TRADEMARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for the revocation of the registration of the International Registration designating Ireland, IR No. 1045463 and in the matter of the registered Proprietor's opposition thereto.

Applicant for Revocation: Vetnique Labs LLC

Proprietor: HASCO TM spólka z ograniczona odpowiedzialnoscia spólka komandytowa

The registered Trademark

1. HASCO TM spólka z ograniczona odpowiedzialnoscia spólka komandytowa (hereinafter "the Proprietor") of ul. Zmigrodzka 242E, PL-51-131 Wroclaw, Poland is the registered Proprietor of IR No. 1045463 in respect of "*Pharmaceutical products, chemical preparations for medicinal purposes, chemical preparations for pharmaceutical purposes, hormones for medical purposes, capsules for pharmaceutical purposes, medicines for human purposes, pills for pharmaceutical purposes, pills for pharmaceutical use, analgesics, anticancer preparations, antineoplastic agents, medicines containing inhibitors, drugs reducing estrogen, drugs used to treat hormone-dependent cancers, medicines containing of aromatase inhibitors, drugs regulating levels of hormones, drugs used for postmenopausal women."* in Class 5.

2. The mark was designated by WIPO to Ireland on 07 May 2010 and the publication of the registration of the mark appeared in Journal No. 2165 dated 08 December 2010

3. On 30 January 2019 **Vetnique Labs LLC** of 3077 Stefan CT, Lisle, Illinois 60532, United States of America (hereinafter "the Applicant"), made an application for the revocation of the registration pursuant to the provisions of

Section 51 of the Trademarks Act, 1996 ("the Act") and Rule 41 of the Trademark Rules,1996.

4. The Proprietor filed a Notice of Opposition dated 11 July 2019, an accompanying Statutory Declaration dated 19 June 2019, of Ms Beata Maria Peplowska, representative of the Proprietor and various exhibits labelled D1 to D16, including licence agreements, invoices showing purchases under the contested mark, Glandex, in Ireland, invoices showing sales under the contested mark in Poland, marketing authorisations for the contested mark in Poland, examples of packaging for Glandex in Polish and patient information leaflet .

5. Acting for the Controller, the Hearing Officer decided to reject the application for revocation with the exception of "capsules for pharmaceutical purposes" and "analgesics" and to allow the mark to remain on the Register for the following goods in Class 5: "Pharmaceutical products, chemical preparations for medicinal purposes, chemical preparations for pharmaceutical purposes, hormones for medical purposes, medicines for human purposes, pills for pharmaceutical purposes, pills for pharmaceutical use, anticancer preparations, antineoplastic agents, medicines containing inhibitors, drugs reducing estrogen, drugs used to treat hormone-dependent cancers, medicines containing of aromatase inhibitors, drugs regulating levels of hormones, drugs used for postmenopausal women." The parties were advised of this decision on 24 July 2019.

6. The Applicant for Revocation, on 12 August 2019, advised of their wish for a Hearing to enable the Applicant to make submissions in relation to the evidence filed by the Proprietor and also the decision to grant a partial revocation of the registration. A Hearing held on 12 September 2019 was attended by Mr Dermot Doyle, representing the Controller, and Mr Paul Kelly of FRKelly, representing the Applicant for Revocation. Following this, the Office advised the parties that the administrative measures relating to the provisions of Rule 41(4) of the Trademark Rules 1996 may not have been applied in their entirety in this case. Arising from this, the Hearing Officer decided to annul his earlier decision as advised on 24 July 2019. The Applicant was afforded the opportunity, should they wish, to file further material in support of their application. They were also

advised that should they decide to file further evidence then the case would be assigned to an alternate Hearing Officer for decision.

7. On 12 November 2019 Mr Kelly filed submissions on behalf of the Applicant. The thrust of these was that the Proprietor's mark should be revoked in accordance with Section 51(1)(b) of the Trademarks Act as the Proprietor failed to show genuine use of the mark.

8. On 27 January 2020 Dr Magdalena Krekora filed a response to Mr Kelly's submissions of 12 November 2019 and also filed additional evidence in support of the Proprietor's case showing use of their mark in Ireland.

9. On 28 January 2020, both parties were offered the opportunity to attend a hearing, file written submissions in lieu of attending at a hearing or have the application decided upon by the Controller based on the materials filed to date. The Applicant advised that they wished to be heard in relation to this while the Proprietor opted to file written submissions in lieu of a hearing.

10. On 30 March 2020 written submissions were filed in support of the Proprietor's case.

11. A Hearing was held on 6th July 2021 at which the Applicant was represented by Mr Paul Kelly and, for the reasons outlined in point 6 above, I presided.

12. On 30th July 2021, the parties were advised of my decision to grant a partial revocation of the mark in respect of the following goods in Class 5: "*capsules for pharmaceutical purposes"* and *"analgesics"*. The mark will remain on the Register in respect of the remainder of the goods in Class 5 as follows: "*Pharmaceutical products, chemical preparations for medicinal purposes, chemical preparations for pharmaceutical purposes, hormones for medical purposes, medicines for human purposes, pills for pharmaceutical purposes, pills for pharmaceutical use, anticancer preparations, antineoplastic agents, medicines containing inhibitors, drugs reducing estrogen, drugs used to treat hormone-dependent cancers, medicines containing of aromatase inhibitors, drugs regulating levels of hormones, drugs used for postmenopausal women.*

In so deciding, I considered carefully all the materials and arguments advanced by both parties and relevant caselaw and precedents. I will refer to these materials as and when appropriate and necessary below.

13. The parties were informed of my decision by way of letter dated 30 July 2021. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Applicant filed on 27 August 2021.

The Application for Revocation

14. The Applicant grounds its application for revocation on the following:

    i. That use of the Trademark in connection with a very broad specification for pharmaceutical products, chemical preparations for medicinal purposes, chemical preparations for pharmaceutical purposes, hormones for medical purposes, capsules for pharmaceutical purposes, medicines for human purposes, pills for pharmaceutical purposes, pills for pharmaceutical use, analgesics, anticancer preparations, antineoplastic agents, medicines containing inhibitors, drugs reducing estrogen, drugs used to treat hormone-dependent cancers, medicines containing of aromatase inhibitors, drugs regulating levels of hormones, drugs used for postmenopausal women has been suspended for an uninterrupted period of five years prior to the date of their application for revocation and that there are no proper reasons for such non-use.
    ii. They therefore contended that the mark in question should be revoked on these grounds.

Notice of Opposition

15. In its Notice of Opposition of 11th July 2019, the Proprietor defended its registration on the following grounds:

    i. The Mark Glandex has been used by the Licensee of the Holder for his medicinal product authorised and sold in Poland as evidenced by a copy of the Marketing Authorisation Agreement between the Holder and the

Licensee. The product is manufactured in Ireland for export to and sold on the Polish market

ii. Evidence was filed in support of this claim and included

- A Statutory Declaration by the Holder
- Copies of Marketing and Manufacturing Agreements
- Copies of purchase invoices
- Copies of sales invoices
- Marketing Authorisation for Glandex in Poland
- Glandex Packaging Design
- Patient Information Leaflet
- Extract from the Polish Company Register

iii. The Opponent further contended that use of a mark for the purpose of export is also considered as use of the mark in Ireland

iv. The Mark in question is used in relation to the treatment of breast cancer. It was contended that almost all of the terms listed in the list of goods of the mark describe the product Glandex as sold by the licensee of the holder with the exception of "*capsules for pharmaceutical purposes*" and "*analgesics*".

v. The Mark Glandex has been genuinely used in Ireland by the Proprietor within the period of five years prior to the filing of the application for revocation and the ground for revocation is not well founded. The registration of the Mark should therefore be upheld.

16. As summarised in points 5 and 6 above, following a Hearing due to an acknowledged administrative error on behalf of the Office, the original decision of the Hearing Officer was annulled and the applicant for revocation was on 12th September 2019 afforded the opportunity to file further material in support of their application. The Opponent was also offered the opportunity to reply to any such additional material being filed.

17. On 12th November 2019, the Applicant filed submissions in support of their case for revocation which can be summarised as follows:

- The submissions filed on behalf of the Proprietor indicate sales of their product in Poland. This does not have any direct correlation with product claimed to be manufactured in Ireland.
- The specification contained within the registered mark covers a very broad range of terms and a broad range of goods.
- The evidence filed by the Proprietor should not be admitted due to deficiencies in its completeness
- It was contended that the licence agreement between the holder and a company in Poland contained deficiencies that resulted in it having no effect insofar as use of the mark in Poland is concerned.
- It was further contended that the licence and supply agreement between the licensee and an Irish based manufacturing company which was filed in evidence by the Proprietor was in fact incomplete.
- It was the view of the Applicant that the evidence of sales invoices filed on behalf of the Proprietor were unclear. Invoices purporting to show evidence of sales of product under the contested mark in Poland were not relevant to the proceedings.
- Additionally, evidence relating to marketing authorisation of the product for sale in Poland was not relevant.
- The packaging and patient information evidence supplied does not show evidence of use of the mark in Ireland.
- An extract from the Polish Commercial register was held to be not relevant.
- The promotional material supplied by the Proprietor was held to have no bearing on the position in Ireland.

The Applicant then included a list of the well known and established principles from case law that should be followed when determining whether genuine use of a mark had occurred.

The issue to be determined is whether the mark in question is being put to genuine use insofar as the alleged export of the product from Ireland is concerned. The Applicant contended that the Proprietor had not shown genuine use of the mark in Ireland for the reasons contained in their submission of 12th November 2019 and summarised above.

18. On 27th January 2020, the Opponent to the application for Revocation filed a response to the Applicant's submission of 12th November 2019. This included a sample of the packaging used on the product, a copy of the quality and technical agreement with the Irish manufacturer Eirgen Pharma together with a copy of a statutory agreement signed by the CEO of Eirgen, data obtained from an external source IQVIA (a healthcare data science company) and a copy of a license agreement governing use of the product. The main points of the submission can be summarised as follows:

    - Affixing of a trademark to goods or to the packaging thereof in the State solely for export purposes is considered as use of the trademark
    - An accumulation of items of evidence has greater resonance in proving the accuracy of facts than if considered individually as per established case law as quoted. When considering proof of use, therefore, account must be taken of all of the evidence submitted for assessment in support of this.
    - The marketing authorisation document filed by the Proprietor is evidence of the good manufacturing practice in respect of the medicinal products for human use to which this refers. This document confirms that the product in question has two authorised manufacturers, one of whom is based in Ireland. The document confirms that the product is manufactured and final packaged in Ireland bearing the mark Glandex.
    - Copies of the technical agreement with the Irish manufacturer Eirgen Pharma and of a Statutory Declaration signed by the CEO of the latter confirm that the product is manufactured and packaged in Ireland for the purpose of exporting to Poland.
    - The Statutory Declaration filed by Ms Peplowska, representative of the Proprietor, was in accordance with the provisions of Rule 66 of the

Trademark Rules 1996. The reasoning behind this contention was included.

- The submission then went on to refute the arguments made by the Applicant in their submission of 12th November 2019 in respect of the packaging on the product, the invoices issued by the Irish manufacturer, Eirgen and the amounts of the product involved.
- The Opponent then contended that, due to the specialised nature of the product, the evidence filed, and the clarifications provided in the submission of 27th January 2020 proved that the product manufactured in Ireland and exported to Poland showed genuine use of the trademark Glandex in Ireland.
- All of the product manufactured under the mark by Eirgen is sold to the licensee of the holder who is entitled to use the mark Glandex. This product is then sold exclusively in the Polish marketplace.
- The sales of one product may serve as a proof of use for more than one of the goods listed in the list of goods of the registered mark.
- The Applicant's questioning of the Opponents invoice evidence was challenged in that the invoices clearly indicate the name of the product.
- All of the documents filed by the Opponent proved when combined that the product supplied under the mark Glandex was manufactured and packaged in Ireland for export to Poland.
- The application for revocation was therefore not well founded and the registration of the trademark Glandex should be upheld.

19. On 28th January 2020 the Office wrote to both the Applicant and the Opponent and invited them to opt for one of attendance at a hearing before an alternate hearing officer, file written submissions in lieu of attending at a hearing or elect to have the matter decided by the Controller based on the materials filed to date.

20. The Applicant replied and advised of their wish to attend at hearing while the Opponent opted to file written submissions in lieu of attending at a hearing.

Written Submission

21. On 30th March 2020, the Opponent filed these written submissions which in the main repeated with emphasis the points made in their submission of 27th January 2020 and summarised in point 18 above. The principal elements of this are as follows:
    - The Holder signed a licence agreement with a company belonging to the same group.
    - The licensee in turn obtained a marketing authorisation in Poland for a medicinal product Glandex.
    - The product Glandex is manufactured in Ireland by a manufacturer of medicinal products, Eirgen Pharma Ltd.
    - Eirgen manufacture, pack and export the product to Poland for the purpose of the sale by the licensee on the Polish market
    - Evidence of the above was filed by way of statutory declarations, copies of agreements between the principal parties involved, copies of purchase and sales invoices, marketing authorisation, packaging, patient information leaflet, Polish company register data, promotional material, quality/technical agreement, and data obtained from an external source (IQVIA).

22. Dr Krekora concluded her Declaration by stating the evidence submitted establishes genuine use in relation to the goods of the registration which are the subject of this revocation action and disproves the Applicant's claim that in consequence of acts or inactivity of the proprietor the mark Glandex should be revoked.

The Hearing

23. At the Hearing held by me on 6th July 2021 the Applicant was represented by Mr Paul Kelly, Trademark Attorney of FRKelly. A summary of Mr Kelly’s submission is as follows:
    - The relevant five-year period runs from January 30, 2014, to January 29, 2019.

- It is accepted and conceded that the registered proprietor has not proved use of the Trademark in Ireland itself. However, it is accepted that use of the Trademark for the purposes of export from Ireland does constitute use insofar as an Irish Trademark registration is concerned.
- The purpose of the relevant provisions in relation to revocation in the Act is to ensure that the Trademark Register can be cleared of unused Trademarks, particularly in order to allow a third party who has a genuine interest in securing rights to do so. Additionally, it ensures that the register can reflect the commercial reality and allow third parties to be reasonably clear as to the scope of the rights. The onus of proving use of the Trademark registration in respect of the goods for which it is registered falls squarely on the registered proprietor.
- It is usually the case that the specification contained in a Trademark application would identify the specific goods of interest to ensure that they were covered.
- Genuine use means actual use of the Trademark by the proprietor or by a third party with authority to use the Mark: Ansul at [35] and [37].
- 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]; centrothern at [71]; reber at [29].
- Affixing of a Trademark 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:Gozze at [43] – [51].
- 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 customs are underway, 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].

- 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].
- 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]
- 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 deminimis rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72] and [76]-[77]; Leno at [55].
- It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: Reber at [32]."
- The Registered Proprietor has to prove that they created and preserved a market in the goods. In this regard, it is submitted that as we are dealing with alleged export of goods, the creation and preservation of the market must be in the country to which product is exported.

- The evidence filed by the Proprietor consists of a Declaration by Beata Maria Peplowska and Exhibits D2 to D16
- Exhibit D2 is a Licence Agreement that appears to have no relevance to the case
- Exhibit D3 is a Licence & Supply Agreement between P.P.F. Hasco Lek S.A. and Eirgen Pharma Ltd and is dated 14 December 2009 and is therefore outside the relevant period. We do not know if the Agreement is still in force and, therefore, this should be disregarded
- Exhibits D4, D5, D6, D7, D9, D10 ,D11, D12, D14 and D15 are also dated with dates that are outside the relevant period
- Exhibit D7 makes no reference to GLANDEX.
- Exhibit D17, this does not show the actual activities operated under the Agreement.
- It is submitted that the Registered Proprietor has not discharged the burden of showing genuine use of the Trademark during the relevant period. There is no evidence to show manufacture or export of the product during the relevant period and, furthermore, no evidence to show the Registered Proprietor has created or preserved an outlet for the goods in Poland.
- In the circumstances, the Trademark Registration should be revoked in its entirety.
- If the Tribunal is satisfied that there has been genuine use, during the relevant period which we dispute, it is incumbent on the Tribunal to arrive at a fair specification that reflects the commercial reality of the situation. In this regard, the product is identified as active substance Exemestane, film coated tablets) on page 5 of Exhibit D3. Exemestane is a substance to treat breast cancer, an antiestrogen aromatase inhibitor that stops the production of estrogen in post-menopausal women.
- If the Tribunal is minded to accept genuine use (which once again we dispute), the specification should be reduced to identify the specific goods as identified above.

- Alternatively, the specification should be reduced to the specific goods and identified as being for export to Poland only. This will ensure that the register accurately reflects the reality of the situation and identifies the Trademark as being a badge of origin of those goods for export to Poland only.

The law

24. The relevant provisions are in Section 51 of the Act, and are written in the following terms:

"(1) The registration of a Trademark may be revoked on any of the following grounds –

(a) that, within the period of five years following the date of publication of the registration, the Trademark has not been put to genuine use in the State, by or with the consent of the proprietor, 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;

(2) For the purposes of subsection (1), use of a Trademark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the Trademark in the form as used is also registered in the name of the proprietor and use in the State includes affixing the Trademark to goods or to the packaging of goods in the State solely for export purposes.

(3) The registration of a Trademark shall not be revoked on the ground mentioned in paragraph (a) or (b) of subsection (1) 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; but, for this purpose, any such commencement or resumption of use occurring after the expiry of the five year period and 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 Trademark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a Trademark 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 Controller or the Court is satisfied that the grounds for revocation existed at an earlier date, that date.

Relevant Period

25. In these proceedings, in light of the publication of the registration of the contested mark on 13 April 2011 and the application for its revocation having been made on 30 January 2019, the period in which the mark must have been put to genuine use is from 30 January 2014 to 29 January 2019, with the period between 20 October 2018 and 29 January 2019 being disregarded if use of the mark had been suspended and resumed during that three-month period.

Issues

26. The questions to be decided are (i) was the mark put to use in the State by the Proprietor or with its consent between 30 January 2014 to 29 January 2019; (ii) if so, was it used in respect of all the goods for which it is registered; and (iii) if it was used for some or all of the goods, was it genuine use?

Decision

27. Having considered all of the evidence filed on behalf of the Opponent and the counter arguments made by the Applicant, I am satisfied that the evidence shows that pharmaceutical products bearing the Glandex Mark were manufactured in Ireland and exported for sale in the Polish marketplace within the relevant period. Adequate proof by way of sales invoices, turnover figures, advertising, and promotion expenditure was furnished to demonstrate this. So, the answer to the first question is yes.

28. Was the mark used in respect of all the goods for which it is registered? The mark is registered in respect of the following goods in Class 5, "*Pharmaceutical products, chemical preparations for medicinal purposes, chemical preparations for pharmaceutical purposes, hormones for medical purposes, capsules for pharmaceutical purposes, medicines for human purposes, pills for pharmaceutical purposes, pills for pharmaceutical use, analgesics, anticancer preparations, antineoplastic agents, medicines containing inhibitors, drugs reducing estrogen, drugs used to treat hormone-dependent cancers, medicines containing of aromatase inhibitors, drugs regulating levels of hormones, drugs used for postmenopausal women."* The Proprietor in their Notice of Opposition of 11th July 2019 failed to provide evidence of the use of "*capsules for pharmaceutical purposes" or "analgesics".* Accordingly, under Section 51(5) I must revoke the registration in respect of both of "*capsules for pharmaceutical purposes" or "analgesics".* The effective date of the partial revocation to be the date the Applicant made its application, namely, 30 January 2019.

29. The third question to be addressed is whether the use shown constitutes "genuine use". The Act does not define the term words "genuine use" of a Trademark for the purposes of Section 51, but the words have been considered by the Court of Justice of the European Union (CJEU) in *ANSUL*[1], wherein the Court stated that:

> *"…. there is 'genuine use' of a Trademark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order*

[1] Ansul BV v. Ajax Brandbeveiliging BV (Case No. C-40/01)

to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the Trademark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark."

30. The CJEU has set out what is required in order to establish genuine use of a Trademark insofar as revocation proceedings are concerned. These include *Ansul*[2]*, La Mer*[3]*, Silberquelle*[4] *and Sunrider*[5] in which the following factors were identified as the criteria to be assessed by competent authorities:

i. Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark. (Ansul at paragraph 35)

ii. The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration. (Ansul at paragraph 36)

iii. The use must be consistent with the essential function of a Trademark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin. (Ansul at paragraph 36; Sunrider at paragraph 70; Silberquelle at paragraph 17)

iv. The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e., exploitation that is

[2] Ansul BV v Ajax Brandbeveiliging BV (C-40/01) [2003] E.C.R. I-2439
[3] La Mer Technology Inc v Laboratoires Goemar SA (C-259/02) [2004] E.C.R. I-1159
[4] Silberquelle GmbH v Maselli-Strickmode GmbH (C-495/07) [2009] E.C.R. I-2759
[5] Sunrider v Office for Harmonisation in the Internal Market (C-416/04 P) [2006] E.C.R. I-4237

aimed at maintaining or creating an outlet for the goods or services or a share in that market. (Ansul at paragraphs 37-38; Silberquelle at paragraph 18)

v. Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. (Ansul at paragraph 39; La Mer at paragraphs 18 and 24-25; Sunrider at paragraph 72)

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

31. It is clear from the foregoing that “genuine use” may be equated with actual use, provided that such use has been more than mere token use and that the use in question has brought the mark to the notice of the relevant class of consumers of the goods for which it is registered. It is not necessary for the purpose of proving genuine use of a mark to establish that the use in question has been continuous or extensive or that it has resulted in the mark becoming well-known to the relevant consumers. It is sufficient to show that the mark has been used as a Trademark for the goods within the relevant period and that it has, as a result, come to the notice of consumers of those goods.

32. The evidence of use submitted in support of maintaining the registration is sufficient to meet the criteria identified by the Court. This use is consistent with the essential function of a Trademark and has guaranteed the identity of the origin of the goods as being the Proprietor. Accordingly, it has performed the essential function of a Trademark by serving to distinguish the Proprietor's pharmaceutical products from other pharmaceutical products of a different origin.

33. Accordingly, I have decided to reject the application for revocation and to allow the registration to remain on the Register in respect of the goods for which use has been proven, namely, "Pharmaceutical products, chemical preparations for medicinal purposes, chemical preparations for pharmaceutical purposes, hormones for medical purposes, medicines for human purposes, pills for pharmaceutical purposes, pills for pharmaceutical use, anticancer preparations, antineoplastic agents, medicines containing inhibitors, drugs reducing estrogen, drugs used to treat hormone-dependent cancers, medicines containing of aromatase inhibitors, drugs regulating levels of hormones, drugs used for postmenopausal women." I have decided to revoke the registration in respect of "capsules for pharmaceutical purposes" and "analgesics" only.

John Nolan
Acting for the Controller
29 December 2021