

O-315-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
No. 2604883
BY VEGECO LIMITED
TO REGISTER THE SERIES OF TWO TRADE MARKS
veggiepets.com
VeggiePets.com
IN CLASS 35**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 103328 BY
JULIA DAWN BARRINGTON-FULLER**

BACKGROUND

1) On 16 December 2011 Vegeco Ltd (hereinafter the applicant), applied to register the following series of two trade marks:

veggiepets.com
VeggiePets.com

2) In respect of the following services in class 35: Retail, mail order and electronic and on-line retail services connected with the sale of animal, pet, dog and cat litter products, bedding for household animals and pets, toys and playthings for pets; advisory and consultancy services relating to all the aforesaid.

3) The application was examined and accepted, and subsequently published for opposition purposes on 3 February 2012 in Trade Marks Journal No.6925.

4) On 1 May 2012 Ms Julia Dawn Barrington-Fuller (hereinafter the opponent) filed a notice of opposition, subsequently amended. The amended ground of opposition is in summary:

The opponent has used the mark VEGGIEPET in the UK since 1998 on pet food. Because of the goodwill and reputation of the opponent in the sign VEGGIEPET, use of the mark in suit would cause misrepresentation and therefore the mark in suit offends against Section 5(4)(a) of the Act.

5) On 6 August 2012, the applicant filed a counterstatement. It denied the ground and stated that it had been using the mark in suit since 2003 in the UK in relation to an online retail service in relation to pet products.

6) Both sides filed evidence and both sides request costs. Neither side wished to be heard in the matter although both provided written submissions.

OPPONENT'S EVIDENCE

7) The opponent herself filed a witness statement dated 29 November 2012. She states that she changed the name of her business from "Pampered Pets" to "Veggiepet" in 1997 and sold vegetarian pet food. The new brand was launched in April 1998. She states that the products were well received and that sales were made. She states that from 2006 -2010 she had to scale back her activities due to the pressures of having a young family and also coping with a serious illness to another family member who had helped with the business. She states that during these four years she effectively sold only to long standing customers. In 2010, when she was thinking of re-launching the business she discovered the applicant's activities and, on legal advice, issued a cease and desist letter. She states that as part of the re-launch she obtained the approval of the Vegetarian Society and signed an agreement with them allowing her to use the "V" symbol on her products. She states that on 5 August 2010 she launched a new website

and also promoted the brand by advertising. She states that she does not want to disclose invoices for the period 2010/2011; as the applicant responded to the cease and desist letter by contacting suppliers to obtain information regarding her business. She does provide a print out from Paypal. Ms Barrington-Fuller states that she has used Google AdWords to promote her mark. She states that her website attracted more than 8,000 hits in the period 20 October 2010 – 20 November 2012. She also provides the following exhibits:

- JDBF1: correspondence with a marketing and graphic design consultant regarding the brand name, stationery and packaging. Dated 1997 /98.
- JDBF2: a copy of a press release issued by Pampered Pets dated April 1998 regarding the launch of range of catfood called Veggiepet. Also copies of advertisements. The press release shows the name “Veggiepet” with a device of a cat and a dog, a device of a three sided rectangle and the strap line “The complete vegetarian food for cats and dogs”. The advertisements are in a magazine called “The Vegetarian” dated Winter 2000, Spring 2001, Summer 2001 and Autumn 2001. A copy of an entry in a directory which has a handwritten date of 2001 is also included but the directory is not identified. There are also two advertisements from “Viva! Life” dated Summer 2000 and Summer 2003. No details as to whether these publications are UK based, the extent of their circulation, whether they are purchased or distributed free are provided. All of the magazine advertisements carry the email address of veggiepet@hotmail.com.
- JBDF3: Copies of 22 invoices. One invoice dated 03.09.02 is for £16.80, two invoices dated 2005 for £59.35, and 19 invoices in 2006 (last dated 10 July) for a total of £590.28. All relate to cat or dog food. All have the name VEGGIEPET at the top of the invoice. The customer addresses cover a large part of the UK.
- JBDF4: Copies of letters from customers. Where these have dates, they are for the period 1998 -2000. Some are orders, others requests for free samples.
- JBDF7: A copy of the agreement with the Vegetarian Society allowing use of the Society’s “V” mark for the period 1 January 2011- 1 January 2012 in return for payment of a licence fee.
- JBDF8: Print out from the new website which has the word “VEGGIEPET” as part of a large device element. Also confirmation of advertising in the Vegetarian Society magazine, for Summer 2011.
- JBDF9: Copies of printouts from Paypal for the period 8 June 2011 – 1 December 2011 totalling £333.70.
- JBDF10: Printouts from Google AdWords. These relate to the period September 2011 –November 2012.

- JBDF11: copy of website report regarding number of visitors to opponent's website. These all appear to refer to 2012.

APPLICANT'S EVIDENCE

8) The applicant filed a witness statement, dated 2 February 2013, by Damian Auke Eadie, a Director of the applicant company. He states that his company was founded in 2003, initially as a sole trader turning into a limited company in 2006. He states that since 2003 he and his company have traded in meat free products for dogs and cats. He states that he conducted research into the marketplace both on the Internet and via catalogues from wholesalers of vegetarian products and pet products. During the course of this research he did not find any references to the opponent. He found a number of other brands for vegetarian pet food and even potential sources of supply from other countries. He decided to use the veggiepet name and registered the ".com.uk" and ".net" versions and in September 2003 began trading. They placed their first advertisement in The Vegetarian magazine in Winter 2003. They also appeared at the National Vegan Festival the same year. He states that business was immediately brisk, although in these years consumers were less used to shopping online. He states that their customers were not necessarily vegetarian themselves, many had pets with allergies to beef or dairy products others had religious issues with products that contained certain meats. He states that as a former web designer he ensured that the website was "keyworded" in order to ensure that it was in the top five of search terms around vegetarian pet food. He also states that at no time did any customer mention the opponent's products or business. Mr Eadie states that he has advertised the business extensively, particularly in magazines, see exhibit DAE1.

9) Mr Eadie states that the opponent traded as Pampered Pets Ltd from its registration in May 1996 until the company was struck off the register on 30 January 2001. He also points out that the domain name veggiepet.co.uk was originally registered in the name of Nigel Barrington-Fuller but lapsed in April 2003 and was therefore unable to be used until it was re-registered by the opponent on 21 July 2010. He makes a number of comments regarding the trading pattern of the opponent and also comments on numerous matters which have been raised in correspondence between the parties. These matters do not assist my decision. He also filed the following exhibits:

- DAE1: Copies of advertisements which show that the applicant has been retailing via the phone, online and post a number of different makes of vegetarian pet food and cruelty free pet products. All show the name of the company as "veggiepets.com". The advertisements were in the following magazines:

The Vegetarian: dated Winter 2003, Summer 2004, Autumn 2004 (first half page advertisement; all subsequent advertisements in this magazine half page unless stated otherwise), Spring 2005, Autumn 2006, Spring 2007, Summer 2007, Autumn 2007 (full page), Spring 2008, Winter 2008, Spring 2009, Autumn 2009 and Spring 2010.

Veggehealth: all half page advertisements, dated Winter 2004, Summer 2005, Autumn 2005, Spring 2006, Winter 2006, Spring 2007, Summer 2007, Winter 2007 and Winter 2008.

Farm Animal Voice: dated Spring 2005 (half page).

Vegan: all half page advertisements, dated Spring 2007, Summer 2007 and Autumn 2007.

Cook Vegetarian: November 2008 (quarter page), April 2009 (full page), August 2009 (quarter page), September 2009 (quarter page), October 2009 (quarter page), February 2010 (quarter page) and December 2010 (half page).

Vegetarian Living: all quarter page advertisements, dated September 2010, October 2010 and November 2010.

Viva Life: all half page advertisements, dated Spring 2006, Autumn/Winter 2006, Spring/Summer 2007 and Winter 2007.

- DAE4: Copies of 30 envelopes dated between 29 April 2010 and 28 November 2011 and 9 cheques dated between 26 February 2010 and 21 November 2011 totalling £707.21.
- DAE5: A list of the UK vegan “fayres” and festivals attended by the applicant which includes at least one per annum from 2003-2009.
- DAE8 & 9: copies of the company registration details for Pampered Pets Limited, initially set up on 3 May 1996. Miss Julia Dawn Fuller is named as the company secretary, but not a director. Also the company is struck off the register on 30 January 2001.
- DAE11: Correspondence with the Vegetarian Society which confirms that the opponent has only ever been authorised to use the Society’s “v” symbol during the period January 2011-January 2012.

OPPONENT’S EVIDENCE IN REPLY

10) The opponent filed three documents, which I take to be witness statements. These are from three individuals who have clearly been sent a proforma statement and have simply had minor details changed. Two state that they have purchased pet food from the opponent for approximately ten years, the third for six years. They identify the product by the name “Veggiepet”.

11) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

12) The only ground of opposition is under section 5(4)(a) which reads:

“5. (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, or

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.”

13) In deciding whether the mark in question offend against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

14) First I must determine the date at which the opponent's claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

"50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000."

15) In the instant case the application date was 16 December 2011. I have to determine whether either party enjoyed goodwill prior to this date. Goodwill was described by Lord Macnaghten in *IRC v Muller & Co's Margarine Ltd* [1901] AC 217 in the following terms:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade. One element may preponderate here and another element there. To analyse goodwill and split it up into its component parts, to pare it down as the Commissioners desire to do until nothing is left but a dry residuum ingrained in the actual place where the business is carried on while everything else is in the air, seem to me to be as useful for practical purposes as it would be to resolve the human body into the various substances of which it is said to be composed. The goodwill of a business is one whole, and in a case like this it must be dealt with as such. For my part, I think that if there is one attribute common to all cases of goodwill it is the attribute of locality. For goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business, and the goodwill perishes with it, though elements remain which may perhaps be gathered up and be revived again."

16) Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Lee Alexander McQueen v Nicholas Steven Croom* BL O-120-04 held:

“45. I understand the correct approach to be as follows. When rival claims are raised with regard to the right to use a trade mark, the rights of the rival claimants fall to be resolved on the basis that within the area of conflict:

- (a) the senior user prevails over the junior user;
- (b) the junior user cannot deny the senior user’s rights;
- (c) the senior user can challenge the junior user unless and until it is inequitable for him to do so.”

17) Goodwill relates to a business. It is generated by the activities of the business; having a name on a company register or a registered trade mark does not generate goodwill. Other than as a registered trade mark, no rights are generated by a word. No rights are engendered by coining a word. Parker J in *Burberrys v J C Cording & Co Ld* [1909] 26 RPC 693 held:

“The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other’s injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but the property in the trade or good-will which will be injured by its use. If the use of a word or a name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business.”

18) I also note that to qualify for protection under the law of passing-off, goodwill must be of more than a trivial nature (*Hart v Relentless Records* [2002] EWHC 1984). However, being a small player does not prevent the law of passing-off from being relied upon (See, for instance, *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49).

19) In *South Cone Inc. v. Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership)* [2002] RPC 19 Pumrey J. in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd’s Application (OVAX)* [1946] 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus, the

evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

20) This cannot be interpreted in a prescriptive fashion. There will be occasions when the evidence does not fall within the above parameters but still establishes goodwill for passing off purposes - see the decision of Professor Annand, sitting as the Appointed Person, in *Loaded* BL 0/191/02.

21) The evidence supplied by both parties is unsatisfactory. However, I must make the best of what has been presented. In doing this I take into account the comments of Lord Macmillian in *Jones v Great Western Railway Company* (1930) 144 LT194 at page 202; where he held that:

“[t]he dividing line between conjecture and inference is often a very difficult one to draw. A conjecture may be plausible but it is of no legal value, for its essence is that it is a mere guess. An inference in the legal sense, on the other hand, is a deduction from the evidence, and if it is a reasonable deduction it may have the validity of legal proof.”

22) Thus I may rely upon inference but I cannot rely upon conjecture. In its evidence the applicant claims that its predecessors in business first used the VEGGIEPET mark in 2003, however no evidence of the acquisition of goodwill was provided, and the applicant only existed legally as of 2006. I will therefore not take into account any evidence from the applicant which is dated prior to 2006. The opponent stated that she started using the mark VEGGIEPET in April 1998 whilst trading as Pampered Pets. However, it would appear from the evidence that Ms Barrington-Fuller was not trading as Pampered Pets but had set up a limited company under this name which was in existence until it was struck off the Register of Companies on 30 January 2001 (exhibits DAE 8 & 9). I will therefore not take into account any evidence from the opponent which is dated prior to 30 January 2001. I shall also ignore any evidence filed by either party after the application date of 16 December 2011.

23) The opponent has shown sales for the years 2002 (£16.80), 2005 (£59.35), 2006 (£590.28) and June 2011-1 December 2011 (£333.70). In a nine year period the opponent sold £1,000.13 worth of cat and dog food under the mark veggiepet. Whilst I accept that there is no deminimis rule in regard to goodwill I have to take into account the highly descriptive nature of the mark and the effect that this would have on the marketplace. To my mind, the public will need to be educated into seeing the sign as an indication of origin as opposed to a highly apt name for vegetarian pet food. As such sales far higher than those evidenced will be required. The opponent also placed three small advertisements in *The Vegetarian* magazine in 2001, and another small advertisement in *Viva! Life* magazine in 2003. Clearly, these did not amount to anything

as no evidence of sales following their appearance has been filed. The applicant is in no better position, having failed to file any sales figures other than copies of cheques dated between 26 February 2010 and 21 November 2011 totalling £707.21. It also demonstrated that it had an extensive advertising campaign in numerous magazines aimed at vegetarians and vegans and given their size these must have been expensive, but no details are provided in the evidence.

24) It is clear that both parties have been advertising in the same magazines to the same audience during the same period from 2006-2011 (*Office Cleaning Services v Westminster Windows* (1946) 63 RPC 39). However, to my mind, considering the evidence of both parties as wholes, neither party could be said to have demonstrated that they enjoyed goodwill under the veggiepet mark at the relevant date. If I take a very lenient stance then both sides could be said to have shown evidence of a concurrent goodwill. I take into account the remarks of Oliver L.J. in *Habib Bank Ltd v Habib Bank AG Zurich* [1982] RPC 1 at 24:

“Where you find that two traders have been concurrently using in the United Kingdom the same or similar names for their goods or businesses, you may well find a factual situation in which neither of them can be said to be guilty of any misrepresentation. Each represents nothing but the truth, that a particular name or mark is associated with his goods or business.”

25) Therefore, even if there is confusion, there is no misrepresentation. The ground of opposition under Section 5(4) therefore fails.

COSTS

26) As the applicant has been successful it is entitled to a contribution towards its costs. I note that the applicant has not been professionally represented and reduce the award of costs in line with this fact.

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering and commenting on the other side's evidence	£300
Submissions	£100
TOTAL	£600

27) I order Ms Julia Dawn Barrington-Fuller to pay Vegeco Limited the sum of £600. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of August 2013

**George W Salthouse
For the Registrar,
the Comptroller-General**