

**O/785/22**

**TRADE MARKS ACT 1994**

**CONSOLIDATED PROCEEDINGS**

**IN THE MATTER OF**

**APPLICATIONS NOS. 503923 AND 503934**

**BY HOLLAND & BARRETT INTERNATIONAL LIMITED**

**TO REVOKE ON THE GROUNDS OF NON-USE**

**TRADE MARK REGISTRATIONS NOS. UK00911896271 AND UK00903425188**

**OWNED BY SOCIÉTÉ DES PRODUITS NESTLÉ S.A.**

## BACKGROUND AND PLEADINGS

1. Société des Produits Nestlé S.A. (“the proprietor”) is the proprietor of the trade mark registrations set out below:

UK00911896271 (the ‘271 mark)

S-26

Filing date: 13 June 2013

Date of entry in register: 17 December 2013

**Class 29:** *Vegetables and potatoes (preserved, frozen, dried or cooked), fruits (preserved, frozen, dried or cooked), mushrooms (preserved, dried or cooked), meat, poultry, game, fish and seafood, all these products also in the form of extracts, soups, jellies, pastes, preserves, ready-made dishes, frozen or dehydrated; jams; eggs; milk, cream, butter, cheese and other food preparations having a base of milk; milk substitutes; milk-based beverages; milk-based beverages containing cereals, chocolate and/or coffee; milk-based and cream-based desserts; yoghurts; soya milk (milk substitute), soya-based preparations; edible oils and fats; non-dairy creamers; sausages; charcuterie; peanut butter; soups, soup concentrates, broth, stock cubes, bouillon, consommés.*

UK00903425188 (the ‘188 mark)

S-26

Filing date: 29 October 2003

Date of entry in register: 18 February 2005

**Class 5:** *Infants' and invalids' foods, feeding preparations and nutritional formulas.*

2. On 11 June 2021, Holland & Barrett International Limited (“the applicant”) applied to revoke the proprietor’s marks on the grounds of non-use based upon Section 46(1)(a) and (b) of the Trade Marks Act 1994.

3. Revocation is sought under Section 46(1)(a) on the basis of non-use within the period of five years following the date of registration (“the first relevant periods”), namely 18 December 2013 to 17 December 2018 (in relation to the ‘271 mark) and 19 February 2005 to 18 February 2010 (in relation to the ‘188 mark). Revocation is

therefore sought from 18 December 2018 (in relation to the ‘271 mark) and 19 February 2010 (in relation to the ‘188 mark), respectively.

4. Revocation is also sought under Section 46(1)(b) on the basis that use of the trade marks have been suspended for an uninterrupted period of five years (“the second relevant period”), namely from 11 June 2016 to 10 June 2021 with revocation being sought from 11 June 2021. This is the same for both the ‘271 and the ‘188 mark.

5. The proprietor filed defences and counterstatements defending the registrations for (a) some of the goods for which the ‘271 mark is registered, namely *milk and other food preparations having a base of milk; milk substitutes; milk-based beverages* (in class 29) and (b) all of the good for which the ‘188 mark is registered.

6. On 21 October 2021, the Registrar directed under Rule 62(1)(g) of the Trade Marks Rules 2008 that the two applications for revocation be consolidated.

7. Both parties filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate. No hearing was requested, and neither party elected to file submissions in lieu.

8. In these proceedings, the applicant is represented by HGF Limited and the proprietor by CMS Cameron McKenna Nabarro Olswang LLP.

9. 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. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **EVIDENCE**

10. The proprietor filed evidence in the form of a witness statement of Isabelle De Blic-Hamon dated 18 November 2021. Ms De Blic-Hamon is the senior legal IP counsel of the proprietor’s company. Her evidence is accompanied by 17 exhibits (IBH1 – IBH17).

11. In response to the applicant's evidence, Ms De Blic-Hamon filed a second witness statement dated 22 March 2022 accompanied by 2 exhibits (IBH1 – IBH2).

12. The applicant filed evidence in the form of a witness statement of Jennifer Kathryn Good dated 24 January 2022 and accompanied by 3 exhibits (JKG1 – JKG3). Ms Good is a trade mark attorney employed by the firm representing the applicant in these proceedings.

## **DECISION**

13. 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;

(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”.

14. Where the mark is a comparable mark, paragraph 8 of part 1, schedule 2A is relevant. It reads:

“8.— Non-use as defence in infringement proceedings and revocation of registration of a comparable trade mark (EU)

(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the "five-year period") has expired before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM ; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union”.

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

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

16. 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 Bunderversammlung 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 Marken 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.

115. 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].”

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

18. IP completion day was 31 December 2020. As the proprietor’s marks are both comparable marks deriving from EUTMs and (a) the first relevant period for the ‘188 mark (namely 19 February 2005 to 18 February 2010), and the first relevant period for the ‘271 mark (namely 18 December 2013 to 17 December 2018), have both expired before IP completion day and (b) IP completion day falls within the second relevant period, which is the same for both marks (namely 11 June 2016 and 10 June 2021), I must consider the EU as the market in which the proprietor is required to show genuine use up to 31 December 2020: see *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, paragraph 36.

#### *The goods which are defended*

19. The proprietor has defended the ‘271 registration insofar as it covers *milk and other food preparations having a base of milk; milk substitutes; milk-based beverages* in class 29. Consequently, the ‘271 mark will necessarily be revoked for the registered

goods that have not been defended. The '271 mark is registered for the following goods (the defended goods are shown in bold):

**Class 29:** *Vegetables and potatoes (preserved, frozen, dried or cooked), fruits (preserved, frozen, dried or cooked), mushrooms (preserved, dried or cooked), meat, poultry, game, fish and seafood, all these products also in the form of extracts, soups, jellies, pastes, preserves, ready-made dishes, frozen or dehydrated; jams; eggs; milk, cream, butter, cheese and other food preparations having a base of milk; milk substitutes; milk-based beverages; milk-based beverages containing cereals, chocolate and/or coffee; milk-based and cream-based desserts; yoghurts; soya milk (milk substitute), soya-based preparations; edible oils and fats; non-dairy creamers; sausages; charcuterie; peanut butter; soups, soup concentrates, broth, stock cubes, bouillon, consommés.*

20. Although the proprietor has defended the term "*other food preparations having a base of milk*", it has not expressly defended certain goods listed in the registered specification which would fall within the term "*other food preparations having a base of milk*" including *cream, butter, cheese, milk-based beverages containing cereals, chocolate and/or coffee, milk-based and cream-based desserts* and *yoghurts*. If the proprietor's intention was to defend these terms, it should have expressly listed them in the defence. I will therefore proceed on the basis that these terms are not defended.

21. Nonetheless, if at the end I conclude that the evidence establishes that the '271 mark has been genuinely used for *cream, butter, cheese, milk-based beverages containing cereals, chocolate and/or coffee, milk-based and cream-based desserts* and *yoghurts*, these terms might still be saved because they fall within the defended term "*other food preparations having a base of milk*", so there is no prejudice to the proprietor caused by my approach.

### The evidence

22. The mark 'S-26' was first used in 1961 as the name of an infant formula formulated with 26 specialised ingredients. In 2012, Nestlé acquired the business which produced

the 'S-26' formula from Wyeth Nutrition, a company specialising in infant nutrition. Nestlé licensed the use of the mark 'S-26' back to Wyeth Nutrition and other Nestlé group companies and the mark has been used by Nestlé's licensees and subsidiaries with its full consent.

23. Ms De Blic-Hamon says that goods branded with the mark 'S-26' have been sold in the EU, specifically in Greece and Cyprus. Further, goods branded with the mark 'S-26' have been manufactured in Ireland (since 2012), France (since 2016) and the Netherlands (since 2019) for export purposes.

24. The retail value generated in Greece for goods sold under the mark 'S-26' between 2016 and July 2021 amounts to over €4.5million. The number of units sold in Greece decreased from over 3.5 million in the five-year period between 2005 and 2010 to 650,000 in the five-year period between 2013 and 2018.

25. The sale figures given for Cyprus are more accurate since they are broken down by year and cover the periods from 2007 to 2010 and 2013 to 2021. These are as follows:

<b>2007</b>	<b>2008</b>	<b>2009</b>	<b>2010</b>	<b>2013</b>	<b>2014</b>	<b>2015</b>
Over €2.5million	Over €2.9million	Over €3million	Over €3.3million	Over €2.2million	Over 2million	Over 1.9million

<b>2016</b>	<b>2017</b>	<b>2018</b>	<b>2019</b>	<b>2020</b>	<b>2021</b>	<b>Total</b>
Over €1.9million	Over €1.8million	Over €1.7million	Over €1.7million	Over €1.7million	Over €1million	Over €27.6million

26. According to Ms De Blic-Hamon, *“recently the production of the goods branded with the mark 'S-26' has been taking place at the proprietor's locally owned factories in Germany, the Netherlands and France, which explains the decrease in proceeds in 2019”*.

27. The sale figures are supported by photographs of the packaging of the goods, invoices, marketing material and screenshots from various websites showing goods available for sale, all of which illustrate use in relation infant formula. The mark ‘S-26’ appears on invoices (dated between 2016 and 2021) next to the description of the goods as ‘milk powder’, although some of the descriptions (for example, “S-26 GOLD 2, LWPB039 Tin 12x400gr”), do not clearly refer to the nature of the goods. It also appears on packaging, advertising material and websites, as shown below:



28. The evidence also includes photographs showing the mark ‘S-26’ being displayed and promoted at trade exhibitions held in Greece in 2017.

29. The brand ‘S-26’ is also referred in an online article from Enterprise Ireland as “*well-known*”. The article, dated 11 November 2021, states:

The Wyeth Nutrition global portfolio of products satisfies a diverse range of nutritional requirements for infants and young children and includes well-known brands such as SMA, S-26, Progress, Promil and Illuma. The Askeaton factory produces formula in both powder and ready-to-feed liquid formats.

30. The proprietor also filed evidence showing that goods branded with the mark ‘S-26’ have been manufactured in Ireland, Netherlands and France for export purposes. Invoices dated between 2015 and 2020 are provided in support.

31. According to Ms De Blic-Hamon, the gross proceeds achieved by the proprietor between 2016 and 2021 as a result of the export of goods branded with the mark ‘S-26’ from Ireland to various countries in Europe, Asia, the Middle East and East Africa are as follows:

<b>Year</b>	<b>Gross Proceeds</b>
2016	Over \$50million
2017	Over \$49million
2018	Over 75million
2019	Over \$40million
2021	Over \$17million

32. The proprietor’s French company also exported over 126,000 units of goods branded with the ‘S-26’ mark between 2017 and 2020.

### Form of the mark

33. Both marks consist of the sequence 'S-26'. There is plenty of evidence showing use of the mark 'S-26' on invoices dated between 2016 and May 2021. There is also evidence of the mark 'S-26' being used on websites (undated, save for the printing date) and packaged goods which display various expiry dates falling in 2016, 2017 and 2019. Although the mark displayed on packaged goods is presented in colours, the colours do not alter the distinctive character of the mark and, as such, the use shown is use of an acceptable variant of the mark as registered.<sup>1</sup> Likewise, use of the mark 'S-26' on the packaging with, or as part of, another mark (i.e. 'S-26 HA GOLD' or 'S-26 Progress GOLD' in the larger circular devices), is acceptable use.<sup>2</sup>

### Genuine use

34. Even disregarding the export figures<sup>3</sup> and the absence of information about the market share held by the mark, the turnover evidence relating to goods sold in Greece and Cyprus between 2007 and 2021 are - given their scale and frequency, and taking into account the market for the goods concerned (which are very specific and relatively inexpensive) - enough to amount to genuine use of the mark 'S-26' during all of the relevant periods.

35. The value of the sale is, in fact, as follows:

- (a) **€11.7million** worth of goods sold in Cyprus between 2007 and 2010. This is in addition to the over 3.5 million units sold in Greece in the five-year period between 2005 and 2010. This is sufficient to establish genuine use of the '188 mark for the first relevant period 19 February 2005 to 18 February 2010;
- (b) **€9.3million** worth of goods sold in Cyprus between 2014 and 2018. In addition to this, a proportion of the €4.5million turnover which is said was generated in

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<sup>1</sup> *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

<sup>2</sup> See *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

<sup>3</sup> These are relied upon by the proprietor on the basis of Section 46(2) of the Act according to which use in the UK includes affixing the trade mark to goods or to the packaging of goods in the UK solely for export purposes, however, I do not need to decide the point because the figures relating to goods sold in the EU are sufficient to show genuine use.

Greece between 2016 and 2021 must fall between 2016 and 2018. This is sufficient to establish genuine use of the '271 mark for the first relevant period 18 December 2013 to 17 December 2018;

- (c) **€9.8million** and **€4.5million** worth of goods sold in Cyprus and Greece respectively, between 2016 and 2021, for a total of **€14.3million**. This is sufficient to establish genuine use of both marks for the second relevant period 11 June 2016 to 10 June 2021 and it is so, even taking into account (i) that the **€1million** turnover generated in 2021 in Cyprus cannot be accounted for (because after the 31 December 2020 use in the EU does not count towards genuine use) - which still leaves **€8.8million** turnover achieved in Cyprus between 2016 and 2020 and (ii) that a proportion of the **€4.5million** turnover generated in Greece between 2016 and 2021 must also relate to 2021 and should be discounted.

36. The only challenge raised in the applicant's evidence is that infant milk is classified in class 5 not in class 29 and that the manufacture, advertising and labelling of these goods is specifically regulated, separate to any general regulations regarding other foodstuffs. The following exhibits are contained in Ms Good's evidence:

- a printout from the WIPO website containing the Class Headings and Explanatory Notes for Classes 5 and 29 of the Nice Classification;
- a printout from the EUIPO Classification Tool, 'TMclass', showing the result of a search for the term "infant milk". Ms Good points out that the search brought up the terms 'powdered milk foods for infants', 'liquid formula milk for infants' and 'powdered milk for babies and infants', all being classified in Class 5, but it did not include any terms in class 29;
- A copy of the UK Government's guidance on the regulations regarding infant and follow-on formula, and food for special medical purposes.

37. Although the point is not expressly argued, it is clear, in my view, that the applicant's evidence is aimed at showing that use in relation to infant milk is not sufficient to retain the registration for milk in class 29.

38. In response to the applicant's evidence, Ms De Blic-Hamon filed a second witness statement with the stated aim of supporting the conclusion that the use of the 'S-26' mark on infant formula milk constitutes use of the class 29 goods detailed in the specification of the '271 mark, namely *milk, and other food preparations having a base of milk; milk substitutes; milk-based beverages*.

39. Ms De Blic-Hamon's evidence shows that the mark 'S-26' was used on goods produced in Ireland for export purposes and that the goods contain milk. Whilst the goods may contain milk, the label clearly describe them as baby formula as a subcategory of baby food.

40. In Case T-660/11, *Polytetra GmbH v OHIM*, the General Court ("GC") held that the use of TEFLON as the name of a material used in the manufacture of other goods, which carried third party trade marks, was not use of the mark in relation to the manufactured goods, but only use in relation to the material.

41. I accept that the case above was based on different facts and circumstances. However, the underlying principle is the same, namely that genuine use as a trade mark for a specified product requires that the mark be applied in such a way that it is, at minimum, capable of being understood as referring to that product.<sup>4</sup>

42. The problem with Ms De Blic-Hamon's evidence is that the proprietor has not used the mark 'S-26' to identify the origin of the milk (which is properly categorised within Class 29) used in the manufacture of the infant formula (which is properly categorised within Class 5) it has sold under the mark 'S-26'.

43. Genuine use of the mark 'S-26' in respect of milk in class 29 would require consumers to understand that the mark 'S-26' identifies not only the origin of the infant formula to which the mark is affixed, but also the origin of the milk used in the manufacture of the infant formula itself. In this case, there is no evidence that the mark 'S-26' has ever been used in relation to milk as a branded ingredient and even if consumers were to note that milk is an ingredient of the infant formula sold under the

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<sup>4</sup> *Compagnie Gervais Danone -v- Glanbia Foods Society Ltd* [2007] IEHC 126 (20 April 2007)

mark 'S-26', they would not understand the mark 'S-26' to also designate the origin of the milk.

44. On the facts here the proprietor has used the mark 'S-26' in such a way that it can only be understood as referring to the infant formula (which belongs to Class 5, not class 29), and not to milk as an identified ingredient of the infant formula. This means that the use made cannot be considered as use as a trade mark in relation to milk or any other goods in class 29.

45. Accordingly, I am satisfied that the proprietor has not proved genuine use of the mark 'S-26' in relation to *milk* or any of the other defended (and/or undefended) goods in class 29 within 5 years of its registration or after. **The '271 mark is therefore revoked in its entirety from the earliest date, namely 18 December 2018.**

46. The '188 mark is registered for *Infants' and invalids' foods, feeding preparations and nutritional formulas* in class 5. The proprietor has defended this registration in its entirety. I have found that the mark 'S-26' has been genuinely used in relation to infant formula, which is a special dietary food that simulates breast milk specifically for babies. The evidence also suggests that the proprietor's formula is sold in both powder and liquid forms.<sup>5</sup> It now falls on me to consider what would be a fair specification for the mark '188 given the use shown in relation to infant formula.

47. 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 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.”

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<sup>5</sup> IBH-10

48. 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 ("Asos") 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.”

49. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 (Court of Appeal), a case which concerned pharmaceutical substances and preparations, Kitchen LJ held that it was well established that (1) a category of goods/services may contain numerous subcategories capable of being viewed independently and, (2) the purpose and intended use of a pharmaceutical product are of particular importance in identifying the subcategory to which it belongs.

50. There is no evidence of the mark ‘S-26’ having been used for *invalids’ foods* and I do not understand infant formula to be a type of invalids’ food. An invalid is a person who is weak or disabled by illness or injury, so an invalid diet is likely to include easily digested and nutritious food, however, it would not include infant formula which is designed for babies and infants.

51. Collins Online English dictionary defines the word “infant” as follows:

- a child at the earliest stage of its life; baby.
- Infants are children between the ages of five and seven, who go to an infant school.

52. The term *infants’ food* would cover in my view infant formula for babies and infants (in relation to which there has been genuine use) as well as pureed vegetables, pureed fruit and other types of solid food which are designed for older infants (these can normally be added to the baby diet at 4-6 months in addition to breastmilk and/or infant formula), in relation to which there has been no use. Likewise, *feeding preparations and nutritional formulas* would include feeding preparations for animals and nutritional formula for adults, in relation to which there has been no use. In my view, the average consumer would describe the goods shown in the evidence as feeding preparations and nutritional formulas for babies and infants. Consequently, I consider that a fair

specification can be achieved in this case by limiting the term “*feeding preparations and nutritional formulas*” to being “*for infants and babies*”.

53. Taking all of the above into account, I consider a fair specification for the ‘188 mark to be as follows:

**Class 5:** *feeding preparations and nutritional formulas, all being for babies and infants.*

54. Accordingly, the ‘188 mark is revoked for *Infants' and invalids' foods* from 19 February 2010. From the same date the mark will remain registered for the reworded specification set out at paragraph 53.

## **CONCLUSIONS**

55. The ‘271 mark is revoked in its entirety from 18 December 2018.

56. The ‘188 mark is revoked for *Infants' and invalids' foods* from 19 February 2010 with the reworded specification “*feeding preparations and nutritional formulas, all being for babies and infants*” applying from 19 February 2010 onwards.

## **COSTS**

57. As both sides had achieved a measure of success, I consider that each should bear its own costs.

**Dated this 13<sup>th</sup> day of September 2022**

**Teresa Perks  
For the Registrar**