BL O/1016/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3619780
BY SHIELDSIE LTD
TO REGISTER THE FOLLOWING TRADE MARK:

Barrier Coat

IN CLASSES 9, 10 & 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 431896
BY MOLNLYCKE HEALTH CARE AB

Background and pleadings

1. On 31 March 2021, Shieldsie Ltd ("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 17 December 2021. The goods applied for are as follows:

> Class 9: Masks [Protective -]; Protecting masks; Head protection; Helmets (Protective -); Eye protection; Visors [protective]; Protective masks; Protection masks; Protective helmets; Protective headgear; Protective visors; Protective face-shields for protective helmets; Dust protective masks; Face-protection shields; Dust masks.
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> Class 10: Protective visors for medical use; Sanitary masks for dust isolation for medical purposes; Sanitary masks for dust prevention for medical purposes; Face protection shields for medical use; Protective face masks for medical use; Protective face masks for dental use; Face masks for surgical use for toxic substance protection; Face masks for surgical use for anti bacterial protection; Face masks for medical use for anti bacterial protection; Face masks for medical use for toxic substance protection; Face shields for surgical use; Face shields for medical use; Face masks for surgical use; Face masks for medical use.
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> Class 25: Waterproof clothing; Weatherproof clothing; Jackets [clothing]; Coats (Top -); Dust coats; Car coats; Wind coats; Rain coats; House coats; Top coats; Winter coats; Trench coats; Wind-jackets; Wind suits; Wind vests; Wind jackets; Wind-resistant jackets; Wind-resistant vests; Wind resistant jackets; Rain ponchos; Rain suits; Rain wear; Rain capes; Rain trousers; Rain jackets; Rain hats; Motorcycle rain suits; Evening coats; Duffle coats; Suit coats; Sport coats; Frock coats; Duffel coats; Heavy coats; Light-reflecting coats; Head wear; Tops [clothing]; Hoods [clothing]; Leisure clothing; Girls' clothing; Cyclists' clothing; Slipovers [clothing]; Casual clothing; Capes (clothing); Face mask [clothing]; Face masks [fashion wear]; Hoods; Hooded sweatshirts; Hooded tops; Hooded pullovers; Hooded sweat shirts; Snoods [scarves]; Sailing wet weather clothing; Weather resistant outer clothing; Sweat bottoms; Sweat suits; Sweat shirts;

Sweat jackets; Sweat pants; Trousers for sweating; Rain slickers; Ponchos; Sports clothing; Combinations [clothing].

2. The application was partially opposed by Molnlycke Health Care AB ("the opponent") on 16 March 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and within the Form TM7 the opponent has listed all the applicant's terms in classes 9 and 10 and the following terms from class 25 as being the subject of this opposition:

Class 25: Jackets [clothing]; Coats (Top-); Dust coats; Top coats; Head wear; Tops [clothing]; Hoods [clothing]; Slipovers [clothing]; Face mask [clothing]; Face masks [fashion wear]; Hoods.

3. The opponent relies on the following trade mark:

UK3583197

BARRIER

Filing date: 22 January 2021
Registration date: 28 May 2021

Relying upon all goods for which the earlier mark is protected, namely:

Class 10: Protective clothing for surgical and medical use; surgical and medical suits; scrub suits; single use warm-up jackets; surgical and medical gloves; surgical and medical face masks; surgical and medical gowns; surgical and medical headwear; surgical and medical footwear; surgical and medical drapes; equipment drapes; surgical and medical sterile sheets; surgical and medical table covers; drapes, sheets and napkins of textile material and linen for surgical and medical use; drapes, sheets and napkins of paper for medical and surgical purposes; blankets for use in surgery and medicine; self-warming

blankets; surgical and medical apparatus and instruments; fluid collection pouches; instrument bags; receptacles for medicines and fluids.

4. The opponent claims that the marks are similar and that the services at issue are identical/similar, resulting in a likelihood of confusion.

5. The applicant filed a counterstatement denying the claims made.

6. The applicant is unrepresented and the opponent is represented by Wilson Gunn.

7. Neither party provided evidence. Neither party requested a hearing but the opponent filed submissions in lieu. This decision is therefore taken following careful consideration of the papers.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Preliminary issues

9. Within the Form TM8 the applicant makes reference to other earlier trademarks that are registered which include the word 'Barrier'. I consider that in *Zero Industry Srl v OHIM*, Case T-400/06, the General Court ('GC') stated that:

> "73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '… there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word

> ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II 4865, paragraph 68, and Case T 29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II 5309, paragraph 71).”

10. The applicant has provided no evidence regarding the market use of these marks, the extent of their use or anything that would show me that the distinctive character of the earlier mark should be diminished. I will therefore consider this no further.

11. Secondly, the applicant refers to their other trademarks relating to ‘Hugging Coat’ and ‘Hug Coat’. This decision is solely based on the applied for mark and whether there is a likelihood of confusion with the earlier mark. There is no consideration regarding its actual use by the applicant. I therefore will consider this line of argument no further also.

DECISION

12. Section 5(2)(b) is being relied upon and is as follows:

> “5(2) A trade mark shall not be registered if because-
>
> > (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> “6. (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

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

14. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3, above, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the filing date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods it has identified.

Case law

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed

and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods and services

16. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "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".

17. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

18. In *Gérard Meric v OHIM* ('Meric'), Case T-133/05, the GC stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

19. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

20. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

21. The goods at issue are:

Applicant's goods	**Opponent's goods**
Class 9: Masks [Protective -]; Protecting masks; Head protection; Helmets	

(Protective -); Eye protection; Visors [protective]; Protective masks; Protection masks; Protective helmets; Protective headgear; Protective visors; Protective face-shields for protective helmets; Dust protective masks; Face-protection shields; Dust masks.	
Class 10: Protective visors for medical use; Sanitary masks for dust isolation for medical purposes; Sanitary masks for dust prevention for medical purposes; Face protection shields for medical use; Protective face masks for medical use; Protective face masks for dental use; Face masks for surgical use for toxic substance protection; Face masks for surgical use for anti bacterial protection; Face masks for medical use for anti bacterial protection; Face masks for medical use for toxic substance protection; Face shields for surgical use; Face shields for medical use; Face masks for surgical use; Face masks for medical use.	Class 10: Protective clothing for surgical and medical use; surgical and medical suits; scrub suits; single use warm-up jackets; surgical and medical gloves; surgical and medical face masks; surgical and medical gowns; surgical and medical headwear; surgical and medical footwear; surgical and medical drapes; equipment drapes; surgical and medical sterile sheets; surgical and medical table covers; drapes, sheets and napkins of textile material and linen for surgical and medical use; drapes, sheets and napkins of paper for medical and surgical purposes; blankets for use in surgery and medicine; self-warming blankets; surgical and medical apparatus and instruments; fluid collection pouches; instrument bags; receptacles for medicines and fluids.
Class 25: Jackets [clothing]; Coats (Top-); Dust coats; Top coats; Head wear; Tops [clothing]; Hoods [clothing]; Slipovers [clothing]; Face mask [clothing]; Face masks [fashion wear]; Hoods.	

Class 9

Masks [Protective -]; Protecting masks; Protective masks; Protection masks; Dust protective masks; Dust masks.

22. I note the opponent's comment in their submissions that the applicant's class 9 goods are identical to 'surgical and medical headwear' in the opponent's specification unless it is held that class 9 cannot include medical and surgical goods as they are more properly found in class 10. I consider that it would not be correct to find these goods to be identical, however, I still find there to be an overlap in method of use (both types being worn on the face) and a general overlap in the purpose of being protective or related to personal safety with the opponent's 'surgical and medical face masks'. The nature might have some overlap also. The user is likely to be different- medical professionals as opposed to other types of users such as those in construction or in scientific labs although it is possible that the end user of the opponent's goods could be patients who are also exposed to the applicant's goods. I do not believe there to be an overlap in trade channels. They are not complementary nor are they in competition. I therefore find them similar to a medium degree.

Head protection; Helmets (Protective -); Protective helmets; Protective headgear;

23. Following the same line of argument as set out above in paragraph 22, I consider that there will again be an overlap in method of use between the above goods from the applicant's specification and 'surgical and medical headwear' from the opponent's specification as they will all be worn on the head. They will share the purpose of protection for a person's head and the nature might also overlap. The user is likely to be different- medical professionals as opposed to other types of users such as those in construction or in scientific labs although it is possible that the end user of the opponent's goods could be patients who are also exposed to the applicant's goods. I do not believe there to be an overlap in trade channels. They are not complementary nor are they in competition. I therefore find them similar to a medium degree.

Eye protection; Visors [protective]; Protective visors; Protective face-shields for protective helmets; Face-protection shields

24. I consider that the same findings apply here as at paragraph 23 above save for the nature of the goods might differ. I therefore find them to be similar to between a low and medium degree.

Class 10

Protective visors for medical use; Face shields for surgical use; Face shields for medical use

25. I find that the above goods fall within the wider category of 'surgical and medical headwear' from the opponent's specification and therefore find them to be identical under the *Meric* principles.

Sanitary masks for dust isolation for medical purposes; Sanitary masks for dust prevention for medical purposes; Face protection shields for medical use; Protective face masks for medical use; Protective face masks for dental use; Face masks for surgical use for toxic substance protection; Face masks for surgical use for anti bacterial protection; Face masks for medical use for anti bacterial protection; Face masks for medical use for toxic substance protection; Face masks for surgical use; Face masks for medical use.

26. I consider that the above goods fall within the wider category of 'surgical and medical face masks' and therefore find them to be identical using the *Meric* principles.

Class 25

Jackets [clothing]; Coats (Top-); Dust coats; Top coats; Tops [clothing]; Slipovers [clothing];

27. I consider that all of the above goods from the applicant's specification are types of clothing and will therefore share a similar nature and method of use with the

opponent's 'protective clothing for surgical and medical use'. The opponent's goods will specifically be worn by medical professionals or patients whereas the applicant's goods are all aimed at the general public. It is possible that the end user of the opponent's goods could be patients who are also exposed to the applicant's goods and medical professionals will be members of the public who purchase clothing goods so there is some overlap of user. The purpose is different as the opponent's goods are for protection and sanitation whereas the applicant's goods cover the body and are worn for modesty. The trade channels are different and they are not complementary nor are they in competition. I therefore find the goods to be similar to a low degree.

Head wear; Hoods. Hoods [clothing];

28. I consider the same arguments from paragraph 27 apply here but in relation to the above goods from the applicant's specification and the opponent's 'surgical and medical headwear'. I therefore find these to also be similar to a low degree.

Face mask [clothing]; Face masks [fashion wear];

29. I find there to be an overlap in method of use (both types being worn on the face) with the opponent's 'surgical and medical face masks'. The nature might have some overlap also. I am not convinced that the purpose will be the same, as the opponent's goods are clearly worn for protection whereas the applicant's goods are used for fashionable purposes, or potentially worn to keep the user warm. Once again, the users of the opponent's goods are likely to be medical professionals but could include patients who are also member of the public who are the likely consumer of the above applicant goods. I do not believe there to be an overlap in trade channels. They are not complementary nor are they in competition. I therefore find them similar to a low degree.

The average consumer and the nature of the purchasing act

30. The average consumer is a legal construct, who is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. 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, at [26].

31. I find that the Class 10 goods at issue are all medical or health related goods and therefore, the average consumer is most likely to be a medical professional although I do not discount that there might be some members of the public who can also use these goods particularly face masks and head coverings following the pandemic. In either case, both sets of consumers can be said to be paying a higher than normal degree of attention in the selection of those good.

32. As the applicant's class 9 goods are all safety and protection related, I consider that the average consumer is likely to be businesses (such as construction/builders) or a member of the general public undertaking works that require safety apparel. Once again, as these goods are related to a person's health and safety, I consider that they will be paying a higher degree of attention.

33. For the class 25 goods, these are general clothing goods and therefore the average consumer will be a member of the general public (although I do not discount that there will be professional or business purchasers). The goods can vary in price from very low to very high and the average consumer is likely to pay a medium degree of attention.

34. The selection process for all of the goods is likely to predominantly involve a visual aspect when looking for products in a retail setting or perusing a specialist catalogue or website. The average consumer might wish to physically handle the goods to ensure the correct size and qualities are present. There may also be advertisements or presentations of the goods that the consumer will be exposed to. I do not however, discount that there may also be an aural component to the purchase through word-of-mouth recommendations or orders which may be placed by telephone.

Comparison of marks

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

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

36. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

37. The marks to be compared are as follows:

Contested mark	**Earlier mark**
Barrier Coat	Barrier

38. The earlier mark is a word mark consisting of one word and therefore the overall impression lies in the word itself.

39. The contested mark is also a word mark but made up of two words. In *El Corte Inglés, SA v OHIM,* Cases T-183/02 and T-184/02, the GC noted that the beginnings of marks tend to have more visual and aural impact that the ends. 'Barrier' comes first in the mark and although it might be allusive of the goods applied for (which I will discuss later in my decision) it will have more conceptual content than 'Coat' which is descriptive of some of the goods applied for. I therefore find that 'Barrier' carries more weight in the overall impression.

40. Visually, the earlier mark comprises of one word of seven letters. This word is found identically at the beginning of the contested mark. The contested mark ends in a four letter word which is not replicated in the earlier mark. Therefore, bearing in mind the decision in *El Corte Inglés, SA v OHIM* (as above), I find the marks to be similar to a between a medium and a high degree.

41. Aurally, 'barrier' will be given its ordinary everyday pronunciation for both marks. The word 'Coat' at the end of the contested mark will also be given its ordinary everyday pronunciation and has no replication in the earlier mark. I therefore find the marks to be aurally similar to between a medium and high degree.

42. Conceptually, I believe the earlier mark will be assigned its ordinary everyday meaning of something that is in place to prevent movement or something from happening. For the contested mark, the word 'Barrier' will carry the same conceptual meaning. The additional word, 'Coat' is likely to be viewed as the item of clothing by a significant proportion of consumers. This will mean it is descriptive of some of the goods that the applicant seeks to register. So, when read together the average consumer will likely attribute a meaning of a coat that acts as a barrier. I therefore consider that the marks will be conceptually similar to a medium degree.

Distinctive character of the earlier mark

43. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

44. 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).
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> 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)."

45. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and/or services, ranging up 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 made of it.

46. The earlier mark comprises the word 'Barrier' which, for the goods it is registered for, can be said to be allusive of the qualities of those goods. They are all protective items which could be viewed as providing a barrier between the medical professional or patient and any harmful germs etc. I therefore consider the earlier mark to be inherently distinctive to a low degree.

Likelihood of confusion

47. 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. 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 has retained in his mind.

48. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the overall impression of the earlier mark lies in the word itself and for the contested mark the word 'Barrier' will be slightly more distinctive.
- I have found the marks to be visually and aurally similar to between a medium and a high degree.

- I have found the marks to be conceptually similar to a medium degree.
- I have found the opponent's mark to be inherently distinctive to a low degree.
- I have identified the average consumer for the goods to be a combination of members of the general public as well as medical professionals. The purchasing process is likely to be predominantly visual.
- I have concluded that a higher or a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods to be between similar to a low degree and identical.

49. Taking all of the above factors into account, including that the earlier mark is wholly encompassed within the contested mark and being the first element, I consider that there is a likelihood of direct confusion only for the goods where 'Coat' is descriptive of the goods themselves or for goods which might be used together with a coat. I consider that the word "Coat" will be easily overlooked for these goods due to its descriptive nature. For all other goods, I find that, particularly in light of the higher degree of attention paid to some of the goods in question, and the low distinctiveness of the earlier mark there will be sufficient distance to offset the similarity of the marks and these goods will not be directly confused.

50. I will now turn to look at indirect confusion. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

> "17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> > (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

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

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

51. These examples are not exhaustive but provide helpful focus as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

> “This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.”[1]

52. For the sake of completeness, I will firstly consider indirect confusion for the goods where ‘Coat’ is descriptive of the goods themselves or for goods which might be used together with a coat. In the event the average consumer does notice the differences between the marks, I consider that the addition of a term that is descriptive of those goods will likely be viewed as a brand extension by the average consumer. I therefore consider there to be a likelihood of indirect confusion.

53. For the remaining goods at issue, I consider that the common element between the marks – ‘Barrier’ is not so strikingly distinctive that no other brand could use it. It is an ordinary dictionary word and, as established above, has a low degree of inherent distinctiveness which has not been enhanced. Therefore, the first category is not satisfied.

54. Regarding the second category, the addition of ‘Coat’ is not an addition of a non-distinctive element for the remaining goods as it is not descriptive or allusive to them.

[1] Paragraph 12

It is also not a word that is frequently used to indicate sub-brands such as 'LITE' or 'EXPRESS' as per the examples provided by Mr Purvis. Consequently, the second category cannot be satisfied.

55. Lastly, where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension. I do not consider that the addition of the word coat at the end of the applicant's mark is a logical brand extension of the opponent's mark, or vice versa, when being used on goods which are not coats. I can see no other reason why the average consumer might believe these undertakings are linked, especially in considering the low distinctiveness of the earlier mark and the higher degree of attention paid for the remaining goods at issue. I therefore do not consider that the third category is satisfied.

56. I bear in mind that the examples above set out by Mr Purvis Q.C. are not exhaustive. However, I do not consider that there are any other logical examples of how the applicant's mark could be indirectly confused with the opponent's. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. As highlighted above, the marks are not natural variants or brand extensions of each other. Even if the opponent's mark is brought to mind when viewing the applicant's mark, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. Consequently, I consider there is no likelihood of indirect confusion.

Conclusion

57. The opposition is successful in relation to the following goods:

> Class 25: Jackets [clothing]; Coats (Top-); Dust coats; Top coats; Hoods [clothing]; Hoods.

58. The opposition fails and registration may continue for all class 9 and 10 goods and the following goods from class 25:

Class 25: Head wear; Tops [clothing]; Slipovers [clothing]; Face mask [clothing]; Face masks [fashion wear].

Costs

59. The applicant has been largely successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I award the opponent the sum of **£500**, calculated as follows:

Considering the Notice of opposition and preparing the counterstatement	£200
Preparation of submissions	£300
Total	**£500**

60. I therefore order Molnlycke Health Care AB to pay Shieldsie Ltd the sum of £500. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 31st day of October 2023

L Nicholas
For the Registrar