

O-123-16

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL REGISTRATION NO. 1216835

IN THE NAME OF MOLOGEN AG

TO REGISTER:

DNABarrier

IN CLASSES 1 & 5

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 403529 BY MÖLNLYCKE HEALTH CARE AB**

BACKGROUND & PLEADINGS

1. On 17 June 2014, Mologen AG (“the applicant”) requested protection in the United Kingdom of the International Registration (“IR”) of the trade mark shown on the cover page of this decision. The United Kingdom Trade Marks Registry (“TMR”) considered the request satisfied the requirements for protection and particulars of the IR were published on 3 October 2014 for the following goods:

Class 1 - Chemicals used in industry and science, in particular proteins, enzymes and nucleic acids, as well as derivatives and/or chemical modifications and/or combinations thereof; gold salts for use in gene therapy.

Class 5 - Medicines; pharmaceutical, chemical, veterinary and medical preparations for sanitary and medical purposes; pharmaceutical substances for gene therapy; biological preparations for medical purposes; vaccines.

2. The designation of the IR is opposed by Mölnlycke Health Care AB (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition, which is directed against all of the goods in the IR, is based upon the goods (shown below) in the following national and Community Trade Marks (“CTM”):

No. 1036866 for the trade mark: **BARRIER** which was applied for on 18 October 1974:

Class 10 - Surgical and medical instruments, apparatus and appliances; but not including contraceptive appliances or any goods of the same description as contraceptive appliances.

No. 961329 for the trade mark: **BARRIER** which was applied for on 22 June 1970:

Class 24 - Surgical drapes, being textile piece goods.

No. 969437 for the trade mark: **BARRIER** which was applied for on 29 December 1970:

Class 25 - Gowns for surgical or medical use.

CTM No. 7155559 for the trade mark: **BARRIER** which was applied for on 12 August 2008 and which was entered in the register on 25 August 2009:

Class 10 – Surgical gloves.

CTM No. 2500809 for the trade mark: **BARRIER** which was applied for on 14 December 2001 and which was entered in the register on 5 August 2004:

Class 5 - Medical and surgical plasters, adhesive material for medical and surgical purposes, disinfectants, compresses, surgical dressings, material for dressings, material for protecting wounds, articles for bandaging, articles for

holding bandages in place, swabs, sponges and abdominal towels for medical and surgical use.

Class 10 - Surgical drapes, surgical sterile sheets, surgical gloves and surgical face masks, surgical and medical apparatus and instruments, receptacles for applying medicines; drapes for operation tables, napkins of textile material and linen for hospital and medical use; protective drapes of paper for medical purposes.

Class 16 - Paper and paper articles, disposable pads of cellulose or paper.

Class 24 - Bed and table covers of paper.

Class 25 - Clothing, footwear, headgear all for surgical and medical use.

3. In its Notice of Opposition, the opponent states:

“The later mark, DNABarrier, is visually, phonetically and conceptually similar to the earlier trade mark, BARRIER. Both marks contain the identical BARRIER suffix so that the earlier mark is contained in its entirety within the later application. Therefore, there is a real possibility that the activities under the later mark will be perceived as being in some way connected with or related to those under the earlier mark...

The goods of the application are similar to those of the registration[s] because they could be used in the same medical/surgical environment as those of the earlier trade mark such that the mark could appear in close proximity with each other.

The possibility of a likelihood of confusion is increased due to the enhanced distinctive character of the earlier mark through its use to date in the UK.”

4. The applicant filed a counterstatement in which the basis of the opposition is denied. Having indicated that it does not put the opponent to proof of use, it states:

“8.3. The applicant denies that the goods of the application are similar to the goods of any opposition mark and puts the opponent to proof of its assertions to the contrary.

8.7 The applicant notes that the opposition is misguided, misinformed and embarrassing and requests that the maximum award of costs be made in its favour.”

5. Although only the opponent filed evidence, the applicant filed written submission during the course of the evidence rounds. Whilst neither party asked to be heard, the

opponent filed written submissions in lieu of attendance at a hearing. I will bear all of these submissions in mind and refer to them, as necessary, later in this decision.

The opponent's evidence

6. This consist of a witness statement from Shawna Traynor, the opponent's General Counsel, Americas; Ms Traynor has held this position since 2005. She states:

“5. Molnlycke is a world-leading provider of single-use surgical and wound care products for customers, healthcare professionals and patients. Molnlycke develops and brings to market innovative wound care and surgical products along the entire continuum of care – from prevention to post-acute settings. Molnlycke solutions provide value for money, supported by clinical and health economic evidence.”

7. Ms Traynor explains that:

“9. Molnlycke's BARRIER brand relates to products which are designed to ensure the best possible safety and comfort to both patients and medical staff. The brand is used in relation to a range of drapes, surgical gowns, surgical masks, surgical headwear and scrub suits.”

8. Exhibit 5 consists of pages downloaded from www.molnlycke.com/barrier on 8 September 2015 i.e. after the filing date of the IR the subject of these proceedings. Under the heading “BARRIER range offers optimal protection and functionality” the goods mentioned by Ms Traynor are identified. The following also appears within the body of the introductory text:

“...and scrub suits offering an optimal barrier against microbial migration to the...”

On page 30 of exhibit 5, the following appears:

“BARRIER® is Europe's leading brand in single use surgical drapes. The range of high quality surgical drapes is developed to provide the best possible barrier against bacterial migration in all surgical procedures...”

9. Exhibit 6 consists of what Ms Traynor describes as:

“10...the most up-to-date versions of the product and marketing literature distributed in the UK in relation to the BARRIER branded products.”

10. Exhibit 6a consists of product literature in relation to BARRIER branded “drapes and sets of drapes” which bear copyright dates of 2014 and 2015. Exhibit 6b consists of what Ms Traynor describes as “a consolidated list of supplementary products for the drapes provided under the BARRIER brand.” The undated pages provided contain

references to items such as an “irrigation pouch”, a “foot cover”, a “fluid collection pouch”, a “circular banded bag” and a “cellulose towel.” Exhibits 6c to 6f consists of lists of these supplementary products which have been provided under the BARRIER brand to Nuffield Health, Spire Healthcare, Ramsay Health Care and BMI Healthcare. I infer from the copyright date which appears on page 119 of exhibit 6c that these pages are from 2014. Exhibits 6g to 6j consist of, inter alia, product literature for what Ms Traynor describes as “surgical gowns”, “surgical face masks”, “surgical headwear” and “scrub suits” which have been provided under the BARRIER brand. Although indistinct, a number of the pages provided appear to bear copyright dates of 2012, 2013 and 2014.

11. Ms Traynor states that in the period 2004-2014 “actual net external sales for BARRIER branded products in the UK” amounted to (rounded):

2004 - £30m	2010 - £24.6
2005 - £32.9m	2011 - £22.5m
2006 – £30.1m	2012 – £21.2m
2007 – £28.5m	2013 - £21.7m
2008 - £27.3m	2014 - £21.7m
2009 - £26.2m	Total - £286.7m

12. Ms Traynor concludes that the above sales combined with the fact that the BARRIER brand has been used “in the UK for at least the last 40 years” results in the opponent’s trade mark having an enhanced degree of distinctive character.

13. That concludes my review of the evidence filed, to the extent that I consider it necessary.

DECISION

14. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

“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.”

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

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

(a) a registered trade mark, 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

16. In these proceedings, the opponent is relying upon the trade marks shown in paragraph 2 above, all of which qualify as earlier trade marks under the above provisions. As all of these trade marks completed their registration process more than 5 years before the publication date of the IR in suit they are, in principle, subject to proof of use, as per section 6A of the Act. However, as the applicant has not asked the opponent to provide proof of use, the opponent is entitled to rely upon all of the goods it has identified.

Section 5(2)(b) – case law

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The approach to the comparison

18. All of the earlier trade marks upon which the opponent relies consist of the word BARRIER presented in upper case. As the specification of CTM no. 2500809 contains the broadest specification of goods (a specification which includes all the goods contained in the other registrations), it is on the basis of this registration that I will conduct the comparison; if the opponent fails in relation to this registration it will be in no better position in relation to the other trade marks upon which it relies. Proceeding on this basis, the competing goods are as follows:

Opponent's goods	Applicant's goods
Class 5 - Medical and surgical plasters, adhesive material for medical and surgical purposes, disinfectants, compresses, surgical dressings, material for dressings, material for protecting wounds, articles for bandaging, articles for holding bandages in place, swabs, sponges and abdominal towels for medical and surgical use.	Class 1 - Chemicals used in industry and science, in particular proteins, enzymes and nucleic acids, as well as derivatives and/or chemical modifications and/or combinations thereof; gold salts for use in gene therapy.

<p>Class 10 - Surgical drapes, surgical sterile sheets, surgical gloves and surgical face masks, surgical and medical apparatus and instruments, receptacles for applying medicines; drapes for operation tables, napkins of textile material and linen for hospital and medical use; protective drapes of paper for medical purposes.</p> <p>Class 16 - Paper and paper articles, disposable pads of cellulose or paper.</p> <p>Class 24 - Bed and table covers of paper.</p> <p>Class 25 - Clothing, footwear, headgear all for surgical and medical use.</p>	<p>Class 5 - Medicines; pharmaceutical, chemical, veterinary and medical preparations for sanitary and medical purposes; pharmaceutical substances for gene therapy; biological preparations for medical purposes; vaccines.</p>
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19. 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 of its judgment 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”.

20. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

21. In *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."

22. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("GC") 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".

24. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

25. Finally, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the 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”.

26. In its Notice of Opposition, the opponent stated:

“The goods of the application are similar to those of the registration[s] because they could be used in the same medical/surgical environment as those of the earlier trade mark such that the mark could appear in close proximity with each other.”

In its counterstatement, the applicant stated:

“8.3. The applicant denies that the goods of the application are similar to the goods of any opposition mark and puts the opponent to proof of its assertions to the contrary.”

27. In my view, the opponent’s claim lacks specificity. It is based upon the general proposition that the competing goods could be used in “close proximity” to one another in, I assume, an environment such as a hospital. In relation to the applicant’s specification in class 1, the words “in particular” and “as well as” have no limiting effect. Consequently, while the applicant’s specification must be interpreted as relating to chemicals used in industry and science at large, the goods which follow this phrase i.e. “proteins, enzymes and nucleic acids” and “derivatives and/or chemical modifications and/or combinations thereof” and the presence of “gold salts for use in gene therapy” are, in my view, likely to be indicative of the actual goods of interest to the applicant. Insofar as class 5 is concerned, the applicant has applied for medicines as well as pharmaceutical, chemical, veterinary, medical and biological preparations; there are also references to “pharmaceutical substances for gene therapy” and “vaccines.” The opponent’s goods in classes 10 and 25 are all for surgical or medical use, whereas its goods in classes 16 and 24 are unlimited. Having considered the relevant factors

outlined above i.e. nature, users, trade channels, intended purpose, method of use and competitive/complementary leanings, I am unable to detect, in the absence of more precise submissions from the opponent to assist me and notwithstanding that the competing goods may, in very general terms, be used in a medical environment, any meaningful degree of similarity between the applicant's goods in classes 1 and 5 and the opponent's goods in classes 10, 16, 24 and 25.

28. That leaves the opponent's goods in class 5 for me to compare with the applicant's goods in classes 1 and 5. The opponent's goods in this class consist of a range of medical and surgical plasters, surgical dressings and articles for bandaging, compresses, adhesive material for medical and surgical purposes and disinfectants, swabs, sponges and abdominal towels. Even if, despite my comments above regarding the broad scope of the applicant's goods in class 1, I proceed on the basis that all of the applicant's goods in this class are intended for medical purposes, and I assume that the users and trade channels may be the same, the physical nature of the competing goods, their intended purpose and method of use are, once again, quite different. The respective goods are not competitive and there is no complementary relationship between them. Considered overall, there is, in my view, no meaningful degree of similarity between the opponent's goods in class 5 and the applicant's goods in class 1.

29. Finally, I turn to the applicant's goods in class 5. As "disinfectants" in class 5 of the earlier trade mark are, in my view, included within the general phrase "pharmaceutical, chemical, veterinary and medical preparations for sanitary and medical purposes" in the application, the competing goods are identical on the *Meric* principle (I shall return to this point later in this decision). I note that collinsdictionary.com defines "compress" as:

"a wet or dry cloth or gauze pad with or without medication, applied firmly to some part of the body to relieve discomfort, reduce fever, drain a wound, etc."

30. That definition supports my own experience that goods such as "medical and surgical plasters", "surgical dressings", "materials for dressings" and "materials for protecting wounds", routinely incorporate some form of medication; medication which would be encompassed by many of the goods in the applicant's specification. The users of the respective goods may be the same as may the channels of trade. Whilst the physical nature of the goods and method of use may be different, the intended purpose may be the same i.e. to aid recovery, manage pain etc. Whilst there may be an element of competition between these goods (one might be used instead of the other), there is, more likely in my view, a complementary relationship in the sense that some of the applicant's goods may be used in conjunction with the opponent's goods in such a way that the relevant public may believe that the responsibility for the respective goods lies with the same undertaking. Bearing in mind the similarity in the users, trade channels and the (at least) complementary relationship that is likely to exist, there is, in my view, a moderate degree of similarity between the opponent's goods in class 5 I have identified above and the majority of the applicant's goods in the same class. However, although the users and trade channels of the opponent's goods in class 5 and the applicant's "pharmaceutical substances for gene therapy" and "vaccines" may be the

same, as may, at a very general level, the intended purpose, the nature and method of use are likely to be quite different and I can discern no competitive or complementary relationship between the goods. If these latter named goods are similar to the opponent's goods, in class 5, it must, in my view, be at a fairly low level. I shall return to these conclusions when I consider the likelihood of confusion.

The average consumer and the nature of the purchasing act

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

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

32. In *Mundipharma AG v OHIM*, Case T-256/04, the GC accepted that there were two groups of relevant consumers for a pharmaceutical product, professional users and the general public.

33. The average consumer of the applicant's goods in class 1 and the opponent's goods in classes 10 and 25 is most likely to be a professional user most likely working in either the medical or a closely allied field. In relation to the opponent's unlimited goods in classes 16 and 24, the average consumer is a member of the general public. As to the parties' goods in class 5, as the above case law makes clear the average consumer may be either a member of the general public or a professional user. However, in relation to “abdominal towels” in the opponent's specification and “pharmaceutical substances for gene therapy” and “vaccines” in the applicant's specification, the average consumer is most likely to be a professional user. As to how these various goods will be selected, a member of the general public is most likely to acquire the goods in classes 16 and 24 by self-selection in either a physical store or the on-line equivalent; as such, visual considerations are likely to dominate the selection process. As to the goods in class 5, these may be acquired in the same manner or, for example, on prescription from a professional user. I do not discount aural considerations in relation to either category of goods, but particularly in relation to the goods in class 5 where such goods may only be available upon request, or having first sought advice from a professional user such as a pharmacist. The degree of care a member of the public will display when selecting such goods is likely to vary, from relatively low in relation to inexpensive goods such as disposable pads and bed and table covers to

relatively high in relation to goods in class 5, which although not terribly expensive, may be used on the person or ingested in order to treat a particular ailment.

34. As to how a professional user will acquire the goods for which they are the average consumer, although the evidence provided suggests that in relation to the goods in classes 10 and 25 the process may be primarily visual (with products selected from brochures, promotional material and the like), I do not rule out aural considerations as such goods may also, for example, be ordered by telephone. I have no evidence as to how a professional user will select the goods in classes 1 and 5. However, I think it likely that professional users such as doctors and pharmacists etc. will obtain the goods having inspected, for example, specialist publications and brochures (whether in hard copy or on-line) provided by, for example, companies specialising in such goods or as a result of, for example, face-to-face meetings with sales representatives representing such companies. As a consequence, the process is likely to consist of a mixture of visual and aural considerations. I would expect a professional user to pay a high degree of attention to the selection of the goods in classes 1 and 5.

Comparison of trade marks

35. It is clear from *Sabel BV 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. 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.”

36. It would be wrong, therefore, artificially to dissect the trade marks, 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 trade marks. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
BARRIER	DNABARRIER

37. As the opponent's trade mark consists exclusively of the well-known English language word BARRIER the meaning of which i.e. “anything serving to obstruct

passage or to maintain separation, such as a fence or gate” (collinsdictionary.com refers) would also be well known, that is where its distinctiveness lies and is the overall impression it will convey.

38. The applicant’s trade mark consists of the letters “DNAB” presented in upper case followed by the letters “arrier” presented in lower case. Although the average consumer is unlikely to know that DNA is an abbreviation for deoxyribonucleic acid, I have little doubt that the average consumer will be familiar with the letters DNA as meaning (broadly speaking) something (for example a chemical) containing genetic information which is found in all living cells. As the word Barrier, as I mentioned above, will be very well known to the average consumer, it will, despite the presentation, identify this word within the trade mark as a whole and will, as a consequence, construe the applicant’s trade mark as DNA Barrier. The distinctiveness and overall impression the applicant’s trade mark conveys stems from the unit it creates rather than the elements of which it is made up.

39. The word BARRIER/Barrier constitutes the whole of the opponent’s trade mark and is an identifiable element (albeit as a suffix) of the applicant’s trade mark. In my view, this results in a medium degree of both visual and aural similarity between them. As the competing trade marks consist of or contain the word BARRIER as an identifiable element, there is also, to that extent, a degree of conceptual similarity. However, as the inclusion of the abbreviation DNA in the applicant’s trade mark creates a totality/unit which will be construed differently to the word BARRIER alone, the overall degree of conceptual similarity is, in my view, medium at best.

Distinctive character of the earlier trade mark

40. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

41. Earlier in this decision (paragraph 37) I provided a definition of the word BARRIER and highlighted some examples from the opponent’s own evidence of this word being used in what appears to be a descriptive manner (paragraph 8). Absent use, the word BARRIER has, in my view, very little distinctive character in relation to the vast majority of the goods upon which the opponent relies. However, the opponent’s evidence indicates that in the period 2004 to 2014, it achieved “actual net external sales for BARRIER branded products in the UK” of some £287m. Although these turnover figures have not been split by class, it is clear that the opponent has conducted a trade in the

United Kingdom under its BARRIER trade mark in relation to what Ms Traynor describes as:

“9...a range of drapes, surgical gowns, surgical masks, surgical headwear and scrub suits”.

42. In its written submissions, the applicant states:

“The [opponent] was not able to identify any documents relating to surgical and medical instruments, apparatus in class 10 and medical and surgical plasters, disinfectants in class 5.”

And:

“Taking the provided documents into account, the opponent’s trade mark shall protect goods for surgical purposes, like surgical masks, headwear, suits, gowns, tape, drapes, bags and drains.”

43. The opponent’s principal use of its BARRIER trade mark has been in relation to those goods identified by Ms Traynor mentioned above; goods which are proper to classes 10 and 25. As I have already concluded that the opponent’s goods in, inter alia, these classes have no meaningful degree of similarity to the applicant’s goods in classes 1 and 5, any enhanced distinctive character the opponent’s BARRIER trade mark may have acquired as a result of the use made of it in relation to such goods does not assist the opponent. Absent the provision of turnover figures on a class-by-class basis and as the opponent’s evidence suggests that it has made very little (if any) use of its BARRIER trade mark in relation to the goods in class 5, I must treat its BARRIER trade mark as unused. Considered on that basis in relation to the goods in class 5, many of which may, for example, act as a physical barrier or may prevent the transmission of infection, the word BARRIER is, in my view, possessed of, at best, a very low degree of inherent distinctive character.

Likelihood of confusion

44. In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision I concluded, inter alia, that:

- there is no meaningful degree of similarity between the opponent's goods in classes 10, 16, 24 and 25 and the applicant's goods;
- there is no meaningful degree of similarity between the opponent's goods in class 5 and the applicant's goods in class 1;
- "disinfectants" in class 5 of the earlier trade mark are, identical to "pharmaceutical, chemical, veterinary and medical preparations for sanitary and medical purposes" in the application on the *Meric* principle;
- there is a moderate degree of similarity between various goods in the opponent's specification in class 5 and the majority of the applicant's goods in the same class and at best a fairly low level of similarity with the applicant's "pharmaceutical substances for gene therapy" and "vaccines" in class 5;
- insofar as it is relevant, the opponent's earlier trade mark is possessed of, at best, a very low degree of inherent distinctive character.

45. In reaching a conclusion, I remind myself of the CJEU's guidance in *Formula One Licensing BV v OHIM*, Case C-196/11P, where it found that:

"41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii)".

46. Although I have found that the earlier mark has, at best, only a very low degree of distinctive character in relation to those goods that assist it, that does not, of itself,

preclude a finding of likelihood of confusion. In *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders”.

47. I have concluded that in relation to the vast majority of the goods at issue in these proceedings, the average consumer, be it a member of the general public or a professional user, will pay at least a relatively high degree of attention during the selection process; that will, of course, make them much less prone to the effects of imperfect recollection. However, even if the average consumer were to pay a somewhat lower degree of attention, the only similarity between the competing trade marks resides in an element i.e. BARRIER/Barrier which I have further concluded is, at best possessed of a very low degree of inherent distinctive character and which does not, in my view, play an independent and distinctive role in the applicant’s trade mark. In this regard, the comments of Arnold J in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) in which he considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*, are relevant.

48. In my view, the medium degree of visual, aural and conceptual similarity which results from a shared element which is, at best, very low in inherent distinctive character and which does not play an independent and distinctive role in the applicant’s trade mark, is insufficient to lead to a likelihood of either direct or indirect confusion. I reach that conclusion in relation to those goods I have concluded are identical on the *Meric* principle (although even in relation to that finding there may well be goods within the general phrase “pharmaceutical, chemical, veterinary and medical preparations for sanitary and medical purposes” which are either not similar at all or are similar to a lesser degree to the goods upon which the opponent relies). The position is even starker when considered in relation to those goods I have characterised as similar to only a moderate degree or in which there is, in my view, no meaningful degree of similarity. In relation to the latter, I considered approaching such goods on the basis that there was no similarity; in those circumstances, the test for likelihood of confusion would

not be engaged - as per the comments of the court in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA. However, in case I were to be found wrong in that regard, I have assumed there is some similarity, albeit very low.

49. Considered overall, I see no reason why an average consumer familiar with the word BARRIER and its meaning would, in relation to the goods at issue assume that goods provided under the applicant's trade mark (in which the word Barrier does not perform an independent and distinctive role), originate from the opponent or an undertaking linked to it. As a consequence of those conclusions, the opposition fails.

Conclusion

50. The opposition has failed and, subject to any successful appeal, the application may proceed to registration.

Costs

51. As the applicant has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the other side's statement:	£200
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Considering and commenting upon the other side's evidence/filing of written submissions:	£500
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Total:	£700
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52. I order Mölnlycke Health Care AB to pay to Mologen AG the sum of **£700**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of March 2016

C J BOWEN
For the Registrar
The Comptroller-General