

O/0709/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004099869

BY

JOEL HARRY BROWN

TO REGISTER:

DR WATSON

AS A TRADE MARK IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP000451734

BY CONAN DOYLE ESTATE LIMITED

BACKGROUND AND PLEADINGS

1. On 13 September 2024, Joel Harry Brown (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 4 October 2024. The applicant seeks registration for the following goods:

Class 25: Articles of clothing; articles of underclothing; articles of outerclothing; leisurewear; sportswear; footwear; headgear.

2. On 6 January 2025, the application was opposed by Conan Doyle Estate Limited (“the opponent”). The opposition is brought under sections 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”).¹ The opponent relies on the following marks:

5(2)(a) ground

DR WATSON

(“the first earlier mark”)

UKTM No. 3552648

Filing date: 6 November 2020

Registration date: 23 April 2021

Relying on the following goods and services:

Class 9: recorded television programmes; motion picture films; eyewear; spectacles and sunglasses; articles of protective clothing, footwear and headgear.

¹ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

Class 16: hat boxes of cardboard.

Class 41: production and distribution of television programmes; presentation of television programmes; television entertainment; production and distribution of motion pictures; presentation of films; entertainment by film.

5(2)(b) ground

HOLMES & WATSON

("the second earlier mark")

UKTM No. 3983434

Filing date: 23 November 2023

Registration date: 22 March 2024

Relying on the following goods:

Class 9: eyewear; spectacles and sunglasses; articles of protective clothing, footwear and headgear

Class 16: hat boxes of cardboard

Class 18: bags; garment bags for travel; handbags; shoulder bags; tote bags; back packs; rucksacks; holdalls; sports bags; kit bags; duffle bags; bum bags; shoe bags

Class 25: clothing, footwear, headwear; articles of outer clothing; leisurewear; shirts; t-shirts; polo shirts; sweatshirts; knitwear; hooded tops; jerseys; jumpers; waistcoats; suits; shorts; trousers; pants; skirts; dresses; neckties; waterproof clothing; jackets; coats; underwear; nightwear; sleepwear; pyjamas; dressing gowns; swimwear; socks; gloves; mittens; scarves; ear muffs; wristbands; belts; braces; aprons; hats; caps; headbands; pocket squares; face masks; face coverings; articles of clothing, footwear and headgear for babies and children; bibs; costumes; fancy dress costumes

3. The trade marks relied upon by the opponent qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had not completed their registration process more than 5 years before the filing date of the application in issue, they are not subject to the use provisions in section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services identified.
4. The opponent claims that the marks at issue are either identical or similar and that the goods for which application is sought are identical and/or similar to the relied upon goods/services. As a result, the opponent argues that there exists a likelihood of confusion.
5. The applicant filed a counterstatement. For the 5(2)(a) claim it admitted that the first earlier mark is identical to the application but denied that the goods are sufficiently similar to give rise to a likelihood of confusion. The applicant also denied the claims made under section 5(2)(b).
6. Only the opponent filed evidence. A short-format hearing took place before me on 7 July 2026, by video conference. The applicant was represented by Ms Claire Breheny of Mathys & Squire LLP who have represented the applicant throughout these proceedings. Skeleton arguments were filed by the applicant prior to the hearing. The opponent, who has been represented by Wilson Gunn throughout these proceedings, did not attend the hearing but elected to file submissions in lieu.

Evidence

7. The opponent's evidence came in the form of a witness statement of Lewis Byrom dated 7 July 2025. Mr Byrom is a Trade Mark Attorney at Wilson Gunn, the representatives of the opponent. Mr Byrom's evidence is accompanied by 22 exhibits, being LB1-LB22. The evidence was adduced to support the opponent's claims of a connection between the opponent's class 41 services and the applicant's class 25 goods.

8. I do not intend to summarise the evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

Preliminary issue

9. On 1 July 2026, the applicant filed a revocation action for non-use against the opponent's first earlier mark (CA000510833). As such, the applicant, in its skeleton arguments, requested that this decision be provisional pending the outcome of the revocation.
10. In *Moore's Rowland*,² Iain Purvis KC confirmed that where the effective date of revocation of an earlier mark falls after the filing date of a contested mark, the opponent may still rely on that earlier mark in opposition proceedings because it remained a valid registration at the relevant date.
11. It is noted that in the revocation action, the earliest revocation date requested by the applicant is 24 April 2026. Therefore, if the revocation is successful, at the filing date of the contested mark (13 September 2024) the first earlier mark would still constitute a valid mark for the purposes of this opposition. The outcome of the revocation action mentioned within the applicant's skeleton arguments therefore has no impact on these proceedings and I do not consider it necessary to treat the current decision as provisional.

My approach

12. The opponent has relied upon its first earlier mark in respect of section 5(2)(a) and its second earlier mark in respect of 5(2)(b). In terms of my approach, I consider it appropriate to begin my assessment with the section 5(2)(a) ground. If this succeeds in full, it will not be necessary to consider the section 5(2)(b) ground. However, if it fails or is only partially successful, I will return to consider

² BL O/0689/25 paragraphs 20-23

the opponent's claim under section 5(2)(b). If required, I will address this point further when considering any final remarks at the conclusion of this decision.

DECISION

Section 5(2)(a)

13. Section 5(2)(a) of the Act is as follows:

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

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

[...]

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

14. Section 5A of the Act states that:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Section 5(2) case law

15. I note the following parts from the standard summary of the principles applicable to the assessment of the likelihood of confusion insofar as it relates to section 5(2)(a) (which requires identical marks):³

(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;

[...]

(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

³ See *Supreme Court judgment in Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25

(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.

Identical marks

16. The parties have agreed that the first earlier mark is identical to the contested mark.

Comparison of goods and services

17. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated that:

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

18. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

19. The goods and services to be compared are as follows:

Opponent's goods and services	Applicant's goods
Class 9: recorded television programmes; motion picture films; eyewear; spectacles and sunglasses; articles of protective clothing, footwear and headgear. Class 16: hat boxes of cardboard. Class 41: production and distribution of television programmes; presentation of television programmes; television entertainment; production and distribution of motion pictures; presentation of films; entertainment by film.	Class 25: Articles of clothing; articles of underclothing; articles of outerclothing; leisurewear; sportswear; footwear; headgear.

20. In its submissions in lieu, the opponent submits the following:

“...the *articles of protective clothing, footwear and headgear* covered by the Opponent’s earlier trade mark are similar to all of the goods covered by the Application. The two sets of goods overlap in their physical nature, both being items of clothing and likely being manufactured from similar materials. They are also likely to be manufactured in similar factories, stored in the same warehouses and distributed by the same entities. They therefore occupy the same channels of trade and reach the market in a like manner. Also, protective clothing, footwear and headgear encompasses goods such as ski gloves, boots and helmets. Having regard to a notional and fair use of the goods at issue, these may therefore be offered alongside the clothing goods covered by the Application (which encompass sportswear and explicitly include leisurewear).”⁴

21. At the hearing, Ms Breheny submitted that these goods are fundamentally dissimilar as they are classified differently and they have different natures. It was also submitted that protective clothing would include goods such as fire-retardant clothing or steel cap boots. They would be made to a safety standard, bought by different categories of people like employers, sold through industrial and safety suppliers with quality standards. A consumer would not see these as coming from the same entity or the same supplier. They would be sold through specialist retailers and have a different function to general clothing.

Articles of clothing; articles of outerclothing; leisurewear; sportswear.

22. When comparing the above terms to *protective clothing*, I note that section 60A(1)(a) of the Act provides that goods are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, nor dissimilar to each other on the ground that they appear in different classes under the Nice Classification. The respective goods share the same broad nature and method of use, in that they are all garments worn on the body. The earlier goods are specifically intended to protect the wearer against injury or particular hazards, whereas the applicant's goods are not subject to such a limitation. With that said, I accept that clothing generally provides the wearer

⁴ The opponent’s submissions in lieu at [11].

some protection from the elements, but not specifically from accident or injury in dangerous environments. Whilst the earlier goods are likely to be sold through specialist safety and workwear suppliers to a greater extent than the applicant's goods, there remains potential for some overlap in trade channels, particularly where retailers offer both protective and non-protective clothing. There may be some overlap in user. The respective goods are not complementary, and I find it unlikely that protective clothing would compete with the above terms. Taking these factors together, I consider there to be a medium degree of similarity.

Articles of underclothing.

23. I compare this term to *protective clothing*. Whilst both are items of clothing worn on the body and therefore share some similarity in nature and method of use, their respective purposes differ. *Articles of underclothing* are primarily intended to provide comfort, hygiene, warmth and a layer beneath outer garments, whereas *protective clothing* is specifically designed to protect the wearer against particular hazards. Whilst there may be some overlap in users and a limited degree of overlap in trade channels, the goods are unlikely to compete and are not complementary. As such, I consider there to be a low degree of similarity.

Footwear; headgear.

24. I consider the closest comparator to *footwear* and *headgear* to be *articles of protective footwear and headgear* respectively. My same reasoning in paragraph 22 also applies here. There is an overlap in nature and method of use with the competing terms. While footwear and headgear provide the wearer with some protection, it is not to the extent that it protects the wearer from accident or injury in a dangerous environment. Users may overlap, as may trade channels. There is no complementary or any competitive relationship to be found between these goods. On balance, I find there to be a medium degree of similarity between *articles of protective footwear and footwear* and *articles of protective headgear and headgear*.

The average consumer and the purchasing act

25. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

26. In *Iconix Luxembourg Holdings*, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor* (Rev1) [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

27. The average consumer for the goods at issue will comprise members of the general public and business users purchasing the goods in the course of their business activities such as tradespeople. The goods are likely to be selected primarily from retail premises, specialist suppliers, catalogues or websites. As such, visual considerations will dominate the purchasing process. However, I do not discount aural considerations, for example where the goods are discussed with a sales assistant or recommended by a third party.
28. The cost of the goods is likely to vary considerably. Generally, I consider that the average consumer will pay a medium degree of attention during the purchasing process. However, a somewhat higher level of attention is likely to be paid in relation to protective clothing, footwear and headgear, where factors such as suitability for purpose, durability, compliance with safety requirements and the degree of protection afforded may be taken into account. Overall, I consider the level of attention to range from medium to above average depending on the particular goods being purchased.

Distinctive character of the earlier mark

29. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

30. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

31. There has been no claim that the mark enjoys an enhanced level of distinctive character, nor has there been any evidence filed to that effect. Consequently, I have only the inherent position to consider.

32. The applicant submits that, while the first earlier mark must possess at least some distinctive character, any such distinctiveness is minimal in relation to the class 9 and 41 goods and services. This is because consumers are likely to perceive "Dr Watson" as a reference to the literary character, rather than as an indicator of trade origin.

33. In support of this, the applicant referred to the Trade Marks Manual Examination Guide which states the following in relation to names of well-known fictional characters:⁵

⁵ <https://www.gov.uk/guidance/trade-marks-manual/the-examination-guide>

“The level of recognition, fame and historical use associated with some fictional names means that they are unlikely to be perceived as indicators of trade origin. For example, ‘SHERLOCK HOLMES’ is a name that has been used by many traders over the years in order to describe both a series of stories and a character that appears therein. Because of the extent of its use, today’s relevant public would not expect products bearing the name ‘SHERLOCK HOLMES’ to originate from the estate of Arthur Conan Doyle. In this type of scenario, the name of the character is devoid of any distinctive character, and is descriptive of any books, films etc. which feature that character. Objections would therefore be taken under sections 3(1)(b) and (c). However, ‘SHERLOCK HOLMES’ applied for bananas or wedding dresses for example, which have no association with the character, would not face an objection.”

34. The applicant also provided a copy of a letter from the EUIPO refusing to register “Dr Watson” as an EU trade mark. The EUIPO considered that the mark was descriptive and lacked distinctive character for certain goods and services in classes 9, 16 and 41. I have considered that letter, however, the refusal did not concern the goods I have compared in this decision, namely articles of protective clothing, footwear and headgear.

35. I find that a significant proportion of the relevant public will understand Dr Watson as a reference to the literary character found in the Sherlock Holmes series of stories. Further, I appreciate that the Trade Marks Manual Examination Guide states that the names of fictional characters may be considered descriptive in relation to goods and services connected with books, films and similar media. However, my assessment of the goods has been confined to the opponent’s protective clothing, footwear and headgear. In respect of those goods, I consider the mark to possess a medium degree of inherent distinctiveness. The mark is neither descriptive nor allusive of these particular goods in question, and I do not consider that they have any meaningful association with the literary character Dr Watson.

Likelihood of confusion

36. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he or she has retained in their mind.

37. I have found the marks to be identical, and I have found the goods to range in similarity from low to medium. I have found that the average consumer will comprise of members of the general public and business users purchasing the goods in the course of their business activities such as tradespeople. Whilst the level of attention paid in respect to purchasing clothing will be medium, a somewhat higher level of attention is likely to be paid in relation to protective clothing, footwear and headgear. I found that visual aspects will dominate the purchasing process, however, I did not discount an aural aspect. I found the earlier mark to hold a medium degree of inherent distinctiveness.

38. Weighing up all of the above, noting the principle of imperfect recollection, that the earlier mark has a medium level of distinctive character, and that consumers rarely have the opportunity to compare marks side by side, I consider that the average consumer is likely to mistake the parties' marks for one another even where I have found the goods to be similar to a low degree. I make this finding on the basis of the interdependency principle, and I consider this lesser degree of

similarity between these goods will be offset by the identity between the competing marks. Consequently, I find that there is a likelihood of direct confusion between the marks. For the avoidance of doubt, the identity of the marks also means that this finding applies even where the consumer pays a higher than medium degree of attention.

Final Remarks

39. Given that I have found a likelihood of confusion based on section 5(2)(a), I do not consider it necessary to consider the 5(2)(b) claim on the basis that doing so will not improve the opponent's position.

CONCLUSION

40. The opposition under section 5(2)(a) of the Act is successful. Subject to any appeal against this decision, the application shall be refused protection in the UK.

COSTS

41. The opponent has succeeded and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced on or after 1 February 2023 are governed by Annex A of Tribunal Practice Notice ('TPN') 1 of 2023. Using that TPN as a guide, I award the opponent the sum of **£1300** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee for filing Form TM7:	£100
Preparing the Statement of Grounds and considering the Counterstatement:	£250
Filing evidence:	£600

Preparing written submissions in lieu: £350

Total: £1300

42. I therefore order Joel Harry Brown to pay Conan Doyle Estate Limited the sum of £1300. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 10th day of August 2026

Catrin Williams
For the Registrar