

O-469-14

TRADE MARKS ACT 1994

**TRADE MARK APPLICATION NO. 2606087
BY CAROLINA JAMES
TO REGISTER THE TRADE MARK**

Cottontails

**IN CLASSES 2, 3, 5, 6, 8, 11, 12, 14, 18, 20, 21,
24, 26, 27, 28, 29, 30, 31, 32, 38, 42, 43 AND 44**

AND

**THE OPPOSITION THERETO UNDER NO. 104184
BY MAIRWEN P GUARD**

Background and pleadings

1. Ms Carolina James applied for the trade mark Cottontails on 4 January 2012 for a diverse range of goods and services in twenty-three different classes, including cosmetics, vehicles, precious metals, carpets, telecommunications, industrial analysis and research services, computer programming, restaurants, veterinary services, garden design services, domestic and pet rabbits, hares, pets, birds, guinea pigs, pigs, dogs, cats, mice, rats, hamsters, squirrels “and other small mammals and bushy tailed animals all being of the European and British species”.

2. Mrs Mairwen Guard has opposed some of the goods and services for which Ms James has applied. Mrs Guard’s opposition is based upon sections 5(1), 5(2)(a) and 5(2)(b)¹ of the Trade Marks Act 1994 (“the Act”) because she considers that Ms James’ mark will be confused with her own mark, CottonTails, number 2295000, which she filed on 9 March 2002 and which was registered on 13 December 2002. The services of her registration which she relies upon are:

Class 38: Provision of telephone communications to provide help about care of rabbits, guinea pigs and other small animals or birds.

Class 43: Re-homing, boarding of rabbits, guinea pigs and other small animals or birds; provision of information help and advice relating to all the aforesaid.

Class 44: Care of rabbits, guinea pigs and other small animals or birds; provision of information, help and advice relating to all the aforesaid.

3. Ms James’ application was published on 7 September 2012. Mrs Guard’s mark is an earlier mark which had been registered for more than five years at this date. Ms James filed a counterstatement, denying a likelihood of confusion between the marks and putting Mrs Guard to proof that she has made genuine use of her earlier mark within the five year period ending on 7 September 2012, as per section 6A of the Act².

4. Ms James has, at all times during this opposition, been represented by Forresters, a firm of trade mark attorneys. Mrs Guard acted for herself until the point that evidence in reply was reached, when she instructed RGC Jenkins & Co to act as her trade mark attorneys. Both sides filed evidence and Mrs Guard also filed written submissions during the evidence rounds. The matter came to be heard before me by video conference on 3 October 2014. Mrs Guard was represented by her trade mark attorney, Ms Katherine Cameron. Ms James did not attend and chose not to be represented at the hearing “in view of the associated costs which would likely have a serious impact on [her] charity business”, but her attorneys filed written submissions in lieu of attendance. I make this decision having listened to and read all the arguments and evidence.

¹ Grounds initially raised under sections 5(3) and 5(4)(a) of the Act were dropped early in the proceedings, before the evidence rounds commenced.

² The five year period is from 8 September 2007 to 7 September 2012.

Mrs Guard's evidence

5. Mrs Guard's witness statement is dated 4 September 2013. She has been the Trustee of CottonTails Rescue since 8 October 1997. Her statement comes from her personal knowledge and from the records of her charity.

6. Exhibit MG1 comprises newspaper and magazine articles about CottonTails for the five year period from 2007 to 2013. This is the relevant period for proof of use, as per section 6A of the Act. Exhibit MG2 comprises newspaper and magazine articles for the years 2002 to 2006, which are prior to the relevant period. Exhibit MG3 comprises newspaper and magazine articles from 1994 to 2002 which are also prior to the relevant period. Since it is the period covered by exhibit MG1 which is pertinent to the question of genuine use, I will provide here a summary of a selection from the twenty-nine articles in exhibit MG1, and not the contents of exhibits MG2 or MG3.

- Two separate articles from Veterinary Nursing Times from 2007 written by Mrs Guard. There is a reference to her work with CottonTails for some fourteen years prior to this date.
- Three articles from the Daily Telegraph from 2007, one of which says: "Rescue, don't buy a rabbit" is a message that still hasn't got across. Rabbits are particularly difficult to rehome. Jessy, a rabbit at CottonTails Rabbit Rescue in Westbury, Wiltshire, is still waiting for someone in that county, or in Bristol or Somerset. Ring 01373 864222 (or see www.cottontails-rescue.org.uk) if you can offer her a home in the New Year [...] Bunny [...], a lovely little rabbit with floppy ears, stayed at CottonTails for weeks after her appearance in the *Telegraph*. "She found a home eventually and is now a house rabbit", says Mairwen Guard, who runs CottonTails".
- An article from the Wiltshire Times from May 2007 referring to the hands-on opportunities given to children to meet rabbits from CottonTails Rabbit and Guinea Pig Rescue at a shopping centre in Trowbridge.
- A feature in the Pets at Home magazine from January 2009: "CottonTails Rescue have an excellent partnership with Pets at Home and were delighted when, in 2007, they were awarded £2,500 to help with the refurbishment of their rabbit and guinea pig accommodation."
- An article from a trade publication called Pet Product Marketing, from April 2010, which is headed: "The *PPM* Small Animal Forum debate over whether rabbits and guinea pigs should be sold in pairs has provoked strong reactions from welfare groups. Both the CottonTails rescue charity and Rabbit Welfare Association have submitted their views on the subject and here we publish the comments in full." One of the sets of comments is from Mrs Guard.
- An article from Pet Product Marketing from December 2010 featuring commentaries from three experts in the care of small animals; one is from Mrs

Guard, who is credited as being the founder trustee of CottonTails Rabbit Rescue.

- An article in the magazine Rabbiting On, from Summer 2010, which starts “A campaign by Mairwen Guard MBE of Cottontails [note spelling] Rabbit and Guinea Pig Rescue, to encourage vets to carry out early neutering in situations where rabbits are socially housed...”.
- An article in the magazine Rabbiting On, from Summer 2010, referring to the sponsoring of rabbit rescue centres in Surrey, Northamptonshire, Solihull, and Cottontails [note spelling] in Wiltshire. There is an inset giving details about CottonTails, which started in 1993. In 2010, CottonTails was accepting 300 rescued rabbits a year and rehomed in pairs.
- An article in Rabbiting On from Autumn 2011 by Mrs Guard, where she talks about her experiences at CottonTails in getting rabbits to bond to form a pair. She directs the reader to the CottonTails website for more advice on matching up rabbits.
- An interview from Pet Product Marketing from March 2011 with Mrs Guard talking about the dumping of pets.
- An article in Rabbiting On from Spring 2012 about long-haired rabbits, by Mrs Guard, crediting her as being the founder of CottonTails.
- An article from the Spring 2013 edition of Pet Focus magazine about the care of rabbits and guinea pigs, with the credit for the information as being from www.cottontails-rescue.org.uk, “with kind permission of Mairwen Guard OBE, owner and founder of CottonTails Rescue.”
- An interview printed in the Spring 2013 edition of Pet Focus magazine, headed “Mairwen Guard has always wanted to save animals ever since she was a young child. Awarded an MBE for Services to Animal Welfare in 2006, Mairwen’s life has been dedicated to working with animals; here, she tells PetFocus about her current occupation running CottonTails Rabbit and Guinea Pig Rescue Centre”. The interview includes a paragraph in which Mrs Guard says that she specialises in rabbits and guinea pigs but also rescues other small animals and birds.

7. Mrs Guard exhibits at MG4 the annual reports from her CottonTails charity for the years 2007 to 2012. The annual reports are published on the CottonTails website. She provides financial information for the past five years which she states have also been published by the Charity Commission:

Financial Year end	Income	Spending
31 Dec 2012	£17,304	£19,058
31 Dec 2011	£19,024	£21,726
31 Dec 2010	£17,598	£21,191
31 Dec 2009	£51,557	£18,562

31 Dec 2008	£16,154	£15,740
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8. The spike in the income figures for 2009 is explained in the annual report for 2009 as being from the result of a legacy. Each report is headed “Main name: CottonTails. Working Name: CottonTails Rescue” and “Charitable Objects: To relieve the suffering of rabbits and other animals who are in need of care and attention in particular by providing and maintaining suitable accommodation for the reception and care of unwanted rabbits and other animals. To advance the education of the public in the care and ownership of animals.” The reports say that the catchment area for adoption and requests for rehoming is Wiltshire, Somerset, Bath and Bristol, as well as a small number from “other non-local areas” (e.g. Sheffield) and “over a hundred miles away”. The 2009 report says: “The CottonTails website continues to go from strength to strength and is a vital part of the charity’s ability to educate and inform on a local, national and international basis.” The 2011 report says “The CottonTails website continues to attract on average over 300 visitors a day, and it is gratifying to know that professionals in the field of veterinary medicine also refer to it for information”.

9. Exhibit MG5 is a national list of rabbit rescue centres compiled by the Rabbit Welfare Association & Fund and Rabbit Rehome, as published from 2007 to 2012 on the rabbitrehome.org.uk website, which Mrs Guard obtained from web.archive.org. CottonTails Rescue (of Westbury, Wiltshire) is listed in each year. Mrs Guard states that this list is referred to via the national RSPCA helpline.

10. Exhibit MG6 is a witness statement from Siobhan Arkell, who is a part-time volunteer with CottonTails. Unfortunately, Mrs Guard’s evidence was mislaid by the IPO after she had filed it, which meant she had to provide copies of all the original documents. Consequently, the copy of this witness statement is unsigned and undated because the original was lost by the IPO. Ms Arkell states that she has known of CottonTails since 1999. She confirms that CottonTails takes in and provides temporary boarding for rabbits, guinea pigs and other small animals and birds. CottonTails carries out vaccinations, administers antibiotics and other medical and grooming care.

Proof of genuine use of CottonTails

11. Section 6A provides:

(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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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 Community 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.

(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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).

12. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import

operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]"

13. The onus is upon Mrs Guard to prove use of her mark, because Section 100 of the Act states:

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

14. In relation to Mrs Guard's class 38 services, *provision of telephone communications to provide help about care of rabbits, guinea pigs and other small animals or birds*, Ms James submits:

"The normal and ordinary meaning given to this service is that it is that provision of telephone communication services for third parties. For the Opponent to show that it has been genuinely using the Earlier Mark for telephone communication services, the evidence would need to show use in relation to setting up a telephone communication service for third parties."

Ms Cameron conceded at the hearing that Mrs Guard had not provided telecommunications services; rather advice by telephone about care of rabbits and other small animals. I will say here that there is no genuine use in relation to the registered services in class 38. Of course, Ms James' submissions also apply to her own use, or intended use, of her applied for services in class 38 (telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting).

15. The correct approach to assessing genuine use is to view the evidential picture as a whole, including whether individual exhibits corroborate each other. In Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v Office for Harmonisation of the Internal Market (OHIM)*¹, the General Court ("GC") said:

"53 In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (*COLORIS*, paragraph 24). However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07 P *Ferrero Deutschland v OHIM*, not published in the ECR, paragraph 36)."³

³ See also the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person in *Brandconcern BV v Scooters India Limited* ("Lambretta") BL O/065/14, referring to this case from the GC.

16. Section 6A(4)(a) states that use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. The registered mark itself is unaltered when it appears in conjunction with words which describe the nature of the business/charity offered under the mark such as Rescue, Rabbit Rescue and Rabbit and Guinea Pig Rescue. There is no need to move on to consider whether the form used is an acceptable variant because the form used is the mark as registered. This conclusion is supported by the CJEU's ruling⁴ in Case C-252/12, *Specsavers International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd, Specsavers Optical Superstores Ltd v Asda Stores Ltd*:

“22. For a trade mark to possess distinctive character for the purposes of Regulation No 207/2009, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (see, to that effect, Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble v OHIM* [2004] ECR I-5141, paragraph 32; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-311/11 P *Smart Technologies v OHIM* [2012] ECR I-0000, paragraph 23).

23. That distinctive character of a registered trade mark may be the result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases, it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service at issue as originating from a given undertaking (see, by analogy, Case C-353/03 *Nestlé* [2005] ECR I-6135, paragraph 30).”

There has been use of the mark CottonTails, as registered.

17. Ms James' written submissions in lieu of a hearing say:

“First, the Applicant is aware that the Opponent is registered as a charity with the Charity Commission. However, organisations which are registered as a charity with the Charity Commission are not permitted to trade without having a separate trading company. The Opponent has not provided any information in relation to owning a separate trading company. The Opponent is therefore not permitted to use the Earlier Mark, in the course of trade, as a charity, and any use of the mark is not in the course of trade for the purposes of genuine use (in accordance with Section 6A(2) and 6A(3) of the UK Trade Marks Act).”

18. This is the first time Ms James has raised this point, two days prior to the hearing. It is not acceptable to raise such a point at such a late stage. As Ms James was not represented at the hearing, and did not attend, I was unable to ask her why it had been left until the eleventh hour, and why there was no evidence, or a request to file evidence, to support the point. As a consequence, I do not propose to say any more about the matter.

⁴ See also the CJEU's ruling in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12.

19. Ms James' submissions go on to say:

“Secondly, the Opponent has purported to provide sufficient and genuine proof of use by way of financial information of the workings of a charity. However the financial information provided is not sufficient to show genuine use of the mark in relation to a charity. The financial incomes of charities in the UK are very large and are measured in millions of pounds per annum. In 2013, Cancer Research UK registered an income at £1,540 million. In 2013, the animal charities RSPCA and RSPB reported to their trustees that incomes of £2,134 million and £122 million had been received respectively. Even lesser known charities such as The Donkey Sanctuary and the Dog's trust registered a £29 million income in 2013 and a £17.7 million income in 2012, respectively. The purported financial information provided by the Opponent is nowhere near these levels of income.”

20. The CJEU stated in *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* C-442/07 that, all else being equal, non-profit-making charities are able to make genuine use of their trade marks:

“17 The fact that a charitable association does not seek to make profit does not mean that its objective cannot be to create and, later, to preserve an outlet for its goods or services.

18 In addition, as the Radetzky-Orden admitted in its written observations submitted to the Court, paid welfare services exist. In modern society, various types of non-profit-making association have sprung up which, at first sight, offer their services free but which, in reality, are financed through subsidies or receive payment in various forms.

19 It cannot be ruled out, therefore, that trade marks registered by a non-profit-making association may have a *raison d'être*, in that they protect the association against the possible use in business of identical or similar signs by third persons.

20 As long as the association in question uses the marks of which it is the proprietor to identify and promote the goods or services for which they were registered, it is making an actual use of them which constitutes 'genuine use' within the meaning of Article 12(1) of the Directive.”

21. In *Antartica Srl v OHIM, The Nasdaq Stock Market, Inc.*, Case C-320/07 P, the CJEU held that:

“29. It is sufficient to note in that respect that, even if part of the services for which the earlier mark is registered are offered by The Nasdaq Stock Market free of charge, that does not of itself mean that that commercial company will not seek, by such use of its trade mark, to create or maintain an outlet for those services in the Community, as against the services of other undertakings.”

22. As per *Ansul*, I must take into account all the relevant facts and circumstances in determining whether there is real commercial exploitation of the mark. My assessment includes the nature of the services and the characteristics of the market concerned, which are those of a charity. There is a multitude of charities of all kinds and all sizes. Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. The evidence shows that Mrs Guard is regularly called upon in national and trade press to provide advice and information on rabbit care and rehoming; such as the article in the April 2010 issue of *Pet Product Marketing*, which refers to the views of the CottonTails rescue charity and the Rabbit Welfare Association. Mrs Guard's articles and interviews all refer to her experience with CottonTails and she directs readers to the CottonTails website for more information. That there is no charge, and comparatively little income, seems commensurate with a charity which its owner runs for the love of the subject matter. The evidence shows that the public, including the national press, the national pet trade press and the veterinary profession, is clearly able to distinguish Mrs Guard's services from others via her CottonTails mark. I also bear in mind the frequency of use of the mark, which the evidence shows is continuous. For example, the website has over three hundred visits a day and, in 2010, CottonTails accepted three hundred rabbits for rehoming. That sort of figure suggests year-round 'custom'; i.e. people making contact with CottonTails for the purpose of availing themselves of the services on offer by Mrs Guard. Those services are primarily the provision of advice and information on rabbit care, and services for the rehoming of rabbits, but the evidence shows that Mrs Guard also extends these services to guinea pigs, other small animals and birds. The services for which Mrs Guard has shown she has used the mark are entirely reflected in the services set out in the specifications relied upon:

Class 43: Re-homing, boarding of rabbits, guinea pigs and other small animals or birds; provision of information help and advice relating to all the aforesaid.

Class 44: Care of rabbits, guinea pigs and other small animals or birds; provision of information, help and advice relating to all the aforesaid.

23. The applicant takes a point that Mrs Guard's financial information shows use of the mark as a charity and that charitable fundraising is proper to class 36, which is not relied upon. It is clear from the evidence that she does provide, under the mark CottonTails, the services set out in the preceding paragraph. It does not matter for the purposes of proving genuine use that she does not rely upon charitable fundraising services for the opposition (which are not covered by her earlier registration).

24. The applicant also relies upon the CJEU's judgment in *Reber Holding GmbH & Co. KG v OHIM*, C-141/13 P, paragraphs 31 and 32. The GC had found that the sale of 40-60Kg per annum of specialist chocolate under a mark was insufficient to constitute genuine use of the national trade mark, which was registered in Germany. It was accepted that there was commercial use of the mark and a degree of continuity in use. Nevertheless, the CJEU said that "not every proven commercial

use may automatically be deemed to constitute use of the trade mark in question". The applicant does not expand upon its reliance on this case. It submits simply that I am bound by the judgment (which I am, of course) and that if I consider that commercial use of Mrs Guard's trade mark has occurred, it is not genuine. I am satisfied that the use made of the mark is genuine, taking into account all the factors I have explored above. Furthermore, unlike in *Reber*, where the use was confined to a single locality, the evidence shows that Mrs Guard's trade mark guarantees the identity of the origin of services to the consumer through publicity on a national level, and through rehoming in the large counties of Wiltshire, and Somerset, the cities of Bristol and Bath, and from further afield. The CottonTails website is accessed nationally, and publicised nationally, as a source of expert advice.

Proof of use outcome

25. I find that Mrs Guard has made genuine use of the mark CottonTails in the relevant five year period and may rely upon the following services:

Class 43: Re-homing, boarding of rabbits, guinea pigs and other small animals or birds; provision of information help and advice relating to all the aforesaid.

Class 44: Care of rabbits, guinea pigs and other small animals or birds; provision of information, help and advice relating to all the aforesaid.

Applicant's evidence

26. Carolina James filed a witness statement dated 2 January 2014 in relation to her use of her mark. Mrs Guard replied to this in a second witness statement from herself and in a witness statement from her trade mark attorney. At paragraph 13 of her written submissions in lieu of a hearing, Ms James says:

"The Opponent has provided witness statements from the Opponent herself and from the Opponent's representative disagreeing with the James Statement, even though the Applicant's use is not an issue that the UKIPO needs to address. It is only the genuineness of the proof of use of the Opponent's mark that will be addressed by the Principal Hearing Officer."

This seems to suggest that Ms James does not regard her use as a matter pertinent to the proceedings. However, in her written submissions she stands briefly by what she refers to as honest concurrent use. I will set out the substance of her evidence and Mrs Guard's reply to it. Ms Cameron stressed that although she (and Mrs Guard) did not see the relevance of Ms James' evidence, for the reasons given by Ms James herself in the quotation I have reproduced above, Mrs Guard filed evidence in reply to meet the obligation upon her by virtue of Tribunal Practice Notice 5/2007, which deals with the procedure for challenging evidence, and to ensure that I did not read any silence on Mrs Guard's part as her acceptance of Ms James' evidence.

27. Ms James states that she has used Cottontails in relation to rabbit rehoming and other pet services and related goods since 1993, as a charity. In that time, she estimates that she has raised £250,000 (this works out at about £12,500 per year, less than the income from Mrs Guard's charity). Undated copies of advertisements for pet-sitting and animal boarding services which appeared between 2005 to 2012 are exhibited at CJ2. Ms James states that these were placed in veterinary surgeries, shops, newsagents, cafes, community centres, churches etc; essentially, the advertisements look typical of the sort of informal, local, advertisements posted on notice boards and in windows of the establishments listed. They were not placed in publications or on the internet (or at least, Ms James does not say so).

28. Exhibit CJ3 is a copy of images of merchandise which Ms James states was sold under the Cottontails mark from 1998. Ms James states that at its peak Cottontails had (she uses the past tense) around 20,000 'friends' who would have known of the Cottontails mark. She does not say when this peak was. The images show greetings cards, postcards, journals and diaries. Pages 23, 24 and 25 show a website, cottontails.org.uk, with dates for the items (journals and diaries and photographs) of 2005, 2006, 2007 and 2008. Mrs Guard points out that the website wasn't registered until 8 July 2009 (she attaches a print from Nominet as proof).

29. Ms James states that her charity organised a national list of rabbit shelters called The Bunny Hopline. Exhibit CJ5 is an extract from such a list, with copies of the 2005 and 2006 cover pages from the list. She states that her charity provided advice to the public, animal professionals and other welfare groups such as The Blue Cross and the RSPCA; advised the Government on changes in the law; ran two welfare campaigns a year; and opened two branches overseas. There are no exhibits to support these statements.

30. Ms James states that her charity was among the first to have a large website and online store called Bunny Buys. She states that cottontails.org.uk regularly came top in Google searches of rabbit-related websites and thousands of people reviewed her website every day. Ms James exhibits at CJ5 a copy of her instructions to a website designer for the bunnybuys website (which says it is the mail order company of Cottontails) dating from around 1999. She states that the cottontails website pointed to the bunnybuys website, but as noted above Mrs Guard has provided evidence to show that the cottontails website was not in existence until ten years later. Mrs Guard exhibits at MPG4 to her second witness statement a printout taken from the Wayback Machine Internet Archive for bunnybuys.com showing that the website was saved only twenty-nine times between 28 September 2000 and 30 May 2013. This would not indicate commercial activity on any genuine scale.

31. Exhibit CJ6 comprises what Ms James states to be copies of various papers taken from the cottontails.org and bunny.co.uk websites, with copyright date markings. Mrs Guard exhibits at MPG2 a printout which shows that the Wayback Machine did not track any amendments made to the Cottontails website except for three snapshots taken on 18 July 2013.

32. There are other similar exhibits and similar challenges made on the basis of dates and the conflict vis a vis the registration dates of the domain names, which it is unnecessary to detail. Ms James refers to her contributions to national newspapers and Which? Magazine, and that she made films, but there are no exhibits to support these assertions.

33. Ms James states that she became very ill in 1999 and that cottontails.org.uk was hacked into and taken over by someone from South East Asia. Without means to raise funds, Ms James states that she closed the charity and trading company in 2003 and continued on a smaller scale using the names Cottontails and Bunny Buys. She started a non-profit small animal boarding, petsitting and housesitting service using the name Cottontails and has created a range of merchandise. Photographs of items bearing the logo Cottontails are shown in Exhibit CJ9, such as pillowcases and cushion covers. They are simple amateur photographs and do not carry any dating or pricing indications. As already recorded, Mrs Guard has provided evidence to show that cottontails.org.uk was not in existence until 2009.

34. Ms Cameron's witness statement consists of submissions which I bear in mind but will not include in the evidence summary.

Decision

35. Sections 5(1) and 5(2) of the act state:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.”

Comparison of the marks

36. In *LTJ Diffusion SA v Sadas Vertbaudet SA* Case C-291/00 the CJEU stated:

“54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a

whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

37. The only difference on a close inspection is the capital T in the middle of Mrs Guard’s mark. I consider this to be a difference so insignificant that it would go unnoticed by the average consumer. Word marks protect the words registered, irrespective of format (T-346/04, *Sadas SA v OHIM*). The parties’ marks are identical. In case I am wrong about that, the marks Cottontails and CottonTails are about as similar as it is possible to be: the similarity between them is of the highest level.

Comparison of goods and services

38. I set out below the services relied upon by Mrs Guard (which have cleared the proof of use hurdle) and the goods and services which she opposes.

Ms James’s application	Mrs Guard’s earlier mark
<p><i>Class 5: Pharmaceutical and veterinary preparations; plasters, materials for dressings; disinfectants; preparations for destroying vermin; fungicides.</i></p> <p><i>Class 31: Domestic and pet rabbits all being of the European and British species of rabbits; hares; domestic pets, birds, guinea pigs, pigs, dogs, cats, mice, rats, hamsters, squirrels and other small mammals and bushy tailed animals all being of the European and British species; fresh fruits and vegetables, seeds, natural plants and flowers; foodstuffs for animals; malt; food and beverages for animals.</i></p> <p><i>Class 38: Telecommunications services; email services.</i></p> <p><i>Class 43: Services for providing food and drink; temporary accommodation; provision of holiday accommodation.</i></p> <p><i>Class 44: Veterinary services; hygienic and beauty care for animals; dentistry services; pharmacy advice.</i></p>	<p><i>Class 43: Re-homing, boarding of rabbits, guinea pigs and other small animals or birds; provision of information help and advice relating to all the aforesaid.</i></p> <p><i>Class 44: Care of rabbits, guinea pigs and other small animals or birds; provision of information, help and advice relating to all the aforesaid.</i></p>

39. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“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.”

40. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“Treat”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

41. ‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

“82 It is true that goods are complementary if 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...”

In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, sitting as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

42. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent

Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

43. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

44. Class 38: *Telecommunications services; email services*

Ms Cameron did not really press the claim in respect of Ms James' telecommunications services and email services, given the concession that Mrs Guard has not made genuine use of these services in her own specification. There are no services in Mrs Guard's class 43 and 44 specifications (she cannot rely on class 38) which are similar to *telecommunications services* and *email services*.

45. Class 44: *Veterinary services; hygienic and beauty care for animals; dentistry services; pharmacy advice*

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

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

46. Consequently, Mrs Guard's services 'care of rabbits, guinea pigs and other small animals or birds' are identical to Ms James' *hygienic and beauty care for animals*. Ms James' *veterinary services* covers veterinary care, which makes the services identical to Mrs Guard's 'care of rabbits, guinea pigs, small animals or birds'.

47. In contrast to services for animals, the natural meaning of *dentistry services* and *pharmacy advice* is that these are services intended for humans, i.e. about humans. Ms Cameron submitted that Mrs Guard's animal care services include dealing with teeth problems endemic in rabbits. This sort of care falls under veterinary services.

One does not take a rabbit to a dentist and one does not seek pharmacy advice about animals; a vet gives medical advice about animals. There is no similarity between Mrs Guard's services and Ms James' *dentistry services* and *pharmacy advice*.

48. Class 43: *Services for providing food and drink; temporary accommodation; provision of holiday accommodation.*

Ms Cameron argued that these services encompassed animal boarding services. I disagree. As above, the natural meaning of these terms is that the recipients of the services are humans, not animals. There is no similarity on any of the levels set out in the authorities cited above.

49. Class 31: *Domestic and pet rabbits all being of the European and British species of rabbits; hares; domestic pets, birds, guinea pigs, pigs, dogs, cats, mice, rats, hamsters, squirrels and other small mammals and bushy tailed animals all being of the European and British species; fresh fruits and vegetables, seeds, natural plants and flowers; foodstuffs for animals; malt; food and beverages for animals.*

In relation to Mrs Guard's 're-homing of rabbits, guinea pigs and other small animals or birds; provision of help and advice relating to all the aforesaid', *domestic and pet rabbits all being of the European and British species of rabbits; hares; domestic pets, birds, guinea pigs, pigs, dogs, cats, mice, rats, hamsters, squirrels and other small mammals and bushy tailed animals all being of the European and British species* are complementary. 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 the goods and services lies with the same undertaking. Consumers obtain a pet by availing themselves of the service: the channels of trade are shared. Although the nature and methods of use differ, there is some shared purpose: the purpose of the animals is to provide pets and the purpose of the service is to provide a pet by providing a home for the pet. There is a good degree of similarity between Ms James' animals and Mrs Guard's animal rehoming service and the provision of help and advice relating to rehoming.

50. Ms Cameron submitted that there is similarity between Ms James' *fresh fruits and vegetables, seeds, natural plants and flowers; foodstuffs for animals; malt; food and beverages for animals* because, for example, if an animal is rehomed, packs of food carrying the trade mark would also be provided, as a complementary item to the rehoming service. I think there is force in that, and it may also be true of animal boarding services. There is no shared purpose, or nature or method of use but there is complementarity and a shared channel of trade in relation to *foodstuffs for animals; food and beverages for animals*. There is a low degree of similarity. The remaining goods are unlikely to be sold specifically for animals by a rehoming centre (one can buy a carrot for a rabbit from anywhere), so in relation to *fresh fruits and vegetables, seeds, natural plants and flowers; malt*, there is no similarity with Mrs Guard's services.

51. Class 5: *Pharmaceutical and veterinary preparations; plasters, materials for dressings; disinfectants; preparations for destroying vermin; fungicides.*

Ms Cameron put forward a similar argument in relation to these goods, giving as an example the fact that when she has a travel vaccination, the medical services are given to her by a company who then provides swabs and plasters which bear the company's trade mark. I think the likelihood of services which provide rehoming and boarding also providing the majority of Ms James' class 5 goods is remote. However, in relation to Mrs Guard's care services in class 44, this encompasses veterinary care. So, the channels of trade would coincide and the dispensing of veterinary preparations would be part of the care given, which may well bear the name of the dispensing service as well as the name of the medication. This makes the goods and the service complementary. There is a low degree of similarity between Mrs Guard's animal care services and *veterinary preparations*. I am less convinced with regard to *plasters, materials for dressings; disinfectants; preparations for destroying vermin; fungicides* (the latter does not appear to be a veterinary preparation). These might be used by the care service, but that does not make them complementary any more than computer software is complementary to the travel service which uses it (as per *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07). Pharmaceutical preparations are for humans, and are not similar to services for animal care. The only goods in class 5 which are similar to Mrs Guard's services are *veterinary preparations*.

52. In summary, the following goods and services of the application are not similar to Mrs Guard's services:

Pharmaceutical preparations; plasters, materials for dressings; disinfectants; preparations for destroying vermin; fungicides.

Fresh fruits and vegetables, seeds, natural plants and flowers; malt.

Telecommunications services; email services

Services for providing food and drink; temporary accommodation; provision of holiday accommodation.

Dentistry services; pharmacy advice.

53. There is **identity** in respect of *veterinary services; hygienic and beauty care for animals*. There is a **good degree of similarity** in respect of *domestic and pet rabbits all being of the European and British species of rabbits; hares; domestic pets, birds, guinea pigs, pigs, dogs, cats, mice, rats, hamsters, squirrels and other small mammals and bushy tailed animals all being of the European and British species*. There is a **low degree** of similarity in relation to *foodstuffs for animals; food and beverages for animals and veterinary preparations*.

Average consumer

54. 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 or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

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

56. The average consumer for Mrs Guard’s services is the general public. They are most likely to encounter her services visually, either by visiting her premises, looking at the website or reading an article about CottonTails in the press. I do not, however, ignore the potential for oral use of the mark, particularly over the telephone, which is one of the ways in which Mrs Guard provides advice. The average consumer of Ms James’ goods is, for the most part, the general public and similar considerations apply in relation to visual selection of the goods or services. For veterinary and pharmaceutical preparations, there is another group of average consumer: the medical professional, who is likely to be more circumspect and pay more attention to these goods than members of the general public. These goods are also purchased more on the basis of visual rather than verbal selection.

Distinctive character of the earlier mark

57. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁵ 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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

⁵ Case C-342/97

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).”

58. I do not think that the use shown by Mrs Guard is of a sufficiently high degree to say that its inherent distinctive character has been enhanced through use. A cottontail is a type of rabbit, albeit a North American species (which is why Ms James’ limited her class specification to animals of the European and British species). However, I bear in mind that Mrs Guard’s specification is not for animals per se but is for care and rehoming services. It is, therefore, allusive rather than descriptive of her services and, in relation to animals which are not rabbits, is distinctive to a good degree. For services relating to rabbits, Mrs Guard’s mark is distinctive to an average degree.

Likelihood of confusion

59. As I have found that the marks are identical, the opposition succeeds under section 5(1) for those of Mrs James’ services which are identical:

veterinary services; hygienic and beauty care for animals.

60. In case I am wrong about the marks being identical, I will consider the likelihood of confusion in relation to *veterinary services; hygienic and beauty care for animals* under section 5(2)(b), as well as for the other goods and services which are not identical to Mrs Guard’s services.

61. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the following principles, which 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 OHIM*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

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

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

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

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

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

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

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

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

62. One of those principles states that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found that the goods and services range from being identical to not similar. Where there is no similarity between the goods or services, neither identity between the marks nor a good degree of distinctive character in the earlier mark will help Mrs Guard's case, as per the CJEU in *Waterford Wedgwood plc v OHIM Case C-398/07*:

“35 It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in *Canon*. However, it cannot be alleged that the Court of First Instance did not take into account the distinctiveness of the earlier trade mark when carrying out that assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

Therefore, the opposition fails for all the goods and services for which there is no similarity:

Pharmaceutical preparations; plasters, materials for dressings; disinfectants; preparations for destroying vermin; fungicides.

Fresh fruits and vegetables, seeds, natural plants and flowers; malt.

Telecommunications services; email services

Services for providing food and drink; temporary accommodation; provision of holiday accommodation.

Dentistry services; pharmacy advice.

63. The marks are near identical (if not identical). In relation to identical services, it is inevitable that the average consumer will imperfectly recollect the fact that one mark has a capital T, if it is noticed at all (as happened in the *Rabbiting On* magazines). The capitalisation will disappear entirely during oral use, such as when telephoning for advice. The opposition succeeds under section 5(2)(b) (if not also under section 5(1)) against *veterinary services; hygienic and beauty care for animals.*

64. In relation to *domestic and pet rabbits all being of the European and British species of rabbits; hares; domestic pets, birds, guinea pigs, pigs, dogs, cats, mice, rats, hamsters, squirrels and other small mammals and bushy tailed animals all being of the European and British species*, which have a good degree of similarity with Mrs Guard’s services, there is also a likelihood of confusion under section 5(2)(b) (if not also under section 5(2)(a)) of the Act). There will be an assumption on the part of the average consumer that rabbits and other animals obtained from an undertaking called Cottontails are part and parcel of a rehoming service which goes by the name of CottonTails. Since the marks are so close, I also consider that there is a likelihood of confusion in relation to *foodstuffs for animals; food and beverages*

for animals and veterinary preparations which are complementary to the service of providing care and rehoming of rabbits and other small animals.

65. It is apparent from my findings in this decision that I consider the marks to be identical, which means that the opposition succeeds under section 5(1) against *veterinary services; hygienic and beauty care for animals* and under section 5(2)(a) against *domestic and pet rabbits all being of the European and British species of rabbits; hares; domestic pets, birds, guinea pigs, pigs, dogs, cats, mice, rats, hamsters, squirrels and other small mammals and bushy tailed animals all being of the European and British species, foodstuffs for animals; food and beverages for animals and veterinary preparations*. However, if I am wrong about the marks being identical and that they are only similar to the highest level, the opposition succeeds against these goods and services under section 5(2)(b) of the Act.

66. Ms James refers to the co-existence of the parties' marks without any actual confusion. In *Samuel Smith Old Brewery (Tadcaster) v. Philip Lee* (trading as 'Cropton Brewery') [2011] EWHC 1879 (Ch); [2012] FSR 7 Arnold J. said, at paragraph 95, that:

"... it is relevant to consider what opportunity there has been for confusion to occur and what opportunity there has been for any such confusion to be detected."

67. Ms James' evidence does not prove to me that there has been either an opportunity for confusion to occur or an opportunity for it to be detected. Mrs Guard's evidence in reply raised a substantial amount of questions over the credibility of Ms James' evidence, which have not been answered; on the contrary, the response has been to downplay Ms James' evidence. Mrs Guard's evidence, when viewed as a whole, creates a picture of genuine use; however, the same cannot be said for Ms James' evidence. For the concurrent use argument to run, there needs to be evidence to suggest that the relevant public has shown that it distinguishes between the parties' goods and services which means that Ms James' evidence needs to show she has used the mark on a sufficient level. The claim to concurrent use and lack of confusion does not get off the ground.

Outcome

68. The opposition succeeds against:

Class 5: *veterinary preparations*.

Class 31: *domestic and pet rabbits all being of the European and British species of rabbits; hares; domestic pets, birds, guinea pigs, pigs, dogs, cats, mice, rats, hamsters, squirrels and other small mammals and bushy tailed animals all being of the European and British species; foodstuffs for animals; food and beverages for animals*.

Class 44: *veterinary services; hygienic and beauty care for animals*.

The application is refused for these goods and services.

69. The opposition fails against:

Class 5: Pharmaceutical preparations; plasters, materials for dressings; disinfectants; preparations for destroying vermin; fungicides.

Class 31: Fresh fruits and vegetables, seeds, natural plants and flowers; malt.

Class 38: Telecommunications services; email services

Class 43: Services for providing food and drink; temporary accommodation; provision of holiday accommodation.

Class 44: Dentistry services; pharmacy advice.

The application may be registered for these goods and services.

Costs

70. Mrs Guard has been successful in relation to a little under half of the goods and services which she opposed. Ms Cameron submitted that I should take into account that Ms James filed evidence of her own use which she then appeared to regard as irrelevant, according to her written submissions in lieu of a hearing. There is substance in that, although Ms James did still appear to consider she had a claim to concurrent use. The strength of such a claim is, however, weak and was not pursued with any amount of vigour in her written submissions: more was made of the fact that “the Applicant’s use is not an issue that the UKIPO needs to address. It is only the genuineness of the proof of use of the Opponent’s mark that will be addressed by the Principal Hearing Officer.” Mrs Guard’s evidence in reply was to rebut Ms James’ evidence and to challenge its credibility, in line with Tribunal Practice Notice 5/2007. That challenge was made efficiently.

71. As a result of the proportion of the attacked goods and services which have survived, Ms James has been slightly more successful in defending her application than Mrs Guard in opposing it. Ordinarily, Ms James would be entitled to a small amount of costs as a contribution. However, taking into account the trouble to which Mrs Guard was put to reviewing a fair amount of evidence which Ms James herself did not, in the end, consider wholly relevant, I feel that the outcome is weighted in favour of Mrs Guard to a small degree. I therefore direct that Ms James is to pay to Mrs Guard the statutory fee for filing the opposition, as a contribution towards her costs.

72. I order Carolina James to pay Mairwen P Guard the sum of £200 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

Dated this 4th day of November 2014

**Judi Pike
For the Registrar,
the Comptroller-General**