

O/346/21

TRADE MARKS ACT 1994

IN THE MATTER OF:

TRADE MARK APPLICATION NO. 3429743

BY KIND PET PRODUCTS (DALIAN) CO., LTD. TO REGISTER

Diamond feline

IN CLASS 31

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 419256

BY SCHELL & KAMPETER, INC

BACKGROUND AND PLEADINGS

1. KIND PET PRODUCTS (DALIAN) CO., LTD. ('the applicant') applied to register trade mark No. 3429743 "Diamond feline" in the United Kingdom ('UK') (the 'contested mark') on 19 September 2019. It was accepted and published in the Trade Marks Journal on 29 November 2019 in respect of the following goods:

Class 31: *Aromatic sand [litter] for pets; Sanded paper [litter] for pets; Straw litter; Litter peat; Litter for animals.*

2. On 29 January 2020, Schell & Kampeter, Inc ('the opponent') opposed the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). This is on the basis of its trade marks listed in the table below and the opposition is directed against all goods in the application. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act because they were applied for at an earlier date than the contested mark. The details of the earlier marks and the goods relied upon are as follows:

First Earlier Trade Mark	UK Trade Mark no. 3424674 for DIAMOND NATURALS
Goods relied upon	Class 31: <i>Pet foods.</i>
Relevant dates	Filing date: 29 August 2019 Date of entry in register: 22 November 2019

Second Earlier Trade Mark	European Union Trade Mark ('EUTM') no. 11318326 ¹ for DIAMOND
Goods relied upon	Class 31: <i>Pet foods; cat foods and dog foods.</i>

¹ Although the UK has left the European Union ('EU') and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice ('TPN') 2/200 for further information.

Relevant dates	Filing date: 05 November 2012 Date of entry in register: 12 April 2013
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Third Earlier Trade Mark	EUTM no. 16218729 for DIAMOND CARE
Goods relied upon	Class 31: <i>Pet foods.</i>
Relevant dates	Filing date: 30 December 2016 Date of entry in register: 11 May 2017

3. Given the date on which it was registered, the opponent's Second Earlier Trade Mark is subject to proof of use pursuant to section 6A of the Act. The opponent made a statement of use corresponding to the goods on which it relies as set out above. The relevant period is 20 September 2014 to 19 September 2019.
4. The opponent contends that their earlier marks and the contested mark contain identical dominant and distinctive elements, and that the goods covered are similar and complementary. The opponent submits that the term "*feline*" in the contested mark is descriptive and devoid of distinctive character. The opponent submits that as there exists a likelihood of confusion, the contested mark should not proceed to registration and that they are awarded costs.
5. The applicant filed a counterstatement denying the grounds of opposition. They admitted that their mark is "*a little bit similar*" to the opponent's, though not when considered in its entirety, since there are various differences. The applicant focused the differences on the length of the marks and disagreed "*feline*" is descriptive and, rather, submitted "*NATURALS*" and "*CARE*" in the opponent's earlier marks are. The applicant submits that their goods are dissimilar or have a very low degree of similarity with the opponent's earlier marks. The applicant requested that the opponent prove use of their Second Earlier Trade Mark.

6. Only the opponent filed evidence and final written submissions in these proceedings. The evidence will be summarised to the extent that it is considered appropriate. I will refer to these as and where appropriate during this decision.
7. No hearing was requested. This decision is therefore taken following a careful perusal of the papers.
8. Both parties are professionally represented. Barker Brettell represents the opponent and Isabelle Bertaux represents the applicant.
9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

EVIDENCE

10. After the opponent filed its evidence, the Tribunal requested that certain further actions were taken. This included pagination, that weblinks must be clearly set out and presented and that exhibits in non-English were filed under the cover of a witness statement from the translator. The opponent filed a retrospective extension of time via a Form TM9 in order to return its evidence in the amended form. The Tribunal granted this extension.
11. The opponent's evidence is in the form of an affidavit of Mark Schell and witness statements of Tracey Arch and Ana Vesperinas.
12. Across the evidence, the following forms of use are depicted which I set out here for ease of cross-referencing:

(a) "DIAMOND"/"Diamond"

(b) "DIAMOND"/"Diamond" followed by various additional words, such as:

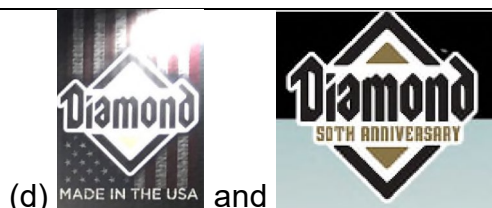
(i) "Diamond Pet Foods"

(ii) "Diamond Premium Adult"

(iii) "DIAMONDPET"

(iv) "DIAMOND CARE"

(v) "Diamond Naturals"



13. Whilst I only summarise part of the evidence below, I have nonetheless taken all of the evidence and submissions into consideration in reaching my decision.

The Affidavit of Mark Schell dated 2 October 2020

14. Mr Schell has been the Vice President of the opponent since 1 January 2008 and his statement is accompanied by 10 exhibits. The opponent is the manufacturer and distributor of pet food products, including treats, canned and dry food for cats and dogs. Mr Schell states that the opponent's online trading activity occurs under the website "*diamondpet.com*", with all of their "*DIAMOND-branded products being sold under the trade marks DIAMOND, DIAMOND CARE, DIAMOND NATURALS,*



and DIAMOND PR089". He states that "*DIAMOND*", the Diamond logo () and "*Diamond Pet Foods*" have been used as the opponent's trading identity for a "*significant period of time*", including in relation to the full product range covered by their earlier marks.

15. Mr Schell adduces images of product labels and stickers for the opponent's various types of pet food bags that bear some of the marks labelled (b) above². He states that these are applied to bags of pet food imported into France from the USA. The product labels/stickers state the trading name is "*Diamond Pet Foods*", with a United States of America ('USA') address. Whilst the labels/stickers themselves are undated, Mr Schell states that "*the same or equivalent labels were being applied and used during the relevant period*". The labels are in French, with the importer noted as either "*N-ID France*" of France or "*Pet Foods International Trading*" of Luxemburg. I have included a sample of the packaging below.

² Exhibit MS1

TABLEAU D'ALIMENTATION

Poids (kg)	Perte de poids (g/jour)	Maintien du poids (g/jour)
2	-	45 g
3,5	60 g	70 g
5,5	70 g	95 g
7	95 g	120 g
9	120 g	-

INFORMATIONS ET MODE D'EMPLOI : Diamond CARE Weight Management est un aliment complet diététique à visée thérapeutique pour le contrôle du poids des chats adultes qui peut être utilisé sur le long terme. Ne convient pas aux chatons. Avant utilisation ou prolongation de la durée d'utilisation, il est recommandé de demander l'avis d'un vétérinaire. Changez l'alimentation de votre animal de manière progressive. Commencez par ajouter une petite quantité de Diamond CARE à l'ancien aliment puis diminuez chaque jour sa quantité pour le remplacer totalement par l'aliment Diamond CARE. La transition doit durer environ 1 semaine ; pour les chats sensibles, allongez la période de transition sur 10 à 14 jours. Veillez à toujours laisser un bol d'eau fraîche à disposition de l'animal.

SP17-06/4

Diamond Naturals® All Life Stages Dog Chicken & Rice

FR - ALIMENT COMPLET AU POULET ET AU RIZ POUR CHIENS DE TOUS ÂGES

COMPOSITION : Poulet (19%), poulet moulu déshydraté (15%), riz brun complet, orge perlé, graisse de poulet (conservée avec des tocophérols mélangés), sorgo, levure séchée, pulpe de betterave séchée, ovo-produit, arôme naturel, graines de lin, huile de saumon (source de DHA), chlorure de potassium, sel, DL-méthionine, chlorure de choline, racine de chicorée séchée, chou kale, graines de chia, citrouille, myrtilles, oranges, quinoa, kelp séché, noix de coco, épinards, carottes, papaye, extrait de yucca schidigera, produit séché issu de la fermentation de Lactobacillus plantarum, produit séché issu de la fermentation de Bacillus subtilis, produit séché issu de la fermentation de Lactobacillus acidophilus, produit séché issu de la fermentation de Enterococcus faecium, produit séché issu de la fermentation de Bifidobacterium animalis, supplément de vitamine E, bêta-carotène, protéinate de fer, protéinate de zinc, protéinate de cuivre, sulfate de fer, sulfate de zinc, sulfate de cuivre, iodure de potassium, mononitrate de thiamine (vitamine B1), protéinate de manganèse, oxyde de manganèse, acide ascorbique, supplément de vitamine A, biotine, niacine, parathénate de calcium, sulfate de manganèse, sélénite de sodium, chlorhydrate de pyridoxine (vitamine B6), supplément de vitamine B12, riboflavine (vitamine B2), supplément de vitamine D, acide folique.

Contient une source de micro-organismes vivants (viabiles) naturellement présents.

CONSTITUANTS ANALYTIQUES GARANTIS : Protéine brute min. 26,0 % min - Matières grasses brutes min. 16,0 % - Cendres brutes 8,0 % - Cellulose brute max. 3,0 % - Humidité max. 10,0 % - DHA (Acide docosahexaénoïque) min. 0,05 % - Zinc min. 150 mg/kg - Sélénium min. 0,35 mg/kg - Vitamine A min. 15 000 UI/kg, Vitamine E min. 150 UI/kg - Acides gras Oméga-6* min. 2,5 % - Acides gras Oméga-3** min. 0,4 % - Micro-organismes* min. 175 000 000 UFC/kg. (Lactobacillus plantarum, Bacillus subtilis, Lactobacillus acidophilus, Enterococcus faecium, Bifidobacterium animalis)
*Non reconnu comme un nutriment essentiel selon les profils nutritionnels d'alimentation canine établis par l'AAFCO (Association of American Feed Control Officials)

Valeur énergétique (énergie métabolisable calculée) : 3 708 kcal/kg (371 kcal/100 g)

QUANTITÉS RECOMMANDÉES (GRAMMES / JOUR)

Poids (kg)	6 - 11 semaines	3 - 4 mois	5 - 7 mois	8 - 12 mois	Chien adulte
2	125 g	120 g	70 g	60 g	45 g
5	210 g	190 g	125 g	95 g	95 g
9	330 g	280 g	210 g	165 g	140 g
14	440 g	375 g	280 g	220 g	190 g
18	530 g	470 g	330 g	260 g	235 g
27	-	610 g	440 g	345 g	305 g
37	-	730 g	515 g	420 g	375 g
45	-	-	610 g	490 g	420 g

Pour les chiens de plus de 45 kg, servez 50 g supplémentaires pour chaque tranche de 5 kg de poids corporel. Pour les chiennes gestantes ou allaitantes, nous recommandons une alimentation à volonté.

Veillez à toujours laisser un bol d'eau fraîche à disposition de votre animal. Conserver dans un endroit frais et sec, à l'abri de la lumière.

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DÉCLARATION AAFCO

L'aliment complet Diamond Naturals All Life Stages Dog Chicken & Rice au poulet et au riz a été formulé conformément aux profils nutritionnels d'alimentation canine pour chiens de tous âges établis par l'AAFCO. Cet aliment convient également aux chiens de grandes races en pleine croissance (pesant plus de 30 kg à l'âge adulte).

Diamond Pet Foods
100 Woodtrail Drive
Gaston, SC, 29053, USA
APHIS: SC-PF0-0003

Importateur FR : N-ID France
Zone Artisanale Les Souhesmes 55220
Les Souhesmes-Rampont FRANCE
Tél. : +33 33 29 87 90 61
Fax: +33 33 29 85 33 80
info@n-id.fr

Importateur BELU :
Pet Foods International Trading
37 Route de Kayl 3514 Dudelange
LUXEMBOURG
Tél. : +352 26 52 10 31
info@petfoods-trading.com

N° de lot et à utiliser de préférence avant... : voir sur le sac.



17. Of the leaflets in English, some of the spellings and measurements used are typical of American English, not British English. For instance, “*flavors*”⁴, “*metabolizable*”⁵, “*fiber*”⁶, “*recognized*”⁷ and the “*cups*” measurement⁸. Most of the leaflets are undated, but some have a copyright date of 2016 or 2017. Mr Schell states that such leaflets “*have been in use since our Company started in the 1970’s*” and are used to “*promote and market our pet foods to customers in market and to potential stockists and distributors at exhibits etc*”. Whilst Mr Schell does not state exactly where the leaflets were distributed, he states that the “*attendee statistics for the exhibitions will provide some indication of level of exposure*”. Some of the photographs of the exhibition materials show some of these leaflets⁹.

18. Mr Schell states that the opponent attends numerous exhibitions around the EU, of which a “*significant amount of activity ... promoting products*” is undertaken. Mr Schell lists 9 EU exhibitions attended within the relevant period¹⁰ and some example attendance figures. The exhibitions have taken place in Germany, Poland,

⁴ See Exhibit MS2, page 15

⁵ See Exhibit MS2, page 17

⁶ See Exhibit MS2, page 57

⁷ See Exhibit MS2, page 111

⁸ See Exhibit MS2, page 22

⁹ For instance, see Exhibit MS6, page 43

¹⁰ For the avoidance of doubt, one of the exhibitions Mr Schell cites precedes the relevant period (Interzoo Germany May/June 2014) and another (Zoorf Expo, Sweden) only states 2019, of which could fall outside the relevant period.

Belgium, England, Italy, Sweden and Spain. Whilst the attendance figures range considerably, each that is mentioned has over 4,000 attendees and 3 of the figures are over 38,000 (for instance, 39,075 trade visitors at Interzoo, Nuremberg 2016, and 38,116 visitors at Animal Day, Poland 2018). The opponent additionally attended the London Vet Show (2018) which is described as “*Europe’s largest veterinary conference and exhibition*”, however I do not have any figures or further evidence supporting this.

19. Mr Schell adduces various photographed display stands and areas which he states are from a “*wide range of European events during 2014, 2016, 2017, 2018 and 2019*”¹¹. The photos show a variety of the marks labelled (b) – (e) either on bags of animal food or on displays and advertising material promoting animal food. Other than 3 photos Mr Schell provides within his affidavit (2 of which are exemplified below as (i) and (ii)), the remaining photos themselves are not timestamped and do not confirm the exhibition at which the photos were taken (see (iii-v)). However, (vi) is promotional material referring to a Spanish website (pronaturalmascotas.es) which accords with a website from Pronatural Mascotas, who is listed as a Spanish distributor offering products from the “*Diamond Care*” brand¹². The Spanish Ministry of Food, Fishing and Agriculture also lists the same party as a distributor of various “*DIAMONDPET*” feed products within their Register of Feed Importers¹³.



¹¹ See Mr Schell’s affidavit, paragraph [8]; Exhibit MS4

¹² See Exhibit MS7

¹³ See Exhibit MS8; Witness Statement of Ana Vesperinas; Exhibit AV1



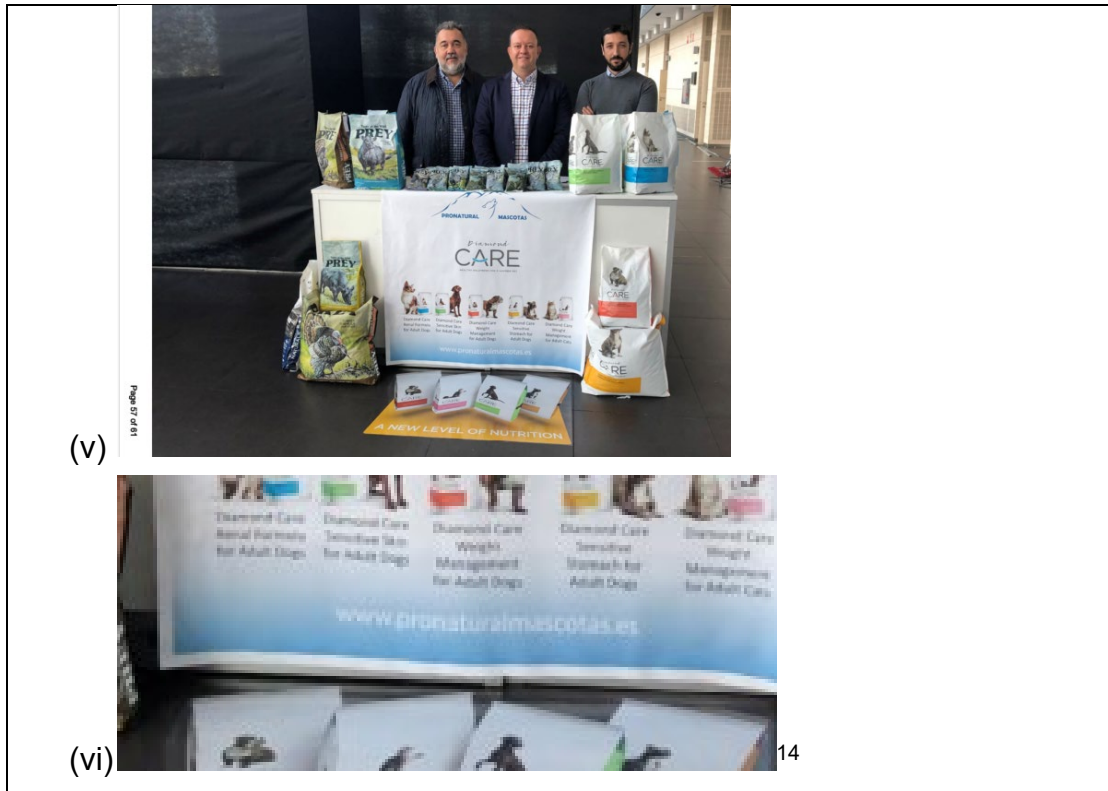
(ii)



(iii)



(iv)



20. Mr Schell states that the opponent produces and distributes various marketing materials for use “*in market*” or as advertisements in third party publications and provides a few examples¹⁵. One is a French excerpt entitled “*NOUVEAUTES N-ID France Juin 2015*” which features photographs of dogs and whilst the advertisement is in French, the article appears to make reference to various ranges of dog food available under the opponent’s marks labelled as (b), (c) and (e). Mr Schell does not confirm where this material was distributed.

21. There are also some examples of the mark labelled (b) from a Polish magazine entitled “*Cztery Tapy*” which Mr Schell states is translated as “*Four paws*” and is a “*free magazine delivered to veterinarian clinics and pet stores throughout Poland*”. The advertisements also include some third-party Polish websites, which Mr Schell states are where their products are also advertised and sold. The distribution or approximate figure of readers is not detailed. Whilst the dates of these magazines are not recorded in English, nor officially translated¹⁶, they are listed on the front

¹⁴ Note this is an enlarged version of the above photograph.

¹⁵ See Exhibit MS3

¹⁶ Exhibit MS3 contains 3 pages that represent themselves as brief translations of the magazine articles from Polish to English. As the source of the translation is unknown, I place little weight on this evidence.

covers as “marzec 3/2018”, “wrzesień 8/2018”, “październik 10/2018” – which I take to mean March, August and October 2018 respectively. For example:

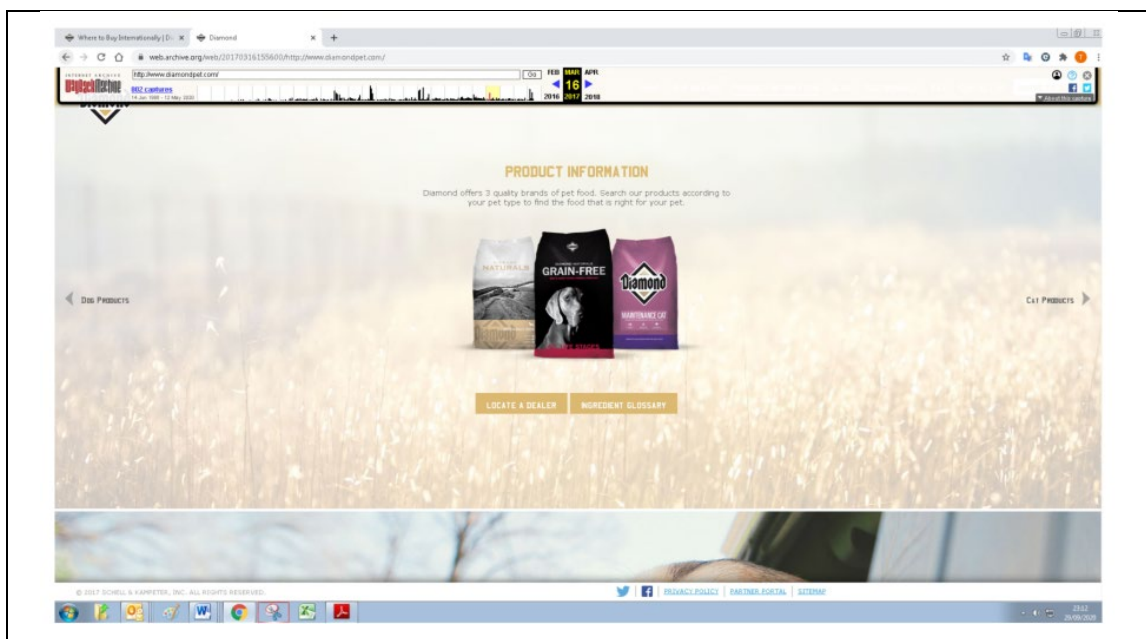


22. Mr Schell also refers to the opponent’s website and provides several screen captures displaying various marks labelled (a), (c) and (d) advertising the brand and by way of labelling on cat and dog food¹⁷. The website also refers to the brand as “Diamond” several times, such as “welcome to the Diamond Family” and “EXPLORE DIAMOND”. Whilst the screen captures are mostly undated, a few show the date of 29 September 2020 and a copyright date of 2020. Mr Schell attests that the screenshots “reflect[s] website content that has been available for some time and certainly during the latter part of the relevant period”. When directing where “Diamond Pet Food” can be bought, the website provides an option to enter your zip code. Under www.diamondpet.com/where-to-buy-internationally/ the UK is listed as an option, with an address for “KENNELPAK LIMITED” based in Nottingham¹⁸. It also lists various other EU countries including France, Denmark, Germany and Greece.

¹⁷ See Exhibit MS5

¹⁸ These accord with invoices mentioned below in paragraph [23]

23. There are also some historic screenshots provided in the form of website captures from the Wayback Machine in the date range 2003 to 2018¹⁹. For instance, on a screenshot dated 16 March 2017 it shows the opponent’s website listing “OUR BRANDS” as “DIAMOND NATURALS ®”, “DIAMOND®” (with the Diamond logo) and “DIAMOND NATURALS® GRAIN-FREE” (in other words, use of the marks labelled (a), (b) and (c)). Another extract of the same date shows photos of dog food products available under “Diamond”, where some marks labelled (b) and (c) are used on the packaging themselves²⁰:



24. Mr Schell states that the opponent operates globally through a network of partner distributors, who “*operate their own websites and undertake marketing/promotional activity*” in respect of the opponent’s products. Mr Schell provides a spreadsheet detailing various distributor webpages and notes which of the opponent’s brands are used²¹. There are 22 entries noted, 9 of which relate to the “*Diamond brand*” and 15 in relation to the “*Diamond Care brand*”. These are across the EU: Portugal (3), Spain (3), France (2), UK (1), Bosnia (1), Cyprus (1), Poland (1), Romania (2), Sweden (6) and Czech (2). There are also various screenshots of these partner

¹⁹ See Exhibit MS5; Mr Schell’s Affidavit, paragraph [13]

²⁰ See Exhibit MS5, pages [12-13]

²¹ Exhibit MS6

distributor websites and other third-party listings of company products (all dated 4 August 2020) that show use of a variety of the marks labelled (a), (b), (c) and (e)²².

25. To evidence sales in the European market, Mr Schell provides various partially redacted invoices in the name of “*Diamond Pet Foods*” also displaying the marks labelled (a) and (e)²³. The invoice and “*visit address*” are noted as “*MO*” and the invoices contain the following information, inter alia:

Invoice and Delivery Address	Order Date	Sales Quantity	Total Invoice amount to Pay
KENNELPAK LIMITED, United Kingdom	16 April 2018	1,717 total sales quantity, comprising of 28 products, of which: <ul style="list-style-type: none"> • 27 include use of the word “<i>DIAMOND</i>” (such as “<i>DIAMOND P/N ... TOW 6/2KG WETLANDS CANINE INTL</i>”) in their descriptions. The sales quantities of these total 1584. 	\$46,020.48
Hajek Pet Food, Czech Republic	27 November 2018	880 total sales quantity comprising of 2 products, of which: <ul style="list-style-type: none"> • 80 are for “<i>DIAMOND 50# PREMIUM ADULT</i>” • 800 are for “<i>DIAMOND 50# HI-ENERGY SPORTING</i>” 	\$20,415.40
Pamas Trading, Romania	7 December 2018	1,605 total sales quantity comprising of 15 products, of which: <ul style="list-style-type: none"> • 5 descriptions include use of the word “<i>DIAMOND</i>” (such as “<i>DIAMOND P/N ... DIA CARE 25# SENSITIVE STOMACH</i>” 	\$43,123.83

²² Exhibit MS7

²³ See Exhibit MS9

		DOG"). The sales quantities of these total 337.	
Pamas Trading, Romania	20 February 2019	1,702 total sales quantity comprising of 20 products, of which: <ul style="list-style-type: none"> 6 descriptions include use of the word "DIAMOND" (such as "DIAMOND P/N ... DIA CARE 25# WEIGHT MANAGEMENT DOG"). The sales quantities of these total 194. 	\$44,811.30.
Invoice: SARL NID, France Delivery: NID FRANCE, France	8 March 2019	1,746 total sales quantity comprising of 10 products, all of which include use of the word "DIAMOND" (such as "DIAMOND P/N ... DIA CARE 15# WEIGHT MANAGEMENT CAT") in their descriptions.	\$49,989.00
BIO 2, Portugal	18 March 2019	1,092 total sales quantity comprising of 1 product entitled "110 (DIAMOND P/N: 110-HT52) DIAMOND 40# PREMIUM ADULT".	\$24,443.44
KENNELPAK LIMITED, UK	6 June 2019	1,796 total sales quantity comprising of 33 products, of which: <ul style="list-style-type: none"> 13 descriptions include use of the word "DIAMOND" (such as "DIAMOND P/N ... DIA CARE 6/8# SENSITIVE STOMACH DOG"). The sales quantities of these total 511. 	\$46,785.72

26. Mr Schell also provides 3 redacted invoices in the period 14 April 2017 – 2 October 2017 from Annabelle Girard of Strasbourg to SARL N-ID France of Boulogny pertaining to English to French translation work covering, for instance, "EN > FR

*translation of Diamond CARE (proofreading inc.) I Made in USA*²⁴. Whilst the opponent has not exemplified the literature translated, Mr Schell states they evidence “*marketing and promotional activity*”. The descriptions on the invoices indicate they are in reference to a mark labelled (b).

27. Mr Schell additionally provides 2 partially redacted forms described as “*copies of credit payments due to a distributor ... the credits being in return for assistance with marketing activities in the local market in association with the Market Assess Program from the USDA*”. Whilst neither details of the program, copies of the marketing activities nor the date range of the activities are given, the forms contain the following information, inter alia²⁵:

Date	Customer	Details
27 September 2018	“1298 – <i>Miramarvet</i> <i>Distribution</i> ” of Romania	It states the promotion/program name of “ <i>Branding with Taste of the Wild in stores & introduction of Diamond Care</i> ” and provides promotion details, including the expectation “ <i>To Extend Product Range in Pet Shop and Consumer, as well as introduction of Diamond Care in th[?]</i> ” ²⁶ and to increase sales volume. It notes the results as “ <i>Increase Sales Volume</i> ”, “ <i>To Introduce Our Brand to the customer</i> ” and “ <i>Increase the relationship with our customer</i> ”.
12 December 2018	“1212 – <i>Kennelpak</i> <i>Limited</i> ” of the UK	It states the promotion/program name of “ <i>MDF support for marketing Taste Of the Wild, & Diamond Care</i> ” [sic] and various promotion details. This includes “ <i>Branding with Diamond Care The London Vet show stand for the exhibition during November 2018. Printing catalog for the London Vet Show. Crufts Show</i> ” [sic] and one of the promotion’s expectations

²⁴ See Exhibit MS10

²⁵ See Exhibit MS10

²⁶ The rest of this wording has been cropped from Exhibit MS10, see page 8.

		<p>being <i>“Marketing presence in the stores with Taste of the Wild and Diamond Care in the most important show at UK”</i> [sic]. It notes the results as <i>“Increase Sales Volume”, “To Introduce Our Brand to the new retailers and vets”</i> and <i>“Increase the relationship with our customer”</i>.</p>
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28. The evidence also contains 3 screenshots dated 29 September 2020 of the opponent’s Facebook page, which has 39,903 likes²⁷. The screenshots show the brand name as *“Diamond Pet Foods”*, with use of the Diamond logo as its profile/page picture and the page creation date of 30 July 2011. The business is listed as *“Pet supplies”* and the opponent’s website is noted.

The Witness Statement of Tracy Arch dated 5 October 2020

29. Ms Arch is an attorney, partner and lead counsel acting on behalf of the opponent in these proceedings and her statement is accompanied by 1 exhibit. The purpose of her witness statement is to refute the applicant’s submissions on the differences between the goods covered by the respective marks. Ms Arch provides evidence to show that *“the goods of interest of the respective parties are indeed complementary or closely similar”*²⁸. This is in the form of 2 photographs taken in a *“supermarket chain store in Shirley, West Midlands”* on 2 August 2020, 1 of which I have included below. The photographs show cat food products offered for sale alongside cat litter products.

²⁷ See Exhibit MS5

²⁸ Exhibit TAA1



The Witness Statement of Ana Vesperinas dated 26 October 2020

30. Ms Vesperinas is a trainee patent attorney of the opponent and is a Spanish national, with Spanish being her “*mother tongue*”. Ms Vesperinas’ statement is accompanied by 1 exhibit and the purpose is to verify an English translation of a Spanish document exhibited in Mr Schell’s affidavit²⁹.

31. Ms Vesperinas has translated the document into English, as containing the following information, inter alia;

- a. The original document is dated 26 September 2018 and issued by the Ministry of Food, Fishing and Agriculture in Spain;
- b. The documentation is a “*Register of Feed Importers*” and notes the business “*PRONATURAL MASCOTAS, S.L*” of Spain are now importing new products under a provider named as “*DIAMONDPET*”;
- c. The new product data includes “*feed products*” including “*DIAMOND CARE WEIGHT MANAGEMENT*”, “*DIAMOND PREMIUM*” and “*DIAMOND HY ENERGY*” etc (i.e. the marks labelled (b)).

²⁹ See Exhibit MS8, Witness Statement of Ana Vesperinas and Exhibit AV1

DECISION

Section 5(2)(b)

32. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

“5(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 of association with the earlier trade mark”.

33. The opponent has based their opposition on three earlier marks. As the opponent's Second Earlier Trade Mark is subject to proof of use, for simplicity, I will begin my assessment by first considering the opponent's First Earlier Trade Mark and Third Earlier Trade Mark. As both of these earlier marks contain the word “DIAMOND” followed by a fairly non-distinctive word (“CARE/“NATURALS”) and have an identical specification, my below analysis applies to both marks relied upon, but for which I will refer to in the singular, as the ‘earlier trade mark’. I will, though, keep in mind the differences between the earlier marks and will differentiate between them as and when relevant.

34. 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.

The principles

- (a) The likelihood of confusion must be appreciated, 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

35. The opponent contends that the contested mark covers goods that are similar and complementary, since the respective goods are sold in close proximity in retail environments and purchased through the same trade channels. The opponent submits that pet foods and pet litter goods both form part of the pet products and services industry. The opponent has adduced some evidence in support of this. This includes, inter alia, two photographs from a West Midlands supermarket showing cat food products being sold in the sale aisle and alongside cat litter products³⁰ and an undated screenshot from amazon.co.uk within which there is a “*pet supplies*” categorisation - though it is not illustrated which exact products are available under this category³¹. I also have sight of an undated extract from the British Library referring to the “*Pet Products and Services Industry Guide*”, which lists some industry overviews and reports which state pet products/supplies as a

³⁰ Exhibit TAA1

³¹ See the opponent’s Written Submissions, paragraph [25]

general term (without sub-categorisation) or explicitly mention either pet litter or pet food³².

36. Although the applicant denies that there is any similarity between the contested goods, largely on the basis that the goods are not similar and do not correspond “to the same category of products”, they also state that the goods are similar to a “very low degree”³³.

37. In the judgment of the Court of Justice of the European Union (‘CJEU’) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*, Case C-39/97, the court stated at paragraph [23] of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

38. The relevant factors for assessing similarity were identified by Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At paragraph [296], he identified the following:

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

(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;

³² See the opponent’s Written Submissions, paragraph [23]. This extract

³³ See the applicant’s Form TM8, paragraph [8] and their Counterstatement, pages [9] and [11]

(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.”*

39. In respect of the complementarity between goods, I point towards *Boston Scientific Ltd v OHIM*, Case T-325/06, where the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

40. With the above factors in mind, the goods for comparison are as follows:

Opponent's goods	Class 31: <i>Pet foods.</i>
Applicant's goods	Class 31: <i>Aromatic sand [litter] for pets; Sanded paper [litter] for pets; Straw litter; Litter peat; Litter for animals.</i>

41. The applied for specification is for various types of animal/pet litter, which are purchased by pet owners to manage the said pet's toileting/waste disposal. In comparison, the opponent's pet food is purchased by pet owners to feed their pet. The use and nature of the two products clearly differ. Whilst the respective goods share an average consumer and enable the care of pets, they differ in their specific purpose: one is for toilet management whereas the other is for sustenance. I have evidence of an overlap in industry and proximity in trading channels, including

shared supermarket aisles – albeit within slightly different sections. However, I do not have evidence showing an overlap in producer and, in my experience, I consider in some trade channels, such as a pet store, the goods will be in different aisles. The average consumer would not buy pet food instead of pet litter (or vice versa) and, thus, there is no competition. In respect of complementarity, one is not important or indispensable for the use of the other, nor are they used together. There is no link, beyond being goods for pets, which would lead to the consumer to think that the responsibility of for these parties' goods would lie with the same undertaking.

42. Overall, I find that the goods are similar, but only to a very low degree.

Average consumer and the purchasing act

43. As the case law 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.

44. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question³⁴. 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. 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

³⁴ See *Lloyd Schuhfabrik Meyer & Co. GmbH*

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

45. All the goods at issue are items for pets, so the average consumer will be the pet owning general public. The goods are sold in retail outlets (physical and online) and potentially veterinary practices. The marks used in relation to them may be seen in advertisements and catalogues. Pet food and litter is typically inexpensive and purchased frequently and when selected, the average consumer will apply a degree of care given that their pet will either consume the product or will be used to manage the pet's toileting. For instance, the average consumer may consider the ingredients within the pet food and what the pet litter is made from. Overall, I consider that the selection process will be a largely visual process (although I will not discount aural use completely), with a low to medium degree of care and consideration being deployed.

Comparison of marks

46. It is clear from *Sabel BV v Puma AG* (particularly paragraph [23]) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. 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.”

47. 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.

48. The respective trade marks are shown below:

Earlier trade marks	Contested trade mark
<p>First Earlier Trade Mark: DIAMOND NATURALS</p>	<p>Diamond feline</p>
<p>Third Earlier Trade Mark: DIAMOND CARE</p>	

49. The opponent submits that the contested mark has a high visual, conceptual and aural similarity to their earlier mark. They submit that the contested mark shares the same dominant and distinctive word as their earlier mark, which is coupled with a secondary term of a *“descriptive or non-distinctive nature”*³⁵. They state that *“‘NATURALS’ is likely to imply natural, wholesome ingredients, [and] the term ‘CARE’ suggestive of products intended for those pets requiring additional support or nutrition, where for example there may be underlying health issues, age related issues etc”*³⁶. Further, that *“feline”* in the contested mark is descriptive: it *“will be seen to have a clear and recognisable meaning in the context of the goods in question, namely pet litter goods intended for cats, the term being a recognised adjective for anything relating/pertaining to or affecting cats or other members of the cat family”*³⁷. Thus, that the contested mark refers to *“‘DIAMOND’ branded goods for cats”*³⁸. The opponent also submits that *“all three of the elements ‘FELINE’, ‘NATURAL(S)’ and ‘CARE’ are popular terms within the relevant market sector and in common use”*³⁹.

³⁵ See the opponent’s Written Submissions, paragraph [36]

³⁶ *ibid*

³⁷ See the opponent’s Written Submissions, paragraph [34]

³⁸ *ibid*

³⁹ See the opponent’s Written Submissions, paragraph [37]

50. The applicant states that the marks are “*somewhat a little bit similar, only to the extent that they use the same common word*”⁴⁰. However, there are visual, phonetic and conceptual distinctions when the marks are viewed in their entirety (particularly considering their differing lettering and lengths). The applicant also submits that “*feline*” in the contested mark is “*not in any way descriptive on the origin of the products in question*” and, when conjoined with “*Diamond*”, it will be conceptually understood as relating to “*precious feline*”⁴¹.

Overall impression

The applicant’s contested mark

51. The applicant’s mark is a word mark consisting of the words “*Diamond feline*” in normal font. The “*Diamond*” element is at the forefront and is the more memorable and distinctive element in the overall impression. The “*feline*” element appears to describe the type of animal for some of the goods applied for, which is not uncommon in the pet food industry. I consider “*feline*” carries less weight in the overall impression of the mark.

The opponent’s earlier trade mark

The opponent’s first and third earlier trade marks are both word marks that, respectively, consist of the words “*DIAMOND NATURALS*” and “*DIAMOND CARE*” in normal font. The overall impression lies in the words themselves, within which the dominant and distinctive element of both marks is the first word, “*DIAMOND*”, of which the second elements are both descriptive and are of secondary importance.

⁴⁰ See the applicant’s Counterstatement, pages [5]

⁴¹ See the applicant’s Counterstatement, pages [5]-[6]

Visual comparison

52. Each of the marks contain the word “*Diamond*”/“*DIAMOND*” at their respective beginnings; this represents a clear and obvious point of similarity. The absence/presence of the word “*feline*” and “*NATURALS*”/“*CARE*” creates points of difference. The different casing used is not a difference since a ‘word mark’ protects the word itself, not its capitalisation⁴². I consider there is a medium degree of visual similarity.

Aural comparison

53. The same similarities and differences mentioned above also apply here, with the point of similarity being articulated in the same way (‘dieh-mund’), but there are differences due to the additional elements “—fe-line”, ‘—cair’ or ‘—nat-trals’. Overall, there is a medium degree of aural similarity.

Conceptual comparison

54. Both marks share the word ‘diamond’, which is an English word used to refer to a four-sided shape and/or type of precious stone. The word is also used to indicate a high quality or level of standard. Both marks evoke an idea around this ‘diamond’ concept – whatever the meaning prescribed. When this shared element is conjoined with components such as “*feline*”, “*NATURALS*” and/or “*CARE*” which are fairly descriptive of the goods available under the mark, there is a high degree of conceptual similarity between the respective marks.

Distinctive character of the earlier trade mark

55. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of

⁴² See in particular paragraph [21] of Mr Iain Purvis QC, sitting as the Appointed Person, in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14.

confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer & Co. GmbH* 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).”*

56. Registered trade marks can possess various degrees of inherent distinctive character, ranging from the low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

57. Starting with the inherent characteristics, the opponent's earlier mark consists of the words “*DIAMOND CARE*” or “*DIAMOND NATURALS*”. ‘Diamond’ is a known word referring to a precious stone or shape and can sometimes be viewed as a reference to a higher standard (among other meanings). I do not consider there is an obvious specific connection to the goods for which the earlier mark is registered

(pet food), but the word “DIAMOND” is generally allusive or suggestive of goods of a certain/high standard or quality. The words “NATURALS” and “CARE” add nothing material in terms of distinctiveness, and, in any event, it is the distinctiveness of the common element, “DIAMOND”, which matters. The allusiveness/suggestiveness is not so strong that I would regard it as a very weak mark, but I nevertheless find both marks have a low to medium degree of inherent distinctiveness for the reasons explained.

58. In this case, the opponent has stated that the proof of use evidence demonstrates “... *consistent and wide-spread use of the Opponent’s Earlier Marks within relevant trade circles and the familiarity and reputation of those marks ... will have enhanced their inherent distinctiveness*”⁴³. The assessment needs to be made from the perspective of the UK average consumer, as that is who must be likely to be confused. Although I have evidence of these earlier marks being used, including in relation to sales, I have little or no evidence in respect of UK use for some years and neither do I have information about the market as a whole. The level of turnover is relatively modest and I only have evidence of one UK customer/distributor. On balance, I do not consider the evidence filed by the opponent to be sufficient to demonstrate enhanced distinctiveness in the UK.

Likelihood of Confusion

59. 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. I point particularly to the principles I referred above in paragraph 34. One of these 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 earlier trade mark, 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

⁴³ See the opponent’s Written Submissions, paragraph [49]

opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

60. There are two types of possible confusion: direct (where the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). The distinction between these was explained by Mr Iain Purvis Q.C (sitting as the Appointed Person) in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C.:

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

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

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

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

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

For the avoidance of doubt, I acknowledge that these three categories are just illustrative – Mr Purvis QC stated that indirect confusion ‘tends’ to fall in one of them.

61. The parties’ marks clearly share a dominant ‘*Diamond*’ element. Even if it is considered that this shared element has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion⁴⁴. Rather, it is still necessary to undertake a global assessment. Although pet food and pet litter have some overlapping trade channels and some superficial aspects of similarity, the similarity is to a very low degree, at most. There is neither any complementarity nor competitiveness between the goods. Notwithstanding that the similarity between the respective marks and common ‘*Diamond*’ element pushes towards finding a likelihood of confusion, the shared element not being particularly distinctive pushes against this finding. Upon analysing all of the relevant factors, including the distance between the goods, direct confusion is not likely. This is irrespective of any imperfect recollection.

62. Whilst the shared element may lead the average consumer to recall the other marks or wonder if there is a connection between them, I do not think there is enough for indirect confusion. This is particularly the case given that the goods are only of very low similarity and the common element not particularly distinctive. I consider that the average consumer would consider the similarities between the

⁴⁴ See in particular *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), paragraphs [18-21]

marks as a mere coincidence as opposed to being indicative of economic connection.

Comparison with the opponent's Second Earlier Trade Mark

63. As the opponent's First and Third Earlier Trade Marks lead to the opposition being unsuccessful, I will now consider the opponent's Second Earlier Trade Mark upon which the opposition is based. As this mark is subject to proof of use, it is necessary to analyse whether the opponent has proved that their mark has been used, I will come to that shortly. In terms of the marks themselves, much of my earlier analysis is applicable. In terms of whether the Second Earlier Trade Mark creates a likelihood of confusion, my views are as follows:

- a. The earlier goods analysis still applies since the additional terms covered in the specification of the earlier mark are contained within "*pet foods*" (as analysed earlier).
- b. The average consumer and the selection process remain the same.
- c. The overall impression of the earlier mark lies in the word "*DIAMOND*" by itself. Comparing this to the contested mark, there is a slightly heightened degree of visual and aural similarity (to a medium to high degree). Though, the marks still have a medium degree of conceptual similarity.
- d. The earlier distinctiveness analysis remains the same – in other words, I do not have enough evidence to find "*DIAMOND*" has enhanced distinctive character. It, therefore, has a low to medium degree of inherent distinctiveness.

64. Notwithstanding that the opponent's Second Earlier Trade Mark has a slightly increased similarity to the contested mark, the factors and assessment do not materially change. Neither does my finding. Therefore, I still do not find a likelihood of confusion, whether direct or indirect. The common presence of "*DIAMOND*" within each mark will be put down to coincidence not economic connection. When

I also bear in mind the differences between the goods and marks along with the distinctiveness of the common element, there will be no likelihood of confusion.

Proof of Use

65. Given the findings I have made thus far, the assessment I make below is only relevant in the event that my findings are overturned on appeal. I will thus state the position more shortly than I otherwise would have done.

66. The proof of use provisions are found in section 6A of the Act, which state:

“(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), (b) 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

67. Mr Schell (Vice President of the opponent) incorrectly states that the relevant period for assessing whether there has been genuine use of the opponent's mark is "18 September 2012 – 18 September 2019". The written submissions also incorrectly state the period as "18 September 2014 – 18 September 2019". As the date of the application in issue is 19 September 2019, taking this date back 5 years, the relevant period is 20 September 2014 to 19 September 2019.

68. The onus is on the opponent, as proprietor of the earlier mark, to show use of it⁴⁵. As the Second Earlier Trade Mark is an EUTM, the opponent must show use of that mark in the EU⁴⁶. In accordance with the relevant case law⁴⁷, whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the EU during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown

Form of the mark

69. Throughout its evidence, the opponent has used its mark in several ways. I have set these out in paragraph 12 above. The Second Earlier Trade Mark is a word mark. Registration of a word mark protects that word written in any normal font, irrespective of capitalisation⁴⁸. The opponent's use of "DIAMOND" alone (i.e. the mark labelled (a)) is use of the mark as registered. Therefore, such use can clearly

⁴⁵ See section 100 of the Act

⁴⁶ For instance, see the CJEU at paragraph [36] in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11

⁴⁷ In particular, this includes that summarised by Arnold J (as he then was) in *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) at paragraphs [114-115]

⁴⁸ See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph [16]

be relied upon. I additionally find that use of this mark followed by descriptive words like “*PET FOOD*”, “*NATURALS*” and “*CARE*” (i.e. the marks labelled (b)) are examples of the mark being used in the same format as registered, albeit presented alongside other words. These forms of use meet the test laid down in cases such as *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12. This is irrespective that sometimes the word “*DIAMOND*” is stylised (such as in the “*DIAMOND CARE*” examples) as such stylisation is just “*an expression of the registered word mark in normal and fair use*” as per *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19.

70. As the opponent has also used the marks labelled (c)-(e) during the relevant period, I will now assess these marks to see whether they cover use of the mark as registered or of an acceptable variant.

71. When concerning the use of one mark with, or as part of, another mark, the case of *Colloseum* (mentioned above) is of significance⁴⁹. When analysing use of the mark in a differing form, I bear in mind the comments of Mr Richard Arnold Q.C. (as he then was) as the Appointed Person in *Nirvana Trade Mark*, BL O/262/06⁵⁰. I have also borne in mind the decision of *Hyphen GmbH v EU IPO*, Case T-146/15




where the General Court held that use of



constituted use of the registered mark () since the addition of a circle (being merely a banal surrounding for the registered mark) did not alter the distinctive character of the mark as registered. The court also held that, although it was relatively more distinctive than the registered mark, the addition of the word “*Hyphen*” to the registered mark in a circle neither altered the distinctive character of the registered mark.

⁴⁹ See paragraphs [31-35] in particular

⁵⁰ See paragraphs [33-34] in particular

Marks labelled (c) and (d) ( and ;  and  respectively)

72. These device marks fully incorporate the mark as registered, in a stylised blackletter-like scripture within a double diamond element. I find the pointed stylised typeface edging and diamond shape reinforce the mark itself (“DIAMOND”). I consider that the use meets the *Colloseum* test in that the word “DIAMOND” retains its independent distinctive role and continues to indicate origin alone. I find that this is use of the mark as registered, upon which the opponent can rely.

73. Nevertheless, should this be incorrect, I find that these uses qualify as acceptable variants in accordance with *Nirvana*. This is given that the other aspects are either stylisations or background devices which do not alter the distinctive character of the registered mark “DIAMOND”.

Marks labelled (e) ( and )

74. As per *Nirvana*, I find that these are examples of acceptable variant uses of the opponent’s mark as registered. This is bearing in mind that the distinctive character of the earlier mark is in the word “DIAMOND” itself and the use of this word with a star graphic instead of the tittle on the ‘i’ and its positioning in a diamond shape does not alter its distinctive character of the mark as registered.

Sufficient Use

75. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself⁵¹. The opponent's evidence which is undated and outside the relevant period does not assist the opponent in the assessment of proof of use.

76. The opponent has not provided any figures for the size of the EU market for pet food, though I would believe it to be reasonably large. Although the evidence could have been better in some respects, when considered in its totality, I am satisfied that the opponent's use of its Second Earlier Trade Mark in various EU countries is sufficient for creating or preserving a market share. Whilst I find that use of the mark as registered (i.e. "DIAMOND" as labelled in the forms (a)-(b)) is enough to demonstrate this, should I be incorrect in making that finding and that use of the registered mark is not enough on its own, I consider use of the marks labelled (c)-(e) further demonstrate genuine use of the mark. I make the following key points:

- a. The opponent's invoices example the registered mark in use by way of



the trading name, Diamond Pet Food, and many products using "DIAMOND" in some form within their description⁵². They evidence that EU sales of pet food amounted to at least \$109,559 in 2018 and \$166,029 in 2019.

- b. The opponent's list of distributors indicates their exposure in several EU countries (such as the UK, France, Portugal and Sweden)⁵³. When I corroborate this list with other evidence (such as the invoices and a document from the Spanish Register of Feed Importers⁵⁴), I have evidence that many of the EU distributors have offered dog and/or cat

⁵¹ See *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09

⁵² See Exhibit MS9

⁵³ See Exhibits MS5 and MS6

⁵⁴ See Witness Statement of Ms Vesperinas, Exhibit AV1 and Exhibit MS8

food products with descriptions containing the registered mark within the relevant period. The product labels and stickers applied to the opponent's bags of pet food also bear the opponent's trading name and the registered mark⁵⁵. In light of all the evidence⁵⁶, I am prepared to accept Mr Schell's comments that the same (or "equivalent") labels were applied to pet food imported into, at least, France in the relevant period.

- c. The opponent has undertaken various types of EU-wide advertising bearing the mark⁵⁷. This includes producing and distributing pet food marketing materials⁵⁸, promotional programs⁵⁹ and disseminating various product leaflets advertising pet food⁶⁰. Although only a few product leaflets are dated, Mr Schell confirms that the leaflets were available during the relevant period and marketed at exhibitions.
- d. The opponent has promoted their products (mostly via dog and cat food bags and promotional material⁶¹) at various EU exhibitions in at least 7 different countries; 3 of which have over 100,000 visitors in attendance combined (Interzoo (Nuremberg) in June 2016 and 2018; Zoomark (Bologna) in May 2019). The 3 photos which are timestamped within the relevant period pertaining to Interzoo and Zoomark⁶² bear the registered mark and a variant form⁶³.

77. The evidence justifies use not only in relation to dog and cat food (which are the actual goods on which use has been shown) but given the case-law on a fair specification⁶⁴, it can also relate to pet food as per the statement of use. I,

⁵⁵ See Exhibit MS1 displaying use of the mark labelled (b)

⁵⁶ For instance, Exhibit MS6, pages [10] and [11] of Exhibit MS5 and pages [9] and [10] of Exhibit MS9 all refer to the same French party (N-ID France), among others.

⁵⁷ This is in the form of a variety of the marks labelled (b) – (e)

⁵⁸ See Exhibit MS3 and Exhibit MS10

⁵⁹ See Exhibit MS10, particularly pages [8] and [9]

⁶⁰ See Exhibit MS2

⁶¹ See Exhibit MS4

⁶² See Mr Schell's Affidavit, paragraph [8]

⁶³ This is in the form of the marks labelled (b), (c) and (e)

⁶⁴ See the summary of Mr Geoffrey Hobbs Q.C. as the Appointed Person at lines [22-25] of page 10 and lines [1-4] of page 11 of *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10

therefore, find a fair specification to be that which the opponent has registered:
“Pet foods; cat foods and dog foods”.

CONCLUSION

78. The opposition under section 5(2)(b) of the Act has been unsuccessful. Subject to any successful appeal against my decision, the application can proceed to registration for the full range of goods applied for.

COSTS

79. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of TPN 2 of 2016. Using that TPN as a guide, I award the applicant the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side’s statement: £200

Considering the other side’s evidence: £500

80. I therefore order Schell & Kampeter Inc to pay KIND PET PRODUCTS (DALIAN) CO., LTD. the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 10th day of May 2021

B Wheeler-Fowler
For the Registrar