O/0722/23

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. UK00003676358
BY MAMMA ROMA LTD
TO REGISTER:

Vi-Q

AS A TRADE MARK
IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 431165
BY THE PROCTOR & GAMBLE COMPANY

BACKGROUND AND PLEADINGS

1. On 2 August 2021, Mamma Roma Ltd ("the applicant") applied to register the trade mark shown on the cover of this decision ("the application") in the UK for the following goods:

> **Class 5:** *Pharmaceutical and medicinal preparations; pharmaceutical and medicinal preparations for the treatment of hair; vitamin and vitamin preparations; vitamin and nutritional supplements in tablets, capsule, and powdered; nutritional supplements; health food supplements; nutritional and vitamin supplements and preparations for animals.*

2. The application was published for opposition purposes on 19 November 2021 and it was opposed by The Proctor & Gamble Company ("the opponent") on 21 February 2022. The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). The opponent relies on the following marks in relation to both grounds of opposition:

> VICKS
>
> UK registration no UK1276160
> Filing date 23 August 1986; Date of entry in register 1988
> Relying on the following goods:
>
> **Class 5:** *Pharmaceutical preparations and substances; all for humans and included in Class 5.*
> ("the opponent's first earlier mark")

> VICKS
>
> UK registration no UK 857248
> Filing date 29 November 1963; date of entry in register 29 November 1963
> Relying on all of its goods, namely:

Class 5: *Salves (medicated) for human and veterinary use; pharmaceutical preparation for the treatment of colds and respiratory ailments; and medicated lozengers.*
("the opponent's second earlier mark")

VICKS

UK registration no UK900301473[1]
Filing date 27 June 1996; date of entry in register 1999
Relying on some of its goods, namely:

Class 5: *Pharmaceutical, veterinary and sanitary substances, infants' and invalids' foods; plasters, material for bandaging, material for stopping teeth, dental wax; disinfectants, preparations for killing weeds and destroying vermin, medicines, chemical products for curative purposes and health care, pharmaceutical drugs, plasters, materials for bandaging, preparations for the destruction of animals and plants, disinfectants.*
("the opponent's third earlier mark")

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

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

5. The applicant filed a counterstatement denying the claims made.

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EUTM. As a result of the opponent having an EUTM being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law and retains its original filing date.

6. The opponent is represented by D Young & Co LLP and the applicant represents itself. Only the opponent filed evidence. The applicant filed submissions. No hearing was requested. Only the opponent filed submissions in lieu of a hearing. The decision is taken following careful consideration of the papers.

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

EVIDENCE

8. As above, the opponent filed evidence. The opponent's evidence in chief came in the form of the witness statement of Mr Jay A Krebs dated 20 October 2022. Mr Krebs is the Assistant Secretary of The Proctor & Gamble Company, a position he has held since 2017. Mr Krebs' evidence is accompanied by 15 exhibits, labelled PG 1 to PG 15.

9. I do not intend to summarise the evidence and submissions at this stage but will refer to the evidence and submissions where necessary throughout this decision.

DECISION

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

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

> "(2) A trade mark shall not be registered if because-
>
> (a) …
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

11. Section 5A of the Act is as follows:

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

12. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"(6)(1) In this Act an "earlier trade mark" means –

(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

13. Given their filing dates, the opponent's marks qualify as earlier trade marks under the above provisions. The opponent's marks completed their registration process more than five years before the application date of the application and, therefore, should be subject to proof of use conditions. However, the applicant did not request that the opponent provide proof of use, therefore, the opponent can rely on all the goods for which its marks are registered.

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

Matratzen Concord GmbH v OHIM, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

THE COMPARISON OF THE GOODS

15. The goods to be compared are as follows:

<table>
<tr><th>The applicant's goods</th><th>The opponent's goods</th></tr>
<tr><td rowspan="2">Class 5

Pharmaceutical and medicinal preparations; pharmaceutical and medicinal preparations for the treatment of hair; vitamin and vitamin preparations; vitamin and nutritional supplements in tablets, capsule, and powdered; nutritional supplements; health food supplements; nutritional and vitamin supplements and preparations for animals.</td><td>First earlier mark

Class 5

Pharmaceutical preparations and substances; all for humans and included in Class 5.</td></tr>
<tr><td>Second earlier mark

Class 5

Salves (medicated) for human and veterinary use; pharmaceutical preparation for the treatment of colds and respiratory ailments; and medicated lozengers.</td></tr>
</table>

	Third earlier mark Class 5 *Pharmaceutical, veterinary and sanitary substances, infants' and invalids' foods; plasters, material for bandaging, material for stopping teeth, dental wax; disinfectants, preparations for killing weeds and destroying vermin, medicines, chemical products for curative purposes and health care, pharmaceutical drugs, plasters, materials for bandaging, preparations for the destruction of animals and plants, disinfectants.*

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

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

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

> (a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

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

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

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

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

19. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court ("GC") stated:

> "29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark"

20. I also note that, in relation to the task of comparing the parties' goods, Mr Geoffrey Hobbs Q.C., as the Appointed Person, in *Separode* Trade Mark, BL O/399/10 confirmed (at paragraph 5) that:

> "The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."

21. The opponent made the following submissions in relation to the comparison of the goods:

> "It is clear that the following terms contained in the application; "*Pharmaceutical and medicinal preparations; pharmaceutical and medicinal preparations for the treatment of hair"* are **identical** to "*Pharmaceutical preparations and substances; all for humans and included in Class 5", "pharmaceutical preparations for the treatment of colds and respiratory ailments; and medicated lozengers", "Pharmaceutical, veterinary and sanitary substances…"* and *"…preparations for … medicines, chemical products for curative purposes and health care, pharmaceutical drugs, plasters, materials for bandaging*…" (original emphasis)

22. The opponent makes reference to the reasoning given by the Hearing Officer in decision O-264-13 to support its submissions in relation to the remainder of the opponent's goods. I have taken this decision into consideration but I am not bound by the decision a previous Hearing Officer has reached in my assessment of the goods. In relation to the remaining services, the opponent states the following:

> "In line with this decision, the Opponent submits that the following terms contained in the Application, *"vitamin and vitamin preparations; vitamin and nutritional supplements in tablets, capsule, and powdered; nutritional*

supplements; health food supplements; nutritional and vitamin supplements and preparations for animals" are **identical or at least highly similar to** *"Pharmaceutical preparations and substances; all for humans and included in Class 5", "pharmaceutical preparations for the treatment of colds and respiratory ailments; and medicated lozengers", "Pharmaceutical, veterinary and sanitary substances…"* and *"…preparations for … medicines, chemical products for curative purposes and health care, pharmaceutical drugs, plasters, materials for bandaging…"* covered by the VICKS registrations.

Moreover, the Oppenent submits that *"vitamin and vitamin preparations; vitamin and nutritional supplements in tablets, capsule, and powdered; nutritional supplements; health food supplements; nutritional and vitamin supplements and preparations for animals""* **are highly simar and/or complementary to** "*infants' and invalids' foods"* covered by the VICKS registrations." (original emphasis)

23. I note that within its counterstatement and submissions, the applicant stated that there are no vitamin products that are provided by the opponent and that it is unfair of the opponent to dispute the goods in the application on this basis. However, despite the opponent not being registered specifically for the term vitamins, this does not automatically indicate that there is no similarity between the goods. An analysis must be conducted, applying the law outlined above, to assess whether there is any similarity or identity between the applicant's and the opponent's goods.

First earlier mark

24. It is my understanding that medicinal preparations, being preparations that have healing benefits, are the same as pharmaceutical goods as they are interchangeable terms. This is on the basis that, to my understanding, medicine is often pharmaceutical. Taking this into account, I agree with the opponent's submissions and find that *"pharmaceutical and medicinal preparations"* in the applicant's specification encompasses "*pharmaceutical preparations and substances; all for humans and*

included in Class 5" in the opponent's specification. Therefore, I find the goods to be identical on the principle outlined in *Meric*.

25. Similarly, I agree with the opponent's submissions, and I consider that "*pharmaceutical and medicinal preparations for the treatment of hair"* in the applicant's specification, whilst limited to the treatment of hair, are encompassed by *"pharmaceutical preparations and substances; all for humans and included in Class 5"* in the opponent's specification. Therefore, I find the goods to be identical on the principle outlined in *Meric.*

26. The opponent submitted that *"vitamin and vitamin preparations", "vitamin and nutritional supplements in tablets, capsule, and powdered"* and *"nutritional supplements", "health food supplements"* in the applicant's specification are identical or highly similar to "*pharmaceutical preparations and substances; all for humans and included in Class 5"* in the opponent's specification. I will be comparing the applicant's goods collectively, as suggested by the opponent, this is on the basis that these goods seem to me to be much alike, and, in line with the guidance in *Separode* that I cited above, are sufficiently comparable to be assessable for the registration essentially the same way for essentially the same reasons.

27. I am of the view that the applicant's goods are all forms of vitamins or vitamin preparations, which are dietary products that are intended to supplement the diet. However, I accept that the applicant's goods may also be used for medical purposes, i.e., if they are recommended by a medical professional, for example. As such, there may be an overlap of purpose and user with the opponent's goods. As submitted, I am of the view that the physical nature and method of use of these goods may be the same in that they may come and be ingested in the form of tablets, capsules, powders or liquids, although I do recognise that pharmaceuticals may be administered by various other means, including injection. In addition, I accept that both pharmaceuticals and nutritional supplements would be dispensed or retailed through chemists, so there is an element of shared trade channels. It is also possible that the producers of pharmaceuticals may also use their manufacturing facilities to produce the applicant's goods, however, I have no evidence to reach a conclusion on that. The goods are unlikely to be in competition with one another and are not complementary,

as one is not important for the use of the other. Taking the above into consideration, I find the goods to be similar to a medium degree.

28. I consider that *"nutritional and vitamin supplements and preparations for animals"* in the applicant's specification is similar to *"pharmaceutical preparations and substances; all for humans and included in Class 5"* in the opponent's specification. I consider that these goods are typically added to animal food to complement their diet or because they are considered beneficial to health. I do not consider that these goods fall within the ordinary and natural meaning of the opponent's goods. However, given that they may both be in the form of powders, tablet, capsules or liquids, the nature of the respective goods is similar. The applicant's goods may be given to animals for medical purposes, or at least for the promotion of good health and, therefore, there may be an overlap in intended purpose with the opponent's goods. In some circumstances, the goods will have the same method of use insofar as they may be consumed orally. I am not of the view that the applicant's goods are ordinarily found in pharmacies. The respective goods are not in direct competition. Further, they are not important or indispensable to the use of another and, as such, are not complementary. Taking the above into account, I find the goods to be similar to a medium degree.

Second earlier mark

29. I agree with the opponent's submissions and consider that *"pharmaceutical and medicinal preparations"* in the applicant's specification encompasses *"pharmaceutical preparation for the treatment of colds and respiratory ailments"* in the opponent's specification. Therefore, I find the goods to be identical on the principle outlined in *Meric.*

30. In relation to "*pharmaceutical and medicinal preparations for the treatment of hair"* in the applicant's submissions, whilst I note the opponent's submissions regarding the identity of the goods in relation to this term, I disagree. I compared the goods with the closest I could identify in the opponent's specification, being "*pharmaceutical preparation for the treatment of colds and respiratory ailments"*. I consider that, whilst the goods may share the same general user and trade channels,

it is my view that the goods will differ in nature, purpose and method of use. In addition, it is not my view that the goods will be in competition, nor will they be complementary. Taking this into account, I find the goods to be similar to a low degree.

31. In relation to *"vitamin and vitamin preparations", "vitamin and nutritional supplements in tablets, capsule, and powdered", "nutritional supplements", "health food supplements"* and *"nutritional and vitamin supplements and preparations for animals"* in the applicant's specification, I note the opponent's submissions, however, I disagree. Applying the same reasoning set out in paragraph 27, I consider that the goods are similar to "*pharmaceutical preparation for the treatment of colds and respiratory ailments"* to a medium degree. I make this finding, whilst taking into consideration that these particular goods of the opponent's have been limited to treat colds and respiratory ailments.

Third earlier mark

32. I consider that "*pharmaceutical and medicinal preparations"* in the applicant's specification encompasses *"pharmaceutical drugs"* in the opponent's specification. Therefore, I consider these goods to be identical on the principle outlined in *Meric.*

33. Whilst "*pharmaceutical and medicinal preparations for the treatment of hair"* in the applicant's specification are used specifically for the treatment of hair, I consider that *"pharmaceutical drugs"* in the opponent's specification are broad, and the terminology drugs is synonymous with pharmaceutical preparations; taking this and the consideration that the opponent's goods can encompass pharmaceutical drugs that can be used for purposes such as hair loss or dandruff into account, I find that the goods are identical on the principle outlined in *Meric.*

34. In relation to *"vitamin and vitamin preparations", "vitamin and nutritional supplements in tablets, capsule, and powdered", "nutritional supplements", "health food supplements"* and *"nutritional and vitamin supplements and preparations for animals"* in the applicant's specification, I note the opponent's submissions, however, I disagree with the opponent. Applying the same reasoning set out in paragraph 27, I

consider that the goods are similar to *"pharmaceutical drugs"* in the opponent's specification to a medium degree.

AVERAGE CONSUMER AND THE PURCHASING PROCESS

35. As the law above indicates, it is necessary for me to determine who the average consumer is for the parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J F ox Limited,* [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

36. The applicant has not commented on the average consumer of the goods, however, the opponent submits that the average consumer is the medical professional or members of the general public, who will rely on a visual/aural purchasing process and that the general public will pay a slightly lower degree of attention than medical professionals.

37. I agree with the opponent that the average consumer includes medical/healthcare professionals and members of the general public at large. The goods are most likely to be self-selected from physical stores, websites or brochures. This means that the mark will be seen and so the visual element of the mark will be significant. However, I also consider that the aural element of the mark is relevant, as the goods may be requested from a sales assistant, recommended by word of mouth or may involve conversations with professionals in a retail or pharmaceutical setting.

38. The price and frequency of the purchase of the goods at issue will vary, as I consider that certain pharmaceutical drugs are very expensive whereas a remedy for a cold or bottle of vitamins, for example, are typically inexpensive. In addition, the goods are likely to be purchased frequently by professionals, but less frequently by the general public. Even when the goods are of lower cost and purchased relatively frequently, a number of factors will still be considered by the average consumer during the purchasing process, for example, the ingredients and suitability of the goods for the particular medical concern.

39. With this in mind, I consider that the average consumer pays a heightened degree of attention when selecting pharmaceutical products, including such products available without a prescription.[2] Taking all of these factors into account, the level of care and consideration that will be adopted during the purchasing process would be higher than medium (but not the highest), however, the non-pharmaceutical goods are frequent (but not everyday) purchases that attract only a medium degree of care and attention.

COMPARISON OF THE MARKS

40. The opponent relies on three earlier marks. Although these marks rely on different specifications, the word marks are identical. Therefore, I will compare the application to the opponent's marks collectively. Any comment made in relation to the opponent's mark applies to all earlier rights. I will refer to the marks as the opponent's mark.

41. The respective trade marks are shown below:

Vi-Q	VICKS
The applicant's mark	The opponent's mark

42. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural, and conceptual similarities of trade marks must be assessed by reference to all the overall

[2] *Bayer AG* v EUIPO, Case T-261/17

impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> "… it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

43. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

44. I note in its submissions that the applicant submits that the logos used by both parties are not the same. This does not assist the applicant. This is on the basis that in the multifactorial assessment of the likelihood of confusion it is not the logos that are being assessed but the application and the marks as registered, which are as demonstrated in paragraph 41 above.

45. The opponent's mark consists of the word 'VICKS'. There are no other elements that contribute to the overall impression of the mark which lies in the word itself. The applicant's mark is a word mark that consists of the word 'Vi-Q'. There are no other elements that contribute to the overall impression of the mark which lies in the word itself.

46. The opponent submits that the marks are similar to a medium to high degree, the opponent states this is the case on the basis that visually the marks share the letters 'VI' at the beginning of the marks where the average consumers focus their attention.

47. Visually, the marks share the first two letters VI. However, the marks differ in the presence of '-Q' in the applicant's mark and 'CKS' in the opponent's mark. I note

the opponent's submission and agree that the average consumer tends to pay more attention to the beginning of the marks.[3] In addition, the opponent submits that the 'CK' in the opponent's mark appears similar to the 'Q' in the applicant's mark, I disagree with this and do not consider that 'CK' and 'Q' will be viewed as visually similar but that the average consumer will be able to identify the differences between the letters in the parties' marks. The applicant submits that the marks differ, in that the opponent's mark appears in capital letters and the applicant's mark is a mixture of upper and lower case. However, this argument is of no relevance as both parties' marks are word only marks and fair and notional use of the same means that they may both be presented in upper case, lower case or any customary combination of the two. Taking all the above into account, I find the marks to be similar to a medium degree.

48. The opponent submits in its counterstatement that the applicant's mark has a hyphen which it submits will not be pronounced. In addition, the opponent submits that the mark will be pronounced as VIQ, as a significant proportion of average consumers will not split the pronunciation of the word into Vi-Q. On this basis, the opponent submits that the marks are aurally similar to a high degree, as the 'S' does little to differentiate the signs. I disagree with the opponent. It is my understanding that hyphens can be used to either join words together or divide words, dependent on certain styles. I am of the view that the use of the hyphen, in this circumstance, has been added to help with the pronunciation of the mark, by separating a prefix to avoid mispronunciation. I consider that the hyphen indicates a break in the words and as a result, the applicant's mark will be pronounced as VAI (break) -queue. The break will not be pronounced as 'break' but will be a natural pause in the pronunciation attributed to the hyphen in the mark. In relation to the opponent's mark, the mark will be pronounced as VIKS. Taking the above into account, and recognising that the marks only share the pronunciation of the first letter 'V', I consider the marks to be aurally similar to a low degree.

49. The opponent has submitted that the marks are conceptually similar but has not elaborated as to why that is the case. I disagree with the opponent that there is any conceptual similarity between the marks. In my view, the applicant's mark will not

[3] *El Corte Ingles, SA v OHIM,* Cases T-183/02 and T-184/02

convey a particular concept to the average consumer as it will be seen as an invented term. However, I do recognise that some consumers may see the mark as a play on the word vitamins and IQ, potentially conveying the concept of smart vitamins or the like, but I am not of the view that this will be a significant proportion of the average consumers who hold this view. In relation to the opponent's mark, I consider that the mark is likely to be recognised as the possessive version of a nickname applied to any gender, for example short for 'Victor' or 'Victoria' or a surname. I do not consider the absence of the apostrophe prevents this from being the case. Given that one mark will convey a concept and the other will not, I consider the marks to be conceptually dissimilar. Even for the consumers that identify the applicant's mark as conveying the concept of smart vitamins or the like, I consider that the marks will be conceptually dissimilar.

DISTINCTIVE CHARACTER OF THE EARLIER MARK

50. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 instic Joined Cases C- 108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; 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 Section of the public which, because of the mark, identifies the

goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

51. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with a high inherent distinctive character, such as invented words which have no allusive qualities.

52. The opponent submits that the mark has a high degree of inherent distinctive character. In addition, the opponent submits that its marks have acquired enhanced distinctive character through use. I will first address the inherent distinctive character of the marks. As mentioned above in the conceptual comparison, I consider that the marks will be viewed by the average consumer as the possessive version of a nickname applied to any gender, for example short for 'Victor' or 'Victoria' or a surname, I am of the view that the marks will be inherently distinctive to a medium degree.

53. In relation to enhanced distinctive character, I will assess the evidence that has been provided collectively for all of the earlier marks.

54. No evidence has been provided to suggest that the UK customers would be aware of the opponent's mark or to indicate that a proportion of the relevant class would identify the goods as originating from the opponent's undertaking because of its mark. Despite this the opponent has pleaded that its marks have acquired enhanced distinctive character through use as the company was launched in the 1920's and the marks have been extensively used and the brand is popular. I have considered the evidence in support of a claim of enhanced distinctiveness and consider that the evidence is sufficient to demonstrate such a claim in regard to the opponent's marks in the UK. I recognise that use of the mark has been particularly long-standing, having

commenced in the 1920's.[4] I have evidence that the use has been intensive with significant unit sales of the opponent's goods, as evidenced below[5]:

Product	Unit Sales				
	52 w/e 06 Jan, 18	52 w/e 05 Jan, 19	52 w/e 04 Jan, 20	52 w/e 02 Jan, 21	52 w/e 01 Jan, 22
VICKS VICKS VAPORUB RUBS-INHALANTS	1,747,521	1,677,418	1,721,641	1,443,449	1,442,436
VICKS VICKS INHALERS SINUS-NASAL	1,242,561	1,209,992	1,270,580	859,416	1,032,521
VICKS VICKS SINEX MICROMIST SINUS-NAS	480,680	520,475	631,207	598,680	656,797
VICKS VICKS SINEX SOOTHER SINUS-NASAI	358,999	338,656	463,699	415,026	444,084
VICKS VICKS FIRST DEFENCE SINUS-NASAL	538,764	550,096	605,577	537,090	321,104
VICKS VICKS BABYRUB RUBS-INHALANTS	53,663	137,946	169,255	169,905	229,999
VICKS VICKS SINEX SINUS-NASAL	445,102	438,319	109,918	245	4

55. The opponent submits that its goods are sold in leading UK supermarkets and/ or online equivalents, namely, Wilko, Boots, Tesco, Amazon, Sainsburys, Morrisons and Superdrug.[6] In addition, the opponent submits that this list is non-exhaustive. Whilst no information has been provided about the number of stores in which these goods are sold, I am prepared to infer that use has been geographically widespread in the UK. The opponent has also spent a significant amount on advertising and promotional activities on digital, outdoor, press, radio and television advertising, specifically in excess of: 1,000,000 in 2016/17, 2,600,000 in 2018/19, 2,300,000 in 2019/20, 2,700,000 in 2020/21 and 2,700,000 in 2021/22.[7] In addition, the opponent's goods have been referenced on national television programmes and in the national press.[8] Further, I note the google analytics demonstrating regular views of the opponent's website by UK consumers,[9] the products offered by the opponent and examples of the products being sold in UK supermarkets,[10] and sample invoices of sale and delivery receipts.[11] Taking all of this into account, I am satisfied that the distinctiveness of the earlier marks have been enhanced to a high degree through use in relation to *"salves (medicated for human use", "nasal sprays for the treatment of colds and respiratory ailments", "inhalants for the treatment of colds and respiratory*

[4] Exhibit PG1
[5] Exhibit PG10
[6] Exhibit PG6 and PG7
[7]Exhibit PG11
[8] Exhibit PG13 and Exhibit PG14
[9] Exhibit PG4
[10] Exhibits PG5, PG6 and PG7
[11] Exhibit PG8

ailments" and "*decongestants".* I note that the findings only apply to those marks which are protected for the respective goods.

LIKELIHOOD OF CONFUSION

56. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

57. I have found the marks to be visually similar to a medium degree, aurally similar to a low degree and conceptually dissimilar. I have found that the level of attention paid by the average consumers will vary from a higher than medium (but not the highest) to medium degree of attention. In addition, the average consumers will select the goods via a visual means (although I do not discount an aural component). I have found the goods to vary in similarity from a low degree of similarity to identical. I have found the opponent's mark to be inherently distinctive to a medium degree and it has acquired enhanced distinctive character – elevating its distinctiveness to distinctive to a high degree.

58. Taking all the above and the principle of imperfect recollection into account, I do not consider that the parties' marks will be mistakenly recalled or misremembered as one another. I recognise that the marks share their first two letters 'VI', which is in favour of the opponent. I also recognise that the average consumer tends to pay more attention to the beginning of the marks. However, I am of the view that as the marks are only visually

similar to a medium degree and aurally similar to a low degree, these in themselves would not be enough for consumers to mistakenly recall/misremember them. In addition, I have found the marks to be conceptually dissimilar, taking this factor into account, the average consumer will be able to remember which mark was a name (regardless of whether they determine it to be a nickname for any gender or a surname) and which mark is either an invented word or play on the word IQ. Consequently, I consider there to be no likelihood of direct confusion between the marks. I have made this decision taking into account the high degree of distinctive character of the opponent's marks and the goods that I have found to be identical.

59. I will now proceed to consider a likelihood of indirect confusion. Indirect confusion involves recognition by the average consumer of the difference between the marks. Mr Purvis QC in the *L.A Sugar Limited* case set out examples of indirect confusion as follows:[12]

> "(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI", etc.). BL O/375/10 Page 15 of 16
>
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."[13]

[12] Paragraphs 16 & 17 of *L.A Sugar Limited v By Black Beat Inc*, Case BL-O/375/10
[13] Ibid, Paragraph 17

60. I note that the examples set out by Mr Purvis are not exhaustive. I also note the recent case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors,*[14] wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was) sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he stated that a finding of a likelihood of indirect confusion is not a consolidation prize and that there needs to be a reasonably special set of circumstances in order to get indirect confusion where there is no likelihood of direct confusion. Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

61. Having recognised the differences between the marks, I do not consider that there is any basis for the average consumer to believe that the undertaking 'VICKS' would rebrand itself as, or create the sub-brand of Vi-Q or vice versa. In addition, I am not of the view that the shared letters are so strikingly distinctive that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. I consider that the shared letters of 'VI' will be seen by the average consumer as purely coincidental. I am unable to identify any obvious circumstance where a finding of indirect confusion may occur. Taking all the above factors into account, I do not consider there to be a likelihood of indirect confusion between the marks, even for goods that are identical.

62. As a result of my findings above, the opposition under section 5(2)(b) is dismissed. I will now proceed to consider the remaining ground of opposition.

Section 5(3)

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

> "5(3) A trade mark which – is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of

[14] [2021] EWCA Civ 1207

the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

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

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is

weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34. 51*.

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

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

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

65. The conditions of section 5(3) are cumulative. There must be similarity between the marks, the opponent must also show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. The opponent must also establish that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the earlier marks being

brought to mind by the later mark. Assuming that these conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

66. The relevant date for the assessment under section 5(3) is the date of the application at issue, being 2 August 2021.

Reputation

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

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

68. Under its 5(3) ground, the opponent relies on the same marks as it did under the section 5(2)(b) ground, being the word-only marks 'VICKS'. In addition, it claims to have obtained a reputation in all its goods as relied upon in the same ground.

69. When assessing the enhanced distinctive character of the opponent's marks, I undertook an assessment of the evidence filed, a summary of which can be found in paragraphs 54 to 55. This same evidence is relied upon for the basis of the opponent's 5(3) claim. I do not intend to repeat the evidence referenced in the enhanced distinctiveness section in full here. Clearly, the use has been geographically widespread, intensive and long-standing. Taking all of this into account, I am satisfied that the opponent had a strong reputation for "*salves (medicated for human use", "nasal sprays for the treatment of colds and respiratory ailments", "inhalants for the treatment of colds and respiratory ailments"* and "*decongestants".* I note that the findings only apply to those marks which are protected for the respective goods.

Link

70. As noted above, my assessment of whether the public will make the required mental link between the marks must take account of all relevant factors. The factors identified in *Intel* are:

> The degree of similarity between the conflicting marks
>
> I have found the marks to be visually similar to a medium degree, aurally similar to a very low degree and conceptually dissimilar.
>
> The nature of the goods for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness of dissimilarity between the goods, and the relevant section of the public.
>
> I have undertaken a full goods comparison above. I have found the goods to vary in similarity from similar to a low degree to identical.
>
> My assessment of the average consumer set out above will also apply to the relevant public for the purposes of section 5(3).

The strength of the earlier marks reputation

I consider that the marks would have a reputation in the UK for "*pharmaceutical preparations and substances; all for humans and included in class 5"* (first earlier mark), "*salves (medicated) for human and veterinary use"* (second earlier mark) and *"pharmaceutical preparation for the treatment of colds and respiratory ailments"* (third earlier mark) under all the earlier marks in the UK at the relevant date.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

I have found the opponent's marks to be inherently distinctive to a medium degree. I have found that the earlier marks would have been enhanced through use and the resultant level of distinctive character is high.

Whether there is a likelihood of confusion

I have found there to be no likelihood of confusion in relation to the goods that I have found to be similar or identical.

71. Taking all of these above factors into account, I consider that the marks are, in my view, too far apart for a link to be made. I see no reason why the UK consumer would be accustomed with the opponent's mark to the point that they would make a link between the marks. In reaching this conclusion, I have borne in mind not only that the medium degree of visual similarity, low degree of aural similarity and conceptual dissimilarity but also the lack of a likelihood of confusion. In addition, I have taken into consideration that the shared use of the letters 'VI' will be viewed as a coincidence. In respect of the distance of the goods at issue, I appreciate that some may be identical but all the aforementioned points are factors pointing against the existence of a link regardless of the level of identity/similarity of the goods at issue.

72. As I have found there to be no link between the marks in the minds of the average consumer in the UK, there can be no resulting damage caused to the

opponent's marks. As a result, the opponent's reliance upon the 5(3) grounds fails in its entirety.

CONCLUSION

73. The opposition fails in its entirety and the application may, therefore, proceed to registration for all the goods applies for.

COSTS

74. The applicant has been successful and successful and, in the ordinary course of these proceedings, would be entitled to a contribution towards its costs. However, the applicant is not legally represented meaning that, in order to claim its costs, it was required to file a completed costs pro-forma. It did not do so. I note that a blank costs pro-forma was provided to the applicant under the cover of a letter from the Tribunal dated 3 February 2023. I also note that this letter set out that:

> "If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded."

75. As no costs pro-forma was filed and the applicant incurred no official fees arising from this action, I make no order as to costs. Both parties are hereby ordered to bear their own costs of these proceedings.

Dated this 27th day of July 2023

A KLASS
For the Registrar