O/0893/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003847215
BY I-TAIL CORPORATION PUBLIC COMPANY LIMITED TO REGISTER:

(SERIES OF TWO)

AS TRADE MARKS IN CLASS 31

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 440555 BY
TAILSCO LIMITED

BACKGROUND AND PLEADINGS

1. On 8 November 2022, i-Tail Corporation Public Company Limited ("the applicant") applied to register the series of trade marks shown on the cover of this decision ("the application") in the UK for the following goods:

   Class 31: Seeds; packaged tuna (pet food); packaged seafoods (pet food); packaged sardines (pet food); packaged mackerel (pet food); packaged poultry (pet food); packaged all meats (pet food); frozen all meats (pet food); frozen seafoods (pet food), animal foodstuff.

2. The application was published for opposition purposes on 18 November 2022 and, on 20 February 2023, it was opposed by Tailsco Limited ("the opponent"). The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. In respect of the section 5(2)(b) ground, the opponent relies on the following marks:

   TAILS
   UK registration no. 3023989
   Filing date 28 September 2013; registration date 27 December 2013
   Relying on all goods and services, namely:

   Class 31: Pet food; dog and cat food.

   Class 35: Providing a website featuring information for consumers in the field of pet food, pet treats and pet toys for particular pet breeds.

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

UK registration no. 3248129

Filing date 3 August 2017; registration date 29 December 2017

Relying on all goods and services, namely:

Class 3: Soaps, shampoos, detergents, all for animals.

Class 5: Veterinary preparations and substances; additives for animal foods; disinfectants; pesticides; powders, sprays and collars, all for killing fleas and all for use with animals; medicated shampoos and detergents all for animals.

Class 18: Collars and harnesses, bits, leads, muzzles, blankets, articles of clothing and non-edible chews; all for animals.

Class 21: Brushes, combs, litter trays, food and water containers all for pet animals; cages for animals and parts and fittings therefor; covers for animal cages; identification barrels, trays and rings for pet animals.

Class 28: Toys and playthings for pet animals.

Class 31: Pet food; dog and cat food; foodstuffs for animals and preparations for use as additives to foodstuffs for animals; litter for animals.

Class 35: Providing information for consumers in the field of pet food, pet treats and pet toys for particular pet breeds via an Internet website.

Class 36: Provision for insurance for animals.

("the opponent's second mark").

4. Under the section 5(2)(b) ground, the opponent claims that the marks at issue are similar and that the goods at issue are identical but, if not, they are similar.[1] As a result, the opponent claims that there is a very significant likelihood of confusion between the marks, including a likelihood of association.

5. Under its section 5(3) ground, the opponent relies on its first mark but only in respect of its goods in class 31. In addition, the opponent also relies on the following mark:

TAILS.COM
UK registration no. 3100714
Filing date 24 March 2015; registration date 3 July 2015
Relying on some goods, namely:

Class 32: Pet food; dog and cat food; foodstuffs for animals.

("the opponent's third mark").

6. Under the section 5(3) ground, the opponent claims that as a result of its use of the marks relied upon, it enjoys a significant reputation in the UK. The opponent argues that because of the similarity of the marks, consumers would believe that the marks are used by the same undertaking or think that there is an economic connection between them. Further, the opponent claims that use of the marks in the application

[1] It is noted that the opponent relies on services also but the pleadings only make reference to goods.

would, without due cause, give rise to an unfair advantage in favour of the applicant. In addition, the opponent claims that use of the marks in the application would be detrimental to the distinctive character and/or reputation of the opponent's marks.

7. Lastly, under its section 5(4)(a) ground the opponent relies on the unregistered signs 'TAILS' and 'TAILS.COM'. It claims to have used both signs throughout the UK since 2014 in relation to "pet food, dog food, cat food". As a result of this use, the opponent argues that it has generated a significant goodwill and is, therefore, protected under the laws of passing off. It claims that use of the marks in the application would likely mislead the public to believe that the goods offered under the mark are those of the opponent or are otherwise associated with, approved or authorised by the opponent. This, it claims, gives rise to a misrepresentation that would result in damage being caused to the opponent as a result of this erroneous belief.

8. The applicant filed a counterstatement denying the claims made and requesting that the opponent provide proof of use in respect of the goods relied upon under its first and third marks.

9. The applicant is represented by FRKelly and the opponent is represented by HGF Limited. Only the opponent filed evidence. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken after careful consideration of the papers.

10. 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.

EVIDENCE

11. The opponent's evidence came in the form of the witness statement of Jamie Wilson dated 25 September 2023. Mr Wilson is the Finance Director of the opponent, a position he has held since November 2022. I note that in total, Mr Wilson has been employed by the opponent for seven years. Mr Wilson's statement is accompanied by 19 exhibits, being those labelled JW1 to JW19, and has been provided to provide use of the marks and also the existence of reputation and goodwill.

12. I do not intend to summarise the evidence filed by the opponent or the counterstatement of the applicant in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

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

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[…]

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

14. Section 6A is also relevant. It reads:

"(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

15. Section 100 of the Act is also relevant. It reads:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

16. The opponent's marks qualify as earlier trade marks under the above provisions because they were all applied for prior to the filing date of the application. The opponent's first and third marks completed their registration processes over five years prior to the filing date of the application. As set out above, the applicant requested that the opponent provide proof of use in respect of those marks. Therefore, the opponent's first and third marks are subject to the use provisions. The opponent's second mark, however, did not complete its registration process more than five years prior to the filing date of the application so it is not, therefore, subject to the use provisions meaning that the opponent can rely on all of the goods for that mark that it highlighted in its notice of opposition.

17. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider*

Corp v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is

deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

18. As per section 6A of the Act (cited above), the relevant period for the present assessment is the five-year period prior to the filing date of the application, being 8 November 2022. The relevant period is, therefore, 9 November 2017 to 8 November 2022 ("the relevant period").

19. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[2] because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

20. Before discussing the evidence of use, I wish to briefly discuss the actual mark that is used by the opponent. The evidence provided is clear in that the main branding of the opponent's business operation is as follows:

[2] *Jumpman*, BL O/222/16

21. This mark is not only present on the opponent's website but the opponent's product packaging. The opponent's first mark is a word only mark consisting solely of the word 'TAILS'. Its third mark is also a word only mark that consists of the words 'TAILS.COM'. Despite its figurative nature and the fact that 'Tails' is stacked above '.com', I consider the above use to be use of the opponent's third mark, as registered. I also consider this to be the case for the opponent's first mark and I say this because the case of *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12, sets out that use of a mark as part of a composite mark may be considered use of the mark as registered so long as the mark continues to be perceived as an indicator of origin. In the present case, '.com' will simply be seen as a reference to the opponent's website with 'Tails' remaining the primary indicator of origin. To confirm, the use shown above (being that which is consistent throughout the evidence) is use of both the opponent's first and third marks as registered. If that is not correct, then the above example of use is an acceptable variant of both marks in that the differences between the marks as registered and the use above are such that they do not alter the distinctive character of the marks.[3]

22. The evidence confirms that the opponent was founded on 28 October 2013 and shipped its first order of pet food in June 2014. Within five years of being founded, the opponent was serving millions of meals a month to thousands of dogs. The narrative evidence sets out that the opponent has remained focused on producing high quality pet foods and providing them to the public via a subscription service offered on its website, tails.com. In March 2022, the opponent launched a retail range of pet food which is sold in stores such as Sainsburys.

23. A number of printouts taken from the opponent's website are provided that show dog food, dog chews and cat food being offered for sale. In addition, a further printout is shown from Sainsbury's website that shows for sale two items, both

[3] *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

being types of dog food. While noted, the printouts appear to have been accessed on 25 September 2023, being after the relevant period. On this point, I note that the printout for one of the products on Sainsbury's website shows a number of reviews. Only one, however, comes from within the relevant period, being 27 May 2022. I raise these points because while I accept that the evidence shows that the opponent offered dog food and dog chews throughout the relevant period,[4] the evidence in respect of cat food is a lot less prominent. Therefore, the evidence relied upon here is of no real assistance when it comes to demonstrating use of other such goods.

24. The opponent has provided a breakdown of its turnover and the number of orders received as well as how many units of goods this equates to. The information provided covers the years 2017 to 2022, though I appreciate that the 2022 figures are expressly confirmed as being up to November of that year. The figures are as follows:

Year	**Turnover (in excess of) (£)**	**Orders / Units (in millions)**
2017	13,430,000	0.9 / 3.6
2018	23,630,000	1.2 / 4.8
2019	30,970,000	1.7 / 6.8
2020	42,300,000	2.0 / 10
2021	58,400,000	2.5 / 12.5
2022	60,800,00	2.3 / 11.5
Total:	110,330,000	10.6 / 49.2

25. While I appreciate the confirmation regarding the 2022 figures being until November of that year only, there is no such confirmation in respect of the 2017 figures. This is an issue because, as above, the relevant period began in November 2017. This means that the majority of the figures from 2017 are likely to have

[4] I will discuss this in further detail below.

accrued prior to the relevant period beginning. I have no way to accurately determine the level of use for 2017 that fell during the relevant period and given that the overwhelming majority of figures would have been from before, I will proceed with this assessment by excluding the 2017 figures. As a result, the actual figures relevant to this assessment are £96,900,000 in turnover from 9.7 million orders for a total of 45.6 million units sold.

26. Sample invoices in support of the turnover/sales figures are provided in evidence.[5] I note that the invoices provided are all from within the relevant period and while the recipient of the invoices have been redacted, I note that they all cover sales shipped to addresses in the UK. Having considered the invoices, I note that they mostly show different types of food (dry or wet food, for example), chews and biscuits for animals.[6] On this point, it appears that due to the tailored nature of the opponent's business, the reference to type of animal the food is meant for is replaced by the name of the customer's pet. As a result, I am not able to determine what type of pet food has been provided from the invoices alone.

27. In respect of the type of pet food provided, I note that images are provided of the opponent's goods on shelves in various supermarket outlined in the UK.[7] The images are not dated but I note that the unchallenged narrative evidence confirms that the images come from within the relevant period. Having considered the images, I am unable to determine with any real accuracy what types of food are shown as to zoom in on the images reduces the quality to the point that I cannot make them out. Having said that, the materials provided on the shelves or on the side of the shelves show cartoons of dogs and show wording such as 'ADVANCED NUTRITION FOR DOGS'. As a result, I find that the images are only capable of demonstrating use of dog food.

[5] JW5
[6] There are two entries for poo bags which are not covered by the goods at issue for these marks. That being said, I do not consider that this takes away from the position that pet food is clearly the main focus of the opponent's business operation.
[7] JW6

28. The opponent's evidence turns to the marketing efforts it has undertaken during the relevant period. Figures for such activities are provided that cover 2018 to November 2022. Those figures are broken down as follows and, for the avoidance of doubt, are confirmed as being figures in excess of:

	Expenditure (figures in excess of) (£)	
Year:	**Performance marketing:**	**PR & brand spend:**
2018:	5,345,000	510,000
2019:	8,550,000	880,000
2020:	8,200,000	1,000,000
2021:	11,100,000	1,350,000
2022:	8,000,000	925,000
Total:	41,195,000	4,665,000

29. There are a number of representative invoices provided alongside this evidence.[8] I note that the first set of invoices relate to advertising services on online platforms such as those provided by Google, Facebook/Meta (including Instagram), Bing and Microsoft during the relevant period. The second set of invoices relates to the opponent's spend on television advertising. In respect of advertising via print media, I note that a number of advertising inserts showing the opponent's branding are also provided.[9] While I do not discount the advertising spend in relation to the print marketing, these examples are all undated and it is not clear whether they are adverts that were run during the relevant period or not.

30. The opponent's evidence sets out that since its inception it has won a number of different awards. Some of these relate to the opponent as an employer so are not relevant to the issue of genuine use.[10] In terms of actual customer facing awards,

[8] See JW7 and JW9
[9] JW8
[10] JW11 and JW12

I note that the opponent has won two silver awards at the 2016 UK Customer Experience Awards.[11] It was also named as one of the Top 20 businesses in 2022 by 'The Startups' magazine.[12]

31. In respect of its pet food subscription service, the opponent has sought to demonstrate the number of new sign ups it has attracted since 2017. The narrative evidence sets out that the figures provided are not to be taken as total customer counts but show how many new customers the opponent has obtained. Also, as was the case with the other figures provided by the opponent, the 2022 figures cover up to November of that year. The figures are as follows:

Year:	New sign ups (in excess of)
2017	135,000
2018	200,000
2019	330,000
2020	275,000
2021	320,000
2022	255,000
Total	1,515,000

32. Following the same approach I have taken to figures provided for 2017 to 2022 above, I will take it that the above figures that actually relate to the relevant period show a total of 1,380,000 new sign ups.

33. There is additional evidence before me in respect of customer testimonials, work with influencers, charity work and social media.[13] Given the evidence already discussed above, I see no merit in discussing this evidence in any detail. This is because, plainly, the evidence summarised above is sufficient to demonstrate that

[11] JW13
[12] JW14
[13] See JW16, 17, 18 and 19, respectively.

the opponent has genuinely used its marks during the relevant period. The level of sales and turnover are substantial and while I have no evidence as to the size of the pet food market in the UK, I consider it reasonable to suggest that the figures provided are sufficient to result in a respectable share of that market. In addition, the opponent has clearly engaged in a sizeable marketing effort during the relevant period. All this being said, the issue I have with the evidence is that it appears that the opponent's business operation is focused on dog food. On this point, any evidence relating to food other than dog food is undated and fails to prove that the opponent genuinely used its mark for such goods during the relevant period. As a result, I find that the use before me is such that the opponent may only rely on "dog food" under its first and third marks.

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

34. Section 5(2)(b) of the Act reads as follows:

> "(2) A trade mark shall not be registered if because-
>
> (a) […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood or association with the earlier trade mark."

35. Section 5A of the Act states as follows:

> "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only."

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

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

37. The parties' goods are as follows:

The opponent's goods	The applicant's goods
The opponent's first mark <u>Class 31</u> Dog food. *The opponent's second mark*[14] <u>Class 31</u> Pet food; dog and cat food; foodstuffs for animals and preparations for use as additives to foodstuffs for animals; litter for animals.	<u>Class 31</u> Seeds; packaged tuna (pet food); packaged seafoods (pet food); packaged sardines (pet food); packaged mackerel (pet food); packaged poultry (pet food); packaged all meats (pet food); frozen all meats (pet food); frozen seafoods (pet food), animal foodstuff.

38. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "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".

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

(a) The respective uses of the respective goods or services;

[14] While the opponent relies on a broader specification of goods and services, I have reproduced only those that I consider necessary here, namely those in class 31.

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

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

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

40. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

41. I note that the opponent's second mark is protected for "pet food" at large. All of the applicant's goods can be said to be different types of pet food and, therefore, fall within the opponent's term. The goods are, therefore, identical under the principle outlined in *Meric*.

42. While the above finding is sufficient for the opposition reliant upon this ground to proceed, I will for the sake of completeness proceed to consider a comparison with the opponent's first mark.

43. The opponent's first mark is protected for "dog food" only. As far as I am aware, dog food can be made using different types of meat, poultry or fish. As a result, I find that the opponent's term of "dog food" can be said to cover all of the following goods in the applicant's specification:

> "Packaged tuna (pet food); packaged seafoods (pet food); packaged sardines (pet food); packaged mackerel (pet food); packaged poultry (pet food); packaged all meats (pet food); frozen all meats (pet food); frozen seafoods (pet food), animal foodstuff."

These goods are, therefore, identical under the principle outlined in *Meric*.

44. While "seeds" in the application may cover a wide range of food for pets such as birds, hamsters or gerbils, I do not consider it to be a type of dog food. That being said, I do consider that there is a degree of similarity between "seeds" and "dog food" in the opponent's first mark. The nature and method of use of the goods will differ, however, I consider that there is a degree of overlap in purpose, user and trade channels. I say this because the goods will be those sought by pet owners[15] who will buy them to give to their pet for sustenance and will seek them from the same aisles in supermarkets and/or via specialist pet stores. The goods are not competitive or complementary. Overall, I consider that there is a low degree of similarity between these goods.

[15] I appreciate that there is not a direct overlap here due to the fact that a dog owner may not own a bird/hamster, or vice versa. However, there may be some overlap in that some consumers will own both.

The average consumer and the nature of the purchasing act

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

46. The goods at issue are those that will be selected by members of the general public who own pets. The goods at issue will be available via general retailers and their online equivalents. In addition, the goods will also be available at specialist stores such as pet shops and, again, their online equivalents. In stores (be that general or specialist), the goods will be displayed on shelves where they will be self-selected by the consumer. A similar approach will apply to goods selected online as the consumer will select them after having seen an image of them on a website. In my view, the selection process for the goods at issue will be primarily visual but I do not discount an aural component playing a role by way of word of mouth recommendations or advice from sales assistants.

47. The goods at issue will be frequent purchases and will come at a relatively low cost. In respect of the level of attention paid, I appreciate that the purchaser is not

going to be the one to consume the goods selected, however, they are still going to wish to ensure that the goods are suitable for their pet. As a result, the consumer is likely to consider factors such as nutrients, ingredients and whether the product is suitable for the type of pet they have (for example, food for a small breed of dog may differ from food required for a large breed of dog). As a result, I am of the view that the goods will be selected after having paid a medium degree of attention.

Comparison of the marks

48. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

49. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

51. The respective trade marks are shown below:

The opponent's marks	The application
TAILS ("the opponent's first mark") ("the opponent's second mark")	  (Series of two)

52. I have submissions from the opponent as to the similarity of the marks at issue. While I do not intend to reproduce those submissions here, I confirm that I have taken them into account in making the following comparison.

Overall Impression

53. The opponent's first mark is a word only mark consisting of the word 'TAILS'. There are no other elements that contribute to the overall impression of the mark that lies in the word itself. As for the opponent's second mark, this is a figurative mark that

consists of the word ‘Tails’ which sits above ‘.com’. Both of these elements are presented in a grey stylised typeface. There is also a small ‘wagging tail’ device element that is connected to the letter ‘m’. The overall impression of the opponent’s second mark will be dominated by the word ‘Tails’, with the ‘.com’ element (being seen solely as an indicator of the opponent’s website) and the device playing lesser roles.

54. The marks in the application are both figurative marks that, save for their use of colour, are identical. The marks consist of a device and word element. Firstly, the device element appears to consist of two tails curved in opposite directions. In the first mark of the application, one is orange/red and the other is blue. In the second mark, these are both black. The word element sits after the device and is the word ‘i-Tail’ presented in a standard blue typeface in the first mark but black in the second. While the device element will not go unnoticed, I remind myself consumers tend to be drawn to parts of marks that can be read. While that may be the case, I consider that ‘Tail’ will play a greater role than the letter ‘i’. My reasons for this will be expanded upon when considering the concept of the marks below. As a result, I find that the overall impression of the marks in the application is dominated by the word ‘Tail’. The letter ‘i' and the device element will, therefore, play lesser roles.

Visual Comparison

The opponent’s first mark and the application

55. These marks are similar insofar as they consist of the letters ‘TAIL’. The marks differ in the addition of the letter ‘S’ at the end of these letters in the opponent’s mark and the presence of the letter ‘i’ and a dash before them in the applicant’s marks. The marks also differ in the inclusion of the device elements in the applicant’s mark, which have no counterpart in the opponent’s mark. As for the typeface used by the applicant, this is standard and, therefore, the opponent may use its mark in the same way by virtue of it being a word only mark (which is

protected for use in any standard typeface and in any colour). Taking all of this into account and bearing in mind the overall impression of the marks, I find that the marks are visually similar to a medium degree.

The opponent's second mark and the application

56. Visually, these marks share the same point of similarity as that discussed above. While that may be the case, the word 'TAILS' in the opponent's mark is presented in a stylised typeface, which is different from that used by the applicant in its marks. The marks differ in respect of the letter 'S' after the shared letters in the opponent's mark and 'i-' before it in the applicant's marks. In addition, the marks differ due to the presence of the device element in the applicant's mark and the presence of the word '.com' in the opponent's mark (presented in the same style typeface as the word 'TAILS') which has a device element of a wagging tail attached to the letter 'm'. Despite all of these differences, I remind myself that the words 'TAILS' and 'TAIL' play greater roles in the respective marks. Overall, I consider that these marks are visually similar to between a low and medium degree.

Aural Comparison

57. Aurally, the opponent's first mark is the word 'TAILS', which consists of one syllable that will be pronounced in the ordinary way. The marks in the application will be pronounced as 'i-Tail', which is two syllables that will be pronounced in the ordinary way. The pronunciation of 'TAIL' and 'TAILS' in the marks is not identical but it is clearly very highly similar. The marks differ in the presence of the letter 'i' in the applicant's marks. Given that the differences between the marks are slight, I am of the view that they are aurally similar to a high degree.

58. When confronted by the opponent's second mark, I am of the view that a significant proportion of consumers would not look to pronounce '.com'. I say this because it will be seen simply as an indicator of the opponent's website. As a result, I consider

that the same outcome reached above can apply to this mark also, namely that they are aurally similar to a high degree. That being said, I consider that there is an equally significant proportion of consumers that will pronounce '.com'. This will be pronounced as 'DOT-COM'. In these circumstances, I consider that these additional two syllables act as point of aural difference. That being said, the presence of the very highly similar 'TAIL' and 'TAILS' elements are such that the marks will be aurally similar to a medium degree.

Conceptual Comparison

59. Considering the marks in the application, I consider that the word 'Tail' will be immediately recognised as a reference to the appendage attached to the rear of many animals. The device elements will be seen as two tails and will only serve to reinforce this meaning. As for the letter 'i' before 'Tail', I consider that consumers will consider this to either be a reference to something being offered that is personalised or a reference to technological goods or services.[16]

60. The opponent's first mark will be understood as a reference to more than one tail, again being the appendage at the rear of an animal. This same meaning will carry through to the opponent's second mark. The device in the second mark will simply reinforce this meaning as it will be understood as a wagging tail. The '.COM' element will simply be considered a reference to the opponent's website, namely that it offers its goods/services online.

61. Comparing the marks, I find that the concept associated with a tail or tails will dominate all marks. While the reference to a tail in the singular or plural is noted, I do not consider that this will alter the impression of the shared concept. In addition, the device elements in the marks only serve to reinforce this concept. The letter 'i' in the applicant's mark (regardless of how it will be understood), and the reference

[16] I say this because it is common in the trade for technological goods or services to commonly introduce the letter 'i' before their product name.

to a website in the opponent's second and third marks will do little from a conceptual standpoint to take away from the shared reference to a tail or tails, especially given their roles in the respective marks. As a result, I find that all of the marks are conceptually similar to a high degree.

Distinctive character of the opponent's marks

62. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."

63. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services for which it is registered, 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. While the opponent did not plead that its marks enjoy an enhanced degree of distinctiveness, it has filed evidence of use. I remind myself that the issue of enhanced distinctiveness is capable of consideration regardless of whether it is pleaded or not. As a result, the issue of enhanced distinctiveness is something that I am required to consider in the present case. Before doing so, however, I will assess the inherent position.

64. As already discussed above, the opponent's first mark is a word only mark made up solely of the word 'TAILS'. The opponent's reliance on this mark covers "dog food" only. While not directly descriptive of the goods at issue, the word 'TAILS' is clearly allusive to the type of goods offered by the opponent, namely those that are for animals. As a result, I am of the view that the opponent's first mark is on the lower end of the scale of distinctiveness. That being said, I do not consider the distinctiveness to be outright low. I say this because, as above, the mark is not directly descriptive of the goods at issue. Overall, I consider that the opponent's first mark is inherently distinctive to between a low and medium degree.

65. In addition to the word 'TAILS', the opponent's second mark includes the '.COM' element and the figurative/presentational elements. While I consider that these will be noticed, they will have little to no impact on the distinctiveness of the mark. I say this because '.COM' will plainly refer to a website and the device element/presentation will reinforce the meaning of the word 'TAILS'. As a result, I find that the same finding reached in respect of the first mark applies to the

opponent's second mark also. Therefore, I find that this mark is also inherently distinctive to between a low and medium degree.[17]

66. In considering the position regarding enhanced distinctiveness, I refer to the same evidential summary that I have produced at paragraphs 22 to 33 above. While that summary was introduced in respect of the assessment of genuine use, it is also relevant to the present assessment. This is because it reflects the entirety of the evidence filed by the opponent. I do not intend to reproduce this summary in full but remind myself that the opponent's turnover as at the relevant date stood at approximately £110 million with 10.6 million orders in total for 49.2 million units. It also sets out that the opponent incurred a total advertising spend of approximately £45 million. I have nothing to suggest the size of the relevant market at issue but I am satisfied that this evidence reflects the position that the opponent likely enjoys a respectable share of the market for dog food. In my view, the evidence is sufficient to warrant a finding that, thanks to the use made of them, the opponent's marks enjoy an enhanced degree of distinctive character. I appreciate that the inherent position is on the lower end of the scale, however, the evidence before me demonstrates that the opponent has significantly used its marks and has a constantly increasing customer base in the UK (with a total of approximately 1.5 million new sign ups over a six-year period). In my view, this results in a finding that the opponent's marks enjoy a high degree of enhanced distinctive character. Given what I have said about the evidence's focus on dog food, I am of the view that this finding only applies in respect of such goods.

Likelihood of confusion

67. 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

[17] I consider that this finding applies regardless of the fact that the opponent's second mark's goods at issue is the broader term of "pet food" at large.

exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he or she has retained in his or her mind.

68. I have found that all of the applicant's goods are identical to the goods in the opponent's second mark. As for the goods in the opponent's first mark, the goods are, for the most part, identical. However, I have found "seeds" to be similar to only a low degree. I have found the average consumer for the goods to be members of the general public that own pets who will select the goods with primarily visual considerations (though I do not discount the aural component) after having paid, generally, a medium degree of attention. In respect of the similarity of the marks at issue, I have found the marks in the application to be:

a. Visually similar to a medium degree and aurally and conceptually similar to a high degree with the opponent's first mark; and
b. Visually similar to between a low and medium degree, aurally similar to a high or medium degree (depending on if '.COM' is pronounced) and conceptually similar to a high degree with the opponent's second mark.

69. The opponent's marks are inherently distinctive to between a low and medium degree. The distinctiveness of the marks has been enhanced to a high degree in respect of "dog food".

70. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I am of the view that consumers will be able to discern the differences between the marks and use those differences to accurately recall which mark was which. While I appreciate that the marks share the conceptual hook in that they all refer to a tail or tails,[18] I consider that the visual differences are such that the average consumer will be able to remember which mark was which. I consider this to especially be the case given the presence of the letter 'i' at the beginning of the verbal element of the marks in the application. While this plays a lesser role, it will not be overlooked. For the avoidance of doubt, I consider that this applies regardless of the distinctiveness of the opponent's marks. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks at issue, even when viewed on identical goods.

71. I now turn to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "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

[18] For the avoidance of doubt, I am of the view that the difference in this shared reference being in the singular and in the plural is something that, in my view, will be overlooked.

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)".

72. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

73. In considering indirect confusion, I remind myself that elements of the marks may still be overlooked. In the present case, I am of the view that the differing references to a tail in the singular or plural is something that consumers are likely to overlook. As a result, I will base my assessment on the differences created by the visual presentation of the marks (including the device elements), the presence of the letter ‘i' in the marks in the application and the presence of ‘.COM’ and in the opponent’s second mark.

74. Taking all of the above into account and even bearing in mind the comments of Mr Mellor Q.C. and Arnold LJ referenced at paragraph 72 above, I find that regardless of which marks of the opponent are being considered, consumers are likely to believe that the marks originate from the same or economically linked undertakings. Before proceeding to set out my reasoning, I wish to briefly set out that while the inherent distinctiveness of the opponent’s marks may be on the lower end of the scale (therefore opening up an argument that the shared use of a reference to a tail on pet food may be coincidental), I remind myself that the opponent’s marks enjoy an enhanced degree of distinctiveness. Therefore, I do not consider that shared reference to a tail will be seen as coincidental due to the level of awareness of the opponent’s brand as shown by its evidence.

75. In terms of the reasoning why consumers would be led to believe the marks originate from the same or economically linked undertakings, I remind myself that I have found above (when considering the concept of the marks in the application), the letter ‘i' is likely to be viewed as an indicator that the ‘Tail’ brand offers personalised/custom goods. In the present case, insofar as it relates to pet/dog food, that could involve the provision of food that is specifically tailored to the user’s pet that may contain certain nutrients or that it avoids certain allergens or foods that the specific breed of pet may be sensitive to. As a result, and bearing in mind what I have said in the preceding paragraph, I am of the view that the marks in the application will be seen as sub-brands/brand extensions of the opponent’s brand. This finding applies to the opponent’s first mark on the basis that the word ‘TAILS’

is its sole element. I consider that it also applies to the opponent's second mark. This is because the presence of the '.COM' element in this mark will simply be viewed as a reference to the opponent's website address. The source of origin will remain the same as it is for the opponent's first mark meaning that consumers will consider the differences to be logical indicator of brand extensions, sub-brands or alternative marks (the latter on the basis that '.COM' will not be seen as a different brand but simply a reference to a website). Lastly, dealing briefly with the different presentation and figurative elements of the marks, I will say that the differences are likely to be viewed by consumers as alternative stylings used by the same undertaking in different scenarios. For example, the word only mark is likely to be that which appears in publications or marketing materials whereas the figurative marks are those used on product packaging. Alternatively, they may simply be seen as indicators of a brand update or refresh. Consequently, I find that there exists a likelihood of confusion between all marks.

76. As the opponent's second mark enjoys identity across the board with the applicant's specification, I find that a likelihood of confusion exists for all of the goods at issue. In respect of the goods that I have found to only be similar to a low degree, I am of the view that this applies for two reasons. Firstly, the opponent's first mark enjoys a high degree of enhanced distinctive character that lies in the word 'TAILS', thereby offering it a wide scope of protection. Secondly, while the visual similarity of the marks may not particularly be at the highest level, the shared use of 'TAIL'/'TAILS' (the differences between such are those that I consider will be overlooked) is very high and to the point that consumers will still believe that the marks originate from the same or economically connected undertakings regardless of the level of similarity between the goods.

77. I will now proceed to consider the section 5(3) ground.

Section 5(3)

78. Section 5(3) of the Act states:

> "5(3) A trade mark which –
>
> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

79. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure,* Case C-323/09, *Marks and Spencer v Interflora,* Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).*

80. Under the present ground, the opponent relies only on its first and third marks. Regardless of what goods the opponent sought to rely on under the present ground, the use provisions apply equally to section 5(3) as it does to section 5(2)(b). As a result, given what I have said above in respect of the opponent's use of its mark, the present ground may only proceed in reliance upon those same goods for which I found there to be genuine use, being "dog food".

81. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar. Secondly, the opponent must show that its marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the opponent's marks being brought to mind by the marks in the application. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

82. Given what I have said about the evidence not only in my assessment of genuine use but my assessment of enhanced distinctive character, it should come as no surprise that I consider that the opponent's marks enjoy a reputation in the UK. I have no intention of repeating my evidential summary here (this can be found at paragraphs 22 to 33 above) but I simply remind myself that prior to the relevant date, the opponent accrued a total turnover of approximately £110 million with a total order amount of 10.6 million and 49.2 million units sold. It also sets out that the opponent incurred a total advertising spend of approximately £45 million. Further, between 2017 and 2022, the opponent had approximately 1.5 million new sign ups. In my view, this evidence is sufficient to warrant a finding that the opponent's marks enjoy a strong reputation in the UK in respect of "dog food".

Link

83. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

<u>The degree of similarity between the conflicting marks.</u>

84. The opponent's first mark is visually similar to a medium degree and aurally and conceptually similar to a high degree with the marks in the application. As for the opponent's third mark, I note that this was not relied upon for the section 5(2)(b) ground. That being said, I consider that my findings in respect of the aural and conceptual similarity between the marks in the application and the opponent's second mark can apply here, namely that they are either aurally similar to a high or medium degree (depending on if '.COM' is pronounced) and conceptually similar to a high degree. As for visual similarity, I remind myself that I have found the opponent's second mark to be visually similar to a low to medium degree with the

marks in the application. While not a like for like comparison (due to the figurative nature of the opponent's second mark), I am of the view that the visual similarity here can be said to be one notch above that found above. Therefore, I consider that the marks are visually similar to a medium degree.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

85. Under the section 5(2)(b) ground, I found that, for the most part, the goods in the application are identical to "dog food", being the reputed goods of the opponent. However, I found "seeds" to be similar to a low degree with "dog food". Those same findings apply here.

The strength of the earlier mark's reputation.

86. I have found that the opponent's marks enjoy a strong reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use.

87. Inherently, I have found the opponent's first mark is distinctive to between a low and medium degree. I consider that the same finding applies to the third mark on the basis that '.COM' does nothing to alter or contribute to the distinctiveness created by the word 'TAILS'. I have also found that as a result of the evidence before me, the opponent's first mark has been enhanced to a high degree. Given the nature of the opponent's evidence, I see no reason why this same finding would not also apply to the opponent's third mark (especially given that mark also formed the basis of my proof of use assessment above).

Whether there is a likelihood of confusion

88. I have found there to be a likelihood of indirect confusion between the marks in the application and the opponent's first mark. In my view, following the same reasons discussed when reaching that finding, the same outcome applies to the opponent's third mark. As I have discussed above, this applies in circumstances where the goods at issue are only similar to a low degree.

Conclusions on link

89. While the present assessment as to the existence of a link is not the same as the one undertaken when considering the issue of confusion, I consider that as there exists confusion between the marks, it plainly follows that consumers would, upon being confronted by the marks in the application, be caused to wonder if it was linked to the opponent's marks.

Damage

90. The opponent has pleaded that use of marks in the application would, without due cause, lead to an unfair advantage in favour of the applicant and cause a detriment to both the reputation of the opponent and to the distinctive character of the opponent's marks.

Unfair Advantage

91. I bear in mind that unfair advantage has no effect on the consumers of the opponent's goods. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to select the goods of the later mark than they would otherwise have been if they had not been reminded of the earlier mark.

92. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

> "80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

93. Given I have found that there exists a likelihood of indirect confusion between the marks at issue, I consider that unfair advantage is automatically made out on the basis that consumers (who are aware of the opponent's marks and its reputation) will erroneously purchase the applicant's goods in the mistaken belief that they are connected to the goods of the opponent. Such a scenario clearly demonstrates a transfer of image from the opponent's marks to the marks in the application, therefore giving the applicant a commercial advantage without paying financial compensation. The opponent's claim as to unfair advantage, therefore, succeeds.

94. The applicant would have a defence if it could establish that it has a due cause in filing the application. However, no evidence or arguments have been put forward to this effect. The applicant's use is not, therefore, with due cause.

95. As damage has been made out on the basis of an unfair advantage, I do not consider it necessary to consider the remaining heads of damage. The opposition reliant upon the 5(3) ground, therefore, succeeds in full.

Section 5(4)(a)

96. Section 5(4)(a) of the Act reads as follows:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-
>
> > (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) …..
> >
> > (b) …..
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

97. Subsection (4A) of Section 5 states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

98. I accept that, based on the evidence before me (and as already assessed above), there exists a strong level of protectable goodwill in the opponent's business in

respect of the goods for which there exists genuine use, enhanced distinctiveness and reputation (namely “dog food”) and that the opponent’s signs (being ‘TAIL’ and ‘TAILS.COM’) are distinctive of and/or associated with that goodwill. I remind myself that, under the section 5(2)(b) ground, I found there to be a likelihood of confusion between the parties’ marks and in respect of all goods. In assessing the present ground, I remind myself of the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, wherein Kitchin LJ set out that it was doubtful whether the difference between the legal tests for likelihood of confusion and misrepresentation will (all other factors being equal) produce different outcomes. Because the opponent’s signs are identical or highly similar to those marks relied upon under the section 5(2)(b) ground, I am of the view that this principle applies here. As such, I am satisfied that a finding of misrepresentation (and subsequently, damage) follows the outcome of the 5(2)(b) ground.

99. As a result of the above, I find that the opponent’s reliance upon its section 5(4)(a) ground succeeds in full.

CONCLUSION

100. The opposition succeeds in its entirety and, subject to any successful appeal of my decision, the application is refused registration for all goods.

COSTS

101. As the opponent has succeeded, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £1,600 as a contribution towards its costs. The sum is calculated as follows:

Filing a notice of opposition and considering the

applicant’s counterstatement:	£300
Filing evidence:	£700
Written submissions:	£400
Official fees:	£200
Total:	**£1,600**

102. I hereby order i-Tail Corporation Public Company Limited to pay Tailsco Limited the sum of £1,600. The above 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 conclusion of the appeal proceedings.

Dated this 13th day of September 2024

A COOPER
For the Registrar