onsagers

Patentstyret
Sandakerveien 64
Postboks 8160 Dep.
0033 OSLO

Oslo, 11. november 2016

Vår ref.: J1202NO00 / ASR
Thomas Gaarder-Olsen

Deres ref.: 201501628

PROTEST MOT VAREMERKESØKNAD
Søknad nummer 201501628
Merke: Fargemerke (Pantone 2587C)
Søker: Glaxo Group Limited

1. Innledning

På vegne av Sandoz A/S har vi tidligere inngitt protest mot varemerkesøknad nr 201501628, et fargemerke bestående av en bestemt lillanyanse med Pantonekode 2587C, jfr. vårt brev datert 2016.05.27

Patentstyret kom kort tid etter med en uttalelse datert 2016.06.03, der det ble informert om at varemerkelovens registreringsvilkår ikke var ansett oppfylt, og at det søkte merket dermed ble nektet registrert. Uttalelsen var velbegrunnet og viser at Patentstyret har forstått sakens problemstillinger.

Søker har senere inngitt en ny besvarelse i saken, datert 2016.09.09. Selv om denne besvarelsen etter Sandoz mening ikke tilfører saken noe nytt som skulle endre Patentstyrets oppfatning, ønsker vi å knytte noen kommentarer til den.

2. Klassifisering

Som tidligere anført, og som lagt til grunn av Patentstyret, er det søkte merket søkt for en varefortegnelse begrenset til medisinsk utstyr i klasse 10, mens den inngitte bruksdokumentasjonen utelukkende viser bruk i forbindelse med legemidler/medisiner, som hører hjemme under vareklasse 5. Som nærmere redegjort for nedenfor anser Sandoz uansett ikke den inngitte dokumentasjonen for å vise farge brukt som varemerke, men i alle tilfelle viser ikke dokumentasjon bruk i forbindelse med medisinsk utstyr i klasse 10.

Søker hevder på sin side at det aktuelle produktet er korrekt plassert i klasse 10, og at salg av astmamedisinen Seretide viser bruk av medisinsk utstyr i denne klassen. Søker understøtter dette blant annet ved å vise til Nice-klassifiseringsretningslinjene og til andre aktørers registreringer.

Det er riktig at en inhalator hører hjemme i klassifikasjonens klasse 10. Dette gjelder alle inhalatorer, uansett om de er tenkt benyttet for behandling av astma og kols eller ethvert annet medisinsk formål. At

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andre aktører, herunder Novartis, har registrert sine inhalatorvaremerker i klasse 10 er følgelig helt naturlig.

Det skal i denne sammenheng også bemerkes at på tidspunktet for en varemerkesøknad er det ikke alltid avgjort om inhalatoren under utvikling vil bli en refyllbar inhalator som hører hjemme i klasse 10 eller ikke. Dette skiller seg imidlertid naturligvis fra søkers foreliggende varemerkesøknad, hvor mulig registrering avhenger av eventuell bruk søker har gjennomført av det søkte merket på faktiske varer.

Som redegjort for i tidligere inngitte protest skal det bestrides at den av søker inngitte bruksdokumentasjon for lilla i forskjellige nyanser viser kjennetegnsbruk. Dokumentasjonen viser imidlertid uansett bare bruk i forbindelse med salg av medisinen Seretide, og ikke salg av inhalatorer.

Formålet med all markedsføring og salg som dokumentert er omsetning av medisinen, ikke det medisinske utstyret som en inhalator utgjør. En pasient som kjøper Seretide gjør dette for å få medisin mot astma, ikke for å erverve en inhalator som sådan.

Dette skillet mellom medisin i klasse 5 og medisinsk utstyr i klasse 10 kommer tydelig frem i de forklarende bemerkninger i Nice-klassifikasjonen:

> *«Klasse 5 omfatter hovedsakelig farmasøytiske preparater og andre preparater for medisinsk bruk.»*
>
> *«Klasse 10 omfatter hovedsakelige medisinske apparater, instrumenter og artikler»*

I søkers bruksdokumentasjon er det hele tiden medisinen som er det sentrale, ikke inhalatoren, som også redegjort for tidligere. I søkers siste besvarelse er dette igjen gjennomgående, og vi viser blant annet til følgende formuleringer:

«Globalt er produktet det fjerde mest solgte farmasøytiske produktet noensinne» (s. 9).

«Produktet har vært en av Norges mest solgte medisiner» (s. 9).

«[...] var GSK med sitt produkt Seretide alene i over 15 år, frem til 2014, om å markedsføre medisiner med denne fargen» (s. 30)

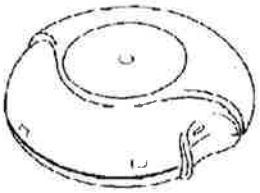
Søker er også innehaver av en norsk varemerkeregistrering for ordmerket SERETIDE, ref. reg. nr. 144026. Dette merket er kun registrert for «farmasøytiske preparater og stoffer» i klasse 5.

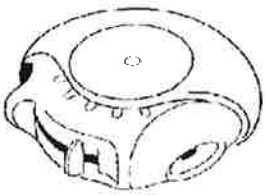
Søker har videre inngitt flere søknader internasjonalt for det samme fargemerket som i foreliggende søknad. Samtlige øvrige søknader omfatter også klasse 5. Dette gjelder søknads nr. 3020150444324 i Tyskland, 014596951 i EU, UK00003108001 i Strobritannia, 01313203 i Benelux og 2015105654 i Japan.

Selv i Norge har søker inngitt en ny søknad for samme merke som omfatter klasse 5, ref. søknadsnr 201607202. Dette kan jo tyde på at søket selv har innsett at en varefortegnelse kun omfattende klasse 10 ikke er i overensstemmelse med faktisk bruk av fargen.

Vi vil i denne forbindelse vist til den nylig avsagte avgjørelsen fra EUIPO Boards of appeal i sak R 2108/2015-4, datert 31. august 2016.

Denne saken gjaldt en innsigelse inngitt av Glaxo Group Limited mot en EUTM-søknad inngitt av Celon Pharma. Innsigelsen var basert på forvekslingsfare med Glaxos egne registreringer for Diskus-inhalatoren, herunder fransk varemerkeregistrering nr. 97685112 for det kombinerte merket nedenfor, registrert for bl.a. inhalatorer i klasse 10.





Glaxo ble bedt om å dokumentere bruken for dette merket, og det ble da fremlagt bruksdokumentasjon som viste inhalatoren markedsført og solgt med astmamedisin, på samme måte som bruksdokumentasjonen fremlagt av søker i Norge viser.

BoA konkluderte med at dette ikke viste bruk for inhalatorer i klasse 10, men kun for de respektive medisinene, hjemmehørende i klasse 5. Det ble eksplisitt kommentert at inhalator i vareklasse 10 er en vare som kan kjøpes uavhenging av virkestoff og som kan bli gjenbrukt, for eksempel ved å kunne etterfylles med ny medisin.

Vi viser til følgende avsnitt fra avgjørelsen (våre uthevelser):

> *37 Moreover, it is also clear from the cancellation applicant's submissions and evidence that* ***the inhaler contains a medicinal substance (against asthma) but is not sold separately*** *and there is no possibility to refill/reuse the DISKUS inhaler. The cancellation applicant explained in detail and also submitted, inter alia, an article from 'Pulse', dated August 1999, in which it is stated that 'an integral dose counter displays the number of doses left in the device, with the last five doses appearing in red to remind the patient that the inhaler needs to be changed'.*
>
> *38 The DISKUS Inhaler alone is not available for sale and it is only and always sold together with the medicine i.e. it is not reusable.*
>
> *39 Therefore, the opponent* ***did not prove use of its earlier trade marks for inhalers but only for the respective medicines*** *which are not covered by its earlier registrations.*
>
> *40* ***The DISKUS inhaler is just a transport medium like ampules, syringes or bottles – a type of packaging****. The cancellation applicant submitted as evidence (Exhibit 21) list of awards for the DISKUS/ACCUHALER and they include awards from the German Packaging Institute for 'the most innovative packaging and for packaging-related solutions of the year', and the DuPont Award for Packaging Innovations 2005 and Packaging Award (Sweden).*
>
> *41* ***The goods in Class 10 must be distinguished from medicinal substances, namely substances to treat diseases or health problems, such as asthma, which fall into Class 5. An 'inhaler' falling into Class 10 is a good which can be bought separately, independently from the active ingredient, and which can be reused, e.g.refilled****. The opponent has proven use for the active substances but none of its earlier trade marks are registered in Class 5. The cancellation applicant does not sell the inhaler separately, without the medicine and therefore* ***the mark is not used for the goods for which it is registered.***

Avgjørelsen vedlegges i sin helhet som:

Bilag 1: BoA avgjørelse i sak R 2108/2015-4.

Vi ber derfor Patentstyret fastholde at den fremlagte dokumentasjonen ikke viser bruk for klasse 10 varer, også i tråd med hva EUIPOs Boards of Appeal legger til grunn.

3. Omsetningskrets

Som anført i Sandoz' tidligere protest og som også lagt til grunn av Patentstyret må pasienter, som både er kjøper og sluttbruker av produktene, regnes med som en sentral del av omsetningskretsen.

Det skal også bemerkes at søker, nok en gang, hevder at astma- og KOLS-medisiner ikke er på byttelisten. Dette er positivt feil, som også dokumentert i Sandoz' protest av 2016.05.27. Søkers produkt Seretide er et av produktene som er på byttelisten.

Det hevdes i søkers seneste besvarelse at omsetningskretsen «*er sammensatt av et stort flertall av leger og farmasøyter og en svært liten gruppe pasienter, som bare er involvert i et lite antall tilfeller*». Denne marginaliseringen av pasienter er delvis basert på det feilaktige premisset om at astmamedisin ikke er på byttelisten.

Med virkning fra 19. oktober 2016 ble det i Norge åpnet for nettsalg av reseptbelagte legemidler. Det vil si at pasienten nå kan logge seg inn på apotekets nettsider, hente frem resepten og kjøpe det reseptbelagte legemidlet, som han så kan få levert rett hjem.

Når det gjelder medikamenter på byttelisten, slik som søkers Seretide, vil pasienten i nettbutikken selv kunne velge mellom de byttbare legemidlene. Med andre ord, hjemme i egen stue, uten lege eller farmasøyt til stede, vil pasienten fritt kunne velge mellom alternative medisiner og treffe sin egen kjøpsbeslutning.

Det skulle dermed ikke lenger være noen som helst tvil om at pasienten er en sentral del av den relevante omsetningskretsen.

Som påpekt av Oslo tingrett og vist til på side 2 og 3 av Sandoz' tidligere protest, har GSK selv tidligere lagt til grunn at pasienter er en del av omsetningskretsen, men etter at de ikke lyktes med å rekruttere pasienter til kjennskapsundersøkelsen, hevder de nå at pasienter ikke har nevneverdig betydning.

Denne argumentasjonen kan ikke føre frem, og som en konsekvens av dette kan heller ikke den av søker fremlagte markedsundersøkelsen legges til grunn, ettersom den ikke omfatter denne sentrale delen av omsetningskretsen.

Vi vil videre vise til EUIPOs slettelsessaker (cancellation) nr. 10179C, 10180C og 10181C, som gjelder Glaxos EU-registreringer nr 2179562, 2179695 og 2179737. Alle registreringene var 3D-registreringer av aerosol-inhalatorer i forskjellige lillanyanser, og de tre avgjørelsene er i praksis identiske. Vi vedlegger kopi av en av avgjørelsene:

Bilag 2: EUIPOs avgjørelse i slettelsessak 10180C.

EUIPO uttaler følgende om omsetningskretsen for astmamedisin (s. 21 i avgjørelsen) (våre uthevelser):

> *The Cancellation Division considers that* ***the relevant public includes both medical professionals (i.e. doctors and pharmacists) and average consumers, that is to say, people who suffer from respiratory ailments.*** *Indeed, where the goods at issue are medicinal products requiring a doctor's prescription prior to their sale to end-users in pharmacies,* ***the relevant public comprises both end-users and health professionals****, that is to say doctors who prescribe the medicinal product and pharmacists who sell the prescribed medicinal product. Even though the choice of those products is influenced or determined by intermediaries,* ***the perception of the general public is still relevant, since patients get in contact with relevant goods when***

> ***purchasing and using the inhalers. As is apparent from the case-law, even in the case of medicinal products available only on prescription, it cannot be excluded that the average consumer forms part of the relevant public. Accordingly, the relevant public comprises both health professionals and average consumers*** *(see, to that effect, 26/04/2007, C-412/05 P, Travatan, EU:C:2007:252, § 52 to 63; and 09/02/2011, T-222/09, Alpharen, EU:T:2011 :36, § 43 and 44).*

Glaxo hadde i disse sakene lagt frem markedsundersøkelser som var ment å dokumentere innarbeidelse av farge som kjennetegn, men som for undersøkelsen fremlagt for Patentstyret var denne kun gjennomført blant leger og farmasøyter.

EUIPO påpeker at undersøkelsene ikke dekke hele omsetningskretsen, og undersøkelsene ble derfor ikke tillagt vekt. Vi viser til EUIPOs uttalelser på side 30 i avgjørelsene;

> *Fourthly, as correctly put forward by the applicant, besides referring to only some of the relevant EU Member States, all* ***the surveys were conducted only among healthcare professionals, namely general practitioners and pharmacists. The criteria for selecting the public interviewed must be assessed carefully. The sample must be indicative of the entire relevant public and must be selected randomly*** *(29/01/13, T-25/11, Cortadora de cerarnica, EU:T:2013:40, § 88). The only documents referring to the perception of general public are comments posted in internet biogs from Belgium, Denmark, France, Germany, the Netherlands and the UK. However, in the majority of the case, the colour purple is mentioned in association with the brand 'SERETIDE' and the fact that in some cases is linked to inhalers does not constitute solid evidence that the shape in question has acquired distinctiveness for the relevant goods.*

Dette bekrefter hva som tidligere er anført, nemlig at GSK's fremlagte markedsundersøkelse er mangelfull ved at den ikke dekker pasienter, i tillegg til andre mangler, og at undersøkelsen følgelig uansett ikke kan tas til inntekt for innarbeidelse av det søkte merket som kjennetegn.

4. Bruk av farger

GSK skriver i sin siste besvarelse, på side 9, at «*Så snart man erkjenner at den relevante omsetningskretsen er helsepersonell, blir det klart at GSK har gjort ustrakt bruk av merket rettet mot det aktuelle publikummet*».

Premisset som her legges til grunn, at den relevante omsetningskretsen kun er helsepersonell, skulle nå være motbevist.

Det er tidligere grundig gjort rede for og dokumentert hvordan farger benyttes, og blir oppfattet, på astmainhalatorer for å indikere bruksområde og virkestoff. Som vist til at Oslo tingrett har også søker selv benyttet farger, herunder lilla, på denne deskriptive måten.

Det er ikke et eneste eksempel på den av søker fremlagte dokumentasjonen som viser det søkte merket benyttet som et tegn på kommersiell opprinnelse. Søker skriver selv i siste besvarelse at «*det er selvsagt umulig for et abstrakt fargemerke å bli brukt isolert*», så da kan det legges til grunn at farge uten unntak har vært benyttet sammen med varemerker som SERETIDE og GSK.

Søker viser her til EU-domstolens sak C-353/03 for å argumentere for at bruk sammen med andre varemerker ikke hinder Pantone 2587C fra å få særpreg gjennom bruk. Avgjørelsen det vises til sier imidlertid noe annet, jfr. punkt 26 i avgjørelsen som er sitert i søkers besvarelse: «[…] *must be as a result of the use of the mark as a trademark*».

For at et merke, som er benyttet sammen med et annet varemerke, skal kunne opparbeide særpreg, er det altså en forutsetning at dette elementet er benyttet som et varemerke, altså som et tegn som i seg selv

viser kommersiell opprinnelse. Dokumentasjon på at den søkte fargen er benyttet på denne måten er ikke fremlagt.

Dette prinsippet er for øvrig presisert i senere avgjørelser fra EU-domstolen, f.eks. i sak C-215/14 fra 2015. Her uttaler EU-domstolen som følger (våre uthevelser):

> *63 So far as, specifically, the acquisition of distinctive character in accordance with Article 3(3) of Directive 2008/95 is concerned,* ***the expression 'use of the mark as a trade mark' must be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the goods or services as originating from a given undertaking*** *(iudqrnent in Nestle, C-353/03, EU:C:2005:432, paragraph 29).*
>
> *64 Admittedly, the Court has acknowledged that such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. However, it has added that in both cases* ***it is important that, in consequence of such use, the relevant class of persons actually perceive the goods or services, designated exclusively by the mark applied for, as originating from a given undertaking*** *(iudqrnent in Nestle, C-353/03, EU:C:2005:432, paragraph 30, and, in connection with Regulation No 40/94, Article 7(3) of which corresponds, in essence, to Article 3(3) of Directive 2008/95, the judgment in Colloseum Holding, C-12/12, EU:C:2013:253, paragraph 27).*
>
> *65 Therefore, regardless of whether the sign is used as part of a registered trade mark or in conjunction with the registered trade mark,* ***the fundamental condition is that, as a consequence of that use, the sign for which registration as a trade mark is sought may serve to identify, in the minds of the relevant class of persons, the goods to which it relates as originating from a particular undertaking*** *(see, to that effect, judgment in Colloseum Holding, C-12/12, EU:C:2013:253, paragraph 28).*
>
> *66 It must therefore be concluded, as indicated in points 48 to 52 of the Advocate General's Opinion, that although the trade mark for which registration is sought may have been used as part of a registered trade mark or in conjunction with such a mark, the fact remains that, for the purposes of the registration of the mark itself, the trade mark applicant* ***must prove that that mark alone, as opposed to any other trade mark which may also be present, identifies the particular undertaking from which the goods originate.***

Markedsføringen og omsetningen det er vist til av søker gjelder produktet Seretide. At Pantone 2587C er benyttet, til og med deskriptivt, i forbindelse med dette produktet, betyr ikke at denne markedsføringen og omsetning automatisk kan legges til grunn som dokumentasjon på innarbeidelse av fargen som sådan som kjennetegn.

Det er ikke fremlagt noe som helst dokumentasjon på at omsetningskretsen, inkludert pasienter, jfr. «the entire relevant public», oppfatter den søkte fargen som en indikasjon på kommersiell opprinnelse.

Ellers viser søker i siste besvarelse, i forbindelse med fargebruk og påstått innarbeidelse, bl.a. til udokumenterte sitater vedrørende situasjonen i andre jurisdiksjoner. Dette kan selvfølgelig ikke tillegges noe som helst vekt.

Som supplement til tidligere inngitt dokumentasjon på at farger benyttes og oppfattes deskriptivt kan det også vises til ovennevnte avgjørelse fra BoA R 2108/2015-4. Selv om denne saken ikke dreide seg om farger, kommenterer BoA i avsnitt 33 at fargen på GSKs inhalatorer identifiserer virkestoffet:

> *33 Every product sold by the opponent is marketed with a separate name of the medicine, verbal trade marks and colours. Consumers look first for a word mark and* ***colours, which identifies the active substance*** *and only finally at a shape.*

Også EUIPO i de tre ovennevnte slettelsessakene la til grunn at farger, herunder lilla, ikke vil oppfattes som et kjennetegn. Til tross for at EUIPO kommenterte at det i saken ikke var lagt frem tilstrekkelig bevis for at farger oppfattes deskriptivt (dokumentasjonen fremlagt av Cipla for dette var betydelig mindre omfattende enn dokumentasjonen fremlagt av Sandoz), vil det forhold at omsetningskretsen er vant til å se farger benyttet på inhalatorer i seg selv være nok til at de ikke oppfatter søkers lilla som et kjennetegn.

EUIPO oppsummerer, nederst på side 24 i avgjørelsene, som følger:

> «*The evidence filed by the parties shows that the purple colour combination of the inhaler shape was perceived by the relevant public merely as a common and customary element of the product and not as a badge of their origin*".

5. Avslutning

På bakgrunn av det ovennevnte, samt tidligere inngitt protest, skal det opprettholdes at det søkte merket mangler særpreg og dermed ikke oppfyller varemerkelovens registreringsvilkår. Patentstyrets avgjørelse om å nekte merket til registrering bes derfor fastholdt.

Med vennlig hilsen
Onsagers AS

Thomas Gaarder-Olsen

DECISION
of the Fourth Board of Appeal
of 31 August 2016

In Case R 2108/2015-4

CELON PHARMA Spółka Akcyjna (S.A.)
Kiełpin, Ogrodowa 2a
PL-05-092 Łomianki
Poland

EUTMR Proprietor / Appellant

represented by Katarzyna Izabela Kręźlewicz, Al. Solidarności 147 lok. nr 3, PL-00-898 Warszawa, Poland

v

GLAXO GROUP LIMITED
980 Great West Road
Brentford, Middlesex TW8 9GS
United Kingdom

Cancellation Applicant / Respondent

represented by SIMMONS & SIMMONS LLP, CityPoint One Ropemaker Street, London EC2Y 9SS, United Kingdom

APPEAL relating to Cancellation Proceedings No C 7 805 (European Union trade mark registration No 9 849 191)

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairman and Rapporteur), C. Bartos (Member) and S. Martin (Member)

Registrar: H. Dijkema

gives the following

Language of the case: English

Decision

Summary of the facts

1 CELON PHARMA Spółka Akcyjna (S.A.) ('the EUTM proprietor') obtained registration of the European Union trade mark No 9 849 191 for the figurative mark

filed on 29.3.2011 and registered on 5.10.2011 for the goods:

Class 5 – Inhalation products used for the treatment of asthma and chronic obstructive pulmonary disease.

Class 10 – Inhalers.

2 The EUTM proprietor claimed the following colours:

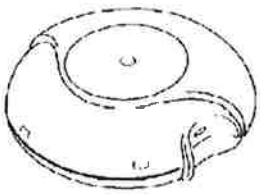
Light brown / coffee, white.

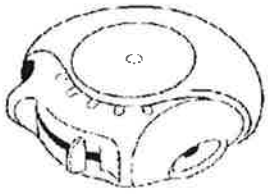
3 On 4.4.2013, Glaxo Group Limited ('cancellation applicant') filed a request for a declaration of invalidity of the registered mark for all the above goods.

4 The grounds of the request for a declaration of invalidity were those laid down in Article 53(1)(a) EUTMR in conjunction with Articles 8(1)(b) and 8(5) EUTMR.

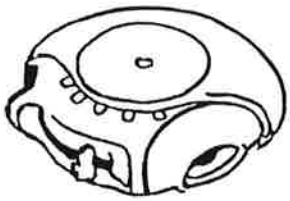
5 The invalidity request was based on, *inter alia,* the following earlier rights:

– French trade mark No 97 685 112

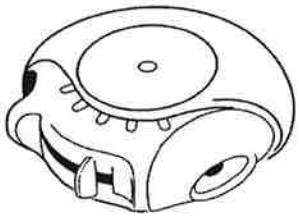




– Hungarian trade mark No 173 643



– Slovenian trade mark No 9771103



And others with identical or highly similar representations:

– Austrian trade mark No 178 683;
– Bulgarian trade mark No 34 831;
– Romanian trade mark No 33 179;
– Danish trade mark No 199 802 449;
– Estonian trade mark No 27 384;
– Irish trade mark No 214 999;
– Latvian trade mark No M 41 677;
– Lithuanian trade mark No 34 318;
– Portuguese trade mark No 324 890;
– Swedish trade mark No 379 293;
– German trade mark No 39 729 905;
– Greek trade mark No 133 673;
– Benelux trade mark No 623 462;
– Bulgarian trade mark No 34 830;
– Finnish trade mark No 213 088;
– Italian trade mark No 1 272 775;
– Hungarian trade mark No 173 642;

all registered for goods in Class 10, namely 'inhalers' and in some cases also for 'medical and surgical apparatus and instruments'..

5 By decision of 7.9.2015 ('the contested decision'), the Cancellation Division upheld the request for a declaration of invalidity for all the contested goods.

6 At the request of the EUTM proprietor, and in reply to the respective invitation by the Office, the cancellation applicant furnished proof of use of all its earlier trade marks. The Cancellation Division examined the evidence in relation to the earlier French trade mark No 97 685 112. It held that the evidence showed that the mark was used for one type of product only, namely inhalers, and that those goods should be compared with the contested goods.

7 The Cancellation Division found the contested goods in Class 5 to be similar and the contested goods in Class 10 to be identical to the opponent's goods 'inhalers'.

8 It held that taking into account the visual and conceptual coincidences the signs were similar. Relying solely on the earlier French trade mark No 97 685 112 the Cancellation Division concluded that in view of the similarity and identity of the goods and similarity of the marks there was a likelihood of confusion on the part of the public for all the contested goods, and declared the contested EUTM invalid in its entirety.

Submissions and arguments of the parties

9 On 20.10.2015, the EUTM proprietor filed an appeal against the contested decision followed by a statement of grounds on 7.1.2016. It argued that the Cancellation Division incorrectly assessed in the contested decision what are the distinctive and dominant components of the signs and the consumer's level of attention. It further argued that the earlier trade mark is weakly distinctive and that the shape of the inhaler has a technical function and therefore the earlier trade mark(s) should be considered invalid.

10 The cancellation applicant reiterated its arguments presented before the Cancellation Division and endorsed the contested decision.

Reasons

11 The appeal is well founded.

Preliminary remarks

12 The EUTM proprietor argued that the cancellation applicant had a patent protection for the shape of the inhaler and that now that the protection period expired, it can no longer enjoy a monopoly protection for the shape of its inhaler. The EUTM proprietor claims that the shape of the earlier marks is purely functional and the aesthetic features are simply the result of good design considerations.

13 The Board cannot take into account the EUTM proprietor's arguments concerning a technical function of the earlier marks and their possible invalidity, even if this particular shape allows better diffusion of the medicine.

14 As correctly pointed out by the cancellation applicant the validity of an international or national trade mark may not be called into question in proceeding for registration of a EUTM, but only in cancellation proceedings brought in the Member State concerned (17.02.2011, T-10/09, 'F1-Live', EU:T:2011:45, § 47 and the case-law cited).

On proof of use

15 According to Article 57(2) and (3) EUTMR, if the EUTM proprietor so requests, the cancellation applicant must submit proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier trade mark has been genuinely used in the territories in which it is protected and for the goods or services for which it is registered and which it cites as justification for its application, or that there are proper reasons for non-use. If, at the date on which the contested EUTM application was published, the earlier mark had been registered for not less than five years, the applicant must submit proof that, in addition, the conditions contained in Article 42(2) EUTMR were satisfied at that date.

16 According to the same provision, in the absence of such proof the application for a declaration of invalidity will be rejected.

17 The EUTM proprietor requested the applicant to submit proof of use for all the trade marks on which the application is based.

Earlier French mark

18 The Board will begin the examination of the application (and of the proof of use) in relation to earlier French trade mark No 97 685 112, as all the earlier marks have almost the same graphical representation and the conclusions will apply accordingly.

19 The request for proof of use is admissible given that the earlier trade mark was registered on 1.7.1997, that is more than five years prior to the date of the application for a declaration of invalidity.

20 The application for a declaration of invalidity was filed on 5.4.2013. The application for the contested EUTM was published on 28.6.2011. Since the earlier mark was registered on 1.7.1997, Article 57(2), 1st and 2nd sentence, EUTMR applies (so-called double proof of use) and the applicant was required to prove that the trade mark on which the application is based was genuinely used in France within the five years preceding the date of the application for declaration of invalidity as well as within the five years preceding the date of publication of the contested EUTM, that is, from 5.4.2008 to 4.4.2013 as well as from 28.6.2006 to 27.6.2011.

21 Furthermore, the evidence must show use of the trade mark for the goods on which the earlier French mark is registered, namely:

Class 10 – Medical and surgical apparatus and instruments, inhalers.

22 According to Rule 40(6) in conjunction with Rule 22(3) IR, the evidence of use must indicate the place, time, extent and nature of use of the earlier mark for the goods and services for which it is registered and on which the application is based.

23 The applicant submitted extensive evidence of use. The evidence submitted to show the reputation of the earlier mark will also be taken into account as evidence of use. The evidence consisted, *inter alia*, of the following:

- Witness statement of Joanne Beth Green, vice-president of Pharma Trade Marks at GlaxoSmithKline group of companies. It explains that the disc shaped inhaler (also called 'DISKUS') is used to sell various brands of respiratory medicaments. A large number of the inhalers were sold worldwide, in 2010, the billionth inhaler was produced. Medicaments sold in DISKUS devices were first sold in France in 1997 and around 6 million of the inhalers were sold each year from 2008 to 2012 in France. The market share of the products sold in the DISKUS inhaler on the market of anti-asthma and COPD products in France was over 20 % each year from 2008 to 2012.
- A list of various national and international awards for design or technology for the DISKUS device, mostly UK or US awards, also, allegedly present in the Paris Pharmapack exhibition in 2011.
- Copies of packaging of pharmaceutical products in the DISKUS inhalator with text in French and expiry date in 2014.
- Advertising material in the shape of the DISKUS device in French explaining the use of the DISKUS inhalator.
- Brochures for various medical products including the DISKUS inhalators in French dated January 2013.
- A consumer survey carried out by GfK in November/December 2013 showing that consumers (general practitioners and patients with respiratory disease) in France, when presented the earlier trade mark ('naked' shape of the inhaler), recognize that it is a product of the applicant (89 % of doctors and 43 % of patients).

24 The shape of a product is one of the types of signs that can be registered as a European Union trade mark. According to Article 4 EUTMR a European Union trade mark may consist of any signs capable of being represented graphically, such as, inter alia, the shape of goods and their packaging, provided that such signs are capable of distinguishing products or services of one to distinguish the company from those of other undertakings (14.9.2010, C-48/09 P, 'Lego brick', EU:C:2010:516, § 39). However, the distinctiveness of such a mark has to be judged with respect to the perception of the relevant public. That perception of the relevant public is not necessarily the same in relation to such a mark as it would be in relation to a word or figurative mark not representing the appearance of the product. Whilst the public is used to recognising the latter marks instantly as signs identifying the product, this is not necessarily so where the sign is indistinguishable from the appearance of the product itself or its packaging (19.9.2001, T-30/00, 'Tabs', § 49; 7.10.2004, C–136/02 P, 'Torches', EU:C:2004:592, § 30).

25 It must be noted that all the representations of the earlier marks, including the French mark, are simple, black and white drawings/sketches, which portray only the general outline of the product and its basic features. Only this representation can be taken into account when assessing whether the mark was used as regis-

tered. The mark as registered is limited to the sketchy representation of contours of an inhaler.

26 Pursuant to Article 15(1)(a) EUTMR, the mark must be used either as registered or in a form not altering its distinctive character. It must be examined whether the used form 'alters' the distinctive character when compared with the form as registered, and this with regard to the overall impression the used form conveys. The less distinctive the mark as registered is and the more basic its representation is, the easier the used form can be the subject of wide modification and the more likely it is that such modifications are substantial.

27 Moreover, the mark must be used for the goods for which it is registered, and not for goods which are similar or complementary to the registered goods.

28 The proof of use submitted is insufficient a) as none of the used forms is an acceptable form of use under Article 15(1)(a) EUTMR, and b) there was no use for the goods 'inhalers' as such.

Form of use

29 The cancellation applicant claimed in its submissions of 4.1.2013 that all its inhalers have basic common features:

- A central circle, which is concentric with the main discs;
- An outer disc which is roughly semi-circular, with a wave that encompasses the central circle;
- Five short radial prongs emanating from the central circle;
- A concave elliptical mouthpiece;
- A convex elliptical section surrounding the mouthpiece;
- A slider that moves along a portion of the outer circumference of the disc;
- A thumb grip behind and in line with the slider.

30 The cancellation applicant stated repeatedly in its submissions and submitted exhausting evidence showing that it sells many respiratory medicaments, including SERETIDE, SEREVENT, FLIXOTIDE and VENTOLIN **in** colourful 'DISKUS' inhalers also known as 'ACCUHALER' and in its opinion this proves use of the cancellation applicant's registrations black and white registrations.

31 The cancellation applicant admits that each of various orally inhaled products (VENTOLIN, SERETIDE, SEREVENT and FLIXOTIDE) is offered in a differently coloured DISKUS inhaler with the name of the orally inhaled medicine on the outside.

FLIXOTIDE

SEREVENT

SERETIDE

VENTOLIN

32 It is clear that in this case there are significant differences between the representation of the mark as registrated and the inhalers appearing in the evidence submitted by the cancellation applicant. The marks registered are simple black and white sketches, drawings. What is clear from the evidence submitted by the cancellation applicant and applicable to all the different forms of use and all the countries is that really important distinctive elements are:

- The colours (two shades of blue, green, violet and orange) and colour contrast with the white circle inside (absent in the registrations);
- Colours and combinations of colours possess distinctive character in itself and are one of the main contributors to the overall distinctiveness of the mark;

- Name of the medicine inside the inhaler (SEREVENT, SERETIDE, VENTOLIN, FLIXOTIDE) and a word mark 'DISKUS';
- Grooves under the circle, resembling a wave.

33 Every product sold by the opponent is marketed with a separate name of the medicine, verbal trade marks and colours. Consumers look first for a word mark and colours, which identifies the active substance and only finally at a shape. Therefore, the shape of the inhaler is not a main differentiating factor.

34 Inhalers sold by the cancellation applicant have a colour contrast, characteristic wave, a word mark with the name of the medicine plus the word mark 'DISKUS', which is not visible in the earlier trade mark as registered. The name of the medicine and even the word 'DISKUS', although describing the basic feature of the shape, is more distinctive than the shape of the inhaler itself.

35 Moreover it is very difficult to compare the shape of the inhaler as registered in detail with the product shapes appearing in the evidence of use. The earlier French mark apparently shows one and the same inhaler in two different perspectives or views. It is very difficult to ascertain whether the various three-dimensional features shown in that representation are present in the products appearing in the evidence. A consumer generally does not tend to focus his attention to small details of a three-dimensional object. The central part of the inhaler as shown in the evidence is always covered by what could be a sticker or a separate element in a contrasting colour, on which a word appears. The cancellation applicant's arguments are essentially based on the reasoning that the earlier mark protects any inhaler as long as it is disk-shaped. Such a broad protection a trade mark does not offer.

36 To conclude, the features of the used form, in particular the use of striking and partly contrasting colours, as well as the presence of distinctive verbal elements, alter the distinctive character of the mark seen as a whole. This is not cast into doubt by the fact that the used form appears in many variations of colours or with different word elements. This is just so because the respective products are marketed with different medicinal substances inside under different names and then each time in different colours. This only corroborates that none of the used forms can be equated to the form as registered.

Use for the registered goods

37 Moreover, it is also clear from the cancellation applicant's submissions and evidence that the inhaler contains a medicinal substance (against asthma) but is not sold separately and there is no possibility to refill/reuse the DISKUS inhaler. The cancellation applicant explained in detail and also submitted, *inter alia,* an article from 'Pulse', dated August 1999, in which it is stated that 'an integral dose counter displays the number of doses left in the device, with the last five doses appearing in red to remind the patient that the inhaler needs to be changed'.

38 The DISKUS Inhaler alone is not available for sale and it is only and always sold together with the medicine i.e. it is not reusable.

39 Therefore, the opponent did not prove use of its earlier trade marks for inhalers but only for the respective medicines which are not covered by its earlier registrations.

40 The DISKUS inhaler is just a transport medium like ampules, syringes or bottles – a type of packaging. The cancellation applicant submitted as evidence (Exhibit 21) list of awards for the DISKUS/ACCUHALER and they include awards from the German Packaging Institute for 'the most innovative packaging and for packaging-related solutions of the year', and the DuPont Award for Packaging Innovations 2005 and Packaging Award (Sweden).

41 The goods in Class 10 must be distinguished from medicinal substances, namely substances to treat diseases or health problems, such as asthma, which fall into Class 5. An 'inhaler' falling into Class 10 is a good which can be bought separately, independently from the active ingredient, and which can be reused, e.g. refilled. The opponent has proven use for the active substances but none of its earlier trade marks are registered in Class 5. The cancellation applicant does not sell the inhaler separately, without the medicine and therefore the mark is not used for the goods for which it is registered.

42 A fortiori the use shown does not cover any of the other goods in Class 10, such as 'medical and surgical devices'.

The other earlier marks

43 As the remaining earlier trade marks invoked by the cancellation applicant have the same or highly similar representations, all being sketchy black and white representations, and cover the same goods in Class 10 as discussed above, it must be concluded that the cancellation applicant did not prove the use of those earlier marks, for the same reasons. None of the evidence relating to Member States other than France shows evidence of use of the mark in the form in which it is registered, or for the goods for which it was registered.

44 It follows that the cancellation applicant has not proven the use of any of its earlier marks. Pursuant to Article 57(2), 3rd sentence, EUTMR, in the absence of such proof the application for invalidity has to be rejected. The contested decision shall be overturned and the appeal allowed.

Costs

45 The cancellation applicant (respondent) is the losing party in the cancellation and appeal procedures and it shall be ordered to bear the costs of the EUTM proprietor (appellant) pursuant to Article 85(1) EUTMR.

Fixing of Costs

46 Pursuant to Article 85(6) EUTMR in conjunction with Rule 94(3) IR, the decision of the Board shall, where applicable, include the fixing of the amount of the costs to be paid by the losing party. The representation costs for the appeal proceedings are fixed, pursuant to Rule 94(7)(d)(v) IR at the standard rate of EUR 550. The representation costs of the cancellation proceedings are fixed at EUR 450. The appeal fee of EUR 800 is also to be reimbursed as provided in Rule 94(6) IR. The total amount is EUR 1,800.

Order

On those grounds,

THE BOARD

hereby:

1. **Annuls the contested decision;**
2. **Rejects the application for a declaration of invalidity of the Community trade mark No 9 849 191;**
3. **Orders the respondent to bear the costs of the appellant in the invalidity and the appeal proceedings;**
4. **Fixes the amount to be paid by the respondent to the appellant with respect to the invalidity and appeal proceedings at EUR 1,800.**

Signed	Signed	Signed
D. Schennen	C. Bartos	S. Martin

Registrar:

Signed

H.Dijkema

2

EUIPO
EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE

OPERATIONS DEPARTMENT
Cancellation Division
C406A

Alicante, 16/09/2016

PONS PATENTES Y MARCAS
INTERNACIONAL, S.L.
Glorieta de Rubén Darío, 4
E-28010 Madrid
ESPAÑA

Notification of a decision to the applicant

Your reference:	**7361**
Invalidity number:	**000010180 C**
Contested trade mark:	**002179562**
	(3D)

Please find attached the decision terminating the proceedings referred to above. The decision was delivered on **16/09/2016.**

Please note that decisions of the Cancellation Division are not signed by the responsible officials but only indicate their full name and bear a printed seal of the Office in accordance with Rule 55(1) EUTMIR.

Karin KUHL

Enclosures (excluding the cover letter): 31 pages

EUIPO
EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE

CANCELLATION DIVISION

CANCELLATION No 10 180 C (INVALIDITY)

Cipla Europe NV, Uitbreidingstraat 84, 2600 Antwerp (Berchem), Belgium (applicant), represented by **Pons Patentes y Marcas International, S.L.,** Glorieta de Rubén Darío 4, 28010 Madrid, Spain (professional representative)

a g a i n s t

Glaxo Group Limited, 980 Great West Road, TW8 9GS Brentford, Middlesex, United Kingdom (EUTM proprietor), represented by **Stephenson Harwood LLP**, 1 Finsbury Circus, EC2M 7SH London, United Kingdom (employee representative).

On 16/09/2016, the Cancellation Division takes the following

DECISION

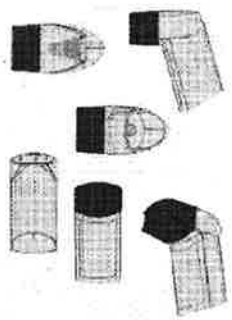
1. The application for a declaration of invalidity is upheld.

2. European Union trade mark No 2 179 562 is declared invalid in its entirety.

3. The EUTM proprietor bears the costs, fixed at EUR 1 150.

REASONS

On 16/12/2014, the applicant filed an application for a declaration of invalidity against European Union trade mark No 2 179 562 ('the contested EUTM'), filed on 12/04/2001 and registered on 09/11/2005, for the 3D mark hereunder:



The request is directed against all the goods ('the contested goods') covered by the contested EUTM, namely:

Class 5: *Pharmaceutical preparations and substances for the prevention, treatment and/or alleviation of respiratory ailments.*

Class 10: *Inhalers, parts and components for all the aforesaid goods.*

The applicant invoked Article 52(1)(a) EUTMR in conjunction with Articles 7(1)(a), 7(1)(b), 7(1)(c), 7(1)(d) and 7(1)(e)(ii) EUTMR.

The Cancellation Division will first examine the applicant's request pursuant to Article 52(1)(a) EUTMR in conjunction with Article 7(1)(b) EUTMR.

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant's first submissions

The applicant argues as follows:

- The contested mark lacks distinctive character as it consists of nothing more than the representation of a standard inhaler in purple. Therefore, the EUTM is devoid of distinctive character.

- On 22/12/2003 the Office already rejected the EUTM application due to the lack of distinctiveness pursuant to Article 7(1)(b) EUTMR.

- The elements of the trademark are non-distinctive, as they are used by many companies in the market. The EUTM does not feature any characteristics that differ from the typical design for inhalers.

- Inhalers are commonly used for this pathology and the EUTM has not special characteristics that could distinguish from the other inhalers in the market.

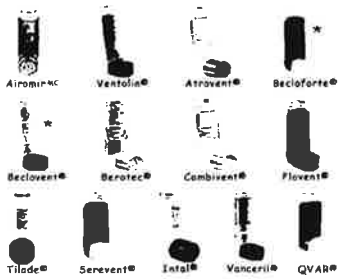
- Moreover, the inclusion of the colours still does very little to create in the mind of the consumer an impression of trade origin. As held by the Court and the Board of Appeal, purple and lilac colours are among the simplest and most common colours (irrespective of product).

- Bearing in mind that the average consumer of inhalers is accustomed to seeing inhalers in different colours, the average consumer cannot perceive the colour of an inhaler as an indicator of commercial origin. The trade mark as a whole must be considered to be non-distinctive.

- In addition, colours are a functional feature of inhalers in view of a colour-code system linking a colour to a medical therapy. In fact, inhalers are only distinguished by their brand.

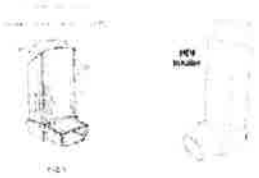
The applicant provided the evidence either within or attached to its observations. Since the documents were not numbered by the applicant, for practical reason they will be listed as follow:

- Doc. 1: Images of the following inhalers from third parties:



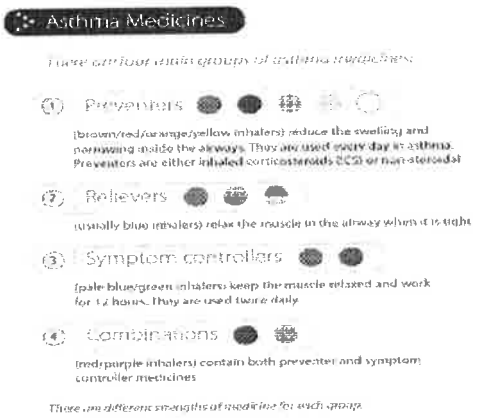
- Doc. 2: An extract from Wikipedia providing a definition of 'inhaler', namely "*a medical device used for delivering medication into the body via the lungs*".

- Doc. 3: Images depicting generic 'MDI inhalers' as follows:



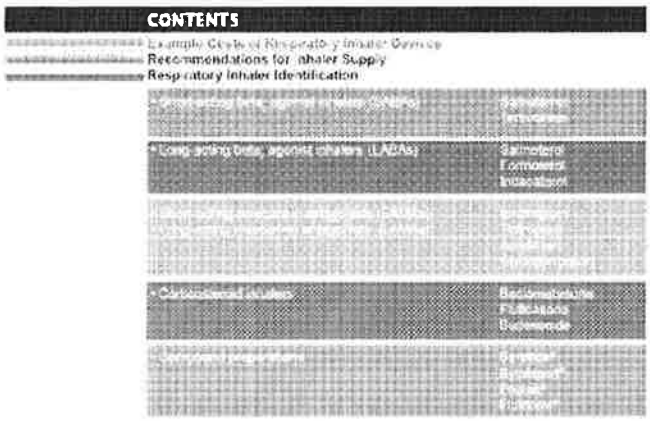
- Doc. 4: Extracts providing a technical description of 'standard MDI inhalers' and an explanation regarding 'How to use a metered dose inhaler'.

- Doc. 5: A table extracted from the website http://asthmafoundation.org.nz/ in which the four main groups of asthma medicines (preventers, relievers, symptom controllers and combinations) are associated with different colours:



- Doc. 6: An extract from http://asmasevera.blogspot.se/2014/03/usas-inhaladores-de-diferentes-colores.html providing the following table 'Asthma Drug Therapy':

- Doc. 7: Printout from "The Greater Glasgow and Clyde Therapeutics Committee" showing the following table:



- Doc. 9: A table from the Spanish 'Grupo Educación y Salud en Asma' and from the website http://personal.us.es/mpraena/poster-inhaladores.html showing that active ingredients are categorized by colours as follows:

	Salbutamol
	Terbutalina
	Formoterol
	Salmeterol
	Beclometasona
	Budesonida
	Fluticasona
	Budesonida + formoterol
	Fluticasona + salmeterol
	Nedocromil

- Doc. 9: Copy of the article entitled "Asthma inhalers and colour: universal dots" published on the British Journal of General Practice on 01/09/2010 stating that:

> *"The importance of colour-coded asthma treatment in patient education is well accepted. Traditionally, reliever medication inhalers are blue in colour and preventer inhalers brown. This custom is not always followed and the inconsistencies in the colour of inhalers create a lot of confusion.*
>
> *Marketing of the same medication in different colour inhalers and introduction of new drugs and combinations contributed to this predicament. The confusion created by the introduction of generic salbutamol in UK in orange-coloured inhalers has been previously discussed. Salbutamol in some countries comes in white inhalers with a blue cap. The colour coding of caps is never reliable as patients can easily change these stoppers.*
>
> *Across the world, inhaled corticosteroids (ICS) are available as brown, white, magenta, blue, orange brown, and red inhalers. Long-acting beta-agonists (LABA) are now marketed in green, blue, white, and greenish blue containers. The new hydrofluoroalkane propellant-based salbutamol is marketed in red or yellow jackets. Interestingly, their advertisement in a journal asks patients to reach for the 'red' in case of need. Inhaled steroids*

and LABA combinations were introduced in violet, red, and brown inhalers. So at any point of time a patient can be exposed to a collection of coloured inhalers with total uncertainty of its contents. [...]

[...] Partridge narrates his unsuccessful efforts to get responsible bodies interested in the problems created by the introduction of a generic salbutamol inhaler. He is not alone in raising the same concerns. Nevertheless, we hope to revive discussion around the convenience of having uniform colours for inhalers. We call upon all manufacturers to consider this concept and adopt the suggested colours for each class of medications".

The article makes references to the following scientific publications (see also Annex 39):

1. Horn CR, Cochrane GM. Colour coding for bronchodilator inhalers. Lancet. 1986;1(8473):165. [PubMed]
2. Minerva BMJ. 1992;305(6853):594.
3. Maxwell D. Distinguishing inhalers to aid blind people. BMJ. 1992;305(6863):1226. [PMC free article] [PubMed]
4. Partridge M. Coloured inhalers. BMJ. 1992;305(6858):890. [PMC free article] [PubMed]
5. Jones KP. Guidelines on the management of asthma. Thorax. 1993;48(10):1050. [PMC free article] [PubMed]

The EUTM proprietor's response

The EUTM proprietor argues as follows:

- The Cancellation Division shall examine the facts in accordance with Article 76(1) EUTMR within the scope of factual submissions made by the applicant (13/09/2013, T 320/10, Castel, EU:T:2013:424, § 28). The onus is therefore on the applicant to prove its claims.

- The applicant has provided very little evidence in support of its claims, the majority of which originates from outside of the EU or is dated over 10 years after the date of application. Additionally, various exhibits have not been translated into the language of these proceedings – namely English – whereas other exhibits are incomplete.

- During the examination proceedings of the EUTM application, in the letter of 29/03/2005 the EUTM Proprietor pointed out that the distinctive element of the EUTM is the specific colour combination as applied to the non-distinctive inhaler shape. The reason why the EUTM proprietor applied for a 3D mark, and not for a colour per se mark, is that the scope of protection is limited to the use of such distinctive colours combination on such specific shape of an inhaler.

- In order to constitute a trade mark, colour combination marks must be capable of distinguishing the goods or services of one undertaking from those of other undertakings (06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 23; and 24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384, § 22). In this case, the fact that a particular colour combination is applied to a specific shape renders the mark distinctive.

  On the goods in question

- The specification of goods covered by the EUTM is narrowly defined. The graphic representation further narrows the mark to two specific colours applied to the specific shape of a metered dose inhaler (MDI).

- Patients cannot choose the colour of their inhaler. These goods are not purchased "off the shelf". Inhalers are sold only under prescription; therefore a patient cannot purchase an inhaler without the involvement of a professional.

- Inhalers require regulatory approval in order to be put on the EU market. However, there is no legal or regulatory restriction in the choice of a colour and pharmaceutical companies are free to use whatever colour they like for their inhalers.

- The regulators will not only approve the pharmaceutical but also the inhaler and product packaging as part of this process. This means that when the getup and colour scheme chosen by a pharmaceutical company for a specific inhaler are finally approved, they cannot be changed. For example, 'Seretide' is and will always be purple as approved by the regulators. Likewise, 'Symbicort', a competing product, is and will always be white and red.

On the relevant public

- Inhalers are 'prescription only' products, which require regulatory approval before they can be put on the EU market for sale.

- Although both healthcare professionals and patients form part of the relevant public it does not mean that both classes of consumers should be given equal weight when considering distinctiveness under Article 7(1)(b) EUTMR. When assessing the distinctive character of the EUTM, it is primarily and essentially the perspective of the average doctor which must be taken into account and given the most weight, without prejudice to the supplementary role that the patients and pharmacists (depending on the substitution regime in each Member State), which constitutes a more limited part of the relevant public, may play in this context.

On the EUTM inherent distinctiveness

- The Office has already carried out this assessment as part of the examination proceedings and correctly concluded that the EUTM was inherently distinctive at the time of the filing date.

- The inhaler market was considerably smaller back in 2001 compared to today. The majority of the inhalers indicated in the applicant's submissions were not available on the EU market at the filing date and therefore cannot form part of the assessment. In addition, at that time there were only 15 Member States of the European Union: Austria, Belgium, Denmark, Finland, France, Germany, Greece, Ireland, Italy, Luxembourg, Netherlands, Portugal, Spain, Sweden and the United Kingdom. The EUTM proprietor only needs to prove distinctiveness of the mark in these Member States.

- At the filing date, the colour combination applied for was highly distinctive, striking and unusual for inhalers. That remains the case today. The purple combination was specifically chosen as a unique identifier of the 'Seretide' inhaler. The colour purple has not been used by any other competitor.

- The choice of purple by the EUTM proprietor was completely arbitrary. There was no legal or regulatory reason why purple was chosen. Purple was not commonplace for

inhalers neither was purple the natural colour for inhalers. At the filing date, third parties inhalers were typically blue, brown or white.

- Patients tend not to remember the brand names of their inhaler medication but instead rely on more visual identifiers such as a colour. The colour combination of the EUTM is highly unusual and striking and will stand out especially as the majority of the other inhalers on the market use white as the predominant colour.

On the acquired distinctiveness

- The EUTM proprietor has sold a two-tone purple coloured inhaler under the brand name 'Seretide' in the EU since 1998. 'Seretide' (sold in Germany as 'Viani' or 'Atmadisc', Hungary as 'Thoreus', Italy as 'Aliflus' and North American countries as 'Advair') contains *salmeterol xinafoate* combined with *fluticasone propionate*.

- The EUTM proprietor sells 'Seretide' in two different inhalers, a dry powder inhaler known as 'DISKUS', which is in the shape of a flat 3D sphere, and a metered dose inhaler (MDI) known as 'EVOHALER' which is in the more traditional 'boot' shaped aerosol inhaler:

- The 'Seretide Evohaler' (25/50 strength) is the subject of the EUTM 2 179 562, the darker shade of purple is Pantone code 2617C and the lighter shade of purple is Pantone Shade 2645C.

- The EUTM proprietors' inhalers were launched in each of the relevant Member States between 2000 and 2003. Seretide has been ranked in the top 5 pharmaceuticals by global sales each year for the last 5 years. In 2004, it was ranked the 7th best-selling pharmaceutical product globally. It is the fourth best-selling pharmaceutical product of all time. Each Evohaler products is a 'blockbuster' since each of them has made sales of over USD 1 billion globally.

- Over the last 10 years, Seretide has maintained a European market share for metered dose inhalers (MDIs) of approximately 34%. This is a basic market analysis based on current publicly available data.

- The EUTM proprietor has extensively used the purple colour combination on MDIs in its marketing material since launch. It has also used images of Evohalers in its marketing throughout the European Union. Such advertising includes educational material for general practitioners (GPs) and specialist doctors. GPs are also encouraged to give these materials to patients when they are prescribed a 'Seretide' inhaler.

- The EUTM proprietor has spent at least GBP 25 million a year in Europe on advertising and promotion of its Seretide inhalers from 2000 to 2009 and at least GBP 7.5 million a year in Europe on advertising and promotion from 2010 until today.

- As at the date of filing of the invalidity application, only two other purple inhalers were sold in the European Union: 'Airflusal Forspiro' and a product market by the applicant itself. 'Airflusal Forspiro', which was launched in Europe in January 2014, is the subject of litigation currently on going in the European Union. The applicant's product is the subject of litigation currently on-going in Sweden. The Swedish court has granted the EUTM proprietor an injunction which prevents the applicant from selling this inhaler in Sweden. It therefore is not currently available on the market.

- In April 2005, TNS Healthcare - a division of Taylor Nelson Sofres Plc, a company specialised in the pharmaceutical and medical market sector - conducted a survey in relation to the purple colour combination. It retained a panel of approximately 1 600 UK GPs which it believes is a representative sample (in terms of region of practice, age, gender and level of qualification) of GPs in the UK. From this panel approximately 500 GPs are selected at random to receive the survey. The aim of the survey in question was to ascertain (i) the level of recognition of the purple colour combination amongst GPs; and (ii) whether the purple colour combination acts as a trade mark.

- Following the commencement of the cancellation action, the EUTM proprietor immediately contacted market research specialists Pfluger Rechtsforschung who conducted 14 surveys in seven of the 15 relevant Member States to ascertain whether the EUTM was distinctive. The surveys were conducted face to face and the respondents (both GPs and pharmacists) were shown an image of the trade mark in question in the relevant purple colours. The results show an enhanced degree of distinctiveness of the mark.

On Article 7(1)(c) EUTMR

- The colour purple cannot denote a class or type of inhaler since it does not correspond to any field of application, active ingredients or strength of the product. Indeed, if that was the scenario, every single inhaler product would have to be in a different colour.

- Inhalers cannot be sold in Europe until they are approved by the European Medicines Authority (EMA) or the national regulators. If there was any sort of colour code the EMA would need to enforce it. However, the EMA has specifically confirmed that there is no colour code for inhalers and companies are free to choose whatever colour they want for their inhalers.

- It is undisputed that pharmaceutical companies are free to use whichever colour they wish for their inhaler products. The choice of colour is completely arbitrary.

- In 2014 the Regional Court of Cologne ruled that:

> *"[...] it has been credibly established that there is no generally binding colour code that determines that such combination preparations need to be purple. A look at competing products already shows this. All that can be taken from the respondents' submission is that some companies market their different medicaments in different colour designs for different applications in order to distinguish them more easily [...]*
>
> *[...] The colour lilac enjoys an island position in the market environment of asthma medicaments. It is unusual and memorable. The Applicant uses the colour lilac not only for the product, the product packaging and the patient information, but also for all promotional measures. Due to the*

considerable promotion expenses, the long market presence, the market share and the achieved sales, it is established that the addressed relevant public (doctors, pharmacists, asthma patients) understand the colour lilac as an indication for a specific manufacturer in the area here discussed […]".

- In a recent decision, the court of Hamburg also confirmed that there is no colour code for inhalers.

- The EUTM Proprietor has conducted multiple surveys in relation to the single purple shade pantone 2587C showing that the purple colour is distinctive of the EUTM proprietor's inhalers.

- The applicant argues that 'combination inhalers' are colour coded purple or pink. However, when the EUTM application was filed, the following 'combination inhalers' were available in Europe:

Red and White

Purple

- Symbicort (the second most successful combination product after Seretide) is red and white. This colour, according to the applicant, should be reserved for 'preventers'. Accordingly, at the filing date, there was no colour code for combination products and the pink product (Foster) referred to by the applicant was not available.

- The combination inhaler market in Europe today clearly shows that combination products are available in orange, pink, red, yellow, blue and purple. Other than Seretide, these products use white/grey as the prominent colour (with the other colour being complementary). Some combination products are red, orange or blue.

- Contrary to the applicant's arguments, colour does not denote any active ingredient. Specifically, purple does not denote the specific combination of Salmeterol and Fluticasone Propionate present in 'Seretide'.

In support of its observations, the EUTM proprietor filed the following evidence:

- **Annex 1**: Copy of the article 'European Medicines Agency to approach GSK after respiratory pharmacists raise concerns about 'Relvar Ellipta' published on the website www.pjonline.com, stating, *inter alia*, as follows:

  "[…] The respiratory pharmacists also point out in their letter that reliever inhalers are traditionally blue and preventer inhalers brown, red or purple. They argue that the blue colour of the inhaler and the name Relvar might confuse patients into thinking it was a reliever inhaler and not a once-daily maintenance inhaler.

  The EMA told The Journal that there is no EU-wide convention on colour coding for inhalers. However, it added: "The EMA will approach the marketing-authorisation holder to flag this issue raised in the UK and will closely follow

up the matter with the company. The medicines regulator also told The Journal that if safety concerns were reported, for example medication errors, it would be in a position to adjust its recommendations on the medicine […]".

- **Annex 2**: Copy of the article "Do you know what inhaler you are on?" published on 30/09/2014 on https://mylungsmylife.wordpress.com stating that

  "[…] I found out that one of my flatmates has asthma, and being naturally inquisitive I asked her if she was on any sort of preventer inhalers, to which she replied that she was on the purple one…I knew she meant Seretide/Advair and I didn't really think that much of it because so many people know their inhalers by colour rather than by their actual name […]

  […] I do admit to using the colours to identify inhalers in some situations but this is purely to help people understand which inhalers I am talking about, and I would not do this unless I thought necessary to aid understanding […]"

- **Annex 3**: Samples of marketing materials by pharmaceutical companies promoting different inhalers (i.e. 'Spiriva', 'Symbicort', 'Rolenium', 'Fostair', 'Flutiform').

- **Annex 4**: A witness statement from Michael B Davies, the principal design engineer who was employed by the EUTM proprietor in 1995 and tasked with the responsibility for suggesting a colour to be used for the 'SERETIDE' product.

- **Annex 5**: A witness statement of Georgina Evans dated 10/12/2004, Vice President and Trade Mark Counsel for the GSK group of companies

- **Annex 6**: Sales information from IMS Health, an independent company, to indicate which MDIs were available in Austria, Belgium, Finland, France, Germany, Greece, Ireland, Italy, Luxembourg, the Netherlands, Portugal, Spain and the UK in 2001. Images of the majority of these inhalers are attached to the sales information.

- **Annex 7**: Extracts from www.asthma.org.uk including comments posted by bloggers between February and April 2004, as follows:

  - *madz: woulldnt it be gr8 if they made inhalers all different colours instead of brown, blue and white!!!????!!*
  - *ickle_monsterr: ive got a purple one, dats better than brown*
  - *ickle_monsterr: they would be nicer to loook at, cos i look at mine all day*
  - *mizz.lola: get over the colour it does not matter but mine is purple they r not just blue and white any way.*

- **Annex 8**: Images showing samples of 'SERETIDE' packaging as used in packing Austria, Belgium, Denmark, Finland, France, Germany, Greece, Ireland, Luxembourg, the Netherlands, Spain, and the UK.

- **Annex 9**: A witness statement of Ms. Joanne Beth Green, Vice President and Trade Mark Counsel of GSK. The witness statement contains business information relating to the product 'SERETIDE EVOHALERS'. Since Ms. Green requested data incorporated in her statement to remain confidential, this information will be analysed in general terms. In this regard, Ms Green presented tables showing: *i)* the approximate number of units of each 'SERETIDE EVOHALER' sold; *ii)* the approximate revenue generated by sales of 'SERETIDE EVOHALER'; *iii)* the market

share for 'SERETIDE EVOHALER' by value in the MDI market, in the EU between 2000 and 2014. The following exhibits have been attached to Ms. Green's:

- Exhibit 1: Copy of an exchange of emails between the EUTM proprietor and IMS Health regarding the use of the IMS data in the present proceedings.

- Exhibit 2: A break-down of unit sales per Member State between 2000 and 2014.

- Exhibit 3: A monetary sales figures from IMS Health regarding the relevant 'EVOHALER' products between 1999 and 2014 and in Europe.

- Exhibit 4: Market share figures from IMS Health regarding the relevant 'EVOHALER' products between 1999 and 2014 and in Europe.

- Exhibit 5: Sample of marketing material in France (2001, from 2004 to 2008), In Ireland and the UK (between 2004 and 2015), Austria (between 2010 and 2012), the Benelux (between 2002 and 2005, 2012, 2014), Germany (between 2007 and 2012), Greece (2002, 2011 and 2012), Italy (between 2008 and 2012), Spain (between 2001 and 2004, 2009), Portugal (between 2009 and 2015), Finland (2001, 2003, 2015), Sweden (2014) .

  The images show, *inter alia*, inhalers in a two-tone purple combination displaying the word elements 'SERETIDE', 'VIANI' (for the German market), both on the product and on the packaging as follows:

- Exhibit 6: Advertising and promotional spend for 'SERETIDE' in the EU.

- **Annex 10**: Printouts from the following sources:

- www.forbes.com featuring the article "The Best Selling Drugs of All Time; Humira joins The Elite" published on 28/01/2013 and ranking 'SERETIDE' among the "Pharma's Biggest Blockbusters".

- www.pmlive.com, www.statista.com and Njardarson Group showing that 'SERETIDE' had been ranked in the top 5 pharmaceutical products by sales between 2009 and 2013.

- Pharma Exec 50 providing a report on the 'World's Top 50 Pharma Companies" in which GlaxoSmithKline is ranked second and 'SERETIDE'/'ADVAIR' is mentioned a key development.

- **Annex 11**: Extracts from http://cdmae.gsk.com featuring information and pictures related to the EUTM proprietor's participation at the European Respiratory Society (ERS) in Stockholm, Sweden (2002). The document contains no reference to the contested EUTM.

- **Annex 12**: Extracts from http://cdmae.gsk.com related to the participation at the European Respiratory Society (ERS) Vienna, Austria (2003). The pictures attached to the extracts show that the colour purple was used, *inter alia*, in connection with the EUTM proprietor's stand, bags, sofas, chairs and cushions. The document contains no reference to the contested EUTM.

- **Annex 13**: Pictures related to the participation at the European Academy of Allergology and Clinical Immunology (EAACI), in Paris (June 2003), showing that the colour purple is used in connection with the EUTM proprietor's stand and promotional items. The document contains no reference to the contested EUTM.

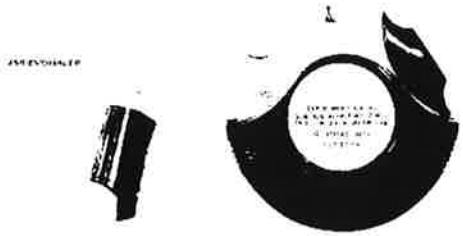
- **Annex 14**: Pictures related to the participation at the congress on Paediatric Pulmonology (CIPP), held in Nice, France, in 2002 and in Lisbon, Portugal, in 2004 showing that the colour purple is used in connection with the EUTM proprietor's stand and promotional material. The document contains no reference to the contested EUTM.

- **Annex 15**: Copy of the EUTM proprietor's observations of 20/02/2004 filed in response to the objection under Article 7(1)(b) EUTMR raised by the Office on 22/12/2003 against the EUTM applications No 2 179 562, 2 179 695, 2 179 737.

- **Annex 16**: Images of promotional material in purple featuring the stylized word element 'SERETIDE' (i.e. mouse mats, pens, cameras, note pads and cuddly toys). The document contains no reference to the contested EUTM.

- **Annex 17**: Extracts containing confidential data provided by IMS Health in form of a table listing sales figures of all inhalers sold in Europe as the second quarter of 2014. The table mentions the mark 'SERETIDE'.

- **Annex 18**: Images of the MDI inhalers referred to in Annex 17 including the EUTM proprietor inhalers 'SERETIDE' in purple as follows:



- **Annex 19**: Extracts showing comments posted on blogs from the UK (dated 2003, 2004, 2007, 2012), Denmark (dated 2008), Germany (dated 2008, 2009, 2011, 2012, 2013) and France (dated 2012), containing, among others, the following quotes: *"I was recently prescribed Seretide (lilac coloured inhaler)"*; *"the round purple shaped steroidal inhaler is called Advair"; "Seretide is a purple asthma inhaler"; "I am on Seretide (purple inhaler); "I have been given a purple inhaler SERETIDE and started..."; "The round purple 'disc shaped' steroidal inhaler is called Advair"*; .

  No images are attached to the comments.

- **Annex 20**: Printouts from the website of TNS Healthcare, a division of Taylor Nelson Sofres Plc, specialises in the pharmaceutical and medical market sector.

- **Annex 21**: Reports of a survey carried out by TNS Healthcare in the UK in 2005 showing that among 209 general practitioners (GPs), 132 associate the purple colour combination with an inhaler and, among those 132, 87 will associate it with 'SERETIDE' sold by the EUTM proprietor.

- **Annexes from 22 to 28**: A report called "Distinctiveness of an inhaler in these colours" (with the image of the contested EUTM) that was prepared on behalf of GlaxoSmithKline by Dr Almut Pfluger of the company Pfluger Rechtsforschung. It contains interviews that were conducted during the period March-April 2015 to: 201 GPs and 201 pharmacists from the UK (Annex 22), 206 GPs and 206 pharmacists from France (Annex 23), 203 GPs and 199 pharmacists from Belgium (Annex 24), 200 GPs and 201 pharmacists from the Netherlands (Annex 25), 200 GPs and 200 pharmacists from Austria (Annex 26), 200 GPs and 201 pharmacists from Ireland (Annex 27) and 200 GPs and 211 pharmacists from Spain (Annex 28). The EUTM proprietor notes that, according to Dr Pfluger, the results are some of the best she has seen for acquired distinctiveness since the introduction of colour marks.

- **Annex 29**: Extracts of an email dated 03/06/2014 from an EMA employee to Ms Green of GSK stating that:

  "[...] No legal requirements or particular guidance exist at the EU/EEA level for the colour coding to be used in inhalers and the packaging for medicinal products for inhalation. This includes both powder forms and metered dose inhaler [...]

  [...] While some EU Member States may require the use of a particular colour coding for particular product types, we are not in position to advise on any such guidance or requirements that may exist at a national level in EU Member States [...]".

- **Annex 30**: Extracts from the applicant's website www.breathefree.com which provides information about asthma/COPD, treatments and medications related thereto. The EUTM proprietor points out that the website has no reference to any "colour code" for inhalers.

- **Annex 31**: Copy of the judgment of 16/04/2014 of the Regional Court of Cologne (Germany) in case No 84O33/14 regarding preliminary injunction proceedings filed by the EUTM proprietor against Sandoz Pharmaceuticals GmbH, Salutas Pharma GmbH, Aeropharm GmbH and Hexal AG. In the judgment it is stated *"The colour purple is not only used for the product, the product packaging and the patient information but also for all promotional efforts".*

- **Annex 31b**: Copy of the decision of 11/06/2014 of the Hamburg Regional Court stating, *inter alia*, that the evidence furnished in said proceedings *"are not suitable to demonstrate a quasi-binding code"* for inhalers.

- **Annex 32**: Copy of the decision of 04/05/2000 of the UK Intellectual Property Office, by which the UK registration 1 524 601 (3D mark), owned by the EUTM proprietor, was invalidated since it was found to be devoid of any distinctive character. The EUTM proprietor's claim of acquired distinctiveness was rejected.

The UK registration No 1 524 601 consisted of a shape of an inhaler having *"the colour pink applied to the cap of the mouthpiece of the inhaler device and colour maroon will apply to the remainder of the surface of the inhaler device"*.

Concerning the use of a colour-code for inhalers, it was held that:

"[...] The Opponent has not been able to identify any public policy relating to the use of colours on inhaler devices which the trade mark registration offends. It seems to me that the Opponent's position is really that there ought to be a public policy that colours should only be used on inhalers to indicate purpose and strength. However, if the Department of Health has no such policy it is not for the Registrar to introduce such a policy via the Trade Marks Act [...]."

Regarding the inherent distinctiveness of the mark, it was stated:

[...] As with most goods, colour is an unavoidable feature of an asthma inhaler. Because the average consumer is accustomed to colours appearing on goods and their packaging, he does not usually regard a colour as an indication of the trade source of the product. There may be exceptions. [...] I do not think that asthma inhalers fall into this category. The registered proprietor's evidence indicates that its own inhalers come in a variety of colours. There were clearly other manufacturers producing inhalers in a range of colours before the relevant date. The evidence suggests that the number of coloured inhalers on the market had increased to the point that it was causing some concern in the relevant circles by the material date. In these circumstances I do not consider that the colours maroon and pink can be regarded as having an inherently distinctive character as at 21 January 1993 [...] The registered proprietor's position at the later date is, if anything, worse than at the date of the registration. [...]"

- **Annex 33 to 36**: A survey report called "[redacted]Distinctiveness of this colour on an Inhaler" that was prepared on behalf of GlaxoSmithKline by Dr Almut Pfluger of the company Pfluger Rechtsforschung. It contains interviews that were conducted in March 2015 to: 200 GPs and 200 pharmacists from the UK (Annex 33), 204 GPs and 200 pharmacists from France (Annex 34), 204 GPs and 200 pharmacists from Belgium (Annex 35), 200 GPs and 235 pharmacists from the Netherlands (Annex 36).

- **Annexes 37 and 38**: A declaration from Derek Holley, "a Director of the London-based Health division of GfK NOK ("Gfk"), an independent organisation specialising in research amongst physicians, other healthcare professionals and patients", providing report of a survey run in Denmark and Sweden between February and April 2014. The survey was entitled "INHALER: COLOUR ASSOCIATION".

- **Annex 39**: Copy of the article "Asthma inhalers and colour coding: universal dots" published on the British Journal of General Practice in September 2010 (listed above within the applicant's evidence).

- **Annex 40**: Extracts from the Internet providing images of several combination inhalers available in different colours on the EU market at the time of the application for invalidity.

- **Annex 41**: Extracts proving information on the products 'Foradil' and 'Onbrez'.

The applicant's reply

The applicant reiterates its previous allegations and maintains that:

- The EUTM has no element that can be considered to be distinctive. The 3D form claimed by the EUTM proprietor, consisting of a MDI with a combination of colours, is used by all the pharmaceutical companies marketing inhalers.

- The average consumer of inhalers is accustomed to seeing representations of the product in different colours.

- As to Annex 1 submitted by the applicant, it shows that the EMA recognises that pharmaceutical companies use different colours for inhalers, including purple. A medicine is normally called and remembered by its name (i.e. Seretide).

- There are different medicines and colours which may change in the market and it is more difficult to remember colours than the name of a medicine. Further, the evidence submitted by both parties show that all inhalers are represented in a combination of two colours.

- In its arguments, the EUTM proprietor has not taken into account all the relevant public because he has not taken into account the patients, when they are the reason for the existence of inhalers. Concerning the applicant's claim of acquired distinctiveness, the evidence refers generally to "Seretide" products, although this brand is used in connection with different products (Diskus, powder form and inhalers), as shown below:

- Therefore, it is not clear if the information provided by the documents refers specifically to the contested EUTM.

- The EUTM proprietor has submitted no invoices, annual reports or any information by independent party.

- In addition, the surveys refer to only seven of the EU relevant Member States. The evidence fails to demonstrate that the contested EUTM has acquired distinctiveness through use in Germany, Italy, Portugal, Final, Sweden, Denmark, Greece and

Luxemburg. Furthermore, the surveys are directed only to practitioners and pharmacists. Patients have not been included.

In support of its submission, the applicant filed a copy of an email from the European Medicines Agency (EMA) (Doc. 10) stating as follows:

> *"In relation to the color code for inhalation medicinal products, there is no EU-wide convention on color coding for inhalers. It is a common choice in some EU Member States that reliever medication inhalers (short-acting beta2-agonist (SABA) such salbutamol and terbutaine) are blue in color and preventer inhalers (inhaled corticosteroids) brown, inhaled steroids and LABA (long-acting beta2-agonist) combinations have been introduced in violet, red and brown inhalers. However, this is not always followed and there are inconsistencies in the color for inhalers. In the EMA guidelines 'Good practice guide on risk minimization and prevention of mediation errors' is pointed out that the choice of color should be considered in product design for inhalation products"*

The EUTM proprietor's rejoinder

- The EUTM proprietor's reiterates its previous arguments, contests the applicant's claims and points out that:

- The applicant contends that using a combination of two shades of the same colour is common in the pharmaceutic industry. However, the applicant refers to inhalers that are available in Canada and provides no time frame from when these products were on the market. Also some of the products the applicant refers to - namely 'Ventolin', 'Becloforte', 'Beclovent', 'Flovent' and 'Serevent' - are inhalers of the EUTM proprietor, indicating that the use of two shades of the same colour is a distinctive feature of the EUTM proprietor's getup.

- As already shown, at the time of the EUTM filing, inhalers were mostly white or brown with only small accents of colour. No company other than the EUTM proprietor used a combination of two shades of purple for a MDI.

- The sales figures provided within the first submissions, relate to the 'Seretide' products sold in the form of the inhalers protected by the contested EUTM. The figures do not include any sales of the product 'Seretide Diskus'. Further, a breakdown is submitted as Exhibit 2 of Ms. Green's statement, which provides full sales details, including a break-down of unit sales for all 15 Member States between 2000 and 2014.

- The surveys were conducted only a number of months after the filing date of the cancellation action. Accordingly, the surveys are extremely relevant as they clearly demonstrate that the EUTM has acquired distinctiveness as at the date of filing of the application for invalidity.

- Patients have little impact on the purchasing decision of prescription medication and it is therefore the doctors and pharmacists that should be given more weight. Further, the lack of patients in the survey does not have any impact on the veracity of the results in relation to doctors or pharmacists. In any case, surveys from patients (from Denmark and Sweden) have been submitted so it is incorrect to say that no patient survey has been submitted.

- The EUTM proprietor has provided evidence of acquired distinctiveness in all the relevant 15 Member States. Such evidence includes sale figures, market share, advertising spend and advertising materials.

- The sales and market share figures were specifically provided in relation to each version of the 'Seretide Evohaler' (as protected by the contested mark) and marketing material was provided from all Member States in relation to the EUTM. Whilst the applicant refers to Cyprus and Malta these member States are irrelevant as these were not part of the EU at the filing date and so are excluded in relation to the present cancellation proceedings. In any case, a survey is only one type of evidence.

- The EUTM proprietor has submitted survey evidence from 11 out of the 15 relevant Member States. Therefore, there is no reason to assume that consumers in the remaining 4 Member States would think any differently. The market shares of the Seretide Evohalers in the 4 remaining Member States are comparable. For example, the market (MDI) shares in Portugal, Italy and Finland are 52.39%, 35.13%, 53.51% compared to 36.35% in France and 26.67% in Belgium. The market share in Greece is slightly lower at 13.24% but again is comparable to say 12.28% in Austria (Annex 9 and Exhibit 4).

In support of its observations, the EUTM proprietor filed the following evidence:

- **Annex 42**: Copy of the decision of 31/03/2015 of the Swedish District Court in case No T 15906-14 regarding an application for an interim injunction submitted by the EUTM proprietor against the applicant on the basis of the contested EUTM.

- **Annex 43**: Images of promotional material including leaflets and brochures in English providing information on 'Seretide' inhalers and showing the contested EUTM, a cup, a flashlight, a cushion, pens, a notepad and a bag all in purple and bearing the sign 'SERETIDE'.

- **Annex 44**: Extracts from the blog page 'My Lungs My Life' showing comments posted on January and May 2015 by UK bloggers. There is no reference to the contested EUTM.

- **Annex 45**: Extracts from Belgian and Dutch blogs containing two comments dated February 2009 ("..I also use seretide, the purple inhaler"); ("For those who are using Seretide, the purple one.. This is a combination of Sere(ven) and (Fixo)tide").

- **Annex 46**: Copy of undated brochures/leaflets showing, among others, the contested EUTM and addressed to the public in Benelux (4 printouts), Denmark (a printout), France (3 printouts), Germany (2 printouts), Greece (a printout), Italy (2 printouts), Ireland (a printout), Portugal (a printout) and the UK (5 printouts).

- **Annex 47**: A table showing the reliever and preventer inhalers marketed over the years and their corresponding colours:

  Reliever inhalers: in blue (Ventolin, Berotec, Bricanyl, Salbutamol Teva, Buventol); in green (Atrovent); in green (Berodual); in orange (Combivent);

  Preventer inhalers: in brown (Becotide, Pulmicort); in green (Serevent, Spiriva, Eklira, Aarane, Spiolto); in orange (Flutide, Foradil MDI, Allergospasmin, Seebri, Flutiform, Duaklir); in blue (Foradil DPI, Atimos, Onbrez, Intal), in red (Miflonide,

Qvar, Symbicort, Duoresp, Anoro), in pink/fuchsia (Asmanex and Inuxair), in yellow (Striverdi, Relvar, Ultibro), in purple (Seretide), in combinations of colours (Oxis - two shades of blues; Beclomet - blue and brown; Giona - blue and orange; Formoterol Stada - red and blue; Seroflo - pink and red).

- **Annex 48**: An extract of article published on 'The Lancet' on 18/01/1986 containing a paragraph entitled 'Colour Coding for bronchodilator inhalers' stating:

  "[...] In a routine outpatient clinic patient and doctor became confused because the usual colour scheme had not been followed [...]

  [...] The patient could easily confuse one brown inhaler with another and so discontinue his inhaled beta agonist or steroid, with potentially disastrous effects. [...]

  [...] With increasing pressure for both generic prescribing and generic distribution there is urgent need for standardisation of colours throughout the pharmaceutical industry (see table) [...]"

CONFUSION OF COLOUR CODES FOR BRONCHODILATOR INHALERS

Inhaler	Colour
Salbutamol	
'Ventolin'	Blue
'Asmaven'	Blue/white cap
'Salbulin'	Grey
'Coburolin'	Clear plastic*
Generics†	White/orange cap; royal blue/sea blue cap; blue; dark blue/light grey cap; clear plastic; blue
Other β_2-agonists	
Orciprenaline ('Alupent')	Clear plastic/grey-green cap
Terbutaline ('Bricanyl')	Blue/grey cap
Fenoterol ('Berotec')	Clear/grey/dark blue cap
Isoetharine ('Bronchilator')	White/red cap
Pirbuterol ('Exirel')	Turquoise/green cap
Reproterol ('Bronchodil')	Green and white
Rimiterol ('Pulmadil')	Petrol blue
Isoprenaline (Riker)	Beige/white mouthpiece
Isoprenaline (Napp)	Green
Steroids	
Beclomethasone ('Becotide')	Beige/brown cap
Beclomethasone ('Becloforte')	Reddish brown
Betamethasone ('Bextasol')	Pale green/dark green cap
Budesonide ('Pulmicort')	Beige/brown

*Formerly brown.
†Evans, Garland, Midpledge, Norton, Kerfoot, Astec.

- **Annex 49**: An extract of article published on 'BMJ' (British Medical Journal) on 10/10/1992 containing a paragraph entitled 'Coloured Inhalers' stating:

  "[...] The traditional concept of blue being for relievers and brown or red for preventive medicines in now totally confused by, for example, the arrival of a generic salbutamol in a brown inhaler. This makes patient education difficult and also causes problems when giving advice [...]"

  We have extolled to them [Association of British Pharmaceutical Industry and the Medicines Control Agency] either the virtues of a rough standardisation of colours, or the application of a mark such as a circle for relievers and a cross for preventers. Despite these numerous dignified and justifiable representations, we repeatedly receive replies to the effect of "there can be no substitute for carefully reading the label before any medicine is taken"

- **Annexes 50 to 52**: A survey report called "[redacted]Acquired distinctiveness of this colour in connection with inhalers" prepared on behalf of GlaxoSmithKline by Dr Almut Pfluger of the company Pfluger Rechtsforschung GmbH. It contains interviews that were conducted to: 200 GPs and 202 pharmacists from Ireland in September

2015 (Annex 50); 100 GPs and 39 pharmacists from Luxembourg in March 2016 (Annex 51), 200 GPs from Austria in September 2015 (Annex 52).

ABSOLUTE GROUNDS FOR INVALIDITY – ARTICLE 52(1)(a) EUTMR IN CONJUNCTION WITH ARTICLE 7 EUTMR

According to Article 52(1)(a) and (3) EUTMR, a European Union trade mark will be declared invalid on application to the Office, where it has been registered contrary to the provisions of Article 7 EUTMR. Where the grounds for invalidity apply for only some of the goods or services for which the European Union trade mark is registered, the latter will be declared invalid only for those goods or services.

Furthermore, it follows from Article 7(2) EUTMR that Article 7(1) EUTMR applies notwithstanding that the grounds of non-registrability obtain in only part of the Union.

As regards assessment of the absolute grounds of refusal pursuant to Article 7 EUTMR, which were the subject of the *ex officio* examination prior to registration of the EUTM, the Cancellation Division, in principle, will not carry out its own research but will confine itself to analysing the facts and arguments submitted by the parties to the invalidity proceedings.

However, restricting the Cancellation Division to an examination of the facts expressly submitted does not preclude it from also taking into consideration facts that are well known, that is, that are likely to be known by anyone or can be learned from generally accessible sources.

Although these facts and arguments must date from the period when the European Union trade mark application was filed, facts relating to a subsequent period might also allow conclusions to be drawn regarding the situation at the time of filing (23/04/2010, C-332/09 P, Flugbörse, EU:C:2010:225, § 41 and 43).

ARTICLE 7(1)(b) EUTMR – NON-DISTINCTIVENESS

The case law

For a trade mark to possess distinctive character for the purposes of Article 7(1)(b) EUTMR, it must serve to identify the goods and services in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish those services and services from those of other undertakings (07/10/2004, C-136/02 P, Torches, EU:C:2004:592, § 29).

The signs referred to in Article 7(1)(b) EUTMR are incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (02/07/2009, T-414/07, Main tenant une carte, EU:T:2009:242, § 32; and 03/12/2003, T-305/02, Bottle, EU:T:2003:328, § 28).

According to settled case-law, the criteria for assessing the distinctive character of three-dimensional trade marks consisting of the shape of the product itself are no different from those applicable to other categories of trade mark. However, for the purpose of applying those criteria, the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the

appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it designates. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctive character in relation to such a three-dimensional mark than in relation to a word or figurative mark (07/10/2004, C 136/02 P, Torches, EU:C:2004:592, § 30; and 20/10/2011, C 344/10 P & C 345/10 P, Botella esmerilada II, EU:C:2011:680, § 45 - 46).

In those circumstances, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR. Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of that provision (07/10/2004, C 136/02 P, Torches, EU:C:2004:592, § 31; and 24/05/2012, C 98/11 P, Hase, EU:C:2012:307, § 42).

It follows that, where a three-dimensional mark is constituted by the shape of the product for which registration is sought, the mere fact that that shape is a 'variant' of a common shape of that type of product is not sufficient to establish that the mark is not devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR. It must always be determined whether such a mark permits the average consumer of that product, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention (07/10/2004, C 136/02 P, Torches, EU:C:2004:592, § 32).

The relevant public and the relevant territory in the present case

The distinctive character of a trade mark, within the meaning of Article 7(1)(b) EUTMR, must be assessed, first, in relation to the goods or services in respect of which registration of the sign is sought and, second, in relation to the perception of the section of the public targeted, which is composed of the consumers of those goods or services (27/11/2003, T 348/02, Quick, EU:T:2003:318, § 29).

In the present case, the goods for which the mark is registered are:

Class 5: *Pharmaceutical preparations and substances for the prevention, treatment and/or alleviation of respiratory ailments.*

Class 10: *Inhalers, parts and components for all the aforesaid goods.*

In its submissions, the EUTM proprietor argues that inhalers are sold only under prescription. Therefore, in its opinion, when assessing the distinctive character of the EUTM, it is primarily the perspective of the healthcare professionals which must be taken into account and given the most weight, while the patients and pharmacists constitute a more limited part of the relevant public. The EUTM proprietor explains that although both healthcare professionals and patients form part of the relevant public it does not mean that both classes of consumers should be given equal weight when considering distinctiveness under Article 7(1)(b) EUTMR.

The applicant contends that the professionals and the patients should be considered as equal part of the relevant public.

The Cancellation Division considers that the relevant public includes both medical professionals (i.e. doctors and pharmacists) and average consumers, that is to say, people who suffer from respiratory ailments. Indeed, where the goods at issue are medicinal products requiring a doctor's prescription prior to their sale to end-users in pharmacies, the relevant public comprises both end-users and health professionals, that is to say doctors who prescribe the medicinal product and pharmacists who sell the prescribed medicinal product. Even though the choice of those products is influenced or determined by intermediaries, the perception of the general public is still relevant, since patients get in contact with relevant goods when purchasing and using the inhalers. As is apparent from the case-law, even in the case of medicinal products available only on prescription, it cannot be excluded that the average consumer forms part of the relevant public. Accordingly, the relevant public comprises both health professionals and average consumers (see, to that effect, 26/04/2007, C-412/05 P, Travatan, EU:C:2007:252, § 52 to 63; and 09/02/2011, T-222/09, Alpharen, EU:T:2011:36, § 43 and 44).

Taking into account the medical nature of the goods, the level of attentiveness of both the professionals and the general end-consumers will be higher than average 07/06/2012, T-492/09 & T-147/10, Allernil, EU:T:2012:281, § 29; 15/12/2009, T-412/08, Trubion, EU:T:2009:507, § 28).

Furthermore, as the contested mark consists of a three-dimensional sign with no legible word elements on it, the examination of its distinctive character must be based on the perception of consumers throughout the European Union.

On the breach of Article 7(1)(b) EUTMR

With respect to the case at issue, the question of whether or not the sign was registered in breach of Article 7 EUTMR must be assessed only with regard to the following mark as registered:

The EUTM consists of the shape of an inhaler device in the colour scheme as shown on the application form (as above): the deep purple is applied to the cap, the lilac to the body of the device.

During the examination proceedings, in the letter of 20/02/2004, the EUTM proprietor indicated that the mark displays the colours deep purple (Pantone ref 2617C) and lilac (Pantone ref 2645C).

The parties' evidence and submissions indicate that inhalers (the contested goods in Class 10) are medical devices used for delivering medical preparations (the contested goods in Class 5) into the body via the lungs in order to treat asthma and chronic

obstructive pulmonary disease ("COPD"). Inhalers can be grouped into 'preventers' and 'relievers': as their name suggests, the former, which are taken every day, help to prevent asthma and COPD symptoms from developing, while the latter are taken to relax the muscle in the airway when breathing difficulties occur. A further category consists of the so-called 'combination inhalers', namely those combining two kinds of medicine: a preventer and a long-acting reliever. The EUTM proprietor's product, which is known in the market as 'SERETIDE', is an example of a 'combination inhaler': it contains *salmeterol xinafoate* combined with *fluticasone propionate* and comes in two different inhalers, a dry powder inhaler known as 'DISKUS', which has the shape of a flat 3D sphere, and a metered dose inhaler ('MDI') known as 'EVOHALER', which has the shape of the contested EUTM, as represented hereunder:

DISKUS Dry Powder Inhaler (all Strengths) | EVOHALER Metered Dose Inhaler (25/50) | EVOHALER Metered Dose Inhaler (25/125) | EVOHALER Metered Dose Inhaler (25/250)

The EUTM proprietor explains that the different numbers related to the metered dose inhalers (i.e. 25/50; 25/125; 25/250) correspond to the strength of the medicine.

As undisputed by the parties, the EUTM is in the form of a metered dose inhaler (MDI) whose shape is similar to variations of metered dose inhaler devices usually available on the market. Indeed, the EUTM proprietor itself states that such standard shape is not distinctive for the goods at issue.

A three-dimensional trade mark consisting of such a shape is not distinctive unless it permits the average consumer of the goods concerned, who is reasonably well informed and reasonably observant and circumspect, to distinguish those goods from the goods of other undertakings without any detailed examination or comparison and without being required to pay particular attention (12/02/2004, C 218/01, Perwoll, EU:C:2004:88, § 53; and 29/04/2004, T 399/02, Botella Corona, EU:T:2004:120, § 24).

In those circumstances, only a mark which departs significantly from the norms or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR (20/10/2011, C-344/10 P & C-345/10 P, Botella esmerilada II, EU:C:2011:680, § 47).

In light of the foregoing, it is necessary to ascertain whether the contested mark departs significantly from the norms and customs of the relevant sector.

In its submissions, the EUTM proprietor states that, at the moment of the filing of the mark, the combination of the two shades of purple applied for was highly distinctive, striking and unusual for inhalers.

Hence, the main issue, in the present case, is whether the two-tone purple combination applied respectively to the cap and the body of an ordinary inhaler is inherently distinctive for the relevant goods in Classes 5 and 10.

In this regard, the applicant's claim is essentially based on the following points:

i. The EUTM merely consists of the shape of a standard metered dose inhaler (MDI) with a combination of two shades of purple. The relevant public is accustomed to seeing inhalers in different colour combinations and, therefore, will not recognise the sign, as a whole, as a badge of origin.

ii. The colours of inhalers are used to describe the medical preparation that is contained therein.

The applicant has submitted tables from independent sources (Doc. 5 to Doc. 8) showing that a variety of colours are associated with either a type of inhaler (i.e. 'relievers' are in blue, in two shades of green and in the combination between green and orange; 'preventers' are in brown, red, orange, yellow, and white; 'combination inhalers' are in red and purple, etc.) or an active ingredient of the medicine (i.e. *salbutamol* in blue; *salmeterol* in green; *fluticasone* in orange, *budesonide* in brown; etc.).

In its submissions, the EUTM proprietor argues that at the time of the filing of the EUTM, inhalers were mostly white or brown with only small accents of colour and that its company was the only undertaking marketing inhalers in a two-shade purple combination. It also contests that the documents filed by the applicant are undated and do not reflect the situation of the EU market at relevant time frame.

Further, the EUTM proprietor argues that there exists no legal or regulatory restriction on the choice of colour for inhalers and, consequently, pharmaceutical companies are free to use whichever colour they like for their inhaler devices.

A part of the documents furnished by the parties suggests that some inhaler devices are indeed coloured according to the colour-code displayed on the applicant's tables (for instance, the product 'Ventolin' containing *salbutamol* is in blue; 'Flixotide' containing *fluticasone* is in orange; 'Serevent' containing *salmeterol* is green; 'Pulmicort' containing *budesonide* is in green).

However, from the evidence on file, taken as a whole, it is not possible to safely conclude that a relevant proportion of the relevant public is able to perceive colours on inhalers as an indication of the medicine contained therein.

Scientific articles - which were published in 1986, 1992, 2010, and 2014 (Doc. 9; Annex 1; Annexes 48 and 49) - and recent emails from the European Medicines Authority (EMA) (Annex 29 and Doc. 10) indicate that the issue concerning the convenience of having uniform colours for inhalers has been a topic of the scientific literature over the years.

The documentation reports that the association between colours and different types of medications is a practice that has not always been followed and that the inconsistencies in the colour of inhalers have at times created confusion within the relevant public. In their articles, the experts raised the "*urgent need for standardisation of colours throughout the pharmaceutical industry*" as at times patients *"became confused because the usual colour scheme had not been followed"* (Annex 48). The evidence shows that there is no fixed colour-code for inhalers and that in fact inhalers having the same medical indication or therapeutic function have been marketed in a variety of colours. Indeed, the evidence indicates that 'preventers' and 'relievers' (i.e. inhalers with difference functions) are sometimes marketed in the same colours.

As explained in the communication of the EMA, although some EU Member States have introduced the use of specific colours to identify a different type of medication

(Annex 29 and Doc. 10), the fact that there is no regulation on colour coding for inhalers (Annex 1 and Doc. 10) has created a situation on the market that is rather confusing. Such inconsistency does not allow the relevant public to interpret colours as a clear indication of the medicine in inhalers.

Nonetheless, the evidence shows that inhalers were marketed in different colours before the date of the filing of the contested registration. The fact that since the eighties it has been debated that a colour-code for inhalers could be beneficial for the patients indicates that colours are a typical characteristic of inhalers. The table attached to the article 'Colour Coding for bronchodilator inhalers' (Annex 48) shows that in 1986 inhalers were available in blue, grey, green, white/orange, reddish brown, beige/brown, turquoise/green, white/red, etc. The EUTM proprietor itself has furnished a prospectus showing that inhalers in blue, green, grey, brown, orange, red, and combination of those colours, have been marketed since the seventies (Annex 47). Even the EUTM proprietor's inhalers came in different colours.

Therefore, from the documents submitted by both parties, it appears that colours, and their combination, were a customary feature of inhalers before the EUTM proprietor applied for the contested registration.

Contrary to the EUTM proprietor's argument, the fact that at the relevant date its company was the only undertaking marketing inhalers in purple does not imply that the combination of deep purple and lilac applied to the shape of a standard metered dose inhaler is inherently distinctive. Indeed, before the filing of the EUTM, several pharmaceutical companies were already marketing inhalers in a range of colours.

Although it is not sufficiently proved that colours indicate a particular characteristic of the goods at hand (i.e. their medical therapy, active ingredients), the evidence has shown that, at the time of the filing of the contested EUTM, the relevant public was accustomed to colours appearing on inhalers and their packaging. Moreover, the launch of new generic products had contributed to inflate the use of different colours and their combinations to the point that it was causing some concern among experts (Annexes 48 and 49). Despite being used only by the EUTM proprietor, at the material date the colour purple was only a 'further' colour to those already existing on the market. In addition, the practice of using different colours, or two shades of the same colour, on the cap and on the body of the inhalers appears to be quite common and functional in order to differentiate the components of the device.

According to settled case-law, it should be noted that although the overall impression given by the mark must be considered, this does not mean that one may not first examine each of the individual features of the get-up of that mark in turn. It may be useful, in the course of the overall assessment, to examine each of the components of which the trade mark concerned is composed (11/04/2014, T-209/13, Olive line, EU:T:2014:216, § 30 and the case law cited therein).

The contested trade mark is characterised by a three-dimensionally-shaped metered dose inhaler having a deep purple cap and a lilac body. However, the manner in which those components are combined in the present case represents nothing more than the sum of the parts which make up the contested trade mark, that is to say, a standard metered dose inhaler with a combination of colours, as is the case with most inhalers devices on the market. Indeed, non-distinctive elements combined with a standard shape will not confer distinctiveness upon that shape (18/01/2013, T-137/12, Vibrator, EU:T:2013:26, § 34-36). The evidence filed by the parties shows that the purple colour combination of the inhaler shape was perceived by the relevant public merely as a common and customary element of the product and not as a badge of their origin.

Following the above analysis, it is concluded that the shape element of the contested mark does not possess any element other than the usual appearance of a metered dose inhaler coloured with a two-tone purple combination. However, such colour does not allow the relevant public to recognise the shape as having a specific origin combination.

This finding applies to all the goods of the contested EUTM:

Class 5: *Pharmaceutical preparations and substances for the prevention, treatment and/or alleviation of respiratory ailments.*

Class 10: *Inhalers, parts and components for all the aforesaid goods.*

Indeed, nor is the EUTM distinctive for pharmaceutical preparations related to respiratory ailments. Here, the shape is simply seen as a reference to the medicine inhaled through the inhaler device.

As for the argument of the EUTM proprietor that, at the time of the filing of the EUTM, the contested mark was found to satisfy the requirements set out in Article 7 EUTMR, it must be point out that Article 56(1) EUTMR gives a right to any natural or legal person, provided that they satisfy the requirements of the abovementioned article, to submit an application for a declaration that the trade mark is invalid and a EUTM shall be declared invalid on such application where it has been registered contrary to the provisions of Article 7 EUTMR. In this regard, it must be stressed that, contrary to the contention of the EUTM proprietor, even though a EUTM is registered, an invalidity applicant can successfully demonstrate that the EUTM at the time of its filing or its registration consisted exclusively of an indication which was devoid of any distinctive character pursuant to Article 7(1)(b) EUTMR.

Based on all the above, and in particular considering that the market for the contested goods is characterised by inhaler shapes marketed in a variety of colours, the Cancellation Division concludes that the EUTM, evaluated in its entirety, based on the overall perception of the trade mark by the relevant public, is devoid of any distinctive character within the meaning of Article 7(1)(b) EUTMR for all the goods registered.

Since Article 7(1) EUTMR makes it clear that it is sufficient that one of the absolute grounds for refusal listed in that provision applies for the sign at issue not to be registrable as a European Union trade mark (28/06/2011, T-487/09, ReValue, EU:T:2011:317, § 80; 17/04/2013, T-383/10, Continental, EU:T:2013:193, § 71-72; and 12/06/2013, T-598/11, Lean Performance Index, EU:T:2013:311, § 52), it is no longer necessary to consider, in the present case, the applicant's arguments alleging breach of Articles 7(1)(c), 7(1)(d) and 7(1)(e)(ii) EUTMR.

Article 52(2) EUTMR - ACQUIRED DISTINCTIVENESS

Pursuant to Article 52(2) EUTMR, where a EU trade mark has been registered in breach of the provisions of Article 7(1)(b), (c) or (d), it may nevertheless not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

In assessing the distinctive character acquired through use of a mark in respect of which protection is sought, the following may be taken into account: the market share

held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 51).

It is clear from case-law that the acquisition of distinctiveness through use of a mark, under Article 7(3) EUTMR, requires that at least a significant proportion of the relevant section of the public identifies the products in question as originating from a particular undertaking on the basis of the mark. However, these circumstances cannot be shown to exist solely by reference to general, abstract data, such as specific percentages (19/06/2004, C-217/13 & C-218/13, Oberbank e.a., EU:C:2014:2012, § 48; and 06/11/2014, T-53/13, Line which slants and curves, EU:T:2014:932, § 97). Moreover, proof of distinctive character acquired through use cannot be furnished by the mere production of sales volumes and advertising materials. Similarly, the mere fact that the sign has been used in the territory of the European Union for a certain time is also not sufficient to show that the target public for the goods in question perceives it as an indication of commercial origin (06/11/2014, T-53/13, Line which slants and curves, EU:T:2014:932, § 100).

The relevant dates for the application of Articles 7(3) EUTMR and 52(2) EUTMR are the filing date of the contested EUTM (12/04/2001) and its registration date (09/11/2005), respectively, and also the date of filing of the application for invalidity (16/12/2014). Moreover, considering that the mark does not contain any verbal element, to which an objection only pertains in part of the European Union, the distinctive character has to be proven across the entire Union (25/09/2014, T-474/12, Shape of goblets, EU:T:2014:813, § 58). In this respect, the relevant territory consists of the European Union within the borders applicable at the filing date, independently of any previous or subsequent change in the territory. At the time of the filing of the EUTM, the Union was composed of the following Member States: Austria, Belgium, Denmark, Finland, France, Germany, Greece, Ireland, Italy, Luxembourg, the Netherlands, Portugal, Spain, Sweden and the United Kingdom.

Given the above, it must be established either that the contested EUTM had acquired distinctive character on account of the use which has been made of it in the Member States of the European Union at the time of the filing date or that it has acquired such distinctive character on account of the use which has been made of it (14 December 2011, T-237/10, 'Clasp lock', para. 90).

Considering the foregoing, the proof of acquired distinctiveness submitted must show that the mark applied for had become distinctive for at least a significant proportion of the relevant public in the European Union, in relation to the goods concerned, as a consequence of the extensive use which was made of it.

The EUTM proprietor submitted extensive evidence of use, which can be grouped as follows:

- Samples of marketing and promotional material, including packaging; leaflets; images taken at international exhibition; samples of merchandising goods, relating to the following territories: Austria, Belgium, Denmark, Finland, France, Germany, Greece, Ireland, Luxembourg, the Netherlands, Portugal, Spain, and the UK (Annexes 3, 8 from 11 to 14, 16, 43, 46 and Exhibits 5 and 6);

- Tables containing confidential data from IMS Health showing sales and market-share figures generated by the products 'SERETIDE' and 'ALIFLUS' (the Italian version of the EUTM proprietor's inhaler) between 2000 and 2014 in all the EU Member States (Exhibits 2, 3 and 4);

- Surveys carried out by the company Pfluger Rechtsforschung GmbH at the time of the cancellation request: *i)* relating to an inhaler device in lilac and deep purple among GPs and pharmacists in Austria, Belgium, France, Ireland, the Netherlands, Spain and the UK; *ii)* relating to the colour 'purple' among GPs and pharmacists in Austria, Belgium, France, Luxembourg, Ireland, the Netherlands and the UK (Annexes from 22 to 28, from 33 to 36 and from 50 to 52); a survey carried out by TNS Healthcare among general practitioners in the UK in 2005 (Annex 21);

- Printouts from an article and blogs from Belgium, Denmark, France, Germany, the Netherlands and the UK in order to show the recognition of the mark among the general public (Annexes 2, 7, 19, 44 and 45);

- Declarations and witness statements from EUTM proprietor's employees (Annexes 4, 5, 9, 37 and 38);

- Printouts showing rankings of the top selling drugs worldwide in 2005 and from 2009 to 2013 (Annex 10);

- Previous decisions from national courts in infringement proceedings filed by the EUTM proprietor in Germany and Sweden (Annexes 31, 31b and 42).

- In its submissions, the EUTM proprietor points out that it has sold a two-tone purple inhaler under the name 'SERETIDE' in the EU since 1998. The product is also known as 'ALIFLUS' in Italy and 'VIANI' in Germany. As above mentioned and illustrated, the name 'SERETIDE' is used in relation to two different inhalers: a dry powder inhaler, with the shape of a flat 3D sphere, and a metered dose inhaler, with the shape used for the EUTM.

According to the EUTM proprietor, the surveys demonstrate that the specific combination of deep purple and lilac as applied to the shape of a metered dose inhaler was perceived by the relevant public as badge of origin both at the time of filing of the contested mark (Annex 21) and at the time of filing of the invalidity application (Annexes from 22 to 28, from 33 to 36 and from 50 to 52). The EUTM proprietor argues that, contrary to the applicant's allegations, the surveys are relevant even if they were conducted only among medical professionals, since patients have little impact on the purchasing of the relevant goods.

The EUTM proprietor further asserts that the sale and market share figures together with the adverting and promotional material clearly demonstrate that the EUTM has acquired distinctiveness as at the date of filing of the application for invalidity.

Nonetheless, the Cancellation Division considers that the EUTM proprietor has not demonstrated acquired distinctive character for the EUTM as such through use.

Firstly, from the evidence on file it appears that the applicant has not used the trade mark in isolation. The material submitted exclusively shows use of the contested mark with one or more brands added to it, in the majority of the cases the word 'SERETIDE' on its own or used in combination with either the elements 'EVOHALER' or 'DISKUS'.

In this regard the Court stated in its judgment of 16/09/2015, C-215/14, Société des Produits Nestlé, EU:C:2015:604, § 63-66, that:

> "63 So far as, specifically, the acquisition of distinctive character in accordance with Article 3(3) of Directive 2008/95 is concerned, the expression 'use of the mark as a trade mark' must be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the goods or services as originating from a given undertaking (judgment in Nestlé, C-353/03, EU:C:2005:432, paragraph 29).
>
> 64 Admittedly, the Court has acknowledged that such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. However, it has added that in both cases it is important that, in consequence of such use, the relevant class of persons actually perceive the goods or services, designated exclusively by the mark applied for, as originating from a given undertaking (judgment in Nestlé, C-353/03, EU:C:2005:432, paragraph 30, and, in connection with Regulation No 40/94, Article 7(3) of which corresponds, in essence, to Article 3(3) of Directive 2008/95, the judgment in Colloseum Holding, C-12/12, EU:C:2013:253, paragraph 27).
>
> 65 Therefore, regardless of whether the sign is used as part of a registered trade mark or in conjunction with the registered trade mark, the fundamental condition is that, as a consequence of that use, the sign for which registration as a trade mark is sought may serve to identify, in the minds of the relevant class of persons, the goods to which it relates as originating from a particular undertaking (see, to that effect, judgment in Colloseum Holding, C-12/12, EU:C:2013:253, paragraph 28).
>
> 66 It must therefore be concluded, as indicated in points 48 to 52 of the Advocate General's Opinion, that although the trade mark for which registration is sought may have been used as part of a registered trade mark or in conjunction with such a mark, the fact remains that, for the purposes of the registration of the mark itself, the trade mark applicant must prove that that mark alone, as opposed to any other trade mark which may also be present, identifies the particular undertaking from which the goods originate."

It is clear from the materials submitted that the contested mark was used consistently in close or immediate connection with the indication 'SERETIDE', on its own or in conjunction with the words 'EVOHALER' or 'DISKUS'. These words appear prominently on all the packaging, the patient information leaflets, and the advertising and promotional material. In addition, the articles and rankings only refer to 'SERETIDE' - there is no mention of the coloured shape. Moreover, the patients can clearly see 'SERETIDE' on the top of the canister of the inhaler when inhaling the medicine, as depicted below:

The sales and market share figures provided by the applicant indicate that the inhaler 'SERETIDE EVOHALER', in the shape for which the mark is registered, has been constantly exposed to the relevant public over the years. However, when being exposed to such product, there is no evidence that the relevant public, in particular the patients, will perceive its shape and colour - that is to say, the EUTM - as an indication of trade origin.

Rather, as consumers are accustomed to recognising the commercial origin of the contested goods from the distinctive word element 'SERETIDE', it is unlikely, given the non-distinctive nature of the shape in question, that the average consumer of those goods, would perceive the shape of the inhaler itself upon which the word 'SERETIDE' is applied as an indication of commercial origin.

Therefore, consumers will instead rely only on the distinctive element 'SERETIDE', used by itself or in association with other words, in order to identify the trade origin of the products. Perhaps they associate the shape with 'SERETIDE' (and therefore with the EUTM proprietor), but nothing more than that. By contrast, the proprietor has not established that an average consumer, confronted with an inhaler in the form of the EUTM, and free of any other marks, would be likely to understand that this inhaler has a given commercial origin, namely that it is exclusive to the proprietor. Indeed, it is not clear that consumers have come to rely on the shape mark in order to distinguish the trade source of the goods at issue.

Secondly, the use of the colour purple on the promotional material, merchandising goods as well as the surveys related to the recognition of the single colour purple (Pantone code 2587C) as a badge of origin of the EUTM proprietor among general practitioners and pharmacists has low probative value in the present case. In fact, besides the fact that the surveys relate to only a few Member States, acquired distinctiveness must be demonstrated with respect to the sign as registered - that is a specific colour combination applied to the shape of an inhaler - in connection with the relevant goods. Use of the colour purple *per se* on advertising and merchandising material can be indicative of promotional activities aimed at increasing the recognition of the colour purple among the public but cannot constitute direct evidence of use of the EUTM as such.

Thirdly, the EUTM proprietor also utilises a rounded inhaler shape under its 'SERETIDE' brand (the so-called 'SERETIDE DISKUS'), which is clearly different to the contested mark, and in large parts of the materials, reference is made solely to 'SERETIDE' and it is therefore not clear to what extent this material actually regards use of the contested mark or such other shape (i.e. Annexes 2, 7, 10, 19, 44 and 45). In this respect, bearing in mind that the 'SERETIDE DISKUS' also comes in purple, it is also uncertain whether the above-mentioned material referring to the use of the colour purple *per se* is related to promoting the shape of the contested mark or the rounded inhaler shape.

Fourthly, as correctly put forward by the applicant, besides referring to only some of the relevant EU Member States, all the surveys were conducted only among healthcare professionals, namely general practitioners and pharmacists. The criteria for selecting the public interviewed must be assessed carefully. The sample must be indicative of the entire relevant public and must be selected randomly (29/01/13, T-25/11, Cortadora de cerámica, EU:T:2013:40, § 88). The only documents referring to the perception of general public are comments posted in internet blogs from Belgium, Denmark, France, Germany, the Netherlands and the UK. However, in the majority of the case, the colour purple is mentioned in association with the brand 'SERETIDE' and the fact that in some cases is linked to inhalers does not constitute solid evidence that the shape in question has acquired distinctiveness for the relevant goods.

Given all the above considerations, it must be held that the evidence submitted by the EUTM proprietor, especially considering the non-distinctive nature nature of the shape in question and the fact that it is constantly accompanied by distinctive word elements, does not make it possible to establish that the EUTM has been recognized as distinctive within the meaning of Article 7(3) EUTMR and Article 52(2) EUTMR.

The fact that the Court of Hamburg found that the EUTM proprietor's product 'VIANI' (the German version of the 'SERETIDE') has been found to possess *"an enhanced competitive uniqueness [...] based on the purple-coloured design of the product"* does not alter this conclusion. Indeed, as the German Court itself stated, its finding *"solely concerns the German market"*, while in the present proceedings the EUTM proprietor had to prove that the EUTM acquired distinctiveness through use in the EU territory.

Conclusion

In the light of the above, the Cancellation Division concludes that the application is totally successful and the European Union trade mark should be declared invalid for all the contested goods, namely:

Class 5: *Pharmaceutical preparations and substances for the prevention, treatment and/or alleviation of respiratory ailments.*

Class 10: *Inhalers, parts and components for all the aforesaid goods.*

COSTS

According to Article 85(1) EUTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party.

Since the EUTM proprietor is the losing party, it must bear the cancellation fee as well as the costs incurred by the applicant in the course of these proceedings.

According to Rule 94(3) and (6) EUTMIR and Rule 94(7)(d)(iii) EUTMIR, the costs to be paid to the applicant are the cancellation fee and the costs of representation, which are to be fixed on the basis of the maximum rate set therein.

The Cancellation Division

Robert MULAC	Karin KUHL	José Antonio GARRIDO OTAOLA

According to Article 59 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Cancellation Division on request. According to Rule 94(4) EUTMIR, such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Annex I A(33) EUTMR) has been paid.