



Neutral Citation Number: [2021] EWHC 3347 (Ch)

Case No: IL-2019-000117

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND & WALES
INTELLECTUAL PROPERTY LIST (Ch D)

7 Rolls Buildings
Fetter lane, London
EC 4A 1NL

Date: 10/12/2021

Before :

MR JUSTICE ADAM JOHNSON

Between :

(1) COMBE INTERNATIONAL LLC
(A company incorporated under the laws of the State
of Delaware, USA)

(2) COMBE INTERNATIONAL LIMITED
- and -

Claimants

(1) DR AUGUST WOLFF GMBH & CO. KG
ARZNEIMITTEL
(A company incorporated under the laws of
Germany)

(2) ACDODO LIMITED

Defendants

MARK VANHEGAN QC and THEO BARCLAY (instructed by STOBBS IP LIMITED)
for the Claimants

SIMON MALYNICZ QC and ASHTON CHANTRIELLE (instructed by LEWIS SILKIN
LLP) for the Defendants

Hearing dates: 12, 13, 14, 15 and 19 July 2021

Approved Judgment

I direct that no official shorthand note shall be taken of this Judgment and that copies of this version as handed down may be treated as authentic.

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Mr Justice Adam Johnson:

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Introduction

1. The Claimants rely on the following UK registered trademarks for the word mark “VAGISIL”, which are registered in the name of the First Claimant and used by the Second Claimant under licence:

Number	Word	Date of entry in register	Class of goods
UK 1046858 (“the 858 mark”)	VAGISIL	21 May 1975	Class 5: “Medicated, deodorising and sanitary preparations and substances all for vaginal use”.
UK 1235127 (“the 127 mark”)	VAGISIL	6 February 1985	Class 3: “Nonmedicated Toilet preparations; soaps; deodorants for personal use; anti-perspirants; non-medicated preparations for the care of the skin and body; talcum powder for toilet use and cosmetic powders for the body”
UK 2414935 (“the 935 mark”)	VAGISIL	25 August 2006	Class 5 “Medicated, pharmaceutical and sanitary preparations and substances; sanitary napkins, towels, towelles, pads, tampons, panties and panty-liners, all for hygienic purposes; wipes, tissues and towelles impregnated with pharmaceutical lotions; medicated feminine hygiene wipes”.

2. The Claimants complain about the Defendants’ placing on the market and sale in the UK of the following goods under the sign “VAGISAN”:

Product name	Packaging	Date of introduction to the market
Vagisan Moist Cream		c. February 2013
Vagisan Intimate Wash Lotion		c. January 2019
Vagisan MoistCream Cremolum		c. February 2020
Vagisan Protective Ointment		c. February 2020

3. The Claimants allege infringement under section 10(2)(b) Trade Marks Act 1994 (“TMA”). The Defendants deny any infringement, and in any event say they are entitled to rely on various defences. They also advance Counterclaims, including a claim for a declaration that their re-branded sign, “DR WOLFF’s VAGISAN” does not infringe the Claimants’ marks.

4. I will say more about the resultant issues at [34]-[41] below. First, however, I will say something about the parties' evidence at trial, and will set the scene with some brief background.

The Witnesses

The Claimants' Witnesses

5. The Claimants relied on evidence from Ms Clare Want and Mr Anthony Santini.
6. Ms Want is the managing director of the Second Claimant, responsible for the VAGISIL brand.
7. Mr Santini has been the General Counsel of the First Claimant since 2012, and gave evidence about Combe's relationship over time with Wolff and the issues that has given rise to.
8. I am satisfied that both Ms Want and Mr Santini were honest witnesses who gave their evidence straightforwardly to the Court.

The Defendants' Witnesses

9. The Defendants relied on evidence from Ms Angela Theveßen, Mr Mohammed Safi Ghauri, Mr Stuart Bowman and Mr Antony Craggs.
10. Ms Theveßen was the Defendants' main witness. Ms Theveßen has been responsible for marketing VAGISAN products in the UK since late 2016. She was an experienced witness, who has given evidence in related proceedings in other jurisdictions, including the United States. Perhaps because of this, and because of a concern that she might give away points which would count against the Defendants, she was rather guarded in her evidence. Most critically, it became apparent during her oral evidence that she had a very narrow view of what might qualify as evidence of confusion as between VAGISAN and VAGISIL, which for her meant only evidence of "*a real customer going into a shop and buying the wrong product.*"
11. As I will explain further below at [154]-[159], that seems to me to be altogether too narrow a view of what legitimately amounts to confusion for the purposes of this case. Unfortunately, that view led to Ms Theveßen adopting an entirely blinkered attitude to the accumulating evidence of confusion which she was presented with during the period 2017 to 2019. In her oral evidence, she was quite unwilling to attach any weight at all to such materials and effectively dismissed them. It seems to me that I therefore need to treat Ms Theveßen's evidence on the topic of confusion with some caution.
12. Mr Ghauri and Mr Bowman were trade witnesses. Mr Ghauri is a category manager at LloydsPharmacy. Mr Bowman is a pharmacist in a small chain of independent pharmacies in the North East of England. They both gave their evidence straightforwardly and honestly.
13. Mr Craggs is the Defendants' solicitor. He gave evidence principally as to the results of researches conducted by members of his firm into the use of the phrases VAG or

VAGI as signposting devices (see below at [88]-[100]). Mr Cragg's evidence was admitted without him being called for cross-examination.

Overview and Background

14. The First Claimant ("*Combe US*") has marketed and sold non-prescription female intimate healthcare products in various parts of the world since the early 1970s under the VAGISIL mark. The Second Claimant ("*Combe UK*") is a wholly owned subsidiary of Combe and is its distributor in the UK. Where appropriate I will refer to the Claimants collectively as "*Combe*".
15. VAGISIL was first introduced into the UK market in 1984. The first product introduced into the market was VAGISIL Medicated Crème, which provides fast relief from itching, burning and irritation.
16. The First Defendant ("*Wolff*") is a German pharmaceutical company. Among other products, two of its main offerings are Alpecin and Plantur caffeinated shampoos. By the early 2000s, it had another product in its stable, namely VAGISAN Moist Cream, whose purpose is to relieve "*the symptoms of vaginal dryness (feeling of dryness, stinging, itching, minor lesions and pain during intercourse)*".
17. VAGISAN was originally launched in Germany, but Wolff was keen to expand into other markets. In February 2012, Wolff applied for an international trade mark designating the EU and US for the word mark VAGISAN in classes 3 and 5. Of course, by then, the Claimants already had the benefit of their UK registered marks.
18. The IREU, No. 0985168, was granted protection on 4 December 2012. When the IR came to the attention of Combe, it opposed the US designation of the IR. That prompted negotiations between the parties relating to the registration and use of the VAGISAN and VAGISIL names in different parts of the world, including the UK. These discussions included correspondence from Combe's German trade mark attorneys, Prinz & Partner, during the period 2014-2015, as to possible arrangements which might permit co-existence of the rival marks in at least some territories, although Combe adopted the position that their "*major markets*" were to be off limits.
19. The negotiations continued until early 2015. I will need to say more about them below. In the end, no settlement was reached, and that has resulted, since 2015, in ongoing proceedings between Combe and Wolff in a number of jurisdictions, including Australia, New Zealand, Singapore and the EU.
20. Returning to the chronology, Wolff introduced VAGISAN Moist Cream in the UK in February 2013, using a company called M&A Pharmachem Ltd as distributor.
21. Sales of VAGISAN were relatively low – taking Wolff's own figures, 9,838 units were sold in 2013 and 7,439 units in 2014. Although initially money was spent on advertising, that stopped after about May 2014 and did not resume until December 2016. There is an issue between the parties as to the significance of the limited sales of VAGISAN products in the period 2014-2016, and I will have to come back to that later. At any rate, it is clear that although Combe UK kept an eye on VAGISAN during this period, activity was limited and no action was taken by Combe UK.

22. In the Autumn of 2016, however, Wolff decided to take steps to grow its UK business. A new distributor was appointed, namely Acdoco Limited (“Acdoco” - the Second Defendant in this action). It obtained an exclusive listing in 790 Boots stores for VAGISAN. VAGISIL was also stocked in Boots, a matter which has some significance, as I will explain below.
23. VAGISAN was relaunched by means of a major television advertising campaign which ran for five weeks between 3 and 31 December 2016, costing in the region of £600,000. This gave sales of VAGISAN a material boost. Interestingly, sales of Vagisil also increased. This again is a point which has developed some significance in this litigation. It has been referred to as the “*halo effect*.” According to the Claimants, it continued to be felt throughout 2017. I will need to examine the halo effect further below, in particular the reasons for it and what properly may be inferred from it.
24. Wolff sought to monitor the effect of its advertising spend on increasing brand awareness, and amongst other things, this prompted reports in February 2017 from DJS Research, and in October 2017 from TimeInc, the latter relating to magazine advertising. These reports are relied on by the Claimants as part of their case that there was actual confusion between the two brands, and I will mention them in more detail below (see e.g. at [121]-[125]).
25. On 2 December 2017, Combe commenced a EUIPO cancellation action against Wolff’s International Trade Mark 0985168 designating the EU.
26. The decision to commence the EUIPO cancellation action in December 2017 has also developed significance in the present action, because it is said by the Claimants to evidence affirmative action by them objecting to the *use* of the VAGISAN mark in the UK, which shows that they did not – as the Defendants allege – acquiesce in the use of that mark for a period of more than 5 years, for the purposes of s48 TMA 1994. Again, it will be necessary to develop an analysis of this point later (see [185]-[197]).
27. It emerged during the trial before me that in fact there were further discussions between the parties in early 2018, shortly after commencement of the EUIPO Cancellation action in December 2017. Mr Santini gave evidence about them, and during trial Mr Craggs, the Defendants’ solicitor, submitted a Witness Statement giving further information and exhibiting a copy of an attendance note of a telephone discussion in early 2018. Mr Santini’s evidence emerged in a somewhat controversial manner, because the substance of it was given for the first time in re-examination. Again, this is a point I will need to return to, although ultimately as it seems to me, there was a very large measure of common ground between the parties as to what happened at the time.
28. Sales of VAGISAN apparently continued to disappoint Wolff. Ms Theveßen sought to conduct inquiries into this. Amongst other steps, a report was commissioned from a German media auditor, Eisold Mediateam. They reported in May 2018 (see further below at [128]-[131]). Wolff decided to try a new approach to advertising its VAGISAN Moist Cream product, and recruited the British comedian Jenny Éclair as a brand ambassador. A new campaign was launched in September 2018 which included two television advertisements featuring Ms Éclair talking bluntly about

vaginal dryness and displaying the Moist Cream packaging. These were referred to as “*One in Two Women*” and “*Bothersome Vagina*.”

29. These advertisements prompted a certain amount of consumer reaction. Additionally, following the Jenny Éclair campaign, Wolff commissioned further research by a company called Monkey See during 2019. I will need to say more about these points below (see at [134]-[142]), since they are also relied on by the Claimants as part of their case that there was actual confusion between the two brands.
30. In January 2019 Wolff introduced a second product into its UK range, namely VAGISAN Intimate Wash Lotion.
31. In September 2019, the EUIPO issued a decision on Combe’s challenge to the VAGISAN mark. They determined that the mark was invalid because of the likelihood of confusion between VAGISAN and VAGISIL, and Wolff’s EU VAGISAN registration was cancelled. An appeal to the Fourth Board of Appeal was dismissed on 3 September 2020, but Wolff has now appealed to the General Court of the CJEU and in the meantime the cancellation decision has been suspended so the IREU remains on the register. (In fact to put it more precisely, following the United Kingdom’s departure from the EU, UK Trade Mark No. 00810985168 was automatically registered by the UKIPO on 1 January 2021. It is that cloned IR UK which now remains on the register, but its fate is dependent on the outcome of the CJEU appeal, because under the new Schedule to the TMA s21A, if the appeal is dismissed then the cloned IR UK will automatically be cancelled).
32. In February 2020, Wolff introduced two more products into its VAGISAN range in the UK: (1) VAGISAN Moist Cream Cremolum – a pessary version of the Moist Cream product, for vaginal insertion; and (2) VAGISAN protective Ointment – for external application.
33. In September 2020 Wolff decided to rebrand its UK VAGISAN products as “*DR WOLFF’s VAGISAN*.” The rebranding is still in progress.

The Issues

The Claim and the Defences

34. Although initially cast more broadly, the Claimants’ claim as advanced at trial before me was a more straightforward one, namely a claim for infringement under s. 10(2)(b) Trade Marks Act 1994.
35. As to this, in Comic Enterprises v 20th Century Fox [2016] FSR 30 Kitchin LJ (as he then was) explained at [28] that six conditions must be satisfied to establish infringement under s.10(2)(b) of the Act:
 - i) there must be use of a sign by a third party within the UK;
 - ii) the use must be in the course of trade;
 - iii) it must be without the consent of the proprietor of the trade mark;
 - iv) it must be of a sign which is at least similar to the trade mark;

- v) it must be in relation to goods or services which are at least similar to those for which the trade mark is registered;
 - vi) it must give rise to a likelihood of confusion on the part of the average consumer.
36. In the present case, it is common ground that the word VAGISAN has been used in the course of a trade in the UK (conditions (i) and (ii)); that the Claimants have not consented (condition (iii)); that, as Mr Malynicz QC put it in opening, that word is “*very, very similar*” to the VAGISIL word marks (condition (iv)); and that, as Mr Malynicz QC also accepted in his opening, the Defendants’ use has been in relation to goods that have “*a high degree of similarity*” to those for which the Claimants’ RTMs are registered (condition (v)).
37. It follows that the real battleground between the parties as to the section 10(2)(b) infringement case was in relation to condition (vi), i.e. whether there is a likelihood of confusion on the part of the average consumer.
38. The Defendants also advance a number of defences. The main defence relies on s.48 TMA. The Defendants submit that Combe *acquiesced* for a period of five years in the use of the VAGISAN Moist Cream product under Wolff’s UK Trade Mark No. 00810985168.
39. Additionally, the Defendants argue:
- i) that the term VAGI, embedded within the word VAGISAN, is a descriptive indicator of the purpose or characteristics of the goods in question, and so they can avail themselves of the defence under section 11(2)(b) TMA;
 - ii) that, despite the Claimants’ application to revoke it, their International Trade Mark presently stands registered on the EUTM Register, and so they can avail themselves of the defence under section 11(1)TMA;
 - iii) that in any event, there has been honest concurrent use of the VAGISIL marks and the VAGISAN sign for a long period, so they can avail themselves of the defence described by the CJEU in Budejovický Budvar, národní podnik v Anheuser-Busch Inc [2012] RPC 11.

The Defendants’ Counterclaims

40. The Defendants seek a declaration that the rebranded sign “DR WOLFF’S VAGISAN” does not infringe the Claimants’ registered marks.
41. The Defendants also seek revocation of the Claimants’ 127 mark and their 935 mark, in respect of goods which do not relate to vaginal use. They suggest there is insufficient evidence that the Claimants have used those marks in respect of goods which do not relate to vaginal use.

Section 10(2)(b) TMA 1994

42. As already noted, the main battleground between the parties on the Claimants' infringement case under section 10(2)(b) TMA 1994 was as to the likelihood of confusion.

Relevant Principles

43. In Comic Enterprises v 20th Century Fox [2016] FSR Kitchin LJ (as he then was) explained the nature of this question, at [79]. He said:

"...the question in every case remains the same, namely whether, having regard to a notional and fair use of the mark in relation to all the goods and services for which it is registered and the actual use of the sign, there is a risk that the average consumer might think that the goods and services come from the same undertaking or economically linked undertakings, and that is all. "

44. The Defendants emphasised the following passage in Interflora Inc v. Marks & Spencer PLC [2015] ETMR 5, where Kitchen LJ gave guidance on the degree of confusion which is relevant (see at [129]):

" ... having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement."

45. As to the legal principles relevant to the question of likelihood of confusion, Kitchen LJ approved the following summary in Specsavers International Healthcare Ltd v Asda Stores Ltd [2012] FSR 19 at [52]:

"(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element 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; and

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

46. In the same case at [87] Kitchen LJ said the following:

“... the general position is now clear. In assessing the likelihood of confusion arising from the use of the sign the court must consider the matter from the perspective of the average consumer of the goods or services in question and must take into account all the circumstances of the case that are likely to operate on the average consumer’s mind in considering the sign and the impression it is likely to make on him. The sign is not to be considered stripped of its context.”

47. The parties also referred me to the very helpful overall summary of the law on section 10(2) contained in the recent decision of Daniel Alexander QC in Planetart LLC and Planetart Ltd v. Photobox Ltd [2020] EWHC 713 (Ch), [2020] ETMR 35, at [15]-[29].

Date of Assessment

48. A preliminary point arises as to the correct date or dates for assessment.
49. As to this, it is well established that whether the use of a sign infringes a trade mark pursuant to section 10(2)(b) falls to be assessed at the time when the sign which is said to infringe the mark in question began to be used in the UK (Enterprise v Europcar [2015] FSR 22, per Arnold J as he then was at [129]), although if the alleged infringer used the sign complained of in a materially different manner or context at a later date then a fresh assessment is to be conducted at that date (Stichting BDO v BDO Unibank [2013] ETMR 31, per Arnold J at [94])
50. In the present case, I did not understand it to be disputed that the relevant dates of assessment are as follows:
- i) for VAGISAN Moist Cream, February 2013;
 - ii) for VAGISAN Intimate Wash Lotion, January 2019;
 - iii) for VAGISAN Moist Cream Cremolum and VAGISAN Protective Ointment, February 2020.
51. As Mr Vanhegan QC pointed out, however, the difference in dates of assessment is unlikely to make much difference to the analysis since it appears to be common ground that if VAGISAN Moist Cream infringed the VAGISIL marks in February 2013 then the other products will also be infringements, and vice versa. I will proceed on that basis.

Risk of Confusion and Actual Confusion

52. The Claimants' case was that there was an obvious and clear risk of confusion in the relevant sense. The risk was the product of a number of factors. Perhaps most significantly, the Claimants relied on the submission that the average consumer would exhibit a limited degree of attentiveness, given both her character and the nature of the products in question. They relied on the accepted fact that the VAGISIL word marks and the VAGISAN sign are "*very, very similar*". They argued that the VAGISAN goods placed on the market in the UK are in fact identical to the goods for which the VAGISIL marks have been registered. They also relied on the fact that the VAGISAN marks were said to have a distinctive character – i.e., to be an indicator of their trade origin. Such distinctiveness was said to be both inherent in the marks, and to have been acquired (and indeed enhanced) through use over time, prior to 2013 (the primary date for assessment). The combination of these factors, argued the Claimants, generated a very material risk of confusion as to trade origin, and obviously so.
53. Moreover, the Claimants submitted that the proof of the pudding was in the eating, and that there was ample evidence of *actual* confusion in practice, which reinforced the overall conclusion that there was a likelihood of confusion: the evidence of actual confusion was just what one would expect to see given the obvious risk.

54. The Defendants contested this overall conclusion. They strongly resisted the proposition that the average consumer would exhibit a limited degree of attentiveness, and submitted that the opposite was true, given the nature of the products in question and their purpose. Although accepting that the VAGISIL sign and the VAGISAN mark were “*very, very similar*”, they resisted the idea (though not with any great vigour) that the VAGISAN goods marketed in the UK were identical to those for which the VAGISIL marks were registered. They also contested the proposition that the VAGISIL marks were distinctive, on the basis that the terms VAGIS or VAGI were descriptive and had a signposting function, which was to reference the purpose of the relevant products (the treatment of vaginal conditions) rather than their commercial origin.
55. On the question of actual confusion, the Defendants submitted that there was no convincing evidence of actual confusion at all. The evidence relied on by the Claimants was all challenged in one way or another. I will need to evaluate the evidence below.
56. Given the nature of these differences between the parties, I propose to deal first with the arguments as to risk of confusion, and then to look separately at the evidence of actual confusion.

Risk of Confusion

The Average Consumer

57. There was a large measure of agreement as to the identity of the average consumer, but disagreement on one point of importance.
58. The parties were agreed that the average consumer is a woman. As the Claimants expressed it, based on Ms Want’s evidence, she is a woman over the age of 18 who is concerned about her health. As the Defendants expressed it, she is a woman who is seeking to treat her condition and requires non-medicated preparations for that purpose.
59. As it seems to me, there is not really much between these formulations. I would adopt an amalgam, and say that the average consumer is a woman over 18 who is seeking to treat her condition and thereby requires preparations for that purpose. I would not limit the description by reference to a requirement for non-medicated products only. I do not see the logic of doing so. The average woman seeking to treat her condition is unlikely to discount using medicated products, and indeed VAGISIL Medicated Crème is (or has been referred to as) as a medicated product. It would seem quite artificial to exclude VAGISIL Medicated Crème from the mind of the average consumer.
60. As to the circumstances of purchase, the parties were agreed that the average consumer is likely to purchase the relevant products in store rather than online. The products are non-prescription and are sold on open shelves in pharmacies and the like, rather than via a dispensary.
61. Beyond that, however, there was an important disagreement between the parties as to the level of attentiveness likely to be exhibited by the average consumer. The

Claimants' overall position was that the average consumer was likely to be both embarrassed and rushed, and therefore prone to brand confusion. The Defendants' overall position was that the average consumer was likely to have undertaken internet or other research before entering a store, given the nature of the products, and could therefore properly be characterised as careful and not prone to confusion.

62. There are a number of points to the analysis of this issue. They all depend on an assessment of the available evidence.
63. It was common ground on the evidence that the average consumer would exhibit a degree of embarrassment and would therefore likely wish to make a speedy purchase – i.e., to pick up the relevant product from the shelf and leave quickly. Ms Theveßen accepted as much in cross-examination, when she was asked about evidence on the same topic she had earlier given in US proceedings:

“Q. Okay. Let us just then just make very clear. It is your evidence in the deposition, which was that it is fair to say that there were many women who were embarrassed to buy product like VAGISAN when they go into stores, yes?”

A. Yes.

Q. And they want to get it, i.e. get the product, buy it and get out quickly without being seen. That was your evidence which you gave on oath in the US, was it not?”

A. Yes

Q. And you have no reason to believe that the position was different in the UK when you gave that evidence?”

A. No”

64. Mr Ghauri gave evidence to the same effect. He agreed that “*in most cases*” consumers would wish to pick up products from the shelf and leave as quickly as possible. In his Witness Statement Mr Ghauri referred to a slide deck prepared by Bayer, the manufacturers of Canesten (another feminine hygiene product), which he indicated was a useful reference source as regards consumer behaviour. In cross-examination he was taken to a page in the slide deck dealing with consumer feedback, which contained the following statements, on the basis of which he agreed that the take-home message from Bayer was that most customers were embarrassed and did not wish to browse:

“I don't always know what I need, and there may be new products since I last needed something, but it's not like I'm going to browse.”

“I hate shopping that section ... its really embarrassing...especially when its next to the condoms ... the last thing I want to think about is sex when I've got Thrush.”

“I couldn’t bring myself to talk to the Pharmacist, it was busy and I was just too embarrassed. I googled it but I got confused – 18-24 Female, Watford.”

“I’m OK asking the Pharmacist now, but I wouldn’t when I was younger – Empty Nester, Birmingham.”

65. Both Ms Theveßen and Mr Ghauri qualified their answers, however. They drew a distinction between (effectively) a speedy purchase and a rushed purchase, the distinction resting on the idea that a speedy purchase is likely to have been informed by prior research. Consequently, although the time spent in store might be limited, the purchase is likely to be an informed one and therefore not rushed and not in the nature of an impulse buy.
66. As to this, the evidence before me was somewhat mixed.
67. Ms Theveßen’s evidence in cross-examination was that the average consumer would inform herself, *“mostly via the internet”*, although she might also talk to a pharmacist, GP or friend.
68. Mr Ghauri in cross-examination said that what consumers *“sometimes do ... especially with women’s health and other intimate health areas”* is to *“conduct a little bit of research before they go in.”*
69. Mr Bowman in his written evidence said that some consumers may initially have been to a GP, and *“[t]hey may also have done quite extensive research before buying”*, which would depend on their age, in the sense that *“[t]he younger ones tend to be more tech savvy and will usually have read about the symptoms on the internet.”*
70. Drawing the threads together, I accept the submission that the average consumer is likely to have conducted *some* research into her condition before shopping.
71. I do not think she is likely to have consulted her GP, however. Mr Bowman’s evidence was too qualified for that. He said only that *“some of the ladies may have initially been to a GP.”* That does not, in terms, describe the *average* consumer.
72. Neither do I think the average consumer is likely to seek assistance from the pharmacist while in store. I say that because of the evidence as to embarrassment given by all the witnesses, and the evidence that consequently consumers are unlikely to linger in store for very long before making a purchase. Those points seem to me inconsistent with the idea that the average consumer is someone who is likely to want to consult a pharmacist. Some consumers may do, I accept; but not, on the basis of the evidence I have seen, the average consumer.
73. Much more likely, it seems to me, is the idea that the average consumer will have conducted *some* research via the internet, before entering the store to effect a purchase. All the witnesses said so, and that makes good sense, because it is a way of becoming informed without embarrassment.
74. That said, I do not consider that that research in the typical case is likely to have been extensive. Mr Bowman only said that *some* consumers *may* have conducted extensive

research. That may be true, but again, what I am concerned with is the average consumer. As to the average consumer, I prefer Mr Ghauri's formulation, and his reference to "*a little bit of research.*"

75. This strikes me as an entirely realistic formulation, given the nature of the goods: they are relatively low price products (in the £5 to £15 range), sold on open shelves and without prescription.
76. Although the goods are healthcare products designed (amongst other things) to alleviate symptoms of discomfort, I accept the Claimants' submission that there is a spectrum of attentiveness within the arena of healthcare or quasi-healthcare products, and that the products in question are at the lower end of that spectrum.
77. The Defendants in their submissions referred me to certain evidential rules of thumb, applied in proceedings before EUIPO, as described in the following way in the present edition of Kerly's Law of Trade Marks and Trade Names (16th Edn.):

"At the EUIPO certain rules of thumb apply which may be found in the current section of the EUIPO Guidelines. In the absence of evidence to the contrary, the average consumer is expected to pay a high degree of attention to expensive purchases, the purchase of hazardous or technical and sophisticated goods, or goods where the consumer often seeks professional assistance or advice, e.g. cars, pharmaceutical products or goods where brand loyalty is important and so forth."

78. I of course accept that as an accurate summary of practice at the EUIPO, but do not consider that it alters the analysis in this case. For one thing, this is the English High Court and not the EUIPO. For another, and perhaps more significantly, all that are described are various rules of thumb. These seem to me to correspond to common-sense starting points for any analysis. But they are no more than that, and must give way (as the passage quoted expressly recognises) to the evidence. Here, I find the best evidence to be that of Mr Ghauri, and his evidence is that consumers are likely only to "*conduct a little bit of research before they go in.*" I find that consistent with the other available evidence and with the inherent probabilities, and I accept it.
79. As to the characteristics of the average consumer, I therefore find as follows:
- i) She is likely to feel a sense of embarrassment and is therefore unlikely to linger in the aisle or in the store longer than necessary. For the same reason she is unlikely to wish to consult a pharmacist.
 - ii) She is unlikely to have consulted a GP beforehand.
 - iii) She is likely to have conducted some internet research, but given the nature of the products and their price, this is unlikely to have been extensive.
 - iv) Overall, her level of attentiveness is likely to be towards the lower end of the attentiveness spectrum.

80. Having identified the characteristics of the average consumer, one can now move on to consider the factors affecting her judgment and behaviour.

Similarity of Marks and Sign

81. It is obviously correct, as the parties were agreed, that the VAGISIL marks and the VAGISAN sign are “*very, very similar.*” The Defendants were entirely right to make that concession. There is a high degree of visual and aural similarity between them, and neither has any meaning in English.

Are the VAGISAN goods within the classes for which the VAGISIL marks are registered?

82. As to whether the VAGISAN goods placed on the market in the UK are identical to the goods for which the VAGISIL marks have been registered, the Claimants rely on the following classes of goods for which the RTMs are registered, namely:

Class 5: Medicated, deodorising and sanitary preparations and substances all for vaginal use [858 Mark].

Class 3: Nonmedicated Toilet preparations; soaps; deodorants for personal use; anti-perspirants; non-medicated preparations for the care of the skin and body; talcum powder for toilet use and cosmetic powders for the body [127 Mark].

Class 5: Medicated, pharmaceutical and sanitary preparations and substances; sanitary napkins, towels, towelettes, pads, tampons, panties and panty-liners, all for hygienic purposes; wipes, tissues and towelettes impregnated with pharmaceutical lotions; medicated feminine hygiene wipes [935 Mark].

83. It seems to me quite clear, as the Claimants submit, that the VAGISAN products with which I am concerned fall within one or other of these categories. VAGISAN Moist Cream, VAGISAN Intimate Wash Lotion, VAGISAN Moist Cream Cremolum and VAGISAN Protective Ointment can each fairly be described as “*non-medicated preparations for the care of the skin and body*” within class 3 of the 127 mark, and/or as “*sanitary preparations and substances*” within class 5 of the 858 and 935 marks.
84. To the extent it is maintained, I reject the Defendants’ submission that the VAGISAN Moist Cream product is not “*for the skin and body*” because it is for internal vaginal use. That submission seems to me to rest on an entirely unrealistic distinction which is not recognised in the Defendants’ own leaflet contained in each Moist Cream packet. This describes the product’s characteristics as follows: “*... the cream has a high water content, thereby moisturising the skin within the vagina and external genital area ... Nurturing lipids (fats) to help to keep the skin supple.*”
85. I therefore conclude that the VAGISAN goods are within the classes for which the VAGISIL marks are registered. That obviously includes the VAGISAN Moist Cream product on sale at the critical assessment date in 2013.

Distinctiveness

86. Another main point of disagreement was as to the distinctiveness of the VAGISIL marks.
87. The Defendants accept that each of the Claimants' registered marks is valid insofar as they relate to goods for vaginal use. As the Claimants pointed out, it therefore follows that the VAGISIL marks have inherent distinctive character: Samuel Smith Old Brewery v. Lee [2012] FSR 7, per Arnold J at [82].
88. Beyond that basic proposition, however, there was disagreement between the parties as to the level of distinctiveness to be attributed to the marks.
89. The Claimants' position was that, as a made-up word with no meaning in English, VAGISIL has at least a normal or average degree of inherent distinctive character, and moreover by 2013 – the key date for assessment – the VAGISIL marks had acquired enhanced distinctiveness in the UK market by reason of their long use and the investment made in such use by the Claimants. Their basic submission, therefore, was that the VAGISIL marks in 2013 were highly distinctive and would have been seen by the average consumer as a signifier of trade origin.
90. The Defendants' main submission was that the first part of the word VAGISIL – meaning either VAGI or VAGIS - was a descriptive or signposting term, and would have been understood as such by the average consumer. Overall, therefore, they contended that VAGISIL had a low degree of distinctiveness. The average consumer, familiar with the use of signposting terms such as “*opt/opti*” or “*pedi*”, would have regarded VAGI or VAGIS in the same way, and would thus have seen those parts of the word as an indicator of the purpose of the products in question (the treatment of conditions affecting the vagina), rather than as a signifier of trade origin. This, they contended, was a serious limitation on the distinctiveness of the mark VAGISIL. Moreover, they said, it is well established that when a mark is largely descriptive, then the significance of even small differences between the mark and the allegedly offending sign will be enhanced in the mind of the average consumer, and that will materially limit the risk of confusion arising.
91. To begin with, I accept the general proposition that descriptive prefixes can be, and often are, used as a signpost for consumers to tell them what the relevant product is used for. We can all think of examples, and the Defendants' witnesses gave a number of them. Mr Bowman, for instance, referred to “*nic/nico/niq*” being used as an indicator for nicotine, and “*pepto*” for stomach related products. Mr Ghauri referred to “*nic*”, “*dent*”, “*migra*”, “*opt/opti*”, “*derm*” and “*pedi*”.
92. A number of authorities have considered the practice of using signposting names in the context of the medical products sector to refer to an ingredient or condition or part of the body, and have acknowledged that where that is done, the public are likely to perceive the relevant component “*more as a reference to the purpose of the product than as an indication of its commercial origin*”: see T-266/17, Uroakut/UryCys, EU:T:2018:859 at [43], a case in which both marks contained URO (Uroakut and Urocys) for products intended to treat urinary tract infections. A similar result followed in Winzer, T-160/09, Oftal Cusi, EU:T:2011:379, where at [80] the Court said:

“In the present case, the Board of Appeal’s analysis in paragraph 17 of the contested decision, according to which the relevant customers will understand that pharmaceutical preparations whose name begins with the word element ‘opthal’, must be approved. ‘Ophthal’ or ‘oftal’ are intended for ophthalmic use. Therefore, those consumers will perceive those elements more as references to the destination of the product than as an indication of its commercial origin.”

93. In this case, I also accept the proposition that VAGI or VAGIS are suggestive of the idea of the vagina. Ms Want said as much when cross-examined. She accepted it was “*highly likely*” that VAGISIL communicated a product to do with the vagina.
94. I do not think it follows, however, that the VAGISIL marks had only a low level of distinctiveness in the UK in 2013. It seems to me that by that stage, whatever their inherent level of distinctiveness, they had acquired enhanced distinctiveness given their use and their position in the market.
95. As to the law on acquired distinctive character, the Claimants referred me to the following tests described by Arnold J in Enterprise v Europcar [2015] FSR 22 at paras 147-149:

“...in assessing whether a trade mark has acquired a distinctive character the competent authority must make an overall assessment of the relevant evidence, which in addition to the nature of the mark may include (i) the market share held by goods bearing the mark, (ii) how intensive, geographically widespread and long-standing the use of the mark has been, (iii) the amount invested by the proprietor in promoting the mark, (iv) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor, (v) evidence from trade and professional associations and (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll. If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character.”

96. Here, an overall assessment of the relevant evidence points in only one direction.
97. Whatever the position may have been as regards the widespread use of *other* signposting phrases, the evidence before me was that there was no common perception of the terms VAGI or VAGIS *actually* being used as signposting or descriptive words for products related to the vagina.
98. On this point, the Defendants relied on the evidence of their solicitor, Mr Craggs. He had conducted (or had supervised the conduct of) internet research, and in his First and Third Witness Statements set out a number of products sold in the UK which have the VAG or VAGI elements and which relate to the vagina – for example Vagi

C, which is a tablet for vaginal infections such as bacterial vaginosis, and which appears to have been on sale in the UK since at least April 2015.

99. Against this, however, was the evidence of the witnesses:

- i) The Defendants' trade witness Mr Ghauri gave evidence as a buyer of healthcare products. His experience was really focused on the 2017-2019 period, but even then, although he was familiar with other signposting prefixes – “*nic*”, “*dent*” and the like – he did not mention VAGI or VAGIS as terms signposting vaginal goods.
- ii) Ms Theveßen had no direct knowledge of the position in 2013, and very fairly accepted that she was not personally aware of any products using VAG or VAGI as a prefix in 2016 or indeed in 2018.
- iii) Ms Want's evidence was that she was not aware of any third party brands using “*the prefix VAG or VAGI in the UK intimate health sector*” in 2012 or 2013.
- iv) That was entirely consistent with the evidence of the Defendants' other trade witness Mr Bowman, who had been in practice as a pharmacist for a number of years by 2013. He was shown an extract from Martindale – a reference source for drugs and medicines – showing all global medicines with VAG or VAGI in their names, and was asked in cross-examination whether he was aware of any other VAG or VAGI product (aside from VAGISIL and VAGISAN) being sold on shelves in the UK in his 30 year career. He said he was not so aware. It was only when prompted by the Court that he was able to identify one product, Vagifem (actually mentioned in his Witness Statement), but it was a prescription only product not sold on shelves and Mr Bowman said he could not remember ever dispensing it.

100. Based on this evidence, it seems to me that the fruits of Mr Craggs' research shed little light on the question of what the average consumer would *actually* have been accustomed to seeing in 2013 (or indeed thereafter).

101. There is also the question of the amounts invested into marketing by the Claimants in periods up to and after to 2013. These were material, and helped to generate high sales figures. The relevant data relied on by Mr Vanhegan QC is shown in the following tables, taken from his written Closing Submissions:

Year	Value of Marketing Spend (£)
2008	812,149
2009	549,376
2010	696,769
2011	531,060
2012	838,600
2013	966,634
2014	1,166,839
2015	1,233,418
2016	1,064,606
2017	1,038,414
2018	962,768
2019	1,157,637 (January to November only)

Year	Value of Sales (£)
2008	2,739,230
2009	2,653,209
2010	2,518,865
2011	2,656,517
2012	2,984,070
2013	3,004,806
2014	3,463,985
2015	3,502,936
2016	4,349,242
2017	4,969,174
2018	5,222,676
2019	5,340,960

102. One would expect such expenditure and sales figures to result in a high degree of consumer awareness of the VAGISIL brand. That is so on the evidence. Ms Theveßen confirmed in her evidence that VAGISIL was a well-known brand in the UK in 2013. Mr Bowman said the same, as did Mr Ghauri, who agreed that VAGISIL is perceived as a strong brand in the relevant sector. In a survey of women conducted in December 2013 VAGISIL was spontaneously identified by 35% of respondents and had 92% prompted awareness. In a repeat survey in May/June 2014 VAGISIL was “*the most top-of-mind*” brand in the female intimate health sector. In August 2014, Wolff’s survey of UK pharmacies revealed that Vagisil Medicated Crème was the product in this segment that was most recommended to the public by the pharmacists surveyed.
103. None of this evidence was challenged. Instead, the Defendants sought to marginalise it. They argued, for example, that it does not matter how well known the brands were which Mr Craggs had identified, or whether Ms Theveßen (or even Ms Want) recognised them. They said the question is one of perception and of how the average consumer would react.
104. Of course I agree. But as to how the average consumer would react:
- i) She would not have been accustomed to seeing VAGI or VAGIS as a signposting device in common usage in the female intimate health sector. Instead, she would have been accustomed to seeing such elements as part of the longer, composite word VAGISIL.
 - ii) By 2013, the VAGISIL marks had been in widespread and longstanding use in the UK market, awareness of the mark having been promoted through material investments made by the Claimants, resulting in a high degree of brand awareness.
105. In such circumstances, I find it inescapable that the average consumer in 2013 would have regarded the entire word VAGISIL as an identifier of trade origin, and would not have discounted the embedded elements VAGI or VAGIS as serving only a signposting function.

Risk of Confusion: Summary

106. All the above factors point in the same direction – i.e., they support the conclusion that there was (and is) a risk of confusion.
107. For completeness, I should mention two further points made by the Defendants, namely (1) the submission that the risk of confusion between VAGISIL Medicated Crème and VAGISAN Moist Cream is lessened because they treat different conditions, and (2) the submission that the local context in which they are marketed is relevant, in particular the positioning of the products on shelves in stores or in pharmacies.
108. As to (1), I reject the submission that the products are for different conditions: see [158]-[159] below. As to (2), I do not see how the relative placement of the competing products is relevant to the legal test I am required to apply, which is whether, having regard to a *notional* and fair use of the VAGISIL marks in relation to all the goods and services for which they are registered and the actual use of the VAGISAN sign, there is a risk that the average consumer might think they come from the same or economically linked undertakings.
109. That being so, as Mr Vanhegan QC submitted, the comparison is between VAGISAN Moist Cream and an *identical*, notional VAGISIL product, not VAGISIL Medicated Crème. It is difficult to see how the placement of the actual VAGISIL and VAGISAN products in relation to each other is a relevant component in this equation.
110. Even if that is wrong, I am quite unpersuaded by the available evidence on this point. For one thing, no evidence was available as to product placement at the critical time in 2013. For another, the up-to-date evidence as to the practice in Boots and in Mr Bowman’s pharmacy shows the Medicated Crème and Moist Cream products either near to each other but on different shelves in the same block dealing with intimate healthcare (Boots), or directly next to each other (Mr Bowman’s pharmacy). In both cases, in my view, the goods are sufficiently close both in physical proximity and in terms of the conditions they are intended to treat, that their placement is unlikely to be of any assistance to the average consumer in making any relevant distinction between them in terms of their trade origin. The evidence also shows that product placement practices are not uniform across the sector.
111. For all those reasons, I conclude that there was (and is) a risk of confusion between the VAGISIL marks and the VAGISAN sign in the relevant sense, i.e., the average consumer is likely to have thought (and to think) that they come from the same or linked economic undertakings. That is likely to be the case for a significant proportion of the relevant public.

Actual Confusion

Overview

112. In support of their case that there was a likelihood of confusion, the Claimants relied on what they said was evidence of actual confusion. It has been held that where actual confusion has occurred it will be highly probative of the question whether there is a likelihood of confusion (see Kitchin LJ in Maier v ASOS [2015] FSR 20 at [80]), and confusion after the date of assessment is helpful in shedding light on the question of whether there was a likelihood of confusion at the relevant date (W3 v EasyGroup [2018] FSR 16 per Arnold J [249]).
113. Thus, argued the Claimants, evidence of actual confusion was just what one could expect to see in this case given the obvious *risk* of confusion. The evidence of actual confusion was evidence of the risk being realised.
114. The Defendants said exactly the opposite. They said there is no evidence at all of actual confusion. They said the Claimants had not brought forward evidence from any witness who claimed to have been confused. They said this was quite remarkable and was consistent with their case that there was, in fact, no risk of confusion. As Mr Malynicz QC expressed it pithily in his written closing statement, lack of proof (i.e., of actual confusion) is proof of lack (i.e., lack of any real likelihood of confusion).
115. The analysis of this issue depends very largely on an assessment of the available evidence. I will therefore consider below the evidence relied on and the Defendants' criticisms of it.
116. Before doing so, however, I should consider one legal question, which arose principally during the course of the parties' legal submissions. This relates to the fact that some of the relevant evidence relied on takes the form of responses to surveys. The Defendants initially seemed to resist the admissibility of this evidence, on the footing that the law has developed guidelines for the admissibility of survey evidence, and permission is usually required to rely on it: see, e.g., Interflora, Inc & Anor v. Marks & Spencer PLC and Anor [2013] EWHC 273 (Ch). No such permission had been sought or given here.
117. As I understood it, however, that particular point was later abandoned because, as I will explain below, the so-called survey materials here are in fact contemporaneous documents, in some cases derived from work commissioned by the Defendants themselves as a response to their own concerns about the levels of sales of VAGISAN products being achieved. The parties were eventually agreed that there was no admissibility issue as such in connection with such materials. They were not being tendered as the product of a survey which was, in effect, akin to an experiment undertaken to assess relevant aspects of market or consumer behaviour. Instead, they are part of the factual background and history of the case. There is, certainly, a question of what such documents actually show. But that is a matter of evaluating them on their own terms, and determining, in light of the manner in which they were constructed, what evidential weight to put on them. It is not a question of admissibility, properly speaking. I will proceed on that basis.

Instances of Alleged Confusion relied on

118. It is convenient to start with a chronological overview of the evidence relied on by the Claimants. In summary, it is as follows.

119. Sales Spikes/Halo Effect: I have mentioned above that following the launch (or relaunch) of VAGISAN in the UK in late December 2016, which included a major advertising campaign, the Claimants noticed a spike in sales of VAGISIL products. This phenomenon was first identified in Boots, the retailer through whom VAGISAN products were being marketed. In a UK Demand Review Report dated 9 January 2017, for example, Combe UK noted: “*We have shipped the highest ever quantities of Vagisil Crème in Dec’ 16. This is believed to be the result of Vagisan promo.*” Shortly afterwards, a graph produced for a Combe planning meeting in 1 April 2017 showed a marked spike in sales in Boots during December 2016 not only of sales of VAGISAN, but also of VAGISIL Medicated Crème and VAGISIL ProHydrate.
120. Further data showed spikes in the sales of VAGISIL products in other stores during December 2016. There was a marked jump in sales of VAGISIL Medicated Crème in Superdrug during that period, and also a marked jump in sales of both VAGISIL Medicated Crème and VAGISIL ProHydrate in Tesco. VAGISAN products were not distributed through either of these retailers.
121. This halo effect phenomenon was noticed not only within the Claimants but also by the Defendants. They commissioned DJS Research to analyse consumer reaction following the relaunch of VAGISAN, and DJS produced a report in February 2017. This was based on an online survey of some 1009 female respondents aged between 18-17. Among the objectives was the identification of any competitors. One question asked was whether the respondents had seen or heard anything recently about treatments for vaginal dryness. Some 14% of respondents said yes, but when then asked “*Which product or treatment did you see or hear anything about?*”, 24% (of the 14%) said VAGISIL, and only 4% (of the 14%) said VAGISAN. DJS recommended, “*The potential for brand confusion should be considered here.*”
122. VAGISIL sales increased again in May 2017, corresponding to another round of VAGISAN Moist Cream TV advertisements.
123. TimeInc review: In October 2017, TimeInc, the owner of a number of magazines in which VAGISAN was advertising, conducted a “*VAGISAN Campaign Effectiveness*” survey. The methodology involved comparing the responses of an “*exposed*” group (i.e. who had been exposed to VAGISAN advertisements in its magazines) with those of an “*unexposed*” group. The exposed group had 143 participants and the unexposed group had 461.
124. Unprompted awareness of VAGISAN was shown to be much higher among members of the *exposed* group (it was identified by 6% of respondents compared to only 1% of respondents in the unexposed group). But the same was also true of VAGISIL – it was identified by 19% of respondents in the exposed group, but only 14% in the unexposed group.
125. The data relating to prompted awareness followed a similar pattern. Respondents were asked, by reference to a list, “*Which of the following brands, if any, have you heard of?*” Some 64% of the exposed group identified VAGISAN, compared to only 32% of the unexposed group. But similarly, 55% of the exposed group identified VAGISIL, compared to 31% of the unexposed group.

126. Exchange with Hugh Lindsay: By early 2018, Ms Theveßen was still dissatisfied with sales of VAGISAN Moist Cream in the UK and wished to see some improvement. On 13 February 2018, she sent an email to Matthew Stirland at Mediacom and others, headed “*Vagisan April TV Plan.*” Since sales had failed to pick up, she suggested a pause on TV advertising in April. Ms Theveßen surmised in her email what the reasons for the slower than desired sales might be. These were (i) limited distribution (“*we are still only available in Boots, Lloyds Pharmacy and a minor amount of pharmacies*”), (ii) consumers not liking the product (but this was discounted), and (iii) the advertising strategy itself.
127. One of those copied on the email was Hugh Lindsay, the chief executive of Slik Media, the UK media auditors retained by the Defendants. On 16 February, he suggested another possible reason. He said:
- “...one other thing that may also be a consideration is brand confusion between Vagisan and Vagisil. Do we have any sales data for Vagisil? Do their sales go up when Vagisan is on air? To a casual observer the two brands’ creative are not that dissimilar. Just a thought.”*
128. Eisold-Mediateam GmbH: In May 2018, Ms Theveßen received a report from Eisold-Mediateam GmbH. They are a German media auditor, whom Ms Theveßen said she used to monitor “*whether Hugh Lindsay is doing a good job.*” Their report is headed: “*Analysis Sales Tracking Vagisan 2016 – May 2018, Dr Wolff UK.*” They conducted a sales analysis for VAGISAN in the UK market. Ms Theveßen confirmed when cross-examined that she asked them to look at all competitors in the market and not just VAGISIL.
129. One of their slides (headed, “*Model spot length/subject – Overview*”) tracked sales of VAGISAN against sales of VAGISIL products, and showed an obvious correlation between the two, including most particularly in December 2016 – i.e., the same spike in sales which the Claimants themselves had noticed, apparently promoted by VAGISAN’s TV advertising campaign.
130. In a separate slide headed, “*Explanations & Learnings*”, Eisold-Mediateam said the following:
- “The effect of distribution is diminished by the sales numbers of competitor VAGISIL, who profits from VAGISAN TV ads.”*
131. They also said:
- “VAGISIL profits from VAGISAN TV advertisements. Since the launch of VAGISAN in 2016, Dr Wolff lost 24,000 sold items to VAGISIL. The profit might be affected by a similar wording. Additional in store promotions could help to lead the customer to the right product.”*
132. The Jenny Éclair Campaign - Twitter and other responses: I have mentioned above that a new TV advertising campaign was launched by the Defendants in September 2018, featuring the comedian Jenny Éclair. The campaign was designed by a creative

agency, Driven. The campaign was launched at an event in September 2018. Driven and the Defendants' PR advisers stressed that a "key message" was the "product name (to differentiate from Vagisil)."

133. The first Jenny Éclair advert was aired on the evening of 10 September 2018. The new campaign generated a degree of social media and other interest, some of which is now relied on as evidence of actual confusion. I will comment on this further below, but for now it is sufficient to note the various categories of communication:
- i) A VAGISAN Twitter account was set up as part of the new campaign. A number of Tweets were received commenting on the premiere on 10 September. Some referred to VAGISIL, not VAGISAN.
 - ii) Other Tweets were also sent to the VAGISIL twitter account, some of which appeared to assume that Jenny Éclair was advertising VAGISIL, rather than VAGISAN.
 - iii) The Claimants' customer care provider, PharSafer, received a number of emails apparently based on the same mistaken assumption.
 - iv) Jenny Éclair received Tweets to her own Twitter account exhibiting the same error.
134. Monkey See: Further research was commissioned during 2019. Via Driven, a company called Monkey See – a behaviour, brand and communications research agency – were tasked with studying the UK market for vaginal dryness products. As they put it in their interim report of September 2019, "*We need a deeper understanding of why sales of Vagisan in the UK aren't comparable to Germany.*"
135. To begin with they conducted a qualitative survey. This involved a series of 8 interviews in London, conducted with menopausal women aged between 45 and 65 who had suffered vaginal dryness in the previous 12 months, and who had not used a prescribed vaginal dryness cream. The 8 were a mix of "*treaters and non-treaters.*"
136. Detailed notes of the interviews have been disclosed. The Claimants in their submissions relied particularly on the following passages:
- i) From the interviewee described as "*Menopause 2*":

"Spontaneously she has heard of Vagisil as a treatment for vaginal dryness... She would also use Vagisil as she has heard of it... In regards to the vagisan product, she thought it was an identical product to the vagisil brand, but has heard of Jenny Éclair who appears in the Vagisan advertisements from listening on the radio."
 - ii) From the interviewee described as "*Menopause 3*":

"Tell me what you know about Vagisan.

"I don't know much about it, but I presume its much the same as Vagisil. Is it the same company? Not sure whether you've

heard of that one or not? I think probably not. I think I just made the connection because the name is so similar.”

iii) From the interviewee referred to as “Menopause 5”:

“Cannot tell vagisil and vagisan apart however recognizes the advert with Jenny Éclair in.”

iv) From the interviewee referred to as “Menopause 8”:

“Have you heard of Vagisan?”

Am I thinking this one is that one? That is the name of the one I buy. (She said Vagisil earlier). Does this one come in a different container as well? (Confusion over which one is used). She uses Vagisan.”

137. Monkey See’s interim report of September 2019 identified 13 points under the heading “*Qualitative top line overview of findings*”, one of which was: “*Confusion between Vagisan and Vagisil.*”
138. Monkey See’s work continued and they then conducted a quantitative study. This was presented in October 2019, as part of an overall report on Monkey See’s research, including the qualitative interviews already referred to. The quantitative study was a survey of women aged 45-65, menopausal or post-menopausal who had suffered from vaginal dryness in the previous 12 months. A total of 1,148 respondents completed the survey, which was a bespoke, mobile compatible online survey lasting about 15 minutes. The questions addressed included a number on “*Brand awareness and usage.*”
139. A summary slide is headed, “*3 key things to take away from today*”, the third of which was as follows:

“There is an opportunity to strengthen the Vagisan brand to improve perception that it is the market leader in this category. Currently.

- *It is not top of mind*
- *Confused with Vagisil*
- *No defined personality*
- *Indiscreet, old-fashioned pack.”*

140. The suggested response was:

“You need to play to the brand’s strengths (specialist, expert) and build a clear personality that sells the benefits of the product over what women are currently using (ideally in a more modern, discreet pack).”

141. A section of the slide deck deals specifically with “*Brand awareness and usage*”, and one of the slides analyses the level of prompted awareness of various brands among the survey participants. The slide is headed with the following description:

“When prompted 55% of women recognise the Vagisan pack ... and Vagisan becomes the third best known brand (from 6th spontaneously). This leap is a result of the confusion between Vagisil and Vagisan.”

142. The problem was discussed on a call with Driven on 23 October 2019, and Driven proposed a possible solution which they summarised in an email the following day to Ms Theveßen:

“We also presented a solution to the brand confusion problem between Vagisil and Vagisan – ‘With Vagisan, you can’. Because this rhymes, it works well as a device to help our brand stick in consumers’ minds over Vagisil. ”

143. Gogglebox: In an article in the Independent on 3 April 2020, Jenny Éclair referenced the following incident on an episode of the television programme Gogglebox:

“On Friday night’s show, Giles and Mary, the nice middle-class, corduroy-trouser and coloured-tights couple, were settling down to watch something featuring Su Pollard. ‘Oh she does the Vagisil advert’, said Mary. ‘No that’s Jenny Éclair’, responded Giles. Ok, there was nothing bitchy about the exchange, but my skin was thin and I’d had a glass of wine. I felt affronted; for starters, the vaginal dryness cream I advertised is called Vagisan, not Vagisil.”

Actual Confusion: Discussion and Conclusion

144. I have no real hesitation in concluding that the Claimants’ case on actual confusion is made out on the evidence. The fact of such *actual* confusion bolsters the overall conclusion that there was (and is) a likelihood of confusion within the meaning of s.10(2)(b).
145. What is striking is the volume of evidence all pointing strongly in the same direction, and fitting into an obvious and coherent pattern. The initial impression derived from the VAGISIL sales spike in December 2016 is only confirmed by the later events, and the efforts undertaken by the Defendants to identify the reasons for what they saw as disappointing sales figures notwithstanding their heavy advertising spend. By late 2019, not just one but a number of advisers and consultants to the Defendants had reached the same conclusion, namely that an important contributing factor was confusion with VAGISIL. Those consultants included Ms Theveßen’s German media auditors, Eisold-Mediateam, in whom she placed particular faith and trust.
146. The Defendants had a number of counter-arguments, designed either to neutralise or marginalise the impact of the evidence relied on. I will address the main points in turn. I do not find any of them persuasive.

147. The Halo Effect: First, Mr Malynicz QC argued that nothing of significance could be read into the sales spikes of VAGISIL products in December 2016 and following. His argument here was that there was (as he put it) “*too much noise in the signal*” for the sales data to be significant. By this he meant that, at various points in time, VAGISIL were *also* advertising or undertaking promotional activities, and the sales spikes might well, on proper analysis, be attributable to those matters rather than to the impact of the VAGISAN advertising campaigns.
148. One can see the logic of that argument, and it is true that there is “*noise in the signal*” in respect of some periods, but importantly, that is not the case for the initial, critical period in December 2016 following VAGISAN’s initial burst of TV advertising after its launch (or relaunch).
149. I have mentioned above at [119]-[120] the data made available to the Claimants, and also (at [129]) the corresponding data reflected in the graph prepared by Eisold-Mediateam. There is no dispute that there was a sales spike. The only question is what it was caused by. On the facts, it cannot have been caused by VAGISIL advertising or promotional activities, because the evidence was that VAGISIL had not advertised on TV since April 2016, and Ms Want clarified in her evidence that there was no promotion for VAGISIL Medicated Crème in Boots in December 2016. The signal, for that period at least, was clear.
150. Product Distribution: A second theory advanced by Ms Theveßen in her evidence was that the sales spikes were caused by limited distribution, and therefore limited availability of, the VAGISAN product. The theory was as follows. A consumer seeing an advertisement for VAGISAN and being prompted to seek relief for her vaginal dryness condition would go to a retailer (say Superdrug) but then discover that VAGISAN was not available (to begin with it was available only in Boots and smaller pharmacies), and buy VAGISIL instead. That, said Ms Theveßen, was not an instance of confusion at all.
151. Again, however, I see real difficulties with this theory if it is measured against the available facts. Within Boots, *both* VAGISAN and VAGISIL were available in December 2016, and sales of *both* increased at the time of VAGISAN’s advertising campaign. The spike in VAGISIL sales therefore cannot be explained on the basis of consumers shopping in a store where VAGISAN was not available. It was available. But sales of VAGISIL benefited from the halo effect anyway.
152. Category Benefit: A third argument was that the benefit felt by VAGISIL was not peculiar to VAGISIL, but instead was felt by other products in the same broad area of feminine hygiene. In other words, what was said was that VAGISAN’s advertising served to raise awareness generally of conditions affecting vaginal dryness, and this created a benefit which was felt across the sector. Increased sales of VAGISIL were a product of such generally raised awareness, and not the result of confusion between the two brands.
153. I am not satisfied that this point is borne out by the evidence. In saying that, I am particularly influenced by the findings of Eisold-Mediateam, Wolff’s own media auditors. Although, as Ms Theveßen accepted, they were provided with data across the whole market, the only correlation they identified in terms of sales spikes was between VAGISAN and VAGISIL (see above at [130]-[131] and below at [162(vi)]).

That conclusion, moreover, is consistent with the preponderance of the other available evidence from multiple other sources. I thus reject the Defendants' category benefit argument.

154. No evidence of complaints: A fourth point was a more general one about the quality and nature of the evidence relied on. It is the point I have briefly mentioned above already (see at [114]), namely the failure by the Claimants to put forward any witness who actually claimed to be confused. Mr Malynicz QC said that the absence of such evidence was both striking and significant. He said that had there in fact been actual confusion, one would have expected to see a clear and consistent track-record of complaints from consumers, and there were none.
155. It is true that there was no evidence of complaints as such – i.e., about the products.
156. On examination, however, I do not find the lack of complaints surprising or significant, and it does not deter me from my overall conclusion. I say that because I do not see why complaints in any material number would have been an obvious by-product of confusion in the relevant sense – i.e., confusion in the form of a mistaken assumption that VAGISAN and VAGISIL emanated from the same or related economic undertakings.
157. The Defendants' case on this point really rested on the proposition that the VAGISAN and VAGISIL products treated different conditions, with the consequence that at least some consumers would be left without an effective treatment for the condition they were seeking to alleviate. In their Written Closing, they expressed the point in the following way:
- “If a woman who was looking for Vagisil Mediated Crème to treat her itch did, as a result of being rushed, in fact purchase Vagisan Moistcream which treats dryness (or vice versa), at the very least you would expect to see evidence of product returns or complaints that the product did not treat their condition.”*
158. I am not at all persuaded by this argument, because it seems to me that on analysis, there was and is very little difference between these products in terms of the treatment they are designed to provide:
- i) VAGISIL Medicated Crème is and was held out by Combe as providing “*Fast Relief from intimate itching, burning and irritation.*”
 - ii) The VAGISAN Moist Cream packaging states that the cream is for the relief of the “*feeling of dryness, burning, itching, minor lesions and pain during intercourse*” and “*for symptoms caused by dryness of the vagina and external genital area (dryness, stinging, itching, minor lesions and pain during intercourse).*”
159. There is, in truth, very little of substance between these descriptions. The products are designed to provide relief from more or less the same symptoms. That strikes me as the most plausible explanation for the lack of complaints, even assuming a degree of confusion between the products in terms of their commercial origin. To put it another way, given that the products appear to be aimed at treating the same

symptoms, the lack of complaints is not at all incompatible with the idea that there was brand confusion. On the contrary, it is entirely consistent with it.

160. Defendants' Research and Adviser Reactions: The Defendants' fifth point was about the weight to be attributed to the various items of research the Defendants themselves commissioned, and the reactions of their own advisers including Hugh Lindsay of Slik Media.
161. In fact, this point was really a series of points about what conclusions can actually be derived from the various reports and recommendations I have referred to.
162. I accept that there are limitations on the nature of at least some of the evidence relied on, and accept that some care is needed in evaluating it. Notwithstanding that, however, what is striking is that the evidence is entirely consistent in suggesting *actual* confusion between the two brands:
 - i) *DJS*: Ms Theveßen in her evidence said that the DJS survey of February 2017 (above at [121]) was directed towards assessing levels of *brand awareness* in light of the Defendants' advertising campaign, and was not concerned with the question of confusion as such. She was right about that of course, but nonetheless the results of the survey are *consistent with* the idea that there was brand confusion. That is because, when asked, the largest proportion of respondents indicated they had recently seen advertising for VAGISIL, whereas the main advertising push had been for VAGISAN. Admittedly, this evidence is not *conclusive* of anything. On its own, all it does is give rise to a question, but it is consistent with the answer to the question being that there *was* brand confusion, and indeed that was posited by DJS as a possible answer since they advised: "*The potential for brand confusion should be considered here.*"
 - ii) *TimeInc*: Similar observations may be made about the TimeInc research of October 2017 (above at [123]-[125]). Unprompted awareness of VAGISIL increased among those who were exposed to advertisements for VAGISAN, again suggesting a degree of confusion between the two, in a manner on the face of it consistent with the halo-effect observed as a result of the VAGISAN TV advertising in December 2016. In and of itself, this material is not conclusive on the issue of brand confusion, but the survey results are again consistent with the idea that there *was* such confusion.
 - iii) *Hugh Lindsay*: In cross-examination, Ms Theveßen said that she had disregarded Mr Hugh Lindsay's suggestion in February 2018 that an explanation for the continuing limited take up of VAGISAN products might be brand confusion, and had disregarded his suggestion that they obtain sales data for VAGISIL so that one could check for any correlation between VAGISAN advertising and VAGISIL sales. If that is correct, it strikes me as having been a most unwise decision, because it was surely an obvious point to check, and Mr Lindsay, although admittedly not the average consumer (Ms Theveßen said she had considered his views irrelevant because he was "*a male person*"), was nonetheless an experienced media auditor responding to his client's request for help.

- iv) *Eisold-Mediateam*: In any event, however it came about, it is clear that a data set including information about VAGISIL sales was provided to Eisold-Mediateam, and that they analysed it. In my judgment, their research is of a different character to that carried out by DJS and by TimeInc. Part of the exercise they conducted was to track VAGISIL sales against sales of VAGISAN. They did so and found a direct correlation, and moreover isolated a reason for it: “*VAGISIL profits from VAGISAN TV advertisements.*”
 - v) When asked about this in cross-examination, Ms Theveßen sought to limit or qualify the effect of that conclusion: while accepting the correlation, she again sought to explain it on the basis of VAGISAN’s more limited distribution, which would drive consumers towards either VAGISIL or another, competitor product, Replens.
 - vi) I have already dealt with this point above, however (see at [150]-[151]), and I am not persuaded by it, because it does not explain why, when VAGISAN advertised, sales of *both* VAGISAN and VAGISIL went up in Boots. As to Replens, Eisold-Mediateam did not identify any correlation between VAGISAN advertising and increased sales of any other products, only VAGISIL. That is despite the fact that they were provided with data across the market, relating to all competitors. This illustrates the point that both the phenomenon, and the explanation for it, were peculiar to VAGISIL; and therefore reinforces the conclusion that the explanation was confusion as between VAGISAN and VAGISIL.
 - vii) *Monkey See*: Like the report from Eisold-Mediateam, the results of the research conducted by Monkey See seem to me to be very strong evidence of brand confusion. Ms Theveßen in her evidence sought to limit its impact. She said that the evidence of confusion derived from the qualitative survey (the interviews) was based on feedback from two women, and was not supported by the results of the qualitative survey. I do not consider that the exercise carried out by Monkey See can be marginalised in this way, however.
 - viii) In terms of their instructions, an important part of their role was to understand why sales of VAGISAN were still slow. Their research was appropriately targeted at female respondents falling within the broad concept of the average consumer. The feedback from 4 of those consulted in the qualitative research was suggestive of confusion (above at [136]), and no doubt directly informed the key finding that there was “*Confusion between Vagisan and Vagisil.*” That conclusion was then reflected again in the overall report which consolidated the results of both the qualitative and the quantitative research, and which included within one of its “*3 key*” findings the proposition that VAGISAN was currently “*Confused with Vagisil.*” That conclusion then informed a debate as to how address the brand confusion problem, as to which Driven made their suggestion on 23 October: the rhyming couplet, “*With Vagisan, you can.*”
163. Taking all this material together, a very clear picture emerges. Although I accept that the DJS and TimeInc reports are of more limited relevance and do not directly address the question of brand confusion, the later Eisold-Mediateam and Monkey See reports do, because they were directly concerned with identifying the reasons for VAGISAN’s slow sales, and both came to the view that one contributing factor was

brand confusion. All the remaining evidence is consistent with that overall conclusion, and no credible alternative explanation had been advanced.

164. Social Media and other reactions: Moving on to the Defendants' sixth point, they were also critical of the quality of the Twitter and other evidence summarised briefly above at [133], which followed in the wake of the Jenny Éclair campaign launch in late 2018. Again, in reality this was a series of points, most particularly that (i) in some instances one could not be certain whether the communication came from a man or a woman, or if a woman whether she could properly be characterised as the average consumer, given the lack of information available (usually just a name); (ii) in some instances the communications relied on were in the form of complaints not about any product, but instead about the tone and content of the Jenny Éclair adverts; and (iii) in some (perhaps many) instances, one could not be sure whether an apparent reference to VAGISIL (rather than VAGISAN – or vice versa) was or was not the product of auto-completion of the text on a mobile phone or laptop, rather than the product of conscious choice by the writer.
165. I see the force of those points, in the sense that they call for a degree of caution in placing weight in the Twitter and email evidence in isolation, without the makers of the relevant statements being called and detailed context being provided. All the same, it seems to me it would be a mistake to discount their relevance entirely. Perhaps, looked at by themselves, they would not properly support a conclusion that there was actual confusion among the population of average consumers. But they do not stand by themselves. They are consistent with a much wider pattern of evidence, and corroborative of the conclusion which that wider pattern of evidence supports, because they exhibit confusion in the sense of mixing up VAGISAN and VASGISIL.
166. A few examples only will suffice to illustrate the point.
167. From the VAGISAN Twitter account, for instance, set up in anticipation of the Jenny Éclair TV campaign (see [133(i)] above), one has the following (taken from a selection of Twitter reactions put together by Driven, after the premiere of the first TV advertisement):

“You could always try vagisil as advertised by @jennyclair.”

“Jenny éclair is the new face of Vagisil.”

“Vagisil cream getting mentioned on an advert with Jenny Éclair just before Vanity Fair. Obviously some kind of target audience thing.”

168. As to the messages sent to the VAGISIL Twitter account (see above at [133(ii)]), they included the following:

From Karen Hillier dated 28 September 2018: “I wonder if Jenny Éclair uses Vagisil moist cream? Getting fed up with her popping up on my TV screen. It’s like a personal attack at all menopausal women.”

From Mandy Nicholson, 12 November 2018: “*Omg some TV adverts lol jenny éclair advertising vagisil moist cream coz no one wants a bothersome vagina x really luv x*”

169. Others follow the same pattern, including the exchange between Giles and Mary on Gogglebox referred to at [143] above. Admittedly, such evidence is subject to important limitations. But what is striking is the accumulation of it, with much of it reflecting the same basic misapprehension that the product being advertised by Jenny Éclair was VAGISIL not VAGISAN. It is that accumulation of evidence, sitting as it does beside the other evidence I have referred to – the halo effect, and the results of the research the Defendants themselves conducted – which is persuasive.

The Defences

Acquiescence

The Issue

170. The Defendants rely on an acquiescence defence under Section 48(1) TMA 1994. They say that the Claimants acquiesced in their use of VAGISAN under the Defendants’ IREU for a period of over 5 years.
171. The logic of this argument is that, as from 4 December 2012, the Defendants’ International Trade Mark designating the EU was granted protection in the EU under number 0985168. This had the effect of turning it into a unitary EU trade mark protected in all 28 Member states including (at the time) the UK. The Defendants argue that the Claimants, who by then of course already had the benefit of their 3 UK registered marks (the latest of which was from 2006), nonetheless acquiesced in – i.e., knowingly tolerated – the use of the Defendants’ later mark for a period of at least 5 years.
172. The Defendants therefore claim reliance on the defence of statutory acquiescence afforded by section 48(1) TMA, which provides as follows:
- “(1) Where the proprietor of an earlier trade mark ... has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark ... -*
- (a) to apply for a declaration that the registration of the later trade mark is invalid, or*
- (b) to oppose the use of the later trade mark in relation to the goods ... in relation to which it has been so used,*
- unless the registration of the later trade mark was applied for in bad faith.”*
173. In the present case, the principal issue between the parties is whether there was *in fact* acquiescence by the Claimants. The Claimants point to various matters which they

say constituted objections to use of the Defendants' mark, and which had the effect of interrupting the statutory 5 year period.

174. There are some subsidiary points. In Budejovicky Budvar [2012] RPC 11, the CJEU held that the five year period for the purposes of acquiescence only begins to run when four conditions have been satisfied (see also Kerly (16th Ed) at 17-063). These are:
- i) the later mark must have been registered;
 - ii) the application for the later mark must have been made in good faith;
 - iii) the later mark must have been used in the relevant territory;
 - iv) the proprietor of the earlier trade mark must be aware both of the registration and the use of the later mark.
175. In the present case, there is no issue about conditions (i) and (ii), but in addition to saying that they did in fact object to the use of the Defendants' mark, the Claimants *also* said that for certain parts of the 5 year time period relied on by the Defendants, the Defendants were *not* actually using their mark in any meaningful way at all, or if they were, the Claimants were not aware of such use because it was so limited that it did not register with them. They therefore submitted that requirements (iii) and (iv) above were not fulfilled.

Some Key Facts

176. It is helpful to start with a brief factual overview and timeline.
177. The Clock Starts Ticking: The Defendants' position was that, by 11 February 2014 at the latest, all the elements necessary for the section 48 period to begin to run were in place. That was on the footing that by then, the Claimants were aware both of the existence of the Defendants' mark (which on the evidence they had been aware of since April 2013), and of its use in the UK (because on 11 February 2014, the Claimants were informed that a sales representative had found VAGISAN on sale).
178. The Claimants in fact put their knowledge of sales of VAGISAN products at a slightly earlier point, in late January 2014. For convenience, and since it is conceded by the Claimants, I will take that as the starting point for the five year period. Nothing much turns on turns on the limited difference between the two formulations.
179. German attorneys' Correspondence - January 2014 to February 2015: As evidence of their objection to the use of the Defendants' mark, the Claimants then rely on a series of exchanges of correspondence which took place in the period January 2014 and February 2015, between Combe's German attorneys, Prinz & Partner, on the one hand, and Wolff's German attorneys, Loesenbeck, Speck, Dantz, on the other. The Claimants say they made it clear in these exchanges of correspondence that they would not tolerate the use of VAGISAN in the UK. I will say more about this correspondence below.
180. No sales of VAGISAN, or no knowledge of sales - mid-2015 to December 2016: The Claimants also say that, in point of fact, there was no continuous use of VAGISAN by

the Defendants for a five year period beginning in late January 2014. They say that by mid-2015 at the latest, VAGISAN had fallen off the UK market, and it was not re-launched until December 2016. At any rate, they say that the Claimants' team, including in particular Ms Want, who was monitoring the UK market, saw no evidence of sales of VAGISAN during that period, and so were not aware of the Defendants' use of their mark. They say, therefore, that the five year period did not run during this period of time.

181. The EUIPO Invalidation Action - 2 December 2017: The Claimants' next, and perhaps main, point is that on 2 December 2017, they applied to the EUIPO to invalidate the Defendants' later registered mark. This, they say, was an overtly hostile act and a direct attack on the validity of the Defendants' mark. Thus, whatever may or may not have happened before 2 December 2017, by that point there can be no doubt that they objected, and objected most strongly, to the use of the VAGISAN mark in the UK, because they were seeking to invalidate it. December 2017 is less than four years after the clock started ticking in January 2014, and so on any view there was no acquiescence for a period of five years.
182. January 2018 Call with Mr Santini: Detailed evidence of the next relevant point arose only during the trial, and in fact during the re-examination of the Claimants' witness Mr Santini. He gave evidence of a discussion he said he had had with the Defendants' management in January 2018, in which he said he indicated that coexistence of the two brands in the UK market was unacceptable and that he did not want the Defendants selling there. The Claimants seek to rely on this, if necessary, as further evidence of their objecting to use of VAGISAN in the UK.
183. Mr Santini's evidence was controversial in the sense that the Defendants said it was unfair to allow the Claimants to rely on it, given that it emerged only during Mr Santini's re-examination by Mr Vanhegan QC. I will come back to this point below. For now, I will simply flag that despite their objection, the Defendants' solicitors conducted some inquiries and on the penultimate day of the trial, submitted a further witness statement of Mr Craggs, attaching a copy of a note of a call which took place with Mr Santini on 18 January 2018. It is therefore common ground that a discussion did take place, but there is some disagreement about what that discussion amounted to.

Acquiescence: Discussion and Conclusions

184. I will now analyse the legal effect of the various points identified above. It is convenient to start with the effect of the EUIPO invalidity action.
185. EUIPO Invalidation Action: According to the later decision of the EUIPO panel of 11 September 2019, the December 2017 invalidity application was "*based on UK trade mark registrations No. 2 414 935 and No. 1 235 127.*" The panel's summary of the Claimants' arguments includes the following:

"The mark 'VAGISIL' also has a reputation in the European Union, in particular in the United Kingdom and Italy, for intimate feminine health products by virtue of extensive brand promotion and sales since 1985."

186. The question is whether the Claimants' initiation of their invalidity action was sufficient to stop the clock running on the five year period under s.48 TMA. Was it, in other words, evidence of a *lack* of acquiescence by the Claimants?
187. The Defendants say not: they argue that it was insufficient. They say that in terms, what section 48 requires in order to stop the clock ticking is an objection to the *use* of the later trade mark (the statutory language talks of the proprietor of the earlier mark having " ... *acquiesced for a continuous period of five years in the use of a registered trade mark*"), and objecting to *use* means commencing an infringement action or similar in order to *prevent* use, and merely challenging the registration of the later mark is not enough. More precisely, the way the Defendants put the point is as follows: "[t]he word 'acquiesced' is used only once and when it is used, it is by reference to 'the use' of the mark in the UK. It does not link that acquiescence to any other legal or factual event ...".
188. There is useful guidance in the authorities on the meaning of the phrase "*acquiescence*." The scope of the principle was considered by the CJEU in Levi Strauss [2007] FSR 8 and Budejovicky Budvar [2012] RPC 11. At [44] of the Budvar case, the Court gave the following guidance (emphasis added):

"As observed by the Advocate General in point 70 of her Opinion, referring in particular to the Danish and Swedish language versions of Article 9 of Directive 89/104, the characteristic of a person who acquiesces is that he is passive and declines to take measures open to him to remedy a situation of which he is aware and which is not necessarily as he wishes. To put that another way, the concept of 'acquiescence' implies that the person who acquiesces remains inactive when faced with a situation which he would be in a position to oppose."

189. And at [49] the Court said as follows, apparently with approval (emphasis added):

"It must be added that, as stated by the European Commission, the effect of any administrative action or court action initiated by the proprietor of the earlier trade mark within the period prescribed in Article 9(1) of Directive 89/104 is to interrupt the period of limitation in consequence of acquiescence."

190. In light of this guidance, I am unable to accept the Defendants' construction of section 48.
191. To begin with, as a straightforward matter of language, it seems to me it involves too narrow a reading of the first part of section 48. It is true that what is described there as having preclusive effect is acquiescence " ... *for a continuous period of five years in the use of a registered trade mark*", but it seems to me quite artificial to stress in that phrase only the word "*use*", and to say that what is needed is some step which is directed towards preventing *use per se*. The phrase taken as a whole is " ... *the use of a registered trade mark.*" As a straightforward matter of language, it seems to me clear that if the owner of an earlier mark seeks to invalidate the *registration* of a later

mark, he cannot be said to be acquiescing in the use of a *registered trade mark*, because he is saying that there has been no valid registration.

192. This conclusion is reinforced if one considers the basic illogicality which flows from the Defendants' argument:

- i) They argue that the clock stops ticking only when steps are taken to oppose *use* of the later mark in the strict sense, and applying for a declaration of invalidity is *not* a form of opposition to use.
- ii) But if that is right, the consequence must be that even if the proprietor of the earlier mark commences invalidity proceedings within five years, there is *still* ongoing acquiescence for the purposes of section 48. On the Defendants' case, nothing has happened to stop it.
- iii) That cannot be correct.
- iv) In submissions, the Defendants sought to suggest that no problem arose, because in such a case there was no question of the proprietor of the earlier mark being precluded from pursuing the invalidity proceedings, and so the issue of acquiescence did not come into play. They gave the following example:

“A acquiesces in B’s mark for 3 years then applies for a declaration of invalidity while still acquiescing to the use. Another 3 years pass and then A sues for infringement. The declaration of invalidity proceeds and there is no preclusion for that as there is no question of 5 years having passed before it was issued, but as there has still been continuing acquiescence to the use, and for 5+ years, A’s infringement action is precluded.”

- v) It seems to me, however, that this merely sidesteps the problem rather than addressing it. There is no getting around the fact that on the Defendants' case, because the invalidity proceedings are *not* an objection to use, there is continued acquiescence for the purposes of the section as a whole even though the proprietor of the earlier mark has commenced such proceedings. He is thus, while pursuing his invalidity proceedings, at one and the same time nonetheless still *acquiescing*. It is no answer to say that does not matter because he is already making his challenge. What is illogical is the idea that even while doing so, he is simultaneously acting in a manner which qualifies as precisely the form of acquiescence the statute deprecates. It is that basic inconsistency which is the issue.
- vi) To put it yet another way, the proprietor of an earlier mark who seeks to invalidate a later one is objecting to the very *existence* of the mark on which the section 48 defence is based. If he is successful, such that the later mark is declared void *ab initio*, then there never will have been any later mark at all for any other person to have made use of. I find it impossible fairly to characterise such an existential form of attack as amounting to acquiescence. It cannot sensibly be described as involving the sort of passivity the CJEU identified in

Budvar as the essential component of acquiescence (see [188] above), and on the contrary seems to me to qualify as just the sort of “*administrative action or court action*” the Court contemplated *would* interrupt the period of limitation.

193. I am further reinforced in this overall conclusion by the view taken of the acquiescence defence by Arnold J (as he then was) in W3 v Easygroup [2018] FSR 16. The case is not on all fours with the present case, but the approach taken to the acquiescence issue is informative. The issue there was that no proceedings of any kind had been initiated by the proprietor of the earlier mark: but what they had done was to instruct solicitors to write a letter before action with draft particulars of claim attached. Was that sufficient? Arnold J thought the arguments finely balanced, and had the point been central to the case would have referred it to the CJEU, but since it was not central formed his own conclusion and determined (obiter) that enough had been done because the steps taken “*amounted to serious, detailed and credible threats of infringement proceedings*” (see at [353]).
194. What is perhaps of more interest in the context of the present case, however, is how the relevant issue was articulated. At [349], Arnold J formulated it in the following way (emphasis added):
- “The first issue which arises is whether it is necessary for a trade mark proprietor to commence proceedings of some kind in order to stop the acquiescence clock running, or whether it is sufficient to instruct solicitors to write a letter before action and draft particulars of claim.”*
195. And at [350], Arnold J said as follows (emphasis added):
- “Counsel for W3 submitted that it was incumbent on the trade mark proprietor to commence proceedings before a competent tribunal, either for infringement or for a declaration that the relevant trade mark was invalidly registered.”*
196. I accept of course that one cannot read too much into these passages, but what they do illustrate is that the dichotomy which troubled the Court in W3 v. easyGroup was between commencing proceedings *of some kind* on the one hand, and writing a solicitor’s letter before action on the other. There was no suggestion of any possible difference between invalidity proceedings and infringement proceedings, and the formulations adopted both by the Court and by counsel for W3 assumed there was no such difference, and that either step would stop the acquiescence clock ticking. That is consistent, as I see it, with a straightforward reading of the CJEU’s decision in Budvar, and consistent also, as it seems to me, with a common sense reading of s.48 TMA.
197. My conclusion is therefore that the Defendants’ section 48 defence fails on that basis – i.e., on the basis that the effect of the Claimants having initiated their cancellation action before EUIPO in December 2017 was to interrupt the five year limitation period prescribed by s.48 TMA.

198. Adviser Correspondence: If I am wrong about that, however, and if it necessary to be satisfied that steps were taken which involved an overt objection *to use* as such, then I should say I am so satisfied.
199. In fact, it seems to me that one can arrive at that conclusion very easily if the EUIPO cancellation proceedings are looked at not in isolation (as I have regarded them so far), but instead in the context of the parties' interactions which both preceded and then followed their inception, including in particular the correspondence between the parties' German attorneys I have already referred to briefly above.
200. I should say a little more about this correspondence. I can summarise it as follows.
201. The context was Wolff's International Registration, mentioned above at [18]. Although the International Registration was granted protection in the EU on 4 December 2012, in March 2013, Combe US opposed the US designation of the International Registration. Discussions about that expanded into exchanges about a possible global agreement, to govern the relationship between the brands across a number of territories.
202. The basic source of disagreement was (or at least came to be) as follows. Wolff's view was that, aside perhaps from the United States (Combe's home market), and Germany (Wolff's home market), where they would agree not to compete against each other, it should be possible in other places for the VAGISIL and VAGISAN brands and marks to *coexist* side-by-side.
203. Combe's view was that such coexistence was not practicable or desirable, and they would not agree to it. Their point was that there were a number of markets where they had a strong presence (the UK being one of them), and in such markets they would not tolerate coexistence with VAGISAN.
204. This divergence of approach can be illustrated by reference to just a few exchanges between the advisers.
205. On 29 January 2014, Prinz & Partner, Combe's German attorneys, wrote to Lossenback, Specht, Dantz, Wolff's attorneys, and made the following "*basic proposals for a global settlement agreement*" (emphasis added):
- “1. Our client, COMBE Incorporated ... will refrain from using their trademark 'Vagisil' in Germany, Austria and Switzerland ('Wolff countries').
2. Your client, Dr August Wolff ... will refrain from using the trademarks 'Vagisan' and 'Vaginelle' in the United States, Canada, Argentina, Brazil, Australia, New Zealand, Singapore, Thailand, India, Russian Portugal, Spain, Poland and the United Kingdom ('COMBE countries').”
206. Note here the stated objection to *use*.

207. In their response of 25 February 2014, Loesenback, Specht, Dantz pointed to the fact that “*in several countries both trademarks coexist for several years*”, and expressed the hope that Combe “*can agree just to continue this coexistence.*”
208. In their response of 10 June 2014, Prinz & Partner disagreed, and said (emphasis added):
- “ ... while our client is still prepared to negotiate a coexistence of the marks ‘Vagisil’ and ‘Vagisan on specific markets, they are not willing to tolerate the use of your clients’ trademark ‘Vagisan’ on their major markets such as the home North American market.”*
209. I note again that the objection is to use. I also think there is no doubt that, looked at in the context of the earlier letter of 29 January, the UK was one of the major markets in which Prinz & Partner were saying that use would not be tolerated.
210. Although there were further exchanges, matters had not progressed by 4 October 2014, when Prinz & Partner wrote again rejecting the concept of coexistence of the two signs, and contesting the proposition that there had been any real coexistence to date. In making the latter point, they repeated the list of “*major markets*” set out in the letter of 29 January – which included the United Kingdom – and said that while Combe had “*substantial sales of products under the ‘Vagisil’ mark in European Union countries such as the United Kingdom, Italy, Poland among others*”, Wolff “*appears to have no sales*”, apart from in the United Kingdom where “*there is only one ‘Vagisan’ product available.*”
211. As I read it, the 4 October letter, in thus again rejecting the idea of coexistence in the “*major markets*”, was obviously maintaining the objection to *use* of the VAGISAN sign in those markets first made in the letter of 29 January.
212. The matter is put beyond any serious doubt by the further passage in the same letter of 4 October 2014, responding to a proposal from Wolff that coexistence might be possible if Wolff marketed its products under the name ‘*Vaginelle*’, not ‘*Vagisan*’:
- “We have discussed your inquiry with our client as to whether they would tolerate the use of the mark ‘Vaginelle’ instead of ‘Vagisan’ in our client’s major markets, but we regret to inform you that our client is not prepared at this time to provide their consent to this use, for the reasons given in our letter of 29 January 2014. Many of the consumers in our client’s major markets use the English language where ‘Vagisil’ and ‘Vaginelle’ are pronounced very similarly. However, an agreement can undoubtedly be reached if your client chose another mark which is more distant to our client’s marks ‘Vagisil’ and ‘Vionell’, respectively.”*
213. Here, Combe are again objecting to the use of the mark “*Vagisan*” in the UK: they are saying they will not tolerate use even of the suggested improvement on “*Vagisan*”, namely “*Vaginelle.*” Implicit in that, obviously, is the idea that Vagisan is equally (if not more) objectionable.

214. Correspondence continued through late 2014 and into early 2015, but without any real progress being made. By early 2015, however, the parties had reached stalemate. As an email from Anja-Silja Loesenbeck (Wolff’s German adviser) dated 9 February 2015 recognised, at the heart of it was the fact that Wolff thought the trademarks “*are able to coexist*”, and Combe disagreed. Ms Loesenbeck put forward one final proposal, for a “*quick overall settlement*”, which would involve Combe agreeing not to use its VAGISIL designation in Germany, Wolff agreeing not to use its VAGISAN designation in the US, and coexistence in “*all other countries of the world.*”
215. That proposal was rejected by Mr Suzbach of Prinz & Partner in an email the following day, 10 February 2015, and after that the parties’ negotiations effectively came to an end for the time being.
216. In his evidence at trial, Mr Santini said that in addition to the correspondence conducted through the German lawyers, he separately had communications with Wolff’s representatives in which he made the same points. That evidence is consistent with common sense in that it is just what one would have expected to happen, and I accept it.
217. In any event, the result in the breakdown in negotiations, as I have mentioned above, was a series of opposition and cancellation actions commenced by Combe against Wolff in a number of different jurisdictions across the globe. For instance:
- i) on 15 December 2015, Combe opposed Wolff’s application in Australia;
 - ii) on 24 December 2015, Combe opposed Wolff’s application in New Zealand; and
 - iii) on 14 November 2017, Combe commenced invalidity proceedings against Wolff’s Singaporean designation of the International TM 985168 for VAGISAN.
218. If necessary, it seems to me entirely appropriate to look at this broader context in evaluating the significance of Combe’s 2 December 2017 EUIPO *cancellation action*. What the context makes clear is that the invalidity proceedings were commenced as part of a wider, indeed global, dispute about the *use* of the VAGISAN mark in a number of different jurisdictions, including the United Kingdom. The genesis of the administrative actions taken by Combe was a disagreement, evidenced very clearly in the correspondence I have referred to, about the possible *coexistence* of the two brands in jurisdictions outside North America and Germany. Combe’s very clear position was that it would not tolerate *use* of the VAGISAN sign or mark in its major markets, the United Kingdom among them. Thus, when it commenced its EUIPO cancellation proceedings, after it became aware of the relaunch of VAGISAN in the UK in late 2016, it was obviously doing so with a view to preventing *use* of the VAGISAN mark in the UK by Wolff, based on its in-principle objection to the idea of coexistence with Wolff in that market.
219. In the course of his oral evidence, Mr Santini explained that he, as a commercial person, would make no real distinction between objecting to registration and objecting to use. He said:

“If there is a dispute over registration, there is a de facto dispute over use as well. It would, in my opinion, be disingenuous to suggest that a party will accept co-existence of a trade mark in a territory when that party is attempting to cancel your trade mark in that territory. There is no such thing as having a problem with another party’s registration but being okay with their commercial use of the mark. That just does not exist.”

220. I agree with that evaluation, but whatever one may think of it as a general statement of principle, it seems to me that the link between the two is very plainly made out in the present case given the context I have described.

221. Thus in my judgment, it is quite clear that by December 2017 at the latest, the Claimants had taken steps which interrupted the period of limitation under section 48 TMA. By then they were not on any view acquiescing in the use of the later VAGISAN mark in the UK. They had made it clear that they would not tolerate such use, and against that background had applied to invalidate the mark. That state of affairs cannot fairly or sensibly be described as acquiescence.

222. Two points remain to be dealt with.

223. The January 2018 Discussion: The first is the Claimants’ reliance on the evidence given by Mr Santini in re-examination. This came out in the following way. In cross-examination by Mr Malynicz QC, Mr Santini was asked about paragraph 41 of his Witness Statement, where he said:

“At all material times, Combe made it clear to Wolff that its use of the conflicting Vagisan brand within the UK was unacceptable.”

224. In answer, Mr Santini referred to three areas covered by this general statement, namely: (1) the letters sent by Wolff’s German counsel, which I have referred to above; (2) communications he (Mr Santini) separately had with Wolff representatives *“in the ensuing years where that representation was made”*, and (3) more recent communications in mediation.

225. In re-examination, Mr Santini was asked about item (2). Mr Malynicz QC raised an objection, but I permitted the evidence to be given on the basis that submissions could later be made about its admissibility if necessary, and on the basis that Mr Malynicz QC would in any event be permitted to ask Mr Santini further questions following his re-examination.

226. In response to questioning by Mr Vanhegan QC, Mr Santini said as follows:

“...In January of 2018... I had a live conference with some of Wolff’s management and legal team members who were then asking if there was some way that we could still re-open discussions. During that time, I made it clear to them that, you know, I was always willing to reopen discussions. I was always

seeking a commercial resolution, but that it had to still be in the context that our core markets were off the table...

And that if there was to be any resolution, our core markets were off the table, but we were still willing to continue to discuss a way to resolve this. They, at that time, wanted to... Their proposal was just to go back to the original proposal of 2014, which is 'We will stay out of the US, you stay out of Germany and we will coexist everywhere else'.

So I told them, and I said, 'Look, we are back to where we were three/four years ago, and that does not get us any further'.

I remember distinctly saying then 'And you know, you have a business in the UK. I am going to remove your right from the UK because I do not want you selling there, and then you are not even going to have a business anymore, so why would you not want to try to resolve this?'"

227. It was initially put to Mr Santini in further questioning by Mr Malynicz QC that his recollection of this conversation was a fabrication. That submission was not persisted in, however, and quite properly so, in light of what happened next. This was that, on the penultimate day of the trial, Mr Craggs made a further witness statement giving evidence as to further inquiries he had undertaken with the Defendants. Among other steps, he had spoken to Mr Thunken, Partner at Uexill & Stolberg, Rechtsanwalt for the First Defendant. Mr Thunken and others had identified a telephone call attended by Mr Santini on 18 October 2018. Another partner at Uexill & Stolberg, Mr Dettmann, confirmed this and identified the attendees. They were Mr Dettmann, Mr Michael Dragu, and Mr Christian Fissbeck-Hoofe. Mr Dettmann later provided a copy of an attendance note, the relevant part of which (translated from the German original) is as follows:

"Discussed and decided: Conference call held with Combe's Counsel Tony? and led by PA Sulzbach. Each side set out their position. In regards to countries that overlap, Wolff mentioned Germany, the UK, Poland and the Netherlands. We noted that the USA could be dispensed with if there was continued co-existence in other countries. We also referred to a telephone call between Digman/Striker in 2015 where Combe offered money if Wolff withdrew from the USA. No moving towards each other whatsoever. Any party may come forward."

228. At the same time, Mr Dettmann's position, having been shown the transcript of Mr Santini's evidence, was that he did not recall Mr Santini saying "*And, you know, you have a business in the UK*": his recollection was that Wolff had confronted Mr Santini with the idea that there was co-existence of the Vagisil and Vagisan products in the UK. Also, Mr Dettmann said he did not recall Mr Santini saying "*I am going to remove your right from the UK because I do not want you selling there*"
229. Mr Craggs' Witness Statement was not objected to by Mr Vanhegan QC, who said that it largely confirmed the evidence of Mr Santini. I agree.

230. It seems to me obvious that the substance of this telephone call involved nothing more than a restatement of the parties' long held positions. The Wolff position was that there had long been co-existence of the two marks in a number of jurisdictions, including the UK, and that that could continue. The Combe position was that they would not tolerate co-existence in their key markets, including the UK. By this stage, that had been the position for a number of years. Moreover, it seems to me that an objection to co-existence necessarily implied an objection to use: in fact, it was the same thing as an objection to use. On these points, the attendance note is entirely consistent with Mr Santini's recollection: "*No moving towards each other whatsoever.*" Mr Santini said the same in his evidence: "*So I told them, and I said, 'Look, we are back to where we were three/four years ago, and that does not get us any further.'*"
231. As to the impact of this on the analysis above, it seems to me it merely reinforces the overall assessment I have already made. My starting point is that the inception of the invalidity action in and of itself was enough (see [185]-[197] above); if that is not correct, then the overall context preceding the inception of that action makes it clear that in substance, Combe's objection was to use of the later registered mark (see [198]-[222] above); the evidence of the January 2018 call, coming as it did shortly after the inception of the invalidity action, merely reinforces that latter conclusion, because it emphasises that the context was continued and persistent disagreement about the basic idea of *co-existence*, which Combe objected to in its major markets. That was well understood by Wolff, and they would have seen that as the substance of the ongoing battle they were fighting.
232. That much can be derived from matters which are common ground between the parties. It is not strictly necessary for me to express a view about Mr Santini's specific recollection that he said: "*I am going to remove your right from the UK because I do not want you selling there*" Had it been necessary for me to have formed a view about that, I would have found that he did use words to that effect. That seems to me inherently likely, since (1) the invalidity action had been initiated shortly before the call, in December 2017, and it is very likely that Mr Santini would have referenced it, and (2) the overall context, stretching back over several years, was a contest over continued co-existence of the two marks, which makes it very likely that Mr Santini would have said that he did not want Wolff selling in the UK, either expressly in those terms or by saying that he would not tolerate *co-existence*.
233. Before leaving this topic, I should make it clear that I reject the contention (if persisted in) that Mr Santini's evidence in re-examination was inadmissible. It is true that the evidence in paragraph [41] of his witness statement was extremely compressed, but Mr Malynicz QC having asked Mr Santini to amplify that evidence, he could not properly object to the answers given then being interrogated further by Mr Vanhegan QC in re-examination. In any event, the submission of Mr Craggs' witness statement and the agreed admission of the evidence it contained – which overlapped almost entirely with that given by Mr Santini – would make ignoring Mr Santini's evidence at this stage an entirely artificial exercise.
234. I should also make clear that I reject entirely any submission that Mr Santini was being dishonest in his evidence. I have already said that as I understood matters, that submission was not being persisted in. If it is, I unhesitatingly reject it.

235. Was there in any event Continuous Use? The Claimants in any event advance the argument that there was no “*continuous use*” of the Defendants’ later mark for a period of five years, or at any rate no “*continuous use*” which the Claimants were aware of. That, they say, is because VAGISAN was effectively withdrawn from the market during most of 2015 and 2016.
236. The Defendants accept that their use of the later registered mark was “*modest*” during the 2015-2016 period, but they say that was enough. They also take a pleading point, in that they say it was never suggested until trial that such modest use did not qualify as use at all, or that the UK market had effectively been abandoned.
237. It seems to me the pleading point is easily addressed.
238. I have set out the text of section 48 TMA above. It provides that the relevant defence arises where the proprietor of an earlier mark has “*acquiesced for a continuous period of five years in the use of a registered trade mark in the UK, being aware of that use*” The burden of showing continuous use rests on the Defendants: see s. 100 TMA.
239. In their Re-Re-Amended Defence and Counterclaim, the Defendants put forward their case on section 48 in the following way:
- “The Claimant has (sic.) acquiesced for a continuous period of five years in the Defendants’ use of the First Defendants’ Trade Mark in the United Kingdom, being aware of that use, and is not entitled to oppose the use of the First Defendants’ Trade Mark in relation to the goods in relation to which it has been so used pursuant to section 48(1) of the Trade Marks Act 1994.”*
240. In their Re-Re-Amended Reply and Defence to Counterclaim at paragraph 8(b), after referring at 8(a) to the outcome of the invalidity proceedings commenced in December 2017, the Claimants said:
- “In any event, the allegation of acquiescence is denied.”*
241. The Defendants then said that, pending evidence, disclosure and/or further information, they relied on two particular matters, namely (1) an assertion that the First Defendants’ Trade Mark was not applied for in good faith, and (2) an assertion that the Claimants first came to know of use of the Defendants’ Trade Mark only in January 2014, and then had applied to invalidate it on 2 December 2017, less than five years later.
242. It is true that the Claimants’ pleaded case does not expressly state that there was no continuous use for a period of five years, but I do not consider that gives rise to any legitimate objection by the Defendants. That is for the simple reason that the case that there *was* continuous use for a period of five years was one for the Defendants to make out.
243. That follows both as a result of the express allocation of the burden of proof under TMA section 100, and as a matter of pleading.

244. Section 100 TMA is a straightforward provision, and states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

245. As a matter of pleading, the Defendants having asserted continuous use for a period of five years, the Claimants denied it. True, the Claimants identified two particular points relied on pending disclosure and evidence, and true it is also that no further points were later added. But I do not consider that means that all the Defendants were required to do in order to make good their case was to address those two points. Whether they did nor they did not, they still had to discharge the burden of proof that was on them to show five years of continuous use.

246. As a pure matter of pleading, the Claimants did not have to do anything to put the Defendants to proof of their case. CPR 16.7(1) provides that a claimant who does not file a Reply shall not be taken to admit the matters raised in the Defence, and 16.7(2) provides:

“A claimant who –

(a) files a reply to a defence; but

(b) fails to deal with a matter raised in the defence,

shall be taken to require the allegation to be proved.”

247. The consequence is that a passive claimant who either does not file a Reply at all, or who does so but says nothing about a particular allegation made against him, nonetheless puts the defendant to proof. Here, the Claimants were not entirely passive. They put forward a denial of the Defendants’ case on continuous use. Having done so, they cannot be in a less advantageous position than if they had done nothing, and in particular in my judgment cannot be limited by the two particular points (advanced only pending disclosure and evidence in any event) they put forward.

248. The Defendants must therefore be taken to have known that their case on continuous use was for them to prove. In my judgment, they cannot complain that they were taken by surprise in having to do so, or say they were not clear what it was they had to do.

249. The Claimants now argue that there was no continuous use, but testing that proposition involves doing no more than asking whether the Defendants have in fact discharged the burden of proof they themselves assumed. I see nothing unfair in that.

250. As to this, it seems to me there is actually little dispute about the facts as such. They were not seriously disputed. It is more a question of how they are fairly characterised. Their key points are as follows:

- i) It was common ground that Wolff stopped advertising its VAGISAN products in the UK after June 2014.

- ii) Ms Theveßen accepted in cross-examination that there was no Google search interest for VAGISAN between 2015 and late 2016.
 - iii) In 2015 VAGISAN was delisted from the C&D list, which as Mr Bowman accepted is a comprehensive listing of healthcare products sold in UK pharmacies.
 - iv) The Defendants gave disclosure of their sales figures and invoices. An analysis conducted by the Claimants in their written closing submissions, which was not challenged in closing by the Defendants, calculated that the Defendants sold a maximum of 498 units of VAGISAN into the UK stores market between 7 September 2015 and 8 August 2016.
 - v) The Defendants also relied on use via their website, www.vagisan.com/en-gb/. The Claimants admitted this was targeted at persons in the UK. The Defendants relied on screenshots from “*The Wayback machine*” to show use of the site throughout the five year period between 2014 and 2019.
251. Looking at this evidence, I have come to the view that the Defendants have not discharged the burden of showing there was continuous use of the VAGISAN mark for a period of five years. Some parts of the story are unclear, but what is clear is that there was little if any active marketing of VAGISAN from June 2014 onwards, and that led to sales levels which can very fairly be described as *de minimis*, at least during the 11 month period between December 2015 and August 2016. Mr Malynicz QC submitted that “*use*” does not have to be on a large or competitive scale, but it seems to me, as Mr Vanhegan QC submitted, that it needs to be on a meaningful or commercial scale. By that I mean on a scale which consistent with there being a continuing intention to sell the relevant products commercially. Here, that was not the position for a period of about two years. The low levels of activity were equally well consistent with the idea that Defendants’ foray into the market had failed, or at least was suspended for a prolonged period pending further review. In either case, I see little to persuade me that there was use in any active, commercial sense, and that is surely what the statute requires.
252. In any event, and consistently with that conclusion, I also find that the Claimants were not in any relevant sense *aware* of any use by the Defendants during the 2015-2016 period. Such *use* as in fact took place barely registered with the Claimants, and understandably so given its *de minimis* nature.
253. On this point, I accept Ms Want’s evidence that VAGISAN was kept on a watching brief by Combe, but had no commercial profile for a long period. In her witness statement she said that she thought VAGISAN had either dropped off the market entirely or were so small that she may not have noticed them. In her oral evidence, she explained that during 2015, VAGISAN was not “*coming up in our IRI.*” As she explained, IRI obtains and reports records of all sales through tills at major multiples and at a representative sample of independent pharmacies. The lack of any presence in the IRI returns is significant, because it suggests there were no sales at all in major multiples, supermarkets or monitored pharmacies. Hence, Ms Want said when pressed in cross-examination, in a passage emphasised by Mr Vanhegan QC in closing:

“Q You did not think they had withdrawn from the market though?”

A. They might well have done, but I do not know what – obviously I did not know what their actual strategy was and where they were selling. Could they still be in some tiny little pharmacy that is not being picked up somewhere, I do not know. But from what I can see there is nothing there.

Q. That is not the question. I said did you think at the time that they had withdrawn from the market, Ms Want? It is a very simple question.

A. Then, I guess ---

Q. Did you think it or not?

A. Yes, I did. I must have done, because that is why they were not there.”

254. In light of this evidence, I find that the Claimants were simply not aware for a continuous period of five years of the Defendants’ use of their later mark. Ms Want and her team monitored the market with a degree of care for competitor products, and it seems to me Ms Want was entitled reasonably to assume, as she did, that for whatever reason Wolff were simply not active in the market, in the sense of actively promoting the sale of their products, for a long period during 2015 and 2016. They simply *“were not there.”* Such limited use as there may have been was at such a low level that it did not register with Ms Want, when it was her job to know about it. That cannot be sufficient to engage the defence afforded by section 48, because that defence arises where a party fails to take steps to stop activity it knows about. It cannot arise, it seems to me, where the activity is so limited that it is reasonable for the holder of the earlier registered mark not to be aware of it.

TMA section 11(2)(b)

255. Section 11(2)(b) TMA provides as follows:

“A registered trade mark is not infringed by ... the use of signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services ... provided the use is in accordance with honest practices in industrial or commercial matters.”

256. Section 11(2)(b) is derived from Article 6(1)(b) of Directive 89/104. In Gerolsteiner Brunnen GmbH & Co v. Putsch GmbH (C-100/02) [2004] E.C.R. I-691, the ECJ explained the purpose of Article 6(1)(b):

“Article 6(1)(b) ... provides that the proprietor of the trade mark may not prohibit third party from using, in the course of

trade, indications concerning, inter alia, the geographical origin of goods provided that the third party uses them in accordance with honest practices in industrial or commercial matters.”

257. The logic of the Defendants’ position here is to say that the term VAGI is a sign or (more likely) an *indication* concerning the intended purpose or characteristics of the goods in question – i.e., treatment of conditions affecting the vagina – and consequently the use of VAGI “*as part of the mark*” is not an infringement. Moreover, given that, “*the case against the whole word [i.e. VAGISAN] must be dismissed.*”
258. I am not at all persuaded by this argument.
259. To begin with, I have already determined that the average consumer in 2013 would not have been accustomed to seeing the embedded elements VAGI or VAGIS as signposting or descriptive devices in common usage. Although phonetically suggestive of the vagina (see [93] above), neither expression is a real word, and so I am unpersuaded that VAGI – the term relied on by the Defendants in advancing the present argument – is sufficiently clear in its meaning to amount to an indication of either the purpose or characteristics of the goods in question.
260. In any event, there is a more fundamental point. What the Claimants seek to prevent is not the use of the embedded element VAGI, even if it can properly be characterised as an *indication*, and neither is that what the Defendants want to be able to use. What the Defendants want to use is the overall word sign VAGISAN, and that is what the Claimants want to stop.
261. I do not see that, as a matter of construction, section 11(2)(b) is apposite to cover that sort of case. The Defendants’ approach is quite artificial in my view. It seems to operate in reverse. It starts from the premise that the embedded term VAGI is an *indication*, with the consequence that the overall *sign* in which it is embedded can be used with impunity.
262. This seems to me to involve entirely the wrong starting point. The correct starting point is not the embedded term VAGI, even assuming it can fairly be described as an *indication*, but instead the word sign VAGISAN. The questions to ask under the section are (1) whether that word sign is distinctive (which I understood to be common ground), and (2) whether that overall sign is descriptive of the intended purpose or characteristics of the goods in question, within the meaning of section 11(2)(b). Not even the Defendants argue that it is, and nor could they: as the Claimants point out, it is a single, invented word with no defined or intrinsic meaning at all. It therefore does not fall within section 11(2)(b), and it is quite artificial to say that it can be made to fit by splitting it in two somewhat arbitrarily (in the sense that VAG or VAGIS rather than VAGI would be equally appropriate break points), and then extrapolating from the possibly indicative nature of the term VAGI the conclusion that the overall word sign VAGISAN is unobjectionable. That seems to me to involve reverse engineering of an entirely illogical type.
263. That conclusion is enough to dispose of the Defendants’ argument on section 11(2)(b), but I would in any event reach the same overall conclusion on the basis that

the Defendants' use of the VAGISAN sign was not in accordance with honest practices in industrial and commercial matters – i.e., the further requirement of section 11(2)(b). As to this, I was referred to the principles set out by Arnold J in Hotel Cipriani v Cipriani (Grosvenor Street) [2009] RPC 9 at [143]-[140], and to the detailed questions, to be used in performing the evaluation, set out by Arnold J in Samuel Smith v Lee [2012] FSR 7 at para 118. I bear in mind in particular Arnold J's explanation that the requirement to act in accordance with honest practices in industrial and commercial matters constitutes in substance the expression of a duty to act fairly in relation to the legitimate interests of the trade mark proprietor.

264. I come to my conclusion for the following reasons:

- i) Although I accept the Defendant's evidence that the choice of the word VAGISAN was originally made in Germany in the mid-1990s, it seems without knowledge of Combe and its brand, nonetheless by the time of the launch of the VAGISAN products in the UK in 2013, the Defendants were well aware of the VAGISIL marks because they wrote seeking permission to use the sign VAGISAN, which the Claimants refused. Moreover, there was a direct overlap between the brands in the sense that the Defendants' goods fell (and fall) within the same sector as the Claimants' goods.
- ii) Thereafter, what is most striking in the Defendants' conduct is their blinkered unwillingness, after the relaunch in late 2016, to acknowledge in any way the clear signals they were receiving about not only the likelihood of confusion between the brands, but also about ongoing *actual* confusion.
- iii) I have dealt with my analysis of these topics above, and will not repeat my detailed findings here. The broad points are that (1) the Defendants were plainly aware (from the German lawyers' correspondence and Mr Santini) that the Claimants' objected to their use of VAGISAN in the UK; (2) they were warned of at least the *potential* for brand confusion by DJS in February 2017 (see above at [121]); (3) the later TimeInc survey ([123] above) and expression of concern by Hugh Lindsay ([126]) pointed in the same direction, and should have been matters of real concern but effectively were ignored; (4) the fact that there actually *was* confusion was then put beyond any real doubt by Ms Theveßen's trusted advisers, Eisold-Mediateam in May 2018 (above at [128]), but the marketing drive continued anyway with the Jenny Éclair advertising campaign in the Autumn of 2018; (5) that inevitably only reinforced the problem (as evidenced by the MonkeySee work undertaken during 2019 – [134]-[142] above).
- iv) To put the matter shortly, as the Claimants did in their written Closing Submissions, the Defendants knew that their use of VAGISAN was likely to cause confusion and carried on when it did. They had no real justification for doing so, and carried on despite continued objections from the Claimants, including their invalidity action commenced in December 2017. Such a pattern of behaviour, to my mind, does not constitute acting fairly in relation to the legitimate interests of the trade mark proprietor, and so I conclude that the section 11(2)(b) defence fails on that basis also.

265. Section 11(1) TMA is as follows:

“A registered trade mark is not infringed by the use of a later registered mark where that later registered trade mark would not be declared invalid pursuant to section 47(2A) or (2G) or section 48(1).”

266. This reflects the idea that, although a later registered trade mark which conflicts with an earlier mark will typically have been invalidly registered, so that its use will amount to infringement, in some exceptional instances that will not be the case, because there will be grounds for saying that the later mark *was* validly registered despite it conflicting with the earlier one.

267. Three instances are given, of which only one is conceivably relevant here, namely that provided for in section 48(1). That is the statutory acquiescence ground, which I have already dealt with above. In that regard what section 11(1) is saying is that, even if there appears to be a later, conflicting registered mark which on the face of it is therefore invalid, with the usual consequence that there *will* be a finding of infringement, that result will not follow if the defendant is able to say: well actually, I could defeat any application for invalidity made by the claimant, because they acquiesced in my use of the mark for five years, and so they lost their right to object.

268. The Defendants say that here, because the later VAGISAN mark (i.e., International Trade Mark designating the EU No 0985168 as UK No 00810985168) stands registered on the EUTM register, they have a defence. Although it is under attack, *“as things stand”*, that later mark has not yet been invalidated (because the existing decision is suspended pending a further appeal), and the result is that the Defendants can still say it *“would not be declared invalid.”*

269. I am afraid that again, this argument strikes me as quite artificial, in the sense that it invites me to ignore what has actually happened, including in terms of my own findings in this Judgment:

- i) I have dealt with the statutory acquiescence defence above at [184]-[254], and rejected it. Having done so, and having held that there was *no* acquiescence, I do not see how logically I could possibly conclude that there is no infringement because there *has* been acquiescence, such that the Defendants would be able to resist any declaration of invalidity on that basis. To put it another way, this argument to my mind adds nothing to, and stands or falls with, the acquiescence defence, which I have already rejected.
- ii) In any event, the fact is that Combe *has* made an application for a declaration of invalidity, which has been successful, albeit that the operation of the declaration is suspended automatically pending the Defendants' further appeal. That being so, I do not see how the Defendants can say that, *“as things currently stand”*, their later mark *“would not be declared invalid”*. It would be, *as things currently stand*, and indeed has been.

Honest Concurrent Use

270. The defence of honest concurrent use was recognised by the CJEU in Case 482-09 Budejovický Budvar, národní podnik v Anheuser-Busch Inc [2012] RPC 11, and the approach in that case has been given effect in later English decisions: see IPC Media v Media10 Ltd [2015] FSR 12, and Victoria Plum Ltd v Victorian Plumbing Ltd [2017] FSR 17. The requirements of the defence were explained by Henry Carr J in the latter case as follows, as [74]:

“(i) Where two separate entities have co-existed for a long period, honestly using the same or closely similar names, the inevitable confusion that arises may have to be tolerated.

(ii) This will be the case where the trade mark serves to indicate the goods or services of either of those entities, as opposed to one of them alone. In those circumstances, the guarantee of origin of the claimant's trade mark is not impaired by the defendant's use, because the trade mark does not denote the claimant alone;

(iii) However, the defendant must not take steps which exacerbate the level of confusion beyond that which is inevitable and so encroach upon the claimant's goodwill.”

271. There is a question whether honest concurrent use operates as an independent defence or only as a factor to be considered as part of the overall assessment of whether the average consumer is likely to be confused: see the observations of Arnold J in W3 Ltd v EasyGroup at [287]. Thankfully, however, that is not an issue I have to resolve in this case, because in my view it is clear that the defence is not made out on the evidence.

272. The burden of proof is on the Defendants: see Bentley Motors Limited v. Bentley 1962 Ltd [2021] FSR 14 per Arnold LJ at para 30 – 35. It will be apparent from what has been said already in this Judgment that in my view, they cannot discharge the burden of showing that they have co-existed for a long period with the Claimants in the UK market, honestly using the same or similar names, and without exacerbation of confusion:

i) In the Budvar case, the brands had coexisted for a period of 30 years, and in IPC Media the period was about 15 years. In the present case, sales of the Defendants' products were limited in the period prior to December 2016 when there was a relaunch, and sales were de minimis for most of 2015 and 2016. I do not consider that there has been continuous co-existence for a sufficiently long period so as to engage the defence.

ii) Such co-existence as there has been has not in any event been honest, in the sense of it comporting with a duty to act fairly in relation to the legitimate interests of the trade mark proprietor. That is because, although they were aware both of the Claimants' objection to use, and of the accumulating evidence of both the risk of confusion and of actual confusion, the Defendants persisted in advertising their products for sale. In such circumstances, I find it impossible to say that the guarantee of the origin of the Claimants' trade mark has not been impaired by the Defendants' use.

- iii) For the same reasons as in (ii) above, I conclude that the Defendants exacerbated the level of confusion between the two brands. Apparently unwilling to accept the consequences, they continually discounted the accumulating evidence of confusion and pressed on with their marketing and advertising strategy throughout 2017 and 2018.

The Counterclaims

Declarations: Dr Wolff's VAGISAN

The Claims

273. I have already noted above that from about September 2020, the Defendants began to rebrand their UK range of products under the sign "DR WOLFF'S VAGISAN." The change is illustrated in the examples below:



Fig 1: Product



Fig 2: Front View



274. The Defendants seek a declaration or declarations to the effect that, whatever may have been the position before, this rebranding does not amount to trade mark infringement in respect of the VAGISIL marks. Should such a declaration or declarations be made?

275. The question, essentially, is whether the addition of the words “DR WOLFF’s” before “VAGISAN” alters the conclusion expressed above that, as between VAGISIL and VAGISAN, there is a risk of confusion by the average consumer.
276. The Defendants argue that the addition of these further words makes a material difference and means there is no risk of confusion. They submit that these further words are distinctive and striking to the consumer. They submit that they introduce a major point of phonetic distinction, in the sense that they mean the first three syllables of each mark are dissimilar. They submit that they also introduce a material conceptual difference, in the sense that they have both surnominal and possessive significance (i.e., they identify VAGISAN as belonging to someone called Dr Wolff). In addition, the Defendants relied on the fact that in negotiations with Dr Wolff, Mr Santini appeared to say that he would be content with a rebranding in this form. That is because, in an email dated 5 November 2018, he said:

“As I explained during our meeting and the communications which since followed, in order for Combe to consider a ‘Dr Wolff Vagisan’ co-located combination, the ‘Dr Wolff’ words would have to be at least equal to or greater in prominence (in font size and colour depth) to the ‘Vagisan’ word. That would be the minimum required for consideration of any Dr Wolff Vagisan combination. I will then take that proposal to my business management team for consideration.”

277. The Claimants, responding to this, relied on two broad points. The first was the factual point that, actually, the transition to DR WOLFF’s VAGISAN has not yet been made, or at least is not yet complete. I did not understand this factual proposition to be contested, and indeed it was supported by the evidence of the Defendants’ own witnesses. Mr Bowman confirmed that in his pharmacy, the Defendants’ original product is still referred to as “VAGISAN Moisturising Cream” or “VAGISAN Moist Cream.” Mr Ghauri referred to that product in the same way in his witness statement.
278. At the time of trial, Wolff’s Facebook page used the handle “@VagisanUK” and referred to “Vagisan MoistCream”, and the Twitter page for DR WOLFF’s VAGISAN referred to “VAGISAN Moist Cream ... #vagisan #moistcream.” Ms Theveßen said that these were both errors and would be corrected, but she also accepted that Wolff’s UK website for DR WOLFF’s VAGISAN is still www.vagisan.com, and that the Defendants had not taken the step of buying www.DrWolffsVagisan.com. She also fairly and openly accepted that there were difficulties in trying to move to a new website name:

“The reason behind that, and we have not found a solution, is that we have got one URL for the whole world. So when you enter it, you then choose the countries. If we were to change that to DR WOLFF’s VAGISAN, to which it has not been referred to in Germany – there it is called VAGISAN only – our ranking in Google would go down the page....”

279. As well as relying on these factual points, the Claimants also submitted that, even on the basis of a straightforward comparison, there was still a risk of confusion between

DR WOLFF's VAGISAN and VAGISIL, because the problematic word VAGISAN still plays an independent, distinctive role in the former, composite sign, and that will result in the average consumer still being susceptible to confusion.

Discussion and Analysis

280. It seems to me appropriate to begin by considering the issue of principle, namely whether DR WOLFF's VAGISAN, if a full re-branding *is* implemented, is nonetheless still likely to give rise to confusion. That is really the point of the Defendants' declaration application, and if the answer is yes, and there is still a likelihood of confusion, then it matters not what the status of the rebranding exercise presently is. Even if fully implemented, it would not – on that hypothesis – entitle the Defendants to any declaration.
281. It seems to me the legal issue which arises, in answering this question of principle, is one as to the treatment of a composite sign or mark. I did not understand that basic proposition to be contested. The question of how in law to treat a composite sign or mark has been examined in a number of authorities, and the relevant principles now appear to be well-settled.
282. In Rousselon Freres et Cie v. Horwood Homewares Ltd, the earlier mark was the word "SABATIER", used in relation to knives. The Defendants registered the marks "JUDGE SABATIER" and "STELLAR SABATIER", and those registrations were challenged. The challenge succeeded. Warren J in his judgment referred to the guidance in relation to composite marks given by the ECJ in Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH [2006] E.T.M.R 13, a case in which the owner in Germany of the trade mark LIFE brought an action for infringement against the Defendant who marketed its products under the name "THOMSON LIFE."
283. The ECJ in Medion indicated that the question of likelihood of confusion, even in the case of a composite mark, had to be based on an overall assessment (at [28]-[29]). In some cases, the assessment might be easy, if the composite mark is dominated by one of its components ([29]-[30]). But even where that is not the case, it may be significant if the later mark includes a component which has an independent distinctive role, even if not the dominant role – see at [30], where the Court said:

"... it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without constituting the dominant element."

284. In such a case, as the ECJ went on to say at [36]:

"It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of the mark."

285. This logic was applied by Warren J, with the result that in the case before him, the challenge to the registration of “JUDGE SABATIER” and “STELLAR SABATIER” succeeded. Although the word “SABATIER” was not a dominant component in either of those later marks, nonetheless it retained an “*independent distinctive role*” (see at [90]), and that justified the conclusion that there was a risk of confusion – see at [93]:

“In the present case, the word SABATIER does, I consider, retain an independent distinctive role in HH’s marks ... The reasoning in Medion applies to a composite mark comprising of an earlier mark, such as SABATIER, in juxtaposition with JUDGE or STELLAR. It is not, in my judgment, possible, consistently with the conclusion that the word SABATIER in HH’s marks retains an independent and distinctive role, to maintain that there is no likelihood of confusion between RF’s SABATIER mark and HH’s marks.”

286. In a later case, White & Mackay v. Origin Wine, Arnold J (as he then was), by reference to the later ECJ decision in Bimbo SA v. Office for Harmonization in the Internal Market (Trade Marks & Designs) (OHM) [2014] E.T.M.R 41, emphasised that even in cases where part of the composite mark has an independent distinctive role, the assessment whether there is a likelihood of confusion requires a comparison of the respective marks as a whole (see at [19]). Thus, even if part of the composite mark has an independent distinctive role, the conclusion that there is a risk of confusion is not automatic: it is still necessary “*to carry out a global assessment taking into account all relevant factors*” (see at [21]).

287. As I see it, the present case is not on all fours with cases like Rousselon Freres et Cie v. Horwood Homewares Ltd, because Dr Wolff do not seek to appropriate the name VAGISIL, and rebrand themselves as DR WOLFF’s VAGISIL. The proposed rebranding is as DR WOLFF’s VAGISAN.

288. Nonetheless, it seems to me that the same basic logic and approach must apply. Whether there is a risk of confusion must involve comparing the competing signs, and the carrying out of a global assessment taking account of all relevant factors. If the word VAGISAN in the composite phrase DR WOLFF’s VAGISAN is properly regarded as having an independent distinctive role, then that is a relevant factor in assessing the overall risk of confusion.

289. It seems to me that the word VAGISAN is to be regarded in that way, and that looked at in the round, there is still a risk of confusion. I come to that conclusion for the following reasons.

- i) I of course accept that the phrase “DR WOLFF’s” provides a degree of phonetic distinction to the composite mark, and moreover has surnominal and possessive significance – i.e., as Mr Malynicz QC indicated, it suggests that “*whoever Dr Wolff is, Vagisan belongs to him or her.*”
- ii) That much is true, but to my mind it still does not prevent the word VAGISAN having its own independent, distinctive role. VAGISAN is the product being

sold. That is what the average consumer is interested in, given her condition. In the composite phrase, therefore, it has a natural emphasis and distinction.

- iii) As Ms Want pointed out in her witness statement for trial, it is common for pharmaceutical and cosmetic brands to use “*Dr*” followed by a name as the “*house*” brand for a range of sub-products (she gave a number of examples.) In such cases, it seems to me, the use of “*Dr*” followed by a name is intended to seek to establish the credibility of the product – since it gives the impression it has the imprimatur of someone who is medically qualified. It is therefore not, it seems to me, likely to be understood as a signifier of trade origin, but rather an indicator of the authenticity and likely effectiveness of the product which is then described. That conclusion, it seems to me, is reinforced by the evidence of Mr Bowman (see above at [277]), to the effect that he still refers to the Defendants’ Moist Cream product as VAGISAN despite the rebranding. It seems quite natural to me that he should do so.
 - iv) The next point of course is the one addressed at some length above, namely that VAGISAN is likely to be confused with VAGISIL. They are obviously not the same word, but they are sufficiently similar as to give rise to confusion and it seems to me that on the face of it, that remains so even if the comparison is between the composite phrase DR WOLFF’s VAGISAN and VAGISIL. VAGISAN retains its own independent, distinctive role even in the composite phrase and is very similar to the word VAGISIL. The strong similarity suggests they spring from the same commercial source, or at any rate, from sources which are linked commercially.
 - v) That conclusion is reinforced by the fact that DR WOLFF is not and never has been a well-known brand name in the UK. Wolff’s products, such as Alpecin Caffeine Shampoo, may be well known, but the brand name DR WOLFF is not. Thus, the average consumer, seeing the phrase “DR WOLFF’s” used in conjunction with “VAGISAN”, would not be inclined to think – *yes of course, that is Dr Wolff the manufacturer of Alpecin Shampoo which is different to the company which manufactures VAGISIL.* Moreover, as Ms Want pointed out in her evidence, neither are consumers familiar with *Combe* as the manufacturers of VAGISIL. In other words, there is nothing in the overall context which is likely to help the average consumer make a clear distinction between the separate trade origins of the two brands, even if one is described as DR WOLFF’s VAGISAN.
 - vi) The upshot, in my view, is that the average consumer faced with DR WOLFF’s VAGISAN would nonetheless still consider it to be associated with VAGISIL. She would naturally place emphasis on the word “VAGISAN” as having an independent distinctive role, and would naturally associate it with VAGISIL.
290. Those conclusions are sufficient to dispose of the Defendants’ applications for declarations of non-infringement. I do not, I think, need to analyse further the Claimants’ submissions to the effect that the Defendants’ re-branding exercise is not complete. In truth, they accepted that it was not. As I have pointed out, the evidence of Mr Bowman and Mr Ghauri which the Claimants relied on, and indeed the evidence of Ms Theveßen as to the apparent mistake in failing to amend the Dr Wolff

Facebook page and Twitter account, is probably best characterised as illustrating the limited significance the words “DR WOLFF’s” are likely to have in the composite phrase looked at as a whole, and the relative importance of the word “VAGISAN” as a descriptor of the product which for the average consumer will be the real focus of her attention.

291. I do not attach any weight in the overall analysis to Mr Santini’s email of November 2018. Looked at objectively, such indication as he may have given was tentative only, and at most was a personal, subjective view or opinion. It does not, I think, assist me in determining whether the average consumer is likely to be subject to confusion.
292. Finally, I should say that I have not been persuaded to change my view on the issue of DR WOLFF’s VAGISAN by the Defendants’ reliance on a recent decision of the Singapore Intellectual Property Office (dated 17 September 2021), in which the Hearing Officer reached a different conclusion on the same or a very similar point. That decision is obviously not binding on this Court, and of course reflects the Hearing Officer’s view based on the materials available to him. I have balanced the relevant factors differently and taken a different view on the evidence available to me, including in particular as to the relative significance of the terms “DR WOLFF’s” and “VAGISAN” in the composite mark (see, e.g., the analysis at [46]-[50] of the Singapore decision), as to which I am reinforced in my own conclusion by the evidence produced at trial about the factual position in this jurisdiction (see [290] above). I therefore note that a different outcome was reached in Singapore, but that is something of an occupational hazard in cross-border litigation cases involving multiple actions, and in and of itself is insufficient to persuade me that my own evaluation is wrong.

Partial Revocation of the 127 and 935 Marks

293. This is a short point.
294. By their Counterclaim the Defendants seek revocation of the Claimants’ 127 mark and their 935 mark, in respect of goods which do not relate to vaginal use. They suggest there is insufficient evidence that the Claimants have used those marks in respect of goods which do *not* relate to vaginal use.
295. This point was not pressed with any vigour by the Defendants in submissions, and did not feature at all in either their written or oral closing submissions.
296. In fact, as Mr Vanhegan QC submitted, the evidence is that the Claimants have used VAGISIL on a large scale in relation to hydrating gel and antifungal and anti-itch preparations in the form of creams, gels, powders and wipes, soaps, deodorants and talcum powder.
297. In her evidence, Ms Theveßen accepted that a fair description of the products on which VAGISIL has been used would be “*women’s intimate health care.*” She was obviously correct to do so. That being the case, the Claimants propose that I should limit the existing classes of goods accordingly. I agree, and so will order that the specifications of the 127 and 935 marks are amended to add at the end the words, “*all the aforementioned goods for female intimate healthcare.*”

Overall Conclusions

298. My overall conclusions are therefore as follows:

- i) The Claimants' infringement case under section 10(2)(b) TMA succeeds.
- ii) The Defendants' Counterclaims are dismissed, save to the extent identified at [297] above.