

O/839/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003523165

BY YUK FONG JAY LEE

TO REGISTER:

La Méduse

AS A TRADE MARK IN CLASSES 10, 16, 25, 26 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 422404 BY

HUMEAU BEAUPREAU LIMITED

BACKGROUND AND PLEADINGS

1. On 17 August 2020, Yuk Fong Jay Lee (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods and services:

Class 10: Ultraviolet ray lamps for medical purposes; Masks for use by medical personnel; Sanitary masks for medical purposes; Gloves for medical purposes; Sanitary masks for dust prevention for medical purposes; Sanitary masks for dust isolation for medical purposes; Medical gowns; Surgical gowns; Boots for medical purposes; Sterile sheets, surgical.

Class 16: Paper; washi; tracing paper; Papers for painting and calligraphy; advertisement boards of paper or cardboard; Blueprints; plans; posters; Aquarelles; watercolors [paintings]; hat boxes of cardboard; greeting cards.

Class 25: Clothing; Footwear; headwear; Shoes; Football shoes; Football boots; Caps being headwear; Hosiery; Gloves [clothing]; Pelerines; Belts [clothing]; Underwear; Underclothing; Sports jerseys; Skirts; Pants; Trousers.

Class 26: Lace for edgings; lace trimmings; passementerie; Embroidery; fancy goods [embroidery]; hat trimmings; shoe trimmings; fastenings for clothing; Brassards; arm bands [clothing accessories]; ribbons for the hair; ornamental novelty badges [buttons].

Class 35: Retail services in relation to headgear; Retail services in relation to footwear; Online retail store services in relation to clothing; Retail services in relation to clothing; Online retail services relating to clothing; Retail services in relation to clothing accessories; Retail services in relation to medical instruments;

Wholesale services in relation to medical instruments; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Sales promotion services; Commercial administration of the licensing of the goods and services of others; Business management and administration; Advertising; Outdoor advertising; Rental of advertising space; Import-export agency services; Production of advertising films; Production of advertising materials; Sales promotion for others; Rental of billboards [advertising boards]; Presentation of goods on communication media, for retail purposes.

2. The application was published for opposition purposes on 27 November 2020 and, on 10 December 2020, it was opposed by HUMEAU BEAUPREAU (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following marks:



EUTM no. 014578843¹

Filing date 17 September 2015; registration date 24 June 2016

Relying on all goods, namely:

Class 9: Spectacles [optics], Sunglasses, Sports glasses, Anti-glare spectacles, Spectacle cases, Spectacle frames.

Class 18: Bags for campers; Beach bags; Sport bags; Holdalls; Satchels; Sling bags for carrying infants; Umbrellas; Parasols; document cases, card holders; Travelling sets; Valises.

¹ Although the UK has left the EU and the EUTMs relied upon by the opponent now enjoy protection in the UK as comparable trade marks, the EUTMs remain the relevant rights in these proceedings. That is because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it stood at the date of application

Class 25: Footwear; Bath slippers; Boots; Beach shoes; Espadrilles; Clogs; Sandals; Clothing; Rainproof clothing; Waist belts.

("the opponent's first mark"); and



EUTM no. 018238658

Filing date 13 May 2020; registration date 25 September 2020

Relying on all goods, namely:

Class 9: Protective masks; Protective visors.

Class 10: Surgical masks; Protective nose masks for medical use; Protective face masks for medical use; Protective breathing masks for medical applications; Face masks for medical use for anti bacterial protection; Face masks for medical use for toxic substance protection; Protective breathing masks made of non-woven materials for medical applications; Protective face visors for medical purposes.

Class 25: Masks (clothing); Masks (clothing).

Class 28: Paper face-masks; Face masks of plastic; Face visors of plastic.
("the opponent's second mark")

3. The opponent submits that the similarity between the parties' marks and the identity and/or similarity between the parties' goods and services will lead to a likelihood of confusion on the part of the relevant public. The applicant filed a counterstatement which denied the claims made and provided detailed explanations as to the reasons why.

4. The opponent is represented by Haseltine Lake Kempner LLP and the applicant is represented by Cloch Solicitors. Neither party filed evidence but during the evidence rounds, the opponent filed written submissions. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

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

DECISION

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

6. 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.”

7. 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.”

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

“(6)(1) In this Act an “earlier trade mark” means –

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

9. The opponent’s marks qualify as earlier trade marks under the above provisions. As the opponent’s marks had not completed their registration process more than 5 years before the application date of the mark in issue, they are not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent can rely upon all of the goods for which its marks are registered.

10. 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 and services

11. The applicant's goods and services are set out in **paragraph one** of this decision and the opponent's goods are set out in **paragraph two**.

12. When making the comparison, all relevant factors relating to the goods 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:

"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".

13. 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.

14. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

“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”.

15. I have submissions from both parties in respect of the comparison of goods and services. I have taken these submissions into account and while I do not intend to reproduce the submissions in full, I will refer to them below, where necessary. I note from its counterstatement, the applicant has accepted that there is some level of similarity regarding its class 25 goods. While this is noted, the applicant has not submitted as to what level of similarity exists between those goods. I will, therefore, proceed to conduct a full goods and services comparison.

Class 10 goods

16. “Masks for use by medical personnel” in the applicant’s specification are the same type of goods as “protective face masks for medical use” in the opponent’s second mark’s specification. These goods are, therefore, identical.

17. “Sanitary masks for medical purposes”, “sanitary masks for dust isolation for medical purposes” and “sanitary masks for dust prevention for medical purposes” in the applicant’s specification are all types of protective face masks for medical use. In my view, “protective face masks for medical use” in the opponent’s second mark’s specification are, by their very nature as medical masks, going to be sanitary and offer protection to the user. Therefore, the applicant’s goods all fall within the broader category covered by the opponent’s goods. As a result, these goods are identical under the principle outlined in *Meric*.

18. I appreciate that there is a general overlap in user and purpose between “ultraviolet ray lamps for medical purposes” in the applicant’s specification and “protective face masks for medical use” in the opponent’s second mark’s specification on the basis that they will both mostly be used by medical staff for medical purposes. Aside from this, I do not consider there to be any overlap in the remaining factors. Despite the general overlap in user and purpose, I do not consider that there is any level of similarity between these goods. However, if I am wrong in this finding, I consider there to be only a very low level of similarity between them.

19. In my view, there is an overlap in purpose between “gloves for medical purposes”, “medical gowns” and “surgical gowns” in the applicant’s specification and “protective face masks for medical use” in the opponent’s second mark’s specification. This is on the basis that all of these goods are worn on the person for protective purposes in a medical environment. In addition, I consider there to be an overlap in user on the basis that all of these goods are likely to be used by those in the medical profession. Further, while I consider the producers of these goods to be different, I am of the view that the distribution channels will be the same in that they will be provided by the same undertakings. As for nature and method of use, I consider these to be different. Overall, I consider these goods to be similar to a medium degree.

20. “Boots for medical purposes” in the applicant’s specification falls within the broader category “footwear” opponent’s first mark’s specification. These goods are, therefore, identical under the principle outlined in *Meric*. However, if I am wrong on my finding of identity on the basis that the opponent’s goods do not cover boots

being for medical purposes, then I am of the view that the applicants' goods are similar to "protective face masks for medical use" in the opponent's second mark's specification for the same reasons set out in paragraph 19 above.

21. "Sterile sheets, surgical" in the applicant's specification are goods that will be used on operating tables in order to ensure the surfaces in a surgery are sterile. While they will not be worn on the person like "protective face masks for medical use" in the opponent's second mark's specification, there is still a general overlap in purpose in that they will be used for medical purposes. While the goods differ in nature and method of use, there is an overlap in user in that both goods will be used by medical staff. Further, even though I consider that the producers of these goods will be different, I am of the view that the distribution channels will be the same in that they will be provided by the same undertakings. Overall, I consider these goods to be similar to a low degree.

Class 16 goods

22. I see no obvious level of similarity between "paper", "washi", "tracing paper", "papers for painting and calligraphy", "advertisement boards of paper or cardboard", "blueprints", "plans", "posters", "aquarelles", "watercolors [paintings]", "hat boxes of cardboard" and "greeting cards" in the applicant's specification and any of the goods in the opponent's specifications. I note that a majority of these goods are made from paper, however, I do not consider that this means that they are similar to "paper face-masks" in the opponent's second mark's specification. These goods are, therefore, dissimilar.

Class 25 goods

23. "Clothing" and "footwear" are present in both the applicant's specification and the opponent's first mark's specification. These goods are self-evidently identical.

24. "Hosiery", "gloves [clothing]", "pelerines", "underwear", "underclothing", "sports jerseys", "skirts", "pants" and "trousers" in the applicant's specification all fall within

the broader category of “clothing” in the opponent’s first mark. These goods are, therefore, identical under the principle outlined in *Meric*.

25. “Shoes”, “football shoes” and “football boots” in the applicant’s specification all fall within the broader category of “footwear” in the opponent’s first mark’s specification. These goods are, therefore, identical under the principle outlined in *Meric*.

26. “Belts [clothing]” in the applicant’s specification has a direct counterpart in the opponent’s first mark’s specification, being “waist belts”. While the terms are expressed differently, I consider that they are identical.

27. “Headwear” in the applicant’s specification can be said to include “masks (clothing)”, which is present in the opponent’s second mark’s specification. This is on the basis that masks as clothing are types of headwear, such as balaclavas, for example. As the opponent’s goods fall within the broader category covered by the applicant’s goods, I consider that they are identical under the principle outlined in *Meric*.

28. I do not consider that “caps being headwear” in the applicant’s specification covers masks. These goods are not, therefore, identical to “masks (clothing)” in the opponent’s second mark’s specification. However, I do consider that there is a level of similarity between them. This is on the basis that the opponent’s term can include masks that cover the entire head, such as balaclavas. Therefore, the nature and method of use overlap in that both goods are items of clothing that are worn on the head. However, I do appreciate that the opponent’s goods may only cover the face, meaning that any overlap in nature and method of use may be limited. Further, there is an overlap in purpose in that the goods may both be worn for the purpose of covering the head to protect the user’s head from the elements, such as cold. There is also a general overlap in user in that the user of both goods will be a member of the general public. Finally, the goods share trade channels in that they are likely to be produced and sold by the same undertakings. Overall, I consider these goods to be similar to a medium degree.

Class 26 goods

29. The opponent has submitted that the applicant's class 26 goods share a high level of similarity with the opponent's 28 goods. This is on the basis that the applicant's goods share the same intended purpose with the opponent's class 28 goods on the basis that they are ornamental and also that they overlap in terms of distribution channels. Further, the opponent submits that as the applicant's class 26 goods are accessories for decorating clothing, they must also be regarded as similar to the clothing items contained within the opponent's class 25 goods.

30. "Lace for edgings", "lace trimmings", "passementerie", "embroidery", "fancy goods [embroidery]" and "fastenings for clothing" in the applicant's specification are all goods that are used in the manufacture of clothing. I do not consider that the purpose of these goods overlaps with "clothing" in the opponent's first mark's specification on the basis that the opponent's goods will be worn and while the applicant's will ultimately be worn as part of clothing, their actual purpose is to be incorporated into clothing. I also consider that there is no overlap in nature or method of use between these goods. As for user, I am of the view that the user of the applicant's goods are manufacturers of clothing whereas the user of opponent's class 25 goods are members of the general public at large. While I appreciate that some members of the general public will buy the applicant's goods to embroider or make their own clothes, any overlap in user is, in my view, superficial. I do not consider that the goods are complementary. The goods will not be sold through the same distribution channels and neither will they be produced by the same manufacturer. Overall, despite a superficial overlap in user, and whilst bearing in mind the opponent's submissions, I do not consider these goods to share any level of similarity with the opponent's class 25 or 28 goods. They are, therefore, dissimilar.

31. "Shoe trimmings" in the applicant's specification are decorative goods that can be purchased by a member of the general public to add to their shoes. I have no submissions as to what these goods include exactly, however, I consider there to be a level of similarity between these goods and "footwear" in the opponent's first mark's specification. There is an overlap in user in that the user of the applicant's

goods will also be a user of the opponent's. There is a general overlap in purpose on the basis that both goods may be worn for stylistic purposes. There is also an overlap in trade channels in that shoe trimmings are likely to be found in the same shops as footwear. I have considered whether the goods are complementary but I do not consider that they are. While footwear may be important or indispensable to shoe trimmings, I do not consider that the average consumer will believe that one undertaking is responsible for both goods.² While I do not consider that these goods overlap in nature or method of use on the basis that the opponent's goods are footwear whereas the applicant's are accessories for the shoe itself, I consider the overlaps in user, purpose and trade channels to be sufficient to warrant a finding of similarity between these goods. Overall, I consider these goods to be similar to a medium degree.

32. "Hat trimmings" in the applicant's specification are goods that are used to decorate hats. This can include goods such as clips and ribbons, amongst others. While the opponent's specifications contain goods such as "masks (clothing)" and "clothing" in general, I do not consider there to be any level of similarity between these goods. This is on the basis that the applicant's goods are not types of clothing and while they may be worn on the head, I see no reason why they would be similar to full head masks such as balaclavas, for example. As for the opponent's submissions that they are similar to its class 28 goods, I do not consider this to be the case. While the applicant's goods and "paper face-masks" in the opponent's second mark's specification may be used for decorative purposes, I do not consider that alone to be sufficient to warrant a finding of similarity between these goods. In my view, there is no obvious level of overlap between these goods or any other goods in the opponent's specification. They are, therefore, dissimilar.

33. "Brassards" and "arm bands [clothing accessories]" in the applicant's specification are different types of clothing accessories that are worn on the arm. They can be worn for decorative or identification purposes (such as to identify the level of rank in the army, for example). While they are not items of clothing, they are types of clothing accessories and, therefore, share a level of similarity between these goods

² *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

and “clothing” in the opponent’s first mark’s specification. While these goods differ in nature and method of use, they do overlap in user and purpose in that both goods can be worn for decorative purposes. I am also of the view that the applicant’s goods will be found in shops next to items such as shirts. Further, I consider that undertakings that provide brassard or arm bands are also likely to provide clothing to accompany such items. Overall, I consider these goods to be similar to a medium degree.

34. The only similarity between “ribbons for the hair” in the applicant’s specification and “paper face-masks” in the opponent’s second mark’s specification is the fact they are goods that are worn on the head. Aside from that, I am of the view that they differ in nature, method of use, purpose and trade channels. The goods are not in competition with one another, neither are they complementary. Overall, I do not consider there to be any level of similarity between these goods. They are, therefore, dissimilar.

35. “Ornamental novelty badges [buttons]” in the applicant’s specification are novelty items. I note that by being in the opponent’s class 28 list of goods in its second mark’s specification, “paper face-masks” may also be used for novelty purposes. Therefore, there can be said to be an overlap in purpose between these goods. There may also be an overlap in user in that both goods will be bought by members of the general public at large but this, in my view, will only result in a superficial overlap. The nature, method of use and trade channels all differ. Further, the goods are neither complementary nor competitive. While the overlap in purpose and superficial overlap in user is noted, I do not consider this sufficient to warrant a finding of similarity between them. These goods are, therefore, dissimilar. However, if I am wrong on this point, I consider them similar to a very low degree.

Class 35 services

36. As a preliminary point in respect of the comparison of these services, I note that, in its counterstatement, the applicant has referred to the case of *IMPERFECT ANGEL – PERFECTLY IMPERFECT* (BL O/628/19) in which it sets out that the Hearing Officer in that case did not make a comparison between the parties’ class

25 goods and class 35 services. No explanation was given as to what these comments meant. However, it appears to me that the applicant is arguing against a comparison of the applicant's class 35 services and the opponent's class 25 goods. Having read the decision, I note that the Hearing Officer elected not to conduct a comparison between the applicant's class 25 goods and the opponent's class 35 services. However, this was on the basis that the goods being applied for were already found to be identical to the opponent's goods so a comparison with the class 35 services was not necessary as it would not further the opponent's position. The facts of that case differ from the facts of the present case. Given that the applicant has applied for class 35 services, it is necessary to compare them in full with the goods in the opponent's specification. I see no reason why a comparison of the class 35 services should not be considered. The comments on this point from the applicant are, therefore, dismissed.

37. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

38. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for

determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

39. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*³, and *Assembled Investments (Proprietary) Ltd v. OHIM*⁴, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*⁵, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;

iv) The General Court’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).

40. The applicant’s specification contains the following services:

“Retail services in relation to headgear; Retail services in relation to footwear; Online retail store services in relation to clothing; Retail services in relation to clothing; Online retail services relating to clothing; Retail services in relation to

³ Case C-411/13P

⁴ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁵ Case C-398/07P

clothing accessories; Retail services in relation to medical instruments; Wholesale services in relation to medical instruments; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.”

41. I will first deal with the retail services relating to clothing, headgear, footwear and clothing accessories before moving to consider the retail services related to the medical field.

42. As set out above, the GC has explained that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore, similar to a degree. It is common for producers of various types of clothing, headgear and footwear products to also retail in those goods. For example, a manufacturer of clothing may operate its own retail stores that exclusively sell their goods. In addition, those goods may be listed for sale on the manufacturer’s website directly rather than via third party retailers. In my view, the average consumer will be aware of the complementary relationship between the producer of these types of goods and the retailing of the same. For the goods that I have found identical in my class 25 goods comparison above, it follows that a medium degree of similarity exists between the opponent’s goods and the services within the applicant’s class 35 specification which relate to identical goods. I, therefore, find that the following services in the applicant’s specifications are similar to a medium degree with various goods contained in the opponent’s marks’ specifications:

“Retail services in relation to headgear; Retail services in relation to footwear; Online retail store services in relation to clothing; Retail services in relation to clothing; Online retail services relating to clothing.”

43. As for the applicant’s “retail services in relation to clothing accessories”, I am of the view that this service includes the retail of brassards and arm bands. While I note that the opponent’s goods do not include clothing accessories, there is a medium level of similarity between “brassards” and “arm bands [clothing accessories]” in

the applicant's specification and the opponent's "clothing" goods. In my view, clothing accessories are commonly sold through the same retailers as clothing, generally. As a result, I consider there to be an overlap in trade channels between these goods and services. While clothing accessories may be sold in shops solely dedicated to those goods, I consider that, for the most part, the average consumer would be aware that they would be sold by general clothing retailers. Therefore, I find that the average consumer would be aware of the complementary relationship between the manufacturer of the applicant's clothing accessory type goods and the retailing of clothing. Overall, I consider there to be a low degree of similarity between these goods and services.

44. As for the services in the applicant's specification, being "retail services in relation to medical instruments" and "wholesale services in relation to medical instruments", these are all services that cover the retail of a broad range of goods. In my view, the goods being retailed are those such as stethoscopes, scalpels, forceps and so on. While I have found identity between the parties' class 10 goods such as face masks, these are not, in my view, medical instruments. The only good in the applicant's specification that may be considered a medical instrument is "ultraviolet ray lamps for medical purposes", which I have found to be dissimilar or, at best, similar to a very low degree. I do not see any obvious level of similarity between these services and any of the opponent's goods. As a result, I consider these services to be dissimilar.

45. "Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies" in the applicant's specification, unlike the services referred to at paragraph 44 above, can be said to include face masks. I have found these types of goods in the applicant's specification to be identical to the opponent's "protective masks for medical use". Applying the same reasoning that I used at paragraph 42 above, I consider these services to be similar to a medium degree with "protective masks for medical use" in the opponent's second mark's specification on the basis that they are complementary and share an overlap in trade channels.

46. In my view, there is no obvious level of similarity between “sales promotion services”, “commercial administration of the licensing of the goods and services of others”, “business management and administration”, “advertising”, “outdoor advertising”, “rental of advertising space”, “import-export agency services”, “production of advertising films”, “production of advertising materials”, “sales promotion for others”, “rental of billboards [advertising boards]”, “presentation of goods on communication media, for retail purposes” in the applicant’s specification and any of the goods in the opponent’s specifications. These goods are, therefore, dissimilar.

47. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those goods and services I have found to be dissimilar will fail.⁶ For ease of reference, the opposition may proceed against the following goods and services in the applicant’s specification only:

Class 10: Ultraviolet ray lamps for medical purposes; Masks for use by medical personnel; Sanitary masks for medical purposes; Gloves for medical purposes; Sanitary masks for dust prevention for medical purposes; Sanitary masks for dust isolation for medical purposes; Medical gowns; Surgical gowns; Boots for medical purposes; Sterile sheets, surgical.

Class 25: Clothing; Footwear; headwear; Shoes; Football shoes; Football boots; Caps being headwear; Hosiery; Gloves [clothing]; Pelerines; Belts [clothing]; Underwear; Underclothing; Sports jerseys; Skirts; Pants; Trousers.

Class 26: Shoe trimmings; Brassards; arm bands [clothing accessories]; Ornamental novelty badges [buttons].

Class 35: Retail services in relation to headgear; Retail services in relation to footwear; Online retail store services in relation to clothing;

⁶ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Retail services in relation to clothing; Online retail services relating to clothing; Retail services in relation to clothing accessories; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.

The average consumer and the nature of the purchasing act

48. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services 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.”

49. The opponent has submitted that the average consumer “comprises both the general public and, in the case of the medical goods (class 10) and related retail services (class 35), the specialist public.” I agree that the average consumer of some goods is a member of the general public at large and that, for some goods, the average consumer will be medical personnel but may also include business users that buy medical goods for use in their medical practices. I also appreciate that some of the class 10 goods, such as protective face masks, while medical in nature, may be purchased by members of the general public as these have become more commonly bought as consumer items as a result of the COVID-19 pandemic.

50. For the class 25 and 26 goods, these are most likely to be sold through a range of clothing retailers and their online or catalogue equivalents. As for the class 10 goods, I am of the view that these are likely to be sold through specialist retailers and their online or catalogue equivalents. However, goods such as medical face masks may also be bought via general retailers given their widespread use in daily life during the COVID-19 pandemic. In physical retail premises (be that specialist or general), the goods at issue will be displayed on shelves or racks, where they will be viewed and self-selected by the consumer. A similar process will apply to websites and catalogues (again, be that specialist or general), where the consumer will select the goods having viewed an image displayed on a webpage or in a catalogue. The selection of the goods at issue will, therefore, be primarily visual, although I do not discount an aural component playing a part, particularly when it comes to sales advice in respect of goods for medical purposes.

51. The price and frequency of purchase of the class 10, 25 and 26 goods at issue may vary. Even where the goods are of low cost and purchased relatively frequently, a number of factors will still be considered by the average consumer during the purchasing process. For example, when selecting the goods in class 25 or 26, the consumers may consider current fashion trends, price, quality and suitability. With this in mind, I consider that the average consumer will pay a medium degree of attention during the purchasing process.

52. Even for those goods that are for medical purposes, I do not consider that the level of attention will be any different. This is because the medical goods at issue are those that are often bought relatively cheaply and in bulk, such as medical gowns and sterile sheets. Of course the consumer will factor in the quality and suitability of these goods but I do not consider that their medical nature takes them any higher than a medium degree of attention.

53. Turning to the class 35 services, I consider these can be separated into the retail services relating to clothing and the retail of pharmaceutical, veterinary and sanitary preparations and medical supplies. Clothing retail services are most likely to be selected having considered, for example, promotional material (in hard copy and online) and signage appearing on the high street. For online retail services,

these are likely to be selected after viewing online advertising or search engine links. Visual considerations will be an important part of the selection process. Such services are also likely to be the subject of word-of-mouth recommendations meaning that aural considerations will not be an insignificant feature of the selection process. When selecting these services, the average consumer is likely to consider such things as stock, price of goods offered in comparison to other retailers, delivery method (for online retail only) and expertise/knowledge of staff. I am of the view that the average consumer is likely to pay a medium degree of attention during the selection process for the services.

54. For those services that relate to pharmaceutical, veterinary and sanitary preparations and medical supplies, I consider that the selection process will be similar to the one discussed at paragraph 53 above. However, I consider that the aural component will play an equal role with the visual one in that the consumer will seek advice from the retailers given the specialist nature of the goods being sold. I consider that the level of attention will be higher than medium (but not considerably so) on the basis that the consumer will still have the same considerations referred to at paragraph 53 above but may pay particular focus to the expertise of the retailer, therefore, slightly increasing the level of attention paid.

Comparison of marks

55. 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.




56. 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.”

57. 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.

58. The respective trade marks are shown below:

The opponent's marks	The applicant's mark
 <p>("the opponent's first mark")</p>  <p>("the opponent's second mark")</p>	

59. The opponent's marks are identical and will, therefore, be considered together when making the following assessments.

Overall Impression

The applicant's mark

60. The applicant's mark consists of the words 'La Méduse' in a cursive typeface. In its counterstatement, the applicant provided detailed comments regarding the breakdown of its mark. The applicant stated that:

“The sign [...] has also a very strong figurative form.

A cursive letter 'L' written in a dark, fluid script.

A cursive letter 'é' written in a dark, fluid script.

A cursive letter 's' written in a dark, fluid script.

61. Firstly, the average consumer normally perceives a mark as a whole and does not proceed to analyse their various details. I do not consider that the average consumer will dissect marks to the point where they would be assessing each letter as proposed by the applicant. Further, while the comments are noted, I do not consider the stylisation used in the applicant’s mark is anything other than the application of a fairly standard cursive font. The typeface used will, in my view, have very little trade mark significance. Turning to the word element, for reasons that I will come to discuss in my assessment of the conceptual comparison of the marks below, I find that ‘Méduse’ plays a greater role in the overall impression of the mark with ‘La’ playing a lesser role. As for the typeface used, I am of the view that this plays a minimal role.

The opponent marks

62. The opponent’s marks are made up of a word and device element. The applicant states that the device element “could be described as an ink stain in the form of a star”. While I accept it may be seen as an ink stain, I do not consider that it will be seen as a star. Further, the applicant states that the device element is “very atypical and unexpected for describing products and services for which the [...] trademarks have been registered.” I do not consider this to be the case. In my view, the average consumer is accustomed to seeing different shapes in trade marks and I do not consider that it will be seen as unexpected.

63. As for the word element, the applicant states that:

“The “police” used in the earlier trademark is very particular and uncommon.



64. While the stylisation used within the mark does appear as if it is someone’s handwriting, I do not consider that the typeface used is particularly remarkable and find that it has very little trade mark significance. Further, I am of the view that despite the comments regarding the specific letters referred to, they will, in the context of the mark as a whole, be viewed as the letters ‘d’ and ‘s’. Therefore, I find that the word will be easily recognisable by the average consumer as the word ‘méduse’. Overall, as the average consumer is drawn to the parts of marks that can be read, I consider that the word ‘méduse’ plays a greater role in the overall impression of the mark with the device element playing a lesser role and the typeface used playing a minimal role.

Visual Comparison

65. While it is displayed in title case in the applicant’s mark and lower case in the opponent’s, both marks share the word ‘méduse’. The device element in the opponent’s marks is not present in the applicant’s mark and the word ‘La’ in the applicant’s mark is not present in the opponent’s marks. While these elements play lesser roles, they still constitute visual differences. Further, the typefaces used in the marks are also different. However, given the roles the typefaces play in the marks, I consider this difference will be overlooked, so too will the use of title/lower

case. Given that the word 'méduse' plays the greater role in the overall impression of both marks, I am of the view that the marks are visually similar to a high degree. Even if I am wrong and the use of typeface is not overlooked, I do not consider it will alter my finding of high similarity between the marks.

Aural Comparison

66. I have no submissions as to the pronunciation of either mark. Firstly, the device element in the opponent's marks will not be pronounced. Secondly, while I note that both parties' marks contain an accent above the first 'e', I do not consider that the average consumer will understand this and will not factor it into their pronunciation of the marks. In my view, the applicant's mark consists of three syllables that will be pronounced 'LA-MEH-DEUCE' whereas the opponent's marks consist of two syllables that will be pronounced 'MEH-DEUCE'. Overall, I find that the marks are aurally similar to a high degree.

Conceptual Similarity

67. I have submissions from both parties that 'méduse' means jellyfish in French. On this point, the opponent refers to the UK IPO's Examination Guide and submits that French is one of the most widely understood European languages in the UK and "whilst the majority of UK consumers cannot be assumed to be fluent, most of them will have an appreciation of some of their more common words" (the opponent's emphasis). While these submissions are noted, I do not consider 'méduse' to be a common word that will be understood by the average consumer in the UK. Instead, it will simply be seen as a foreign language word with no obvious meaning. This applies to the use of the word in both marks.

68. As for the device element in the opponent's marks, I do not consider that this will have any concept to the average consumer and will, instead, be seen as purely decorative. The concept of the opponent's marks is, therefore, dominated by the word 'méduse'.

69. Turning to the applicant's mark, I refer to the section of the UK IPO's Examination Guidance discussed at paragraph 67 above. In respect of the word 'La', I am of the view that a majority of average consumers will have an appreciation for this word and understand it as meaning 'the' in a foreign language, be that French, Spanish or Italian. It, therefore, has no conceptual impact on the mark. As a result, the marks are, conceptually, dominated by the word 'méduse' which, as set out above, will be understood as a foreign language word with no obvious meaning. Given that no meaning will be attributed to either mark, I consider them to be conceptually neutral.

Distinctive character of the opponent's marks

70. 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).”

71. Registered trade marks possess various 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 opponent has not submitted that the distinctive character of its marks have been enhanced through use and, in any event, has not filed any evidence to that effect. Therefore, I have only the inherent position to consider.

72. The opponent's marks are identical and consist of the word 'méduse' and a decorative device element of what I consider will be seen as an ink stain. The word 'méduse' is the dominant and distinctive element of the mark. It will be seen as a foreign language word that will have no obvious meaning to the average consumer in the UK. In the context of the goods for which the opponent's marks are registered, I do not consider that it has any descriptive or allusive qualities. While this may be the case, I do not consider that the use of a foreign language word is particularly remarkable and find that, overall, the opponent's marks enjoy a medium degree of inherent distinctive character.

Likelihood of confusion

73. I have found all of the applicant's goods and services to range from being identical to similar to a very low degree to the goods in the opponent's marks' specifications. I have found the average consumer for the goods and services to be both members of the public, medical professionals and business users. I have found that the majority of goods and services will be selected through primarily visual means (although I do not discount an aural component) and that some services will be selected both visually and aurally. I have concluded that the average consumer will generally pay a medium degree of attention but that this may extend to a higher than medium (but not considerably so) degree for some of the services.

74. I have found applicant's mark to be visually and aurally similar to a high degree and conceptually neutral with the opponent's marks. I have found that the opponent's marks enjoy a medium degree of inherent distinctive character. I have

taken these factors into account in my assessment of the likelihood of confusion between the marks.

75. I have found the word 'méduse' to be the element of the parties' marks that plays a greater role in their overall impressions. Taking all of the above factors and the principle of imperfect recollection into account, I consider that the device element, the stylistic differences in the typefaces used and the word 'La' in the marks will be overlooked or misremembered meaning that the average consumer is likely to mistake the parties' marks for one another. Consequently, I consider that there is a likelihood of direct confusion between the marks. I consider that this finding will apply to those goods and services that I have found to be similar to a medium degree and above and in circumstances where the average consumer may pay a higher than medium degree of attention. In respect of those goods and services that I have found to be similar to a low degree, I consider that the high degree of visual and aural similarity between the marks will off-set the low similarity between those goods and services. As a result, my finding of direct confusion applies to those services also. However, I do not consider that the high similarity will off-set those goods that I have found similar to a very low degree. For those goods, there is no likelihood of confusion. In the event that I am wrong on my finding of direct confusion, I will proceed to consider indirect confusion.

76. Indirect confusion involves recognition by the average consumer of the difference between the marks. In the present case, even if the average consumer notices the differences between the marks, the shared common element of 'méduse' remains the dominant element of both marks. As a result, I am of the view that the differences will be seen by the average consumer as indicative of an alternative mark from the same or economically linked undertakings.⁷ Further, I consider it likely that the average consumer will consider that the removal of 'La' from the opponent's marks, the addition of the device element and the different typefaces used are all consistent with a rebranding. Consequently, I consider there to be a likelihood of indirect confusion between the marks on those goods and services that I have found to be similar to a medium degree and above and in circumstances where the average consumer may pay a higher than medium degree of attention.

⁷ Paragraphs 16 & 17 of *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

As per my findings at paragraph 75 above, I consider that this finding will also apply to those goods and services that I have found to be similar to a low degree but not those goods that I have found similar to a very low degree.

CONCLUSION

77. The opposition succeeds in part. In respect of the following goods and services, the application is refused:

Class 10: Masks for use by medical personnel; Sanitary masks for medical purposes; Gloves for medical purposes; Sanitary masks for dust prevention for medical purposes; Sanitary masks for dust isolation for medical purposes; Medical gowns; Surgical gowns; Boots for medical purposes; Sterile sheets, surgical.

Class 25: Clothing; Footwear; headwear; Shoes; Football shoes; Football boots; Caps being headwear; Hosiery; Gloves [clothing]; Pelerines; Belts [clothing]; Underwear; Underclothing; Sports jerseys; Skirts; Pants; Trousers.

Class 26: Shoe trimmings; Brassards; arm bands [clothing accessories].

Class 35: Retail services in relation to headgear; Retail services in relation to footwear; Online retail store services in relation to clothing; Retail services in relation to clothing; Online retail services relating to clothing; Retail services in relation to clothing accessories; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.

78. In respect of the following goods and services, the application may proceed to registration:

Class 10: Ultraviolet ray lamps for medical purposes.

- Class 16: Paper; washi; tracing paper; Papers for painting and calligraphy; advertisement boards of paper or cardboard; Blueprints; plans; posters; Aquarelles; watercolors [paintings]; hat boxes of cardboard; greeting cards.
- Class 26: Lace for edgings; lace trimmings; passementerie; Embroidery; fancy goods [embroidery]; hat trimmings; fastenings for clothing; ribbons for the hair; ornamental novelty badges [buttons].
- Class 35: Retail services in relation to medical instruments; Wholesale services in relation to medical instruments; Sales promotion services; Commercial administration of the licensing of the goods and services of others; Business management and administration; Advertising; Outdoor advertising; Rental of advertising space; Import-export agency services; Production of advertising films; Production of advertising materials; Sales promotion for others; Rental of billboards [advertising boards]; Presentation of goods on communication media, for retail purposes.

COSTS

79. Both parties have achieved an equal measure of success in these proceedings. I do not, therefore, consider it appropriate to make an award of costs in favour of either party. Therefore, I order that both parties bear their own costs.

Dated this 15th day of November 2021

A COOPER
For the Registrar