O/0248/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001707281 IN THE NAME OF SHEDRAIN CORPORATION AND ROSE & WILLIAM CONSULTING LLC FOR THE FOLLOWING MARK:

DOUGLAS & FIR

IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. OP000440630 BY DOUGLAS MARKEN– UND LIZENZEN GMBH & CO. KG

BACKGROUND AND PLEADINGS

1. Shedrain Corporation and Rose & William Consulting LLC ("the holders") are the holders of the International Registration shown on the cover page of this decision ("the IR"). The IR was registered on 15 December 2022 and, with effect from the same date, the holders designated the UK as a territory in which they seek to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 3 February 2023. The holders seek protection in the UK for the following goods:

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

2. The IR is derived from an earlier trade mark registered by the holders in the United States of America. As such, the IR benefits from an earlier priority date of 12 December 2022, being the filing date of the holders' US mark.

3. On 3 May 2023, Douglas Marken- und Lizenzen GmbH & Co. KG ("the opponent") filed an opposition against the application under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies on the following trade mark:

   DOUGLAS

   UK trade mark number UK00003375695
   Filing date 15 February 2019; registration date 28 June 2019
   Relying on some goods only, being:

   Class 25: Clothing, in particular scarves, bath robes, ladies' underwear; shoes and slippers; waist belts.

4. The opponent argues that the marks at issue are highly similar and that the goods of the parties are either identical or highly similar. As such, the opponent claims that there exists a likelihood of confusion between the marks.

5. The holders filed a counterstatement denying the claims made against them.

6. The opponent is represented by Potter Clarkson LLP. The holders are represented by HGF Limited. Both sides filed evidence in these proceedings. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken following a careful perusal of the papers.

7. 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.

EVIDENCE

8. The opponent's evidence came in the form of the witness statement of Sarah Talland dated 15 November 2023. Sarah Talland is a Chartered Trade Mark Attorney and Partner at the opponent's representative. Their statement is accompanied by three exhibits, being ST1 to ST3. While the purpose of the evidence is not expressly set out, it consists of a range of evidence that purports to show the opponent's mark on internet search results as well as its own website and to support the opponent's claims of the similarity between the opponent's goods in class 25 and the holders' goods in class 25.

9. The holders' evidence came in the form of the witness statement of Lauren Somers dated 14 March 2024. Lauren Somers is a Director and Chartered Trade Mark Attorney at the holders' representative. Their statement is accompanied by nine exhibits, being LS1 – LS9. The evidence was adduced to support the claims made in the holders' TM8 and counterstatement and in response to the opponent's claims made in its TM7.

10. I do not intend to summarise the evidence filed by the parties (or the opponent's submissions in lieu) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent deemed necessary below.

PRELIMINARY ISSUES

Holders' evidence

11. As set out above, the holders have filed evidence to support the claims made in its counterstatement and in response to the opponent's claims made in its notice of opposition. The holders have provided evidence in the form of exhibits LS1 and LS2 showing other businesses and trade marks using the word 'DOUGLAS'. On this point, I appreciate that evidence showing common use in the marketplace of a word used in trade marks may be capable of pointing to a weakening of the distinctive character of said word. However, in the present case, there is no actual evidence of use provided by the holders in order to show the level of exposure these other marks or businesses have achieved in the UK marketplace.[1] As such, I do not consider that this evidence points to use on the market place that can be said to weaken the distinctive character of the word 'DOUGLAS'.

12. In addition to the above, the holders have filed evidence that relates to comparisons of other marks, all of which involve comparisons between trade marks that consist of names (see LS3 to LS8). I note that these include comparisons between marks made up of forenames against those made up of full names, such as 'JOSEPH' against 'JOSEPH RIBIKOFF' and 'GIORGIO' against 'GIORGIO ARMANI'. Additionally, there are comparisons provided relating to other marks including names, such as 'PAUL AND SHARK' against 'PAUL SMITH' and 'VICTOR' against 'VIKTOR & ROLF'. While noted, I do not consider this evidence is of any assistance to the holders. In short, the present case is to be determined after consideration of a series of assessments that are based on the marks as they appear before me. Any reference to other trade mark comparisons is, therefore, of

[1] For guidance in respect of this point, see the case of *Zero Industry Srl v OHIM*, Case T-400/06

no impact to the assessments I must make. As a result, I will say no more about this evidence.

DECISION

Section 5(2)(b): legislation and case law

13. Section 5(2)(b) of the Act reads 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".

14. Section 5A of the Act states as follows:

> "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."

15. 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 or international trade mark (UK) 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.

16. The opponent's mark qualifies as an earlier trade mark under the above provisions. As the opponent's mark had not completed its registration process more than five years before the filing date of the IR, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent may rely on the goods highlighted in its notice of opposition.

17. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("CJEU") 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 Harmonization 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 the goods

18. The parties goods are as follows:

The opponent's goods	The holders' goods
Class 25 Clothing, in particular scarves, bath robes, ladies underwear; shoes and slippers; waist belts.	Class 25 Coats; footwear; gloves; headwear; neckwear; rainwear; socks, bottoms as clothing; tops as clothing; clothing jackets; outer jackets.

19. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account, as per *Canon*, where the CJEU stated at paragraph 23 of its judgement:

> "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."

20. 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.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court ("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 fur 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."

22. In their counterstatement, the holders argue that since the opponent's term "clothing" is followed by "in particular", the term "clothing" is limited to the items that follow, being scarves, bath robes, ladies underwear, shoes and slippers, waist belts. While noted, I do not agree. In short, the Cambridge dictionary defines 'in particular' as meaning 'especially' so while it may indicate a focus on certain goods over others, it does not limit the term to only those goods listed in the same way 'namely' does, for example. A GC case, being *Häfele GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-336/09, stated that 'in particular' should be treated as 'for example'. Paragraph 33 of this case states:

"…according to the case-law, the words 'in particular' used in a description of goods are merely indicative of an example (Case T-224/*01 Durferrit v OHIM – Kolene (NU-TRIDE)* [2003] ECR II-1589, paragraph 41, and judgment of 12

November 2008 in Case T-87/07 *Scil proteins v OHIM – Indena(affilene*), not published in the ECR, paragraph 38). Used in a list of goods, those words serve to distinguish goods that are of particular interest to the holder of a mark, without however excluding any other goods from the list (affilene, paragraph 39)."

23. Given this, I find that the opponent's term is not limited to 'scarves, bath robes, ladies underwear, shoes and slippers, waist belts'.

24. I have comments from both parties as to the claimed identity/similarity of the goods. I can confirm that I have taken these into account in making the following comparison, however, I do not intend to discuss them in full here.

Footwear

25. The term 'footwear' in the holders' specification is a broad term that includes the opponent's term of 'shoes and slippers'. As a result, I find these goods to be identical in accordance with the principle in *Meric*.

Neckwear

26. The term 'neckwear' in the holders' specification is a broad term that includes the opponent's term 'scarves'. As I result, I find these goods to be identical in accordance with the principle in *Meric*.

Coats; rainwear; socks; tops as clothing; bottoms as clothing; clothing jackets; outer jackets

27. These are all items of clothing. Given what I have said above about the opponent's term of "clothing, in particular scarves, bath robes, ladies underwear" (in that it is not limited to the goods following 'in particular'), I find that it can cover any type of clothing goods. As such, I find that these goods are identical under the principle outlined in *Meric*.

Gloves; headwear

28. These goods are clothing accessories so while they are not identical to the opponent's terms of "clothing, in particular scarves, bath robes, ladies underwear" (nor the term of "waistbelts", for that matter), I do consider that there is a degree of similarity. While the goods have different construction and are made of different materials (leading to a difference in natures), I find that because they are used in the same way (in that they are items to be worn on the body) they will have a similar method of use. Additionally, the purpose of both parties' goods will overlap to some degree as they may all be worn for style/aesthetic purposes or to complement the user's outfit. In respect of trade channels, these goods are likely to be produced and sold by the same undertakings and will likely be found in close proximity to one another in stores. Further, the goods will be sold to the same users. Taking all of this into account, I find that these goods are similar to a medium degree.

The average consumer and the nature of the purchasing act

29. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

30. The goods at issue are ordinary consumer goods that will be selected by the general public at large. They will likely be available from a retail outlet and their

online or catalogue equivalents (where available). In physical stores, the goods will be displayed on shelves or racks where they will be self-selected by the consumer. When the selection takes place online or via a catalogue, the goods will be selected after viewing an image of the goods on a webpage or catalogue page. Clearly, the visual component will dominate the selection process, though I do not discount the aural component entirely as suggestions may come from word-of-mouth recommendations or advice from sales assistants. In respect of the level of attention paid, I am of the view that when selecting the goods, the consumer is likely to consider factors such as the suitability of the goods, materials used, cut, quality, aesthetic appearance and durability. The cost of purchase is likely to vary and the goods will be purchased on a reasonably frequent basis as the need for them arises. Generally speaking, the average consumer will pay a medium degree of attention when selecting the goods.

Comparison of marks

31. 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.

32. 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 relative 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."

33. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the 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.

34. The respective trade marks are shown below:

The opponent's mark	The IR
	DOUGLAS & FIR

35. In their counterstatement, the holders deny that the marks are similar. The holders state that the opponent's mark would be perceived as the common male name "DOUGLAS" in a particular stylisation which includes an overlapping letter D and O at the start of the mark. The holders further state that visually and aurally the IR is perceptibly different to the opponent's mark for a single stylised word as the IR is made up of three parts. Conceptually, the holders argue that the IR conveys a very different overall impression on the consumer.

36. I have submissions from the opponent as to the similarity of the marks at issue. While I do not intend to reproduce those submissions here, I confirm that I have taken them into account in making the following comparison.

Overall impression

37. The IR is a word only mark consisting of 'DOUGLAS & FIR' in a black uppercase font. There are no other elements that contribute to the overall impression of the mark which lies equally across the mark.

38. As for the opponent's mark, this is a figurative mark which consists of the word 'DOUGLAS' in upper case in a black standard font. The D and O are interlinked. On this point, I consider it necessary to point out that even though the D and O are interlinked, consumers will still read this word as 'DOUGLAS'. The word 'DOUGLAS' clearly dominates the overall impression of the mark, however, I am of the view that the stylisation element of the interlinking letters will play a role, albeit a lesser one.

Visual comparison

39. At the outset of the comparison, I consider it necessary to set out that the IR, being 'DOUGLAS & FIR' is a word only mark. As such, it is capable of being presented in the exact same typeface as that used in the opponent's mark (though I appreciate that this does not cover the interlinking of the letters) on the basis that, as above, the opponent's typeface is a fairly standard one. Whilst it is not legitimate to perform a comparison between a word mark and the figurative presentation of a word by considering specific ways in which the word might be presented, the point I make here is that the word mark is not limited to any particular typeface and therefore the typeface in which the opponent's figurative mark is presented does not provide a point of distinction in itself.[2] As a result, the points of visual difference are the interlinking of the 'D' and 'O' at the beginning of the opponent's mark, the ampersand and the word 'FIR' that follow the word 'DOUGLAS' in the IR. All of these points of difference will have an impact on the visual comparison of the marks.[3] Overall, I am of the view that when compared as wholes, the shared use of the word 'DOUGLAS' at the start of both marks is sufficient to result in a finding that the marks are similar to a medium degree.

Aural comparison

40. The opponent's mark will be pronounced 'DUG-LUSS'. As for the IR, this will be pronounced 'DUG-LUSS AND FUR'. The IR has two additional syllables. As

[2] See *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22, paragraphs 23 and 34.
[3] On this point, I remind myself that (1) these points in the IR play an equal role with the word 'DOUGLAS' and (2) the interlinking 'D' and 'O' plays a lesser role in the opponent's mark.

consumers tend to pay more attention to the beginning of words in marks[4] which, in the present case, is where the marks are identical, I find that the marks are aurally similar to a medium degree.

Conceptual comparison

41. Conceptually, the holders submit that the IR conveys a very different overall impression on the consumer when compared to the opponent's mark. They state that alongside the term 'FIR', the 'DOUGLAS' component of the mark invokes the meaning of trees and horticulture as "Douglas Fir" is the name of a species of tree. Therefore, rather than seeing the mark as an individual's forename, as the opponent's mark would be read, the IR would evoke the meaning of trees or types of trees.

42. The opponent disagrees with the holders' assessment of the mark which suggests that the term DOUGLAS FIR invokes the meaning of trees and horticulture. The opponent argues that although the average consumer may be familiar with the term FIR referring to a tree, it is uncommon for the relevant UK consumer for the goods at issue to be familiar with the term DOUGLAS to refer to a species of a FIR tree, which is not native to the United Kingdom. The opponent further argues that the inclusion of the '&' removes the invocation of a Douglas Fir, and more plausibly denotes the individual meaning of the words. The opponent states the marks are conceptually similar to a high degree due to the shared element 'DOUGLAS' which will be understood as referring to the name DOUGLAS or a location, being the capital of Isle of Man. The opponent states that the addition element of "& FIR" does not give the overall mark a new meaning.

43. The opponent's mark consists solely of the word 'DOUGLAS'. I consider it likely that the majority of consumers will afford the word 'DOUGLAS' (in both marks) the meaning of a given name. Although, I do not discount that some average consumers may recognise DOUGLAS as a location name, I do not believe that this will consist of a significant proportion of consumers.

[4] See *El Corte Inglés, SA v OHIM, Cases T-183/02 and T-184/02*

44. As I have stated in paragraph 31 above, average consumers do not artificially dissect the mark, given this I am not going to discuss the possibility of the consumer shortening the mark to exclude '& FIR'.

45. While 'DOUGLAS & FIR' may be understood as a reference to the Douglas Fir tree by some consumers, I do not consider that this makes up a significant proportion of consumers so is of no assistance here. On this point, I am of the view that consumers would notice the ampersand between DOUGLAS and FIR and, as such, would not make the relevant connection to the species of tree called Douglas Fir. Instead, I will proceed on the basis that 'DOUGLAS' will be understood as a forename and 'FIR' will be seen as a reference to a tree. While DOUGLAS is considered as a forename, I consider it very unlikely that the consumer will associate FIR as also being a name. The IR does not have any meaning as a whole outside of its reference to two ordinary words, 'DOUGLAS' and 'FIR'. That being said, I will say that, when viewing the IR as a whole, the combining of a forename with the name of a tree will be seen as somewhat unusual and I consider that this gives the IR a degree of whimsical character, which is absent from the word DOUGLAS alone.

46. In comparing the marks, I find that the shared connection to the word 'DOUGLAS', which conveys the same meaning in both marks, is a point of conceptual similarity between the marks. That being said, it is offset to some degree by the addition of '& FIR' in the IR. Overall, I consider that there is a medium degree of conceptual similarity between the marks.

Distinctive character of the opponent's mark

47. 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)."

48. 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. However, the opponent has not pleaded that its mark has obtained an enhanced level of distinctiveness and, no evidence has been filed to that effect. Therefore, I only have the inherent position to consider.

49. As previously outlined in my comparison of the marks, the majority of consumers will perceive the opponent's mark as the word 'DOUGLAS' despite the interlinking D and O. While it will not be overlooked, the interlinking of the letters 'D' and 'O' does not contribute to any material degree to the mark beyond the distinctiveness that is created by the word 'DOUGLAS'. As such, I find that the distinctiveness of the mark lies in the word 'DOUGLAS', which is a relatively common forename in the UK. I appreciate that this neither describes nor alludes to the goods upon which the opponent relies. However, average consumers in the UK will not consider the use of a popular forename to be particularly remarkable from a trade mark

perspective. Overall, I find that the opponent's mark has only a moderate degree of inherent distinctive character.[5]

Likelihood of confusion

50. 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 and services 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's 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 they have retained in their mind.

51. Whilst conducting a global assessment of the likelihood of confusion I must be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods at issue are marketed, and in which type of store/platform they are made available.

52. Throughout the course of this decision, I have found that the respective goods range from being identical to similar to a medium degree. The average consumers are members of the general public at large who will select the goods via primarily visual means (though I do not discount an aural component) after having paid a medium level of attention during the purchasing process. I have found the marks

[5] See, by analogy, the judgment of the CJEU in *Harman International Industries, Inc v OHIM, Case C-51/09P*, where the court said it was necessary to consider the commonness, or otherwise, of names in assessing their distinctive character as trade marks.

to be similar to a medium degree from a visual, aural and conceptual perspective. I have found the opponent's mark to possess a moderate degree of inherent distinctive character.

53. In considering the issue of confusion, I am of the view that it is necessary to first consider the *Medion* principle, the correct approach to which was set out by Arnold J (as he then was) in the case of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch). In that case, 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 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.
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> 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."

54. I have accepted that 'DOUGLAS & FIR' does not have a clear meaning. Therefore, it is difficult to say it has a clear meaning that is different to the meanings of 'DOUGLAS' and 'FIR', separately. I do not believe that 'DOUGLAS' has distinctive significance independent of the whole of the contested mark. 'DOUGLAS & FIR' is an unusual combination of words with a whimsical character (like 'James and Oak'). Standing back and looking at the mark like this, as most average consumers 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.

55. Even though I have discounted the relevance of the *Medion* principle, this does not mean that there cannot be confusion and I will, therefore, proceed to consider the issue in the ordinary way.

56. The opponent has pleaded that the element 'DOUGLAS' in the IR has a higher degree of distinctive character due to its dual meaning as a name or location, whilst the element 'FIR' will have a secondary position in the mark, with a singular meaning of an evergreen coniferous tree. I disagree. As above, I have found that the overall impression of the IR lies across each element equally. As such, 'FIR' does not have as secondary position as suggested by the opponent. I acknowledge that the competing marks coincide in their shared use of the word 'DOUGLAS'. Nevertheless, the IR contains additional elements, being an ampersand and the word 'FIR'. Additionally, the D and O in the opponent's mark are interlinked. While the interlinking element at the beginning of the opponent's mark is not something that consumers would look to pin their recollection of the marks on, I consider that the role that '& FIR' plays in the IR is such that consumers would notice it and use it to assist them in remembering which mark was which. Taking the above into

account, it is my view that the differences between the competing marks are likely to be sufficient for the consumer, paying a medium degree of attention, to distinguish between them and avoid mistaking one for the other. As such, notwithstanding the principles of imperfect recollection and interdependency, I find that there is no likelihood of direct confusion, even when considered on identical goods.

57. That leaves indirect confusion to be considered. In respect of such, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc,* Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "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)".

58. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria*,[6] where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

59. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*.[7] This is mere association not indirect confusion.

60. The types of cases set out in paragraph 17 of Mr Purvis's decision *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 set out at paragraph 57 above 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 else but the brand owner would be using it in a trade mark at all. The second word, 'FIR', is just as distinctive as 'DOUGLAS' and I see no reason why consumers would consider it logical for an undertaking to add an equally distinctive word to indicate a sub-brand or brand extension of 'DOUGLAS', especially when considering that '& FIR' does not indicate a certain type of goods for which the sub-brand or brand extension could be said to relate. Further, it seems highly improbable that the IR would be taken as signifying a collaboration between the

[6] BL O/219/16
[7] BL O/547/17

holders and another party as ‘FIR’, being viewed as a type of tree, is not likely to be taken as the name of a collaborative party. Therefore, there is no logical basis on which ‘DOUGLAS & FIR’ is liable to be seen as a brand extension of ‘DOUGLAS’ on this basis.

61. I acknowledge that this argument might be stronger in some circumstances where the combination of the forename of one person with the surname of another could indicate a tie-up or joint venture. However, as I have already stated ‘FIR’ is not a surname. Further, ‘DOUGLAS’ is a relatively common forename and it has not been shown has become highly distinctive. It is, therefore, unlikely that average consumers will believe there could only be one possible (legitimate) user of marks including that name.

62. Taking all of the above into account, I find that there exists no likelihood of indirect confusion, even when the consumers are confronted by the marks on identical goods.

CONCLUSION

63. The opposition fails in its entirety. Therefore, the IR may, subject to any successful appeal of my decision, proceed to protection in the UK in respect of all of the goods for which protection was sought.

COSTS

64. The holders have been successful and are entitled to a contribution towards their costs, based upon the scale published in Tribunal Practice Note 1/2023. In the circumstances, I award the holders the sum of £850 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the notice of opposition and preparing the counterstatement:	£250

Preparing evidence:	£600
Total:	**£850**

65. I therefore order Douglas Marken- und Lizenzen GmbH & Co. KG to pay Shedrain Corporation and Rose & William Consulting LLC the sum of £850. The above 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 18th day of March 2025

N Barratt
For the Registrar