

Intellectual Property Office of Singapore Case Summary: Combe International Ltd v Dr. August Wolff GmbH & Co. KG Arzneimittel [2020] SGIPOS 3

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Vagisan

This case concerns the registered trade mark “**Vagisan**” (“the Mark”) owned by Dr. August Wolff GmbH & Co. KG Arzneimittel (“the Proprietor”) in respect of the following goods:

Class	Goods
3	Soaps, perfumery, essential oils, cosmetics, hair lotions.
5	Pharmaceutical products, sanitary products for medical purposes; dietetic substances for medical purposes.

Combe International Ltd (“the Applicant”) challenged the validity of the registration. One of the main grounds for the challenge was Section 8(2)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed.) and the Applicant relied on the following earlier mark, among others:

S/N	Applicant’s Mark	Applicant’s Goods
1	VAGISIL	<u>Class 3</u> Cosmetics and toiletries for feminine use, lotions, powders, sprays, towels impregnated with non-medicated preparations, and washes; and all other goods in Class 3.
2		<u>Class 5</u> Pharmaceutical preparations, medicated creams, and vaginal suppositories.

To succeed in a challenge under Section 8(2)(b), the Applicant must show: (a) similarity (or identity) of marks; (b) similarity (or identity) of goods; and (c) likelihood of confusion arising from the two similarities.

Similarity of Marks

A comparison of the similarity between the marks - **Vagisan** and **VAGISIL** in the present case - usually entails assessing their similarity from three aspects – visual, aural and conceptual – before making an assessment as to whether they are more similar or dissimilar overall.

On visual similarity, the Principal Assistant Registrar (“PAR”) considered the prefix VAGI to be a weak element in the mark as it is likely to be recognised as a shortening of the word “vagina” and as indicating the intended treatment area of the goods. This being so, the distinctiveness of the Applicant’s Mark lies in the way the prefix VAGI is conjoined with a 3-letter suffix starting with the letter “S”. In view that this distinctiveness is captured in the Mark and because the competing marks coincide in most letters, as well as in their structure and number of letters, the PAR found the marks similar to an above average degree.

With regard to aural similarity, the PAR considered the overall phonetic impression produced by the marks, which is influenced by the number and sequence of its syllables, and the rhythm and intonation of the marks and found the marks similar to an above average degree. In so deciding, the PAR observed that in the aural context, “VAGI” may not be immediately associated with the word “vagina” due to the difference in pronunciation.

As for conceptual similarity, the PAR found that the marks - both invented words with no dictionary meaning – were conceptually neutral.

Overall therefore, the PAR considered that the marks are more similar than dissimilar to an above average extent.

Similarity of Goods

On goods-similarity, the PAR found identity in some goods. For example, the Proprietor's "soaps" and "cosmetics" in Class 3 overlaps with the Applicant's "cosmetics and toiletries for feminine use" and the Proprietor's "pharmaceutical products" in Class 5 overlaps with the Applicant's "pharmaceutical preparations, medicated creams, and vaginal suppositories".

Likelihood of Confusion

Taking a holistic view of all the circumstances, the PAR found that a likelihood of confusion exists on the facts. Some factors given by the PAR as pointing to a likelihood of confusion are: the above average degree of similarity between the marks, the identity of the goods, the impression given by the marks and the possibility of imperfect recollection of the mark.

The PAR recognised that consumers will pay a fairly high degree of attention when purchasing the goods concerned but was of the view that while that may render direct confusion (i.e. mistaking one mark for another) less likely, the possibility of indirect confusion still exists (i.e. that consumers may think that the goods come from sources that are economically linked or associated). Furthermore, even consumers paying a higher degree of attention need to rely on their imperfect recollection of trade marks.

Conclusion

The PAR therefore allowed the application, and declared the registration of **Vagisan** to be invalid.

Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/docs/default-source/resources-library/hearings-and-mediation/legal-decisions/2020/combe-international-v-dr-august-wolff-arzneimittel-2020-sqipos-3.pdf>.