

O-152-15

TRADE MARKS ACT 1994

APPLICATION BY BARKING BREW LTD

UNDER NO 2632956

FOR REGISTRATION OF A SERIES OF TWO TRADE MARKS:

**Barkers Brew
BARKERS BREW**

AND

OPPOSITION NO. 104285

BY SOCIETE DES PRODUITS NESTLE S.A.

Background and pleadings

1. On 5 December 2013, a decision was issued on behalf of the Registrar rejecting opposition No. 104285 by Société des Produits Nestlé S.A. against application 2632956 in the name of R2 Pets Ltd.

2. The application was made on 28 August 2012 and is for a series of two marks: BARKERS BREW and Barkers Brew. There is no material difference between these marks and so from here on I will refer to them in the singular as BARKERS BREW.

3. The Hearing Officer responsible for the decision of 5 December 2003 rejected the opponent's grounds of opposition under sections 5(2)(b) and 5(3) of the Act. He accepted that the opponent's evidence showed that the opponent's earlier mark - the word BAKERS - has a strong reputation in the UK for the goods at issue – pet food - and was highly distinctive of such goods. Despite this he found that there was no likelihood of confusion between the opponent's earlier mark and the applicant's mark, even if both were used for identical goods. Further, he found that the relevant public would not make a link between the marks and therefore the applicant's mark could not take unfair advantage of the earlier mark, nor be detrimental to its distinctiveness or reputation.

4. The opponent appealed to the Appointed Person. On 3 November 2014, Professor Ruth Annand, as the Appointed Person, set aside the Hearing Officer's decision and remitted the case to the registrar for a fresh determination by a different Hearing Officer. The crux of Professor Annand's reasoning is apparent from paragraphs 24 - 26 and 28 - 31 of her judgment. These are re-produced below.

“24. To my mind the issue was not so much *Medion* but rather one of general principle: the overall impression the Applicant's mark would have on the pet-owning public in the particular circumstances of this opposition.

25. The Hearing Officer seems, however, to have determined that because in his view BARKERS BREW “hung together”, and BREW was not purely descriptive of pet food, BARKERS had no independent significance in the Applicant's mark, and that was sufficient to preclude likelihood of confusion (or a link) with the Opponent's mark, even though BAKERS was highly distinctive and identical goods were involved.

26. On the contrary, the CJEU makes clear in *Bimbo* that “hanging together” is not the determinative criteria in assessing a composite mark: the decisive question being whether the composite mark forms a unit having a different meaning as compared to its components taken separately (*Bimbo*, para. 25).

27. –

28. In my judgment, the Opponent was justified in complaining that the Hearing Officer did not consider the overall blend of meaning and significance of BARKERS BREW to the pet-owning public in the context of pet food, and thus made an error of law.

29. Furthermore, that consideration of the overall blend of meaning and significance of BARKERS BREW should have taken place (but it is not apparent from the decision that it did) in the light of the Opponent's evidence as to:

1) The state of the UK pet food market including the common use of sub-brands to indicate different pet food product ranges. Although the evidence spoke to the Opponent's business only, its BAKERS brand was shown to be a UK market leader. The evidence established that the Opponent had made extensive use of sub-branding in the UK, not only allusively/descriptively – e.g., BAKERS COMPLETE, BAKERS MEATY MEALS, but also fancifully – e.g., BAKERS ALLSORTS, BAKERS WHIRLERS. Those sub-branding practices accord with my own experience of the UK pet food market generally as a pet-owning member of the public (*Marks and Spencer plc v. Interflora Inc.* [2012] EWCA Civ 1501).

2) The extent and circumstances of public recognition of BAKERS on the UK market (*Case C-252/12, Specsavers International Healthcare Ltd and Others v Asda Stores Ltd*, 18 July 2013, paras. 34 – 41, *Case T-47/06, Antartica Srl v. OHIM* [2007] ECR II-0042, paras. 48 – 60, confirmed on appeal *Case C-320/07 P* [2009] ECR I-0028) which would have included a wide and varied range of BAKERS + sub-brand pet foods/treats. Both were significant because they would have contributed to the overall impressions of the respective marks in the minds of the pet-owning public, when those marks were encountered in use on the UK market in relation to pet foods.

Conclusion

30. For the reasons I have given above, I do not consider that either the global assessment of likelihood of confusion for Section 5(2)(b), or the global assessment of the existence of a "link" for Section 5(3), was carried out by the Hearing Officer in an appropriately correct (viz overall blend of meaning and significance the pet-owning public would attribute to BARKERS BREW) or complete manner (viz taking account of evidence as to: (a) the state of the UK pet food market; and (b) the reputation of BAKERS on that market).

31. In those circumstances, and in the absence of a first instance decision on, and/or taking into account those matters, I believe that the correct course of action in this appeal is for me to refer the opposition back to the Registrar for a fresh determination (*MISS BOO Trade Mark*, BL O/391/14, para. 26)."

5. I take this to mean that I must consider the whole matter afresh. It is clear that I am not bound by the findings of the original Hearing Officer. Equally, although I must take account of the Appointed Person's criticisms of the original decision, her

judgment does not require me to reach different conclusions to those of the original Hearing Officer.

The hearing

6. A further hearing took place on 20 March 2015 at which the opponent was represented by Mr Simon Malynicz of counsel. The applicant was not represented.

The earlier mark

7. The opponent relies on a series of three earlier trade marks, which are registered in the UK under No. 2137189. Each of those marks consists of, or includes, the word BAKERS. Two of the marks show the word BAKERS on a (unremarkable) background. The opponent is no better off with these two marks than the word BAKERS alone. Consequently, I will focus on this mark. The earlier mark is registered in class 31 for 'Foodstuffs for animals, birds and for fish; supplements for the aforesaid goods'. It is subject to the 'proof of use' requirements in s.6A of the Act. The original Hearing Officer found that a fair description of the goods for which use had been shown was 'Dog Food; foodstuffs for animals'. That finding was not criticised on appeal and at the further hearing Mr Malynicz invited me to adopt it. Having read the evidence myself, I adopt the previous Hearing Officer's finding in this respect.

The evidence

8. The opponent's evidence was set out in paragraphs 6 – 9 of the decision dated 5 December 2013. I see no need to repeat the original Hearing Officer's summary of the evidence. I will therefore limit myself to the following observations:

- The opponent's mark was first used in the UK in 1992 and has been used continuously since then.
- The opponent's primary product is a complete dry dog food, i.e. it meets the nutritional requirements of dogs without having to be mixed with other foodstuffs. The main product is called BAKERS COMPLETE, but there are related products sold as BAKERS MEATY MEALS, BAKERS COMPLETE GRAVY BITES, BAKERS COMPLETE WEIGHT CONTROL and various other descriptive variations.
- The opponent is the market leader in the dry dog food market. In 2012 the opponent's share of the UK dry dog food market amounted to nearly 50%.
- As well as a range of complete dry dog foods, the opponent also sells dog treats and chews. Some of these products have fancy names, such as

ALLSORTS, WHIRLERS (as mentioned by the Appointed Person) and SIZZLERS.

- Sales under the mark in 2011 and 2012 exceeded £100m.
- The opponent spends around £3m per annum advertising its products in the UK. This includes TV advertising of the various versions of BAKERS COMPLETE.
- There is no direct evidence as to the public's perception of the mark BARKERS BREW

9. It follows from what I have said that:

- The earlier mark is entitled to protection for 'Dog Food; foodstuffs for animals'.
- These are identical to the goods covered by the application; namely 'Pet food, pet foods, foodstuffs for pet animals; pet food for dogs; food preparations for dogs; dog food'.
- The earlier mark has a strong reputation for dog food and is highly distinctive.

The Section 5(2)(b) ground

10. The original Hearing Officer found that:

- The relevant average consumer is a pet owning member of the general public.
- Pet food is predominantly selected by eye, but the sound of the marks will also play some part in the selection process and cannot therefore be overlooked.
- Pet food is selected with "*more than the lowest*" degree of attention, but is not "*a very carefully considered decision*". I take this to mean that it is selected with an average or normal degree of attention.

11. These findings were not criticised on appeal. Mr Malynicz submitted that pet food is an everyday item and not selected with any particular care. I agree that consumers do not pay an above average level of attention when selecting pet food. However, most pet owners care enough about their pets to try and select a suitable foodstuff, so I don't accept that such consumers pay a below average level of attention either. I find that average consumers of pet food select such products with a normal or average level of attention.

12. The central matter for reconsideration is therefore “*the overall blend of meaning and significance of BARKERS BREW to the pet-owning public in the context of pet food*” taking into account of:

- The state of the UK pet food market including the common use of sub-brands to indicate different pet food product ranges.
- The extent and circumstances of public recognition of BAKERS on the UK market which would have included a wide and varied range of BAKERS + sub-brand pet foods/treats.

13. The opponent’s use of sub-brands was mentioned by Professor Annand in connection with both of the matters she decided that the original Hearing Officer should have been taken into account as relevant background to his assessment of the “*overall blend of meaning and significance of BARKERS BREW to the pet-owning public..*”. This could mean doing one of two things. Firstly, it could mean taking account of the use of sub-brands in the pet food market as illustrated by the opponent’s own use. Secondly, it could mean taking account of the specific sub-brands used by the opponent in assessing the likelihood of confusion (or the public making a link for the purposes of the s.5(3) ground) between the respective marks.

14. In its judgment in *Specsavers*¹ the CJEU held that it was appropriate to take into account the colour in which a figurative mark, registered in black and white, had been used when assessing the likelihood of confusion between that mark and a later mark, or that the later mark would take unfair advantage of the reputation of the earlier mark. Specifically the court stated that:

“35. The Court has also held on several occasions that the global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, inter alia, *SABEL*, paragraph 23; *Medion*, paragraph 28; and *OHIM v Shaker*, paragraph 35).

36. Furthermore, according to the case-law of the Court, the more distinctive the trade mark, the greater the likelihood of confusion. Therefore, trade marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than trade marks with a less distinctive character (Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 18).

¹ Case C-251/12

37. At the very least where there is a trade mark which is registered not in a particular colour or characteristic, but in black and white, the colour or combination of colours in which the trade mark is later used affects how the average consumer of the goods at issue perceives that trade mark, and it is, therefore, liable to increase the likelihood of confusion or association between the earlier trade mark and the sign alleged to infringe it.

38. In those circumstances, it would not be logical to consider that the fact that a third party, for the representation of a sign which is alleged to infringe an earlier Community trade mark, uses a colour or combination of colours which has become associated, in the mind of a significant portion of the public, with that earlier trade mark by the use which has been made of it by its proprietor in that colour or combination of colours, cannot be taken into consideration in the global assessment for the sole reason that that earlier trade mark was registered in black and white.

39. Concerning, in the second place, the examination of whether any unfair advantage has been taken of the distinctive character or reputation of the trade mark within the meaning of Article 9(1)(c) of Regulation No 207/2009, it is necessary to undertake a global assessment, taking into account all the factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned. As regards the strength of the reputation and the degree of its distinctive character, the Court has already held that, the stronger that mark's distinctive character and reputation are, the easier it will be to accept that detriment has been caused to it (see Case C-487/07 *L'Oréal and Others* [2009] ECR I-5185, paragraph 44).

40. In that regard, it is clear from the order for reference that the similarity between the trade marks of the Specsavers group and the signs used by Asda was created intentionally in order to create an association in the mind of the public between the two trade signs. The fact that Asda used a similar colour to that used by the Specsavers group with the intention of taking advantage of the distinctive character and reputation of the latter's trade marks is a factor which must be taken into account in order to ascertain whether it can be held that unfair advantage is being taken of the distinctive character or reputation of the trade mark (see, by analogy, *L'Oréal and Others*, paragraph 48).

15. It appears from paragraph 39 of the court's judgment that the colour in which the mark was used was relevant because it formed part of the reputation of the earlier mark. It was therefore part of the enhanced distinctive character of the mark, which the court has repeatedly said should be taken into account in assessing the likelihood of confusion etc. This appears to be consistent with the judgment of the Court of Appeal of England and Wales in the same case in which that court said that a mark registered in black and white is registered in respect of all colours². This in turn appears to be consistent with paragraph 37 of the CJEU's judgment above,

² See paragraph 5 of the court's judgment in [2014] EWCA Civ 1294.

where the court refers to colour affecting “*how the average consumer of the goods at issue perceives that trade mark*” (emphasis added). If correct, this would mean that the green version of the Specsavers mark represented normal and fair use of the registered mark. On this view of the matter, the CJEU was saying no more than that where a mark is registered in all colours, but used extensively in a particular colour, and that colour has come to form part of the public’s perception of the reputation and the enhanced distinctive character of the trade mark concerned, this should be taken into account when assessing the likelihood of confusion (or a link being made) with a later mark. This does not appear to support an approach of taking into account other matter extraneous to the earlier mark itself, such as the specific sub-brands with which it has been used³.

16. In *Il Ponte Finanziaria SpA v OHIM*⁴ the CJEU stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.” (emphasis added)

17. Although the opponent’s evidence in this case indicates that it has used the mark BAKERS in association with a number of sub-brands, the opposition is based on the single word mark BAKERS. In these circumstances, I do not think that the opponent can ask for the use of any of its particular sub-brands to be taken into account in the assessment of the likelihood of confusion between its mark and BARKERS BREW. However, I take due note of the tendency in this market (as with many others) for primary marks to be used in combination with sub-brands that may be descriptive, allusive or comprised of fancy words, as illustrated by the opponent’s use of

³ The position may be different when it comes to an examination of the evidence of use of the later trade mark and one of the issues is whether it was chosen so as to take unfair advantage of an earlier mark: see, *Coca Cola Company v OHIM*, Case T-480/12 at paragraphs 84 – 90.

⁴ Case C-234/06

BAKERS in conjunction with various sub-brands. I will therefore approach the matter in accordance with the first of the two possible approaches described in paragraph 13 above.

Similarity of marks

18. The opponent contends that the marks have no meaning for the goods at issue beyond the fact that BAKERS and BARKERS are surnames. In any event, the opponent submits that the level of conceptual similarity, or dissimilarity, has relatively little impact in this case because BARKERS BREW has no immediately recognisable meaning⁵. Further, the goods at issue are not expensive items bought only after a good deal of thought, so the consumer will not spend much time thinking about the meaning of the marks.

19. The opponent cited a dictionary reference for 'barker' as '*a tout at an auction, sideshow etc. who calls out for custom to passers-by*'. I accept that this meaning is not very well known. However, as I pointed out to the opponent prior to the hearing, the first meaning for Barker in Collins English Dictionary is '*a person or animal that barks*'. Mr Malynicz provided me with an extract from the Oxford Dictionary of English which suggests that this meaning may be old and outdated. I accept that the dictionaries do not establish - either way - whether BARKER is well known as a noun meaning 'one that barks', but there can be no doubt that the relevant public are very familiar with the meaning of 'bark' in the context of animals. Further, I note that the addition of the suffix '-er' is a common way of designating a person or animal with the characteristic in question, e.g. 'fighter', 'player', 'shooter', 'singer', 'tracker' etc.

20. Unlike the original Hearing Officer, I therefore find it hard to resist the applicant's submission that, in the context of animal food, a significant proportion of the relevant public will see the word BARKERS in BARKERS BREW as meaning 'animals that bark', and BREW as a fanciful way of indicating that the product is a (probably liquid) blended one. To consumers such as these (of which I am one) BARKERS BREW as a whole appears to be a fancy way of designating a (probably liquid) blended product for animals that bark. And as nearly all dogs bark, in the context of dog food, the mark would therefore be seen as a fanciful but obvious way of conveying the message that the product is a liquid blended product (BREW) for dogs (BARKERS).

21. For those average consumers of pet food who see the meaning I did, BARKERS BREW as a whole has a meaning as "*a unit*" compared to "*its components taken separately*", i.e. a 'brew' for 'barkers'. This is in contrast to the mark in the *Bimbo*

⁵ Unlike, for example, the mark at issue in case C-361/04, *PICASSO*.

case⁶ mentioned by Professor Annand, where the two words making up the later mark – BIMBO DOUGHNUTS – had no semantic connection to one another.

22. I accept that not all relevant consumers will see the applicant's mark this way. As is apparent from the decision of the previous Hearing Officer, the word BARKERS in BARKERS BREW is also capable of being seen as a surname. For consumers who see the mark this way, BARKERS BREW will convey the message that the product is a (probably liquid) blended product from a person or firm called BARKERS. Seen this way, the meaning of the mark as a whole is not much more than the sum of its parts.

23. Given that either of the meanings described above is easily grasped, I consider that even consumers in a hurry will see one or other of the possible meanings of the applicant's mark. I consider that at least as many consumers will attribute the meaning described at paragraph 20 above to the applicant's mark, as against the proportion of the relevant public which will attribute the meaning described in paragraph 22 above.

24. As regards the opponent's mark, I doubt that the meaning cited by the opponent, i.e. *'a person who bakes and sells bread, cakes etc.'* would enter a consumer's mind in the context of a trade mark in pet food. Rather, I think that relevant consumers are more likely to see the opponent's mark for what it is: the possessive form of the word BAKER being the name of a firm or person trading in pet food.

25. Turning to visual similarity, I accept that the words BAKERS and BARKERS are quite highly similar. Further, as BARKERS is at the beginning of the applicant's mark, it will strike the consumer first. However, the applicant's mark consists of two words whereas the opponent's mark is a single word. Further, the presence of the additional letter 'R' in BARKERS means that the first word in the applicant's mark has 7 letters compared to 6 in the opponent's mark. Taken together these factors mean that the level of overall visual similarity between the marks is 'medium'. Mr Malynicz submitted that there was a *"reasonable"* degree of similarity between the marks as wholes, which I think accords with my own assessment.

26. The opponent accepts that the sound of the marks is less important than how they look because the goods at issue are primarily selected by sight. Nevertheless, I agree with the opponent that the first word of the applicant's mark, BARKERS, consists of two syllables (BAR-KERS), which together sound quite similar to BAKERS (BAY-KERS) and appropriate weight must be given to this. Nevertheless, I find that the difference between the sound of the first syllables of BARKERS and BAKERS (described above) combined with the presence of the additional word - BREW - in the applicant's mark, means that the overall level of aural similarity

⁶ *Bimbo SA v OHIM*, Case C-591/12P

between the marks is no higher than 'medium'. The alliteration of the 'B' sound in the applicant's mark helps to distinguish the marks aurally. This is because it makes it less likely that the second word – BREW – will be missed or disregarded by an average consumer.

Likelihood of confusion

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

The principles

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

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

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

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

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

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

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

28. The opponent's mark is highly distinctive, the part of the applicant's mark which is similar to the opponent's mark appears at the beginning of the applicant's composite word mark, and the respective goods are identical. These factors point towards a likelihood of confusion. The opponent also points out that the human eye has a tendency to see what it expects to see⁷. In this case that could lead the average consumer, who is familiar with BAKERS as an established trade mark for pet food products, to approximate BARKERS to BAKERS. Such a consumer may then attach little distinguishing significance to BREW believing it to be an allusive sub-brand of BAKERS. No one is going to believe that BAKERS has changed its name to BARKERS, or that the same undertaking trades as both BAKERS and BARKERS, so this proposition depends in part on average consumers misreading BARKERS BREW as BAKERS BREW, or perhaps imperfectly recollecting BAKERS as BARKERS.

29. Earlier I found that average consumers would either see BARKERS BREW as a blended liquid product (BREW) for animals that bark (BARKERS), or as a blended liquid product marketed by a person or firm called BARKER. Consumers who see the applicant's mark in accordance with the first meaning are more likely to see BARKERS BREW as a conceptual "*unit*" and are therefore unlikely to rely more on BARKERS than BREW in order to identify the commercial source of the goods. Moreover, the conceptual identity of the composite mark is liable to counteract, to some degree, the visual and aural similarities between the marks so far as this

⁷ Per Arnold J. in *Och-Ziff Management Europe Ltd v OCH Capital* [2010] EWHC 2599 (Ch)

section of the relevant public is concerned⁸. By contrast, the section of the relevant public composed of average consumers who see BARKERS BREW as a blended liquid product marketed by a person or firm called BARKER, are likely to attach relatively more weight to the word BARKERS than the word BREW in order to identify the commercial source of the applicant's goods. Consequently, any confusion between BAKERS and BARKERS amongst this group of consumers is more likely to result in confusion.

30. Although the question of confusion must be assessed through the eyes and ears of an average consumer, it appears that the average consumer test does not require the tribunal to treat all such consumers as either likely to be confused, or not. In *Interflora v Marks and Spencer*⁹ the Court of Appeal held that it was appropriate to give due weight to the likely reactions of different sections of the public, provided that these represent the range of likely reactions of persons with the attributes of an average consumer. Kitchen L.J. stated that:

“129.....In deciding a question of infringement of a trade mark, and determining whether a sign has affected or is liable to affect one of the functions of the mark in a claim under Article 5(1)(a) of the Directive (or Article 9(1)(a) of the Regulation), whether there is a likelihood of confusion or association under Article 5(1)(b) (or Article 9(1)(b)) , or whether there is a link between the mark and the sign under Article 5(2) (or Article 9(1)(c)) , the national court is required to make a qualitative assessment. It follows that it must make that assessment from the perspective of the average consumer and in accordance with the guidance given by the Court of Justice. Of course the court must ultimately give a binary answer to the question before it, that is to say, in the case of Article 5(1)(b) of the Directive, whether or not, as a result of the accused use, there exists a likelihood of confusion on the part of the public. But in light of the foregoing discussion we do not accept that a finding of infringement is precluded by a finding that many consumers, of whom the average consumer is representative, would not be confused. To the contrary, if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then we believe it may properly find infringement.

130 In the circumstances of this case we are, of course, concerned with a claim under Article 5(1)(a) (and Article 9(1)(a)) in the context of internet advertising and the question to be answered was whether the advertisements in issue did not enable reasonably well-informed and observant internet users, or enabled them only with difficulty, to ascertain whether the goods and services so advertised originated from Interflora or an undertaking economically linked to Interflora or, on the contrary, originated from M & S, a third party. In answering this question we consider the judge was entitled to

⁸ The counteraction theory is well recognised in the case law: see, for example, the judgment of the CJEU in Case C-361/04, *PICASSO*

⁹ [2014] EWCA 1403 (Civ)

have regard to the effect of the advertisements upon a significant section of the relevant class of consumers, and he was not barred from finding infringement by a determination that the majority of consumers were not confused.”

31. I find that the section of the relevant public made up of consumers who immediately grasp the words BARKERS BREW as a fanciful reference to a blended liquid product (BREW) for animals that bark (BARKERS) are unlikely to mistake the word BARKERS for BAKERS and thereby confuse the applicant’s mark with a variant of the opponent’s mark. I recognise that there are limits to the conceptual counteraction theory. Mr Malynicz reminded me of another decision of Professor Annand as the Appointed Person in *Adelphoi Ltd v D C Comics*¹⁰ in which she upheld the decision of another Hearing Officer that use of BATMAN and BATSMAN in relation to (mostly) identical goods was likely to cause confusion, despite the different meanings of those words to consumers. However, the marks at issue in that case were highly visually and aurally similar. They were therefore particularly prone to being misread or misheard, one for the other. The marks at issue here, BAKERS and BARKERS BREW, are visually and aurally similar to only a medium degree. The average consumer is deemed to be reasonably observant. Even allowing for the tendency of the human eye to see what it expects to see in some situations, I do not consider that direct confusion is likely amongst consumers for whom the applicant’s mark has the conceptual impact described in the first sentence of this paragraph.

32. Turning to the section of the public who do not immediately see the meaning of BARKERS BREW described above, and who instead see BARKERS as a surname, I acknowledge that there is a higher risk of confusion through the direct misreading/mishearing of the word BARKERS in BARKERS BREW as BAKERS. This is because consumers of pet food may be expecting to see the BAKERS trade mark used in relation to pet food. On the other hand, BAKER and BARKER are common and familiar surnames. The public is generally well accustomed to distinguishing between one surname and another. This experience is liable to mitigate, to some extent, the likelihood of people of this section of the relevant public mistaking the word BARKERS in BARKERS BREW for BAKERS.

34. The section of the public which sees the word BARKERS in BARKERS BREW as a name is likely to attach relatively greater weight to that element of the applicant’s mark (compared to BREW) when it comes to the identification of the commercial source of the goods. However, it does not follow from this that the word BREW makes only a negligible contribution to the distinctive character (and therefore the distinguishing power) of the applicant’s mark. The word BREW may be allusive of a liquid blended product, but in the context of pet food it is, as Mr Malynicz had to accept, a somewhat fanciful way of conveying that message to consumers. As the

¹⁰ BL O/440/13

case law of the CJEU makes clear, consumers normally perceive a trade mark as a whole. I must therefore attach appropriate weight to the fact that the applicant's mark is BARKERS BREW, not just BARKERS. I bear in mind the relevant public are accustomed to trade marks being used together with sub-brands, and the impact this may have on consumers' perception of the likely significance of the word BREW in the mark BARKERS BREW. However, it is also necessary, in that context, to take into account that the opponent does not rely on the use or registration of any existing sub-brand similar to BREW. This means that the sort of confusion under consideration here depends on the proposition that consumers are likely to both a) mistake the name BARKERS for the name BAKERS, and b) assume that BREW is another sub-brand of BAKERS, despite not having seen that sub-brand before, or any similar sub-brand.

35. Taking all relevant factors into account, I do not consider it likely that a significant section of the relevant class of consumers who see the word BARKERS as a name, with the attributes of an average consumer and paying a normal level of attention, is likely to directly mistake BARKERS BREW for BAKERS.

36. It is also necessary to consider the possibility that some relevant consumers could imperfectly recollect one mark for the other. However, I do not consider it likely that any significant section of the relevant class of consumers, with the attributes of average consumer and paying a normal level of attention, is likely to imperfectly recollect BARKERS BREW for BAKERS, or vice versa.

37. I conclude that no significant section of the relevant class of consumers is likely to confuse BARKERS BREW with BAKERS, or otherwise be confused into believing that the user of BARKERS BREW is economically connected to the user of the well known BAKERS trade mark.

38. The opposition under s.5(2)(b) fails accordingly.

The Section 5(3) ground

39. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. 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; *General 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 Saloman, 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*.

(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 proprietor 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*).

40. It is obvious that the earlier mark has the necessary reputation in relation to dog food.

41. In *Intra-Press SAS v OHIM*¹¹, the CJEU stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

42. Consequently, my finding that the respective marks are not sufficiently similar to give rise to a likelihood of confusion does not mean that they are not sufficiently similar for the pet-owning public to call the BAKERS mark to mind when confronted with the mark BARKERS BREW.

43. I must take all relevant factors into account in making the required global assessment of the public making a link between the marks. The identity of the respective goods, and therefore of the consumers of the goods, and the strong reputation of the earlier mark are factors which make it more likely that the relevant public will link the marks. In making this assessment it is again appropriate, as the Appointed Person pointed out, to take into account the public's general familiarity with the use of sub-brands.

44. It might be appropriate to go further and take account of the use of specific material extraneous to the mark applied for where this shows that the applicant subjectively intended to take unfair advantage of the reputation of the earlier mark¹².

¹¹ Joined cases C-581/13P & C-582/13P

¹² See paragraphs 87 and 88 of the judgment of the General Court in Case T 480/12 *The Coca-Cola Company v OHIM*

However, there is no evidence that the applicant copied any of the opponent's sub-brands or marketing materials from which it might be inferred that the applicant intended to take unfair advantage of the BAKERS mark. I do not therefore consider that there is anything of this kind to be taken into account in this case.

45. I find that the degree of similarity between the marks, even in combination with the other factors mentioned above, is insufficient to cause the relevant public to link the applicant's mark with BAKERS. Those who see BARKERS BREW as a fanciful way of designating a blended liquid product for animals are very unlikely to be reminded of the BAKERS mark, which has a very different character.

46. Those consumers who see BARKERS BREW as designating a blended liquid product made by a person or firm called BARKERS are also unlikely, absent confusion between the marks, to make a link between them. After all, the very purpose of surnames like BAKER and BARKER is to distinguish the people with those names from others. There is therefore no reason for someone who recognises the applicant's mark as BARKERS BREW to think about BAKERS.

47. If I am wrong about this I do not consider that the strength of any link that the public might make between the marks would be sufficient for the applicant's mark to receive any marketing boost from the reputation of the BAKERS mark. Mr Malynicz submitted that the applicant's mark might receive more attention from consumers who initially saw it as BAKERS BREW, but then realised their mistake. In other words that the applicant's mark might benefit from so-called initial interest confusion. However, even if there was some fleeting confusion between the marks, the opponent has not shown how or why it would lead to the transfer of the image of the opponent's mark, or of the characteristics which it projects, to the goods identified by the applicant's mark. More likely, once consumers realised that the applicant's mark was not the opponent's mark, they would simply resume their search for the mark they were looking for. Consequently, even if I had found that consumers would make a link between the marks, I would still have rejected the opponent's claim that the applicant's mark would take unfair advantage of the earlier mark.

48. The opponent also initially claimed that the use of BARKERS BREW will be detrimental to the distinctive character of BAKERS. However, Mr Malynicz accepted at the hearing that this ground stood or fell with the s.5(2)(b) ground. Having rejected the opposition under s.5(2)(b), it is not therefore necessary for me to address this part of the s.5(3) grounds of opposition.

49. I therefore reject the s.5(3) ground.

Outcome

50. Subject to further appeal, the opposition is rejected and the mark will be registered.

Costs

51. The Appointed Person set aside the original Hearing Officer's decision on costs and remitted that matter, and the costs of the appeal proceedings, back to the registrar.

52. As I have found that the opposition has failed, the applicant would normally be entitled to a contribution towards its costs. For the reasons set out in paragraphs 44 and 45 of his decision, the original Hearing Officer decided not to award costs to either side. The applicant did not appeal that decision.

53. So far as I can see, the applicant took no active part in the appeal proceedings. The opponent succeeded in having the matter remitted to the registrar, but has ultimately lost the opposition.

54. However, other than confirming that it would like this decision to be made from the papers, the applicant has played no part in the remitted opposition proceedings either.

55. In all the circumstances I adopt the reasoning of the original Hearing Officer so far as the original opposition proceedings and concerned, and likewise make no order for costs for the other stages of the proceedings. I therefore order each side to bear its own costs.

Dated this 8th day of April 2015

**Allan James
For the Registrar**