

O/822/22

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NUMBERS 3581604 AND 3581583
BY OPTIMUM MEDICAL SOLUTIONS LIMITED
TO REGISTER:

OPTIPRE

IN CLASS 5

AND

OPTIPRO

IN CLASSES 5 AND 10

AND OPPOSITIONS THERETO UNDER NUMBERS 424956 AND 424970
BY JAMES BOYLAN SAFETY LIMITED

AND

IN THE MATTER OF APPLICATION NUMBER 3629307
BY JAMES BOYLAN SAFETY LIMITED
TO REGISTER:

OPTIPRO

IN CLASSES 9, 10 AND 25

AND AN OPPOSITION THERETO UNDER NUMBER 428857
BY OPTIMUM MEDICAL SOLUTIONS LIMITED

BACKGROUND AND PLEADINGS

Oppositions 424956 and 424970

1. On 19 January 2021, Optimum Medical Solutions Limited (“OMS”) applied to register the trade mark **OPTIPRE** (number 3581604) in the UK. The application was published for opposition purposes on 12 March 2021, in respect of the following goods:

Class 5 *Sanitising wipes; antibacterial wipes; impregnated medical wipes; hand sanitising preparations; medicated and sanitising soaps and detergents; antibacterial and sanitising sprays.*

2. Also on 19 January 2021, OMS applied to register the trade mark **OPTIPRO** (number 3581583) in the UK. The application was published for opposition purposes on 12 March 2021, in respect of the following goods:

Class 5 *Sanitising wipes; sanitising surface wipes, sanitising skin wipes, antibacterial wipes; impregnated medical wipes; hand sanitising preparations; medicated and sanitising soaps and detergents; antibacterial and sanitising sprays.*

Class 10 *Face shields for medical use; face shields for protection against infection; transparent face shields for use by medical personnel; medical gloves; surgical gloves; gloves for use in dentistry; latex and rubber gloves for medical use; protective gloves for use by persons working in medicine and dentistry; face masks for medical use; protective face masks for medical use; face masks for use in the prevention of infections; surgical face masks; respirators for medical use; disposable aprons for medical and surgical use; parts and fittings for all the aforesaid.*

3. On 14 June 2021, James Boylan Safety Limited (“JBS”) filed oppositions against the OPTIPRE and OPTIPRO applications, opposing them in full – OPTIPRE under sections 5(2)(a), 5(2)(b) and 5(4)(a) and OPTIPRO under 5(1), 5(2)(a) and 5(4)(a) of

the Trade Marks Act 1994 (“the Act”). JBS failed to file relevant evidence and so the 5(4)(a) ground was later struck out.

4. For both oppositions, JBS relies upon its earlier OPTIPRO mark (number 917895200),¹ which was filed on 3 May 2018 and registered on 11 October 2018. JBS relies upon the following goods:

Class 9 *Gloves for protection against accidents; bullet proof waistcoats; footwear for protection against accidents, irradiation and fire; eye glasses; Eyeglass frames; protective goggles; Protective helmets; protective headgear; protection devices for personal use against accidents; protective masks; protective suits for aviators; clothing especially made for laboratories; clothing for protection against accidents, radiation and fire; workman's protective face shields, headphones; ear buds.*

Class 25 *Clothing; footwear; headgear.*

5. Under section 5(1), JBS claims that its earlier mark is identical to the OPTIPRO application and the respective goods are identical. Under section 5(2)(a), JBS claims that its earlier mark is identical to both of OMS’ applications and that the respective goods are identical or similar. In the alternative, JBS claims that the OPTIPRE application should be refused under section 5(2)(b) as it is similar to its earlier mark.

6. OMS filed counterstatements to both oppositions on 18 January 2022 denying a likelihood of confusion on the basis of a lack of similarity between any of the goods. Opposition numbers 424956 and 424970 were subsequently consolidated.

¹ JBS initially relied upon a second earlier mark, number 906513964. As no evidence was filed and the mark was subject to proof of use, the mark was struck out and the proceedings continued in relation to earlier mark 917895200 only.

Opposition 428857

7. On 20 April 2021, JBS applied to register the mark **OPTIPRO** (number 3629307) in the UK. The mark was published for opposition purposes on 10 September 2021, in respect of goods in classes 9, 10 and 25.²

8. On 7 December 2021, OMS filed an opposition against JBS' OPTIPRO application under sections 5(1) and 5(2)(a). OMS opposes only class 10 of the application and relies upon its OPTIPRO application (number 3581583), which is the subject of opposition 424970. It claims the marks are identical and the goods are identical or similar, resulting in a likelihood of confusion.

9. JBS filed a defence on 10 February 2022 stating that it accepts the marks are identical but cannot comment on the identity or similarity of the goods until the extent of the earlier right becomes finite, i.e. the outcome of opposition 424970.

10. Opposition 428857 was subsequently consolidated with oppositions 424956 and 424970.

11. Both parties filed evidence, which I will summarise to the extent I consider it necessary. A hearing took place before me on 5 July 2022. OMS was represented by Mr Lee Curtis of HGF Limited and JBS by Mr Kieron Taylor of Swindell & Pearson Ltd.

EVIDENCE AND PRELIMINARY ISSUES

12. OMS filed evidence in the form of the witness statement of Lee Curtis, Partner and Chartered Trade Mark Attorney at HGF Limited, and its corresponding six exhibits (LMC1 – LMC6).

13. LMC1 and LMC2 are copies of the Nice Classification Guide for classes 9 and 10.

² These are listed in the Annex to this decision.

14. LMC3 is a copy of a webpage taken from the website of JBS, which was accessed on 20 March 2022. Mr Curtis submits that this has been filed to demonstrate the typical way in which JBS markets its goods. The way in which a party markets its goods is not relevant to the decision I am required to make in these proceedings, which is a notional assessment based on the parties' respective specifications.

15. LMC4 contains a copy of Form TM16 (Application to record a change of ownership) filed by Swindell & Pearson Ltd on 29 April 2021, requesting a change of ownership of trade mark numbers 917895200 (the earlier mark relied upon in oppositions 424956 and 424970), 906513964³ and 904339982⁴ from Alan Bruce to JBS, to be effective from 30 March 2021.

16. LMC5 contains a copy of an assignment deed dated 1 June 2021, detailing the aforementioned assignment from Alan Bruce to JBS.

17. LMC6 contains the two TM7a (Notice of threatened opposition) forms filed by the representatives of JBS on 11 May 2021 in relation to OMS' OPTIPRE and OPTIPRO applications.

18. Mr Curtis' witness statement is not clear, but it seems OMS are suggesting JBS were not the owners of the earlier mark when it filed the TM7a forms, which I will shortly address.

19. JBS filed evidence in reply to OMS' evidence in the form of the witness statement of Grattan Boylan, Director of JBS, accompanied by one exhibit (JB01). JB01 contains an assignment deed relating to the aforementioned assignment of three trade marks from Alan Bruce to JBS; the assignment deed is dated 30 March 2021. In his witness statement, Mr Boylan explains that the assignment document was first produced and signed on 30 March 2021 and that it was subsequently copied and re-signed on 1 June 2021 for the purposes of filing it at the EUIPO.

³ This mark is not being relied upon in these proceedings and will play no further part in my decision.

⁴ As above.

20. Given that evidence is not required to be filed with Form TM16, and that according to the Register, the effective date of assignment of trade mark number 917895200 from Alan Bruce to JBS was 30 March 2021, I am satisfied that JBS were the owners of the earlier right at the date of filing the TM7a forms. There is no uncertainty as to the ownership of the earlier mark relied upon in oppositions 424956 and 424970.

DECISION

21. Given the impact of opposition 424970 on opposition 428857, I will begin by assessing the oppositions by JBS against OMS' OPTIPRE and OPTIPRO applications.

THE OPPOSITION AGAINST THE OPTIPRE MARK (424956)

22. Sections 5(2)(a) and (b) of the Act state that:

“(2) A trade mark shall not be registered if because –

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

(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.”

Relevant law

23. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik*

Meyer & Co GmbH v Klijsen Handel B.V., Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.⁵

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;

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 upon 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.

(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 marks

24. The trade marks to be compared are as follows:

JBS' Earlier mark (917895200)	OMS' Contested mark (3581604)
OPTIPRO	OPTIPRE

25. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

26. The marks share the first six letters, consecutively: ‘OPTIPR’. The earlier mark ends with the letter ‘O’ and the contested mark ends with the letter ‘E’. The contested mark does not reproduce, without any modification, the earlier mark, nor is the difference between the last letter of the marks so insignificant that consumers would see the marks as identical. I do not consider the marks to be identical and so the opposition based on section 5(2)(a) must fail. I will, however, proceed to consider the section 5(2)(b) ground.

27. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:

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

28. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

29. The earlier mark consists solely of the word 'OPTIPRO', the overall impression of which rests in the one word itself. The same applies to the contested mark 'OPTIPRE'.

Visual comparison

30. The marks coincide in the first six letters OPTIPR-, creating the visual similarity. The earlier mark ends -O and the contested mark -E, creating a minor difference. Overall, I find a very high degree of visual similarity between the marks.

Aural comparison

31. Both marks consist of three syllables, the first two of which are identical – 'OP' and 'TEE'. The final syllables of the marks differ – likely pronounced 'PRO' in the earlier mark and 'PREY' in the contested mark. Overall, I find a high degree of aural similarity between the marks.

Conceptual comparison

32. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court ("GC") and the CJEU including *Ruiz Picasso v OHIM*.⁶ The assessment must be made from the point of view of the average consumer.

33. Consumers may see in the marks the letters 'OPTI' as relating to the eyes or vision, though OPTI is not a dictionary-defined word in the English language. In the contested mark, the combination of 'OPTI' and 'PRE' creates an invented word with no clear meaning.

34. In the earlier mark, consumers may see the letters 'PRO' as an informal noun short for 'professional'. Combined with 'OPTI', the earlier mark may convey the message of goods used by professionals that relate to the eyes or vision. In the alternative, such

⁶ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

a concept may involve too strained a thought-process, with consumers simply seeing 'OPTIPRO' as an invented word with no clear meaning.

35. I am of the view that consumers will not immediately grasp a conceptual message from OPTIPRE. In terms of OPTIPRO, consumers will either think of goods used by professionals that relate to the eyes or vision, or they will not immediately grasp a concept. To conclude, the marks are either conceptually dissimilar or conceptually neutral.

Distinctive character of the earlier mark

36. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *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).”

37. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

38. I have no evidence from JBS from which to make an assessment as to an enhanced distinctive character and so I will assess only the inherent distinctive character of the earlier mark. It consists of the word OPTIPRO. As discussed in the conceptual comparison, above, the average consumer may perceive the word as invented, albeit, because of the commonplace use of 'OPTI' in words relating to the eyes or vision and of 'PRO' as short for 'professional', it may, for some consumers, be suggestive of goods relating to the eyes or vision and used by professionals. The specification of JBS' registration does not actually contain such goods, the result being that the mark is not descriptive or allusive for the goods for which it is registered. Overall, I consider that the mark has a medium to high degree of inherent distinctive character.

Comparison of goods

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

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

40. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

41. Further, in *Kurt Hesse v OHIM*,⁷ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*,⁸ the GC stated that “complementary” means:

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

42. In *Gérard Meric v OHIM*, the GC confirmed that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):⁹

“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”.

43. I bear in mind that it is permissible to group goods/services together for the purposes of assessment: *Separode Trade Mark*:¹⁰

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same

⁷ Case C-50/15 P

⁸ Case T-325/06

⁹ Case T-133/05

¹⁰ BL O/399/10

reasons, the decision taker may address them collectively in his or her decision.”

44. Section 60A of the Act is also relevant, which states that:

“(1) For the purposes of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear to be in the same class under the Nice Classification,

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

45. The competing goods are shown in the table below:

Earlier mark (JBS)	Contested mark (OMS)
<i>Class 9: Gloves for protection against accidents; bullet proof waistcoats; footwear for protection against accidents, irradiation and fire; eye glasses; Eyeglass frames; protective goggles; Protective helmets; protective headgear; protection devices for personal use against accidents; protective masks; protective suits for aviators; clothing especially made for laboratories; clothing for protection</i>	<i>Class 5: Sanitising wipes; antibacterial wipes; impregnated medical wipes; hand sanitising preparations; medicated and sanitising soaps and detergents; antibacterial and sanitising sprays.</i>

<i>against accidents, radiation and fire; workman's protective face shields, headphones; ear buds.</i>	
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Class 25: <i>Clothing; footwear; headgear.</i>	
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46. At the hearing, Mr Taylor for JBS argued that JBS' goods in class 9 are similar to OMS' goods in class 5 on the basis that they could all be sold by the same provider, i.e. an undertaking selling gloves and face masks, particularly when considering the matter from the perspective of personal protective equipment ("PPE"), may also sell antiseptic wipes.

47. Mr Curtis for OMS contends that the goods are not similar: that their nature, use and purpose are different, with OMS' goods being liquids, sprays and wipes used for sanitising and JBS' goods being items of industrial protection wear for the body to protect against accidents. Mr Curtis went on to argue that the *Treat* case prevents a finding of similarity between goods purely on the basis that one undertaking may sell both groups of goods; he referred to "traditional supermarkets" as an example. I was also referred to the decision of the EUIPO Opposition Division in *Synoptis Pharma Sp. Z O.O v Anteo Medical B.V.* in which the decision taker found no similarity between protective clothing, masks and goggles in class 9 and pharmaceutical and sanitary goods in class 5.¹¹

48. Whilst I understand Mr Curtis' argument between sanitising liquids, sprays and wipes and industrial protection wear, it is crucial that I consider the core meaning of the actual terms listed in the parties' specifications and the protection afforded to those terms rather than grouping all the goods together and referring to them under one broad category. I do, however, consider it is appropriate, in line with *Separode*, to group OMS' class 5 goods for the purpose of the comparison: they are all sanitising preparations.

¹¹ OMS accepts that decisions of the EUIPO can only be of guidance to the UKIPO. See its Skeleton Arguments at [9].

49. *Protective masks* in JBS' specification is not limited in any way to a particular industry or field, or to a particular purpose; it is a broad term which, regardless of its class, would cover all types of masks designed to protect the user, whether that protection is against accidents, disease, pollution or inhalants, for example. *Protective masks* clearly have a different physical nature and method of use to OMS' sanitising preparations. They are unlikely to be in competition, nor are they complimentary in line with the case law. However, the goods may overlap somewhat in their purpose: for preventing the spread of disease, resulting in an overlap in end users. They may also be offered in the same premises and, in some circumstances, in the same aisles, likely sharing trade channels. I acknowledge that this assessment may not extend to all types of protective masks – in particular, industrial-style masks referred to by OMS. However, JBS' term is not limited to this sub-category of masks; it has protection for the broad term *protective masks*. Overall, I consider OMS' class 5 goods to be similar to a low degree to JBS' *protective masks*. I consider this to be JBS' best case; none of the remaining terms in JBS' specification would have a higher degree of similarity with OMS' goods.

The average consumer and the nature of the purchasing act

50. 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 the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

51. JBS submits that the average consumer is a member of the general public;¹² OMS has not made submissions on the point. I consider there to be two groups of average consumers: members of the general public or professionals in the medical (or similar) industries. For both groups of consumers, the goods are everyday products, attracting no more than a medium degree of attention in their selection. The purchase will be mainly visual with consumers self-selecting the goods from the shelves of supermarkets or pharmacies or from the websites of such undertakings. Given that orders for such goods may be made over the telephone and that consumers may communicate with sales advisors, I do not discount an aural element to the purchase.

Likelihood of confusion

52. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally from the perspective of the average consumer. In making my assessment, I must keep in mind 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. The factors considered above have a degree of interdependency: for example, 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.

53. I have found the marks to be visually very highly similar, aurally highly similar and either conceptually dissimilar or conceptually neutral. I have found the earlier mark to have a medium to high degree of inherent distinctive character. I have identified the average consumer to be either a member of the general public or a professional who, paying a medium degree of attention, selects the goods predominantly by visual means, though there will also be an aural element to the selection. I have found the goods to be similar to a low degree.

¹² JBS' statement of grounds at [10].

54. Whilst under section 5(2)(a) I found the marks to not be identical, they are aurally and visually highly similar, with the only difference being the last letter. In my view, it is entirely plausible that the average consumer could misremember the final letter in the marks and imperfectly recall OPTIPRE as OPTIPRO or vice versa, particularly as the beginnings of words tend to have more impact than the ends.¹³ Bearing in mind the interdependency principle, despite the goods being similar to only a low degree, I find there to be a likelihood of direct confusion.

THE OPPOSITION AGAINST THE OPTIPRO MARK (424970)

55. I now turn to JBS' opposition against OMS' OPTIPRO mark. The relevant sections of the Act are as follows:

“5 (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because—

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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.”

¹³ El Corte Inglés, SA v OHIM, Cases T-183/02 and T-184/02.

Comparison of marks

56. The parties have agreed that the marks at issue in this opposition are identical and I proceed with sections 5(1) and 5(2)(a) on this basis.

Comparison of goods

57. The case law at paragraphs 39 to 44 also applies here.

58. Save for *sanitising surface wipes* and *sanitising skin wipes*, OMS' class 5 goods in its OPTIPRO application are identical to its OPTIPRE application. Therefore, my findings at paragraphs 46 to 49, above are repeated and apply to the entirety of the class 5 goods. The goods are similar to a low degree to JBS' *protective masks*.

59. I turn to the remaining goods in OMS' application. The goods to be compared are as follows:

Earlier mark (JBS)	Contested mark (OMS)
<i>Class 9: Gloves for protection against accidents; bullet proof waistcoats; footwear for protection against accidents, irradiation and fire; eye glasses; Eyeglass frames; protective goggles; Protective helmets; protective headgear; protection devices for personal use against accidents; protective masks; protective suits for aviators; clothing especially made for laboratories; clothing for protection against accidents, radiation and fire; workman's protective face shields, headphones; ear buds.</i>	<i>Class 10: Face shields for medical use; face shields for protection against infection; transparent face shields for use by medical personnel; medical gloves; surgical gloves; gloves for use in dentistry; latex and rubber gloves for medical use; protective gloves for use by persons working in medicine and dentistry; face masks for medical use; protective face masks for medical use; face masks for use in the prevention of infections; surgical face masks; respirators for medical use; disposable aprons for medical and surgical use; parts and fittings for all the aforesaid.</i>

60. Both parties made detailed submissions on the comparison between OMS' class 10 goods and JBS' class 9 goods, which I have in mind when making my findings. I will refer to specific submissions where relevant in my comparison.

61. With the exception of *disposable aprons for medical and surgical use*, OMS' class 10 goods can broadly be described as falling into two groups: face masks and gloves. I will deal with each group separately.

Face masks

62. JBS' specification includes *protective masks*; OMS' includes: *face shields for medical use; face shields for protection against infection; transparent face shields for use by medical personnel; face masks for medical use; protective face masks for medical use; face masks for use in the prevention of infections; surgical face masks; respirators for medical use.*

63. Whilst the class headings distinguish between goods for surgical and medical purposes (class 10) and those for protection against accidents (class 9), section 60A of the Act prevents me from considering this as a factor in determining the similarity between the goods. Class headings may be relevant where there is ambiguity in the specification,¹⁴ but I do not consider that to be the case here. What is pertinent is the core meaning of the terms in the specifications, and it is important to highlight that whilst OMS' face masks and face shields are listed for particular purposes, the *protective masks* in JBS' specification are not. Accordingly, JBS' term could incorporate OMS' terms, resulting in identity in accordance with *Meric*.

Gloves

64. At the hearing, Mr Taylor for JBS argued that the only difference between the gloves in class 10 and those in class 9 is the user. I disagree. Regardless of how each

¹⁴ *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 (COA).

party markets its gloves and to which industry, I must consider the ordinary meaning of the wording used in the specifications.

65. I consider OMS' gloves – *medical gloves; surgical gloves; gloves for use in dentistry; latex and rubber gloves for medical use; protective gloves for use by persons working in medicine and dentistry* – to be gloves worn to avoid the spread of infection or disease; they are made of a relatively thin, stretchy material and are usually disposable. JBS' gloves, on the other hand – *gloves for protection against accidents* – are evidently for the purpose of protecting the user against accidents. They are highly unlikely to be made of a thin material as that would offer very little protection against accidents such as cuts and burns, for example: on the contrary, they are likely to be made of a much thicker and more durable material and will most likely be reusable as opposed to disposable.

66. Both groups of goods are worn on the hands of the users to offer protection and so there is an overlap in method of use, but I consider the physical nature of the goods to differ. In circumstances where disposable latex gloves are suitable for offering some protection against accidents, the users may overlap and there may be an element of competition. I consider the goods to reach the market by different trade channels and to not be complementary. Overall, I find a low degree of similarity between the goods.

Disposable aprons for medical and surgical use

67. I am of the view that JBS' *clothing especially made for laboratories* could include aprons, resulting in identity between these goods in line with *Meric*.

68. The goods for which I have found identity will proceed under section 5(1)(a); for the remaining goods section 5(1)(a) does not apply and these will proceed under section 5(2)(a).

Distinctive character of the earlier mark and the average consumer and purchasing act

69. My findings as to the distinctive character of the earlier mark as well as the average consumer and the nature of the purchasing act will be identical to those in opposition 424970 against the OPTIPRE mark, and so the relevant paragraphs apply here.

Likelihood of confusion

70. I repeat paragraph 52, above.

71. I have found the marks to be identical. I have found the earlier mark to have a medium to high degree of inherent distinctive character. I have identified the average consumer to be either a member of the general public or a professional who, paying a medium degree of attention, selects the goods predominantly by visual means, though there will also be an aural element to the selection. I have found the goods to be either identical or similar to a low degree.

72. Given the identity between the competing marks, it is my view that the average consumer will be directly confused, even for goods that are similar to a low degree due to the interdependency principle. There is a likelihood of direct confusion.

CONCLUSIONS

73. Oppositions 424956 and 424970 have been successful and OMS' applications for OPTIPRE and OPTIPRO under numbers 3581604 and 3581583 are refused.

74. Given the reliance on application 3581583 for opposition 428857, there is no requirement for me to consider the opposition against JBS' application for OPTIPRO under 3629307, which may proceed to registration.

COSTS

75. JBS has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. Although these proceedings involved three consolidated oppositions, I bear in mind that the issues were overlapping. In the circumstances I award JBS the sum of £1400, calculated as follows:

Official fees in two oppositions:	£200 ¹⁵
Preparing statements and considering the other side's statements:	£300
Preparing evidence and considering the other side's evidence:	£500
Preparing for and attending a hearing:	£400
Total:	£1400

76. I therefore order OPTIMUM MEDICAL SOLUTIONS LIMITED to pay JAMES BOYLAN SAFETY LIMITED the sum of £1400. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 22nd day of September 2022

E FISHER (née VENABLES)

For the Registrar

¹⁵ This is reduced to take account of the section 5(4)(a) being struck out.

Annex

- Class 9 *Protective clothing for the prevention of injury; safety clothing for protection against accident or injury; reflective clothing for the prevention of accidents; high Visibility safety clothing; insulated clothing for protection against accident or injury; fire resistant clothing; garments for protection against fire; protective work clothing [for protection against accident or injury]; bullet proof waistcoats; clothing especially made for laboratories; footwear for protection against accidents, irradiation and fire; boots [protective footwear]; protective footwear for the prevention of accident or injury; safety headgear; safety headwear; protective helmets; protective headgear; protective face-shields for protective helmets; eye glasses; safety goggles; Safety glasses for protecting the eyes; protective goggles; safety boots for use in industry [for protection against accident or injury]; safety footwear for protection against accident or injury; safety gloves for protection against accident or injury; gloves for protection against accidents; gloves for protection against injury; asbestos gloves for protection against accidents; gloves for industrial purposes for protection against injury; gloves for protection against X-rays for industrial purposes; Disposable gloves for laboratory use; disposable plastic gloves for laboratory use; disposable latex gloves for laboratory use; protective headphones; ear buds.*
- Class 10 *Protective clothing for surgical purposes; protective clothing for medical purposes; protective face masks for medical use; protective breathing masks for surgical applications; protective breathing masks made of non-woven materials for medical applications; Face masks for medical use for anti bacterial protection; face masks for medical use for toxic substance protection; face masks for surgical use for anti bacterial protection; protective breathing masks made of non-woven materials for surgical applications; face masks for surgical use for toxic substance protection; high filter surgical masks; protective face masks for dental use; Face shields for medical use; face shields for protection against infection; transparent face shields for use by medical personnel; disposable aprons for medical and surgical use; orthopaedic footwear;*

gloves for medical examinations; gloves for medical purposes; disposable protective gloves for medical purposes; surgical gloves; disposable gloves for surgical use; latex medical gloves; disposable gloves for veterinary use; gloves for dental use; gloves for medical use; gloves for use during operations; gloves for use in hospitals; rubber gloves for medical use; latex gloves for medical use; examination gloves for medical use; rubber gloves for surgical use; latex gloves for surgical use; protective gloves for use by surgeons during operations; protective gloves for use by persons working in medicine; Protective gloves for use by persons working in the dentistry.

Class 25 *Clothing; Headgear; Footwear; articles of clothing for outdoor activities; articles of clothing having water-resistant properties; articles of protective clothing for use in inclement weather conditions; thermally insulated clothing; rainwear; weatherproof jackets; weatherproof clothing; quilted jackets [clothing]; thermal underwear; body warmers; hoods [clothing]; scarves; Ready-to-wear clothing; Snoods [scarves]; weather resistant outer clothing; headwear; hats; footwear for men and women [excluding orthopaedic footwear]; boots; socks for footwear; non-slipping devices for footwear; fittings of metal for footwear; gloves; overalls; workwear; uniforms; high visibility clothing, headwear and footwear; disposable articles of clothing; Disposable slippers.*