

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2178649 BY
JOHN LYNDON JAMES
TO REGISTER A TRADE MARK IN CLASSES 18, 28 AND 31**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 50296
BY FADULLA LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2178649
by John Lyndon James to register a Trade Mark
in Classes 18, 28 and 31**

AND

**IN THE MATTER OF Opposition thereto under No. 50296
by Fadulla Limited**

BACKGROUND

1. On 2 October 1998, John Lyndon James of Cinderford, Gloucestershire, applied to register the trade mark shown below in Classes 18, 28 and 31.



2. The application was examined and was subsequently published for the following range of goods:

Class 18

“Leads, harnesses, leashes and collars; all for animals”.

Class 28

“Toys and playthings for animals”.

Class 31

“Foodstuffs for animals; bird foods; grain seeds and nuts for animal consumption; dried foods for animal consumption; cat foods; dog foods; fish foods; treats being foods for dogs, cats, birds and fish”.

3. The application is opposed by Fadulla Limited of Billericay, Essex. The opposition is based upon the following:

Section 3(1)(b) - because the trade mark is prima facie devoid of any distinctive character.

Section 3(1)(c) - because the trade mark is prima facie a sign which may serve in trade to designate the intended purpose or other characteristics of the goods.

Section 3(1)(d) - because the trade mark is a sign which is customary in the current language or established practices of the trade.

Section 5(4)(a) - because the opponent has widely used the trade mark OUR PET and as such has accrued significant goodwill, part of which vests in the said trade mark. In the circumstances the trade mark applied for is liable to be prevented by virtue of the law of passing off.

Section 3(6) - Because the applicant's trade mark application has been filed in bad faith and as such offends against the provisions of Section 3(6) of the Act.

4. The applicant filed a Counter-Statement which, in essence, consists of a denial of the various grounds of opposition.

5. Both sides filed evidence and both seek an award of costs. In accordance with Trade Marks Registry practice, the case was reviewed by a Hearing Officer who advised the parties that, in his view, it was not necessary for a Hearing to be held to decide the matter; the parties were however reminded of their right to be heard. In the event, neither party requested a Hearing or filed written submissions.

Opponents' evidence

6. This consists of a statutory declaration dated 15 August 2000 by Alan David Paul Newman. Mr Newman explains that he is the Managing Director of the opponents a position he has held since the creation of the Company in 1981; he confirms that he has access to all the relevant records and information relating to the use of the trade mark OUR PET, and has the necessary authority to make his declaration on the Company's behalf; he adds that the information in his declaration comes from his own knowledge or from the records mentioned.

7. Mr Newman states that his Company first used the trade mark OUR PET in the United Kingdom in relation to pet products including dogs toys, cat toys, chains, leads and brushes in April 1997 and that use has been continuous throughout the United Kingdom since that date. He goes on to explain that an application was made by the opponents to register the trade mark OUR PET in the United Kingdom in June 1997 but this application was rejected by the Trade Marks Registry on the basis that it was devoid of distinctive character.

8. The Company has not, explains Mr Newman, maintained separate records of the value of sales of goods under the OUR PET trade mark, but he estimates that since its first use in 1997

the approximate percentage of his Company's sales attributable to this trade mark was 50% in 1997 and at least 75% for 1998 and 1999. The Company's total sales figures during this period are shown below together with the percentage of sales under the OUR PET trade mark.

<u>Year</u>	<u>Total Sales</u>	<u>OUR PET sales</u>
1997	£750,349	£375,174
1998	£572, 993	£429,744
1999	£702,866	£527,149

Exhibit ADPN-1 is said to consist of a range of invoices from the opponents' suppliers demonstrating that goods bearing the OUR PET trade mark have been ordered by them for delivery to the United Kingdom; also included are invoices issued by the opponents to customers in the United Kingdom all of which are said to relate to sales of goods under the OUR PET trade mark.

9. Paragraph 5 of Mr Newman's declaration is reproduced verbatim below:

"5. Mr John Lyndon James was a freelance agent commissioned by Fadulla Limited in September 1993 as a salesman. Mr James was paid commission, but unfortunately a dispute arose relating to Mr James offering his own goods in preference to Fadulla Limited's products. Mr James made claims against Fadulla after an amicable verbal agreement to end the contract between us of 1 September 1993 was disregarded. Specifically commission was invoiced by Mr James from 1 September 1993 to September 1996. There is now produced and shown to me marked ADPN-2 two invoices illustrating the point. There is now produced and shown to me marked ADPN-3 an invoice issued by Harvey Copping and Harrison Solicitors who were dealing on our behalf in the matter of the dispute relating to the contract. After we terminated our relationship with Mr James he remained active in the pet trade from 1996 to date and must have become aware of my Company's usage of OUR PET in 1997. Not only was he selling products to the same customers as my Company, but he attended the Pet Index Exhibition at the NEC in April 1998, where my Company exhibited OUR PET products. There is now produced and shown to me marked ADPN-4, true copies of pages from the Pet Index show catalogue from 1994 to 1999."

10. Mr Newman explains that his Company have promoted their OUR PET trade mark mainly by the issuing of price lists and catalogues to the pet trade and by attendance at the Pet Index Exhibition at the NEC in 1998, 1999 and 2000. The Pet Index exhibition is, says Mr Newman, the most prestigious exhibition relating to the pet trade in the United Kingdom and is held annually; exhibit ADPN-5 is a copy of the show catalogue for April 2000. Exhibits ADPN-6 and ADPN-7 consist respectively of: examples of promotional use of the OUR PET trade mark on header sheets for Christmas gifts distributed between Summer and Autumn of 1998 and recent catalogue sheets showing continued use of the OUR PET trade mark; similar

catalogue sheets were, says Mr Newman, produced in 1997 and 1998.

11. Exhibit ADPN-8 consists of two letters; these are from, explains Mr Newman, printers who produce labels and header cards for his Company. The letters are from Antiphap Press (dated 14 July 2002) and Vinyl Concepts Company of Hong Kong (dated 13 July 2000). Both are open letters addressed to “To whom it may concern”; the letters are signed by the Managing Director of Antiphap Press and an authorised signatory of Vinyl Concepts Company. They read as follows:

Antiphap Press

“To whom it may concern

We have printed labels for bulk chews and header cards for pre-packed dog chews for Fadulla Ltd with the OUR PET brand since April 1997.”

Vinyl Concepts Company

“To whom it may concern

We have printed and sent dog stockings, cat stockings, cat toys, dog toys and dog leads with the OUR PET brand for Fadulla since March 1997.”

12. Exhibit ADPN-9 is a copy of a ‘Without Prejudice’ letter dated 9 October 1998 sent to the opponents by the applicant’s Trade Mark Attorney’s A. R. Davies & Co. It is in effect a cease and desist letter relating to the opponents’ use of their OUR PET trade mark. Mr Newman states that despite the claims made in the letter no subsequent action was taken regarding his Company’s use of their OUR PET trade mark.

13. In paragraph 9 of his declaration Mr Newman says:

“I have attempted to obtain further third party corroboration of our claims and have so far been able to obtain a letter from one of our customers - WPP Products - which is now produced and shown to me marked ADPN-10.”

This undated letter from W.P.P Quality Products of Linford, Essex, reads as follows:

“Dear Mr Newman

Re trading name “OUR PET” as far as I am able to remember this name has been use by Fadulla from late early 1997 and as over the past 2 year sold fadulla products as “OUR PET” and all products have this label on if you need any more re this subject please phone on above numbers.

yours W.P.P. QUALITY PRODUCTS”.

Applicant’s evidence

14. This consists of a statutory declaration dated 26 February 2001 by John Lyndon James.

Mr James states that he is the Managing Director of James and Steel Limited a position he has held for two years; prior to this he was a sole trader trading under the name of James Marketing. He confirms that he is authorised to make his declaration on the Company's behalf adding that the information in his declaration are taken from his own personal knowledge or from Company records.

15. Mr James explains that he has been involved in the pet trade for twenty seven years. He goes on to say that in 1993 or thereabouts he became an agent for Fadulla Limited (the opponents in these proceedings) and this relationship lasted until 1996. The remainder of Mr James' declaration is reproduced verbatim below:

“4. During the time I worked as an agent for Fadulla there was no mention or use of the mark OUR PET. In fact any use of the mark by Fadulla Limited did not, by their own admissions, commence until 1997 and therefore the agency agreement which existed between myself and Fadulla Limited is of no consequence.

5. In 1994 my Company began producing and selling products under the mark MY PET and in 1995 our Trade Mark Agents A.R. Davies & Co filed a UK trade mark application on my behalf for the mark MY PET logo in class 31. This was subsequently followed by a further application for the mark in classes 18 and 28. In early 1997 a Community trade mark application for the same MY PET logo was filed covering classes 18, 28 and 31. There is now produced and shown to me Exhibit JJJ1, copies of registration certificates relating to the UK and Community trade mark registrations.

6. The MY PET range was very popular and we quickly built up a reputation in the mark. In mid 1998, we decided we should like to extend this product range and an obvious extension of this was the mark OUR PET. Some thought was also given to the adoption of YOUR PET, but we felt that OUR PET conveyed a better impression. Having given consideration to the adoption of OUR PET, we then discovered that Fadulla Limited had commenced use of the mark. We were of course concerned to learn of this as we felt it was too close to our own MY PET range of products and that customers would consider products produced by Fadulla Limited under the mark OUR PET to be goods of my Company. Therefore, we were suspicious of their motives in adopting the name. Furthermore, their adoption of the mark hindered our legitimate business interests and our wish to extend our range. In these circumstances, we consulted my Company's trade mark agents who wrote to Fadulla Limited pointing out our interest in the mark MY PET and that any use by them of the mark OUR PET would cause confusion.

7. On advice from our trade mark agents, we also felt that it would be prudent to file an application for OUR PET, and this we did in October 1998. The mark was subsequently accepted for a stylised version of the mark, which corresponded to the stylisation of our MY PET logo mark. Thus, not only would our customers consider the mark OUR PET to be an extension of the MY PET range they would be in no doubt as to the origin of the goods, due to the distinctive stylisation of our mark.

8. Fadulla Limited were fully aware of our use of MY PET and their adoption of the

mark OUR PET was not coincidental. In fact, Fadulla Limited could not have failed to have been aware of our use of MY PET as they actually shared a stand with us at various trade shows, where we promoted our range of MY PET products.”

16. That completes my review of the evidence filed in so far as I consider it necessary.

DECISION

17. I will deal with the opposition based on Sections 3(1)(b), (c) and (d) of the Act first. The relevant Sections of the Act read as follows:

“3.-(1) The following shall not be registered -

- (a)
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

18. In the present case I must consider whether, on a prima facie basis, the mark in suit meets the requirements of Sections 3(1)(b), (c) and (d) of the Act. The applicant has not submitted any evidence that their mark has acquired a distinctive character as a result of the use made of it.

19. It is well established that this question should be considered in the light of the 20 September 2001 judgement of the European Court of Justice in *Proctor & Gamble Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, [2002] RPC 17 for the mark BABY DRY. This judgement gives very useful guidance on the test for descriptiveness under Section 3(1)(c) of the Act.

20. Paragraphs 37, 39 and 40 of the judgement read as follows:

“37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indications as trade marks is, as both Proctor & Gamble and the OHIM acknowledge, to prevent registration as

trade marks signs or indication which, because they are not different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.”

“39. The signs and indication referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way or designating the goods or services concerned or their essential characteristics.”

“40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services of their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

21. These paragraphs indicate that only trade marks which are no different from the usual way of designating the relevant goods or services or their characteristics are debarred from registration by Section 3(1)(c) of the Act. It is the opponents’ contention that the mark the subject of the application in suit is: “a combination of two non-distinctive words shown with insufficient stylisation within the mark in suit to justify registration”. Resulting from this basic contention the opponents say that the application is: prima facie devoid of any distinctive character, a sign which may serve in trade to designate the intended purpose or other characteristics of the goods and a sign which is customary in the current language or established practices of the trade.

22. The trade mark in suit consists of the two dictionary words OUR and PET in a stylised configuration; it has been applied for in relation to a range of pet related products in Classes 18, 28 and 31. However, as made clear by the decision in BABY DRY “descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form”. When one considers that both Sections 3(1)(c) and (d) of the Act contain the words “which consist exclusively of.....”, together with the guidance provided by the European Court of Justice in the BABY DRY case, it is quite clear that the application in suit can not fall foul of either of these sections of the Act. In the BABY DRY decision the Court said:

“Furthermore, a mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole

from the usual way or designating the goods or services concerned or their essential characteristics.”

23. I note from the evidence provided by Mr Newman, that the opponents themselves sought to register the words OUR PET as a trade mark in June 1997 with Mr Newman explaining that the application was rejected by the Trade Marks Registry as being non-distinctive. That application was applied for in respect of the plain words OUR PET in relation to a range of pet related products in classes 18, 20, 21, 28 and 31 and was made some time before the Court’s decision in BABY DRY. Whether or not the plain words OUR PET would be acceptable as a trade mark for pet related products following the Court’s decision is not a matter I need to determine. The words OUR PET in the particular graphical form shown in the application in suit are, in my view, presented in such a manner that they are capable of distinguishing the applicant’s goods from those of other undertakings; as such the opposition based on sections 3(1)(c) and (d) of the Act are dismissed.

24. However, this is not an end of the matter as I still need to consider the objection under Section 3(1)(b) of the Act. In *Cycling IS...* trade marks [2002] RPC 37, Geoffrey Hobbs QC acting as the Appointed Person made the following comments:

“66. That brings me to the question of whether the signs possess a distinctive character enabling them to fulfil the essential function of a trade mark in relation to goods and services of the kind specified in the application for registration. (*The goods and services comprise “clothing, footwear and headgear” in Class 25 and “advertising, all relating to the cycling industry” in Class 35*).

67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.

68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.

69. The difference between these two positions resides in the question whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral.

70. The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect.

71. I do not suppose that such a person would pause to construe the signs when encountering them in any of the different settings (including advertising and promotional settings) in which they might be used. Even so, the degree of attention required to take note of the signs in the first place would be sufficient, in my view,

to leave a well-informed and reasonably observant and circumspect person with the clear impression that the signs were being used with reference to goods and services related to cycling.”

25. Mr Hobbs went on to observe:

“73. Doing the best I can on the materials before me, I think that the signs in question would be perceived by the relevant class of persons as pronouncements in identifying cycling as the *raison d’être* for the marketing of the goods and services to which they are related. That is a message that the members of a consortium of bicycle retailers might naturally be interested in putting across to customers and potential customers. I do not think that the nature of the pronouncement or its presentation can in either case be regarded as sufficiently striking to function as an indication of trade origin in relation to goods or services of the kind specified in the application for registration that is now before me.

74. It seems to me that the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin neutral (relating to the general commercial context of the relevant trading activities) rather than origin specific.”

26. I also bear in mind the comments of The Court of First Instance in *Mag Instrument Inc. v Office for Harmonization in the Internal Market (Trade Marks and Designs)* Case T-88/00 where the Court stated:

“Under Article 7(1)(b) of Regulation No 40/94, moreover, it is sufficient, in order to defeat the absolute ground for refusal, to demonstrate that the mark possesses a minimum degree of distinctiveness. It is therefore necessary to determine - in the context of an a priori examination and without reference to any actual use of the sign within the meaning of Article 7(3) of Regulation No 40/94 - whether the claimed mark will enable the targeted public to distinguish the marked goods or services from those of other undertakings when they come to make a purchasing choice.”

27. In my view the trade mark in suit does (at the very least) because of the way in which the two words are represented possess the minimum degree of distinctiveness required to defeat the remaining objection based on Section 3(1)(b) of the Act; the application in suit would in my judgement be perceived by the average consumer as being (in Mr Hobb’s words) origin specific rather than origin neutral; as a result the opposition based on Section 3(1)(b) is dismissed accordingly.

28. The remaining objections are based on Sections 3(6) and 5(4)(a) of the Act. Section 3(6) reads as follows:

“3.(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

29 In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J

considered the meaning of “bad faith” in Section 3(6) of the Act and stated (at page 379):

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

30. In a recent unreported decision of the Appointed Person; *in the matter of Application No 2031741 by Eicher Limited - Royal Enfield Motor Units to register a mark in Class 12 and in the matter of Opposition thereto under No 45356 by David Matthew Scott Holder T/A Velocette Motorcycle Company and in the matter of Application No 9188 by David Matthew Scott Holder T/A Velocette Motorcycle Company* for a declaration of Invalidity in respect of Trade Mark No 1514064 in the name of Eicher Limited - Royal Enfield Motor Units, paragraph 31, Simon Thorley QC in relation to Section 3(6) stated that:

“An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (See Lord Denning M.R. in Associated Leisure v Associated Newspapers (1970) 2 QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see Davy v Garrett (1878) 7 Ch. D. 473 at 489). In my judgment precisely the same considerations apply to an allegation of lack of bad faith made under Section 3(6). It should not be made unless it is distinctly proved and this will rarely be possible by a process of inference.”

31. In their Statement of Grounds the opponents do not particularise the nature of their complaint under this Section of the Act. However, in his evidence Mr Newman refers to a business relationship that existed between the opponents and the applicant Mr James (see paragraph 9 above), and records various instances where the respective parties business interests have “crossed paths”. The chronology of events (including where necessary the paragraph number of the declaration from which the information is obtained) appears to me to be as follows:

1993-1996 - applicant acts as an agent for Fadulla Limited (James para.3);

1994 - applicant begins producing and selling products under the MY PET trade mark (James para 5);

11/95 - UK trade mark application filed in the applicant’s name for the trade mark MY PET (stylised) for goods in Class 31;

10/96 - UK trade mark application filed in the applicant’s name for the trade mark MY PET (stylised) for goods in Classes 18 and 28;

3/97 - Community trade mark application filed in the applicant's name for the trade mark MY PET (stylised) for goods in Classes 18, 28 and 31;

4/97 - opponents claimed first use of the trade mark OUR PET (Newman para.3);

6/97 - opponents seek to register the trade mark OUR PET in the United Kingdom - application rejected as being non-distinctive (Newman para.3);

4/98 - applicant/opponents attend Pet Index Exhibition (Newman para. 5);

Mid-1998 - applicant adopts the trade mark OUR PET (James para.6);

10/98 - application in suit filed.

32. While bad faith may exist when there is no actual dishonesty has the applicant's behaviour fallen short of that which would be considered acceptable in commerce? It seems to me that the Opponents' case consists of mere assertion and opinion which the applicant has rebutted. There is no evidence that the applicant adopted the OUR PET trade mark in the knowledge that the opponents' were already using their OUR PET trade mark and nothing from which it can be inferred; in fact, the applicant's evidence is entirely to the contrary (see para. 15 above). Bad faith requires proof and lays a significant burden upon the opponents to provide such before a finding can be given. In the absence of such evidence the opposition under Section 3(6) also fails.

33. The final objection is based on Section 5(4)(a) of the Act; this reads as follows:

"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".

34. The law on the common law tort of passing off is set out by Geoffrey Hobbs QC, acting as the Appointed Person, in *Wild Child* [1998] 14 RPC, 455:

"A helpful summary of the element 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] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 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:

(a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(b) that there is a misrepresentation by the defendant (whether or not

intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

The restatement of the elements of passing off in the form of this classical trinity has been referred to as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

35. Thus, to succeed in a passing off action, it is necessary for the opponents to establish that at the relevant date ie. 2 October 1998 the date of the filing of the application in suit (i) they had acquired goodwill under their OUR PET trade mark, (ii) that use of the applicant's trade mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause damage to them.

36. In *South Cone Inc. v Jack Bessant & Others* [2002] RPC 19 Mr Justice Pumfrey said:

"As Mr Hobbs QC said in *WILD CHILD Trade Mark* [1998] RPC 455 the registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. The second question follows: how cogent must the evidence be upon which the registrar should act in upholding an opposition on this ground?"

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 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 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. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

37. At the material date in these proceedings ie. 2 October 1998, the opponents would have been using their OUR PET trade mark for some 18 months. Turnover in the period 1997-1998 under their OUR PET trade mark is estimated by Mr Newman at approximately £800k; the goods on which the trade mark is said to have been used are, (it would appear), pet products including dogs toys, cat toys, chains, leads and brushes. In support of these claims the opponents have filed the documents mentioned in my summary of the evidence above and I consider these documents in more detail below:

Exhibit ADPN-1 - this exhibit consists of twelve invoices; these invoices are from suppliers of goods to the opponents under the OUR PET trade mark, together with invoices from the opponents to purchasers of goods which are said to have borne the OUR PET trade mark. Of the twelve invoices supplied, three are from companies who have supplied goods to the opponents under the OUR PET trade mark; the remainder are invoices from the opponents to what appear to be wholesalers and retailers of pet related products.

38. I note that seven of the nine invoices issued by the opponents to their customers are after the material date in these proceedings and as such are of no assistance; it also appears that none of the invoices actually indicate that the goods bore the OUR PET trade mark. However, Mr Newman has sworn in his statutory declaration that they did and this evidence has not been challenged. In his evidence Mr Newman says that:

“...together with invoices which we subsequently issued to our UK customers the value of which all relate to sales of OUR PET branded goods only.”

39. Of the two invoices from suppliers and the two invoices to what appear to be retailers that I can consider, I note that the invoices from the suppliers Bura Rak Tannery Co Ltd (dated 29 October 1997) and Khon Kaen Tanner Group Co Ltd (dated 11 December 1997) consist of goods identified as rawhide dog chews. Similarly while the invoices to Satellite Pet Products of Southampton and Risha Products of Essex (both dated 11 September 1997) both appear to consist principally of dog chews, I note that the latter also includes references to “Asst. small squeaky toys” and “Med Asst squeaky toys”, which I take to be references to small and medium sized squeaky toys for animals. The invoices are for £2930.98 and £712.06 respectively. Other exhibits are as follows:

ADPN- 4 - this exhibit consist of pages from the Pet Index show catalogue for the years 1994 to 1999. Fadulla Limited appears in the list of exhibitors but no mention is made of the OUR PET trade mark.

ADPN-5 - is a copy of the Pet Index show catalogue for 2000; this is after the material date in these proceedings and is of no assistance.

ADPN-6 and ADPN7 - consists respectively of: examples of promotional use of the OUR PET trade mark on header sheets for Christmas gifts distributed between the Summer and Autumn of 1998 and recent catalogue sheets showing continued use of the OUR PET trade mark. I note that in ADPN-6 the words OUR PET are shown in one example separated by a stylised letter “f” in an oval device and in another accompanied by the words “CATNIP CAT TOYS”; in exhibit ADPN-7 the words OUR PET are shown in block capital letters (sometimes alone) and on other occasions in yellow on a red rectangular background. Although after the material dates in these proceedings, in his evidence Mr Newman confirms that similar catalogue sheets to those in exhibit ADPN-7 were produced in 1997 and 1998. I note that the header sheets in ADPN-6 are in relation to a range of Christmas treats for cats and dogs whilst in ADPN-7, the words OUR PET appear on toys for pets such as balls and sacks.

ADPN-8 - this exhibit consists of the two letters reproduced in full above, indicating that the companies concerned had printed labels for goods bearing the OUR PET trade mark for the opponents since March and April 1997.

ADPN-10 - this consists of the undated letter also reproduced in full above indicating that the Company concerned W.P.P. Quality Products were aware of the opponents’ use of the OUR PET trade mark from some time in early/late 1997.

40. I am given no indication as to the size of the market for pet products in the United Kingdom, but given the number of pet owners in this country, it is I think, reasonable to assume that the market for pet products must be worth many hundreds of millions of pounds; the opponents have provided no information regarding their market share.

41. On the basis of the above facts I am unable to hold that the sales of the opponents’ recognisable goods under the trade mark are such as to have established goodwill or reputation in the market place. The level of sales is in my view insignificant given the likely size of the market and the particular spread of sales is not presented so that it is not possible to determine whether there might be a locally protectable goodwill. The first leg of the ‘trinity’ is therefore not satisfied and I do not need to consider the other two legs to find that the opponents’ case under Section 5(4)(a) is not made out. The opposition under this head is also dismissed.

42. The opponents have failed in respect of all allegations in these proceedings and I order them to pay to the applicant the sum of £500 as a contribution towards their costs. This sum is 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 18th day of October 2002

**M KNIGHT
For the Registrar
the Comptroller-General**