O/0489/25

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NUMBER WO0100001643354
BY STOR-MED PTY LTD
TO REGISTER THE FOLLOWING TRADE MARK:

STERIRACK

IN CLASSES 9, 19, 20 & 37

AND

AN OPPOSITION THERETO UNDER NUMBER OP600003398
BY BELINTRA NV

BACKGROUND AND PLEADINGS

1. International registration WO0100001643354 ("the IR") consists of the sign shown on the cover page of this decision. The holder is Stor-Med Pty Ltd ("the holder"). The IR is registered with effect from 29 December 2020. On the 17 January 2024, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement.

2. The holder seeks protection for the IR in relation to the following goods and services:

Class 6: Metal panels, walling and storage for medical use and for use in pharmacies.

Class 19: Non-metallic storage apparatus and structures; non-metallic storage and raised floors; non-metallic walling and wall panels; non-metallic panels and panel systems.

Class 20: Non-metallic shelving, shelves and storage products and systems; non-metallic racking for storage; non-metallic shelving and racking parts and frames; non-metallic storage cabinets and trolleys; non-metallic storage systems; non-metallic containers and boxes for storage; non-metallic storage and shelving units; non-metallic shelving for sale in kit form; non-metallic storage cabinets, shelves and benches; plastic basket systems and products; metal trolleys, racks, cabinets and shelving for medical use and for use in pharmacies.

Class 37: Installation, construction, repair and maintenance services; installation, construction and repair of shelving, racking and storage products, systems and installations; information advice and consultancy in relation to the aforesaid services.

3. The IR was published for opposition purposes on 03 May 2024. On 5 August 2024, Belintra NV ("the opponent") opposed the IR in the UK on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act") in relation to all of the goods that the IR is registered for.

4. The opponent relies upon the mark detailed below ("the earlier mark"):

STERISYSTEM

Comparable trade mark, registration no: UK00918129373
Filing date: 26 September 2019
Registration date: 25 January 2020

5. For the purpose of these proceedings, the opponent is reliant upon all of the goods for which the earlier mark is registered:

Class 6: Containers, and transportation and packaging articles, of metal; Modular storage and transport systems of metal; racking of metal for storage purposes; Metal storage shelters; Baskets of metal; Trays of metal; Parts and components for the aforesaid goods included in this class.

Class 12: Human-powered trolleys and carts; Handling carts; Hand trucks; Handling carts; Wheeled containers for the transport of goods; Parts and components for the aforesaid goods, included in this class.

Class 20: Flower tables; Working tables; Height-adjustable tables; Industrial work tables; Shelves for storage; Mobile storage racks; baskets for storage; Storage modules; Storage units; Cabinets for storing articles; Relocatable metal storage racks; Relocatable storage racks, not of metal; Modular storage and transport systems; Modular cabinets; Modular shelving; Containers, not of metal [storage, transport];

Transport containers (Non-metallic -); Transportable exhibition stands, not of metal; Parts and components for the aforesaid goods, included in this class.

6. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. Further, as registration of the opponent's mark was completed less than five years before the designation date of the IR, proof of use is not relevant in these proceedings as per section 6A of the Act.

7. Under section 5(2)(b), the opponent claims that the goods and services are identical or highly similar, and that the marks are similar as they coincide in the distinctive element, 'STERI'.

8. The holder filed a defence denying the opponent's claims.

9. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that: "The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit." The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions, except where proof of use is required. However, no leave was sought to file any evidence in respect of these proceedings. As such, I am disregarding the evidence unrelated to proof of use that was filed by the opponent as part of its submissions.

10. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. As neither the Tribunal nor either of the parties requested that the case be heard orally, it is heard on the papers.

11. The holder is represented by J A Kemp LLP and the opponent is represented by De Clercq & Partners. A hearing was neither requested nor considered necessary, however both parties filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

12. 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.

Preliminary issues

13. The opponent refers me to an EUIPO decision between the parties, which I am told is currently subject to an appeal. However, I note that I am not bound by decisions made in other jurisdictions.

14. The opponent also refers me to another opposition case, OP000435601. This opposition went undefended, and I do not consider it pertinent to the matter before me.

DECISION

Section 5(2)(b)

15. Sections 5(2)(b) and 5A of the Act state:

> "5(2) A trade mark shall not be registered if because –
>
> […]

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

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

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

Relevant law

16. 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 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 and services

17. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

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

18. 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.

19. In *Gérard Meric v OHIM*, 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 für Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

20. Further, in *Kurt Hesse v OHIM*,[1] the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,[2] the General Court ("GC") stated that "complementary" means:

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

21. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court stated that "complementary" means:

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

[1] Case C-50/15 P
[2] Case T-325/06

22. 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."

23. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

> "…the applicable principles of interpretation are as follows: (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services. (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms. (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers. (4) A term which cannot be interpreted is to be disregarded."

24. In *Avnet Incorporated v Isoact Limited* [1998] FSR 16, Jacob J (as he then was) said at [19]:

"[…] definitions of services … are inherently less precise than specifications of goods. […] In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

25. The goods/services to be compared are shown in the table below:

The opponent's goods	The holder's goods/services
Class 6: Containers, and transportation and packaging articles, of metal; Modular storage and transport systems of metal; racking of metal for storage purposes; Metal storage shelters; Baskets of metal; Trays of metal; Parts and components for the aforesaid goods included in this class.	Class 6: Metal panels, walling and storage for medical use and for use in pharmacies.
Class 12: Human-powered trolleys and carts; Handling carts; Hand trucks; Handling carts; Wheeled containers for the transport of goods; Parts and components for the aforesaid goods, included in this class.	
	Class 19: Non-metallic storage apparatus and structures; non-metallic storage and raised floors; non-metallic walling and wall panels; non-metallic panels and panel systems.
Class 20: Flower tables; Working tables; Height-adjustable tables; Industrial work tables; Shelves for storage; Mobile storage racks; baskets for storage; Storage modules; Storage	Class 20: Non-metallic shelving, shelves and storage products and systems; non-metallic racking for storage; non-metallic shelving and racking parts and frames; non-metallic

units; Cabinets for storing articles; Relocatable metal storage racks; Relocatable storage racks, not of metal; Modular storage and transport systems; Modular cabinets; Modular shelving; Containers, not of metal [storage, transport]; Transport containers (Non-metallic -); Transportable exhibition stands, not of metal; Parts and components for the aforesaid goods, included in this class.	storage cabinets and trolleys; non-metallic storage systems; non-metallic containers and boxes for storage; non-metallic storage and shelving units; non-metallic shelving for sale in kit form; non-metallic storage cabinets, shelves and benches; plastic basket systems and products; metal trolleys, racks, cabinets and shelving for medical use and for use in pharmacies.
	Class 37: Installation, construction, repair and maintenance services; installation, construction and repair of shelving, racking and storage products, systems and installations; information advice and consultancy in relation to the aforesaid services.

26. In making my assessment, I note that the goods at issue are storage systems and storage components and so have the same broad nature, purpose and method of use and the same trade channels.

Class 6

27. I compare, “metal panels, walling and storage for medical use and for use in pharmacies” with the opponent’s “Modular storage … systems of metal.”

28. Both sets of goods are made of metal, and both are used for the purpose of storage. The holder’s panels and walling could be used as component parts of the opponent’s modular systems. The opponent’s goods are for general use, whereas the holder’s goods are for medical use and for use in pharmacies. Overall, I find the goods to be of at least a medium level of similarity.

Class 19

29. I find “non-metallic storage apparatus and structures”, “non-metallic storage and raised floors”, “non-metallic walling and wall panels” and “non-metallic panels and panel systems” to be of at least a medium level of similarity when compared to the opponent’s Class 20 “Modular storage … systems”. This is because both sets of goods relate to storage and the holder’s goods could be used as component parts of the opponent’s modular systems.

Class 20

30. “Non-metallic storage cabinets …”, “non-metallic storage cabinets …” and “metal … cabinets … for medical use and for use in pharmacies” are *Meric* identical to the opponent’s “Cabinets for storing articles”.

31. “Non-metallic … trolleys” and “metal trolleys … for medical use and for use in pharmacies” are *Meric* identical to the opponent’s Class 12 “Human-powered trolleys and carts”.

32. “Non-metallic containers and boxes for storage” are *Meric* identical to the opponent’s “Containers, not of metal [storage, transport]”, or at least highly similar.

33. “Non-metallic storage … units” are *Meric* identical to the opponent’s “Storage units”.

34. “Non-metallic shelving, shelves …” and “non-metallic shelving …”, “non-metallic … shelving units”, “non-metallic storage … shelves …”, “non-metallic shelving for sale in kit form” and “metal … shelving for medical use and for use in pharmacies” are *Meric* identical to the opponent’s “Shelves for storage”, or at least highly similar.

35. “Non-metallic racking for storage” and “non-metallic … racking parts and frames” are highly similar to the opponent’s “Relocatable storage racks, not of metal”.

They are all racking products, the only difference being that the opponent's goods are relocatable, whereas the holder's goods are generic racking goods.

36. "Metal … racks … for medical use and for use in pharmacies" are highly similar to the opponent's "Relocatable metal storage racks".

37. "Plastic basket systems and products" are highly similar to the opponent's "baskets for storage".

38. "Non-metallic … storage products and systems" and "non-metallic storage systems" are similar to the opponent's "Modular storage … systems" to at least a medium degree. While the holder's goods are not of metal, whereas the opponent's goods could be made of metal as well as not be made of metal, they both involve storage systems, and the holder's storage products could be used as component parts of the opponent's modular systems.

39. I take "non-metallic storage … benches" to be benches with storage capacity and by comparison with the opponent's "Cabinets for storing articles", both are used for storage, the former having a liftable lid, the latter having a door. They would be sold through the same channels. I find the respective goods to be of a medium level of similarity.

Class 37

40. In respect of "installation, construction and repair of shelving, racking and storage products, systems and installations", I think it is reasonable to suppose that installation and maintenance services for storage systems are complementary to a trade in the goods themselves. Consumers may expect to be able to request an after sales service of assembling and maintaining storage systems such that consumers would believe that such services and the storage systems offered by the opponent could be the responsibility of the same undertaking. As such, I find that the respective services (together with the holder's "information advice and consultancy in relation to the aforesaid services") by comparison with the opponent's goods are of a medium level of similarity.

41. “Installation, construction, repair and maintenance services” at large (together with the holder’s “information advice and consultancy in relation to the aforesaid services”) is caught by the above finding, and so is also of a medium level of similarity.

The average consumer and the purchasing act

42. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

43. The average consumer for the goods at issue is likely to be an organisation or a member of the public seeking storage systems and their installation. Notwithstanding the potential cost of corporate storage systems, these goods and services are of a highly practical nature and even where the goods were intended for medical use or for use in pharmacies, I consider that the level of attention paid by consumers during the purchasing process would be of a medium level.

44. The purchasing process would be primarily a visual one as the potential consumer perused catalogues and websites offering storage products, although I do not rule out verbal considerations should enquiries about specifications need to be made.

Comparison of the trade marks

45. It is clear form *Sabel* 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. The CJEU states at paragraph 34 of its judgment in *Bimbo*, that:

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

46. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

47. The marks to be compared are as follows:

The opponent's mark	**The holder's mark**
STERISYSTEM	STERIRACK

48. Both marks are plain word marks consisting of single words, those words being the only things that contribute to the overall impressions made by the marks.

49. Visually, the marks share the identical five letter prefix, “STERI-”, which is then succeeded by the six-letter suffix “-SYSTEM” in the case of the opponent’s mark and the four letter suffix “-RACK” in the case of the holder’s mark. Thus, the opponent’s mark is two letters longer than the holder’s mark. Overall, I find the marks to be of a medium level of visual similarity.

50. Aurally, the marks are “STEH-REE-SISS-TEM” versus “STEH-REE-RAK”, being four syllables in the case of the opponent’s mark and three in the case of the holder’s mark. Overall, I find the marks to be of a medium level of aural similarity.

51. Conceptually, the opponent says the following in its submissions in lieu:

> “34. Both the Earlier Mark and the Contested Mark are word marks. Considered as a whole, the signs have no particular meaning in relation to any of the good[s] in question.
>
> 35. However, it cannot be denied that both the Earlier Mark and the Contested Mark will be split by the majority (if not all) of the relevant public into 'STERI' and 'SYSTEM' or 'RACK'. In this regard, the EU Court of Justice has held that, although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a word sign, they will break it down into elements which, for them, suggest a specific meaning or which resemble words known to them (CJEU 13/02/2007, *Respicur*, T-256/04, § 57).
>
> 36. In that respect, [the] Opponent observes that the word elements 'SYSTEM' and 'RACK' have the same or an overlapping meaning since they can both refer to storage solutions, according to the respective definitions of the same in the Cambridge and Collins dictionaries, as consulted last on November 16, 2024:

- SYSTEM: 'a set of connected things or devices that operate together' (… [Collins]); 'a group or combination of interrelated, interdependent, or interacting elements forming a collective entity; a methodical or coordinated assemblage of parts, facts, concepts, etc.' (… [Colins])
- RACK: 'a frame or shelf, often formed of bars, that is used to hold things' (… [Cambridge]); 'a frame or shelf, usually with bars or hooks, that is used for holding things or for hanging things on' (… [Cambridge])

…

40. The coinciding element 'STERI' has no clear and specific meaning in relation to the goods in question and should be considered a distinctive element.

…

47. Conceptually, … the signs in question have a meaning for the public in the relevant territory since they may split up the signs in the words 'STERI' and 'RACK' resp. 'SYSTEM'. Due to the overlapping meaning of the element 'RACK' and 'SYSTEM', the relevant public, when encountering the marks in question, may well use both words interchangeably. Accordingly the relevant public will split up the marks in two words that have an (almost) identical meaning. Therefore, the signs are conceptually similar due to the overlapping meaning of the elements 'RACK' and 'SYSTEM'."

52. The holder, at paragraph 1.7 of its submissions in lieu, says the following:

"The conceptual understanding of both marks is … different. Both are invented words. Consumers might understand the 'STERI' prefix as an allusion to 'sterile'; for example, as in the well-known adhesive wound bandage "Steri Strips". The words "SYSTEM" and "RACK" have completely different meanings."

53. The respective words as wholes are invented. A significant proportion of average consumers would see the prefix “STERI” as having no meaning. For the goods and services at issue, while some consumers might see the prefix as connoting the word “sterile”, it would not be a significant proportion of average consumers. Even though a medical setting is referenced in two of the holder’s terms, the average consumer would not associate the goods and services at issue with the notion of sterile environments: their essential nature does not change regardless of their setting. The suffix “-SYSTEM” would give rise to the concept of things being organised and the suffix “-RACK” would give rise to the idea of a compartmentalised shelf.

54. The average consumer would derive no concept from the shared prefix. While both suffixes are suggestive of the goods and services at issue, they give rise to different specific concepts and so I find that the marks are conceptually dissimilar.

Distinctive character of the earlier mark

55. In *Lloyd Schuhfabrik Meyer* 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 *WindsurfingChiemsee 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)."

56. 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, 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.

57. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use in relation to its mark. Consequently, I have only the inherent position to consider.

58. The earlier mark consists of the invented word "STERISYSTEM". The prefix "STERI-" would not have any meaning attached to it by a significant proportion of average consumers and so it would not be seen as suggestive of the opponent's goods. The suffix "-SYSTEM" is, however, suggestive of storage systems. Overall, I find the mark to be of a medium level of inherent distinctive character.

Likelihood of confusion

59. 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 trade 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 he has retained in his mind.

60. I have found the goods and services to range from a medium level of similarity to being identical. I found the marks to be visually and aurally similar to a medium degree and conceptually dissimilar. I have found the earlier mark to possess a medium level of inherent distinctive character. I have identified the average consumer to be an organisation or a member of the public who would pay a medium level of attention during the purchasing process which would be primarily a visual one, although I do not rule out verbal considerations.

61. While the marks share the five-letter prefix "STERI-", they differ in respect of the six letter and four-letter suffixes "-SYSTEM" and "-RACK". These differences would be noticed by the average consumer and so there is no likelihood of direct confusion.

62. I will also consider indirect confusion. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:[3]

> "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 recognised 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

[3] BL O/375/10

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).”

63. 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* (O/219/16), 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.

64. The holder cited two cases that it considered showed "that merely sharing a prefix, and one which is arguably weak, does not necessarily lead to a finding of a likelihood of confusion", but I do not find these cases particularly compelling.[4] I also note that the holder has searched the register and found the following: "17 "steri" marks in Classes 6, 19 and 20. It is clear from the specification of goods of many of these marks that the "STERI" element is used to allude to a sterile aspect of the goods. We therefore dispute the Opponent's assertion that "STERI" is the more distinctive part of the two marks."[5] I am not persuaded by these submissions. We have no information as to whether and to what extent these marks have been used on the market and, as per *Zero Industry Srl v OHIM*, Case T-400/06, it is certainly not a basis for demonstrating that the distinctive character of that element has been weakened because of its frequent use in the field concerned.

65. As I have already stated, the average consumer would not associate the goods and services at issue with the notion of sterile environments: their essential nature does not change regardless of their setting. They would not see the prefix "STERI-" as having any particular meaning and so it is distinctive relative to the suffixes in the respective marks.

66. In the context of category (c) of the Purvis categories, the opponent's mark is "STERISYSTEM" and the change of one element – replacing "-SYSTEM" with "-RACK" while retaining the identical prefix "STERI-", appears entirely logical and consistent with a brand extension.

67. The goods and services at issue involve storage systems and storage components. The word "-SYSTEM" gives rise to the concept of organisation and is suggestive of the goods. The word "-RACK" means a compartmentalised shelf, racking being a storage solution in its own right or forming part of a larger storage system. As such, it is entirely plausible that "STERIRACK" would be seen as the racking sub-brand of the "STERISYSTEM" brand, such that the average consumer would make an association between the marks and believe

[4] Paras 5.9 and 5.10 of the holder's submissions in lieu – the cases ONCOLYSE v ONCOLAR (BL O/0458/02) and REALMZ v realme (BL O/0092/24) have different factual matrices from the case before me. In the former case, the suffixes are not dictionary words that would be recognised by the average UK consumer and in the latter case I do not consider the two words to share a prefix at all.
[5] Holder's submissions in lieu, paragraph 5.7

that the respective goods and services came from the same or economically linked undertakings. Therefore, I find that there is a likelihood of indirect confusion.

CONCLUSION

68. The opposition has been entirely successful.

69. Subject to any appeal, the IR may not become protected in the UK.

COSTS

70. The opponent has been entirely successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1 of 2023. As this is a fast track case, costs are capped at £600, excluding official fees, made up of £250 for filing a notice of opposition and £350 for filing written submissions.

71. I award the opponent the sum of £700, calculated as follows:

Official fee:	£100
Filing a notice of opposition:	£250
Filing written submissions:	£350
Total:	**£700**

72. I therefore order Stor-Med Pty Ltd to pay Belintra NV the sum of £700. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 30th day of May 2025

John Williams
For the Registrar