

O/330/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
No. 2579323  
BY SMITHKLINE BEECHAM LIMITED  
TO REGISTER THE TRADE MARK  
VAPOMENTHOL  
IN CLASS 5**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 102310 BY  
THE PROCTOR AND GAMBLE COMPANY**


## BACKGROUND

1) On 21 April 2011 SmithKline Beecham Limited (hereinafter the applicant), applied to register the trade mark VAPOMENTHOL in respect of the following goods in Class 5: pharmaceutical preparations and substances.

2) The application was examined and accepted, and subsequently published for opposition purposes on 27 May 2011 in Trade Marks Journal No.6889.

3) On 25 August 2011 The Procter & Gamble Company (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

| Number      | Mark  | Filing and Registration Date | Class | Relevant Specification   |
|-------------|---|------------------------------|-------|--|
| CTM 58529   | VAPOSYRUP   | 01.04.96 / 01.10.98          | 5     | Pharmaceutical preparations and substances for the prevention, treatment and alleviation of coughs and other disorders and ailments of the respiratory system and similar conditions.  |
| CTM 58545   | VAPORUB   | 01.04.96 / 10.08.98          | 5     | Pharmaceutical preparations and substances for the prevention, treatment and alleviation of coughs, colds and other disorders and ailments of the respiratory system and similar conditions.   |
| CTM 6398069 | VAPOSTEAM   | 26.10.07 / 09.10.08          | 5     | Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides. |
| CTM 6398135 | VAPODROPS   | 26.10.07 / 25.11.08          | 5     | Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides. |
| CTM 6770051 |  | 20.03.08 / 05.02.09          | 5     | Pharmaceutical preparations and substances for the treatment of colds and respiratory ailments; medicated lozenges, medicated throat drops, medicated chewing-gums; medicated ointments and creams.  |
| CTM 9237991 | VAPOCOOL  | 12.07.10 / 30.11.10          | 5     | Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides. |

|               |                   |                        |   |  |
|---------------|-------------------|------------------------|---|--|
| UK<br>2552718 | VICKS<br>VAPOCOOL | 12.07.10 /<br>08.10.10 | 5 | Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides. |
| UK<br>1422537 | VAPOSYRUP         | 20.04.90 /<br>24.01.92 | 5 | Pharmaceutical preparations and substances, all in syrup form; all included in Class 5.  |
| UK<br>913493  | VICK<br>VAPOSTEAM | 18.08.67 /<br>16.05.69 | 5 | Inhalants being pharmaceutical, preparations for the treatment of colds and respiratory ailments.  |
| UK<br>408756  | VAPORUB           | 15.10.1920             | 5 | Medicated salves for human use.  |

- a) The opponent states that its earlier marks consist of a family of marks incorporating the prefix VAPO. These have been used in the EU by the opponent in relation to pharmaceutical products including pharmaceuticals for the treatment of colds and respiratory ailments for many years and the opponent has substantial goodwill and reputation in their VAPO family of marks. The mark in suit is visually, phonetically and conceptually similar to the opponent's family of marks and the goods are also identical or similar. The opponent states that the application offends against Section 5(2)(b).
- b) The opponent relies upon all of the above listed marks in asserting that it enjoys reputation in these marks such that use of the mark in suit on identical or similar goods would, without due cause, take unfair advantage of or cause detriment to the distinctive character and repute of the opponent's earlier marks, and thereby offend against Section 5(3) of the Act. The opponent states that this damage would include dilution, degradation and free riding by falsely creating a connection between the corresponding products. The opponent states:

"Dilution is caused when a mark's ability to identify the goods for which it is registered is weakened, since use of the similar trade mark VAPOMENTHOL, leads to a dispersion of the identity and hold upon the public mind of the opponent's earlier trade marks."

"With regard to degradation, this detriment is caused when the goods for which the applicant's sign is used might be perceived by the public in such a way that the trade mark's power of attraction is reduced. As the opponent can obviously exert no control over the quality of the applicant's VAPOMENTHOL products, this detriment may arise for the fact that the applicant's goods are of an inferior quality to those offered by the applicant."

“In relation to free riding, advantage is taken by the applicant as a result of the use of a similar sign. There is a transfer of the image of the opponent’s marks to the goods identified by the similar sign of the applicant. As such, there is clear exploitation or riding on the coat tails of the opponent’s marks with a reputation in the pharmaceutical field.”

4) On 24 October 2011, the applicant filed a counterstatement. They requested proof of use in relation to CTM 58529 and 58545, and UK 1422537, 913493 and 408756 in relation to all the goods covered by the earlier marks. They deny that the marks are similar stating that whilst they share the same prefix VAPO, this is non-distinctive as it clearly has a descriptive meaning in relation to the goods in question. They assert that VAPO is a clear derivation from the word VAPOUR (UK spelling) or VAPOR (USA spelling) meaning a substance suspended or diffused in the air and that it has a clear and identifiable meaning when used in the context of products intended to produce a vapour to be inhaled by the patient to relieve respiratory conditions. They assert that there are a number of marks upon the UK and CTM Registers in Class 5 with the prefix VAPO, and thus the term has been diluted.

5) Both sides filed evidence and both sides request costs. Neither side wished to be heard in the matter although both provided written submissions.

## **OPPONENT’S EVIDENCE**

6) The opponent filed a witness statement, dated 23 December 2011, by Hugh Ayling an employee of the opponent company who describes his job as including “protecting and building the Vicks brand equity”. He states that the VAPORUB brand was first launched by Richardson-Vicks in 1911, was acquired by his company in 1985 and is sold worldwide. He states that the product is designed to relieve colds and congestion and is sold in over 5000 outlets throughout the UK. Sales during the years 2009-2011 in the UK have averaged £21.5million per annum. Mr Ayling provides examples of invoices and orders which reinforce the assertion of UK wide sales. He also states that the brand enjoyed a 5-9% share of the market for decongestant treatments in the UK during the years 2008 –May 2011. I note that on the internal paperwork regarding orders and on the invoices (exhibits 2 & 3) the product is always referred to as “Vicks Vaporub”.

7) At exhibit 4 Mr Ayling provides examples of advertising for the product during the period 1988 -2009. All the advertisements, with two exceptions are for Vicks Vaporub. The two exceptions are in 1999 an advertisement for “Vicks Vaposyrup”, and in 2001 an advertisement for “Vicks Inhaler”. At exhibit 5 he provides a UK price list dated 2 May 2005, and two price lists, both dated 1 November 2011, which barely differ only slightly. All three price lists show listings for vaporub and vaopsyrup, but none of the other marks shown at paragraph 3 above. At exhibit 6 he provides a number of instances of media and press references. Unfortunately, most are after the relevant date of 21 April 2011 or relate to use outside the UK, indeed some are not in English. Given that no sales figures for any country other than the UK have been provided the opponent is clearly not relying upon reputation in Europe. At exhibit 7 is a copy of a study carried out

in 2010. This states that Vaporub had an unaided association of 52% and an aided awareness of 100% with the Vicks brand. It also states that all other Vicks brands have a low level of consumer awareness. At exhibit 8 is another study which Mr Ayling states “makes various references to the VICKS range of products including VAPORUB”. However, he does not refer to any specific mentions or draw any conclusions from the study. It is unclear why it was filed. He states that due to the success of VAPORUB the company launched other products including VAPOSYRUP and VAPOSTEAM both of which treat congestion. At exhibit 9 he provides copies of pages from the internet which are all dated after the relevant date. At exhibit 10 he provides the results of Google searches in France and Italy regarding the terms VAPOSYRUP and VAPOSTEAM dated 26 July 2011 and 3 November 2011. Mr Ayling states:

“Thanks to the considerable promotion, awareness and success of the VAPORUB brand and our family of other VAPO prefixed trade marks including VAPOSYRUP and VAPOSTEAM, we believe that recognition of this family in the market sector is extremely high.”

## **APPLICANT’S EVIDENCE**

8) The applicant filed a witness statement, dated 2 March 2012 by Emma Sopha Stopford the Vice President and Trade Mark Counsel of GlaxoSmithKline Services Unlimited which is part of the GlaxoSmithKline group of companies along with the subsidiary SmithKline Beecham Ltd. She states that she has worldwide responsibility for trade marks owned by her company. She disputes that the opponent has used its marks VAPOSYRUP or VAPOSTEAM in the UK. At exhibit 3 she provides a print out of the opponent’s UK website dated 24 February 2012 which shows that the only product with a VAPO prefix is VAPORUB. Ms Stopford also points out that this mark is used with the house mark VICKS and that the letter “R” in VAPORUB is stylised in that it is a capital letter. She states that VAPO is not distinctive in its own right given its clear descriptive meaning in relation to the goods in question. It is clearly derived from the word VAPOUR meaning a substance suspended or diffused in the air which has a clear identifiable meaning in the context of products intended to produce a vapour to be inhaled by the patient to relieve respiratory congestion. At exhibit 5 she provides a copy of the free Merriam-Webster dictionary definition to back up her point.

9) At exhibit 7 Ms Stopford provides copies of pages from the website NHS CHOICES which refers to “vapour rubs” in a generic manner. Also as part of this exhibit are pages which show a number of companies selling decongestant products using the term “vapour rub”, inter alia, Boots Vapour Chest Rub, Calpol Vapour Rub, Karvol Vapour Rub, Tesco Vapour Rub and Asda Vapour Rub. The exhibit shows that these are all available on sale in the UK as at 14 February 2012, after the relevant date. At exhibit 10 she also provides “state of the Register” evidence of other VAPO marks in Class 5.

## OPPONENT'S EVIDENCE IN REPLY

10) The opponent filed a further witness statement, dated 25 April 2012, by Mr Ayling. He makes certain observations regarding the applicant's evidence which do not assist me in my decision.

11) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## DECISION

12) The first ground of opposition is under section 5(2)(b) which reads:

"5.-(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 of association with the earlier trade mark."

13) An "earlier trade mark" is defined in section 6, the relevant part of which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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."

14) The opponent is relying upon its trade marks listed in paragraph 3 above all of which are clearly earlier trade marks. The marks were filed in the period beginning with 1920 and ending on 12 July 2010. Of the marks relied upon five (CTM 58529 and 58545 and UK1422537, 913493 and 408756) have been put to strict proof of use by the applicant and are subject to The Trade Marks (Proof of Use, etc) Regulations 2004 paragraph six of which states:

"6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

15) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the marks has been made. In the instant case the publication date of the application was 27 May 2011, therefore the relevant period for the proof of use is 28 May 2006 – 27 May 2011. The guiding principles to be applied in determining whether there has been genuine use of a mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

16) The marks concerned are registered for the following goods:




|                             |  |
|-----------------------------|--|
| CTM 58529<br>VAPOSYRUP      | Pharmaceutical preparations and substances for the prevention, treatment and alleviation of coughs and other disorders and ailments of the respiratory system and similar conditions.        |
| CTM 58545<br>VAPORUB        | Pharmaceutical preparations and substances for the prevention, treatment and alleviation of coughs, colds and other disorders and ailments of the respiratory system and similar conditions. |
| UK 1422537<br>VAPOSYRUP     | Pharmaceutical preparations and substances, all in syrup form; all included in Class 5.  |
| UK 913493<br>VICK VAPOSTEAM | Inhalants being pharmaceutical, preparations for the treatment of colds and respiratory ailments.  |
| UK 408756<br>VAPORUB        | Medicated salves for human use.  |

17) The opponent did not provide any evidence of use of the mark VICK VAPOSTEAM other than a Google search of France and Italy which are after the relevant period being dated 26 July 2011. The only evidence relating to VAPOSYRUP were price lists, dated 2 May 2005 and 1 November 2011, which predate and post date the relevant period respectively, and an advertisement from 1999 which also predates the relevant period. The opponent did not provide any sales figures, advertising expenditure or market share figures for either of these marks. To my mind, the opponent has singularly failed to show genuine use of its mark VAPOSYRUP or VICK VAPOSTEAM. Trade marks CTM 58529, UK1422537 and UK 913493 will not be considered under this ground of opposition. The opponent has shown use of the mark "Vicks VapoRub" and whilst I accept that the registered mark does not have the house mark "Vicks" as part of it, and that the use shown has been with the slight stylisation of the letter "R" being a capital letter I do not believe that either of these elements alter the fact that the opponent has shown use of its VAPORUB mark upon a medicated salve for human use. I accept that the salve is used to alleviate colds and respiratory ailments but it would appear to be sold only as a salve which is rubbed onto ones chest so that the heat of the body gradually releases to fumes which are then inhaled and which help the patient to breath.

18) In summary, the following marks and specifications will be used in the comparison of marks and goods.

| Number      | Mark      | Relevant Specification in Class 5  |
|-------------|-----------|--|
| CTM 58545   | VAPORUB   | medicated salve for human use  |
| CTM 6398069 | VAPOSTEAM | Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides. |
| CTM 6398135 | VAPODROPS | Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for  |

|                |   |  |
|----------------|---|--|
|                |   | dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.   |
| CTM<br>6770051 |  | Pharmaceutical preparations and substances for the treatment of colds and respiratory ailments; medicated lozenges, medicated throat drops, medicated chewing-gums; medicated ointments and creams.  |
| CTM<br>9237991 | VAPOCOOL  | Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides. |
| UK<br>2552718  | VICKS<br>VAPOCOOL   | Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides. |
| UK<br>408756   | VAPORUB   | Medicated salves for human use.  |

19) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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 impressions 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; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in that mark;

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

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

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

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

20) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods previously outlined.

21) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. (as he was then)

sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”


22) To my mind, the opponent has singularly failed to show that it has a significant reputation in any of the marks at paragraph 18 above with the exception of its VapoRub mark. Whilst the evidence of use provided relates to Vicks VapoRub, it has shown significant sales of a medicated salve under this mark in the UK with a 5-9% market share and sales lately averaging over £20 million per annum for an item that is relatively cheap. It has also provided evidence that when presented with the mark VapoRub a majority of the public surveyed associate it with Vicks, and when the balance are assisted, then they also associate the mark with Vicks. The applicant can claim an enhanced protection for its mark based upon reputation. Inherently, the mark has a low level of distinctiveness, as it alludes to the nature of the product.

23) I must now determine the average consumer for the goods of the parties, which are broadly, pharmaceutical preparations. The average consumer would be the general public. The opponent describes the average consumer as:

“any prospective purchaser or consumer of pharmaceutical preparations and substances for the prevention, treatment and alleviation of coughs and other respiratory illnesses/disorders/ As such, the average consumer will be the general member of the public and such items are likely to be relatively inexpensive, high volume goods and due regard must be given to the commercial realities of the market place, including the doctrine of imperfect recollection.”

24) To my mind the average consumer will not purchase healthcare products without giving a reasonable amount of attention to the type of product, the symptoms it alleviates and any potential side effects or restrictions. The types of goods in this case are more likely to be selected by the average consumer visually, either self selected in a retail environment, from a catalogue or on-line. Although I must take into account aural considerations, and the role played by pharmacists etc.

25) Clearly all the opponent's specifications encompass the specification applied for, and the goods must therefore be considered to be identical. This is not contested by the applicant. I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

| Applicant's Trade Mark | Opponent's Trade Marks  |
|------------------------|---|
| VAPOMENTHOL            | CTM 58545 & UK 408756 VAPORUB   |
|                        | CTM 6398069 VAPOSTEAM   |
|                        | CTM 6398135 VAPODROPS   |
|                        | CTM 9237991 VAPOCOOL  |
|                        | UK 2552718 VICKS VAPOCOOL   |
|                        | CTM 6770051  |

26) The opponent claims that it has a "family" of marks and that because they all share the same prefix but differ in the suffix, the applicant's mark will be seen as simply an addition to the "family" or economically linked to the opponent. However I note that in the case of *The Infamous Nut Company v Percy Dalton (Holdings) Ltd* [2003] RPC 7 , Professor Annand sitting as the Appointed Person said:

"It is impermissible for Section 5(2) (b) collectively to group together several earlier trade marks in the proprietorship of the opponents.

Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by Section 6). This where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant's mark must be considered against each of the opponent's earlier trade marks separately (ENER-CAP trade mark [1999]RPC 362).

In some circumstances it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a "family of marks" in the proprietorship and use of the opponent (AMOR, Decision No 189/1999 of the Opposition Division, OHIM OJ 2/2000 p235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31."

27) I was also referred to the views expressed by the ECJ in C-552/09 *Ferrero SpA v OHIM (KINDERYOGHURT)* where they said:

- “90 By the fifth part of the sole ground of appeal, Ferrero submits that the General Court erred in law by not taking proper account of the existence in the present case of a family of trade marks, on the ground that this is irrelevant for the purposes of assessing similarity.
- 91 In so doing, the General Court misinterpreted the case-law in that, although, in the context of Article 8(1)(b) of Regulation No 40/94, the existence of a family of trade marks increases the likelihood of confusion by leading the consumer to believe that the challenged trade mark is part of that family, that is precisely because of the similarity between the challenged trade mark and the family of marks, or, more specifically, on account of the element common to them (Case C-234/06 P *Il Ponte Finanziara v OHIM* [2007] ECR I-7333, paragraph 63).
- 92 Ferrero further submits that the very existence of a family of trade marks increases the likelihood that the trade mark of a third party containing the element shared by that family will automatically be perceived by the relevant consumer as similar to that common element.
- 93 According to Ferrero, that applies fully to the situation where the challenged trade mark contains the word ‘KINDER’, which enjoys a considerable reputation and is compared with a family of 36 trade marks, all of which contain the same word, either alone or in combination with other words.
- 94 OHIM contends that the fifth part of the sole ground of appeal is both inadmissible and clearly unfounded. First, the challenge to the General Court’s finding that Ferrero could not rely on the existence of a ‘family’ of similar trade marks would involve a new factual assessment, which cannot be made in the context of an appeal. Secondly, OHIM argues that the possible existence of a family of marks is relevant only in the context of Article 8(1)(b) of Regulation No 40/94, in so far as it can create indirect confusion, by leading the public to believe that the later mark is yet another mark in that family. As regards Article 8(5) of Regulation 40/94, however, that argument is not legally sound because confusion itself is not relevant. Likewise, the lack of similarity between, on the one hand, all the marks in the series and, on the other, the challenged sign is enough to rule out definitively the possibility both of a likelihood of confusion and of detriment or unfair advantage.

– Findings of the Court

- 95 First of all, OHIM’s argument relating to the inadmissibility of the fifth part of the sole ground of appeal must be rejected. It is apparent from its arguments

that Ferrero is seeking to claim that, in taking the view that the existence of a family of trade marks is not relevant for the purposes of assessing similarity, the General Court failed to have regard to the scope of Article 8(1)(b) of Regulation No 40/94.

- 96 A part of a plea which is submitted to that effect thus relates to a matter of law and must therefore be declared admissible.
- 97 As to the substance, it should be borne in mind that it is settled law that the existence of a 'family' or a 'series' of trade marks is an element which must be taken into account for the purposes of assessing the likelihood of confusion. In those circumstances, the likelihood of confusion results from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for and may consider, erroneously, that that trade mark is part of that family or series of marks (*Il Ponte Finanziaria v OHIM*, paragraph 63).
- 98 However, as is apparent from paragraph 52 above, that element is irrelevant for the purposes of assessing the existence of a similarity between the earlier mark and the challenged mark.
- 99 Consequently, as is apparent from paragraph 66 above, it is only if there is some similarity between the marks at issue that the General Court must take into account, in the global assessment of a likelihood of confusion or of a link being made between those marks, the existence of a 'family' or 'series' of trade marks."

28) As the opponent has not shown use of any of its marks, with the exception of its VAPORUB mark it does not have a family of trade marks. I shall compare the applicant's mark to the opponent's strongest case which resides with its VAPORUB mark. Clearly they share the first four letters, but differ thereafter. Both marks are semi-descriptive, in that they both consist of two words which allude to their properties which have been conjoined. The first five letters of the opponent's mark actually spell, albeit the American version, the word VAPOR. Although I accept that most consumers would see and pronounce the mark as VAPO-RUB. Similarly the applicant's mark would be seen and pronounced as VAPO-MENTHOL. Visually and aurally there are similarities and also differences.

29) Conceptually, the applicant's mark would appear to allude to a product which forms a menthol vapour which would aid breathing. Equally the opponent's mark alludes to substance that forms a vapour but only after you rub it on yourself. There are conceptual similarities and also differences.

30) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. To my mind, whilst there are differences in the marks, they are such that when used on

identical goods, as in the instant case, there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2) (b) therefore succeeds. Given this finding I do not need to consider the opponent's other marks under this ground or indeed the other ground of opposition.

## **CONCLUSION**

31) The opponent is successful under Section 5(2)(b).

## **COSTS**

|  |             |
|--|-------------|
| Preparing a statement and considering the other side's statement               | £200        |
| Preparing evidence and considering and commenting on the other side's evidence | £200        |
| Expenses   | £200        |
| <b>TOTAL</b>   | <b>£600</b> |

32) As the opponent has been successful it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £600. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated 31<sup>st</sup> of August 2012**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**