O/0453/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003956357
BY SELLERX GERMANY GMBH TO REGISTER:

Oakshield

AS A TRADE MARK IN CLASSES 9 & 14

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 444315 BY
MONTRES TUDOR SA

BACKGROUND AND PLEADINGS

1. On 13 September 2023 SellerX Germany GmbH ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK ("the applicant's mark"). The application was published for opposition purposes on 29 September 2023 and registration is sought for the following goods:

Class 9: Phone cases; cell phone cases; mobile phone cases; mobile telephone cases; cellular telephone cases; carrying cases for cell phones; protective cases for cell phones; cell phone covers; cases for mobile phones; carrying cases for mobile phones; carrying cases for cellular phones; protective cases for mobile phones; mobile phone covers; waterproof smartphone cases; laptop cases; carrying cases for mobile telephones; mobile phone screen protectors; carrying cases for cellular telephones; cases adapted for mobile phones; cases for telephones; tablet computer cases; laptop carrying cases; cases for tablet computers; protective cases for tablet computers; cases adapted for tablet computers; cases for headphones; protective cases for personal digital assistants; cases for electronic diaries; electronic book reader covers; wearable activity trackers; pedometers.

Class 14: Watch bands; wrist watch bands; bands for watches; watch cases.

2. On 27 November 2023, the applicant's mark was opposed by Montres Tudor SA ("the opponent"). The opposition was brought in reliance upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). Under both grounds, the opponent relies on the following mark:

BLACK SHIELD
UK registration no. 3068063
Filing date 12 August 2014; registration date 14 November 2014
Relying on some goods, namely:

Class 14: Clock and watchmaking, namely watches, wristwatches, clocks and other chronometric instruments, chronometers, chronographs (clock and watchmaking), apparatuses and instruments to measure and record the time not included in other classes; watch straps, dials (clock and watchmaking), boxes, cases and presentation cases for clock and watchmaking.

("the opponent's mark")

3. The opposition, insofar as it relies on section 5(2)(b), is aimed only at the applicant's "wearable activity trackers" in class 9 and "watch bands", "wrist watch bands", "bands for watches" and "watch cases" in class 14. In bringing this claim, the opponent claims that the goods at issue are either identical (specifically the class 14 goods) or similar (being the class 9 goods). Further, the opponent claims that the marks are highly similar. Taking these two points together with a claim that the opponent's mark enjoys a high degree of inherent and acquired distinctive character, the opponent's position is that there exists a likelihood of confusion between the marks at issue.

4. The section 5(3) ground is targeted at all of the goods that the applicant seeks to register. The opponent claims that its mark enjoys a reputation and goodwill which it claims will inevitably lead to the relevant public making a mental link between the marks at issue. The opponent claims that use of the applicant's mark would take unfair advantage of the opponent's mark and be detrimental to its reputation and/or distinctive character.

5. The applicant filed a counterstatement wherein it did accept that there existed some similarity between the class 14 goods at issue. However, for the most part, the applicant denied the claims against it.

6. The applicant is represented by Olivier de Combret of MXP Prime Platform Ltd and the opponent is represented by D Young & Co LLP. Only the opponent filed evidence. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration 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 Ms Anna Marie Reid dated 25 March 2024. Ms Reid is a partner at the opponent's representative and is, therefore, duly authorised to file evidence on its behalf. The purpose of Ms Reid's statement was to adduce evidence demonstrating the overlap between wearable activity trackers and watches. It is noted that Ms Reid's statement was accompanied by six exhibits, being AMR1 to AMR6.

9. I do not intend to summarise the evidence filed by the opponent (or its submissions, for that matter) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

PRELIMINARY ISSUES

The applicant's counterstatement

10. It is noted that in its counterstatement, the applicant sought to raise an argument that the term 'SHIELD' is commonly used for trade marks covering goods in class 14 in the UK. In support of this point, the applicant referred to 15 different trade marks registered in the UK for class 14 goods that include the word 'SHIELD' within them. This is noted; however, this is not supported by any evidence of fact so any claim that the distinctiveness of the opponent's mark has been weakened by the common use of 'SHIELD' is of no assistance. Even if the applicant had filed evidence that these marks were present on the trade marks register, it would still be of no assistance here. I say this because it is established case law that, without any evidence as to how the marks are used in the marketplace, the mere presence of trade marks that contain the same element as the mark at issue is not sufficient to establish that the distinctive character of that element has been weakened due to its frequent use.[1] Therefore, given that no evidence in respect of these marks has been provided, any claim that the opponent's mark's distinctive character has been weakened is not relevant. I will, therefore, say no more about it.

Section 5(3) ground

11. While the opponent initially sought to rely on section 5(3) of the Act, it is noted that it did not file any evidence that purported to demonstrate that it enjoys a reputation in the relevant territory. As such, the section 5(3) ground could have been deemed abandoned at that stage in accordance with Rule 20(3) of the Trade Marks Rules 2008. However, in its written submissions in lieu of a hearing, the opponent confirmed, at paragraph four, that the section 5(3) ground had been dropped by the opponent. As a result, the section 5(3) ground is treated as having been

[1] See paragraph 73 of *Zero Industry Srl v OHIM*, Case T-400/06

withdrawn. Therefore, this decision proceeds in respect of the section 5(2)(b) ground only.

DECISION

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

12. Section 5(2)(b) of the Act reads as follows:

"(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 or association with the earlier trade mark."

13. 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."

14. 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.

15. The opponent's mark qualifies as an earlier trade mark under the above provisions. While the opponent's mark did complete its registration process more than five years before the filing date of the applicant's mark, the applicant did not request that the opponent provide proof of use for the same. On this point, I note that the opponent did give a statement of use confirming that it has used its mark during the five-year period prior to the filing date of the opponent's mark in respect of all goods relied upon. As such, the opponent's mark is not subject to the use provisions pursuant to section 6A of the Act. Consequently, the opponent may rely on all of the goods highlighted in its notice of opposition.

16. 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 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 goods

17. The competing goods are as follows:

The opponent's goods	The applicant's goods
Class 14 Clock and watchmaking, namely watches, wristwatches, clocks and other chronometric instruments, chronometers, chronographs (clock and watchmaking), apparatuses and instruments to measure and record the time not included in other classes; watch straps, dials (clock and watchmaking), boxes, cases and presentation cases for clock and watchmaking.	Class 9 Wearable activity trackers. Class 14 Watch bands; wrist watch bands; bands for watches; watch cases.

18. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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:

"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".

19. 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.

20. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP*

TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

21. I have set out above that the applicant has accepted that there is a degree of similarity between the goods in class 14. As for the class 9 goods, the applicant denies that they are similar. I note that while it did not file written submissions, the applicant did set out the reasons for this denial in its counterstatement. On this point, I note that the opponent has filed evidence regarding the claimed similarity between the applicant's class 9 goods and the opponent's class 14 goods. Further, I note that the opponent has also filed submissions in respect of the same. In doing so, the opponent made reference to two decisions of this office, the first being *VERSION TECH* (BL O/213/22) and the second being *XPLORA* (BL O/682/19). These decisions were appended to the opponent's submissions at Annex 4 and 5, respectively. Even though the first decision was issued by me, the ordinary position in respect of decisions of this Tribunal remains, namely that they are not binding on Hearing Officers in other cases. As such, the inclusion of these decisions as annexes to the opponent's submissions are of no real assistance.

22. For the avoidance of doubt, I have given due consideration to the comments of the parties and will only seek to discuss them further where necessary below.

Class 9

23. The opponent's position in respect of the applicant's class 9 term, being "wearable activity trackers" is that it includes smartwatches. Essentially, the opponent argues that the relevant comparison here is between "smartwatches" and the opponent's "clock and watchmaking, namely watches [and] wristwatches". I note that previously, in *VERSION TECH*, I found that "wearable activity trackers" covered a wide range of wearable devices such as smartwatches that are used to track and monitor the user's activity. This finding was reached when I was comparing such goods with "wearable personal electronic devices […] that process, store, and transmit biometric data of the user". As such, the reference to wearable activity trackers being smartwatches was not impactful on my finding of identity in that case and should not be taken as a concrete finding that wearable activity trackers and smartwatches are the same. Upon reflection, I am of the view that while a smartwatch can be a device that is used to track activity, I do not consider that a wearable activity tracking device is necessarily a smartwatch.

24. In support of its position, the opponent filed evidence in the form of an article from The Telegraph that shows a list of the best fitness trackers.[2] It is noted that the list mostly includes smartwatches. While noted, there are several times in the article where the author refers to 'fitness watches' and 'trackers' separately, seemingly indicating that they are different categories of goods. This is done in the article's sub-heading, its first paragraph and in the actual title of the list of goods (being 'best fitness trackers and smartwatches'). As such, I do not necessarily consider that the opponent's evidence sufficiently demonstrates that an activity tracker *is* a smartwatch. In addition, I note that the opponent makes reference, in its evidence, to goods offered by Apple, Fitbit, Garmin, Samsung and Huawai. This is demonstrated by way of printouts from these companies' websites showing the offering of wearable electronic devices.[3] Having considered the printouts from

[2] AMR1
[3] AMR2 to AMR6

these companies' website, I note that there are several references to the goods being 'activity trackers'. However, this does not necessarily mean that the goods shown are actually activity trackers. In support of this point, the evidence is clear in that all of these goods offer features that go far beyond that of simply an activity tracker. For example, the 'Apple Watch' offers multiple features such as an alarm, a calculator and a camera remote, the 'FitBit Charge 6' offers Map, Wallet and YouTube features, the 'Garmin Venu 3S' offers the ability to make calls and send texts (and is referred to as 'more than just a fitness smartwatch') and the 'Samsung Galaxy Watch6' offers the ability to stream music, text and call. Taking all of this into account, I am of the view that regardless of how the aforementioned companies refer to their goods, they are all clearly types of smartwatches that, amongst other things, include activity tracking features. They are not, therefore, "wearable activity trackers" in accordance with the core meaning of such goods. To conclude that a wearable activity tracker is a smartwatch would, in my view, be a result of an unnatural straining of the language (as per *YouView*, cited above). As a result, I disagree with the opponent's position and will, instead, proceed to consider a comparison of these goods on the basis of the plain and ordinary meaning of the applicant's term, being a wearable activity tracker.

25. Essentially, the comparison I must make here is between "wearable activity trackers" and watches in class 14 (which, as per the Nice Classification, expressly excludes smartwatches). While I appreciate that both goods are worn on the wrist, they have different natures and purposes. I say this because the applicant's term covers an electronic device that tracks activity whereas the other covers a mechanical device that is used to tell time. In addition, I do not consider that the producer of a watch would also produce and sell a wearable activity tracker. On this point, I appreciate that a producer of a watch may produce and sell a smartwatch. However, this is not the comparison at issue here. As such, I find that the trade channels do not overlap. In respect of user, I appreciate that someone who buys a watch may also seek to buy a wearable activity tracker. However, the user base for such goods is so vast that any overlap on this point is likely to be

fleeting. Lastly, I do not consider that the goods at issue are complementary in nature and neither are they competitive. Overall, I consider that these goods are dissimilar.

Class 14

26. The applicant's specification includes the terms "watch bands", "wrist watch bands" and "bands for watches". The opponent's specification includes the term "watch straps". It is my understanding that, in this context, the terms bands and straps are interchangeable. As such, I find that these terms describe the same goods and, as such, they are self-evidently identical. If this is incorrect and a 'band' is not the same as a 'strap', I find that the goods are still highly similar. I say this because their methods of use, purposes, trade channels and users all overlap. Further, the goods are likely to be competitive in nature as a user may select a band over a strap, or vice versa.

27. The applicant's specification includes the term "watch cases". While expressed slightly differently in the opponent's specification (as the longer "watch straps, dials (clock and watchmaking), boxes, cases and presentation cases for clock and watchmaking"), it can be construed as covering the same goods, i.e. cases for watches. As such, I find that these goods are self-evidently identical.

Conclusion of the goods comparison

28. Where there is no similarity between goods, there can be no likelihood of confusion under section 5(2)(b) grounds.[4] In light of my findings above, it follows that the opposition fails against the dissimilar goods, being "wearable activity trackers" in class 9. It will, however, proceed against the applicant's class 14 goods, which I have found to be identical or highly similar.

[4] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA.

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. I note that the opponent made submissions in respect of the average consumer. Having considered these, they appear to be directed at the applicant's claim that the opponent sells luxury goods whereas the applicant sells much cheaper goods through the internet. This appeared to be geared towards the issue of the watch goods which are no longer at issue. That being said, I still consider it necessary to address the point here. In making submissions on this issue, the opponent made reference to a decision of this Tribunal in the case of *Oyster and Pop* (O/0605/24).[5] This is, again, a decision that was issued by me that, as set out above, is not binding on the decision I must make here. That being said, I consider that the approach I adopted there is applicable here, namely that the present assessment is a notional one based on the terms as they appear before me and not how they

[5] It appended a copy of the same to its submissions at Annex 1.

are intended to be sold by the parties or how much they cost. Therefore, as the goods at issue here are not limited in a way to suggest their value or how they are selected (being the arguments put forward by the applicant), the actual activities undertaken by the parties are not relevant. As a result, I am of the view that I can simply conclude that as the goods at issue are ordinary consumer goods, they will be selected by members of the general public at large.

31. The goods will be available from a range of retailers, be that general retailers or more specific electronic or watch/jewellery stores. Regardless of the scenario, the goods will be displayed on shelves or on racks where they will be self-selected by the consumer. As such, I find that the visual component will dominate the selection process. That being said, the aural component will not be ignored entirely by way of word-of-mouth recommendations or advice from sales assistants. The goods will likely be selected on a relatively frequent basis and at varying costs. In terms of the level of attention paid, I note that the opponent goes on to submit (when discussing a likelihood of direct confusion) that the average consumer will pay a low degree of attention. While I appreciate that the goods at issue may include those on the cheaper end of the scale, consumers will still consider various factors such as fit (for the wearable goods), style, suitability/compatibility and materials used. Such factors will give rise to a higher level of attention than that submitted by the opponent. On balance, it is my view that the factors discussed give rise to a finding that the average consumer will pay a medium degree of attention when selecting the goods at issue.

Comparison of the marks

32. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the

overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

33. 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."

34. 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 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.

35. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
BLACK SHIELD	Oakshield

36. I note that I have detailed submissions from the opponent as to the similarity of the marks. As was the case with the goods comparison above, I do not have written submissions from the applicant. That being said, it did make comments as to the similarity of the marks in its counterstatement. While I do not intend to discuss the submissions or comments of the parties here, I can confirm that I have given them due consideration.

Overall impression

37. The opponent's mark is a word only mark that consists of the words 'BLACK SHIELD'. As for the applicant's mark, this is also a word only mark that consists of one word, being 'Oakshield'. While presented as one word, the average consumer will understand it to be the conjoining of two words, being 'Oak' and 'shield'. The opponent submits that the word 'SHIELD' dominates the overall impression of both parties' marks. I appreciate that the first words of the marks, being 'BLACK' and 'Oak', will qualify the following word on the basis that it will denote the type of shield referred to. However, the word 'SHIELD' is, as I will come to discuss further below, unremarkable from a trade mark perspective. Further, I remind myself that consumers tend to focus on the beginnings of marks.[6] As such, I see no reason why the word 'SHIELD' would dominate either mark. Instead, I find that the words in each mark combine to form a unitary meaning and, therefore, I find that the overall impression of both marks is dominated equally by the words within them.

Visual comparison

38. The opponent relies on the fact that the marks share eight letters, being 'A-K-S-H-I-E-L-D'. While it is clearly the case that the marks share these same letters and that both marks include the identical word 'SHIELD', the opponent's reliance upon the common use of 'A' and 'K' is somewhat misguided and is, in my view, reliant upon an artificial dissection of the mark. I say this because the letters 'A' and 'K' form parts of different words and this will be obvious to the consumer. Therefore, I do not consider that much weight will be placed on the fact that the letters 'A' and 'K' are present in entirely different words, being 'BLACK' in the opponent's mark and 'Oak' in the applicant's. As a result, I consider that while they share an identical second word, being 'SHIELD', the first words of the marks differ entirely. On this

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

point, I remind myself that, as above, consumers tend to focus on the beginnings of marks. Overall, taking all of this into account and bearing in mind the overall impression of the marks, I find that they are similar to a medium degree.

Aural comparison

39. Aurally, I find that both marks will consist of two syllables that will be pronounced in the ordinary way. The first syllables differ whereas the second syllables are identical. On this point, I remind myself that not only is the point of difference at the beginning of the marks, but I also consider that from an aural perspective, they are both short marks. While there is no special test for comparing short marks,[7] I consider that the shortness of the marks in the present case is such that consumers will notice their differences. As a result, I find that these marks are aurally similar to a medium degree.

Conceptual comparison

40. I note that I have detailed submissions from the opponent in respect of the conceptual comparison. In making its submissions, the opponent makes reference to two recent decisions of the EUIPO opposition division. While these are noted, they are not binding on the decision I must make here. Saying that, I am in agreement with the opponent in respect of its overall submission in respect of this assessment, namely that they are similar to a high degree. Firstly, I am of the view that the concept associated with the opponent's mark will be that of a *shield that is coloured black*. Secondly, the concept associated with the applicant's mark will be that of a *shield made out of oak wood*. Clearly, the shared reference to a shield creates a significant point of similarity between them. While the reference to the different colour/material of said shields is a point of difference, it is not a significant one. On this point, I appreciate that a black shield may be made out of oak,

[7] See paragraph 44 of *BOSCO*, BL O/301/20

however, this is not particularly obvious in the mark so it will not play a factor in the consumers overall view of the conceptual comparison. Taking all of this into account, and as alluded to above, I find that the marks are conceptually similar to a high degree.

Distinctive character of the opponent's mark

41. 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)."

42. 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 through use and, on this point, I note that the opponent did initially plead that its mark had acquired an enhanced degree of distinctiveness. However, it did not file evidence of use and, as such, I only have the inherent position to consider.

43. The opponent submits that its mark has no established or natural meaning in relation to the goods relied upon and, therefore, it has a high degree of inherent distinctive character. For reasons I will come to discuss below, I disagree with the opponent's assessment of the distinctiveness of its mark.

44. As I have set out above, the opponent's mark, being 'BLACK SHIELD', consists of two ordinary dictionary words that combine to create a unitary meaning, being that of a shield that is coloured black. On this point, I note that the specification includes *watch cases* and I consider that the purpose of such goods is to protect the user's watch. Another expression for this is that the goods are used to *shield* the watch from damage. In light of this, I find that the reference to 'SHIELD' in the opponent's mark in this scenario is somewhat allusive to the intended purpose of the goods. As such, the distinctiveness of the opponent's mark will be on the lower end of the scale. While not outright low, I consider that the distinctiveness sits at somewhere between a low and medium degree. For the other goods at issue here, the mark does not carry the same allusive meaning. While I accept that the mark is neither descriptive nor allusive of such goods, this alone does not warrant a finding of a high degree of distinctive character as submitted by the opponent. I say this because I consider that the reference to a black shield will be considered somewhat ordinary from a trade mark perspective. As such, I consider that, in this scenario, the opponent's mark enjoys a medium degree of inherent distinctive character.

Likelihood of confusion

45. 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 services 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 minds.

46. I have found the goods at issue to be identical. For some goods, however, I found that if this was wrong, then they are similar to a high degree. The average consumer base is formed of members of the general public at large who will select the goods via primarily visual means, though I do not discount the aural component entirely. The goods will be selected with a medium degree of attention. In respect of the marks at issue, I have found them to be visually and aurally similar to a medium degree and conceptually similar to a high degree. Lastly, I have found that, for some goods, the opponent's mark possesses a medium degree of inherent distinctiveness but for others (being the watch cases), this will sit at between a low

and medium degree. On this point, I remind myself that a weaker degree of distinctive character does not preclude a likelihood of confusion.[8]

47. The opponent's submissions in respect of direct confusion are based on the claims that (1) the goods at issue are identical or highly similar, (2) the marks are highly similar, (3) the average consumer pays a low degree of attention and (4) the earlier mark enjoys a high degree of inherent distinctiveness. While I accept that I have found that the goods at issue are identical or highly similar and that the marks are conceptually similar to a high degree, I disagree with the other claims relied upon. It is my view that the visual and aural differences created by the words 'Oak' and 'BLACK', which both sit at the beginnings of the marks, will result in consumers being able to accurately recall the marks for one another. I do not consider that the conceptual level of similarity will counteract these differences.[9]

48. In addition, I remind myself that, as set out above, the consumer tends to focus on the beginnings of marks, being where these marks differ entirely. I appreciate that the marks share the word 'SHIELD', however, this is not the dominant element of either mark. Therefore, I do not consider that it can be said to be the element used to recall the marks to the exclusion of the other elements. Even if it was the dominant element of either mark, it would not result in the consumer forgetting which mark started with 'Oak' and which started with 'BLACK'. Consequently, I do not consider that there exists a likelihood of direct confusion between these marks, even on identical goods.

49. I will now proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

[8] *L'Oréal SA v OHIM*, Case C-235/05 P
[9] I note that conceptual similarities *may* overcome visual and aural differences between marks (see *The Picasso Estate v OHIM*, Case C-361/04 P). However, this is not always the case (see *Nokia Oyj v OHIM,* Case T-460/07).

“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)”.

50. I note that in its submissions, the opponent simply states that in the event that there is no direct confusion, indirect confusion would occur. It offers no reasons beyond this. As such, I consider it only appropriate for me to consider the three factors set out in *L.A. Sugar*. While these factors are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion can occur, I have no alternative examples put forward by the opponent. Without anything further, I consider that it would be inappropriate (and unfair to the applicant, for that matter) for me to formulate any further arguments on the opponent's behalf.

51. The marks share the same second word, being 'SHIELD'. This is an ordinary dictionary word that is either allusive to the goods relied upon by the opponent or, simply, a normal dictionary word. As such, it cannot be said to be so strikingly distinctive to result in the consumer believing that only one undertaking would use it. The next consideration is whether the applicant's mark simply adds a non-distinctive element that consumers would expect to find in a sub-brand or brand extension. This is not applicable to the present case on the basis that the word 'Oak' is not a mere addition to the words 'BLACK SHIELD'. As such, the present case does not fall within this category of indirect confusion. This leaves the third category set out in *L.A. Sugar*, being whether the applicant's mark consists of changes to an element in the opponent's mark that consumers would consider to be logical and consistent with a brand extension. I consider that this represents the opponent's best case but, even then, it does not result in a likelihood of indirect confusion. My reasons follow.

52. In this scenario, I appreciate that the consumer will recognise the shared use of the word 'SHIELD' but will note that it is preceded by a different word. The difference in the preceding word will clearly be noticed and I do not consider that the change would be considered a logical one. I say this because one refers to a material, being oak, whereas the other refers to a colour. As I have discussed above, oak may be painted black but this is not obviously conveyed to consumers

to the point that the change from black to oak becomes logical. If, for example, the change was from 'BLACK SHIELD' to 'RED SHIELD' or 'Pineshield' to 'Oakshield' then I am of the view that consumers would consider the marks to be logical extensions of one another, with each denoting different colours/types of woods. Such a connection could give rise to a logical scenario wherein a consumer would consider that the differences point to an extension of the brand that uses different colours/materials. However, I do not consider that this conclusion can be said to apply to a perceived change from a colour of a shield to a material used in a shield, or vice versa. Again, I remind myself that 'SHIELD' is not distinctive to the point that consumers would think any reference to the same would be associated with the opponent, even taking into account the higher degree of conceptual similarity between the marks. On this point, I consider that the reference to a different type of shield is purely coincidental in the circumstances, especially when considering the weaker degree of distinctive character for some of the goods at issue. Lastly, I wish to point out that while consumers may call to mind the opponent's mark upon viewing the applicant's mark due to the shared use of 'SHIELD', I consider this to be mere association, not indirect confusion.[10] Consequently, I do not consider that there exists a likelihood of indirect confusion between the marks at issue, even on identical goods.

53. As a result of the above, the present ground fails in its entirety and as the section 5(3) ground of opposition has been deemed withdrawn, my decision concludes here.

CONCLUSION

54. The opposition fails in its entirety and, subject to any successful appeal of my decision, the applicant's mark may proceed to registration for all of the goods applied for.

[10] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

COSTS

55. The applicant has succeeded in full and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. While the applicant only engaged in these proceedings by filing a counterstatement, it was required to consider the evidence filed by the opponent. As such, I will make a reduced costs award in respect of that task. In the circumstances, I hereby award the applicant the sum of £600 as a contribution towards its costs. This sum is calculated as follows:

Considering a notice of opposition and preparing a counterstatement:	£300
Considering the opponent's evidence:	£300
Total:	**£600**

56. I hereby order Montres Tudor SA to pay SellerX Germany GmbH the sum of £600. 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 23rd day of May 2025

A COOPER
For the Registrar