU:C:2014:2436, [38] and [40] confirmed that the therapeutic indication of a pharmaceutical preparation is relevant for the purposes of defining a subcategory of goods, but the fact it is supplied on prescription is not.
9. Accordingly, one limb of the Appellant's grounds must fail. The fact that the Respondent's goods have been provided only on prescription is immaterial to the drafting of the "fair specification". This leaves the other limb, namely whether its method of administration (injection) is material to that specification.
10. Mr Marsden, for the Appellant, suggests that the fact the medication was supplied only in injectable form is relevant because it goes to its "method of use", which is material to the definition of the sub-category of goods. Furthermore, Mr Marsden says consumers prefer not to have medications administered by injection where other less invasive options are available.
11. Notwithstanding these submissions, it appears to me that the Hearing Officer was right to exclude the method of administering the medication from the fair specification. It is clear from *RESPICUR* that just because a medical condition can be treated by different active ingredients or different dosages does not make it appropriate to include those matters in defining the appropriate sub-category of goods.
12. This general statement extends logically to methods of administration of the medication. Different dosages of a medication can make clinical compliance easier; for instance, a protocol of fewer doses makes it less likely one will be missed. Dosage changes can also make the medication less unpleasant to take (due to less severe side effects) or make it more efficacious. These are all things that consumers would be

expected to prefer. Likewise, a change of active ingredient can make the drug more effective in treatment or reduce side effects. If dosage and active ingredient are not relevant to defining a sub-category, then neither should the method of administration.

13. Therefore, I dismiss the first ground of appeal and uphold the Hearing Officer's fair specification of the goods.

### **Misuse of anabolic steroids**

14. The second ground of appeal challenges the Hearing Officer's finding that those who misuse anabolic steroids are part of the relevant public for the first group of goods, at [32]:

The first goods I shall consider are Protein supplements; protein dietary supplements; food supplements consisting of amino acids; protein ... supplements in powder, tablet, gel and drop form; protein ... supplements all being for the purpose of sports performance and enhancement, weight loss, weight gain and the improvement of health. These goods are used by people who wish to increase their protein intake in order to build or maintain muscle mass and keep their body functioning healthily. There may be some overlap in the users of the respective goods. Anabolic steroids, such as the opponent's testosterone propionate, are sometimes used (without medical advice) to increase muscle mass. In practice, therefore, there is likely to be some overlap in the purpose for which the goods are used. I consider that there will also be some overlap in nature and method of use, as the applicant's goods will mainly be in a form that can be taken orally. I have noted that the opponent's goods are generally available only on prescription, but the pharmacies from which the users would obtain those products would also sell the applicant's supplements. Any competition is likely to be at a low level. The goods are not complementary. Taking all these factors into account, I consider that there is a low degree of similarity between the goods.

15. The Hearing Officer also made a similar finding in the next paragraph, namely that "supplements designed to improve sports performance and enhancement, weight loss and weight gain, I consider that these goods may be used for the same purposes as the unsupervised use of anabolic steroids" (Decision, [33]). Accordingly, she found these goods to be similar to a low degree.
16. Mr Marsden submits that it is improper to include those who misuse anabolic steroids as a relevant public. I accept that there was evidence before the Hearing Officer regarding anabolic steroid misuse (a screenshot from the NHS website) and in certain circumstances it might have been appropriate to take judicial notice of the fact that anabolic steroids are used by those seeking to build muscle mass. However, I do not think it was appropriate to define the average consumer to include those *misusing* anabolic steroids.
17. The Hearing Officer suggested that those misusing Anabolic steroids were doing so "without medical advice". This does not seem strong enough to me. Doctors would strongly advise against taking (and would not prescribe) anabolic steroids to assist with training and the associated building of muscle mass.
18. More problematic still is the fact that anabolic steroids are Class C controlled drugs. While the possession of most Class C drugs is a criminal offence under section 5 of the

Misuse of Drugs Act 1971, the possession of anabolic steroids is specifically excepted from this rule under the Misuse of Drugs Regulations 2001 (SI 2001/3998), reg 4(3). Nevertheless, under section 4 of the 1971 Act, it is a criminal offence to supply anabolic steroids to a person unless that supply is by prescription and by a person listed in regulation 9 of the 2001 Regulations. So even though possession is lawful, a person seeking to misuse anabolic steroids either has to obtain them personally from overseas or by an illegal route.

19. In other words, a person misusing anabolic steroids would not get their supply from a domestic pharmacy operating lawfully. Accordingly, the Hearing Officer was entirely wrong in her factual findings when she suggested the average consumer—being a steroid misuser—would obtain their supply of both anabolic steroids and protein supplements & c from a pharmacy (and likewise the connected findings that flowed from the error). A more serious error is the whole premise upon which the assessment was based. In my view, as a matter of principle it is quite wrong to treat those who purchase goods illegally as representing the average consumer.
20. Therefore, the assessment of the similarity of goods should have taken into account only the average consumer who is taking the medication to increase their testosterone levels for appropriate medical reasons. The evidence before the Hearing Officer was that low levels of testosterone could (in a man) lead to a low sex drive, erectile dysfunction, fatigue, depression as well as being used to treat delayed puberty, it could also be used (in a woman) for treating breast cancer or menopause symptoms.
21. There is no reason for these symptoms in themselves to lead to a patient wishing to build muscle mass or otherwise improve their sporting performance. Accordingly, it is my view that the first group of goods identified by the Hearing Officer as well as sporting supplements (set out above) do not overlap in nature or purpose of use with the medication. The fact that all the products might be sold (on prescription) in a pharmacy and are taken orally is not enough in my mind to make the goods similar.
22. I therefore find that “pharmaceutical preparations for the treatment of low levels of testosterone” are dissimilar to “Protein supplements; protein dietary supplements; food supplements consisting of amino acids; protein ... supplements in powder, tablet, gel and drop form; protein ... supplements all being for the purpose of sports performance and enhancement, weight loss, weight gain and the improvement of health” and also dissimilar to “supplements designed to improve sports performance and enhancement, weight loss and weight gain”. The application can therefore proceed to registration in respect of those goods.

### **General challenge to finding of similarity**

23. The Appellant also challenged the Hearing Officer’s decision as to similarity of goods in respect of the remaining refused goods. The Hearing Officer’s reasoning is set out in Decision, [33]:

The next group comprises Vitamins and vitamin preparations; vitamin drinks, drops, supplements and tablets; vitamin and mineral supplements and preparations; vitamin and

mineral food supplements; dietary supplements; dietary supplements containing CBD oil; vitamin, dietary, and nutritional supplements in powder, tablet, gel and drop form.... These encompass products that may be used for a wide variety of purposes, from improving general health to ameliorating specific conditions or problems. The applicant's evidence indicates that some of the side effects of low levels of testosterone include fatigue and depression, as well as low sex drive and erectile dysfunction. An individual suffering from these symptoms might choose to take particular vitamin and mineral supplements or seek hormone treatment via a medical professional...

24. Mr Marsden submits that this finding is erroneous. In contrast to the other goods, his reasoning in respect of vitamins & c was not as clearly articulated. Essentially, he argued that a medication for treating a particular condition was not similar to substances which might alleviate the symptoms in other ways. In *Pfizer Ltd v Eurofood Link (U.K.) Ltd* [2001] FSR 3, [48 and 49] the court concluded that a drug for treating erectile dysfunction (Viagra which comprises Sildenafil) was similar to a herbal drink that was intended to stimulate a person's libido. In other words, a non-pharmaceutical product which was used to alleviate similar symptoms to those treated by a pharmaceutical product were considered to be similar goods. Accordingly, in my view, the Hearing Officer finding that vitamins & c were similar goods to "pharmaceutical preparations for the treatment of low levels of testosterone" is not something which is outside the bounds of reasonable disagreement. So, in respect of these goods, I uphold the Hearing Officer's decision.

## Conclusion

25. I have overturned the Hearing Officer's decision in relation to some goods but not others. The application should therefore proceed to registration in relation to the following goods in Class 5 (this includes the underlined goods, which have already been accepted by the Hearing Officer).

Protein supplements; protein dietary supplements; meal replacement powders; nutritional supplement meal replacement bars for boosting energy; nutritional drink mix for use as a meal replacement; food supplements consisting of amino acids; edible fish oils for medical purposes; protein, vitamin, dietary and nutritional supplements all being for the purpose of sports performance and enhancement, weight loss, weight gain and the improvement of health.

26. The Hearing Officer's decision in relation to the following goods is upheld and so the application for the following goods in Class 5 is refused:

vitamins and vitamin preparations; vitamin drinks, drops, supplements and tablets; vitamin and mineral supplements and preparations; vitamin and mineral food supplements; dietary supplements; dietary supplements containing CBD oil; protein, vitamin, dietary, and nutritional supplements in powder, tablet, gel and drop form.

27. The Appeal has been partially successful and partially unsuccessful. Therefore, I make no award as to costs. However, the Hearing Officer's award of costs requiring the Respondent to pay the Appellant £840 still stands.

PHILLIP JOHNSON  
THE APPOINTED PERSON  
25 February 2024

**Representation:**

Mr Andrew Marsden (of Wilson Gunn) appeared for the Appellant

Mr Tom Hooper (of Bird & Bird LLP) appeared for the Respondent