

**O/0888/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. UK3810040  
IN THE NAME OF CHARA LTD  
TO REGISTER AS A TRADE MARK**

**CHARA**

**IN CLASSES 3, 20, 24 & 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 437197  
BY CANIS MAJOR PET SCIENCE LLC**

## BACKGROUND AND PLEADINGS

1. On 15 July 2022, CHARA Ltd (“the applicant”) applied to register trade mark number UK3810040 for the mark “**CHARA**” in the United Kingdom. The application was accepted and published for opposition purposes on 29 July 2022, in respect of goods and services in classes 3, 18, 20, 24 and 35.

2. The application is opposed by Canis Major Pet Science LLC (“the opponent”). The opposition was filed on 31 October 2022 and is based upon Section 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods and services in the application, as listed in the table under paragraph 19 of this decision.<sup>1</sup>

3. The opponent relies upon UK trade mark registration number 3823119 for the mark “**CHARA**”, and claims priority from US trade mark number 97/298,966, with a priority date of 07 March 2022. The mark was registered in the UK on 02 December 2022 in Classes 05, 18 and 31, with the opponent relying on all goods, as listed in the table under paragraph 19 of this decision.

4. The opponent submits that the marks are identical and that the nature of the competing goods and services are highly similar, leading to a likelihood of confusion on the part of the consumer which includes a likelihood of association. The opponent requests that the application is rejected in its entirety and seeks an award of costs in its favour.

5. The applicant filed a counterstatement denying all the claims against it.

6. Both parties filed evidence, only the opponent elected to file written submissions. Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

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<sup>1</sup> I note that the applicant requested that Class 18 be deleted following publication of the application and as such the opposition is against the remaining classes 3, 20, 24 and 35 only.

7. In these proceedings, the opponent is represented by Hansel Henson Limited and the applicant is unrepresented.

## **EVIDENCE AND SUBMISSIONS**

### **The Opponent's evidence**

8. The opponent filed evidence in support of the opposition in the form of the witness statement of Justine Eloise Rayner Flockhart dated 13 March 2023, which is accompanied by two exhibits. Ms Flockhart is a solicitor and partner of Hansel Henson Limited, acting as representatives to the opponent.

9. The opponent also filed written submissions in lieu on 15 June 2023.

### **The Applicant's evidence**

10. The applicant filed evidence in support of the defence in the form of the witness statement of Hristov Angelov Totochev dated 05 April 2023, which is accompanied by one exhibit. Mr Totochev is a Director of the applicant company.

11. I have taken the evidence and submissions into account in reaching my decision and will refer to them during the decision to the extent I consider necessary.

## **DECISION**

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

13. By virtue of the claimed priority date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to Section 6 of the Act. As the earlier mark had completed its registration process less than 5 years before the application

date of the contested mark, it is not subject to the use provisions contained in Section 6A of the Act. The opponent is, therefore, entitled to rely upon the mark in relation to all of the goods indicated without having to prove that genuine use has been made of it.

### **Section 5(2)(a) –**

14. Section 5(2)(a) is relied on and read as follows:

“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 trade mark is protected, or

(b) ...

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

15. Section 5A states:

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

### **Identity of the marks**

16. It is a prerequisite of Section 5(2)(a) that the respective 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 (“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.”

17. The competing marks each consist of the same single word **CHARA**, presented in a standard typeface in capital letters. The respective trade marks are self-evidently identical.

### **Comparison of goods and services**

18. Section 60A of the Act provides:

“(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 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 Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

19. The goods and services to be compared are:

<b>Opponent’s goods</b>	<b>Applicant’s goods and services</b>
	<u>Class 3</u> <i>Cosmetics; Creams (Cosmetic -); Cosmetic soaps; Cosmetic soap; Cosmetics and cosmetic preparations; Moisturisers [cosmetics]; Skincare cosmetics; Multifunctional cosmetics;</i>

	<p><i>Cosmetic kits; Kits (Cosmetic -); Natural cosmetics; Skin balms [cosmetic]; Non-medicated cosmetics; Body oil; Face oils; Shower oils; Hair oil; Bath oils; Facial oil; Essential oils; Bath oil; Hair oils; Cosmetic oils; Cleansing oil; Non-medicated oils; Bath oils (Non-medicated -); Non-medicated shower oils; Non-medicated bath oils; Skin care oils [non-medicated]; Bath oil, not for medical use; Bath and shower oils [non-medicated]; Facial oils; Lip balm; Hair balms; Hair balm; Lip balms; Cleansing balm; Balms (Non-medicated -); Beauty balm creams; Lip balms [non-medicated]; Lip balm [non-medicated]; Skin balms (Non-medicated -); Non-medicated skin balms; Foot balms (Non-medicated -); Non-medicated lip balms; Non-medicated balm for hair; Balms other than for medical purposes; Balms, other than for medical purposes; Functional cosmetics; Cosmetic moisturisers; Hair cosmetics; Decorative cosmetics; Lip cosmetics; Organic cosmetics; Cosmetic preparations; Cosmetics preparations; Cosmetic creams; Mineral oils [cosmetic]; Cosmetics for animals; Beauty care cosmetics; Deodorants for animals; Natural essential oils; Natural oils for cosmetic purposes; Pet shampoos; Pets (Shampoos for -); Pet odor removers; Deodorants for pets; Pet stain removers; Shampoos for pets; Animal grooming preparations; Shampoo for animals; Non-medicated pet shampoos.</i></p>
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Class 5

*Animal feed additive for use as a nutritional supplement for medical purposes; anti-flea collars for pets; antiparasitic collars for animals; bitter tasting pet training aid in the form of a spray to prevent pets from licking, chewing and biting on objects; deodorizing preparations for pet litter boxes; dietary pet supplements in the form of pet treats; dietary supplements for pets; dietary supplements for pets in the nature of a powdered drink mix; disposable pet diapers; heartworm prevention medications for pets; herbal anti-itch and sore skin ointment for pets; medicated animal washes; medicated shampoos for pets; medicated supplements for foodstuffs for animals; nappies for pets; pharmaceutical preparations for animal skincare; pharmaceutical preparations for the treatment of worms in pets; sanitary pants for pets; sore skin ointment for pets; vitamins for pets.*

Class 18

*Backpacks for pets; bags for carrying pets; coats for cats; coats for dogs; collars for cats; collars for pets; dog bellybands; dog clothing; dog collars; dog collars and leads; dog leashes; dog shoes; garments for pets; pet accessories, namely, canvas, vinyl and leather pouches for holding disposable bags to place pet waste in; pet hair bows; pet hair ornaments; pet products, namely, pet restraining devices consisting of leashes, collars, harnesses,*

<p><i>restraining straps, and leashes with locking devices; pet tags specially adapted for attaching to pet leashes or collars; raincoats for pet dogs; rawhide chews for dogs.</i></p>	
	<p><u>Class 20</u>  <i>Beds for pets; Inflatable pet beds; Portable beds for pets; Beds for household pets; Dog beds; Cat beds; Pet crates; Pet houses; Pet cushions; Cushions (Pet -); Pet furniture; Playhouses for pets; Beds for animals; Pet grooming tables; Dog kennels; Dog baskets; Dog houses [kennels]; Non-metal dog tags; Dog tags, not of metal; Flaps (Cat/dog -) not of metal or masonry; Cat/dog flaps not of metal or masonry; Dispensers for dog waste bags, fixed, not of metal; Cat baskets; Scratching posts for cats; Cat flaps of non-metallic materials; Sleeping mats; Accent pillows; Stuffed pillows; Head supporting pillows; U-shaped pillows; Memory foam pillows; Beds, bedding, mattresses, pillows and cushions; Clothes covers; Kennels for household pets.</i></p>
	<p><u>Class 24</u>  <i>Blankets for household pets; Mats of linen; Fabric place mats; Quilt bedding mats; Textile place mats; Place mats of textile; Travellers' rugs; Travelling rugs; Pillow covers; Pillow cases; Covers for pillows; Pillowcases [pillow slips]; Mattress covers; Bed covers; Duvet covers; Bed coverings; Cushion covers.</i></p>

<p><u>Class 31</u></p> <p><i>Canned foodstuffs for dogs; cat food; consumable pet chews; digestible chewing bones for dogs; digestible teeth cleaning treats for dogs; dog biscuits; dog food; drinking water for dogs; edible chewing bones for dogs; edible chews for dogs; edible dog treats; edible organic pet treats for dogs, cats; foodstuffs for dogs; pet beverages; pet food.</i></p>	
	<p><u>Class 35</u></p> <p><i>Online retail services relating to cosmetics; Retail services in relation to pet products.</i></p>

20. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“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”.<sup>2</sup>

21. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated that:

“In assessing the similarity of the goods or services concerned, ... 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

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<sup>2</sup> Paragraph 29

purpose and their method of use and whether they are in competition with each other or are complementary”.<sup>3</sup>

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

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the 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”.<sup>4</sup>

24. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, said:

“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 reasons, the decision taker may address them collectively in his or her decision.”<sup>5</sup>

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<sup>3</sup> Paragraph 23

<sup>4</sup> Paragraph 82

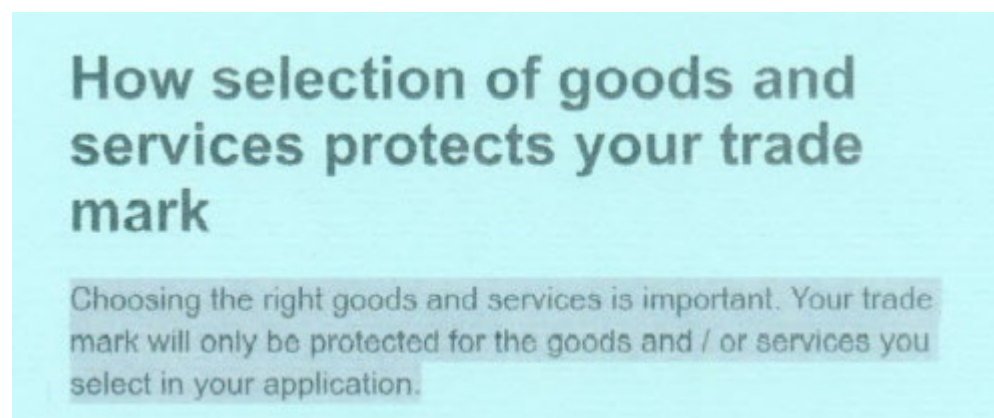
<sup>5</sup> Paragraph 5

25. While making my comparison, I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise. ... Nevertheless the principle should not be taken too far. ... 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."<sup>6</sup>

26. In its written submissions, the opponent submits that many of the applied for goods and services are pet-related, however the broad terms applied for are not limited to be in relation to humans and could therefore encompass a pet version of those goods or the goods to which the retail services relate.

27. The applicant submits that the competing marks are registered in different classes and that its goods and services are distinct from those of the earlier mark. In his witness statement and Exhibit HT001, Mr Totochev draws my attention to the following information provided on the "Register a trade mark" page of the United Kingdom Intellectual Property Office (UKIPO) website:



28. However, I am mindful of the fact that the Nice Classification is purely administrative,<sup>7</sup> and that pursuant to Section 60A of the Act, goods and services are

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<sup>6</sup> Paragraph 12

<sup>7</sup> See *Mould Pro* decision Case T-794/21 at {22-28}.

not to be automatically found to be dissimilar simply because they fall in a different class.

### Contested goods in Class 3

*Deodorants for animals; Pet shampoos; Pets (Shampoos for -); Deodorants for pets; Shampoos for pets; Animal grooming preparations; Shampoo for animals; Non-medicated pet shampoos.*

29. There is an overlap in purpose between the applicant's above-listed goods and the opponent's "*medicated animal washes; medicated shampoos for pets*" in Class 5, with the goods all being used specifically on animals for the purpose of grooming, albeit the opponent's goods contain additional medicinal ingredients and so provide a dual function. There is an overlap in users, nature and method of use, as well as trade channels, leading to a high degree of similarity.

*Pet odor removers.*

30. The purpose of these goods is similar to the opponent's "*deodorizing preparations for pet litter boxes*" in Class 5 in that they are both designed to remove animal smells and are similar in nature and method of use. They will be used by the same consumer and will be distributed through the same channels of trade. I therefore find them to be similar to a high degree.

*Pet stain removers.*

31. To my mind, these goods are used specifically to remove stains caused by pets from carpets and fabrics, rather than as a deodoriser, although I acknowledge that the elimination of odours may be an incidental result of using the goods. "*Pet stain removers*" are different in nature, purpose and method of use to the opponent's earlier "*deodorizing preparations for pet litter boxes*" in Class 5. The goods are neither complementary to, nor in competition with, the earlier goods, although they are likely to share trade channels. Overall, I find the competing goods to be similar to no more than a medium degree.

*Cosmetics for animals.*

32. I consider that the average consumer would perceive the term 'cosmetics' as being something that beautifies or enhances appearance. I disagree with the opponent that the primary purpose is the same as for the various earlier medicated products of the opponent's Class 5 specification, which in my view are intended to provide relief from something (such as from itching or infection). There will be an overlap in nature and method of use with goods such as "*medicated shampoos for pets*" inasmuch that they are both designed for use on animals and are applied directly on the animal, and there will also be an overlap in users and trade channels. However, the goods are neither complimentary nor in competition. I consider them similar to no more than a medium degree.

*Cosmetics; Creams (Cosmetic -); Cosmetic soaps; Cosmetic soap; Cosmetics and cosmetic preparations; Moisturisers [cosmetics]; Skincare cosmetics; Multifunctional cosmetics; Cosmetic kits; Kits (Cosmetic -); Natural cosmetics; Skin balms [cosmetic]; Non-medicated cosmetics; Body oil; Face oils; Shower oils; Hair oil; Bath oils; Facial oil; Essential oils; Bath oil; Hair oils; Cosmetic oils; Cleansing oil; Non-medicated oils; Bath oils (Non-medicated -); Non-medicated shower oils; Non-medicated bath oils; Skin care oils [non-medicated]; Bath oil, not for medical use; Bath and shower oils [non-medicated]; Facial oils; Lip balm; Hair balms; Hair balm; Lip balms; Cleansing balm; Balms (Non-medicated -); Beauty balm creams; Lip balms [non-medicated]; Lip balm [non-medicated]; Skin balms (Non-medicated -); Non-medicated skin balms; Foot balms (Non-medicated -); Non-medicated lip balms; Non-medicated balm for hair; Balms other than for medical purposes; Balms, other than for medical purposes; Functional cosmetics; Cosmetic moisturisers; Hair cosmetics; Decorative cosmetics; Lip cosmetics; Organic cosmetics; Cosmetic preparations; Cosmetics preparations; Cosmetic creams; Mineral oils [cosmetic]; Beauty care cosmetics; Natural essential oils; Natural oils for cosmetic purposes.*

33. I acknowledge the opponent's submissions that a broad term could encompass a pet version of similar (unqualified) goods, however I am mindful not to take the principle too far. I am further guided by *YouView* not to apply too liberal an

interpretation to the natural meaning of the goods at issue. While goods for use on animals are usually qualified as such,<sup>8</sup> the same is not true of similar goods intended for use by humans. However, I consider it unlikely that the average consumer, being deemed reasonably well informed and reasonably circumspect,<sup>9</sup> would confuse the purpose or intended use of either set of goods with one another. Although the physical nature of the applicant's aforementioned cosmetics, toiletries, balms and oils may be similar to the opponent's "*medicated animal washes; medicated shampoos for pets*" in Class 5, the respective end users and uses will be different, although there may be some overlap in as much that pet owners who use products specific to animal care on their pets will also use shampoos and soaps intended for use by human beings on themselves. There will be an overlap in distribution channels: all are likely to be being found in supermarkets, however, goods intended for human use would be found in different aisles to those intended to be used for animal grooming. The goods are not in competition with each other, neither are they complementary. I do not consider that the average consumer would expect the goods at issue to be provided by the same or economically-linked undertakings. I therefore find them to be dissimilar.

#### Contested goods in Class 20

*Beds for pets; Inflatable pet beds; Portable beds for pets; Beds for household pets; Dog beds; Cat beds; Pet crates; Pet houses; Pet cushions; Cushions (Pet -); Pet furniture; Playhouses for pets; Beds for animals; Pet grooming tables; Dog kennels; Dog baskets; Dog houses [kennels]; Non-metal dog tags; Dog tags, not of metal; Flaps (Cat/dog -) not of metal or masonry; Cat/dog flaps not of metal or masonry; Dispensers for dog waste bags, fixed, not of metal; Cat baskets; Scratching posts for cats; Cat flaps of non-metallic materials; Kennels for household pets.*

34. I accept that the manufacturers of general animal products often offer a wide range of goods which could include anything from dog beds and baskets to harnesses

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<sup>8</sup> See the examples provided by the opponent by way of Exhibits JEF01 and JEF02 which all in some way refer to the product as being for animals, be that either through the descriptions on the webpage, or through the wording and/or depiction of a domestic animal on the label of the actual goods.

<sup>9</sup> *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60.

and leads. While the applicant's above listed goods are not of the same nature, method of use or purpose as, for example, the opponent's "*dog collars and leads*" in Class 18, they will share channels of trade and it would not be unreasonable for the average consumer to expect the goods to originate from the same or economically-linked undertakings as the opponent's various pet products in Class 18. The opponent has provided evidence by way of Exhibit JEF01 to demonstrate that the goods have converged on the market in such a way as to support a finding of complementarity. Overall, I consider the opposing goods to be similar to a medium degree.

*Sleeping mats; Accent pillows; Stuffed pillows; Head supporting pillows; U-shaped pillows; Memory foam pillows; Beds, bedding, mattresses, pillows and cushions; Clothes covers.*

35. Without evidence to the contrary, which I do not consider that the opponent has provided,<sup>10</sup> the average consumer of "*Sleeping mats; Accent pillows; Stuffed pillows; Head supporting pillows; U-shaped pillows; Memory foam pillows; Beds, bedding, mattresses, pillows and cushions; Clothes covers*" will think of products for human use, being the ordinary and natural meaning of the terms. The goods are different in purpose, nature, and method of use to the earlier goods in Classes 05, 18 and 31, which are all specific to animals. They are not complementary in a trade mark sense and there is no element of competition between such goods. I therefore consider them to be dissimilar.

#### Contested goods in Class 24

*Blankets for household pets.*

36. While "*Blankets for household pets*" are not of the same nature, method of use or purpose as, for example, the opponent's "*Backpacks for pets*" in Class 18, they will share channels of trade and it would not be unreasonable for the average consumer to expect the goods to originate from the same or economically linked undertakings

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<sup>10</sup> RALEIGH INTERNATIONAL Trade Mark [2001] RPC 11 at [20].

as the opponent's various pet products in Class 18. I consider the opposing goods to be similar to a medium degree.

*Mats of linen; Fabric place mats; Quilt bedding mats; Textile place mats; Place mats of textile; Travellers' rugs; Travelling rugs; Pillow covers; Pillow cases; Covers for pillows; Pillowcases [pillow slips]; Mattress covers; Bed covers; Duvet covers; Bed coverings; Cushion covers.*

37. For the same reasons given under paragraph 35 in relation to the opposed Class 20 goods, I find no correlation between the above goods and any of the opponent's earlier goods. Consequently, I consider them to be dissimilar.

#### Contested services in Class 35

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

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

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

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

40. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*<sup>11</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>12</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>13</sup>, Mr Hobbs concluded that:

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

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

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

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

41. It is clear from the case law that where the applicant’s retail services are to be compared with the opponent’s goods, those services will be different in nature, purpose and method of use to those goods. However, I am able to find similarity in respect of the goods and the services at issue, providing that there is some

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<sup>11</sup> Case C-411/13 P

<sup>12</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment.

<sup>13</sup> Case C-398/07 P

complementarity and/or shared trade channels. It is equally clear that a finding of complementarity does not necessarily mean that the goods and retail services are similar if the consumer would find it unlikely for them to be offered by the same undertaking. I also note that I must not treat the retail services as goods, although consideration of the retail services normally associated with the opponent's goods should be made.

*Retail services in relation to pet products.*

42. Taking the guidance set out above into account, I find the contested "*Retail services in relation to pet products*" to be similar to all of the opponent's goods in classes 5, 18 and 31 to a medium degree.

*Online retail services relating to cosmetics.*

43. I interpret the applicant's "*Online retail services relating to cosmetics*" to refer naturally to the retail of cosmetics for human use. In paragraph 33 of this decision, I found dissimilarity between the applicant's various cosmetic products and the opponent's goods. I consider that retail of the applicant's same goods to be even further removed from the earlier goods. Consequently, I find "*Online retail services relating to cosmetics*" to be dissimilar to the goods relied upon by the opponent.

44. A degree of similarity between the goods and/or services is essential for there to be a finding of likelihood of confusion: *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA. 41. In relation to the goods and services which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(a), I will take no further account of such goods and services, with the opposition failing to that extent.

**The average consumer and the nature of the purchasing act**

45. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

46. The average consumer for the goods and services for which I found similarity will most likely be the pet-owning general public, with the goods in common sold through a range of channels, including general retailers, pet shops and their online equivalents. In bricks and mortar stores, the goods will be displayed on shelves where they will be viewed and self-selected by the consumer, and a similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a web page. The selection process will be a predominantly visual one, although aural considerations will play a part. Although the price of the goods can vary, on balance, the cost of the purchase is likely to be relatively low. When using the retail services at issue, the average consumer will make their choice based on the range of goods available and prices charged, customer services offered, and other factors, for example, in the case of physical stores, the location of a shop. These are services that the consumer will be using because they wish to purchase the goods stocked.

47. Considered overall, I agree with the opponent that the level of attention paid by the general public when selecting either the goods or the retail services will be to a medium degree.<sup>14</sup>

### **Distinctive character of the earlier marks**

48. The more distinctive the earlier mark, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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<sup>14</sup> See paragraph 16 of the opponent’s written submissions, dated 15 June 2023.

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).”

49. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up 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 made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence of use of the mark has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

50. The opponent’s mark comprises the single word “CHARA” which the opponent submits has no meaning in relation to the goods at issue. I agree that it is likely to be perceived by the average consumer as an invented word with no allusive qualities in respect of the goods at issue. I remind myself that the opponent’s goods are aimed at the general public. Overall, I consider the opponent’s mark to be highly distinctive.

### **Likelihood of confusion**

51. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater

degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing 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 (*Lloyd Schuhfabrik* at [26]).

52. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

53. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

54. I have found the earlier mark to be inherently highly distinctive, and that the average consumer will pay a medium degree of attention during selection of the goods and services. Given that I have found the competing marks to be identical, I consider there to be a likelihood of direct confusion between the marks in relation to all the goods and services for which a degree of similarity was found.

55. The opposition under section 5(2)(a) succeeds in relation to the following goods and services only:

### Class 3

*Cosmetics for animals; Deodorants for animals; Pet shampoos; Pets (Shampoos for -); Pet odor removers; Deodorants for pets; Pet stain removers; Shampoos for pets; Animal grooming preparations; Shampoo for animals; Non-medicated pet shampoos.*

### Class 20

*Beds for pets; Inflatable pet beds; Portable beds for pets; Beds for household pets; Dog beds; Cat beds; Pet crates; Pet houses; Pet cushions; Cushions (Pet -); Pet furniture; Playhouses for pets; Beds for animals; Pet grooming tables; Dog kennels; Dog baskets; Dog houses [kennels]; Non-metal dog tags; Dog tags, not of metal; Flaps (Cat/dog -) not of metal or masonry; Cat/dog flaps not of metal or masonry; Dispensers for dog waste bags, fixed, not of metal; Cat baskets; Scratching posts for cats; Cat flaps of non-metallic materials; Kennels for household pets.*

Class 24

*Blankets for household pets.*

Class 35

*Retail services in relation to pet products.*

**CONCLUSION**

56. The applicant has been partially successful. Subject to any successful appeal, the application by CHARA Ltd may proceed to registration in respect of the following goods and services only:

Class 3

*Cosmetics; Creams (Cosmetic -); Cosmetic soaps; Cosmetic soap; Cosmetics and cosmetic preparations; Moisturisers [cosmetics]; Skincare cosmetics; Multifunctional cosmetics; Cosmetic kits; Kits (Cosmetic -); Natural cosmetics; Skin balms [cosmetic]; Non-medicated cosmetics; Body oil; Face oils; Shower oils; Hair oil; Bath oils; Facial oil; Essential oils; Bath oil; Hair oils; Cosmetic oils; Cleansing oil; Non-medicated oils; Bath oils (Non-medicated -); Non-medicated shower oils; Non-medicated bath oils; Skin care oils [non-medicated]; Bath oil, not for medical use; Bath and shower oils [non-medicated]; Facial oils; Lip balm; Hair balms; Hair balm; Lip balms; Cleansing balm; Balms (Non-medicated -); Beauty balm creams; Lip balms [non-medicated]; Lip balm [non-medicated]; Skin balms (Non-medicated -); Non-medicated skin balms; Foot balms (Non-medicated -); Non-medicated lip balms; Non-medicated balm for hair; Balms other than for medical purposes; Balms, other than for medical purposes; Functional cosmetics; Cosmetic moisturisers; Hair cosmetics; Decorative cosmetics; Lip cosmetics; Organic cosmetics; Cosmetic preparations; Cosmetics preparations; Cosmetic creams; Mineral oils [cosmetic]; Beauty care cosmetics; Natural essential oils; Natural oils for cosmetic purposes.*

Class 20

*Sleeping mats; Accent pillows; Stuffed pillows; Head supporting pillows; U-shaped pillows; Memory foam pillows; Beds, bedding, mattresses, pillows and cushions; Clothes covers.*

Class 24

*Mats of linen; Fabric place mats; Quilt bedding mats; Textile place mats; Place mats of textile; Travellers' rugs; Travelling rugs; Pillow covers; Pillow cases; Covers for pillows; Pillowcases [pillow slips]; Mattress covers; Bed covers; Duvet covers; Bed coverings; Cushion covers.*

Class 35

*Online retail services relating to cosmetics.*

**COSTS**

57. As both parties have achieved what I consider as a roughly equal measure of success, I direct that each party should bear their own costs.

**Dated this 19th day of September 2023**

**Suzanne Hitchings  
For the Registrar,  
the Comptroller-General**