

**O-397-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**TRADE MARK APPLICATION 3175876 BY MR BENJAMIN GEORGE WALKER**

**FOR THE TRADE MARK:**

**MEDIVAPOUR**

**&**

**OPPOSITION THERETO (No. 408197) BY**

**MEDIPEN LIMITED**

**AND**

**THE (NOW DEFUNCT) CONSOLIDATED PROCEEDINGS CONCERNING:**

**AN APPLICATION (No 501425) BY MR WALKER**

**TO DECLARE INVALID THE TRADE MARK (No 3170077) MEDIVAPOUR**

**OWNED BY MEDIPEN LIMITED**

## **BACKGROUND AND PLEADINGS**

1. The decision concerns a trade mark application made by Mr Benjamin George Walker on 21 July 2016. He applied for the mark MEDIVAPOUR, a mark which was accepted and subsequently published for opposition purposes on 7 October 2016. Registration is sought in relation to the following goods and services:

**Class 1:** Flavour improvers for tobacco.

**Class 3:** Essential oils; etheric oils; scented oils; aromatic oils; ethereal oils; essential vegetable oils; emulsified essential oils; blended essential oils; natural essential oils; aromatic essential oils; terpenes [essential oils]; essential oils of citron; essential oils of cedar wood; essential oils of lemon; ethereal essences and oils; cosmetics; topical skin care preparations for cosmetic purposes; skin care creams; skin care mousse; essences for skin care; skin care lotions; skin care oils; milky lotions for skin care; cosmetic creams for skin care; non-medicated skin care preparations.

**Class 5:** Pharmaceutical preparations; pharmaceutical preparations, namely smoking cessation preparations; tobacco-free cigarettes for medical purposes; imitation cigarettes; pharmaceutical preparations, namely preparations for human use including, but not limited to, transdermal patches, lozenges and micro tablets, mouth sprays and nasal sprays; pharmaceutical products used for discouraging smokers from smoking; cigarettes containing tobacco substitutes for medical purposes; tobacco free cigarettes for medical purposes; pharmaceutical preparations and solutions containing nicotine for medical use; pharmaceutical preparations and solutions containing nicotine for use in electronic cigarettes; pharmaceutical preparations and solutions containing nicotine for use in electronic cigarettes and to assist in the cessation of smoking; chewing gum for use to aid in the cessation of smoking; sweets, candy and confectionery for use to aid in the cessation of smoking .

**Class 9:** Batteries for electronic cigarettes, cables for charging electronic cigarettes; USB cables for connecting electronic cigarettes to electronic devices; cables for connecting electronic cigarettes to mains electricity; adapters for charging electronic cigarettes.

**Class 10:** Medical devices for use in connection with smoking cessation; pharmaceutical devices, namely devices to aid in the cessation of smoking; medical devices, namely medical devices for human use including, but not limited to inhalators; apparatus used as an aid to help in the cessation of smoking.

**Class 30:** Chewing gum; sweets, candy and confectionery.

**Class 34:** Tobacco; smoking tobacco; smokers' articles; cigarettes; electric cigarettes; electronic cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes; pocket machines for rolling cigarettes; liquid nicotine solutions for use in electronic cigarettes; flavourings, other than essential oils, for use in electronic cigarettes; dry herbs for use in electronic cigarettes; nicotine capsules and pods for use in electronic cigarettes; filter-tipped cigarettes; cigarettes containing tobacco substitutes, not for medical purposes; tobacco free cigarettes, other than for medical purposes; smoking pipes; electronic smoking pipes; smoking pipe cleaners; herbs for smoking; lighters for smokers; ashtrays for smokers; pipe stands [smokers requisites]; racks for smokers' pipes; smokeless cigarettes; vaporizer pipes; oral vaporizers for smokers; cartridges for electronic cigarettes; liquids for electronic cigarettes; cigarettes containing tobacco substitutes; tobacco substitutes.

**Class 35:** Advertising; business management; business administration; office functions; retail and online retail services in relation to the sale of flavour improvers for tobacco, essential oils, etheric oils, scented oils, aromatic oils, ethereal oils, essential vegetable oils, emulsified essential oils, blended essential oils, natural essential oils, aromatic essential oils, terpenes [essential oils], essential oils of citron, essential oils of cedar

wood, essential oils of lemon, ethereal essences and oils, cosmetics, topical skin care preparations for cosmetic purposes, skin care creams, skin care mousse, essences for skin care, skin care lotions, skin care oils, milky lotions for skin care, cosmetic creams for skin care, non-medicated skin care preparations, pharmaceutical preparations, pharmaceutical preparations, namely smoking cessation preparations, tobacco-free cigarettes for medical purposes, imitation cigarettes, pharmaceutical preparations, namely preparations for human use including, but not limited to, transdermal patches, lozenges and micro tablets, mouth sprays and nasal sprays, pharmaceutical products used for discouraging smokers from smoking, cigarettes containing tobacco substitutes for medical purposes, tobacco free cigarettes for medical purposes, pharmaceutical preparations and solutions containing nicotine for medical use, pharmaceutical preparations and solutions containing nicotine for use in electronic cigarettes, pharmaceutical preparations and solutions containing nicotine for use in electronic cigarettes and to assist in the cessation of smoking, batteries for electronic cigarettes, cables for charging electronic cigarettes, USB cables for connecting electronic cigarettes to electronic devices, cables for connecting electronic cigarettes to mains electricity, adapters for charging electronic cigarettes, medical devices for use in connection with smoking cessation, pharmaceutical devices, namely devices to aid in the cessation of smoking, medical devices, namely medical devices for human use including, but not limited to inhalators, apparatus used as an aid to help in the cessation of smoking, chewing gum, chewing gum for use to aid in the cessation of smoking, sweets, candy and confectionery, sweets, candy and confectionery for use to aid in the cessation of smoking, tobacco, smoking tobacco, smokers' articles, cigarettes, electric cigarettes, electronic cigarettes, electronic cigarettes for use as an alternative to traditional cigarettes, pocket machines for rolling cigarettes, liquid nicotine solutions for use in electronic cigarettes, flavourings, other than essential oils, for use in electronic cigarettes, dry herbs for use in electronic cigarettes, nicotine capsules and pods for use in electronic cigarettes, filter-tipped cigarettes, cigarettes containing tobacco substitutes, not for medical purposes, tobacco free cigarettes, other than for medical purposes,

smoking pipes, electronic smoking pipes, smoking pipe cleaners, herbs for smoking, lighters for smokers, ashtrays for smokers, pipe stands [smokers requisites], racks for smokers' pipes, smokeless cigarettes, vaporizer pipes, oral vaporizers for smokers, cartridges for electronic cigarettes, liquids for electronic cigarettes, cigarettes containing tobacco substitutes, tobacco substitutes.

2. Registration of the mark is opposed by MediPen Limited ("the opponent"). It initially pleaded a number of grounds of opposition, but, for reasons that will become apparent, the only issue left to be determined is whether there is a likelihood of confusion under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") with the opponent's mark **MediPen** which was filed on 7 April 2015 and subsequently registered on 10 July 2015 in respect of:

**Class 44:** Medical, hygienic and beauty care; Anti-smoking therapy; Health care.

3. Only the applicant filed evidence. A hearing then took place before me on 8 June 2016 at which the applicant was represented by Mr Jamie Muir Wood, of Counsel, instructed by Trade Mark Wizards Limited. Although the opponent was initially represented during the proceedings, by the time of the hearing it represented itself; submissions on its behalf were given by its managing director, Mr Jordan Owen.

4. For context, it is necessary to record the following facts:

- i) The failure of the opponent to file any evidence means that the grounds of opposition that were initially pleaded under sections 5(3), 5(4)(a) and 3(6) of the Act are dismissed. As Mr Muir Wood observed, these grounds require evidence to support them, without which they cannot succeed. Indeed, rule 20(2)(b) of the Trade Mark Rules 2008 ("the Rules") (as amended) indicates that an opponent shall be deemed to have withdrawn its opposition on such grounds if no evidence is filed.

- ii) Grounds were initially also pleaded under sections 5(1) and 5(2)(a) of the Act on the basis of a separate earlier mark owned by the opponent. That mark consisted of the word **MEDIVAPOUR**, a mark which was filed on 17 June 2016 and registered on 23 September 2016. However, that mark was cancelled following an invalidation action brought against it. The primary consequence of this, in terms of these proceedings, is that the opponent can no longer rely on that earlier mark (its registration being deemed never to have been made), so the grounds under sections 5(1) and 5(2)(a) are also dismissed.
- iii) The opponent's now cancelled registration was the subject of two cancellation proceedings. One was lodged by Mr Walker, the applicant here, with those proceedings being consolidated with the present opposition after a defence had been filed. The other was lodged by what Mr Muir Wood described as the entity through which Mr Walker trades. The second cancellation was lodged in case there was any doubt over who (Mr Walker or his trading company) owned the goodwill relied upon. The second cancellation was not defended, hence why the registration has now been cancelled and is why this decision does not need to determine the validity of the opponent's MEDIVAPOUR mark.
- iv) The evidence filed by the applicant was, Mr Muir Wood explained, filed for the purpose of the now defunct cancellation proceedings. Consequently, I will not summarise it in this decision. However, this decision also deals with the costs of that now defunct application for invalidity.
- v) At the hearing, Mr Owen made frequent reference to the MediPen mark as if it were registered for goods, a particular device in class 34 to assist with smoking cessation. He explained that he had "updated" his registration to include goods in class 34 given that he had misunderstood certain things when he first filed the earlier mark. Whilst I understand that inexperience dealing with trade mark matters may lead to applications being made for goods/services which do not reflect the true scope of a person's business, the fact remains that the only earlier mark that the opponent is able to rely

on in these proceedings covers services only. The “updating” referred to by Mr Owen is a re-filing of the MediPen mark after the applicant applied for the subject mark. The re-filing and the goods it covers cannot be taken into account. The assessment will be made between the various goods and services applied for, against the services of the earlier mark.

- vi) Mr Owen also made frequent reference to his business, its reputation and the nature of its MediPen product. As I pointed out to Mr Owen at the hearing, these are not matter of which I can take cognisance as the opponent filed no evidence during the proceedings.

5. Having set out this background and context, I now turn to the opposition itself, and the operation of section 5(2)(b) of the Act.

### **SECTION 5(2)(b)**

6. Section 5(2)(b) of the Act states that:

“5.-(2) A trade mark shall not be registered if because – ..

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

7. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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



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

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

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

### **Comparison of goods/services**

8. When making a comparison, all relevant factors relating to the goods/services should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“the CJEU”) stated at paragraph 23 of its judgment:

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

9. Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

“(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.”

10. Mr Muir Wood, on behalf of the opponent, accepted in his skeleton argument that there may be some similarity between the applied for goods in class 3 with the earlier mark's beauty care services, albeit he submitted that the relationship between them was of such a nature that any similarity was low. I agree. The nature and methods of use are clearly different. There may be some overlap in trade channels and overall purpose, and a degree of competition and/or complementarity. There is a low degree of similarity between the class 3 goods and the opponent's beauty care services.

11. It was also accepted that there may be some (little) similarity between the goods in class 5 (except for imitation cigarettes) and 10 with the opponent's health care services and smoking cessation services. I also agree with this assessment. Whilst there is some similarity, I do not consider that it can be pitched at anything over than a low degree given the difference in nature and methods of use. Whilst there may be some complementarity, there is no evidence to show how strong this is in trade. However, I also extend this finding to imitation cigarettes. Being in class 5 means that they has some form of medicinal purpose and could easily be used to assist with smoking cessation. There is at least a low degree of similarity with smoking cessation services.

12. In relation to the other goods and services, my findings are as follows:

- Class 1 covers flavour improvers for tobacco. I can see no rhyme or reason for concluding that such goods are similar to the opponent's services, even smoking cessation services. There is no obvious relationship and there is no evidence to show that such flavour improvers have any application in smoking cessation. The goods are not similar to the opponent's services.
- Class 9 covers batteries, chargers and cables for electronic cigarettes. Whilst there is, arguably, some similarity between electronic cigarettes and smoking cessation services, such add on products are clearly a step removed. I conclude that there is no similarity here, but if I am wrong on that then any similarity must be extremely low.
- Class 30 covers various types of sweets and gum. Whilst gum (and potentially sweets) could be medicated to help with smoking cessation, they would fall in class 5 if that were the case. Therefore, the goods in class 30 are simply ordinary forms of the product. Again, I see no similarity here. The nature, purpose and channels of trade differ. There is nothing to suggest a true competitive or complementary relationship.
- Class 34 covers a mixture of traditional tobacco and tobacco products and smokers' articles, but also goods such as electronic cigarettes and vapours. In relation to the former, I agree with Mr Muir Wood that there is no similarity with the opponent's services because tobacco cessation and tobacco (and related) products are effectively pulling in the opposite direction. However, in relation to goods such as electronic cigarettes, I agree with Mr Owen that they could well be used as a mechanism to help a person stop smoking. Thus, there is some degree of overall purpose, a degree of competition and/or complementarity. However, without evidence to show the strength of any complementarity etc., I conclude that at most the goods are similar to a moderate (between low and medium) degree.
- Class 35 covers a variety of services including advertising, business management, business administration and office functions; however, I can see

no rhyme or reason for concluding that such services are similar to the opponent's services. The class also covers various retail services connected with the sale of, essentially, the goods covered by the applicant's other classes. Without wishing to oversimplify matters, I can see no reason for concluding that the retail of goods which I have found not to be similar to the services of the application are similar to the services of the application. Where the goods were similar, then their retailing may give rise to a low degree of similarity to the opponent's services. For reasons that will become apparent, I do not consider it necessary to go into this assessment in any greater degree than this.

### **Average consumer and the purchasing act**

13. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

14. All of the goods and services strike me as ones likely to be purchased by members of the general public, albeit, for these relating to smoking or smoking cessation, the consumer will be over the buying age for tobacco products. Most will be subject to a normal level of care and consideration during the selection process, although, there are some exceptions to this: e.g. the goods in class 30 will be subject to a more casual selection whereas the services in class 43 for health care and smoking cessation, and

to some extent the goods for smoking cessation, may be subject to slightly more care than the norm, although not of the highest level.

15. Many of the goods and services will be encountered in brochures, leaflets, websites and in physical premises where the marks are likely to be displayed. However, there is also the potential to request the goods orally at chemist shops (for the class 5 and 10 goods) or over the counter in supermarkets etc. particularly in respect of tobacco products. The over the counter process for tobacco products is due to the fact that the goods cannot be on display, which increases the need to request them orally. For most of the goods and services, the visual impacts of the marks take on more importance (although their aural impact will not be ignored) but for tobacco products the aural impacts are more (or as) important.

### **Comparison of marks**

16. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

17. The marks to be compared are: **MEDIVAPOUR** and **MEDIPEN**.

18. Both marks constitute a single element, which are the only things that contribute to their overall impressions.

19. I begin by observing that the difference in casing of the marks has no impact on the comparison. This is because notional use of either mark includes use in lower and upper and lower casing. Both visually and aurally the marks share the first four letters and the first syllable, MEDI-. However, the rest of the marks are very different, the second part of one containing 6 letters as opposed to 3, and having two syllables as opposed to one. The letters and syllables share little similarity. I consider there to be a moderate (between low and medium) level of visual and aural similarity.

20. Conceptually, I agree with Mr Muir Wood that the prefix MEDI- is likely to be perceived as a contraction of medicine or medicated, which creates some similarity. However, vapour and pen have no similarity and consequently no conceptual similarity between the marks as a whole; one is suggestive of a medicated vapour, the other a pen that is medicated in some way. This all equates, therefore, to just a low degree of similarity based on the shared MEDI- message.

### **Distinctiveness of the earlier mark**

21. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier marks, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

22. As the opponent filed no evidence, I have only the inherent characteristics of the mark to consider. From that perspective, I have already indicated that the mark MediPen alludes to a pen like device that is medicated in some way. Had the mark been for goods that could have possessed a pen-like quality then the inherent distinctiveness of the mark would have been very low. However, the earlier mark is registered in respect of services which means that the allusive quality is not as strong. Nevertheless, the average consumer encountering the mark in relation to such services may still see some allusiveness, perhaps that the (medical) service will make some make use of a pen-like device as part of the therapy. Therefore, I still consider that the mark has only a moderate (between low and medium) level of inherent distinctive character. It is also noteworthy that the parts of the marks which are common relate to the prefix medi-, which in my view has a strong allusive quality relating to medication or medicine, with a consequent weak level of distinctiveness.

### **Likelihood of confusion**

23. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the

responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).



(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

24. In terms of direct confusion, I do not consider it likely that the average consumer will mistake one mark for the other, even when the closest goods/services are being considered. The commonality of the weak prefix MEDI-, together with the very different suffixes –VAPOUR/-Pen (suffixes which I also accept are weak elements), is sufficient for the average consumer to distinguish between them.

25. That then leads to indirect confusion. In my view, it is not likely that the average consumer will put the commonality that exists between the marks (the shared MEDI-element) down to the undertakings responsible for the goods being the same or being related. This is due principally to the highly allusive nature of the common prefix. As Mr Muir Wood put it, the average consumer will just assume that separate undertakings are making use of the same allusive prefix. They will regard this as an unsurprising co-incidence and not trade connection. Of course, I bear in mind that the marks both have a similar structure, with the same allusive prefix coupled to a weak (or even descriptive) element. However, given the weakness of the common element, the fact that there is only a moderate degree of similarity between the goods and the services, I am of the clear view that indirect confusion is not likely. The ground of opposition fails.

## **Conclusion**

26. The opposition fails. Subject to appeal, the application may proceed to registration in respect of all of the applied for goods/services.

## **Costs**

27. I have determined these proceedings in favour of the applicant. It is, therefore, entitled to an award of costs. At the hearing, Mr Muir Wood sought costs off the published scale, or at least at the upper end of the scale. The main reasons put forward were the disproportionate nature of the proceedings, raising a large number of claims

that were not pursued, and the broad attack on all of the goods/services. Mr Owen explained that these proceedings were part of a larger ongoing dispute, although he did accept that the claims may have gone too far. In my view, whilst I am satisfied that the claim could have been more proportionate, they are not what I would ordinarily describe as unreasonable behaviour. In terms of the breadth of the attack (in terms of goods and services), the claim was far from unreasonable. I therefore make my award from the published scale, albeit, slightly higher than what I may have awarded to reflect, for example, that evidence was produced which became redundant.

28. I award the applicant the sum of £2500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee for the defunct application for invalidity - £200

Considering the statement of case and filing a counterstatement, and vice versa in the defunct application for invalidity - £600

Filing evidence - £1000

Attending the hearing - £700

29. I therefore order MediPen Limited to pay Mr Benjamin George Walker the sum of £2500. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 03<sup>rd</sup> day of July 2018**

**Oliver Morris**

**For the Registrar,**

**the Comptroller-General**