

O/0073/25

TRADE MARKS ACT 1994

INTERNATIONAL TRADE MARK 1707281

**IN THE NAME OF SHEDRAIN CORPORATION AND ROSE & WILLIAM
CONSULTING, LLC**

AND

DESIGNATION OF THE UK FOR PROTECTION OF THE TRADE MARK

AND

OPPOSITION No.440667

BY DOUGLAS & GRAHAME LIMITED

BACKGROUND AND PLEADINGS

1. This is an opposition by Douglas & Grahame Limited (“the opponent”) to the designation of the UK on 15th December 2022 by the holders of International Trade Mark 1707281 (“the IR”) for protection of the IR in the UK under the terms of the International Agreement known as the Madrid Protocol.

2. The IR consists of the words DOUGLAS & FIR. Protection of the mark is sought in relation to:

Class 25: Coats; footwear; gloves; headwear; neckwear; rainwear; socks; bottoms as clothing; tops as clothing; clothing jackets; outer jackets.

3. The IR claims priority from an earlier filing of the same mark for the same goods in the USA on 12th December 2022 (“the relevant date”)

4. The IR holders are two US corporations incorporated in the State of Oregon: Shedrain Corporation and Rose & William Consulting, LLC.

5. The opponent bases its opposition on two earlier UK trade marks. The first is the word mark DOUGLAS & GRAHAME, which was registered under 3293902 on 1st June 2018 with effect from the filing date of the application on 2nd March 2018. This mark is registered in relation to a range of services in classes 35, 40 and 42. These include retail services for male clothing, footwear, and headgear in class 35, tailoring services in class 40, and design of clothing, headgear, and footwear in class 42.

6. The second earlier mark is the word mark DOUGLAS, which was registered under 2020233 on 23rd August 1996 in relation to “*Articles of outerclothing, none being footwear, for men, youths and boys.*”

7. The opponent claims the IR is similar to the earlier trade marks, that the respective goods/services are identical or similar, and there is a likelihood of confusion on the part of the public, including the likelihood of association. Consequently, the opponent says that protection of the IR would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) which is as follows:

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

(a) -

(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”.

8. The opponent further claims to have acquired goodwill under DOUGLAS from using that mark since 1996 in relation to “*coats, suits, jackets, waistcoats, trousers, jeans, shirts, polo shirts.*” The opponent says that use of the IR would constitute a misrepresentation that the holders are connected with the opponent, which would damage the opponent’s goodwill. Consequently, the opponent says that protection of the IR would be contrary to section 5(4)(a) of the Act, which is as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) -

(b) -

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

9. The IR holders filed a counterstatement denying the grounds of opposition. I note the holders:

(1) Put the opponent to proof of use of trade mark 2020233 during the five-year period ending on the relevant date.

(2) Put the opponent to proof of the goodwill claimed to have been generated by its use of DOUGLAS since 1996.

(3) Denied that the respective marks are similar enough to cause confusion, claiming that the IR holder's mark "*invokes the meaning of trees and horticulture as "Douglas Fir" is the name of a species of tree*", whereas DOUGLAS and DOUGLAS & GRAHAME are male forenames

(4) Denied that *footwear, headwear, neckwear, socks, bottoms, and tops*, for which the IR is registered, are covered by *outerclothing* for which earlier trade mark 2020233 is registered.

(5) Denied that the services in classes 40 and 42 for which earlier trade mark 3293902 is registered, are similar to the goods in class 25 for which protection of the IR is sought.

(6) Denied that the services in classes 35 for which earlier trade mark 3293902 is registered are similar to the goods in class 25 for which protection of the IR is sought, except for retail services relating directly to those class 25 goods.

REPRESENTATION

10. The IR holders are represented by HGF Ltd. The opponent is represented by Ansons. Neither side asked for a hearing. Therefore, this decision is based on the papers before me.

EVIDENCE

11. The IR holders' evidence consists of a witness statement (with 9 exhibits) by Lauren Somers. Ms Somers is a trade mark attorney with HGF Ltd. The purpose of her evidence is to show the co-existence of fashion brands with a common element, e.g., Christian Dior/Christian Louboutin and Giorgio/Giorgio Armani, and that the

opponent is not the only user of brands including the word DOUGLAS in the clothing sector.

12. The opponent's evidence consists of a witness statement (with 3 exhibits) by Michael Finlay, who is a director of the company. The purpose of Mr Finlay's evidence appears to be to show that the opponent used DOUGLAS as a trade mark for men's clothing, particularly between 2018 and 2022.

STATUS OF EU CASE LAW

13. 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.

THE SECTION 5(2)(b) GROUND OF OPPOSITION

Proof of use of earlier trade mark 2020233

14. The opponent's reliance on earlier trade mark 2020233 is subject to it satisfying section 6A of the Act, which is as follows:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

15. This means that the opponent must show genuine use of DOUGLAS in relation to *articles of outerclothing, none being footwear, for men, youths, and boys* in the period 13th December 2017 to 12th December 2022.

16. Mr Finlay gives evidence that:

“The trade mark DOUGLAS has been used by Douglas & Grahame Limited continuously since the early 1990s.

The trade mark DOUGLAS is used on a range of premium contemporary menswear, which includes classic formalwear ideal for the boardroom or special occasions including suiting and blazers, complimented by formal shirts and accessories, and on a range of casualwear, which includes shirts, knitwear, chinos, denims, and casual outerwear.”

17. Exhibited to Mr Finlay’s statement¹ are copies of webpages from the website douglasmenswear.com. These appear to have obtained from the internet archive site called The WayBack Machine. They show men’s clothing collections from 2018, 2019, 2020 and 2021 consisting of jackets, trousers, coats, chinos, shirts, tops, ties, and jumpers. I cannot see the DOUGLAS trade mark on any of the clothes themselves, but the mark does appear on some of the webpages.

18. Also exhibited to Mr Finlay’s statement² are eight pictures showing formal jackets with tags attached bearing the mark DOUGLAS. Mr Finlay does not explain where or when these pictures were taken.

19. Mr Finlay provides a list of UK stockists of DOUGLAS clothing. These include 25 addresses in Northern Ireland, about 50 in England/Wales, and 9 in Scotland. This appears to represent the position at the date of Mr Finlay’s statement in January 2024.

20. According to Mr Finlay, UK sales of DOUGLAS branded clothing exceeded £1.5m in each of the years 2018 to 2022.

¹ As exhibit MF1

² As exhibit MF2

21. In *easyGroup Ltd v Nuclei Ltd & Ors*,³ Arnold LJ summarised the law relating to genuine use as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark.

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark.

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality.

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns. Internal use by the proprietor does not suffice. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter.

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark.

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and

³ [2023] EWCA Civ 1247

services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use.

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus, there is no de minimis rule.

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use.

22. The IR holders have not contested Mr Finlay's evidence of use of DOUGLAS, either by filing evidence to refute his claims, or by challenging his evidence in submissions. I take this into account in accepting Mr Finlay's evidence of use of DOUGLAS as sufficient to show genuine use of the mark during the relevant period in relation to the clothing listed in paragraph 17 above.

23. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*⁴ the Court of Appeal set out the proper approach to framing a fair specification, as follows:

"245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in

⁴ [2017] EWCA Civ 1834

relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.”

24. Having regard to this guidance, I am satisfied that the registered specification, i.e., *articles of outerclothing, none being footwear, for men, youths and boys* is a fair description of the use shown, and one that would accord with the perception of the relevant average consumer.

25. Trade mark 3293902 was registered less than 5 years prior to the relevant date. Consequently, it is not subject to proof of use. This means the opponent can rely on that mark in relation to all the services for which it is registered.

Global assessment of the likelihood of confusion

26. 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 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.

The principles

(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/services

27. The respective goods/services are set out below:

The IR	The earlier trade marks
Class 25: Coats; footwear; gloves; headwear; neckwear; rainwear; socks; bottoms as clothing; tops as clothing; clothing jackets; outer jackets.	Trade mark 2020233 Class 25: Articles of outerclothing, none being footwear, for men, youths, and boys. Trade mark 3293902 Class 35: The bringing together for the benefit of others of a selection of men's, male youths' and boys clothing, headgear, footwear, bags, clothing accessories and fashion accessories enabling customers to conveniently view and purchase those goods in retail outlets, by means of a catalogue or through a retail website; wholesale

	<p>services in relation to men's, male youths' and boys' clothing, headgear, footwear, bags, clothing accessories and fashion accessories; fashion show exhibitions for commercial purposes; organisation of fashion shows for commercial purposes; organisation of fashion shows for promotional purposes; all the aforesaid services solely relating to goods for men, male youths and boys.</p> <p>Class 40 Tailoring; cobbler services; millinery services; manufacture of clothing, footwear, headgear, bags, clothing accessories and fashion accessories.</p> <p>Class 42 Design of clothing, headgear, footwear, clothing accessories, fashion accessories and bags.</p>
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28. I start by comparing the goods of the IR with those of trade mark 2020233. It is well established that goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.⁵

29. The IR holders deny that *footwear, headwear, neckwear, socks, bottoms, and tops*, for which the IR is registered, are covered by *outerclothing*. The earlier mark plainly does not cover *footwear* because such goods are expressly excluded. I accept that it does not cover *socks* either. This is because these goods are normally worn under

⁵ See, for example, *Gérard Meric v OHIM*, Case T- 133/05, the General Court

footwear rather than as outerclothing. I find that *headwear, neckwear, bottoms and tops* are examples of outerclothing. These descriptions cover hats, scarves, trousers, and polo shirts, all of which may be worn as outerclothing. Therefore, I find these goods are identical to the goods covered by trade mark 2020233.

30. The IR holders do not appear to dispute that *coats, rainwear, clothing jackets, and outer jackets* are covered by *articles of outerclothing.... for men* etc. In any event, I find these descriptions also cover identical goods in class 25.

31. In *Canon*,⁶, the CJEU held 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.”

32. Whilst *footwear* and *socks* are not covered by the specification of trade mark 2020233, they are clearly similar goods to *articles of outerclothing*. This is because they are similar in nature, share some of the same purposes (i.e. to attractively dress the wearer and protect the body) and may be complementary (i.e. matching) products commonly sold by the same undertakings.

33. The IR holders appear to accept that some of the services in class 35 for which trade mark 3293902 is registered, i.e., *The bringing together for the benefit of others of a selection of men’s, male youths’ and boys clothing, headgear, enabling customers to conveniently view and purchase those goods in retail outlets, by means of a catalogue or through a retail website*, are similar to the goods in class 25 for which protection for the IR is sought. I agree they are similar, complementary, goods/services.

⁶ Case C-39/97

34. For reasons that will become clear it is not necessary to consider whether the other services covered by trade mark 3293902 are similar.

The average consumer and the selection process

35. The relevant average consumer is a member of the public in the market for outerclothing for males. Such a consumer is likely to pay at least a 'normal' or average degree of attention when selecting the goods.

36. The goods are likely to be selected from websites, shop displays or printed advertisements. Therefore, the way the marks look is most important. However, word-of-mouth recommendations may also come into the process, so the way the marks sound must also be considered.

Distinctive character of the earlier trade marks

37. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,⁷ 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

⁷ Case C-342/97

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)."

38. The words DOUGLAS & GRAHAME and DOUGLAS are not descriptive of the goods/services for which the earlier marks are registered. However, descriptiveness is not the only factor which may affect the distinctive character of a word mark. In *Harman International Industries, Inc v OHIM*,⁸ the CJEU found that:

"Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname 'Becker' which the Board of Appeal noted is common."

39. Although there is no evidence on this matter, my own experience tells me that DOUGLAS is a common surname. Surnames are frequently used as trade names, usually based on the name of the founder(s) of the business. This common perception will reduce the degree to which average consumers will expect all trade marks including the surname DOUGLAS to signify the goods/services of a particular undertaking. Therefore, viewed as a surname, I find that DOUGLAS has a below average degree of inherent distinctive character.

40. If, whether alone or in combination with GRAHAME, DOUGLAS is perceived as a male forename, as the IR holders contend, then its inherent distinctive character is no higher. This is because, as the CJEU has observed, common forenames (like Douglas) are, if anything, less distinctive than surnames in many parts of the EU, and the same is true in the UK. This is particularly true in relation to clothing where the use of forenames as trade marks is common.

⁸ Case C-51/09P

41. The opponent submits that DOUGLAS has acquired a high degree of distinctive character through use. However, it has not pleaded a case of enhanced distinctiveness. Nor is there any pleading that DOUGLAS has acquired a reputation on a scale sufficient to bring an opposition under section 5(3). In these circumstances, I do not consider the opponent can reasonably have expected the IR holders to have understood that part of its case was based on the distinctive character of DOUGLAS having been materially enhanced through use. Strictly speaking, this means there is no need to consider the matter further. However, for the sake of completeness, I record here that I would have rejected such a claim. Whilst it seems the opponent has been trading under DOUGLAS in relation to male clothing for many years the extent of the sales claimed (£1.5m per annum) is relatively modest compared to the huge size of the UK market for male clothing. Further, other than showing that it has a website on which such goods can be viewed (but not bought) the opponent has not provided any information showing how, or to what extent, the DOUGLAS trade mark has been promoted to the public. The remainder of the evidence of use provided is also rather skeletal, e.g., there is not a single sales invoice.

Comparison of marks

42. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
<p style="text-align: center;">DOUGLAS & GRAHAME</p> <p style="text-align: center;">DOUGLAS</p>	<p style="text-align: center;">DOUGLAS & FIR</p>

43. I first compare the IR to DOUGLAS & GRAHAME. From a visual perspective, the first word in the marks – DOUGLAS - is the same, but the second word – GRAHAME v FIR is obviously different. The difference affects the overall length of the marks, the earlier mark being noticeably longer. The aural comparison is similar: the earlier mark has five syllables, the first three of which are the same – DOUG-LAS-AND. The

endings are different GRAY-HAM v FUR, which means the earlier mark has five syllables in total compared to the IR's four.

44. As already noted, the IR holders submit that DOUGLAS & GRAHAME will be perceived, conceptually, as two male forenames whereas DOUGLAS & FIR will call to mind the name of conifer tree called the Douglas Fir. The tree is native to North West America, but timber from the trees appears to be sold in the UK.⁹

45. The opponent contends that DOUGLAS & GRAHAME will be perceived as two surnames, as will DOUGLAS & FIR.

46. I find that DOUGLAS & GRAHAME will be perceived by average consumers either as two surnames, or as two male forenames.

47. The evidence does not establish that the Douglas Fir is sufficiently well-known in the UK for average consumers of clothing to perceive DOUGLAS & FIR as the name of a particular species of conifer, although some consumers with an unusually high level of knowledge about conifers or timber may see it this way. The ampersand also lessens the chances of the mark being perceived like this.

48. I do not accept the opponent's submission that DOUGLAS & FIR will be perceived as two surnames. Admittedly, the construction of the mark (i.e., a well-known name followed by an ampersand) could lead a few consumers to wonder if FIR is also a (possibly rare) name. However, there is no evidence that FIR is in fact a name of any sort. Consequently, I do not accept that the construction of the mark is enough to lead average consumers to perceive the mark as two surnames.

49. In my view, DOUGLAS & FIR is likely to be perceived as a quirky combination of the name Douglas (either as a male forename or surname) and the name of a well-known species of conifer, i.e., the fir tree.

50. On this view of the matter, I find the marks as wholes are conceptually dissimilar, although the name concept in the common element DOUGLAS means there is some conceptual overlap between the marks.

⁹ See exhibit LS9

51. Turning to the comparison with DOUGLAS solus, I note the earlier mark is contained within the IR, and as the first element to those reading from left to right. On the other hand, it is difficult to miss the fact that the IR has a second element (& FIR) making it noticeably longer than the earlier mark from a visual perspective.

52. From an aural perspective, the earlier mark has two syllables whereas the IR has four – DOUG-LAS-AND-FUR.

53. Comparing the marks conceptually leads me to a similar conclusion to the one set out in paragraphs 49/50 above.

Likelihood of confusion

54. The IR holders' evidence seeks to show that the opponent is not the only user of DOUGLAS in trade marks used in the clothing sector in the UK. Exhibit LS1 to Lauren Somers statement consists of webpages from the websites douglashayward.com, douglasattire.com, and douglasmenswear.com. These were downloaded in March 2024. They appear to show use of DOUGLAS and DOUGLAS HAYWARD in relation to clothing. I note that one of these users of DOUGLAS claims to have been established in 1964. The opponent claims to have co-existence agreements in place with some of these entities, but does not wish to identify the entities concerned or provide details.

55. Apart from confirming my own impression that personal names are commonly used as brands, or parts of brands, in the clothing sector, I do not find this evidence of much assistance. This is because there is no information as to the length of time, or the scale, of these parties use of DOUGLAS. This makes it hard to draw the inference that the public are already accustomed to distinguishing between different users of DOUGLAS or DOUGLAS-derivative marks. There is, therefore, no need to consider the opponent's point about co-existence agreements. In any event, it is hard to see why this would make any difference to the public's perception of whether DOUGLAS is uniquely associated with the opponent.

56. I find there is no likelihood of direct confusion between the IR and DOUGLAS & GRAHAME. Even after making appropriate allowance for consumers' imperfect

recollection of the marks, the differences between them (outlined above), combined with the differences between the goods and services (even where similar as per paragraph 33 above), are sufficient to rule out the likelihood of average consumers mistaking the IR for the earlier mark.

57. The opponent submits that the degree of similarity between DOUGLAS & FIR and DOUGLAS, the identity of some of the goods in class 25, and the interdependency principle described in paragraph 26(g) above, compel me to find there is a likelihood of confusion these marks. I reject this submission. The likelihood of confusion depends on the specific facts of the case. The mechanical application of general guidance is not appropriate. Even after making an appropriate allowance for imperfect recollection, I find the differences between the marks (outlined above) are, in my view, sufficient to avoid the likelihood of average consumers mistaking the IR for the earlier mark, even where the goods are identical.

58. Turning to the likelihood of indirect confusion, the opponent submits that DOUGLAS has an independent distinctive role in DOUGLAS & FIR. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*,¹⁰ Arnold J (as he then was) considered the impact of the CJEU's judgment in *Bimbo* on the court's earlier judgment in *Medion v Thomson*. The judge said:

"18 The judgment in Bimbo confirms that the principle established in Medion v Thomson is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In Medion v Thomson and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also

¹⁰ [2015] EWHC 1271 (Ch)

perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

59. It is difficult to say that DOUGLAS & FIR has a clear meaning that is different to the meanings of DOUGLAS and FIR separately. However, I do not accept it automatically follows that DOUGLAS must have distinctive significance independently of the whole of the contested mark. DOUGLAS & FIR is an unusual combination of words with a quirky, composite, character. Standing back and looking at the mark like this, as an average consumer would, I find that DOUGLAS & FIR would be seen as one, not two signs. Consequently, I do not think that this is a case to which the *Medion* principle applies. Further, even if I am wrong about that it does not automatically follow that there is a likelihood of indirect confusion.

60. In *L.A. Sugar Limited v By Back Beat Inc*,¹¹ Mr Iain Purvis Q.C., as the Appointed Person, explained that:

¹¹ BL O/375/10

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).*
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).*
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example).”*

61. The types of cases set out in paragraph 17 of Mr Purvis’s decision are not exhaustive. However, they are the most usual circumstances where indirect confusion may arise. In my judgment, none of them apply here. The word DOUGLAS is not so distinctive that consumers would assume that no one but the opponent would be using it in any other trade mark. The second word, FIR, is just as distinctive as DOUGLAS

for clothing etc., arguably more so. Although the opponent has not clearly articulated such an argument, the high point of the opponent's case could have been that consumers will assume that DOUGLAS & FIR is a collaboration between the opponent and another entity called FIR. However, this seems unlikely if (as I have found it will be) DOUGLAS & FIR is perceived as a quirky combination of the name of a person with that of a well-known species of conifer. Therefore, I see no proper basis on which to find that DOUGLAS & FIR is liable to be seen as a brand extension of DOUGLAS, or a collaboration between two businesses called DOUGLAS and FIR.

62. There is even less likelihood of indirect confusion between DOUGLAS & FIR and DOUGLAS & GRAHAME. This is because, in this case, the IR does not include the second element of the earlier mark. Therefore, there is no logical basis for assuming DOUGLAS & FIR is a collaboration with, or otherwise connected to, DOUGLAS & GRAHAME.

63. I conclude that the opposition based on section 5(2)(b) of the Act, fails.

THE SECTION 5(4)(a) GROUND OF OPPOSITION

64. In *Discount Outlet v Feel Good UK*,¹² Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per

¹² [2017] EWHC 1400 IPEC

Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21).”

Goodwill

65. I accept the opponent had established sufficient goodwill by the relevant date under DOUGLAS in relation to the goods specified in paragraph 17 above to bring a passing off action.

Misrepresentation

66. The opponent’s passing off case fails because use of DOUGLAS & FIR in relation to the goods covered by the application would not constitute a misrepresentation to the public that those goods are connected with the opponent. I recognise that it is not necessary for all, or even a majority, of the public to be deceived; a substantial number will do. However, for the reasons I have given for rejecting the opponent’s case that there is a likelihood of confusion, I find that no substantial number of persons will be deceived by the IR holders use of the contested mark.

67. The section 5(4)(a) ground fails accordingly.

COSTS

68. The IR holders have been successful and are entitled to a contribution towards their costs. I assess this as follows:

£400 for considering the notice of opposition and filing a counterstatement;

£1000 for considering the opponent's evidence and filing evidence in response.

69. I therefore order Douglas & Grahame Limited to pay Shedrain Corporation and Rose & William Consulting, LLC the sum of £1400. This 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 27th day of January 2025

Allan James
For the Registrar