O/0959/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. 3761636

IN THE NAME OF

ALAN DOBBIE GLASS AND GLAZING LTD
FOR THE TRADE MARK:

Dobbie Glass and Glazing

IN CLASS 37

-AND-

AN APPLICATION FOR A DECLARATION OF THE INVALIDITY THEREOF

UNDER NO. 506061

BY DOBBIES GARDEN CENTRES LIMITED

BACKGROUND AND PLEADINGS

1. On 3 March 2022, Alan Dobbie Glass and Glazing LTD ("the Proprietor") applied to register the trade mark on the cover page of this decision in the UK ("the contested mark"). The application was published for opposition purposes on 18 March 2022 and registration was granted on 27 May 2022. The contested mark stands registered for the following goods:

> Class 37: Installation of glass and glazing units; Glazing, installation, maintenance and repair of glass, windows and blinds; Constructing [erecting and glazing] conservatories; Glazing services; Glazing [glasswork]; Constructing [erecting and glazing] garden buildings; Renovation of glazing; Double glazing installation; Glazing of windows; Glazing services for buildings; Installation of secondary glazing; Plate glass installation and repair services; Installation of glazed building structures; Application of security films to glazing.

2. On 2 May 2023, Dobbies Garden Centres Limited ("the Applicant") applied to have the contested mark declared invalid under section 47(2)(a) of the Trade Marks Act 1994 ("the Act").[1] The application was brought under sections 5(1), 5(2)(a) and 5(2)(b) of the Act; it is directed at all services; and is reliant upon the following series trade mark registration:

> **DOBBIES**
>
> **dobbies**
>
> UK registration no. 3529038
>
> Filing date 2 September 2020; registration date 16 April 2021.
>
> Relying on a selection of goods and services contained in Classes 1, 9, 19, 20, 21 and 35 of the registration, as set out in paragraph 24 of this decision.[2]

[1] The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

[2] The trade mark is registered in respect of goods and services in Classes 1, 2, 3, 4, 5, 7, 8, 9, 11, 16, 19, 20, 21, 24, 25, 26, 28, 29, 30, 31, 32, 33, 35, 39, 41, 43 and 44.

3. By virtue of its earlier filing date, the trade mark upon which the Applicant relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As it had not been registered for five years or more at the filing date of the application, the earlier mark is not subject to the use conditions set out in section 47 of the Act. Consequently, the Applicant may rely on the above goods and services without having to show any use at all.

4. The Applicant claims: under the section 5(1) ground, that the competing marks are identical and that the respective goods and services are identical; under the section 5(2)(a) ground, that the competing marks are identical and that the respective goods and services are similar, giving rise to a likelihood of confusion; under the section 5(2)(b) ground, that the competing marks are similar and that the respective goods and services are similar, giving rise to a likelihood of confusion.

5. The Proprietor filed a defence and counterstatement denying the claims made.

6. Both parties filed evidence and submissions. A hearing was not requested and neither party elected to file written submissions in lieu of a hearing. I therefore make this decision following a careful consideration of the papers before me.

7. The Applicant is represented by Shepherd and Wedderburn LLP and the Proprietor is represented by The Trademark Helpline.

EVIDENCE

8. The Proprietor filed evidence consisting of the Witness statement of Bryan Mackenzie dated 17 January 2024 and is accompanied by nine exhibits labelled BM1 to BM9. Mr Mackenzie is a director of Alan Dobbie Glass and Glazing LTD. The exhibits consist of a certificate of incorporation for Alan Dobbie Glass and Glazing LTD; screenshots taken from the Proprietor's 'Alan Dobbie Glass & Glazing' website and social media page on the Facebook platform; certificates including a copy of a certificate to affirm that 'Alan Dobbie Glass and Glazing' is a member of the 'Glass and Glazing federation'; invoices including one for the supply and installation of a composite front door.[3]

[3] Exhibit BM8 page 7.

9. The Applicant filed evidence consisting of the Witness statement of Debbie Mary Harding dated 18 March 2024 and is accompanied by five exhibits labelled DMH1 to DMH5. Ms Harding is the company secretary and a director of Dobbies Garden Centres Limited. The exhibits consist of company incorporation documents relating to the Applicant; BT phonebook entries for private individuals with the surname 'Dobbie' and 'Dobie' recorded as residing in Edinburgh; a list of the Applicant's store locations throughout the UK (in excess of 70 stores).

10. I shall refer to the evidence where necessary in my decision.

Preliminary issues

11. In the Proprietor's counterstatement, and in Mr Mackenzie's witness statement, the following submissions are advanced:

> "3.a.iii. […] The [Proprietor's] mark leverages the goodwill built up by the name regarding window and door installation in their targeted regions: Edinburgh, the Lothians and Fife.
> […]
> 3.b.i. […] A reasonably informed consumer who was looking for glass and glazing services may likely assume that the [Proprietor's] mark relates to those and not the goods and/or services typically provided by the [Applicant], which are broadly those provided by a garden centre."[4]

> "13. To date I have not experienced any confusion amongst my customers between the Name ["Dobbie Glass and Glazing"] and the [Applicant's] registration. I believe that it would take quite a logical leap to believe there is a connection between the Name, "Dobbie Glass and Glazing" and the [Applicant's] simpler mark "Dobbies." The [Applicant] is a gardening centre, a field which our business has never entered or intends to enter.

[4] Applicant's counterstatement.

14. Dobbie is a relatively common surname in the area of our operation and during the lifetime of the business there has never been a conflict between our respective businesses. […].”[5]

12. Firstly, Mr Mackenzie’s turn of phrase seems to suggest a concession that ‘Dobbie Glass and Glazing’ would be connected with ‘Dobbies’ i.e. he states that it would take a “logical leap to believe there is a connection between the two”. I consider this was an error and given the preceding sentence (and indeed the entirety of his witness statement) it is likely he meant to say “illogical leap” instead. Therefore, I do not consider this to be a concession that the marks are identical/similar and I shall conduct my assessment in the usual way disregarding this unfortunate turn of phrase.

13. Secondly, the Proprietor points to the differing business activities/target markets of the respective parties (presumably to imply that such difference would prevent a likelihood of confusion). However, I note that it is not a relevant consideration that, at present, the parties are trading in what the Proprietor regards as discrete business sectors, because I must consider notional use of the Proprietor’s mark at a level where direct competition between the parties could take place. This requires me to make an assessment based on a notional use extended to the full width of the terms in the competing specifications, not just the goods and services for which the competing marks are currently being used in trade. An assessment of likelihood of confusion requires a consideration of all the circumstances in which the contested registration might be used, and that is how I shall proceed with my assessment.

14. Thirdly, the Proprietor states its activities are geographically limited to certain parts of Scotland and has advanced arguments of there being an absence of confusion in the marketplace. I note that actual confusion in the marketplace is not necessary for a finding of likelihood of confusion and I shall proceed on this basis. Furthermore, the confinement, thus far, of the Proprietor’s business activities to a certain part of the UK is not a relevant consideration either, since a trade mark registration provides a monopoly right for the entirety of the UK. As a matter of completeness, I also note that

[5] Witness statement of Bryan Mackenzie.

the only evidence before me from the Proprietor is of its use of 'Alan Dobbie Glass and Glazing' and not of the mark in contention, 'Dobbie Glass and Glazing'.

DECISION

Legislation

15. Sections 5(1), 5(2)(a) and 5(2)(b) of the Act have application in invalidation proceedings pursuant to section 47 of the Act. The relevant provisions of the Act are as follows:

Section 47

"(2) […] the registration of a trade mark may be declared invalid on the ground

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain [...] unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[…]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[…]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed."

Sections 5(1), 5(2)(a) and 5(2)(b)

"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.

5(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.

Claim under sections 5(1) and 5(2)(a)

Identity of the marks

16. The respective trade marks are shown below:

Applicant's mark	Proprietor's mark
Series mark 1: **DOBBIES** Series mark 2: **dobbies**	**Dobbie Glass and Glazing**

17. It is a prerequisite of sections 5(1) and 5(2)(a) that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union 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."

18. Notwithstanding the respective marks all share the sequence of letters 'D-O-B-B-I-E', they are self-evidently not identical to each other overall.

19. As both section 5(1) and section 5(2)(a) of the Act require the marks to be identical, the claim for invalidation based upon sections 5(1) and 5(2)(a) therefore fails because the marks are not identical.

Claim under section 5(2)(b)

Case law

20. I am guided by the following principles which 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 Harmonisation in the Internal Market ("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 the goods and services

21. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia:[6]

(1) the physical nature of the goods or acts of service;
(2) their intended purpose;
(3) their method of use / uses;
(4) who the users of the goods and services are;
(5) the trade channels through which the goods and services reach the market;

[6] See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.,* [1996] R.P.C. 281 – the *"Treat"* case

(6) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and

(7) whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors);

or

(8) whether they are complementary to each other.

22. 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"*.[7] Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity,[8] and it can be clearly distinguished from 'use in combination' – the latter being where goods/services are merely used together, whether by choice or convenience (e.g. wine and wine glasses[9]), this means that they are not essential for each other.

23. Section 60A(1)(a) of the Act provides that goods and services are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, nor dissimilar to each other on the ground that they appear in different classes under the Nice Classification.

24. The goods and services to be compared are as follows:

Applicant's goods and services	Proprietor's services
Class 1: Sealants. **Class 9:** Electric doorbells	**Class 37:** Installation of glass and glazing units; Glazing, installation, maintenance and repair of glass, windows and blinds; Constructing [erecting and glazing] conservatories; Glazing services; Glazing [glasswork];

[7] *Boston Scientific Ltd v OHIM,* Case T-325/06, paragraph 82

[8] *Kurt Hesse v OHIM*, Case C-50/15 P

[9] As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited,* BL O/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."*

Class 19: Doors; door frames; windows; window frames; building materials of glass; tiles; glass tiles. **Class 20:** Door, gate and window fittings; door knockers; metal furniture; locks and keys; works of art and ornaments and decorations, made of wood; ornaments of wood. **Class 21:** Glassware; porcelainware; ornaments and decorative objects of glass, wood, porcelain; unworked and semi-worked glass. **Class 35:** Wholesale services, retail services, online retail services, mail order retail services all connected with the sale of doors, door fittings, door knocker, windows, window fittings, draught excluders, mirrors, unworked glass, semi-worked glass, glassware, porcelain.	Constructing [erecting and glazing] garden buildings; Renovation of glazing; Double glazing installation; Glazing of windows; Glazing services for buildings; Installation of secondary glazing; Plate glass installation and repair services; Installation of glazed building structures; Application of security films to glazing.

25. The Proprietor's services include, *inter alia,* glazing services, installation of windows and blinds, constructing conservatories and garden buildings (which includes glazing those constructions). I note that: 'glazing', within the context of Class 37, means installation of glass; 'plate glass installation' is synonymous with 'glazing', i.e. it involves the installation of a pane of glass; 'double glazing' refers to two-layered glass panes which have a sealed space between them to provide insulation e.g. double glazed windows; 'installation of secondary glazing' involves installing an additional pane of glass on the inside of windows to improve insulation; a conservatory is a structure typically annexed to a dwelling which has glazed outer walls and a glazed roof – a conservatory is an example of a 'glazed building structure', as is a greenhouse – a greenhouse is also a garden building; and 'security films' are transparent films applied to windows to reinforce the glass.

26. The Applicant's earlier mark is protected for "Doors; door frames; windows; window frames" and fittings for the same; and for the provision of retail and wholesale services in connection with the sale of those goods. The Applicant's protection also includes 'building materials of glass' which is a wide term which I interpret to encompass not only window panes but also panels of glass for use in construction.

27. For the purposes of making a comparison, I have grouped the Proprietor's services below where the same reasoning applies.[10]

"Installation of glass and glazing units; Glazing, installation maintenance and repair of glass, windows and blinds; Glazing services; Glazing [glasswork]; Renovation of glazing; Double glazing installation; Glazing of windows; Glazing services for buildings; Installation of secondary glazing; Plate glass installation and repair services; Application of security films to glazing."

28. The above services encompass the installation of windows and the installation of glass in window frames, buildings etc. The goods upon which the applicant relies include the following: *"windows; window frames; building materials of glass"* in Class 19 and *"window fittings"* in Class 20.

29. In general terms, goods and services are different in their nature, purpose and method of use, neither are they typically interchangeable and therefore would not be in competition with each other. I think the same can be said when comparing these goods with the above Class 37 services, although I find that the aforementioned goods would be targeted towards the same user as the services and would share the same trade channels. This is because installing windows and using building materials of glass (such as glass panels) would require a specialist tradesperson and is less likely to be undertaken by a member of the general public as a 'DIY' project, it therefore follows that a consumer purchasing windows and building materials of glass would be the user of the installation services of those goods; and indeed, may require their windows/ panes of glass to be fitted with security film.

30. Furthermore, I find that similarity exists on the basis of complementarity – the glazing services cannot be provided without the actual goods themselves – a consumer may therefore believe that the manufacturer of windows, window frames and building materials of glass is economically linked to the business providing the installation services. For example, a business providing installation services of windows would likely take measurements at a customer's home and then actually custom-manufacture, supply and fit the same.

[10] *Separode Trade Mark* BL O/399/10, paragraph 5

31. On the same vein, the Applicant's *"windows; window frames; building materials of glass"* are complementary to the services of *"maintenance and repair of glass [and] windows; renovation of glazing; plate glass […] repair services"* for the same reason – a consumer seeking these services will also have to purchase the materials to carry out the repair, maintenance etc. and therefore may consider that the provider of the services and the supplier of the goods are economically linked.

32. I note that the Proprietor's evidence supports my above reasoning i.e. the provider of fitting services may also supply the goods too. For example, the following information is displayed on the website and Facebook pages in the Proprietor's evidence (my emphasis): "we supply and fit a wide range of windows and doors";[11] "our advanced double-glazed windows systems have features which will keep you and your family warm";[12] "crafted with attention to detail, our vertical slider windows [have] the functional benefits and performance of a modern PVCu window";[13] "we specialise in supplying and fitting a range of standard to bespoke PVC doors and windows";[14] "a popular misconception is that the complete window including the frame needs to be replaced, 9/10 times only the double glazing unit needs replacing […] you could keep your existing frames and just replace out of date units with new […] double glazed units".[15]

33. Taking all the foregoing into account, I consider the above identified goods and services to be similar to a low degree.

"Installation maintenance and repair of […] blinds"

34. The Applicant's Class 20 goods include *"window fittings"*. Within the context of Class 20, I interpret 'window fittings' to encompass blinds, including for example, integral blinds that are fitted between the panes of double glazing. I consider the services of installation, maintenance and repair of blinds to be complementary with the Applicant's goods such that the consumer will believe that they originate from the

[11] Exhibit BM2 page 2.

[12] Exhibit BM2 page 4.

[13] Ibid.

[14] Exhibit BM3, page 3.

[15] Exhibit BM2, page 5.

same undertaking. I also consider there would be an overlap in user and a possibility of an overlap in trade channels. The respective goods and services are similar to a low degree.

"Constructing [erecting and glazing] conservatories; Constructing [erecting and glazing] garden buildings; Installation of glazed building structures."

35. When comparing these services with the Applicant's *"doors; door frames; windows; window frames; building materials of glass"* in Class 19, I find that the nature, purpose and uses differ and they are not in competition with each other either. However, conservatories and other glazed building structures include window, window frames, doors and door frames as essential components and they are constructed using building materials of glass (i.e. panels of glass form the roof and walls of such structures). I therefore find there is complementarity between the respective goods and services on the basis that a consumer would expect an installer of conservatories etc. to supply the windows, doors and glass building materials they need to construct the building, consequently a consumer would believe that the supplier of the materials and the installer are economically linked. On this basis the users would be the same and there would be overlap in trade channels. Taking the foregoing into account, I find that the user would be the same and that there would be an overlap in trade channels. Overall, the identified goods and services are similar to a low degree.

The average consumer and the nature of the purchasing act

36. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods in question. It is therefore necessary to determine who the average consumer of the goods is, and how the consumer is likely to select them. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word 'average' merely denotes that the person is typical,[16] which in substance means that they are neither

[16] *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), paragraph 60

deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.[17]

37. The average consumer of the goods and services at issue will be a member of the general public. The goods will likely be displayed in brochures, online and in showrooms. The consumer will likely select the services at the point of purchase of the goods (and therefore select them after viewing brochures, after attending a showroom etc.) indeed, the consumer may even be presented with an integrated price whereby the fitting costs are factored into the price of the goods themselves for example. Whilst I do not discount that there may be an aural component to the selection process, I consider the selection process will predominantly be visual.

38. The relative cost of the goods and services will vary since a consumer may seek the installation of a single window or door; or they could be replacing all the windows and doors in their property which would make the cost substantially higher.

39. Factoring in the potential for the cost of the goods and services to run high, whilst also taking into account that the goods and services are such that they would be bought/used relatively infrequently (perhaps even as a one-off), I consider the consumer will be diligent in their selection process to ensure that the goods and the fitting services are of a suitable standard. The consumer will therefore pay a medium to high degree of attention in their selection process.

Comparison of the marks

40. I have already set out the principles gleaned from established case law with regard to comparing competing marks. I also note that the Court of Justice of the European Union ("CJEU") stated in *Bimbo SA v OHIM*,[18] 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

[17] *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

[18] Case C-591/12P, at paragraph 34.

and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

41. 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 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.

42. The marks being compared are shown below:

Applicant's mark	Proprietor's mark
Series mark 1: **DOBBIES** Series mark 2: **dobbies**	**Dobbie Glass and Glazing**

Overall impression

43. Both are word-only marks, therefore, the overall impression of the marks rests in the words themselves and not any particular stylistic representation of those words.

44. I find that the words 'Glass and Glazing', when used in the context of the applied-for services, have limited weight relative to the services and would merely be perceived as words associated with the services provided e.g. *installation of glass and glazing units.* Indeed, I do not overlook the possibility that the average consumer of the services may fail to perceive the words 'Glass and Glazing' as an intentional part of the brand name, therefore these words will be accorded less attention than the word 'Dobbie'. As such, the overall impression of the contested mark is dominated by the word 'Dobbie'.

Visual comparison

45. A word mark protects the word itself and the comparison must be made on the basis of the word, not any particular presentation of the word. The protection of a word mark is not limited by any features such as capitalisation which appear on the Register,

as such those features do not provide a point of distinction when comparing two word-only marks.[19]

46. In terms of visual similarity, 'D-O-B-B-I-E' forms the first six letters of the earlier mark and that sequence of letters is therefore identical to the first word of the contested mark. I note that generally, although just as a rule of thumb, the first parts of a mark normally carry a greater significance as that is where a consumer tends to focus their attention.[20] Notwithstanding the letter 'S' at the end of the earlier mark is a point of visual difference between the marks, due to its placement at the end of the word, the presence of the same root 'DOBBIE' in both marks gives rise to a very high degree of visual similarity.

47. The other visual differences lie in the words 'Glass and Glazing' which are not present in the earlier mark. Given my earlier comments regarding the limited relative weight of those words, I assess the visual similarity as medium to high *overall*, this is because, even if the average consumer perceives the words 'Glass and Glazing' as descriptive and/or non-distinctive, that does not in itself mean they will be ignored in a visual comparison.[21]

Aural comparison

48. The marks contain the same sequence of six letters 'D-O-B-B-I-E', which will be pronounced identically in both marks as 'DOB-EE'. This aural identity lies at the beginning of the contested mark, which carries a greater significance. The earlier mark has the addition of an 'S' sound at the end, however, this does not provide a notable difference in the pronunciation between 'DOBBIES' and 'Dobbie' such that the two words are aurally very highly similar.

49. Whilst the words 'Glass and Glazing' are not present in the earlier mark, given my assessment of the relative weight those words play in the overall impression of the contested mark, this difference is not significant as those words may not even be

[19] See the comments of Iain Purvis KC, sitting as the Appointed Person in the following two cases: *Groupement Des Cartes Bancaires v China Construction Bank Corporation,* Case BL O/281/14, paragraph 21; and *HERNO S.p.A. v Miss Sparrow Ltd,* BL O/954/22, paragraph 37.

[20] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraph 81

[21] In *Purity Wellness Group Ltd v Stockroom (Kent) Ltd*, Case BL-O/115/22, it was determined that *"descriptiveness does not of itself render an element negligible or aurally invisible"*.

articulated by the average consumer. Therefore *overall*, I consider the marks to be aurally similar to a medium to high degree.

Conceptual comparison

50. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.[22] The parties both advanced statements that 'Dobbie' is a surname, with the Applicant stating that it is the surname of its founder, James Dobbie;[23] and the Proprietor stating that it is the surname of its founder, Alan Dobbie.[24]

51. I accept that 'Dobbie' / 'Dobbies' may be perceived as a person's name/ surname (or deriving from a person's name) by the average UK consumer. However, I also must take into account that it may not bestow any meaning in the mind of the average consumer at all, instead it could be perceived as an invented word and I have nothing before me to suggest any other finding.

52. The words 'Glass and Glazing' in the contested mark have a clear concept, however, these words have limited weight in the overall impression of the mark.

53. Where 'Dobbie' / 'Dobbies' is perceived as a name, the marks have a shared concept (the only difference being that 'Dobbies' would be perceived as being a pluralisation of that name/surname). In such circumstances, I find the marks to be conceptually highly similar *overall*.

54. Where the average consumer derives no meaning from 'Dobbie' / 'Dobbies', it follows that the marks are conceptually neutral with regard to those words, and that the words 'Glass and Glazing' provide a point of distinction between the marks which has limited significance anyway.

Distinctive character of the Applicant's mark

55. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This

[22] This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

[23] Witness statement of Debbie Mary Harding dated 18 March 2024.

[24] Witness statement of Bryan Mackenzie dated 17 January 2024.

is because the more distinctive the earlier mark, the greater the likelihood of confusion may be,[25] although it is the distinctive character of a component that is similar between the marks that is particularly relevant.[26]

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

57. The Applicant makes no claim of enhanced distinctiveness through the use made of the earlier mark, and although it has filed evidence, and advanced a statement that the Applicant's business has been operating under the name 'DOBBIES' for over 150 years (having its founding roots in Scotland), there is nothing sufficient before me which would enable me to determine factors such as the Applicant's market share, details of advertising expenditure etc.[27] Therefore, I only have the inherent distinctiveness of the mark to consider.

58. 'DOBBIES' could be perceived as the pluralisation of the name/ surname 'Dobbie' or it could be perceived as an invented word. Either way, it has no direct nor allusive meaning in the context of the relevant goods and services. Where the average consumer perceives 'Dobbies' as an invented word, then the inherent degree of distinctive character of the mark would be high.

59. The Proprietor's witness submits that 'Dobbie' is a "relatively common surname in the area of our operation [which includes Edinburgh]"[28] (presumably to undermine the distinctiveness of 'Dobbie'); the Applicant's witness contends this by providing evidence of scarce entries in the 'BT Phonebook' for that surname in the Edinburgh area.[29]

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[25] *Sabel v Puma.*

[26] *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraphs 38 and 39.

[27] That is, any of the factors set out in *WindsurfingChiemsee v Huber and Attenberger*, joined Cases C-108/97 and C-109/97.

[28] Witness statement of Bryan Mackenzie.

[29] Witness statement of Debbie Mary Harding and accompanying Exhibit DMH4.

60. I place no weight on this evidence since it is not only confined to a particular geographical location (as opposed to applying to the entirety of the UK), it also does not establish whether 'Dobbies' would be considered as being low in distinctive character if it were found to be a common name, nor high in distinctive character if it is not. All it shows is that one resident with the surname 'Dobbie' is listed in the BT (residential) phonebook for Edinburgh, which is hardly sufficient for establishing how many people have the surname 'Dobbie' throughout the UK, especially when considering the reality that not all people have landlines, and/or even if they do, I take judicial notice that they can opt out of being listed in the phonebook in any event. This evidence does not assist me in my assessment.

61. All I can say on this point is that, ultimately, if 'Dobbies' is understood as a name/ surname, I consider it to be an average trade mark with at least a medium degree of distinctive character.

Likelihood of confusion

62. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.[30] I must also consider the average consumer of the goods, the nature of the purchasing process and bear in mind that 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.[31]

63. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.[32] The relative weight of the

[30] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

[31] *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

[32] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.[33]

64. It is well established that confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect, which is where the consumer notices that the marks are different, but the later mark and the earlier mark share common elements that lead the consumer to conclude that it is another brand of the owner of the earlier mark,[34] for example, where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension.[35]

65. I have found a low degree of similarity between the parties' goods and services under comparison and that the average consumer will predominantly make a visual selection of those goods and services, paying a medium to high degree of attention during that selection process.

66. I have found that 'Dobbies' and 'Dobbie' are very highly visually and aurally similar, and share the same concept depending on perception. Where the average consumer derives no meaning from 'Dobbies' / 'Dobbie', the marks are conceptually neutral with regard to those words. On account of the presence of the wording 'Glass and Glazing' in the contested mark, I have found the marks to be visually and aurally similar to a medium to high degree *overall*, this is because even though those words are descriptive and/or non-distinctive in relation to the contested services, they cannot be ignored in the overall comparison., and that the words 'Glass and Glazing' provide a point of distinction between the marks Notwithstanding 'Glass and Glazing' have a clear conceptual meaning, one which is not shared with the earlier mark, I have found that little weight will be attributed to those words by the average consumer, as such the overall impression of the contested mark is dominated by the word 'Dobbie' which forms the first word of the contested mark, where the very high degree of similarity with the earlier mark lies.

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[33] See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

[34] See *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, paragraphs 16 to 17 wherein Mr Iain Purvis QC, sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion.

[35] Ibid.

67. I have found that where the average consumer perceives ‘Dobbies’ as an invented word, then the inherent degree of distinctive character of the earlier mark would be high; alternatively, if it is understood as a name/ surname, it would have at least a medium degree of distinctive character.

68. Taking all the above factors into consideration, and allowing for imperfect recollection, whilst bearing in mind the principle of interdependency, I find that the average consumer – or at least a significant proportion thereof – will simply mistake one mark for the other on account of the shared identity of the root ‘D-O-B-B-I-E’ and will be directly confused as to the origin of the contested services as a result.

69. Where a proportion of the average consumer recognises the differences between the marks owing to the non-distinctive and/or descriptive wording ‘Glass and Glazing’, I consider this would nonetheless lead to indirect confusion. This is because they will believe that the services bearing the later mark come from the same undertaking, or from an economically linked undertaking, owing to the marks’ similarities i.e. they conclude that the contested mark is another brand of the owner of the earlier mark, because they share the common element ‘D-O-B-B-I-E’ (with the plural ‘DOBBIES’ not affecting such a conclusion).

OUTCOME of the claim under section 5(2)(b)

70. The application to invalidate UK trade mark registration number 3761636 under section 5(2)(b) of the Act is successful in its entirety. Subject to any appeal against my decision, the contested mark will be declared invalid. Under section 47(6) of the Act, the registration is deemed to have never been made.

COSTS

71. The Applicant has been successful and is entitled to a contribution towards its costs based on the contributory scale set out in Tribunal Practice Notice 1/2023. I take into account that the evidence filed by the Applicant was unnecessary (consisting for the most part of company incorporation documents). I therefore make no award for the preparation of that evidence, I only make an award for the consideration of the Proprietor’s evidence.

72. In the circumstances I award the Applicant the sum of £750, which is calculated as follows:

Official fee for filing Form TM26I	£200
Preparing the Statement of Grounds and considering the Counterstatement	£250
Considering and commenting on the Proprietor's evidence	£300
TOTAL	**£750**

73. I therefore order Alan Dobbie Glass and Glazing LTD to pay Dobbies Garden Centres Limited the sum of **£750**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 15th day of October 2025

Daniela Ferrari

For the Registrar