

O-122-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2495889
BY SWIRL PRODUCTS LIMITED TO REGISTER A
TRADE MARK IN CLASSES 3 & 5**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 98404 BY SMITH KLINE BEECHAM LIMITED**

BACKGROUND

1. On 22 August 2008, Swirl Products Limited (“Swirl”) applied to register **NIT NURSE** as a trade mark for the following goods in classes 3 and 5:

Class 3:

Shampoos; hair care products; hair lotions; sun creams; suncare products; aftersun preparations; cosmetics; soaps; perfumery; essential oils; dentifrices; skin lotions; skin care products; skin cleansing preparations; personal hygiene products in class 3.

Class 5:

Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; preparations for destroying lice in the hair.

2. The application was accepted and published for opposition purposes on 10 October 2008 in Trade Marks Journal No.6756.

3. On 10 December 2008, SmithKline Beecham p.l.c. (now SmithKline Beecham Limited) (“SKB”) filed a notice of opposition. This consisted of grounds based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (as amended) (the Act). In their Statement of Grounds SKB indicate that the opposition (which is based upon the following trade marks), is directed against all of the goods in the application for registration:

Trade Mark	No:	Application Date	Registration date	Goods
NIGHT-NURSE	999527	6/10/1972	12/4/1974	Pharmaceutical preparations and substances for human use being decongestants for relief of respiratory conditions.
COUGH NURSE	2357359	3/3/2004	30/7/2004	Pharmaceutical preparations and substances.
DAY NURSE	1091865	2/3/1978	27/3/1980	Pharmaceutical preparations and substances, all for human use and all being decongestants for relief of respiratory conditions.
DAY & NIGHT NURSE	2301711	29/5/2002	8/11/2002	Pharmaceutical preparations and substances.

4. Insofar as the objection based upon section 5(2)(b) of the Act is concerned, SKB say the following in relation to their various trade marks:

NIGHT-NURSE:

“...The element NIT at the beginning of the mark NIT NURSE is both visually and phonetically similar to a very high extent to the word NIGHT at the beginning part

of the mark NIGHT-NURSE. The first two letters of the opposed mark NI are identical to the first two letters of the earlier trade mark and the last letter T is identical also. The application and the earlier trade mark both consist of two single syllable words and end in the identical suffix NURSE.”

5. SKB’s comments in respect of the trade mark DAY & NIGHT NURSE are much the same, albeit they recognise that the word NIGHT forms only a part of the trade mark.

6. In relation to the trade marks COUGH NURSE and DAY NURSE SKB say:

“The application and the earlier trade mark both consist of two single syllable words and end in the identical suffix NURSE.”

7. Finally, in relation to all of their trade marks SKB say:

“The goods “pharmaceutical preparations” covered by the opposed application in class 5 are identical to the goods covered by the earlier trade mark[s]. The remaining goods covered by the opposed application are similar to those covered by the earlier trade marks.

In the circumstances, there is a likelihood of confusion including a likelihood of association and this is made all the more so given the identity, alternative high similarity, of the respective goods. The relevant public are likely to have an imperfect recollection of the respective marks and therefore be confused. In addition, due to the opponent, owning and using a series of marks ending in the suffix NURSE the relevant public may be confused into thinking that there is a connection between the opponent and the applicant in terms of the opponent introducing sub-brands using the NURSE suffix.”

8. In relation to their objection under section 5(3) of the Act, SKB say in relation to their NIGHT NURSE trade mark:

“The opponent has made substantial extensive and continuous use of its NIGHT NURSE mark in relation to pharmaceutical preparations and substances for the treatment of colds, chills and influenza since 1975. This use has been supported by national advertising campaigns including via television and other media. As a result, the opponent has significant reputation in the earlier trade mark. The applicant’s use of NIT NURSE will be without due cause and will take unfair advantage of and/or be detrimental to the distinctive character or repute of the earlier trade mark.

In particular, the applicant’s use of NIT NURSE constitutes “riding off the coat tails” of the earlier trade mark, given the latter’s reputation in the earlier trade mark and its series of marks ending in the suffix NURSE, in order to promote the opposed mark for human healthcare products of a different type in relation to which the opponent does not and would not use its NIGHT NURSE mark.

In addition or alternatively, the applicant's use of NIT NURSE in relation to the opposed goods will tarnish the reputation of the earlier trade mark and its series of trade marks ending in the element NURSE particularly in relation to use on a treatment for nits.

In addition or alternatively, the applicant's use of NIT NURSE in relation to the opposed goods will blur the opponent's reputation in the earlier trade mark and its series of trade marks ending in the element NURSE".

9. SKB repeats these arguments for the other trade marks pleaded, noting that COUGH NURSE has been used since 2004, DAY NURSE since 1978 and DAY & NIGHT NURSE since 2002.

10. On 18 February 2009 Swirl filed a counterstatement. While this consists, in essence, of a denial of the grounds upon which the opposition is based, I note that Swirl admit that SKB have used their NIGHT NURSE trade mark since 1975 in relation to preparations for the treatment of colds, chills and influenza, adding that this use has not, in their view, changed since 1975. However, Swirl do not admit that SKB have a reputation in the other trade marks pleaded and I note that in boxes 5 and 6 of their counterstatement they indicate that they require SKB to provide proof of use in relation to "All goods and services". The following extracts taken from Swirl's counterstatement will, I think, give a flavour of the basis of their defence to the opposition:

"1. It is denied that [the goods contained in SKB's registrations] are identical or similar to those specified [in Swirl's application].

2. The opponent's mark does not cover [Swirl's goods in class 3] or "preparations for destroying lice in the hair", and as such the two marks will not be used in the same market.

3. The uses of the goods associated with each mark are different, and the natures of the goods themselves are different. The goods associated with each mark are neither complementary or in competition. Furthermore, the goods associated with the mark NIT NURSE would be sold in a different part of a shop to decongestants. There will be one section for shampoos and head lice treatment, and a separate section for decongestants.

4. [In relation to the comparison between the trade marks NIT NURSE and NIGHT NURSE] it is submitted that the differences i.e. the G and H of the mark NIGHT NURSE, introduce a significant difference in the look and sound of the mark. Furthermore, the G and H change the conceptual meaning of the mark significantly...the marks are clearly distinguishable by the purchasing public.

5. [In relation to the objection based upon section 5(3) of the Act] the opponent's reputation is a very specific reputation, relating to colds and flu.

6. The opponent appears to be submitting that they have a reputation in all marks ending in the suffix NURSE. However, the opponent is not unique in the marketplace in using the suffix NURSE in a trade mark to allude to a product being a “nurse”. A number of other marks containing the word NURSE have been entered on the UK trade mark register. More particularly, a number of marks have been registered containing the suffix NURSE, and which use the word NURSE to refer to a product as a person [a number of examples are provided]. Therefore, the opponent is not unique in the marketplace in using the suffix NURSE in a trade mark to allude to a product being a person.

7. The relevant public would be aware that there are a number of different products with different trade origins having the suffix NURSE in their brand name. Therefore, the use of the suffix NURSE in the applicant’s trade mark would not lead the relevant public to assume that the product had the same trade origin as products bearing [SKB’s trade marks]. This is especially true in view of the very specific reputation of the opponent.”

11. Both parties filed evidence. While neither party asked to be heard both parties filed written submissions which I will refer to as necessary below.

EVIDENCE

SKB’s evidence

12. This consists of a witness statement, dated 26 May 2009, from Emma Stopford who is the Vice President and Trade Mark Counsel of GlaxoSmithKline Services Unlimited which, together with SKB, is part of the GlaxoSmithKline group of companies (GSK). Ms Stopford, who has worked for GSK since 2001, confirms that the information in her statement comes from her own knowledge or from the records of GSK and SKB. SKB is, explains Ms Stopford, a manufacturer and merchant of consumer healthcare products both in the United Kingdom and worldwide.

13. Ms Stopford states that SKB have used their earlier trade marks (for the goods for which they stand registered) from the dates indicated in paragraphs 8 and 9 above, which for ease of reference are:

NIGHT-NURSE – 1975, DAY NURSE – 1978, DAY & NIGHT NURSE – 2002, COUGH NURSE – 2004.

14. Exhibit ESS1 consists of photographs of the current packaging of goods bearing the trade marks mentioned in paragraph 3, packaging which Ms Stopford says has not changed since 2001. Exhibit ESS2 contains sales figures achieved under the various trade marks between (where appropriate) 1994 and 2008. I note that sales (in £) between 2003 and 2008 were as follows:

Trade mark	2003	2004	2005	2006	2007	2008
NIGHT-NURSE	3,577, 421	2,943,726	3,457,727	4,042,623	4,408,469	5,471,048
DAY NURSE	2,160,566	1,726,941	1,809,619	1,926,704	1,912,992	2,558,543
DAY & NIGHT NURSE	1,213,311	1,121,502	1,265,295	1,652,783	1,934,014	2,799,617
COUGH NURSE	-	241,419	116,049	164,240	131,430	113,568

15. Exhibit ESS3 consists of a number of invoices issued by GSK to either AAH Pharmaceuticals Ltd of Warrington or Sants Pharmaceutical Dist Ltd of Manchester (which Ms Stopford describes as wholesale distributors). The invoices are dated January, February and March 2002, January 2003, February 2004, April and September 2005, March and August 2006, January and September 2007 and January and April 2008. I note that all of SKB's trade marks mentioned in paragraph 3 appear in one or more of the invoices provided.

16. Ms Stopford explains that that the earlier trade marks have been used extensively both individually and as a family of trade marks, on a wide selection of advertising and promotional materials in the United Kingdom. I note that advertising of the products is seasonal (taking place between November and February) with expenditure in the period November 2000 to February 2008 amounting to some £7.2m in respect of television advertising, £1m in respect of radio advertising and £92k in respect of regional press advertising.

17. Ms Stopford says that the three advertisements provided as exhibit ESS5 show that:

“...the public has been educated to identify the word NURSE on its own as being indicative of the origin of the products belonging to our NURSE range of products in addition to the individual earlier trade marks.”

18. Ms Stopford explains that the first advertisement (for the DAY NURSE and NIGHT NURSE products) entitled “Nurse it BETTER” appeared in pharmacy windows nationwide from 31 December 2001 to 6 January 2002. The remaining two advertisements (both directed at the trade) and entitled “NURSES GET 20% EXTRA FUNDING” and “It’s true. Nurses are totally dedicated” respectively, are both said to date from the winter of 2000-2001 and refer to, inter alia, advertising budgets of £2.4m (for 2000) and £2m.

19. Ms Stopford describes exhibit ESS6 as:

“copies of a collection of publications referring to the products sold [under the trade marks shown in paragraph 3] and associated advertising campaigns.”

20. I note that the dates of the copies provided range from October 2007 to January 2009 and are taken from trade publications such as: P3, Pharmacy Magazine, Chemist & Druggist, Over The Counter and Training Matters. The extracts provided speak, inter alia, to the success of “the Nurses range” and the support provided by GSK in terms of television and radio advertising campaigns.

21. Exhibit ESS7 consists of a CD containing examples of television and radio advertising aired in the United Kingdom featuring the NIGHT NURSE and DAY & NIGHT NURSE trade marks all of which it appears were transmitted prior to the filing of Swirl’s trade mark application. Exhibit ESS8 contains details of the radio stations on which the advertisement mentioned above appeared, together with information on, inter alia, the number of times the advertisement was played and the numbers of listeners likely to have heard the advertisement. Exhibit ESS9 consists of a poster for the Night Nurse product which Ms Stopford explains appeared in pharmacies nationwide during 2006.

22. Exhibit ESS10 consists of photographs of pharmacies which displayed advertisements for (it appears) the Day & Night Nurse product in the period 2 to 28 January 2007. The locations shown in the photographs are: Combe Down, Swindon, Chippenham, Bristol, Chester, Bagillt, Holywell, Rhyl and Wrexham. Exhibit ESS11 consists of details of market share data for the NURSE range of products from May 2008 and May 2009. This appears to show that the NURSE range enjoyed a 15.8% share of the “MultiSymptom” market in 2008, a percentage share which reduced to 15.3% in May 2009.

23. Ms Stopford explains that SKB’s investigations:

“have not revealed the use of NURSE as a suffix for a product name for goods falling within classes 3 and 5 by any other third party”.

24. In addition, she states that a review of the Saegis Pharmaceuticals In Use database:

“did not reveal any other UK trade marks including the suffix NURSE for pharmaceutical products falling within class 5.”

25. Exhibit ESS12 consists of the results of on-line searches (conducted on 15 and 19 May 2009) for the term NURSE which Ms Stopford explains was “input into the search box for the pharmacy stores”. The results taken from the following websites: www.boots.com, www.pharmacy2u.co.uk, www.rolandspharmacy.co.uk and www.asda-pharmacy.co.uk, indicate that of the 24 retrievals, 20 related to the trade marks in paragraph 3; the other uses were, in SKB’s view, either descriptive or used the word NURSE as a prefix as in “Nurse Harvey’s Gripe Mixture.”

26. Exhibit ESS14 consists of a copy of the registrar’s decision dated 3 April 2003 in Opposition No. 80388 in relation to the trade mark NIT NURSE applied for by Richard

Conroy on 3 November 2000 in respect of “Oils and shampoos for the control of head lice”, which was opposed by SKB under sections 5(2)(b) and 5(3) (based on trade mark No. 999527) and section 5(4)(a) of the Act. I note that SKB failed under section 5(2)(b), were likely to fail under section 5(4)(a), but succeeded under section 5(3) of the Act. Exhibit ESS15 consists of a copy of a letter dated 3 November 2007 from GSK to Swirl’s professional representatives Appleyard Lees drawing their attention to this decision and asking if their client would be prepared to voluntarily withdraw their application for registration.

27. Having provided submissions on the competing goods at issue in these proceedings (including providing at exhibit ESS16 extracts from www.about.com (2002), Martindale The Extra Pharmacopoeia (1996) and www.bupa.co.uk (February 2008) which relate, inter alia, to the differing ways in which head lice and nits may be treated), Ms Stopford then goes to compare the competing trade marks. She says:

“Additionally, given the common use of the misspelling of the word NIGHT as NITE in advertising this increases the likelihood of confusion in the mind of the purchaser from a visual and aural perspective.”

28. Exhibit ESS17 consists of extracts obtained from the internet on 26 May 2009 some of which are from the United Kingdom e.g. www.babipur.co.uk, www.sillyjokes.co.uk and www.yell.com, which contain the word “Nite” being used as an alternative to the word “Night”. However, in some instances the use may be seen as trade mark use as opposed to use in a descriptive sense.

29. Finally, Ms Stopford provides submissions on what she considers will be the damage and detriment to SKB’s trade marks. She says:

“That reputation is likely to suffer damage through the use of the Applicant’s confusingly similar mark for goods which are likely to tarnish the reputation of [SKB’s trade marks]. In particular, if, as the Applicant has alluded to, the Applicant’s mark is to be used for a range of treatments for head lice or other human parasites this will impact detrimentally on [SKB’s trade marks] and the reputation they have acquired through long standing use given the unpleasant connotations associated with this condition. Nits and headlice are a nasty and unpleasant condition viewed with derision by others.”

30. Exhibit ESS18 consists of seven cartoons in which the punch line relates either directly or indirectly to nits or head lice. Ms Stopford goes on to say:

“the Opponent has spent significant sums of money over an extended period of time marketing products under [SKB’s trade marks] and educating the consumers that the NURSE suffix indicates products produced by the Opponent. There is no evidence to show that the NURSE suffix is commonly used by third parties for class 3 or 5 goods. Therefore, the Applicant’s adoption of the NIT NURSE trade mark will take unfair advantage of the investment made by the

Opponent.... It will also result in the “blurring” of that reputation, in particular in relation to the distinctive character of the NURSE suffix.”

Swirl’s evidence and written submissions

31. This consists of a witness statement, dated 18 March 2010, from Richard Waddington who is a trade mark attorney at Appleyard Lees, Swirl’s professional representatives in these proceedings. Mr Waddington explains that his evidence is drawn from information provided to him by Swirl and from internet searches conducted by staff at his firm. Exhibit KB1 consists of a printout obtained from www.ipo.gov.uk on 10 March 2010 which Mr Waddington explains:

“...gives details of marks which are on the UK trade mark register and which contain the word NURSE.”


I note that the search produced 35 results in a range of classes.


32. Exhibit KB2 consists of what Mr Waddington describes as “a series of extracts” which I note were obtained on the same date and from the same website mentioned above. Of these extracts Mr Waddington says:

“These extracts give details of trade marks on the UK register which contain the word NURSE as a suffix, and which are not owned by the Opponent. These marks are all registered/applied for in respect of pharmaceutical products, healthcare products, and other complimentary goods and services. Therefore, these marks are all registered/applied for in respect of goods and services which are similar to those of the Opponent’s trade marks.”

The trade marks contained in exhibit KB2 are as follows:

Trade Mark	No:	Application date	Registration date	Goods and services
MINI NURSE	E3601689	8/1/04 IC date 18/7/03 (France)	22/6/05	Perfumes, eaux de toilette; bath and shower gels and salts not for medical purposes; toilet soaps; personal deodorants; cosmetics, in particular creams, milks, lotions, gels and powders for the face, body and hands; sun-tanning milks, gels and oils and after-sun preparations (cosmetics); makeup preparations; hair wash; gels, mousses, balms and preparations in aerosol form for hairdressing and haircare; hair lacquers; hair-colouring and hair-decolorizing preparations; preparations for waving and setting hair; essentials oils.


 <p>Registration of this mark shall give no right to the exclusive use of a device of a nurse.</p>	1066617	2/8/76	12/5/81	<p>3 - Anti-perspirants; perfumes; non-medicated toilet preparations, cosmetic preparations, shampoos and soaps.</p> <p>5 –Pharmaceutical preparations and substances; deodorants, antiseptics, germicides, antifungal substances; materials included in Class 5 impregnated with, or incorporating, any of the aforesaid goods; first aid outfits (sold complete); bandages (other than elasticated bandages), materials prepared for bandaging; medical and surgical plasters, surgical dressings; antiseptics and medicinal preparations impregnated into wipes or tissues; cotton wool for pharmaceutical use; and lint for medical purposes; but not including decongestants for the relief of respiratory conditions.</p>
<p>BABY NURSE</p> <p>Registration of this mark shall give no right to the exclusive use, separately, of the words "Baby" and "Nurse".</p>	1095726	17/5/78	11/10/79	<p>5 - Pharmaceutical and sanitary preparations and substances, medicated preparations for the care of the skin; all for babies.</p>
<p>Nurse It</p>	2487133	9/5/08	10/10/08	<p>5 - Packs of sterile dressings containing the following: 1 x Sterile Laminated Paper Field (50cm x 50cm), 1 x Powder Free Latex Gloves (Medium), 7 x 10cm x 10cm 4 Ply Non-Woven Swabs, 1 x Paper Towel (45cm x 50cm), 1 x Polythene Disposable Yellow Bag (46cm x 26cm), 1 x Compartment Tray, 2 x Plastic Forceps.</p>
<p>The Pocket Nurse</p>	2421619	11/5/06	10/11/06	<p>5 - Pharmaceuticals; medicines and dressings.</p> <p>16 – Printed publications.</p> <p>44 - Nursing advice; medical services; pharmaceutical advice.</p>
<p>BREAST NURSE</p>	2348458	12/11/03	16/4/04	<p>10 - Medical apparatus; gel pads filled with gel material, pads for medical use, pads which provide a cooling and/or soothing effect.</p>
<p>POCKET NURSE</p>	2463872	10/8/07	7/3/08	<p>10 - Medical supplies for</p>

				education, namely, stethoscopes, cleaning enema apparatus; spill kits consisting primarily of gloves, an isolation bag, a towel, and a disposable germicidal wipe in a plastic bag; EKG rulers, namely, a plastic medical tool useful for reading electrocardiogram printouts; personal protection kits consisting primarily of an isolation gown, a cap, a face mask, gloves and shoe covers; eye charts; wound measuring guides; bandages; stethoscope ID tags; goniometers; face masks; caps; shoe covers; isolation gowns; gait belts; pill counter trays; CPR face shield insert; and physical assessment kits consisting primarily of a stethoscope, a blood pressure cuff, a hammer, scissor polish, a tuning fork, a penlight and a fanny pack.
 <p>EMERGENCY nurse</p> <p>EMERGENCY nurse</p> <p>EMERGENCY nurse</p> <p>EMERGENCY nurse</p> <p>Series of 5</p> <p>Proceeding because of distinctiveness acquired through use.</p>	2158602	18/2/98	11/8/00	<p>16 - Periodical magazines, all relating to emergency nursing care.</p> <p>35 - Advertising and marketing services, all provided through a magazine relating to emergency nursing care.</p>

33. Exhibit KB3 consists of pages downloaded from www.pocketnurse.com on 10 March 2010. Of these pages Mr Waddington says:

“The website offers pharmaceutical products for sale. The website can be easily found from a Google search of UK based pages when submitting the term “pocket nurse”. The extract from the website clearly indicates that the term Pocket Nurse (device) is in use in respect of pharmaceutical products.”

This is a reference to trade mark No. 2463874 details of which can be found in exhibit KB1 but not in exhibit KB2. The relevant details are as follows:

Trade Mark	No:	Application date	Registration date	Goods
	2463874	10/8/07	7/3/08	10 - Medical supplies for education, namely, stethoscopes, cleaning enema apparatus; spill kits consisting primarily of surgical gloves, an isolation bag, a towel, and a disposable germicidal wipe in a plastic bag; EKG rulers, namely, a plastic medical tool useful for reading electrocardiogram printouts; personal protection kits consisting of an isolation gown, a surgical cap, a surgical mask, surgical gloves and surgical shoe covers; eye charts; wound measuring guides; stethoscope ID tags; goniometers; surgical masks; surgical caps; surgical shoe covers; isolation gowns; gait belts; pill counter trays; CPR face shield insert; and physical assessment kits consisting primarily of a stethoscope, a blood pressure cuff, a hammer, scissor polish, a tuning fork and a penlight.

34. Exhibit KB4 consists of pages downloaded from www.amazon.co.uk on 12 March 2010. Of these pages Mr Waddington says:

“The website extract shows the product BREAST NURSE being offered for sale within the UK.”

I note that the pages provided refer to the breast nurse product by Oscar + Dehn whereas the owner of the BREAST NURSE trade mark mentioned above is Florri Feme Pharmaceuticals Ltd. Swirl also filed written submissions dated 18 March 2010; I will refer to the submissions as necessary below.

SKB’s evidence-in-reply

35. This consists of a second witness statement, dated 7 June 2010, from Ms Stopford. Ms Stopford’s statement consists primarily of submissions on Swirl’s evidence; once again I will refer to these submissions as necessary below. That said, I note that Ms Stopford provides three exhibits to her statement; these are as follows:

Exhibit ESS19 consists of pages downloaded on 20 May 2010 from www.bbc.co.uk in relation to the use of the glottal stop in the English language. Applying the comments contained in this article to these proceedings Ms Stopford concludes:

“The article notes that “it is relatively common for an average native-speaker of British English to drop the final “tee” of a word..., “In garages and offices all over the country, those words will be pronounced without a trace of a “tee” to be

heard, and perfectly understood". Those garages and offices, it may be surmised, would clearly be occupied by average consumers in the UK. Therefore, it is reasonable to deduce from this that the pronunciation of the first word of the Opponent's mark may well be pronounced as "nigh". It would also follow that the first word of the Applicant's mark would also be pronounced in an identical fashion, i.e. as the sound "nigh", rendering the two marks aurally identical and indistinguishable to the average consumer."

36. Exhibit ESS20 is filed in response to a comment contained in Swirl's written submissions of 18 March 2010 which said:

"8. Moreover, by virtue of the nature of the products associated with the earlier trade marks, it is obvious that they will be used internally. This use is clearly dissimilar from the use of products of the present application which, by virtue of the nature of the goods specified, are clearly for external use on the body."

37. The exhibit consists of pages downloaded on 20 May 2010 from www.olbas.co.uk, www.vicks.co.uk and www.4headaches.co.uk which, in Ms Stopford's view demonstrate that:

"The earlier trade marks may now or in the future be potentially used on any number of products which could be taken orally, applied to the skin topically, or inhaled – namely a diversity of delivery methods are possible."

I note that the Olbas product (which assists breathing) is available in the form of an oil, as an inhaler, as pastilles, as menthol lozenges, as a vaporiser, as tissues and as a bubble bath; the Vick product is supplied as a hand foam which neutralises colds and other germs and in the form of a rub which relieves colds and congestion and which can either be applied to the chest and back or melted into hot water and the resulting steam inhaled; the 4Head product (which treats headaches) comes in the form of either a stick or a hydro-gel patch which are then either rubbed into or placed onto the forehead.

38. Exhibit ESS21 consists of pages downloaded on 25 May 2010 from www.pocketnurse.com filed in response to Swirl's comments at paragraph 33 above. Ms Stopford points out, inter alia, that the website shows pricing of goods exclusively in dollars, that the address is shown as Pittsburgh, USA and that the products on the website are:

"sold for instructional use only and are not for general consumer, personal, direct or indirect human or animal use."

Ms Stopford concludes that:

"Sales of products from the Pocket Nurse website are not intended for general consumer use and the channels of trade differs to that of both the Applicant's and Opponent's goods. Therefore the existence of this US based website does not

conclusively confirm that the mark POCKET NURSE has been used in the UK to any extent which would affect the reputation built up in the NIGHT NURSE and other earlier trade marks of the opponent.”

39. Insofar as the BREAST NURSE product mentioned in paragraph 34 is concerned, Ms Stopford says that given the nature of the device sold under this name and the very specific consumer at whom it is targeted, the use of this trade mark would not, in her view, affect the reputation built up in SKB’s trade marks.

40. That concludes my summary of the evidence filed in these proceedings to the extent that I consider it necessary.

DECISION

41. The first ground of opposition is based upon section 5(2)(b) of the Act which reads as follows:

“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, or

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

42. 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, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

43. In these proceedings SKB are relying on the registered trade marks shown in paragraph 3 above, all of which have application dates prior to that of the application for

registration which was filed on 22 August 2008; as such, they all qualify as earlier trade marks under the above provisions. The application for registration was published for opposition purposes on 10 October 2008 and SKB's earlier trade marks were registered on 12 April 1974, 27 March 1980, 8 November 2002 and 30 July 2004 respectively. With the exception of trade mark No. 2357359 (COUGH NURSE) SKB's earlier trade marks are subject to The Trade Marks (Proof of Use, etc) Regulations 2004. As I noted above, in their counterstatement Swirl ask SKB to provide evidence of the use they have made of their earlier trade marks in relation to "all goods and services". The relevant sections of the Proof of Use Regulations read as follows:

"6A Raising of relative grounds in opposition proceedings in case 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).”

Proof of use

44. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of publication of Swirl’s application for registration i.e. 11 October 2003 to 10 October 2008.

45. The leading authorities on the principles to be applied when determining whether there has been genuine use of a trade 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 principles:

- 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).

46. In addition, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to

decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

47. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

48. Finally, the comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (España), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

49. The goods for which SKB’s earlier trade marks are registered can be found in paragraph 3 above. They are described as either “pharmaceutical preparations and substances” (at large), or those goods “being for human use and being decongestants for relief of respiratory conditions”. Having considered SKB’s evidence as a totality, and having applied the principles outlined above, I have no hesitation in concluding that the use that SKB have made of their earlier trade marks (which are subject to proof of use) has been genuine (a view which Swirl appear to share – see below). Having reached that conclusion, I must first determine as a matter of fact on what goods SKB’s trade marks have been used.

50. I note that in their Notice of Opposition (albeit under section 5(3) of the Act) SKB say of all of their earlier trade marks:

“[SKB] have made substantial, extensive and continuous use of its ...mark in relation to pharmaceutical preparations and substances for the treatment of colds, chills and influenza...”

51. In paragraph 30 of her witness statement dated 26 May 2009 Ms Stopford said:

“The use of the family of NURSE suffixed marks by the Opponent and subsequent reputation has expanded since the launch of the NIGHT NURSE product in the 1970s. Since then the product range has expanded into cough treatments as well as cold and flu preparations.”

52. In paragraph 22 of their written submissions dated 18 March 2010 Swirl said:

“...It is submitted that all of these preparations and treatments are, at their broadest, in the field of respiratory ailments. However, the products would normally all be classed as cold and flu remedies, since coughs are usually associated with colds and flu. Therefore, the Opponent’s reputation subsists only in the field of cold and flu remedies. This is supported by the extensive evidence provided by the Opponent that shows use of the earlier trade marks only in this field.”

53. In paragraph 16 of their written submissions dated 10 August 2010 Swirl said:

“...It is not disputed by the Applicant that the Opponent has a reputation in the suffix NURSE when applied to products in the cold and flu remedy market. However, the NIGHT NURSE family of products has been in existence since at least 1972, and has never been extended to cover products outside of the cold and flu remedy market. Therefore, the Opponent cannot claim a reputation for the earlier marks which extends beyond the cold and flu remedy market.”

54. From the extracts reproduced above, there appears to be a measure of agreement between the parties as to the goods on which SKB’s trade marks have been used i.e. SKB describe the goods on which their trade marks have been used as, inter alia, “pharmaceutical preparations and substances for the treatment of colds, chills and influenza” whereas Swirl describe them as “cold and flu remedies.” This is not surprising given that a review of SKB’s evidence (see for example exhibits ESS1 and ESS5) describes the NIGHT NURSE, DAY NURSE and DAY & NIGHT NURSE products as being for “colds and flu” and (insofar as it is relevant) the COUGH NURSE product as being a liquid which “relieves night-time dry, tickly coughs.” In my view the evidence shows that SKB have used their trade marks (which are subject to proof of use) in relation to “pharmaceutical preparations and substances for the treatment of colds, chills and influenza.”

55. Having reached that conclusion I must now determine what constitutes a fair specification. In making a determination on this point I must decide how the average consumer would describe SKB’s goods. The goods on which SKB have used their trade marks are everyday consumer items that can be found on any high street; they are goods with which the average consumer is very familiar. As a consequence of that

familiarity the average consumer will, in my view, describe SKB's goods as cold and flu remedies.

56. Insofar as the NIGHT NURSE and DAY NURSE registrations are concerned I note that they are already limited to: "Pharmaceutical preparations and substances, all for human use and all being decongestants for relief of respiratory conditions." In view of my findings above, and keeping in mind the existing wording of the specifications concerned, I think a fair specification would read:

"Pharmaceutical preparations and substances for human use being decongestants for the relief of colds and influenza."

57. However, that is not the case for the DAY & NIGHT NURSE and COUGH NURSE registrations (the latter of which is not subject to proof of use and to which I will return in a moment) both of which are registered for "pharmaceutical preparations and substances" at large. The phrase pharmaceutical preparations and substances is a very broad one and would include pharmaceutical products and substances for a multiplicity of uses. In this regard the comments in *Reckitt Benckiser (España), SL v OHIM* are relevant. In that case it was held that if a trade mark is registered for a specification of goods:

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

58. In my view the use SKB have made of their DAY & NIGHT NURSE trade mark has only been in relation to a sub category of the goods for which it stands registered i.e. for cold and influenza remedies as opposed to for pharmaceutical preparations and substances at large. Consequently, insofar as the DAY & NIGHT NURSE registration is concerned, a specification identical to that mentioned above would be appropriate for the purposes of further comparison. However, as the COUGH NURSE registration is not subject to proof of use, it will be necessary for me to consider the specification as registered.

Section 5(2)(b) – case law

59. In reaching a decision I must take into account the guidance provided by the European Court of Justice (ECJ) in a number of judgments germane to this issue. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & 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* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

It is clear from all these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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 Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* 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) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;
- (f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;
- (g) 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;
- (h) 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;
- (i) 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;
- (j) 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 + Adidas Benelux BV*, paragraph 41;

(k) 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.

The average consumer and the nature of the purchasing decision

60. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade.

61. The goods on which SKB have used their trade marks i.e. cold and influenza remedies are relatively inexpensive everyday consumer items which will be bought (with varying degrees of frequency) by the general public when the need arises. Insofar as the COUGH NURSE trade mark is concerned, this stands registered for pharmaceutical preparations and substances at large. This is a broad term which will encompass a wide range of disparate goods. Whilst it would include goods capable of selection by the general public, it would also include a range of goods many of which would only be selected by those with specialist medical knowledge.

62. Turning now to the goods in Swirl's application, many of the same considerations apply. For example, shampoos, hair care products, hair lotions, sun creams, suncare products, aftersun preparations, cosmetics, soaps, perfumery, essential oils, dentifrices, skin lotions, skin care products, skin cleansing preparations, personal hygiene products and preparations for destroying lice in the hair are, (for the most part), relatively inexpensive everyday consumer items which again will be bought with varying degrees of frequency by members of the general public. Insofar as pharmaceutical and veterinary preparations and sanitary preparations for medical purposes are concerned, my comments above in relation to pharmaceutical preparations and substances at large are relevant.

63. As to how SKB's cold and influenza remedies will be selected, these are the sort of goods which, in my experience, the average consumer is likely, for the most part, to select from a shelf in a retail establishment (such as a chemist's or supermarket). In those circumstances, the visual characteristics of the trade mark are likely to be the most important. However, I am also aware that in some retail settings the goods may be displayed behind the counter making it necessary for the average consumer to ask for the goods by name, thus bringing aural considerations into play. Although the goods are relatively inexpensive, given that they consist of a range of cold and influenza remedies which are (at present) to be ingested, the average consumer will want to ensure that they choose the right product for their particular symptoms and as a consequence will, I think, pay a reasonable level of attention to their selection. Insofar as many of the goods falling within the phrase pharmaceutical preparations and substances at large would be aimed at the general public, many of the same considerations would apply. Turning to those goods which fall within the phrase pharmaceutical preparations and substances

which are aimed at medical professionals, I have no information as to how this average consumer is likely to select the goods at issue. That said, given that they are likely to be selecting the goods on a commercial basis and with (potentially) a range of specialist applications in mind, it is likely that not insignificant sums of money will be in play. As to the selection process itself, I think this is likely to involve, inter alia, familiarising themselves with the products in question by reviewing specialist literature (both in hard copy and on-line) and following discussions with representatives from pharmaceutical companies. All of this suggests to me that this average consumer is for the most part likely to pay a high level of attention to the selection of the goods.

64. Insofar as shampoos, hair care products, hair lotions, sun creams, suncare products, aftersun preparations, cosmetics, soaps, perfumery, essential oils, dentifrices, skin lotions, skin care products, skin cleansing preparations, personal hygiene products and preparations for destroying lice in the hair are concerned, these are the sort of goods which, in my experience, the average consumer is likely, for the most part, to select on much the same basis as SKB's cold and influenza remedies i.e. by the eye from the shelf of a chemist's or supermarket and with a reasonable degree of care given that they are, inter alia, to be used in or on the body. That said, for some of these goods (preparations for destroying lice for example) which are not bought as frequently, the average consumer may wish to take advice prior to their selection; in that situation aural considerations will also come into play. Finally, insofar as pharmaceutical and veterinary preparations and sanitary preparations for medical purposes are concerned, the considerations I have outlined above in relation to pharmaceutical preparations and substances apply with equal force.

Comparison of goods

65. In line with my findings above, the goods to be compared are as follows:

SKB's goods	Swirl's goods
Pharmaceutical preparations and substances for human use being decongestants for the relief of colds and influenza (in respect of registration Nos: 999527,1091865 and 2301711) And: Pharmaceutical preparations and substances (in respect of 2357359)	Class 03: Shampoos; hair care products; hair lotions; sun creams; suncare products; aftersun preparations; cosmetics; soaps; perfumery; essential oils; dentifrices; skin lotions; skin care products; skin cleansing preparations; personal hygiene products in class 3. Class 05: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; preparations for destroying lice in the hair.

66. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the ECJ accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (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.

67. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05, at paragraph 29 the General Court said:

“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 (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42.”

68. In view of the comments in the above case, it is clear that the pharmaceutical preparations and substances in SKB's registrations (whether limited or not) are identical to the pharmaceutical preparations appearing in Swirl's application. I will now compare the goods for which SKB have proven use with Swirl's goods in class 3. While the physical nature of some of the competing goods may be the same, for example, they may both be supplied in the form of a liquid and while the users of the competing goods

may also be the same i.e. the general public, that level of generality tells one very little. More important, in my view, are the intended purpose of the competing goods and whether they are either in competition or are complementary to one another. Insofar as the latter is concerned, I note that in case T-325/06 *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* the Court of First Instance (now the General Court) said:

“It is true that goods are complementary if 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 that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

69. The purpose of SKB's goods is to alleviate the symptoms of colds and influenza, whereas the purpose of Swirl's goods in class 3 is (broadly speaking) to clean, maintain, protect or beautify (the hair, skin or teeth). The intended purpose of the competing goods and their current methods of use are, in my view, quite different. In addition, the goods are neither in competition with one another nor (can they in light of the guidance in *Boston Scientific*) be considered complementary. While both sets of goods will be sold in retail outlets such as chemists or supermarkets, at least insofar as the latter is concerned, my own experience tells me they will be sold in different parts of the supermarket (although that may not be true in, for example, a small chemist store). In summary, while the competing goods may share the same nature and users, the differences in the intended purpose and method of use of the goods, combined with the fact that the goods are neither in competition nor complementary to one another suggests to me that any degree of similarity that exists is at a very low level.

70. Insofar as Swirl's goods in class 5 are concerned, I must once again first approach the comparison on the basis of the goods for which SKB have proven use. In view of the comments in *Gérard Meric* mentioned above, I have already concluded that the phrase pharmaceutical preparations appearing in Swirl's application must be regarded as identical to the goods on which SKB have proven use. Comparing the goods on which SKB have proven use with the veterinary preparations appearing in Swirl's application, it appears to me that while the nature and users of the goods may once again be the same, the intended purpose of the competing goods is likely to be quite different. As the competing goods are, in my view, neither in competition with nor complementary to one another, once again if there is any similarity it must be at a very low level. Comparing the sanitary preparations for medical purposes which appear in Swirl's application with the goods on which SKB have established use, other than the users of the competing goods, I can find no meaningful areas of coincidence; once again if there is any similarity is at a very low level. That leaves me to compare the preparations for destroying lice in the hair with the goods on which SKB have proven use. Once again

the nature and users of the goods may be the same but the intended purpose and current method of use is quite different and the goods are not in competition with nor complementary to one another. In view of the above if there is any similarity it must once again be at a very low level.

71. I will now compare the goods contained in registration No. 2357359 (which was not subject to proof of use) and the goods contained in class 3 of Swirl's application. Registration No. 2357359 is registered in respect of pharmaceutical preparations and substances at large. As I mentioned earlier this, in my view, is a very broad term which would include a wide range of goods including, for example: medicated preparations for protection of the skin from the sun, medicated skin cleansing preparations, medicated preparations for personal hygiene, perfumed body sprays for medical use and, of course, preparations for destroying lice in the hair. In essence, many of Swirl's non-medicated goods in class 3 find their medicated counterpart in class 5. In those circumstances, the nature, intended purpose and method of use of the competing goods are likely to be much the same as will the users. In addition, the goods may either be in competition with one another or may be considered to be complementary. Consequently, in my view, there is a high degree of similarity between pharmaceutical preparations and substances at large in class 5 and all of the goods in class 3 of Swirl's application.

72. That leaves the comparison between the goods contained in registration No. 2357359 (which was not subject to proof of use) and the goods contained in class 5 of Swirl's application. Registration No. 2357359 is registered in respect of pharmaceutical preparations and substances at large. As I mentioned above this term is identical to the term pharmaceutical preparations appearing in Swirl's application and is, in my view, broad enough to also include pharmaceuticals for use as veterinary preparations and preparations for destroying lice in the hair. That leaves sanitary preparations for medical purposes. This phrase includes, inter alia, goods which are used to treat a range of health related conditions, including those which give rise to issues of cleanliness and the prevention of infection. They are likely, in my view, to be used by the same users in conjunction with specific pharmaceutical preparations and substances. As a result, there is, in my view, a high degree of similarity between the competing goods.

Comparison of trade marks

73. For the sake of convenience, the trade marks to be compared are as follows:

SKB's trade marks	Swirl's trade mark
NIGHT-NURSE COUGH NURSE DAY NURSE DAY & NIGHT NURSE	NIT NURSE

74. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does

not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives

75. SKB's position is that Swirl's NIT NURSE trade mark is similar to each of their earlier trade marks and to a family of trade marks owned by them which end in the suffix NURSE. In approaching the family of trade marks argument I will keep in mind the comments of the Appointed Person Professor Ruth Annand in *The Infamous Nut Company Limited v Percy Dalton (Holdings) Limited* (BL O/411/01) when she said:

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

36. Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by section 6). Thus 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).

37. 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, p. 235). 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."

76. The comments of the ECJ in *Case C-234/06 P Il Ponte Finanziaria SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* are also relevant. The court said:

"63. The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically 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 or considers erroneously that that trade mark is part of that family or series of marks.

64. As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market."

77. While the above cases confirm that it is necessary for me to begin by comparing each of SKB's trade marks with the trade mark of Swirl, I note that in their evidence and written submissions both parties concentrate on the comparison between the NIGHT NURSE and NIT NURSE trade marks; this suggests (that at least insofar as the comparison of trade marks is concerned) both parties agree that the NIGHT NURSE trade mark represents SKB's best case; I agree. If SKB are unable to succeed on the basis of their NIGHT NURSE trade mark they are unlikely to be in any better position in relation to the other trade marks they rely upon all of which contains prefix elements which are less similar to Swirls' NIT NURSE trade mark. However, it appears to me that SKB has in effect two "best cases" i.e. that mentioned above in relating to the competing trade marks and, insofar as the competing goods are concerned, the COUGH NURSE trade mark (which is not subject to proof of use) and the specification of which places SKB in a stronger position than that applicable to their other trade marks.

78. The competing trade marks consist of the words NIGHT and NIT in the prefix position accompanied by the identical word NURSE in the suffix position (the hyphen between the words NIGHT and NURSE is, in my view, insignificant and is likely to go unnoticed as its positioning does not alter the meaning of the words it separates). The words NIGHT, NIT and NURSE are all well known dictionary words. Although the words NIGHT and NIT appear before the word NURSE, as the words NIGHT and NIT are likely to be seen by the average consumer as an indication of the time of day when SKB's goods are to be taken (or when their effects will be most beneficial), or the condition that the goods are designed to treat, neither word is, in my view, distinctive of the goods on or for which it has been used or applied (in this respect, I wonder quite how Swirl intend to use the NIT NURSE trade mark on non NIT related goods such as dentifrices).

79. As to the word NURSE, SKB claim that this element is distinctive of their goods. In response to this claim Swirl have filed evidence showing that there are a number of trade marks on the United Kingdom and Community trade registers which are not owned by SKB which contain the word NURSE and which are applied for or registered for what Swirl describe as:

"pharmaceutical products, healthcare products, and other complimentary goods and services".

80. State of the register evidence tells one little. In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04* the General Court (GC) stated:

“68. As regards the search of the Cedexlex database, the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word ‘bus’ is used descriptively by public transport businesses.”

81. This was a view re-iterated by the GC in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06.* While I am aware of the judgment of Mr Daniel Alexander QC, sitting as a deputy judge of the High Court, in *Digipos Store Solutions Group Ltd v Digi International Inc* [2008] RPC 24, in that case Mr Alexander was not referred to the judgment of the GC in *GfK AG*. I also note that in his judgment Mr Alexander referred to the *Madame* case being an absolute grounds case and appeared to consider this of some significance. The GC cases referred to above are relative grounds cases; clearly the GC considered that the principle of not giving weight to state-of-the-register evidence also applies in cases involving relative grounds issues.

82. Of the trade marks identified by Swirl only two appear to have been used (the searches being conducted on 10 and 12 March 2010 i.e. after the material date in these proceedings). The first is in relation to the POCKET NURSE trade mark which is registered for a range of goods in class 10 in the name of PocketNurse Enterprises Inc. In their evidence in reply SKB commented on this use pointing out that the website shows that PocketNurse Enterprises Inc are based in the United States, that the pricing of goods on their website is in dollars and that the goods sold are for instructional use only and not for, inter alia, general consumer use.

83. The second is in relation to the BREAST NURSE trade mark which stands registered in class 10 in the name of Florri Feme Pharmaceuticals Limited although the use shown in exhibit KB4 is by Oscar + Dehn. In their evidence-in-reply SKB comment on the nature of the device sold under this trade mark and the very specific consumer at which it is aimed.

84. As I pointed out above, the state of the register evidence does little to assist me. Insofar as the two trade marks on which use may have been shown are concerned, the dates of the searches are of concern (although I note that the BREAST NURSE product was available on the Amazon website from as early as 15 March 2007). However, the more telling point is that both trade marks relate to goods which are quite different to those on which SKB have proven use (although there may be a more general

connection with the broader goods contained in the COUGH NURSE trade mark). In short, the state-of-the-register evidence and the examples of use do not assist Swirl.

85. The word NURSE is of course well known in a medical context i.e. as a noun referring to a person who tends the sick, injured or infirm or as a verb meaning to tend the sick. When considered in isolation in relation to SKB's goods the word is likely to be seen by the average consumer as a reference to a product which nurses (tends to) its user; as a consequence, it is, in my view, a word with at best only a low degree of inherent distinctive character for such goods. The same conclusion applies to the use of the word in relation to the majority of the goods in Swirl's application.

86. In summary I have concluded that the NURSE element is likely to be marginally more distinctive than the words NIGHT or NIT. However, its aptness for use in relation to goods of a medical nature combined with its positioning in the competing trade marks, leads me to conclude that neither trade mark has a truly distinctive or dominant element. In my view, the distinctiveness of each trade mark (including the COUGH NURSE trade mark to which the same considerations apply) lie in their totalities rather than in the individual elements of which they are composed.

87. I now turn to the visual, aural and conceptual comparison with those conclusions in mind; I have described the competing trade marks above. Insofar as the NIT NURSE and NIGHT NURSE trade marks are concerned, they both consist of two words presented separately; the first word in each trade mark consists of three and five letters respectively with each word beginning with the letters NI and ending with the letter T; the second word in each trade mark is identical. The competing trade marks are, in my view, visually similar to a reasonable degree. As to the COUGH NURSE trade mark, while the second word in each trade mark is identical, the first words share no visual similarity; these trade marks are, in my view, visually similar albeit to a much lower degree.

88. The manner in which the NIGHT NURSE and NIT NURSE trade mark will be articulated/heard has been the subject of much debate in both the evidence and written submissions.

89. In their written submissions dated 18 March 2010 Swirl said:

“4. Finally, the mark NIT NURSE is phonetically significantly different from the mark NIGHT NURSE. The letters G and H in the mark NIGHT-NURSE elongate the I sound in the mark...”

90. In response to this comment SKB filed evidence in relation to the use of the glottal stop in the English language concluding:

“Therefore, it is reasonable to deduce from this that the pronunciation of the first word of the Opponent's mark may well be pronounced as “nigh”. It would also follow that the first word of the Applicant's mark would also be pronounced in an

identical fashion, i.e. as the sound “nigh”, rendering the two marks aurally identical and indistinguishable to the average consumer

91. In my view both trade marks consist of two single syllable words the pronunciation of which will be well known to the average consumer; the pronunciation of the word NURSE would be identical. Insofar as the words NIGHT and NIT are concerned, these are, as I mentioned above, well known words in the English language. While the use of the glottal stop cannot be overlooked, in my view, its effects on the pronunciation of such well known words as these will be minimal; the word NIT contains a short vowel sound whereas NIGHT or NIGH would both contain a long vowel sound. However, the fact that both trade marks begin with the letters NI and share the identical word NURSE, results, in my view, in a reasonable degree of oral/aural similarity between them. As to the COUGH NURSE trade mark, while the second word in each trade mark is identical, the first words share no aural similarities; once again these trade marks are, in my view, aurally similar but to a much lower degree.

92. Finally, I turn to consider the conceptual position. In their written submissions dated 18 March 2010, Swirl said:

“The marks are significantly different conceptually. The word NIGHT in the mark NIGHT-NURSE implies a time. On the other hand, the mark NIT in the word NIT NURSE implies a condition...”

93. In her witness statement dated 7 June 2010 Ms Stopford said:

“2. The mark NIT NURSE does not imply a condition, but rather a nurse (carer) who examines patients for the condition of head lice and/or nits. The conceptual meaning of the mark NIGHT NURSE implies a nurse (carer) who works during the night time...”

94. The words NIGHT and NIT have quite different meanings. At a general level I agree with SKB that the conceptual message the average consumer is likely to take from both trade marks is one of a nurse (carer). However, the more specific conceptual messages the trade marks are likely to convey are of a nurse who works at night and a nurse who specialises in the treatment of head lice. While the conceptual meaning of the words NIT NURSE (as a reference to e.g. an individual who used go into schools to examine children for head lice) will be familiar to some, it will, I am sure, have no specific meaning for others. Insofar as the COUGH NURSE trade mark is concerned, I think the same considerations are likely to apply i.e. that the general conceptual message sent by this trade mark will be one of a nurse (carer) and the specific conceptual message will be of a nurse who specialises in coughs.

Distinctive character of SKB’s earlier trade marks

95. I must now assess the distinctive character of SKB’s trade marks. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in

respect of which it has been registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

96. In my view the trade mark NIGHT-NURSE is allusive rather than descriptive of the goods for which it stands registered; considered absent use, it is, in my view, possessed of a reasonable degree of inherent distinctive character. However, the evidence shows that SKB have used their NIGHT NURSE trade mark since 1975 (a point which Swirl admit). All of the use made has been in respect of (broadly speaking) pharmaceutical preparations for the treatment of colds and influenza. Sales of the NIGHT NURSE product in the period 2003 to 2008 amounted to some £24m, with promotional expenditure (for all of SKB's earlier trade marks) in the period 2000 to 2008 (which included, inter alia, television and radio advertising) amounting to some £8.3m. In addition, by 2008 SKB's NURSE range of products enjoyed a 15.8% share of the "Multisymptom" market. In my view, the use made by SKB of their NIGHT NURSE trade mark since 1975 has resulted in it acquiring a high degree of distinctive character. Insofar as the COUGH NURSE trade mark is concerned, this has only been used since 2004. While it shares its inherent distinctive qualities with the NIGHT NURSE trade mark i.e. it is allusive rather than descriptive, the use made of it since 2004 (approximately £800k) is insufficient, in my view, to improve the trade mark's inherent credentials to any appreciable extent (although I accept that it may have benefited from its association with the other NURSE trade marks.)

Likelihood of confusion

97. In determining whether there is a likelihood of confusion, 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 and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of SKB's NIGHT NURSE and COUGH NURSE trade marks as the more distinctive these trade marks are the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.

98. Turning first to the NIGHT NURSE trade mark, I have concluded that: (i) the pharmaceutical preparations for which SKB have proven use are identical to the pharmaceutical preparations at large for which Swirl have sought registration, (ii) in relation to the other goods in Swirl's application if any similarity exists it is at a very low level, (iii) that neither trade mark has a distinctive or dominant component, the

distinctiveness lying in the totalities, (iv) the competing trade marks share a reasonable degree of both visual and aural similarity, send similar general but different specific conceptual messages and (v) SKB's trade mark has as a result of the use made of it since 1975 acquired a high degree of distinctive character. Applying these conclusions to the matter at hand, I have decided that even where the goods are identical, the very well known meaning of the first word in each trade mark combined with the degree of attention which the average consumer is likely to pay when selecting the goods is likely to mitigate against both direct and indirect confusion and the opposition based upon the NIGHT NURSE trade mark fails accordingly.

99. As to the COUGH NURSE trade mark, I have concluded that: (i) the pharmaceutical preparations and substances for which this trade mark is registered are identical to the pharmaceutical preparations at large for which Swirl have sought registration and that they are highly similar to the other goods in Swirl's application, (ii) that neither trade mark has a distinctive or dominant component, the distinctiveness lying in the totalities, (iii) the competing trade marks share a much lower degree of visual and aural similarity than the NIT NURSE/NIGHT NURSE trade marks, send similar general but different specific conceptual messages and (iv) the use SKB have made of their COUGH NURSE trade mark since 2004 has not improved upon its inherent distinctive character to any appreciable extent. As a consequence of these conclusions, I have decided that notwithstanding the identity/high level of similarity in the goods, once again the well known meaning of the words that form the prefixes of the competing trade marks combined with the degree of attention which the average consumer is likely to pay when selecting the goods is likely to avoid either direct or indirect confusion and the opposition based upon the COUGH NURSE trade mark also fails.

100. That leaves SKB's argument regarding their family of trade marks containing the suffix NURSE, the approach to which I have outlined at paragraphs 75 and 76 above. The evidence shows that SKB have used all of their earlier trade marks prior to the filing of Swirl's application for registration. The earliest use for the NIGHT NURSE product dates from 1975, followed by the introduction of DAY NURSE in 1978, DAY & NIGHT NURSE in 2002 and COUGH NURSE in 2004. I have no doubt that by the time of Swirl's application the use SKB had made of their various trade marks ending with the NURSE suffix would have been sufficient for them to establish a family of NURSE trade marks in the mind of the average consumer. However, this use would only have been in respect of (broadly speaking) pharmaceutical preparations for the treatment of colds and influenza. It should be noted that while SKB were able to rely upon the full width of the specification for their COUGH NURSE trade mark above, when considering this trade mark as a member of a family of trade marks, it is the use that has been made of the trade mark that matters. In their statement of case SKB said that they had made use of this trade in relation to "pharmaceutical preparations and substances for the treatment of colds, chills and influenza". Strictly speaking this is true, although the use is actually in respect of a liquid for the treatment of "night time dry coughs." So, does SKB's family argument advance its case under section 5(2)(b)?

101. The average consumer would at the time of the filing of Swirl's application been familiar with a family of SKB's trade marks ending with the NURSE suffix used in relation to pharmaceutical preparations for the treatment of colds and influenza. I concluded above that while these goods would be identical to the pharmaceutical preparations at large contained in Swirl's application any similarity they shared with the other goods in Swirl's application must be very low. In my view the difference between the specific meanings that would be conveyed to the average consumer by the word NIT appearing in Swirl's application (as compared to the meanings of the words NIGHT, COUGH, DAY and DAY & NIGHT appearing in SKB's family of trade marks), combined with the nature of the purchasing decision is sufficient to avoid the average consumer associating Swirl's trade mark with the family of trade marks owned by SKB and assuming an economic connection. SKB's opposition based on their family of NURSE trade marks fails accordingly.

Section 5(3)

102. The final objection is based upon section 5(3) of the Act. Section 5(3) of the Act reads as follows:

“(3) A trade mark which –

(a) 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 Community trade mark or international trade mark (EC) 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.”

103. As there is nothing in Swirl's evidence or submissions which indicates that it is relying on the defence of due cause, I need say no more about it.

104. In order to get an objection based upon section 5(3) of the Act off the ground, SKB must prove that their earlier trade marks both individually and collectively (if they wish to rely upon a family of trade marks) have a reputation. Reputation, for the purposes of section 5(3) of the Act, means that the earlier trade mark is known by a significant part of the public concerned with the products or services covered by that trade mark (paragraph 26 of the ECJ's judgment in *General Motors Corp. v Yplon SA (CHEVY)* [1999] ETMR 122). Here again I intend to proceed on the assumption that it is the NIGHT NURSE trade mark which provides SKB with their best prospect of success.

105. In their statement of grounds SKB framed their objection under section 5(3) in the following terms:

“In particular, the applicant's use of NIT NURSE constitutes “riding off the coat tails” of the earlier trade mark, given the latter's reputation in the earlier trade

mark and its series of marks ending in the suffix NURSE, in order to promote the opposed mark for human healthcare products of a different type in relation to which the opponent does not and would not use its NIGHT NURSE mark.

In addition or alternatively, the applicant's use of NIT NURSE in relation to the opposed goods will tarnish the reputation of the earlier trade mark and its series of trade marks ending in the element NURSE particularly in relation to use on a treatment for nits.

In addition or alternatively, the applicant's use of NIT NURSE in relation to the opposed goods will blur the opponent's reputation in the earlier trade mark and its series of trade marks ending in the element NURSE".

106. In her witness statement dated 26 May 2009 Ms Stopford said:

"29...That reputation is likely to suffer damage through the use of the applicant's confusingly similar mark for goods which are likely to tarnish the reputation of the earlier trade marks. In particular, if as the applicant has alluded to, the applicant's mark is to be used for a range of treatments for head lice or other human parasites this will impact detrimentally on the earlier trade marks and the reputation they have acquired through long standing use given the unpleasant connotations associated with this condition. Nits and headlice are a nasty and unpleasant condition viewed with derision by others...

30....it is conceivable that a consumer may believe that the applicant's marks is an extension to the current NURSE product range.

31. As demonstrated above, the opponent has spent significant sums of money over an extended period of time marketing products under the earlier trade marks and educating the consumers that the NURSE suffix indicates products produced by the opponent. There is no evidence to show that the NURSE suffix is commonly used by third parties for class 3 or 5 goods...."

107. In her witness statement dated 7 June 2010 Ms Stopford said:

"15. As demonstrated above the opponent may now or in the future potentially use any of the earlier trade marks on a range of products with different delivery methods or expanding uses in the related goods category. Confusion of consumers may therefore be caused due to the similarity of the trade marks, where consumers may assume that the products under the respective trade marks may be complementary, related or that the range of products sold by the opponent has expanded.

108. I note that in the decision dated 3 April 2003 (exhibit ESS14) the Hearing officer concluded that the use of the trade mark NIT NURSE in relation to "oils and shampoos for the control of head lice" in class 3 would both tarnish and blur the reputation SKB

enjoyed in their NIGHT NURSE trade mark, although I note he remained unconvinced that the applicant in those proceedings would gain any unfair advantage from the use of the NIT NURSE trade mark. I will return to this decision below.

109. In *Intel Corporation Inc v CPM United Kingdom Ltd* Case C-252/07 the Court of Justice of the European Union (CJEU) considered Article 4(4)(a) of Directive 2008/95/EC of the European Parliament and the Council of 22 October 2008 (the Directive), which is the basis of section 5(3) of the Act:

“26 Article 4(4)(a) of the Directive establishes, for the benefit of trade marks with a reputation, a wider form of protection than that provided for in Article 4(1). The specific condition of that protection consists of a use of the later mark without due cause which takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark (see, to that effect, in respect of Article 5(2) of the Directive, *Marca Mode*, paragraph 36; *Adidas-Salomon and Adidas Benelux*, paragraph 27, and Case C-102/07 *adidas and adidas Benelux* [2008] ECR I-0000, paragraph 40).

27 The types of injury against which Article 4(4)(a) of the Directive ensures such protection for the benefit of trade marks with a reputation are, first, detriment to the distinctive character of the earlier mark, secondly, detriment to the repute of that mark and, thirdly, unfair advantage taken of the distinctive character or the repute of that mark.

28 Just one of those three types of injury suffices for that provision to apply.

29 As regards, in particular, detriment to the distinctive character of the earlier mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is notably the case when the earlier mark, which used to arouse immediate association with the goods and services for which it is registered, is no longer capable of doing so.

30 The types of injury referred to in Article 4(4)(a) of the Directive, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see, in relation to Article 5(2) of the Directive, *General Motors*, paragraph 23; *Adidas-Salomon and Adidas Benelux*, paragraph 29, and *adidas and adidas Benelux*, paragraph 41).

31 In the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

32 However, the existence of such a link is not sufficient, in itself, to establish that there is one of the types of injury referred to in Article 4(4)(a) of the Directive, which constitute, as was stated in paragraph 26 of this judgment, the specific condition of the protection of trade marks with a reputation laid down by that provision.

37 In order to benefit from the protection introduced by Article 4(4)(a) of the Directive, the proprietor of the earlier mark must adduce proof that the use of the later mark 'would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark'.

38 The proprietor of the earlier trade mark is not required, for that purpose, to demonstrate actual and present injury to its mark for the purposes of Article 4(4)(a) of the Directive. When it is foreseeable that such injury will ensue from the use which the proprietor of the later mark may be led to make of its mark, the proprietor of the earlier mark cannot be required to wait for it actually to occur in order to be able to prohibit that use. The proprietor of the earlier mark must, however, prove that there is a serious risk that such an injury will occur in the future.....

44 As regards the degree of similarity between the conflicting marks, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public. That is particularly the case where those marks are identical.

45 However, the fact that the conflicting marks are identical, and even more so if they are merely similar, is not sufficient for it to be concluded that there is a link between those marks.

46 It is possible that the conflicting marks are registered for goods or services in respect of which the relevant sections of the public do not overlap.

47 The reputation of a trade mark must be assessed in relation to the relevant section of the public as regards the goods or services for which that mark was registered. That may be either the public at large or a more specialised public (see *General Motors*, paragraph 24).

48 It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the

earlier mark, although it has a reputation, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.

49 Furthermore, even if the relevant section of the public as regards the goods or services for which the conflicting marks are registered is the same or overlaps to some extent, those goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public.

50 Accordingly, the nature of the goods or services for which the conflicting marks are registered must be taken into consideration for the purposes of assessing whether there is a link between those marks.

51 It must also be pointed out that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered.

52 In such a case, it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered will make a connection between the conflicting marks, even though that public is wholly distinct from the relevant section of the public as regards goods or services for which the earlier mark was registered.

53 For the purposes of assessing where there is a link between the conflicting marks, it may therefore be necessary to take into account the strength of the earlier mark's reputation in order to determine whether that reputation extends beyond the public targeted by that mark.

54 Likewise, the stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind.

55 Accordingly, for the purposes of assessing whether there is a link between the conflicting marks, the degree of the earlier mark's distinctive character must be taken into consideration.

56 In that regard, in so far as the ability of a trade mark to identify the goods or services for which it is registered and used as coming from the proprietor of that mark and, therefore, its distinctive character are all the stronger if that mark is unique – that is to say, as regards a word mark such as INTEL, if the word of which it consists has not been used by anyone for any goods or services other than by the proprietor of the mark for the goods and services it markets – it must be ascertained whether the

earlier mark is unique or essentially unique.

57 Finally, a link between the conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically-linked undertakings (see to that effect, inter alia, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17, and Case C-533/06 *O2 Holdings and O2 (UK)* [2008] ECR I-0000, paragraph 59).

58 However, as is apparent from paragraphs 27 to 31 of the judgment in *Adidas-Salomon and Adidas Benelux*, implementation of the protection introduced by Article 4(4)(a) of the Directive does not require the existence of a likelihood of confusion.

59 The national court asks, in particular, whether the circumstances set out in points (a) to (d) of Question 1 referred for a preliminary ruling are sufficient to establish a link between the conflicting marks.

60 As regards the circumstance referred to in point (d) of that question, the fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark would call the earlier mark to mind is tantamount to the existence of such a link.

61 As regards the circumstances referred to in paragraphs (a) to (c) of that question, as is apparent from paragraph 41 to 58 of this judgment, they do not necessarily imply the existence of a link between the conflicting marks, but they do not exclude one either. It is for the national court to base its analysis on all the facts of the case in the main proceedings.

62 The answer to point (i) of Question 1 and to Question 2 must therefore be that Article 4(4)(a) of the Directive must be interpreted as meaning that whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

63 The fact that for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.

64 The fact that:

- the earlier mark has a huge reputation for certain specific types of goods or services, and
- those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
- the earlier mark is unique in respect of any goods or services, does not necessarily imply that there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.”

Reputation

110. The evidence provided, which includes numerous references to the success of the NIGHT NURSE trade mark and indeed to the NURSE range of trade marks in general, leaves me in no doubt that the use that has been made of the NIGHT NURSE trade mark since 1975 has resulted in it acquiring a reputation in the United Kingdom for pharmaceutical preparations and substances for human use being decongestants for the relief of colds and influenza; this is also likely to be true of the DAY NURSE and DAY & NIGHT NURSE trade marks which have also been used on a substantial scale since 1978 and 2002 respectively. However, the position is somewhat less certain in relation to the COUGH NURSE trade mark which was not introduced until 2004.

The Link

111. In determining whether a link would be created I need to bear in mind a number of factors. These include that the competing trade marks share a reasonable degree of both visual and aural similarity and send similar general conceptual messages, that the NIGHT NURSE trade mark has acquired a high degree of distinctive character, that the respective goods are in some respects identical and where the degree of similarity in the goods is only at a low level both parties' trade marks are directed at the same average consumer i.e. the general public, and finally that in relation to the goods for which it has been used SKB's use of the NURSE suffix appears to be unique. However, even when used on identical goods, given the very well known meaning of the word NIT, I remain unconvinced, that Swirl's NIT NURSE trade mark will call SKB's NIGHT NURSE trade mark to mind and in so doing form the necessary link in the mind of the average consumer.

112. However, even if a link is established this would not of itself establish unfair advantage or detriment to the distinctive character or the repute of SKB's NIGHT NURSE trade mark.

113. In *L'Oreal SA and others v Bellure NV and others* the CJEU defined what is meant by unfair advantage:

“41 As regards the concept of ‘taking unfair advantage of the distinctive

character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It 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.

50 In the light of the above, the answer to the fifth question is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation 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 proprietor of the mark in order to create and maintain the mark's image."

114. SKB have to establish that there would be an advantage and that it would be unfair. It is to be noted that the CJEU refers to the third party seeking to take advantage, ie a conscious decision being made. The question of the unfair aspect was considered by Lloyd LJ in *Whirlpool Corporations and others v Kenwood Limited* [2009] EWCA Civ 753:

"136. I do not consider that Kenwood's design involves anything like a transfer of the image of the KitchenAid mark, or of the characteristics which it projects, to the goods identified by Kenwood's sign (see *L'Oréal v Bellure* paragraph 41). Of course, as a newcomer in a specialist market of which KitchenAid had a monopoly, and being (necessarily) in the basic Cshape of a stand mixer, the kMix would remind relevant average consumers, who are design-aware, of the KitchenAid Artisan. That, however, is a very different phenomenon, in very different commercial circumstances, from the situation considered in *L'Oréal v Bellure*. I find the Court's judgment instructive, but it does not seem to me to lead to the conclusion in favour of Whirlpool for which Mr Mellor contends. On the contrary, having rejected his radical submission that the word "unfair" could just as well have been left out of the article, it seems to me that the decision points away from, rather than towards, liability under the article on the facts of the present case. It is not sufficient to show (even if Whirlpool could) that Kenwood has obtained an advantage. There must be an added factor of some kind for that advantage to be categorised as unfair. It may be that, in a case in which advantage can be proved, the unfairness of that advantage can be demonstrated by something other than intention, which was what was shown in

L'Oréal v Bellure. No additional factor has been identified in this case other than intention.”

115. This matter was also considered by Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch):

“160. Thus something more than mere advantage is required. It must be an unfair advantage. Lloyd LJ seems to state that an advantage is rendered unfair if it is intended. He also leaves open the possibility that unintended advantage may have a sufficient quality of unfairness about it to qualify.”

116. There is no evidence that Swirl sought to take advantage of the reputation of SKB and no additional factors have been identified. According to the CJEU “the proprietor of the earlier mark must adduce proof that the use of the later mark ‘would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark’.” In *Mäurer + Wirtz GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-63/07 the GC stated:

“40 It is possible, particularly in the case of an opposition based on a mark with an exceptionally high reputation, that the probability of a future, non hypothetical risk of detriment to the earlier mark or of unfair advantage being taken of it by the mark applied for is so obvious that the opposing party does not need to put forward and prove any other fact to that end. However, it is also possible that the mark applied for does not, at first sight, appear capable of giving rise to one of the risks covered by Article 8(5) of Regulation No 40/94 with respect to the earlier mark with a reputation, even though it is identical with or similar to the earlier mark, in which case the non-hypothetical, future risk of detriment or unfair advantage must be established by other evidence, which it is for the opposing party to put forward and prove (Case T-215/03 *Sigla v OHIM – Elleni Holding (VIPS)* [2007] ECR II-711, paragraph 48).”

117. The risk must be more than hypothetical; it cannot, in my view, simply be inferred. In the absence of evidence to support SKB’S claims that Swirl’s NIT NURSE trade mark will take unfair advantage of or be detrimental to the distinctive character or repute of SKB’s NIGHT NURSE trade mark and in the absence of any additional factors being identified, SKB’S claims based on “riding off the coat tails” and “blurring” are dismissed.

118. In *L’Oreal SA and others v Bellure NV and others* Case C-487/07 the CJEU considered tarnishment:

“40 As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power

of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.”

119. In my view there is nothing inherent in the vast majority of goods for which Swirl have sought registration that would result in the tarnishing of SKB's NIGHT NURSE trade mark. In reality the evidence and submission provided make it palpably clear that this particular arm of SKB's opposition based upon section 5(3) of the Act is directed at the” preparations for destroying lice in the hair” which appears in the class 5 element of Swirl's application.

120. In their written submissions dated 18 March 2010, Swirl said:

“21...it is stated that nits and head lice are a nasty and unpleasant condition. However, it is submitted that the opponent is in the field of pharmaceutical products and, therefore, is also in the field of providing alleviation for nasty and unpleasant conditions. A person cannot control whether or not they contract head lice in the same way that a person cannot control whether or not they contract a cold or flu. Having head lice does not make a person dirty or unhygienic. In fact, it is a well known fact that head lice are more easily contracted if a person has clean hair. There is, therefore, nothing to be ashamed of if a person contracts head lice.”

121. I note that in his decision of 3 April 2003 (exhibit ESS14), the Hearing Officer commented on this issue in the following terms:

“63 [Counsel] 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 opponent's 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” who make their home on the human body. I cannot help but feel that that tarnishing of the opponent's reputation will most certainly occur.”

122. Having considered SKB's evidence (exhibit ESS18) and submissions on the tarnishing point, and despite the Hearing Officer's conclusions in the earlier proceedings, I remain unconvinced that the use of Swirl's NIT NURSE trade mark will have the adverse consequences SKB suggest. As both sets of goods are for the treatment of illnesses of one sort or another over which the sufferer has no control, and while I accept that (historically at least) sufferers of nits may have been exposed to a degree of teasing, nits are a fairly common affliction and I do not think that the average consumer (who is considered to be reasonably well informed) will be so disgusted by the thought of nits that the use of the NIT NURSE trade mark will have any material impact on the image the average consumer has of SKB's NIGHT NURSE trade mark.

123. Having reached those conclusions in relation to the NIGHT NURSE trade mark, and while despite my comment above in relation to the COUGH NURSE trade mark I am prepared to proceed on the basis that SKB have the necessary reputation in each of their earlier trade marks and in a family of trade marks which contain the NURSE suffix, this does not, in my view, assist SKB. None of the earlier trade marks when considered individually are as close to Swirl's NIT NURSE trade mark as the NIGHT NURSE trade mark nor do they have the same degree of reputation. While I am prepared to accept that SKB have a family of trade marks with a reputation, as these trade marks have all been used upon essentially the same goods i.e. cold and flu remedies of one sort or another, my conclusions above applies with equal force to the family argument. The opposition based upon section 5(3) of the fails.

Conclusion

124. In summary, the opposition based upon sections 5(2)(b) and 5(3) of the Act have failed.

Costs

125. As Swirl have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Swirl on the following basis:

Preparing a statement and considering the other side's statement:	£400
Preparing evidence and considering and commenting on the other side's evidence:	£800
Written submissions:	£400
Total:	£1600

126. I order SmithKlineBeecham Limited to pay to Swirl Products Limited the sum of **£1600**. This sum 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 31 day of March 2011

C J BOWEN
For the Registrar
The Comptroller-General