Partial Use of Pharmaceutical Trademarks

Comparative Analysis of the Swiss and the EU Approaches

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I. Switzerland

In Switzerland, protection is granted to a trademark if it is used in connection with goods/services *for which it has been claimed* (art. 11(1) Swiss Trademark and Indication of Origin Protection Act (hereafter: TmPA))[1]. As a consequence of non-use, article 12(1) of TmPA provides that, if the trademark owner *has not used the mark in relation to the goods or services for which it is claimed for an uninterrupted period of five years following the expiry of the opposition period or the conclusion of opposition proceedings, he may no longer assert his right to the trade mark, unless there are proper reasons for non-use.*

According to the Swiss Trademark Guidelines of the Swiss Federal IP Institute (hereafter: IPI), in non-use cancellation proceedings within the meaning of art. 35a TmPA, the assessment of the likelihood of use in accordance with Art. 11 TmPA takes place according to the same criteria as those applied in opposition proceedings when the opponent must demonstrate the likelihood of use of the opposing mark following the invocation of non-use by the defendant[2].
The assessment of whether the mark has been used in connection with the goods/services for which protection was claimed is based on a two-step test:

A. Subsumption

As a first step, it should be determined whether the goods/services for which the mark is used are covered by the goods/services indicated in the trademark registration. In particular, general indications in the class headings of the Nice Classification cover only the goods that can actually be put into that specific general category[3].
Use for goods/services, even similar ones, which do not appear in the registered mark, cannot maintain the right to the mark[4]. In practice, the meaning of a particular term can be determined by reference to several sources (dictionaries, the Nice Classification, legal definitions (e.g. for pharmaceutical preparations[5]), the terminology used in a given economic sector, etc.).[6]

* The text for those footnotes was missing.
1 Swiss Trademark and Indication of Origin Protection Act (LPM) of August 28, 1992; RS 232.11.
2 Swiss Trademark Guidelines 2017, p. 241 (https://www.ige.ch/fr/prestations/services-en-ligne-et-centre-de-telechargement/marques.html); *see also:* Swiss Trademark Guidelines 2019 (draft), p. 304.
3 Swiss Trademark Guidelines 2017 (p. 219); *see also:* Swiss Trademark Guidelines 2019 (draft), p. 278.
4 Eric Meier, Art. 11 LPM, in *Commentaire Romand Propriété Intellectuelle,* De Werra/Gilliéron (ed.), 2013, p. 841 and opinions cited.
5 "Medicines: products of chemical or biological origin intended to act medically on the human or animal body, or presented as such, and used in particular to diagnose, prevent or treat diseases, injuries and handicaps; blood and blood products are considered medicines" (Art. 4(1)(a) Therapeutic Products Act (LPTh) of December 15, 2000; RS 812.21).
6 Eric Meier, *"L'usage de la marque dans la pratique de l'IPI",* IPI-LES CH seminar, Geneva, 23.4.2015; Eric Meier, Art. 11 LPM, in *Commentaire Romand Propriété Intellectuelle,* De Werra/Gilliéron (ed.), 2013, p. 841.

For instance, the legal definition of "food supplements"[7] makes it clear that they are different from medicines, as both have a different mode of action, function and active ingredients. Moreover, medicines are subject to a much stricter legal regulation. From an economic point of view, pharmaceutical preparations are unlikely to be part of the usual product range of a dietary supplement manufacturer. Therefore, food supplements do not fall under the general category of pharmaceutical preparations.[8]
Surprisingly, in 2014, the IPI considered that use of the opposition mark in Switzerland for "garlic dragees against atherosclerosis complaints" and "nutritional supplement for the protection of the eyes from age- and light-related damage" could be subsumed under the general category "pharmaceutical preparations".[9]
Another case law example of subsumption in Class 5 is when "enzyme preparations for the degradation of lactose" are deemed to fall under the general categories "pharmaceutical products, sanitary preparations, dietetic products for medical purposes".[10]

B. Partial Use

The second step consists in determining whether use of the mark with respect to certain goods/services indeed covered by the general category would validate protection of the mark for this entire category; in other words, one should determine the scope of the so-called "partial use".
A typical example for the pharmaceutical industry would be a mark registered for the general category of "pharmaceutical preparations" in Class 5, but used for pharmaceutical preparations for the treatment of a specific disease, especially as marketing authorizations are usually granted by health authorities for a particular therapeutic indication only.
In order not to unduly restrict the economic freedom of trademark owners[11], the Swiss Federal Administrative Court (hereafter: FAC) in several landmark cases resorts to the so-called "extended minimal solution", i.e. use with respect to specific goods/services may validate use of the mark for the whole general category under certain conditions, which are set forth below:

1. The general category is defined, not in general terms, but in a *narrow and precise way*[12] and does *not include essentially different sub-categories*.[13]
   In other words, protection will not be extended to a wide range of products or services, or products or services that are inherently different. Consequently, the scope of protection conferred to the mark cannot extend to all commercial variations of similar goods or services, but only to goods or services which are sufficiently differentiated to constitute consistent categories or subcategories of a given product or service. To determine whether goods or services belong to the same category or subcategory one should determine whether, from an objective point of view, they have the same properties, purpose and indented use. Moreover, it should not be possible to further divide these categories or sub-categories without it being in an arbitrary manner.[14]
   In particular, the general category "pharmaceutical preparations" is relatively broad and includes various sub-categories.[15] On the contrary, the specification e.g. "pharmaceutical products and medicines in the field of urology" does not include further sub-categories.[16]
   In other words, when a mark is registered for *medicines intended for treating a specific therapeutic condition or part of a human body,* such a formulation would generally be considered as not containing further sub-categories.
2. The actual use is *prototypical* for the general category and makes the future use of other goods/services falling under this category *presumed and expected,* in the eyes of consumers.[17]
3. The goods falling under the general category belong to the *usual assortment* of a *typical* manufacturer of the branch.[18]

7 "Food supplements are foods whose purpose is to supplement the normal diet. They constitute a concentrated source of vitamins, minerals or other substances having a nutritional or physiological effect, alone or in combination, marketed in the form of doses" (Art. 1 Ordinance of the DFI on food supplements (OCAI) of December 16, 2016; RS 817.022.14).
8 FT 4A_444/2013, sic! 2014, 367, consid. 5.4.2 "G5" (5.2.2014).
9 IPI decision in the opposition proceedings No. 13019 – ALLVITA/ALVITAL, p. 6 (15.10.2014).
10 IPI decision in the opposition proceedings No. 13264 – LACDIGEST/LACTEASE, p. 5 (22.9.2014).
11 Cf. FAC B-6249/2014, consid. 4.6 – Campagnolo (fig.)/F.LLI Campagnolo (fig.) (25.7.2016); FAC B-5871/2011, consid. 2.3 – GADOVIST/GADOGITA (4.3.2013).
12 FAC B-5871/2011, consid. 2.3 – GADOVIST/GADOGITA (4.3.2013).
13 FAC F B-2678/2012, consid. 6.2.4. – OMIX/ONYX PHARMACEUTICALS (7.3.2013).
14 Swiss Trademark Guidelines 2017, p. 220; *see also:* Swiss Trademark Guidelines 2019 (draft), p. 280. Both versions of the Guidelines refer by way of analogy to the Judgment of the EU General Court T-126/03, ALADIN, para. 45–46 (14.7.2005).
15 FAC B-5871/2011, consid. 2.5 – GADOVIST/GADOGITA (4.3.2013); FAC B-6375/2011, consid. 4.8 – FUCIDIN/FUSIDERM (12.8.2013).
16 FAC B-2678/2012, consid. 6.2.4 – OMIX/ONYX PHARMACEUTICALS (7.3.2013).
17 FAC B-5871/2011, consid. 2.3 – GADOVIST/GADOGITA (4.3.2013).
18 FAC B-5543/2012, consid. 7.1.6 – six (fig.)/SIXX, sixx (fig.) (12.6.2013); Cf. FAC 5871/2011, consid. 2.3 – GADOVIST/GADOGITA (4.3.2013).

How has the FAC applied the above-mentioned conditions 2 and 3 in practice?

Goods covered by the trademark registration:	Goods for which the mark is used:	Case law considerations:	Goods for which valid use is recognized:
Pharmaceutical products	Solution for the treatment of sub foveal ocular choroidal neovascularization on medical or veterinary prescriptions	Use is not typical for the entire general category. However, one should take into account an expected future use and obvious minimum future business development.	Pharmaceutical preparations for the treatment of eye diseases[19]
Pharmaceutical products	Antibiotics for the treatment of bacterious skin infections – dermatological products, i.e. drugs for the treatment of skin, available on prescription only	Average consumers can acquire those goods only after receiving advice from a medical specialist and with a prescription. Therefore, the relevant consumer circles would be medical specialists, which include dermatologists.[20] Within the general category "pharmaceutical products", the goods for which the mark is used are typical only for prescription drugs and cannot suggest future use of the mark with respect to all types of dermatological products or a broader category of pharmaceutical products. Thus, the relevant consumer circles are unlikely to expect that the mark be used in future for dermatological products other than prescription-only drugs.[21]	Drugs for the treatment of skin, available on prescription
Pharmaceutical products and medicines in the field of urology	Drug based on tamsulosine and marketed in the form of tablets, intended for the treatment of functional symptoms of benign prostatic hyperplasia	The use is typical of the general category claimed, which does not include further sub-categories.	Drugs in the field of urology[22]
Pharmaceutical preparations and substances	Anti-asthmatics available under prescription only	"Pharmaceutical preparations and substances" is a very broad generic wording, which includes numerous goods of different nature and composition. Pharmaceutical preparations are used to treat mild and severe, one-time and chronic, mental and physical ailments and diseases, and to diagnose or to control physiological functions. Therefore, use for "prescription anti-asthmatics" cannot be viewed as either prototypical or belonging to the usual assortment of a typical manufacturer of the branch. Although anti-asthmatics are not commonly typical of all types of pharmaceuticals, they can still be produced by any pharmaceutical company.[23]	"Pharmaceutical preparations and substances for the treatment of diseases of the lungs and respiratory tract", taking into account an expected future development[24]
Pharmaceutical products, as well as chemical products for sanitary use	Contrast agents	Contrast agents are not typical of "chemical products for sanitary use" as they have a diagnostic and not a sanitary function. For the relatively broad category of "pharmaceutical products", contrast agents, i.e. substances used to enhance the contrast of structures or fluids within the body in medical imaging, are not typical as they differ from therapeutic products in the intended purpose and use. Thus, no future use for the whole general category of "pharmaceutical products" can be expected. Even if contrast agents were typical for the category of diagnostic medical preparations, no future use can be expected even for other types of diagnostic products, such as pregnancy tests, blood glucose test strips or eye drops for retinal examination.	Contrast agents[25]

Based on the FAC case law, one can reach the following conclusion:

Goods covered by the trademark registration:	Goods for which the mark is used:	Goods for which valid use is likely to be recognized:
Pharmaceutical products, i.e. the *general category*	Goods intended for the treatment of a very specific condition – e.g. solution for the treatment of cataract/antibiotics for the treatment of bacterious skin infections/ anti-asthmatics	Pharmaceutical preparations for the treatment of eye diseases/the treatment of skin/the treatment of diseases of the lungs and respiratory tract. In other words, one should determine a relevant "umbrella" subcategory for the goods for which the mark is used.
Pharmaceutical products limited to a *sub-category*, e.g. medicines in the field of urology	Goods intended for the treatment of a very specific condition – e.g. drug based intended for the treatment of functional symptoms of benign prostatic hyperplasia	The whole sub-category – e.g. medicines in the field of urology

19 FAC B-5119/2014, consid. 3.2 – VISUDYNE/VIVADINE (17. 3. 2016).
20 FAC B-6375/2011, consid. 4.7 – FUCIDIN/FUSIDERM (12. 8. 2013).
21 FAC B-6375/2011, consid. 4.7 – FUCIDIN/FUSIDERM (12. 8. 2013).
22 FAC B-2678/2012, consid. 6.2.4 – OMIX/ONYX PHARMACEUTICALS (7. 3. 2013).
23 FAC B-6375/2011, consid. 4.8 – FUCIDIN/FUSIDERM (12. 8. 2013).
24 FAC B-2636/2015, consid. 4.3 – AXOTIDE/ACOFIDE (29. 3. 2016).
25 FAC B-5871/2011, consid. 2.5 – GADOVIST/GADOGITA (4. 3. 2013).

Interestingly, up to 2017, the approach of the IPI and the FAC differed with respect to this issue. Traditionally, the IPI resorted to a "minimal solution" that was more favorable to the defendant in the opposition proceedings – if the opposing mark was used only for a part of the registered goods/services, it was protected only to that extent. The IPI was of the view that the interests of the opponent, who had to demonstrate use of the mark, were anyway taken into account at the stage of examination of the similarity of goods in the sense that the similarity assessment would take into consideration not only the defendant's goods identical to those for which the use was evidenced, but would also extend to similar ones.[26]
By contrast, the approach of the FAC (minimal *extended* solution) put the accent on the interests of the opponent, while the approach of the IPI at that time ensured the simplicity, foreseeability and legal security of the decisions on non-use.[27]
An example of application of the IPI's previous approach can be the opposition proceedings when the opposing mark was registered for "pharmaceutical preparations" but used for "vaginal tablets for the treatment of vaginal discharge and restoration of the physiological vaginal flora". The mark was maintained for those specific goods only.[28]
In 2017, however, IPI changed its approach and now also applies the *"minimal extended solution"*.[29]
In practice, protection cannot be extended to all similar products or services within the meaning of Art. 3(1)(b and c) TmPA, in particular to products which are considered as emanating from similar companies with regard to their usual places of manufacture or distribution.[30]
Aligned with the case law of the FAC, the current IPI's approach appears to correspond to the minimum extended solution of German law[31], which is essentially equivalent to the approach adopted by the EUIPO and the EU Court.[32] Let us review the latter and consider how the same is compatible with the Swiss practice and whether pharmaceutical trademark owners may expect similar decisions on partial trademark use in Switzerland and in the EU.

II. European Union

Article 18 EUTMR provides that, in order to be enforceable, the mark must be used in connection with the goods or services for which it is registered.
For instance, according to the third sentence of Article 47(2) EUTMR, if the earlier trade mark has been used only for part of the goods or services for which it is registered, it will, for the purposes of the examination of the opposition, be deemed to be registered *for that part of the goods or services only*. Similar provisions on revocation for non-use are indicated in Article 58 EUTMR.

A. Comparison Between the Goods/Services for Which the Mark Is Used and the Registered Specification of Goods/Services (Subsumption)

At EU level, one should carefully assess whether the specific goods and services for which the mark has been used fall within the general category of the registered goods and services.[33] Whereas, in general, classification does not serve more than administrative purposes, it is relevant, in order to assess the nature of the use, to establish whether the goods for which a mark has been used fall under the general indication for which the mark is registered or under another general indication of that same class, which is not covered by the registered specification.[34] In the latter case, the mark will not be considered as having been used for the registered goods or services.[35]
In Class 5, the class heading is *"pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides"* and each of those items is interpreted as a "general indication".
For instance, the meaning of pharmaceutical products does not cover food supplements, not even those adapted for medical use. Although both goods serve to improve a patient's health, pharmaceutical products have a different function from food supplements; the former are for treating a disease or illness, the latter for providing the body with something it needs or lacks, through nutrition.[36] Furthermore, the fact that food supplements are available in pharmacies does not mean that they cannot be available in other

26 Swiss Trademark Guidelines 2014, p. 172 (https://www.ige.ch/index.php?id=1003&L=1).
27 Eric Rojas, "Les effets de l'usage partiel de la marque en procédures d'opposition et de radiation: Pratiques divergentes! Conséquences différentes?", IPI-LES CH seminar, Geneva, 23.4.2015
28 IPI decision in the opposition proceedings No. 12623 – GYNOFLOR/GYNO-CANESFLOR, p. 6 (5.12.2013).
29 Swiss Trademark Guidelines 2017, p. 219; *see also:* Swiss Trademark Guidelines 2019 (draft), p. 279.
30 Swiss Trademark Guidelines 2017, p. 220; *see also:* Swiss Trademark Guidelines 2019 (draft), p. 279.
31 FAC B-6249/2014, consid. 4.6 – Campagnolo (fig.)/F.LLI Campagnolo (fig.) (25.7.2016).
32 Swiss Trademark Guidelines 2017, p 219; *see also:* Swiss Trademark Guidelines 2019 (draft), p. 279.
33 EUTM Guidelines for Examination in the EUIPO Office, Part C, Opposition, Section 6, p. 50 (version 1.10.2017).
34 EUIPO Decision on Opposition No. B 2 577 883, PINOVITAL/PINOVINOL, p. 6 (21.11.2016).
35 EUTM Guidelines for Examination in the EUIPO Office, Part C, Opposition, Section 6, p. 52 (version 1.10.2017).
36 EUIPO Decision on Opposition No B 2 577 883, PINOVITAL/PINOVINOL, p. 6 (21.11.2016); *see also:* EUIPO Decision on Opposition No B 2 872 136, ORTHOCOMPLEX/OSTEOCOMPLEX, p. 5 (19.6.2018)

sales outlets. Anyhow, sale, even exclusive, of certain goods in pharmacies does not mean that they are necessarily pharmaceutical preparations or medicinal products.[37] Thus, a food supplement is not a good included in the broad *pharmaceutical products* category. On the other hand, however, pharmaceutical products include e.g. skin care creams for medical purposes based on clay.[38]

B. Partial Use

As a general rule, a mark which is registered under *all* or *part* of the general indications in a given Class heading and used for several goods/services in the same class falling under one of these general indications will be considered as having been used for that *specific general indication*.[39] At the same time, some general indications of goods/services can include various *sub-categories* and the question arising in this context is the extent of protection granted.
In that respect, the following scenarios can be distinguished:

1. Mark Registered for a Broad Category of Goods/Services

In the Aladin case, the General Court held:

> if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the subcategory or subcategories to which the goods or services for which the trade mark has actually been used belong.[40]

Thus, protection is recognized only for the *subcategory or subcategories* to which the used goods or services belong if:

a) a trade mark has been registered for a *category* of goods or services:
   - which is sufficiently *broad* to cover a number of subcategories other than in an arbitrary manner;
   - those subcategories can be perceived as being *independent* from each other;

   and
b) it can be shown that the mark has been genuinely used in relation to only *part of the initial broad specification*.[41]

In practical terms, it is not necessary for the trademark owner to file evidence of all the commercial variations of similar goods or services but merely of those goods or services, which are sufficiently distinct to constitute coherent categories or subcategories.[42]

2. Mark Registered for Precisely Specified Goods/Services

On the other hand, proof of genuine use of the mark for some of the specific goods or services maintains the rights in *the entire general category* if:

1. a trade mark has been registered for goods or services specified in a *relatively precise manner;* so that
2. it is *not possible,* without any artificiality, *to make any significant subdivisions* within the category concerned.[43]

The EUIPO decision should clearly indicate in which cases making subdivisions is considered impossible and, if necessary, specify why.[44]
In order to define adequate subcategories of general indications, the *purpose or intended use* of the product or service in question is of fundamental importance, as consumers take into account these considerations before making a purchase.[45]
According to the EU case law, "pharmaceutical preparations" are considered as a sufficiently broad category for it to be possible to identify various subcategories.[46] In particular, it was found that the concept of pharmaceutical preparation covers goods, which are sufficiently different in their intended purpose and end consumers, according to their specific therapeutic indications, and in their channels of distribution, depending on whether they are available on medical prescription or over the counter; therefore, it is possible to identify within it various sub-categories.[47]
In a number of decisions, the EU Court had to define adequate subcategories for pharmaceutical preparations in Class 5 and held that *the purpose and intended use* of a therapeutic preparation are expressed in its therapeutic indication.[48]

37 Judgment of the General Court T-802/16, FEMIBION, para. 38 (17.11.2017).
38 EUIPO Decision of the Fifth Board of Appeal No. R 2106/2016-5 in Opposition proceedings No. B 2 464 124, argiléa vs. ARGILA AMAZONIA (Fig.), p. 3 (11.7.2017).
39 EUTM Guidelines for Examination in the EUIPO Office, Part C, Opposition, Section 6, p. 52 (version 1.10.2017).
40 Judgments of the General Court T-126/03, ALADIN, para. 45 (14.7.2005); T256/04, RESPICUR, para. 23 (13.2.2007).
41 EUTM Guidelines for Examination in the Office, Part C, Opposition, Section 6, p. 53 (version 1.10.2017).
42 Judgment of the General Court T-126/03, ALADIN, para. 46 (14.7.2005).
43 Judgments of the General Court T-126/03, ALADIN, para. 45 (14.7.2005); T256/04, RESPICUR, para. 23 (13.2.2007).
44 EUTM Guidelines for Examination in the Office, Part C, Opposition, Section 6, p. 54 (version 1.10.2017).
45 Judgments of the General Court T-256/04, RESPICUR, para. 29–30 (13.2.2007); T-493/07, FAMOXIN, para. 37 (23.9.2009).
46 Judgments of the General Court T-256/04, RESPICUR, para. 26 (13.2.2007); T-483/04, GALZIN, para. 28 (17.10.2006).
47 Judgments of the General Court T-493/07, T-26/08 & T-27/08, FAMOXIN, para. 35 (23.9.2009); T-487/08, KREMEZIN, para. 58 (16.6.2010).
48 Judgments of the General Court T-256/04, RESPICUR, para. 29–30 (13.2.2007); T-493/07, T-26/08 & T-27/08, FAMOXIN, para. 36–38 (23.9.2009); T-487/08, KREMEZIN, para. 59 (16.6.2010).

In view of the above, the *therapeutic indication* is the key element for defining the relevant subcategory of pharmaceutical products. Other criteria (such as dosage form, active ingredients, whether it is sold on prescription or over the counter) have been found irrelevant in this regard.[49] In fact, a given medical condition can often be treated using a number of types of medication with different dosage forms and containing different active ingredients, some of which are available over-the-counter whilst others are available only on prescription.[50]

Applying the above criterion, the EU Court and the EUIPO have found the following subcategories adequate for the Class 5 goods:

Goods covered by the trademark registration:	Goods for which the mark is used:	Goods (i.e. relevant subcategory) for which valid use is likely to be recognized
Pharmaceutical preparation (products)/drugs/ medicines	antitussive medicinal product	antitussive medicines[51]
	diuretic pharmaceutical preparations	medicines, namely diuretic pharmaceutical preparations[52]
	immunosuppressant used for the treatment of various autoimmune diseases/disorders as well as for preventing immune reactions against transplanted organs	medicines, namely immunosuppressants[53]
	vaccines	vaccines[54]
	dermatological preparations for topical use and antiseptics	dermatological preparations for topical use and antiseptics[55]
	pharmaceutical product for sinusitis	pharmaceutical products for sinusitis[56]
Pharmaceutical preparation (products)/drugs/ medicines	pharmaceutical preparations for the symptomatic treatment of pain, temperature and inflammation	pharmaceutical preparations for the symptomatic treatment of pain, temperature and inflammation[57]
	gastrointestinal medicine	pharmaceutical drugs and products for the treatment of gastrointestinal disorders[58]
	powder-spray preparation for foot perspiration and painful feet	pharmaceutical and sanitary preparations for foot care and in particular foot perspiration[59]
	anti-inflammatory analgesic medicines	anti-inflammatory analgesic medicines[60]
	antipyretics	antipyretics[61]
	multi-dose dry powder inhalers containing corticoids, available only on prescription	preparations for respiratory illnesses[62]
	pharmaceutical preparations with digoxin for human use for the treatment of heart problems	pharmaceutical preparations for cardiovascular illnesses[63]
	sterile solution of adenosine for use in the treatment of a specific heart condition, being for intravenous administration in hospitals	pharmaceutical preparations for the treatment of the heart[64]

49 EUTM Guidelines for Examination in the Office, Part C, Opposition, Section 6, p. 57 (version 1.10.2017).

50 Judgment of the General Court T-256/04, RESPICUR, para. 31 (13.2.2007).

51 Judgment of the General Court T-258/08, DIACOL, para. 36 (24.1.2017).

52 EUIPO Decision on Opposition No B 2 593 708, Lasix/Dolasix (Fig.), p. 5 (5.6.2017).

53 EUIPO Decision on Opposition No B 2 616 285, AZAIMUN/AIMMUNE, p. 6 (27.2.2017).

54 EUIPO Decision on Cancellation No 12175 C, GARDASIL, p. 5 (8.12.2016). Taking into account that vaccines are specific types of substances administered for the prevention, amelioration or treatment of infectious diseases and the fact that there are combination vaccines that combine protection against two or more diseases, the EUIPO was of the opinion that it was too formalistic to define coherent subdivisions within the term "vaccines".

55 EUIPO Decision on Opposition No B 2 344 375 APAISYL/Apaisac Biorga (Fig.), p. 6 (13.4.2017) (a subsequent appeal does not concern the proof of use).

56 EUIPO Decision of the Board of Appeal No. 908/2016-4 in Opposition Proceedings No B 2 520 966, NASOLAXTEN/NASODREN, p. 5 (28.8.2017).

57 EUIPO Decision on Opposition No B 2 649 385, SPASMIL/BABYSPASMYL, p. 7 (24.8.2018).

58 EUIPO Decision of the Board of Appeal No. R 669/2017-5 in Opposition Proceedings No B 2 580 192, Colina (fig.)/KOLINEB, p. 13 (6.12.2017); *see also:* EUIPO Decision on Cancellation No 11 096 C, PENTASA, p. 13 (25.5.2018).

59 EUIPO Decision on Cancellation No 10 891 C, SPREEEMYK (Fig.), p. 5 (18.7.2017).

60 EUIPO Decision on Opposition No B 2 732 801, DOLMEN/DOLMEN, p. 5 (26.3.2018).

61 EUIPO Decision on Opposition No B 2 619 347, APIRETAL/apiheal (Fig.), p. 14 (29.6.2017).

62 Judgments of the General Court T-256/04, RESPICUR, para. 35 (13.2.2007). The Court in this case also held that "multi-dose dry powder inhalers containing corticoids, available only on prescription" were not appropriate as a sub-category as this formulation is based on form, the active ingredient and the obligation to obtain a doctor's prescription (para. 31); "glucocorticoids" were not considered appropriate either as the such a sub-division is based on the active ingredient (para. 34). *See also:* EUIPO Decision of the Board of Appeal No. R 340/2016-1 in Opposition Proceedings No B 2 088 790, DUOVENT/DUOVA, pp. 4–5 (31.1.2016). The Board of Appeal held that "pharmaceutical preparations for inhalers" were not an appropriate sub-category as such an identification is based on the method of administration of the pharmaceutical preparation, namely inhalation, and not on the therapeutic indication, i.e. the disease treated.

63 Judgment of the General Court T-493/07, T-26/08 & T-27/08, FAMOXIN, para. 43 (23.9.2009); this point is not contested in the judicial review by the CJEU of 09-07-2010, C-461/09P.

64 Judgment of the General Court T-487/08, KREMEZIN, para. 61 (16.6.2010).

Goods covered by the trademark registration:	Goods for which the mark is used:	Goods (i.e. relevant subcategory) for which valid use is likely to be recognized
Pharmaceutical preparation (products)/drugs/ medicines	medicines for preventing the formation of blood clots	pharmaceutical preparations for the treatment of thrombosis[65]
	products for removal of warts and verrucae, nail fungus as well as corns and persistent callus	pharmaceutical preparations for dermatological use[66]
	dermatological preparations for topical use and antiseptics	dermatological preparations for topical use and antiseptics[67]
	eye drops	ophthalmic pharmaceutical preparations[68]
	ascorbic acid	vitamin preparations[69]
	medicines for the treatment of asthma and seasonal allergies	medicinal and pharmaceutical preparations and substances for the treatment of diseases of the respiratory system[70]
	pharmaceutical preparations for the treatment of breast cancer	pharmaceutical preparations for the treatment of breast cancer[71]
	psycho-analeptics, namely antidepressants	pharmaceutical preparations for the treatment of the central nervous system[72]

Goods covered by the trademark registration:	Goods for which the mark is used:	Goods (i.e. relevant subcategory) for which valid use is likely to be recognized
Pharmaceutical preparation (products)/drugs/ medicines	hormonal preparation for treating nocturnal enuresis, diabetes insipidus and polyuria	pharmaceutical preparations consisting of preparations for treating nocturnal enuresis, diabetes insipidus and polyuria syndrome and hormonal preparations for treating nocturnal enuresis, diabetes insipidus and polyuria syndrome[73]
	gels for the transmission of ultrasound	gels for the transmission of ultrasound[74]
	bromazepam-based antianxiety agents	medicines for the central nervous system, pharmaceutical products for the central nervous system[75]
	capsules for relieving hot flushes during the menopause and gel for vaginal dryness treatment	capsules for relieving hot flushes during the menopause and gel for vaginal dryness treatment[76]
pharmaceuticals for veterinary application/veterinary preparations	vaccine for pigeons against salmonellosis	veterinary vaccines against salmonellosis[77]
	veterinary preparations mainly based on natural ingredients and advertised as natural products	homeopathic veterinary preparations[78]
	vaccine for cattle immunization against mastitis	vaccine for cattle immunization against mastitis[79]

As one can see, in the above examples, the main criterion used for defining an adequate sub-category is indeed the therapeutic indication. Surprisingly and contrary to what is stipulated in the EUTM Guidelines for Examination, in a number of decisions, the relevant sub-category appears to have been determined based on the active substance, e.g.: skin care creams for medical purposes based on clay[80], iron-

65 EUIPO Decision on Opposition No B 2 605 809, Lovenox/Lovexok, p. 5 (23.5.2017).
66 EUIPO Decision on Opposition No B 2 404 344, WORTIE/WARTNER, p. 6 (16.8.2017).
67 EUIPO Decision on Opposition No B 2 344 375, APAISYL/APAISAC BIORGA (Fig.), p. 6 (13.4.2017).
68 EUIPO Decision of the Board of Appeal No. R 295/2016-2 in Opposition Proceedings No B 2 225 459, VISADRON/VISUDROP, pp. 20–21 (7.4.2017). The sub-category of "eye drops" was not considered appropriate by the Board of Appeal as it refers to the dosage form of the (ophthalmic) pharmaceutical preparation, i.e. to an ocular route to administer such drugs. Moreover, 'eye drops' sometimes do not have medication in them and are only lubricating and tear replacing solutions (pp. 20–21).
69 EUIPO Decision on Opposition No B 2 217 282, ASCORVIT/ASCORAM, p. 6 (4.4.2017).
70 EUIPO Decision of the Board of Appeal No. R 367/2016-5 in Cancellation Proceedings No 10 409 C, SINGULAIR, p. 11 (6.3.2017).
71 Judgment of the General Court T-238/15, Zimara, para. 46–50 (21.9.2017).
72 EUIPO Decision of the Board of Appeal No. R 310/2016-1 in Opposition Proceedings No B 2 381 039, ADOXA/AYOXXA, p. 5 (14.2.2017). The Board of Appeal also indicated that this sub-category was appropriate even though apparently it was based on an anatomic criterion, i.e. the part of the human body, which is targeted by the preparation, namely the central nervous system, rather than the therapeutic indication stricto sensu. On the contrary, the specifications "pharmaceutical preparations for the treatment of depression" or "pharmaceutical preparations for the treatment of mental disorders" were considered too narrow to constitute a sub-category.
73 EUIPO Decision on Opposition No B 2 437 922, NOCUTIL/NOCUVANT, p. 6 (27.1.2017).
74 EUIPO Decision on Opposition No B 2 556 911, STARVET/STARVIT ACRYLIC TEETH (Fig.), p. 6 (9.1.2017).
75 EUIPO Decision on Opposition No B 2 506 981, sedam/AngioSedam, p. 8 (9.1.2017).
76 EUIPO Decision on Opposition No. B 2 377 482, MALENA/MADENA, p. 7 (17.9.2018).
77 EUIPO Decision of the Board of Appeal No. R 312/2015-5 in Opposition Proceedings No B 1 905 705, Zoosal/ZOTAL, p. 8 (21.4.2016).
78 EUIPO Decision on Opposition No B 2 177 809, PlantaVet/PlanVet, p. 7 (9.6.2017).
79 EUIPO Decision on Opposition No B 2 609 389, STARTVAC/ISTARVAC-GBM, p. 4 (26.4.2017).
80 EUIPO Decision of the Board of Appeal No. R 2106/2016-5 in Opposition proceedings No. B 2 464 124, argiléa/ARGILA AMAZONIA (Fig.), p. 3 (11.7.2017).

based pharmaceutical products[81], pharmaceutical preparations, namely valerian[82], calcium-based pharmaceutical preparations[83].
Interestingly, in a cancellation case, the EUIPO maintained the mark for the general registered category of pharmaceutical preparations. In fact, the trademark owner provided evidence of use with respect to a sufficiently broad range of pharmaceutical preparations with very different therapeutic indications (e.g. organ transplantation, autoimmune diseases, prevention of gout, deep vein thrombosis, heart conditions, menopause, birth control, osteoporosis, treatment of certain types of cancer or preparation for surgery). In view of the broad spectrum of those pharmaceutical preparations, and also taking into account that the trademark owner cannot be required to prove use of the mark for all conceivable subcategories within this broad category, and its legitimate interest in being able in the future to extend its range of goods within the limits of this broad category, use was considered proved for pharmaceutical preparations as a whole, without establishing specific subcategories.[84]

III. Concluding Remark

In practice, it appears that the solutions adopted in Switzerland and in the EU would lead to similar decisions. The IPI in its Swiss Trademark Guidelines has incorporated a reference to the EU case law regarding the way to determine whether goods or services belong to the same category or subcategory, i.e. one should find out whether they have the same properties, purpose and indented use.[85] So far, however, there is no clear indication in the Swiss case law regarding how to determine properties, purpose and indented use for pharmaceutical goods in order to define adequate subcategories. Contrary to the EU approach, the Swiss practice has taken into consideration such factors as availability on prescription or as an OTC drug. However, in our opinion, the EU criterion based on the "therapeutic indication" is probably more appropriate.

81 EUIPO Decision on Opposition No B 2 539 677, profer (fig.)/ ProFem (fig.), p. 8 (17.7.2018).
82 EUIPO Decision on Opposition No B 2 805 722, Bisabelin/SABELIN, p. 10 (27.7.2018).
83 Judgment of the General Court T-483/04, GALZIN, para. 28 (17.10.2006).
84 EUIPO Decision on Cancellation No 11966 C, Aspen, p. 7 (20.12.2017).
85 See above footnote no. 14.