

O-085-03

DECISION OF THE TRADE MARKS REGISTRY

TRADE MARKS ACT 1994

APPLICANT: RICHARD CONROY

APPLICATION No. 2251340

CLASS 3

AND

OPPONENTS: SMITHKLINE BEECHAM PLC

OPPOSITION No. 80388

NIT NURSE

BACKGROUND

Trade Mark in issue

1. On 3rd November 2000 Richard Conroy of 50 Tabley Road, Handforth, Cheshire, SK9 3RZ applied to register the mark NIT NURSE.

Specification of goods

2. Registration is sought in respect of:

Class 3: Oils and shampoos for the control of head lice.

History

3. Registration is opposed by SmithKline Beecham plc. The grounds of opposition are given as being under ss. 5(2)(b), 5(3) and 5(4)(a) of the Act. The opponents are the proprietors of registration No. 999527, applied for on 6th October 1972. The details of this registration are:

NIGHT-NURSE

Class 5: Pharmaceutical preparations and substances for human use being decongestants for relief of respiratory conditions.

4. All of the grounds of opposition were denied by the applicant. Both sides seek an award of costs.

HEARING

5. At the conclusion of the evidential stages of this opposition, I notified the parties that I did not consider that an oral hearing was necessary for a decision to be reached in these proceedings. However, the applicant requested that an oral hearing be appointed; this is in accordance with their right to be heard provided by Rule 54 of the Trade Mark Rules 2000.
6. The hearing took place before me on 12th February 2003. At the hearing the applicant was represented by Mr. Mitcheson of Counsel instructed by Lloyd Wise, McNeight & Lawrence; the opponents were represented by their Trade Mark attorney Ms. Evans of GlaxoSmithKline Beecham plc.

EVIDENCE

Opponents' evidence

7. This consists of a statutory declaration dated 29th May 2002 made by Ms. Georgina Evans. Ms. Evans says that she is an authorised attorney of the GlaxoSmithKline group of companies (GSK) of which SmithKline Beecham Plc (SB) is a part.

8. Ms. Evans states that the applicant's NIT NURSE product first came to the attention of GSK in October 2001 when an advertisement for it was placed in an edition of "Chemist and Druggist", a nationwide magazine aimed at pharmacists. Exhibit GE1 consists of a copy of this advertisement. Two samples of the NIT NURSE product are also shown at Exhibit GE2.
9. Reference is also made to an objection GSK made (I assume directly) to the applicant's use of a get-up that arguably reflects that of the opponents' product (see Exhibits GE2 and GE3; see next paragraph). Ms. Evans states that the applicant has agreed to stop using the name and packaging pending the outcome of these proceedings.
10. Ms. Evans then turns to the opponents' trade mark registration and use of NIGHT NURSE. The details of registration No. 999527 are recited, and I have already referred to the sample of the NIGHT NURSE product in Exhibit GE3. Ms. Evans says that there are strong similarities between the pack liveries of NIGHT NURSE and NIT NURSE namely the prominent green cross, the green coloured bottom to the packs and the similar use of dark-blue, green and white colours. Ms. Evans states that the current NIGHT NURSE packaging has been used since 1999. She then refers to exhibit GE4 which consists of a sample of the NIGHT NURSE pack used prior to 1999. It is stated that this pack was used between January 1996 and July 1999.
11. It is stated that the trade mark NIGHT NURSE has been used extensively since 1972 on an over-the-counter pharmaceutical product for the treatment of coughs, shivers, aches and pains, runny or blocked nose, sore throat and headaches. It is stated that the livery of this pack is substantially the same as the current pack. Annual sales figures in respect of NIGHT NURSE are provided:

1995	£3.7 million
1996	£3.6 million
1997	£3.2 million
1998	£2.9 million
1999	£3.8 million
2000	£4 million

12. Ms. Evans states that since 1995 in excess of £12 million has been spent on advertising and promotion in the UK of the NIGHT NURSE product and its companion product DAY NURSE. Examples of such advertising are provided at GE5. The examples provided are :
 - a. A trade advertising poster,
 - b. A poster used in pharmacy windows,
 - c. A video tape of a television advertisement that was screened in all ITV regions from Q4 1999 TO Q4 2000. From Q4 2001 it was only screened in Wales and the West.
13. The examples provided show joint advertisements for the two products. It is not clear whether the two products are advertised or promoted separately and if so what the breakdown of the advertising spends is. Ms. Evans states that given the nationwide coverage of the advertisements and promotions, it is highly likely that the applicant will have been aware of NIGHT NURSE.

14. Ms. Evans then gives her opinion as to the similarity of the marks and the similarity of goods. As this is not strictly evidence of fact, I will draw upon this when I give my own analysis under these heads.
15. Ms. Evans concludes her evidence by giving her opinions as to the ground pleaded under s. 5(3). She states that given the substantial reputation in the NIGHT NURSE mark, there would be a resulting risk of tarnishing. She also refers to the risk that would be run if consumers were confused in the actual consumption of the two products. Reliance is placed on one of the Registry's decisions (GALAXY B/L 0/179/00) to support her latter argument. Again, I will deal with these contentions in more detail when I consider the ground under the s. 5(3) ground.

Applicant's evidence

16. This consists of a witness statement dated 14th August 2002 made by Mr. Richard Conroy, the applicant in these proceedings. Mr Conroy begins by stating that the NIT NURSE product has been marketed by his licensee (In-Line Cosmetics Limited) initially through a home shopping TV channel but more recently through pharmacies. Marketing of the product began in January 2000 and was suspended in January 2002 by agreement with the opponents (see paragraph 9 above).
17. Mr. Conroy states that total sales of NIT NURSE products (presumably between the two dates referred to above) have amounted to £36, 979 and that advertising expenditure amounts to £2, 200. He refers to Exhibit RC1 which consists of an advertising leaflet for the NIT NURSE product together with a number of press articles that also refer to it. Mr. Conroy adds that no instances of confusion have come to his attention; he expands on this by giving his opinions as to why confusion is unlikely – I will draw upon these opinions where necessary later in this decision.
18. Mr. Conroy refers to negotiations that have taken place between the two parties in relation to the get-up of the mark. The opponents, in their evidence-in-reply, cried foul in Mr. Evans' second Declaration, claiming that this information is subject to the 'without prejudice rule'. I tend to agree. It is thus inadmissible in evidence, being between the parties, and I am accordingly not allowed to consider it (see *Calderbank v Calderbank* [1976] Fam. 93).
19. In the applicant's counterstatement they provide state of the register evidence which shows a number of marks containing the word NURSE. Mr. Conroy's evidence takes this further by showing two of the marks (Nurse Sykes' Powder & Nurse Harvey's Gripe Mixture) listed on internet web-sites as available products. The applicant's claim being that they are used in the marketplace and not just simply registered marks, and therefore relevant to the distinctiveness of the NURSE element of the opponents' mark.
20. Mr. Conroy then explains how he came to select the NIT NURSE name. He says that he conceived the product as a replacement for the now obsolete "Nit Nurse" who visited schools to check children's hair for head lice. Exhibit RC3 consists of a web-page which discusses the demise of the "Nit Nurse".
21. Mr. Conroy concludes his evidence by stating that if the NIT NURSE product were taken orally no harm would come to the taker.

Opponents' evidence in reply

22. This consists of a further statutory declaration from Ms. Evans, dated 8th November 2002. Other than comments in relation to the without prejudice statements made by Mr Conroy (see above), the evidence essentially gives further opinion, particularly in reply to Mr. Conroy's own opinion, as to the likelihood of confusion. I will refer to these where necessary as part of this decision.
23. Ms Evans concludes by stating that no evidence has been put forward by the applicant to establish the non-harmful nature of the NIT NURSE product if taken orally. I would add that the corollary also exists in that no evidence is before me to establish that the NIT NURSE product would be harmful if taken orally.

LAW

24. The relevant sections of the Act are:

“(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.

(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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 Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

APPLICATION OF THE LAW: s. 5(2)(b)

25. The case law relevant to s. 5(2)(b) has been set out recently in several decisions of the European Court of Justice (ECJ), in particular: *Sabel BV v Puma AG* [1998] ETMR 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] ETMR 1 and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77, and can be summarised as follows:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd*, paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and *vice versa*; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(f) 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; *Sabel BV v. Puma AG*, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

Comparison of goods

26. Both parties specify their goods precisely. The opponents' goods are in Class 5, that is: 'Pharmaceutical preparations and substances for human use being decongestants for relief of respiratory conditions', while the applicant's is in Class 3: 'Oils and shampoos for the control of head lice.' On the face of it, they appear to be very different goods. But I do not believe the matter

is as simple as that. A medicated shampoo, for example, could be considered to be a similar product to a pharmaceutical. Fortunately, the case law now contains plentiful advice on the approach one should take in considering similarity of goods.

27. First, I must only consider the goods as they are set out in the specifications as listed. Whatever use is claimed may, or may not, reflect the goods as specified, but is, nevertheless, irrelevant to the right registration grants (see *Origins Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280). Under s. 5(2)(b) notional and fair use of the respective marks for the goods/services contained within the specifications is assumed. The protection granted to the opponents is that bounded by the limits of their specification of goods, not by what they may actually be trading in at a given time: the Registrar will compare mark against mark and specification against specification, and that is what I must consider here.
28. Guidance on the approach to be adopted in comparing goods and services can be found in two main authorities. The first is *British Sugar Plc v James Robertson & Sons Ltd (TREAT)* [1996] RPC 281 at page 296. Adapted to the current case the test proposed by Mr. Justice Jacob involved consideration of the following:

- (a) the uses of the respective goods or services;
- (b) the users of the respective goods or services;
- (c) the physical nature of the goods or services;
- (d) the trade channels through which the goods or services reach the market;
- (f) the extent to which the respective goods or services are competitive.

In its judgment in *Canon*, the ECJ stated at paragraph 23:

“23. 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 end users and their method of use and whether they are in competition with each other or are complementary.”

29. A number of other authorities have dealt with the proper approach to the meaning of particular terms. Terms are to be given their ordinary and natural meaning (see, for example, *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267), And also from the *TREAT* case:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”

30. Finally, the Registrar is entitled to treat the Class number as relevant to the interpretation of the scope of the specification of goods (*Reliance Water Controls Ltd v Altecnic Ltd* [2002] RPC 34).

31. Working through the *Treat* principles, the uses of the goods are different. One is an oral medication for the ‘relief of respiratory conditions’, while the other a topical treatment for a common human parasite. That both are, in the words of Ms. Evans, healthcare products - and that their purpose is the treatment of a medical condition- is certainly the case. However, I cannot help but feel that this description is an example of low resolution definition, like ‘computer program’, that may set its focus too widely. I do not believe that the uses of these two products are the same, any more than saying that the uses of an aeroplanes and a family car are identical because both are employed as forms of transport.
32. The ‘users’ are taken from the same population, that is, members of the general public. Mr. Mitcheson suggested that the users were different: adults with colds or flu and (largely) children with head lice. I think this is based on a misinterpretation of the word ‘user’. I note that *Canon* might be taken to support Mr. Mitcheson’s interpretation – it employs the words ‘end users’ – but, nevertheless, I think that the word here must refer to ‘user’ for services, but ‘purchaser’ for goods (in most cases, the purchaser will be the user). Trade marks are concerned with use in trade, and the process of acquisition is where the mark interacts with buyers, i.e. where trade occurs. At this point, for both sets of goods, the ‘user’ is the same. This is also the view taken by the OHIM Board of Appeal in *Lidl Stiftung & Co KG v. Heinz Iberica SA* [2003] 25 (see, in particular, paragraph 25). Even if I am wrong in my view, it could be argued that children are not the users of the applicant’s goods anyhow: it will be the parents who make the decision to apply the product, and they are the ones who eventually use it (albeit on their progeny).
33. As to the physical nature of the goods and services, as Ms. Evans pointed out, both are liquids, and are sold in cardboard boxes. However, Mr. Mitcheson observed that so was whisky, a product very different from both those under discussion. Again, I think Ms. Evans is simplistically taking too low a resolution definition here: what part of our physical world is not composed of solids, liquids or gases? That the applicant’s products falls into the same category as the opponents is not exactly a stunning coincidence.
34. In answering the question as to whether the nature of the goods is the same, one must look further, and dig deeper. The opponents’ product contains paracetamol, promethazine hydrochloride, dextromethorphan hydrobromide, and also alcohol, sugar and sodium benzoate (see Exhibit GE2). The first three are the active ingredients, being an analgesic, a decongestant and a cough suppressant. They are all clearly pharmaceutical medicines. The way they are listed suggests this, all being cited as ‘Ph. Eur’. I cannot help but feel that the nature of these products is very different from those in the applicant’s product. The latter appear to me to be ingredients not unusually found in goods such as shampoos: ‘Tea Tree Oil’, ‘Eucalyptus Oil’ and ‘Neem Oil.’
35. Against the background of this analysis, I have come to the following conclusions: the uses of the goods are different, the users are the same, the nature is different. They are neither in competition or complementary. As to trade channels, I think it is clear that both can be sold in chemists shops and pharmacies. But I do not regard this as particularly decisive. Many very different products are offered for sale in such establishments. I note the comments of Mr. Mitcheson:

“..we say that there is a distinction between the way in which the products are sold in the chemists themselves. One is definitely a behind-the-counter product -- the opponent’s decongestant. The second, we are told by Mr. Conroy, is traditionally sold behind the counter. I accept that we cannot say it is always sold that way. The evidence does not say that. But either way we say there is a distinction. First, if it is sold behind the counter, then

any consumer requiring that good will have to ask the pharmacist for that good in the first place. Pharmacists are required and trained to ask consumers whether or not they have used the product before. Whether they need any assistance in knowing how to apply that product, what dose to take and generally requiring the consumer to be sure that he or she knows what they are buying. If on the other hand the NIT NURSE product was to be sold on a shelf, again, we say it is in a very different part of the shop to decongestants, there will be a section for shampoos etc in one part of the shop and behind the counter decongestant remedies behind the pharmacist in another. Again, we say that there is a very great distinction to be made in the way these two products are sold and I would remind you of the decision in the *Treat* case where Mr. Justice Jacob concluded that one of the reasons why the goods were different was because they were sold on a different shelf in the same supermarket.”

36. In my view, the products are different, but not significantly different.

The similarity of the marks

37. At the hearing, Ms. Evans contended that the applicant’s livery – which she argued bore more than a passing resemblance to the opponents’ – was a factor I must consider, under the ‘global test’ espoused in *Sabel*. I disagree: this is not what the case law counsels, though it might be relevant to passing off (see the decision of the Appointed Person in BL O/583/01, paragraph 15).

38. As for s. 5(2)(b), the livery of the applicant’s product, and its alleged similarity with the livery of the opponents’ product, is thus not a factor in my considerations. I say this because in the various assessments I will make against each of the grounds pleaded, I can only take cognisance of the trade mark as applied for (the words NIT NURSE solus) together with what I regard to be the notional and fair use of the mark.

39. Livery aside, the marks do have certain similarities. Ms. Evans referred in particular to the visual and aural similarities: the common NURSE, and NIT verses NIGHT. Mr. Mitcheson emphasised the differences,

“Clearly NIGHT NURSE is not a made up word. Both parts of the NIGHT NURSE marks are English words and therefore that should be borne in mind when working out whether they have additional reputation and what sort of meaning they bring to the consumer when the consumer is looking at the product. We should compare the separate word ‘nit’ with the word ‘night’. They have very separate meanings. They are separate and distinct visually. Of course, they have similar letters, but most cases that come before the Registry have similar letters in one way or another. There are an additional two letters in ‘night’. There is an additional hyphen and again, we say, that is a distinction that can be made as, of course, to the aural use of nit verses night. For those reasons, sir, we say that the marks can be distinguished and, in particular, conceptually, we say, that NIGHT NURSE has a very different meaning to NIT NURSE, especially in the context of the use of NIT NURSE as a term to refer to the old-fashioned style of lice inspector that school children of a certain age are used to.”

40. I am not certain that the conceptual similarity between the marks is as far away as Mr. Mitcheson suggests. Both a ‘night nurse’ and a ‘nit nurse’ are nurses of a kind. And, as I discuss further below, in both cases a *product* is being described as a nurse. I think this may well be part of the

opponents' reputation, but it is also an element that is, in my view, indicative of similarity between the marks. Nevertheless, 'night nurse' and 'nit nurse' conjure different impressions in the mind. Though, perhaps, familiarity with the latter is now passing into history, I suspect many adults – the common purchasers of these goods – will be less familiar with the concept.

41. In short, the marks, I believe, are similar, but do not share the overwhelming similarity suggested by Ms. Evans. There are differences as well.

Distinctive Character

42. It is now well established that a mark possessive of a highly distinctive character enjoys greater protection than one that does not (see point (f), above). As *Sabel* makes clear, this benefit can arise from nature or notoriety, that is, a mark with a substantial inherent capacity to distinguish, or one that is well known in the marketplace. No doubt the opponents would argue both on behalf of their mark.

43. I think I would describe the opponents' mark as allusive. It is not descriptive, but neither is it arbitrary. Mr. Mitcheson suggested that the word element NURSE was descriptive. I disagree. As I have already found, the product is described as a person by the mark, and uniquely so in the marketplace. I regard the opponents' mark as a reasonably strong mark.

44. As for its reputation in the marketplace, for my own view, I think that I am prepared to accept that the opponents have a significant reputation. Mr. Mitcheson sought to downplay this on the basis of the evidence they submitted – with some justification I believe – as their evidence on reputation is slender to say the least. In particular, they provide no information on market share, and there is thus no way of knowing how comparatively popular their product is. However, 30 years of use is claimed and the advertising spend is high. Further, I note that the applicant himself recognises the extent of awareness the opponents' product possesses; he states that it:

“... has been so widely advertised that *its identity is clearly recognisable by the public* and unlikely to be confused with any other product.”

45. The first part of this sentence is something of an admission against interest. It accepts the fame of the NIGHT NURSE product, rather coming to the aid of the opponents' somewhat anorexic substantiation of notoriety. For his part, Mr. Mitcheson suggested that the applicant could be making the more subtle point I set out in the next paragraph. I think this is unlikely. The suggestion is that the opponents' fame actually mitigates *against* confusion. I note the following from: (BL O/067/03), paragraph 47:

“Mr Campbell tried to use this reputation against Reckitt. He put forward the argument that owing to the fame of DISPRIN the public would be able to differentiate between other trade marks which did not differ a great deal. Mr Campbell's argument flies in the face of settled European law. The ECJ has decided that marks with a reputation have a greater penumbra of protection, not a lesser one. The logic of Mr Campbell's argument if extrapolated would lead up to trade marks claiming protection under section 5(3) of the Act effectively only being protected if the conflicting trade mark was identical. Reputation can make the weak mark strong; it can lead the consumer where the goods are only slightly similar considering that they emanate from the same economic undertaking or a linked undertaking. Reputation encourages connection by the consumer, it does not

discourage it. Neither does reputation eliminate imperfect recollection.”

In my view, the applicant’s statement amounts to an acknowledgment of the well known status of the opponents’ mark.

46. Nevertheless, I am not convinced that the nature of this reputation helps the opponents establish a likelihood of confusion. The use of their mark has been very specific: it has focused solely on a treatment for the symptoms of colds and flu for thirty years. Though there was an extension to a DAY-NURSE product, and to non-liquid forms of both (Exhibit GE4), this does not represent a diversification in use of the name over a range of medicines. In 1972 NIGHT-NURSE was a pharmaceutical preparation for human use being decongestant for relief of respiratory conditions, that is, colds and flu. It still is some thirty years later. The question might be asked by consumers: ‘Why diversify now, and why this product?’ – a product that is very far removed from that in which they have their established market.

DECISION

47. The global comparison commanded by the case law requires the factoring of a number of inputs into an equation that computes the risk of confusion between two marks as used on their specified goods. Some of these factors will carry extra weighting in one case that they will not so attract in others. Indeed, there may even be a negative weighting under particular circumstances.
48. As I have found, I do not believe that the opponents’ reputation enhances their position under s. 5(2)(b). It is a very specific reputation, relating to colds and flu and, in my view, consumers will not expect that the markers of NIGHT-NURSE, with no history of diversification, would so abruptly take so an unusual departure as to suddenly begin manufacturing a treatment for lice infestation.
49. Nevertheless, as I found above, the opponents’ mark is possessive of a fairly significant inherent capacity to distinguish.
50. The applicant describes his product (and the opponents’) as ‘traditionally’ behind the counter medicines (Conroy, Statement, paragraph 3(i)). This, I take, as equivalent to the opponents’ description of their product as an ‘over the counter’ pharmaceutical (Evans Declaration, paragraph 6). And it introduces a further factor into the equation; the interposition of pharmacy staff between the product and the customer. However, the applicant’s use of the equivocal word ‘traditionally’, rather undermines any certainty I can place on this contention. Nevertheless, both products are both treatments for human ailments and not, as a rule, blasé purchases, particularly for use on children.
51. The similarities between the marks have been discussed: NURSE and NIT verses NIGHT, the latter two words making up the first parts of the marks. Though the difference consists of two letters only, in my view the visual appearance of NIT and NIGHT is very different. The G and H introduce a significant difference in the ‘look’ of the mark.
52. Aurally, it is usually accepted that in English the emphasis falls on the first part of a word, and though NIGHT and NIT each consist of one syllable, night has a ‘longer’ sound.

53. Conceptually, the meaning of these two words is far apart. Nevertheless, as I have noted, both contain the word ‘nurse’, albeit very different types. And there is the conceptual link between the goods in that both are *products* and are called ‘nurse’, something which appears to have been, to date, unique to the opponents’ preparation. The applicant was unable to demonstrate that other products existed on the marketplace which captured this approach. There appeared to be some that referred to a person (‘Nurse Harvey’s’, for example).
54. Finally, there is the difference between the goods, which I have found to be dissimilar. Taking all these factors together, I am unable to conclude that confusion between the marks is a likelihood. I do not believe that consumers of these items will be confused by the word content of the marks. And I do not believe that they might come to the conclusion that the goods are economically linked. Though there will be some association with the famous NIGHT-NURSE product, in the content of the care that would be taken by consumers when buying such products, I do not consider that it would survive the purchasing process, so as to blossom into full grown confusion. This ground fails.

APPLICATION OF THE LAW: s. 5(3)

55. I note the following from the *RARE* trade mark case (BL 0-470-01), where the Hearings Officer, Mr. Allan James, stated:

“51. The purpose and scope of Section 5(3) of the Act has been considered in a number of cases including *General Motors Corp. v Yplon SA (Chevy)* 1999 ETMR 950 and 2000 RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited* 2000 FSR 767 (*Typhoon*), *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42 and *C.A. Sheimer (M) Sdn Bh’s TM Application (Visa)* 2000 RPC 484.

52. The points that come out of these cases are as follows:

- a) ‘Reputation’ for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (paragraph 26 of the ECJ’s judgment in *Chevy*);
- b) Protection is only available where the respective goods or services are not similar (paragraph 29 of the Advocate General’s opinion in *Chevy*);
- c) The provision is not intended to give marks ‘an unduly extensive protection’ - there must be actual detriment or unfair advantage (not merely risks) which must be substantiated to the satisfaction of the national court or tribunal (paragraph 43 of the Advocate General’s Opinion in *Chevy* and paragraph 88 of Pumfrey J’s judgment in the *Merc* case);
- d) The provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with them (per Neuberger J in the *Typhoon* case);
- e) The stronger the earlier mark’s distinctive character and reputation the easier it will be to accept that detriment has been caused to it (paragraph 30 of the ECJ’s judgment in the *Chevy* case);

f) Confusion as to the trade source of the goods or services offered for sale under the later mark is not a necessary condition before there can be detriment, but is one form of detriment (paragraph 88 of Pumfrey J's judgment in the *Merc* case);

g) Detriment can take the form of either making the earlier mark less attractive (tarnishing) or less distinctive - blurring (paragraph 88 of Pumfrey J's judgment in the *Merc* case);

h) Unfair advantage can take the form of feeding on the fame of the earlier mark in order to substantially increase the marketability of the goods or services offered under the later trade mark (per G Hobbs QC in *Visa* at page 505, lines 10-17)."

56. I have already determined that the opponents enjoy a 'Chevy'-type reputation with the public and, following my views expressed above at paragraph 44, the applicant seems to agree. The admission by the applicant rather makes unnecessary the sort of information usually required in assaying the notoriety of the earlier mark, properly highlighted by Mr. Mitcheson:

"In the General Motors [*Chevy*] case and indeed the court put it even more strongly by saying that the national court must take into consideration all the relevant factors of the case, in particular the market share, the intensity, the geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it. Again, sir, you simply do not have enough evidence before you in order to decide that an objection under section 5(3) is made out."

I agree that the opponents' evidence fails to supply some of this information, in particular, that relating to market share. The opponents failure to submit this evidence certainly weakens their case. That this information was available cannot be denied, as Ms. Evans smuggled it into her submissions, though I have ignored it in my considerations here. Nevertheless, there is the admission by the applicant, which essentially amounts to an acknowledgement equivalent to the 'reputation' condition set out in paragraph 29 of *Chevy*, (that 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. Compare 'The Opponent's products has been so widely advertised that its identity is clearly recognisable by the public....', Conroy, paragraph 3 (iv)).

57. Following this conclusion, and my finding that the marks at issue are similar and the goods dissimilar, the qualifications for 'entry' to the grounds under s. 5(3) have been met. The next questions are whether the use of the later mark (without due cause) would:

- (a) take unfair advantage of, or
- (b) be detrimental to

the distinctive character or the repute of the earlier trade mark.

58. Thus there must be injury to the repute or character of the opponents' mark, or there must be some gain to the applicant, by his use of his mark.

59. I have determined the extent of the opponents' reputation, and consider it large. The harm or help the applicant will inflict or gain relates to the character or repute of the earlier mark. They, therefore, impact on (or spring from) the inherent capacity of the mark to distinguish, or on its reputation in the marketplace. Mr. Mitcheson made the following comment:

“Advocate-General Jacobs goes on to say at the end of paragraph 42 that marks should not be given unduly extensive protection and he then refers to the words of the article itself in paragraph 43: ‘It is to be noted in particular that Article 5(2), in contrast to Article 5(1)(b), does not refer to a mere risk or likelihood of its conditions being fulfilled. The wording is more positive: ‘Takes unfair advantage of, or is detrimental to’.’ In other words, there is not a risk of the mark taking unfair advantage or being detrimental to. “Moreover, the taking of unfair advantage or the suffering of detriment must be properly substantiated, that is to say, properly established to the satisfaction of the national court; the national court must be satisfied by evidence of actual detriment or of unfair advantage.”

.... we say that in this case there is no evidence of actual detriment or unfair advantage and for that simple reason you should reject the opposition under section 5(3). These comments were upheld by the Court in the General Motors case.”

60. In my view Mr. Mitcheson is being excessive about the nature and the extent of the evidence under s. 5(3) that is required to show detriment or advantage. I am not sure what he regards as sufficient to meet that requirement. A plethora of Witness Statements from consumers saying they bought the applicant's product because they perceived a connection with the opponents' NIGHT NURSE? Or others stating that they were 'put off' the latter because of the applicant's NIT NURSE product? Surveys contending the same? That this information might be efficacious for the opponents' case is not denied, but I think there is enough evidence already before me to substantiate 'detriment' under s. 5(3), as I will now explain.

61. I have set out my view of the opponents' reputation above: it is large and specific, well established, but defined: they are a longstanding oral remedy for the symptoms of colds and flu. And, in addition, they enjoy a unique position in the marketplace in that their product is described as a 'nurse'; this is a component of the distinctive character of their mark. In this context it seems to me that the applicant has captured a central aspect of the earlier mark's hitherto exclusivity. And, whatever their intention in picking this particular mode of appellation, I do not believe they can but be connected with the opponents' product. Of course, it may well be true that some will be familiar with the expression NIT NURSE, but not all. I suspect that many buying the product would be parents with younger children, and ignorant of the now defunct practice of visiting nurse examining school children's heads for lice and nits (see Exhibit RC3). I do not believe that the applicant's explanation of the choice of their name qualifies as 'due cause' under s. 5(3).

62. In her evidence, Ms Evans referred me to the *Galaxy* case, where chocolate was the successful opponents' primary good under s. 5(3), and the applicant's specification contained, 'preparations for killing weeds and destroying vermin; pesticides, insecticides, herbicides, fungicides.' I think this case is worth extensive quotation:

“The concept that use of a similar or identical sign on dissimilar goods could damage or tarnish, due to potentially damaging connotations, an earlier mark is not an unfamiliar one. In the case of *Claeryn / Klarein* [Benelux Court of Justice 1.3.1975 NJ 1975,472] a mark for gin was said to be damaged by an identical sounding mark for detergent.

Similarly, in *Hack's application* (1941 RPC 91) the proprietors of a well known mark (BLACK MAGIC) which was registered for chocolate and chocolates succeeded in opposing an application to register the same mark for "laxatives other than laxatives made with chocolate". Morton J. found in favour of the proprietors of the earlier mark under Section 11 of the Trade Marks Act 1938 on the basis that there might be confusion in the sense that people might be 'caused to wonder' whether there was a connection in trade between the parties. The circumstances appear similar to those in the *Claeryn/Klarein* case. In both cases the potential for damage to the reputation of the earlier trade mark with consequent damage to its ability to add value to the goods in respect of which the mark had been used is manifest. The case in suit appears to be on all fours with these earlier cases. As Mr Alexander put it, "Who would wish to be reminded of rat poison when eating GALAXY chocolate?". Should GALAXY become an established trade mark for herbicides, insecticides and other toxic products then the question of damage to the value of the GALAXY chocolate mark has to be considered. In my view the unpleasant association would cause the value of the GALAXY chocolate brand to be diminished."

63. Mr. Mitcheson pointed out that the comparison in this case was nowhere near as stark as that between a famous chocolate and a weed killer and pesticide. I agree. But it does not follow that tarnishing will not occur to the opponents' reputation because the differing nature of the goods at issue is not quite so dramatic. We are comparing a well known oral medicine, with a long commercial history, and a treatment for, in the applicant's own words, 'blood sucking insects' (Exhibit RC1) who make their home on the human body. I cannot but help feel that tarnishing of the opponents' reputation will most certainly occur.
64. This is enough to win on this ground, but I also believe that 'blurring' of the opponents' reputation will also result if the mark in suit is registered and used. As I have stated, the opponents are, on the evidence before me, unique in calling their product a 'nurse'. Use of the applicant's mark will tend to diminish this aspect of the distinctive character of the earlier mark.
65. Finally, will the applicant gain any advantage from the opponents' reputation? That is, will that latter be a 'springboard' for the sales of the Nit Nurse product? It requires some connection between the two products that can be short of confusion, but amounts to more than just a 'bringing to mind' of the earlier mark. The following is from BL O/052/03, paragraph 76:

"In *Daimler Chrysler AG v Javid Alavi trading as MERC* [2001] RPC 42 Pumfrey J stated:

'...but Jacobs AG emphasises that the provision is not to be used to give marks 'an unduly extensive protection', emphasising that there is a question of a risk of unfair advantage or detriment: there must be actual unfair advantage or detriment. But, for this to happen, there must be some sort of connection formed (I avoid the word association) between the sign used by the defendant and the mark and its associated reputation'.

A mere association, a bringing to mind, will not do for Intel to succeed. For there to be an unfair advantage I will need to believe that, for instance, people will purchase Digitall's product in the belief that it there is a connection with Intel; that Digitall's trade mark is or will ride on the coat tails of Intel's trade mark, that Digitall will gain sustenance from Intel's trade mark as the mistletoe does from the apple tree."

66. Following my findings under s. 5(2)(b), I remain to be convinced in this case that the applicant will gain some advantage from the opponents' existing reputation that will enhance the sales of their mark. However, the opposition succeeds under this ground on the basis that there will be a detriment to the distinctive character or the repute of the earlier trade mark.
67. The final ground is passing off under s. 5(4)(a). As the opponents have succeeded in their opposition, I do not consider it necessary to deal with this ground in detail. However, following my finding under s. 5(2)(b), I consider it unlikely that the opponents would pass the 'misrepresentation' requirement necessary to establish passing off.
68. The opponents have succeeded, and are entitled to an award of costs. I order the opponents to pay them £1700. This is 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 this 3RD Day of April 2003

**Dr W J Trott
Principal Hearing Officer
For the Registrar.**

DECISION OF THE TRADE MARKS REGISTRY

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION

APPLICANT: RICHARD CONROY

APPLICATION No. 2251340

CLASS 3

AND

OPPONENTS: SMITHKLINE BEECHAM PLC

OPPOSITION No. 80388

NIT NURSE

SUPPLEMENTARY DECISION

1. On 3rd April 2003 I issued a substantive decision in relation to the above opposition. In summary, I found in favour of the opponents, but made the following error in the costs order as follows (paragraph 68):

“The opponents have succeeded, and are entitled to an award of costs. I order the opponents to pay them £1700. This is 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.”

2. Under the power provided by the Registrar's inherent jurisdiction, I correct my decision in these proceedings by amending the second sentence of paragraph 68 to read: “I order the applicant to pay them £1700.”

Dated this 14th Day of April 2003

**Dr W J Trott
Principal Hearing Officer
For the Registrar.**