O/0807/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3798302
BY MEDISONAL LTD
TO REGISTER:

ADARA

AS A TRADE MARK IN CLASS 5
AND

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO 436693
BY MEDA AB

BACKGROUND AND PLEADINGS

1. On 13 June 2022, Medisonal Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision ("the application") in the UK for the following goods:

> **Class 5**: *Pharmaceuticals and natural remedies containing cannabis derivatives for veterinary purposes; dietary supplements for animals; animal feed supplements for veterinary purposes; dietetic food and substances adapted for veterinary use; medical cannabis for veterinary use; hemp-based dietary supplements for general health and wellness; cannabis based food products for medicinal and health purposes; medicated candy; medicated chewing gum; cannabis based beverages for medicinal and health purposes; transdermal patches for the relief of pain for veterinary use; products for the administration of medical cannabis, namely mouth sprays, gels; gel caps, tampons, suppositories and transdermal patches for veterinary use; cannabis extracts; cannabis resins and cannabis oils and cannabis waxes for veterinary use; all being unlicensed medical products and none being for the treatment of skin conditions.*

2. The application was published for opposition purposes on 8 July 2022, and it was opposed by Meda AB ("the opponent") on 6 October 2022. The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act").[1] The opponent relies on the following trade mark in relation to both grounds of opposition:

ALDARA
UK00002012580
Filing date 28 February 1995; date of entry in register 8 December 1995.
Relying on the following goods:

> **Class 5:** *Pharmaceutical preparations.*

[1] The opposition was initially filed on the ground of section 5(2)(b). However, on 26 October 2023 the opponent filed a Form TM7G to add a section 5(3) ground. This additional ground was accepted by the tribunal on 27 October 2023.

3. Under its 5(2)(b) ground, the opponent claims that due to the similarity between the parties' marks and the identity and/or similarity of the goods at issue, there exists a likelihood of confusion on the part of the relevant public, which includes the likelihood of association.

4. Under its 5(3) ground, the opponent claims that it has obtained a reputation in the UK in its mark and use of the application would take unfair advantage of, and/or be detrimental to, the distinctive character or the repute of the opponent's mark.

5. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of the earlier mark for all the goods relied upon.

6. The opponent is represented by Withers & Rogers LLP; the applicant is represented by Harper James. Both parties filed evidence in chief. The opponent also filed evidence in reply. No hearing was requested. Neither party filed submissions in lieu of a hearing. The decision is taken following a careful consideration of all of the papers.

7. The provisions of the act relied upon in these proceedings are assimilated law as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of the EU courts.

EVIDENCE

8. As mentioned above, both parties filed evidence. The opponent's evidence in chief came in the form of the witness statement of Andreas Rejnus dated 23 October 2023. Mr Rejnus has been the Director of the opponent since May 2023. Mr Rejnus's evidence is accompanied by 10 exhibits and was adduced in order to demonstrate genuine use of the opponent's mark and that it enjoys a reputation.

9. The applicant's evidence in chief came in the form of the witness statement of Addy Bridger dated 5 February 2024. Addy Bridger is a Trade Mark Attorney at Stratagem Intellectual Property Management Limited (previous representative of the applicant). The witness statement is accompanied by one exhibit and was adduced in order to demonstrate the steps required for the prescribing of unlicenced medicines in the veterinary and human healthcare fields.

10. As mentioned, the opponent also filed evidence in reply, which came in the form of the witness statement of Ms Stephanie Davies dated 31 May 2024. Ms Davies is an Attorney at the opponent's representative, a position she has held since November 2021. Her evidence is accompanied by 3 exhibits and was adduced in order to demonstrate what unlicenced medicines cover, provide cannabis guidance for unlicenced medicines and to demonstrate the existence of products applied to the skin that do not treat skin conditions.

11. I do not intend to summarise the evidence any further at this stage but will refer to the evidence where necessary throughout this decision.

Proof of Use

12. Section 6A of the Act is as follows:

> "(1) This section applies where-
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in sections 5(1), (2) or (3) obtain, and
>
> (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section 'the relevant period' means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the relevant period the earlier trade mark has 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, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) 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

(b) 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.

[(5) Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated

for the purposes of this section as if it were registered only in respect of those goods or services.

…"

13. Section 100 of the Act is as follows:

"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."

14. Given its filing date, the opponent's mark qualifies as an earlier trade mark under section 6 of the Act. The opponent's mark completed its registration process more than five years before the filing date of the application and, therefore, is subject to proof of use conditions. As set out above, the applicant has put the opponent to proof use of meaning that the conditions of use do apply to the earlier mark. The relevant period for the purposes of the proof of use assessment is the five-year period ending with the date of application for the contested mark. It is therefore from 14 June 2017 to 13 June 2022.

15. In *EasyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being 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, 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 Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'[2008] ECR I9223, 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], Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], 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], Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 Ferrari SpA v DU [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a subcategory of goods or services, the principles 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]; Centrotherm at [71]; Leno at [29]; Ferrari at [32].

(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]; Centrotherm at [71]; Leno at [29]; Gözze at [37], [40]; Ferrari at [32].

(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]. 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].

(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]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34]; Leno at [29]-[30], [56]; Ferrari at [33].

(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]; Leno at [55].

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

16. Proven use of a mark which fails to establish that “the commercial exploitation of the marks is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

17. I am also guided by *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander Q.C., as the Appointed Person stated that:

> "22. The burden lies on the registered proprietor to prove use. […] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

18. I also note Mr Alexander Q.C.'s comments in *Guccio Gucci SpA v Gerry Weber International AG*, Case BL O/424/14. He stated:

> "The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. […] The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the <u>best evidence first time round</u> – or lose it"" [original emphasis]

19. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

> "21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities,

in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

> [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.
>
> 22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

<u>The opponent's evidence</u>

20. Mr Rejnus states that the opponent's brand was founded in Sweden in 1954, was listed on the Stockholm stock market in 1995 and from 2006 to 2016 was listed under "Large Cap" on the Nasdaq Stockholm exchange.

21. In relation to the opponent's mark, the opponent states that since 1998 its mark 'ALDARA' has been used for a product called 'Imiquimod', which it states is an immune response modifier and used to treat a range of conditions, including genital warts and

superficial basal cell carcinoma. It was approved for medical use in the EU in 1998. In 2006, 3M (the original owner of the patent) sold its EU business to the opponent. It is submitted that the ALDARA product is sold throughout the UK to various consumers, including pharmacies, hospitals, clinics and schools. The corporate structure of the opponent merits some explanation at the onset. Mr Rejnus also explained that the opponent forms part of a group of companies owned by the parent company, Viatris Inc.

22. The opponent has provided evidence in respect of turnover figures, packaging bearing the opponent's mark, invoices, government guidance pertaining to advertising medication, expenditure on leaflets, market share and extracts from third parties. I note the following in regard to the evidence:

a) Turnover figures for the products sold under the ALDARA mark from 2017 to 2021 in the UK:[2]

Year	**Volume (in excess of)**	**Sales in GBP (in excess of)**
2017	80,000	2,700,000
2018	90,000	3,200,000
2019	75,000	3,100,000
2020	40,000	1,700,000
2021	40,000	1,600,000

b) Exhibit 6 is a sample of 26 redacted invoices that pertain to the sale of goods between 16 July 2018 and 17 May 2022. As mentioned, the invoices are redacted, therefore I am unable to determine the quantity, pack sizes, unit prices, net price, VAT/VAT value and the complete postal addresses for the customers. However, I am able to determine the town or city of the customer from the redacted invoices and they all cover sales across the UK. In all of the invoices, the opponent's mark appears within the description section of the invoice as "Aldara Crm 5% 250MG 12SA GB MDA", and the Viatris mark

[2] Witness statement of Andreas Rejnus, paragraph 15

appears at the top of the documents. I note that the relationship between the opponent and Viatris has been explained previously.

c) Exhibit 3 lists various conditions that are treated by the opponent's goods, those conditions being: Actinic Keratosis, Superficial Basal Cell Carcinoma, Keratoacanthoma and Bowen's disease. Additional information, such as prescribing information, dosage and administration, is also provided. The opponent's mark appears on the packaging for its cream, as can be seen below:

d) Exhibit 2 contains the approval from the EU granting marketing authorisation for 'Aldara – Imiquimod'. It states that marketing shall be subject to compliance with the conditions relating to the manufacture and/or importation, control and issues referred to in supporting EU documentation.

e) Exhibit 5 is images of packaging for the opponent's 'Aldara 5% cream'. The opponent's mark is displayed in the following form:

f) Exhibit 4 is an example of a patient leaflet that is supplied with the 'Adara' products.

g) The opponent has explained that, as its goods are prescription-only medication in the UK, they are not permitted to promote its products to the general public. The opponent has attached government extracts in exhibit 7 demonstrating the government guidance pertaining to the advertisement of medicines.

h) The opponent has provided the following figures of expenditure on informational leaflets pertaining to ALDARA products in the UK: £17,163 (2018), £6,834 (2019) and £12,454 (2021). [3]

i) The opponent provided a table of the annual market share of the ALDARA product in respect of Imiquimod products in the UK for the years 2017 to 2021, which I have replicated below[4]:

Year	Market Share
2017	98%
2018	98%
2019	94%
2020	72%
2021	70%

j) Specific extracts from the online tool and website extracts with details of IQVIA (A global company that offers data, technology and services to improve healthcare outcomes) and its tool MIDAS are outlined in exhibit 8.

[3] Witness statement of Andreas Rejnus, paragraph 18
[4] Witness statement of Andreas Rejnus, paragraph 19. The opponent states that this evidence was provided by IQVIA which it states is the largest healthcare data science company and leader in human data science technology.

k) Exhibit 9 are extracts from clinical papers on the effects of cannabidiol, cannabis and CBD and the potential treatments that can be made from those goods.

l) Exhibit 10 contains extracts from websites and online articles dated 15 September 2015, 22 January 2020 and 3 October 2023. The article dated September 2015 is outside of the relevant period. The other articles being "Teddi Mellencamp to start immunotherapy" and "Mosquito-bourne disease could be prevented by skin cream" from 'Female first' and the University of Leeds website respectively are both dated within the relevant period. They make reference to the opponent's goods, specifically the immunotherapy cream called imiquimod Aldara that is used to stimulate the immune system.

Form of the mark

23. In *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

> "31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.
>
> 32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)." (emphasis added)

24. The earlier mark is ALDARA. There are examples of the earlier mark being used in standard font appearing in blue title case, and with a registered trade mark symbol, for example, on packaging and on a patient leaflet. The marks also appear in title case on the invoices provided by the opponent's mark. Clearly, this will be use upon which the opponent can rely, because word-only marks cover use in all possible fonts, typefaces and colours.[5]

25. The opponent has also provided examples of the mark, as described above, that appear with a trade mark device element appearing in superscript next to the mark. As per the case of *Colloseum*, use of a mark generally encompasses both its

[55] *La Superquimica v EUIPO*, Case T-24/17, paragraph 39.

independent use and its use as part of another mark taken as a whole or in conjunction with that other mark. I consider that the 'TM' in superscript will be viewed as an indication that the mark is in fact a trade mark and I consider that the opponent's mark maintains its role as an independent indication of origin within this example of use. I do not consider that these alter the distinctive character of the mark to the point that it would not be considered use of the mark as registered.

Genuine use of the mark

26. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. In making my assessment, I am required to consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the goods for which use has been shown;
- the nature of those goods and the market(s) for them; and
- the geographical extent of the use shown.

27. I note that the applicant reiterated that it did not consider the evidence to show use of the mark in relation to the goods relied upon. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[6]

28. I note that the opponent has provided evidence regarding its turnover during the relevant period as outlined above, which amounted to in excess of £12,300,000 between 2017 and 2021.Sample invoices were also provided which demonstrate the sale in the UK of Aldara cream specifically in Coventry, Chessington and Hilton. Whilst the evidence only outlines three geographical locations, I note that the invoices are samples and that there are many types of different pharmaceutical items on the invoices, which alongside the high turnover would suggest that the customers are retailers that sell to a wider client base. The goods listed on the invoices appear with

[6] *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09

the opponent's mark throughout the evidence. I have no evidence or submissions from the parties to assist me on the size of the market for the goods concerned i.e. pharmaceutical preparations. Despite this, from my own knowledge, I believe the market in the UK to be substantial.

29. In relation to the promotional events and materials, the opponent has provided evidence to support that pharmaceutical preparations that are prescription only are subject to strict advertising regulations in the UK. They cannot be advertised to the general public but can be promoted to healthcare professionals and others who can prescribe or supply the product. No figures have been provided in relation to advertising directed at medical professionals and others who prescribe or supply the product. The opponent submits that as the products have *"longstanding use in the UK, particularly by the NHS; doctors and health professionals are very familiar with the product and therefore My Company Group has not been required to invest substantially in advertising and marketing"*.[7] This is noted but it offers little assistance in terms of figures for advertising and marketing expenditure. However, I recognise that the opponent has filed its expenditure on informational leaflets relating to its products, which I have noted above. Despite this, there are limitations with this evidence, as I note that there is no information on the scale of the audience nor the distribution or reach of the promotional material.

30. Taking all of the above into consideration, I am of the view that the opponent has attempted to create and maintain a market for its goods under its mark. Therefore, I am satisfied that the opponent has demonstrated genuine use of its mark during the relevant period in the UK.

31. In relation to fair specification, all of the use shown of the opponent's mark is in relation to creams. I have taken into consideration the approach set out in *Merck KGaA v Merck Sharp & Dohme Corp & Ors*,[8] to frame a fair specification. I accept that the opponent's goods being *"pharmaceutical preparations"* would include creams. However, it would also include many other goods, such as tablets and ointments, and so it would not be fair to allow the opponent to rely on this general term purely on the

[7] Witness statement of Andreas Rejnus, paragraph 17
[8] [2017] EWCA Civ 1834, 244-248

basis of the evidence for *"creams".* In addition, taking the therapeutic indication into consideration, I note that the opponent has demonstrated that its goods are used to treat a variety of ailments, including of Actinic Keratosis, Superficial Basal Cell Carcinoma, Keratoacanthoma, Bowen's disease and Genital Warts. As its use extends beyond the treatment of forms of skin cancer, in my view, a fair specification for its class 5 goods would be *"pharmaceutical preparations, namely, medicated creams for the treatment of skin cancer and dermatological conditions in humans."*

Section 5(2)(b): legislation and case law

32. Section 5(2)(b) of the Act reads as follows:

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

(a) …

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood or association with the earlier trade mark."

Section 5A of the Act is as follows:

"5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

33. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

Sales Germany & Austria GmbH, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

COMPARISON OF GOODS

34. The goods to be compared are as follows:

The opponent's goods	**The applicant's goods**
Class 5: *Pharmaceutical preparations, namely, medicated creams for the treatment of skin cancer and dermatological conditions in humans.*	Class 5: *Pharmaceuticals and natural remedies containing cannabis derivatives for veterinary purposes; dietary supplements for animals; animal feed supplements for veterinary purposes; dietetic food and substances adapted for veterinary use; medical cannabis for veterinary use; hemp-based dietary supplements for general health and wellness; cannabis based food products for medicinal and health purposes; medicated candy; medicated chewing gum; cannabis based beverages for medicinal and health purposes; transdermal patches for the relief of pain for veterinary use; products for the administration of medical cannabis, namely mouth sprays, gels;*

	gel caps, tampons, suppositories and transdermal patches for veterinary use; cannabis extracts; cannabis resins and cannabis oils and cannabis waxes for veterinary use; all being unlicensed medical products and none being for the treatment of skin conditions.

35. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

36. Guidance on this issue has also come from Jacob J. (as he was then) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors."

37. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

"… there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking."

38. I note that the applicant's goods are limited to "*all being unlicensed medical products and none being for the treatment of skin conditions".* I have taken this limitation into account when conducting my comparison of the goods.

Dietary supplements for animals; animal feed supplements for veterinary purposes; dietetic food and substances adapted for veterinary use

39. It is permissible to group goods together for the purpose of comparison where they are *"sufficiently comparable for registration in essentially the same way for the same reasons".*[9] I deem this to be the case with respect to the applicant's goods above, as I consider that the applicant's goods are substances that are prepared for special dietary requirements, with the purpose of introducing forms of nutrition into animals. Bearing this in mind, their purpose is similar to the opponent's goods insofar as they are used to improve a patient's medical condition. Although, the specific purpose of the goods will differ. However, I do recognise that the end users for both goods will differ, with the applicant's users being animals and the opponent's users being humans. In the absence of any evidence or submissions to the contrary, I do not

[9] *Separode* Trade Mark, BL O/399/10, paragraph 5

consider that the goods will share the same nature, as the opponent's goods will be in the form of a cream and the applicant's goods in the form of a tablet or gel. I do not consider that there will be an overlap in trade channels, nor do I consider that there will be an overlap in the method of use. It is not my view that the goods will be complementary, nor do I consider that they are in competition. It is my view that any overlap in the relevant factors is so fleeting that they would be insufficient to find any similarity in the goods. In *Unicorn Studio Inc v Veronese Case CH-2023-000214,* Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity requires the exercise of common sense.[10]Taking a realistic approach to the comparison of these particular goods, I find the goods at issue to be dissimilar.

Hemp-based dietary supplements for general health and wellness

40. I consider that these goods are substances that are prepared for special dietary requirements, with the purpose of introducing forms of nutrition for health and wellness and as no user is specified, this can include both humans and animals. The opponent's goods are merely for humans. Taking this into consideration, there may be an overlap in end users of the parties' goods. As a consequence, it is my view that the general purpose of the applicant's goods is similar to the opponent's goods insofar as they are used to improve a patient's medical condition. However, there may be a difference in the specific purpose of the goods. The goods may also overlap in nature, as the applicant's goods may also be provided in the form of a cream. Given that the goods can share the same nature, I also consider that the method of use may overlap. I also recognise that the applicant's goods are limited so as not to include skin conditions, I do not consider that the goods will be sold by the same undertakings or in the same retail environments. Even if there was an overlap in distribution, I consider that the products would be positioned in different sections of the retail environment. It is not my view that the goods will be in competition, nor do I consider that they are complementary. It is my view that any overlap in the relevant factors is so fleeting that they would be insufficient to find any similarity in the goods. In *Unicorn Studio Inc v Veronese Case CH-2023-000214,* Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity requires the exercise of common

[10] Paragraph 24

sense.[11]Taking a realistic approach to the comparison of these particular goods, I find the goods at issue to be dissimilar.

Medical cannabis for veterinary use; cannabis resins and cannabis oils and cannabis waxes for veterinary use; Pharmaceuticals and natural remedies containing cannabis derivatives for veterinary purposes; cannabis based food products for medicinal and health purposes; cannabis based beverages for medicinal and health purposes; medicated candy; medicated chewing gum; products for the administration of medical cannabis, namely mouth sprays, gels; transdermal patches for the relief of pain for veterinary use; gel caps, tampons, suppositories and transdermal patches for veterinary use.

41. As per the case of *Separode,* I have collated these goods to compare because they are all cannabis related products. I remind myself of the case of *Unicorn Studio Inc v Veronese Case CH-2023-000214,* Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity requires the exercise of common sense.[12] I note that he stated that:

> "24. Thirdly, any finding of similarity in the end requires the exercise of common sense and requires the hearing officer to stand back and consider the overall question. It strikes me that here the hearing officer was engaging essentially in a box-ticking exercise, asking how many of the factors identified in *TREAT* or in *Canon* could be said to have been satisfied. Had the hearing officer stood back and considered the overall question of similarity, I believe she would have considered and certainly ought to have considered that the idea that figurines and works of art were similar to electric lamps, chandeliers or mirrors was nonsensical and it hardly needed a careful consideration of the *Canon* or *TREAT* factors to come to that conclusion. I therefore agree with the appellant that this category of goods should have been found dissimilar, and certainly it could not have reasonably been found similar to more than 'a very low degree'. The hearing officer's decision that it might approach a medium degree of similarity such as to give rise ultimately to a risk of confusion was to my mind not a decision within the range of views which was reasonable to take

[11] Paragraph 24
[12] Paragraph 24

on the facts of this case, and the opposition should therefore have been dismissed in relation to this category of goods."

42. I consider that the reasoning in the above case applies in the current circumstances. Taking a step back and looking at the overall question of similarity of the goods, I consider that a finding of any similarity between the applicant's and the opponent's goods is so fleeting that it would be insufficient to find any similarity between the goods. Taking a realistic approach to the comparison of these particular goods, it would hardly need a careful consideration of those factors to conclude that the above cannabis related products are not similar to creams used to treat dermatological conditions and skin cancer. I do recognise that the use of cannabinoids is being explored to treat various dermatological conditions, including cancer, as outlined in exhibit 9. The article states that research has shown that *"cannabinoids"[…] can reduce cell proliferation and induce apoptosis in melanoma cells"* and "*the findings revealed cannabinoids, individually or combined, reduced tumour growth and promoted apoptosis and autophagy in melanoma cells".*[13] However, I have not been provided with any evidence that demonstrates that at this current time, the parties goods are used to treat the same conditions. Therefore, taking all of the above into account, I find the goods to be dissimilar.

43. As a level of similarity is required between the competing goods in order for there to be a likelihood of confusion under the Act,[14] and no similarity has been found, the opposition fails. For ease of reference, the opposition fails against all of the goods in the applicant's specification.

Section 5(3)

44. Section 5(3) of the Act states:

"5(3) A trade mark which – is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a

[13] Exhibit 9, page 3
[14] eSure Insurance v Direct Line Insurance [2008] ETMR 77 CA

reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

45. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel,* Case C-408/01, *Adidas Salomon,* Case C-487/07, *L'Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora,* Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows.

(a)The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon, paragraph 29 and Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34. 51*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40.*

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation *(Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).*

46. The conditions of section 5(3) are cumulative. First, the opponent must show that the earlier mark is similar to the application. I consider that the marks similar as they share the letters 'A-D-A-R-A' and only differ in the presence of the letter 'L' that

appears in the opponent's mark. Secondly, it must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

47. The relevant date for the assessment under section 5(3) is the date of the application at issue, being 13 June 2022.

Reputation

48. In *General Motors*, Case C-375/97, the CJEU held that:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
>
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot

be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

Reputation

49. Under its 5(3) ground the opponent relies on the same mark as it did under section 5(2)(b) ground, being the word mark 'ALDARA'. In addition, it claims to have obtained a reputation in the same set of goods in class 5 as relied upon in the same ground.

50. In determining whether the opponent has demonstrated a reputation for the goods at issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including *"the marks share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it".*

51. I can deal with this ground relatively swiftly.

52. Earlier in my decision, when assessing the genuine use of the opponent's mark, I undertook a detailed assessment of the evidence filed. The same evidence is relied upon for the basis of the opponent's section 5(3) claim. I do not intend to repeat the evidence in full here, however, a summary of the evidence can be found in paragraph 22. I consider that whilst there is evidence of advertising, and I recognise the limitations with prescription only medication, there is little evidence of promotion to healthcare professionals and others who can prescribe or supply the product, to who the opponent is able to advertise. In addition, the evidence of geographical scope is not particularly widespread. Whilst it might be the case that the specific addresses reflect more than 3 addresses/locations, due to the redactions in the invoices, I am unable to ascertain a wider scope than three locations, although there is a potential that those customers are retailers. The sales figures are not low, rather they are substantial, however, with the redactions in the documents, I am unable to contextualise the number of units sold and the scale of the sales. I also note the market share evidence provided by the opponent. Taking all of the above into account, I am not satisfied that

the opponent has a reputation for providing its goods under the earlier mark in the UK at the relevant date. I appreciate that I have found the use to be sufficient to demonstrate genuine use. However, on this point, I remind myself that in order for there to exist a reputation, the opponent is required to prove that the mark is known by a significant part of the relevant public in the relevant territory. This is simply not borne out in the evidence and, as such, I find that the opponent's opposition based upon section 5(3) falls at the first hurdle.

53. For the avoidance of doubt, even if there were to exist a reputation in the opponent's mark, this would not be sufficient to advance the opponent's case beyond that which was found under the section 5(2) ground above. I say this because whilst I acknowledge that the present ground can succeed in respect of dissimilar goods, the evidence before me is far from sufficient to result in a finding that the consumers would be caused to wonder if the marks are issue were linked for the dissimilar goods. This will not be the case in the current circumstances because firstly, as I mentioned, any reputation is weak and secondly, the distance between the goods at issue is too great. Taking all of these above factors into account, I do not consider that the similarity between the marks combined with the strength of the reputation of the opponent's earlier marks will be sufficient for a link to be made by a significant part of the relevant public.

54. As a result of my findings above, the opposition based upon section 5(3) of the Act fails in entirety and is dismissed.

CONCLUSION

55. The opposition is fails under sections 5(2)(b) and 5(3) of the Act.

COSTS

56. The applicant has been successful in the opposition and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £750 as a contribution towards the costs of the proceedings.

The sum is calculated as follows:

Filing a defence/ counterstatement and considering the notice of opposition	£250
Preparing and filing evidence and considering the other side's evidence	£500
Total	**£750**

57. I therefore order Meda AB to pay Medisonal Ltd the sum of £750. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 1st day of September 2025

A KLASS
For the Registrar