**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2632956**
**IN THE NAME OF R2 PETS LIMITED**

**AND IN THE MATTER OF OPPOSITION No. 104285 THERETO**
**BY SOCIÉTÉ DES PRODUITS NESTLÉ SA**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON**
**BY THE OPPONENT**
**AGAINST A DECISION OF MR M BOYLE**
**DATED 5 DECEMBER 2013**

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**DECISION**

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## Introduction

1. This is an appeal involving the correct comparison of marks in the global assessment of likelihood of confusion under Section 5(2)(b) of the Trade Marks Act 1994, where a composite trade mark is applied for which contains an identical or allegedly similar component to that of which an earlier trade mark is comprised.

2. The Court of Justice of the European Union ("CJEU") recently set out its accumulated guidance on this issue[1] in *Bimbo SA v. OHIM*, 8 May 2014 (emphasis added):

> "19. … according to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion … (see Case C‑ 334/05 P *OHIM v Shaker* EU:C:2007:333, paragraph 33, and Case C‑ 193/06 P *Nestlé v OHIM* EU:C:2007:539, paragraph 32).
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> 20. The existence of a likelihood of confusion on the part of the public must be assessed globally, account being taken of all factors relevant to the circumstances of the case (see, to that effect, Case C‑ 251/95 *SABEL* EU:C:1997:528, paragraph 22; *OHIM v Shaker* … paragraph 34; and *Nestlé v OHIM* … paragraph 33).
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> 21. The global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks at issue, must be based on the overall impression given by the marks, account being taken, in particular, of their distinctive and dominant components. The perception of the marks by

[1] In the context of Article 8(1)(b) of Regulation (EC) No 40/94 (now Regulation (EC) No 207/2009) which is the equivalent under the CTM system to Section 5(2)(b) of the Act.

the average consumer of the goods or services in question plays a decisive role in the global assessment of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, to that effect, *SABEL* … paragraph 23; *OHIM v Shaker* … paragraph 35; and *Nestlé v OHIM* … paragraph 34).

22. The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole (*OHIM v Shaker* … paragraph 41).

23. The overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker* … paragraphs 41 and 42, and *Nestlé v OHIM* … paragraphs 42 and 43 and the case-law cited).

24. In this connection, the Court of Justice has stated that it is possible that an earlier mark used by a third party in a composite sign that includes the name of the company of the third party retains an independent distinctive role in the composite sign. Accordingly, in order to establish the likelihood of confusion, it suffices that, on account of the earlier mark still having an independent distinctive role, the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark (Case C‑ 120/04 *Medion* EU:C:2005:594, paragraphs 30 and 36, and order in Case C‑ 353/09 P *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraph 36).

25. None the less, a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately (see, to that effect, order in Case C‑ 23/09 P *ecoblue v OHIM and Banco Bilbao Vizcaya Argentaria* EU:C:2010:35, paragraph 47; *Becker v Harman International Industries* EU:C:2010:368, paragraphs 37 and 38; and order in *Perfetti Van Melle v OHIM* … paragraphs 36 and 37) …"

3. The CJEU delivered its judgment in *Bimbo* after Mr. Martin Boyle for the Registrar decided the present case in BL O/490/13, dated 5 December 2013.

4. On the other hand, the Hearing Officer benefitted from an extensive review of the case law in *Aveda Corporation v. Dabur India Limited* [2013] EWHC 589 (Ch) after which Arnold J. held that the *Medion* principle (see para. 24 of the above citation from *Bimbo*) could apply not only where the common component in a composite sign was identical but also similar (para. 45).

5. That was impliedly accepted by the CJEU in *Bimbo* which stressed that *Medion* did not purport to deviate from the law governing the global assessment of likelihood of confusion (emphasis added):

"33. Next, in so far as Bimbo argues that the General Court disregarded the rule that a finding that one component of a composite sign has an independent distinctive role constitutes an exception, that must be duly substantiated, to the general rule that the consumer normally perceives a trade mark as a whole, it should be pointed out that the purpose of examining whether any of the components of a composite sign has an independent distinctive role is to determine which of those components will be perceived by the target public.

34. Indeed, as the Advocate General observed in points 25 and 26 of his Opinion, it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.

35. The determination of which components of a composite sign contribute to the overall impression made on the target public by that sign is to be undertaken before the global assessment of the likelihood of confusion of the signs at issue. Such an assessment must be based on the overall impression produced by the trade marks at issue, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, as has been stated in paragraph 21 above. Therefore, this does not involve an exception, that must be duly substantiated, to that general rule.

36. Moreover, the individual assessment of each sign, as required by the settled case-law of the Court of Justice, must be made in the light of the particular circumstances of the case and cannot therefore be regarded as being subject to general presumptions. As the Advocate General observed in point 24 of his Opinion, it is clear, in particular, from the case-law subsequent to *Medion* …, that the Court of Justice did not introduce, in that judgment, a derogation from the principles governing the assessment of the likelihood of confusion."

**Application No. 2632956**

6. Application number 2632956 was filed on 28 August 2012 by Barking Brew Limited, which subsequently changed its name to R2 Pets Limited ("the Applicant") for a series of 2 trade marks BARKERS BREW (in lower and upper case).

7. The goods for which registration was sought were in Class 31: Pet food, pet foods, foodstuffs for pet animals; pet food for dogs; food preparations for dogs; dog food.

8. Following publication, the Application was opposed on 27 December 2013 by Société des Produits Nestlé SA ("the Opponent") under Section 5(2)(b) and 5(3) of the Trade Marks Act 1994.

9. The Opponent based its grounds of opposition under Section 5(2)(b) and 5(3) on its earlier series of 3 trade marks BAKERS registered in the UK under number 2137189

in Class 31 for: Foodstuffs for animals, birds and for fish; supplements for the aforesaid goods.

10. The Hearing Officer singled out mark 1 in the Opponent's series for the word mark BAKERS in upper case as representing the Opponent's best case in comparison with mark 2 in the Applicant's series for the word mark BARKERS BREW also in upper case. There was no challenge to that on appeal.

11. The Opponent's series of trade marks was registered on 3 September 1999. It was therefore subject to the proof of use requirements in Section 6A of the Act.

12. The Applicant took issue with the grounds of opposition in a Notice of defence and counterstatement filed on 21 January 2013. The Applicant put the Opponent to proof of use of UK Registration number 2137189.

13. Only the Opponent filed evidence. The matter came to a hearing before Mr. Boyle on 18 July 2013. The Opponent was represented at the hearing by Mr. Dale Carter of Nestlé UK Limited. The Applicant did not appear and was not represented, but instead filed written submissions.

**Hearing Officer's decision**

14. The Hearing Officer's findings were in brief:

*Proof of use*

1. The Opponent had amply proved genuine use of the "mark in suit"[2] during the material period (29 September 2007 – 28 September 2012). A fair specification in view of such use was: Dog food; foodstuffs for pet animals.

*Section 5(2)(b)*

2. The respective goods were identical (Case T-133/05, *Gérard Meric v. OHIM* [2006] ECR II-2737).

3. The average consumer was a pet-owning member of the public. The purchase act would primarily be visual, through selecting the goods from a shelf in a retail outlet, but oral considerations could not be ruled out. The average consumer would pay more than the lowest degree of attention to the selection of food best suited to their pet. However, pet food was a relatively inexpensive everyday item and its purchase would not involve a very carefully considered decision.

4. As the possessive form of a common English surname, BAKERS had no more than average inherent distinctive character. However, the evidence established that the Opponent's mark had acquired a high degree of enhanced

[2] It is not clear whether this finding by the Hearing Officer was with regard to the Opponent's series of 3 trade marks or mark 1 of the Opponent's series, which the Hearing Officer had identified as representing the Opponent's best case. Nothing turned on this on appeal.

distinctiveness in the UK through use in relation to pet food by the application date.

I note that the evidence showed widespread and longstanding use of BAKERS with secondary marks for dog/puppy food and treats including BAKERS COMPLETE, BAKERS REWARDS, BAKERS MEATY MEALS, BAKERS JOINT DELICIOUS, BAKERS MEATY TWISTS, BAKERS DENTAL DELICIOUS, BAKERS HEALTHY DELIGHTS, BAKERS MINI BONES, BAKERS WHIRLERS, BAKERS HEALTHY HEARTS, BAKERS SIZZLERS, BAKERS ALLSORTS, BAKERS PLAY 'N' CHEW, BAKERS NUTRICHEW, BAKERS HAPPY WALKS, BAKERS GRAVY BITES, BAKERS NIBBLES (Witness Statement of Dale Carter, dated 24 April 2013, DC 3, Witness Statement of Emma Walker, dated 24 April 2013, EW5 – EW8).

5. Used in connection with pet food, the average consumer would perceive BAKERS/BARKERS as possessive forms of common English surnames.

6. Although the word "brew" could conjure up the idea of a mixture of ingredients, its use in connection with dog food (in solid or liquid form) was fanciful.

7. BAKERS was the sole element for comparison in the Opponent's mark.

8. In the Applicant's mark: (a) BARKERS had an average degree of distinctiveness; (b) BREW had at least a moderate degree of distinctiveness due to its unusual/fanciful use in the context of pet food; (c) BARKERS qualified BREW to produce a composite term. Together they formed the dominant and distinctive element of the mark.

9. There was a reasonable degree of visual similarity and a moderate degree of oral similarity between the marks.

10. Beyond the fact that BAKERS/BARKERS would be seen as surnames, there was no conceptual similarity between them. The unusual and fanciful use of the word BREW gave it at least moderate distinctiveness in the Applicant's mark and produced a modest conceptual difference between the marks.

11. In the Applicant's mark, BARKERS had no significance independent of BREW. BREW was not a purely descriptive word like LITE or COMPLETE indicating a product extension of pet food. Despite the identity of goods, nature of consumer and purchasing act, principle of imperfect recollection and high enhanced distinctiveness of the Opponent's mark, there was no likelihood of confusion direct or indirect.

*Section 5(3)*

12. The Opponent had a strong reputation in its BAKERS brand for pet food.

13. However, the requisite "link" between the marks was not established. In the Applicant's mark BARKERS qualified BREW. The composite term hung together which militated against the Applicant's mark being compared as BARKERS. The average consumer encountering BARKERS BREW on dog food would not bring BAKERS to mind.

14. The conditions of Section 5(3) were not made out.

**The appeal**

15. On 31 December 2013, the Opponent filed Notice of appeal to the Appointed Person under Section 76 of the Act.

16. At the appeal hearing before me, the Opponent was represented by Mr. Simon Malynicz of Counsel. The Applicant did not appear and was not represented, and filed no written submissions.

17. Mr. Malynicz accepted that the appeal was by way of review of the Hearing Officer's decision, and that this tribunal should not interfere in the absence of error (*REEF Trade Mark* [2003] RPC 5, para. 28).

18. Mr. Malynicz referred me to recent guidance/observations on the standard of review in *Okotoks Limited v. Fine & Country Limited* [2013] EWCA Civ 672 paragraphs 50 – 53, *Healey Sports Cars Switzerland Limited v. Jensen Cars Limited* [2014] EWHC 24 (Pat), paragraph 5, *Shanks v. Unilever plc* [2014] EWHC 1647 (Pat), paragraph 27 and *AGADOR Trade Mark*, BL O/248/14, paragraph 5, which I have borne in mind.

**Grounds of appeal**

19. The main ground of appeal, as I understood it, was that the Hearing Officer was led into error by a wrong interpretation/application of the *Medion* principle on his part.

20. Having earlier acknowledged that BREW would be known to the English speaking public as signifying *inter alia* a mixture of ingredients, he failed to consider the overall blend of meaning and significance that the pet-owning public would ascribe to the composite term BARKERS BREW in the context of the goods in suit (which included liquid dog food). That failure to consider, in the global assessment of likelihood of confusion, the *overall* impression BARKERS BREW would have on the pet food buying public, was contrary to law.

21. I agree.

22. Moreover, to my mind the Hearing Officer failed to take proper account of the evidence in showing:

    1) The state of particularly the UK dog food/treats market and what signs the UK public was accustomed to seeing on/in relation to pet foods at the time. Although the evidence only related to the Opponent's activities, it was clear from that evidence (and the Hearing Officer appeared to accept) that BAKERS

was one of the biggest brands on the UK pet food market, and was likely representative of that market.

2) The particular circumstances surrounding the recognition of BAKERS on the UK market including the extensive range of products being offered by the Opponent under the BAKERS brand + secondary marks as identified at paragraph 14, sub-paragraph 4 above.

23. The controversial passages in the decision were I think paragraphs 36 and 37 (cf. the global assessment of likelihood of confusion), and paragraph 42 (cf. the global assessment of the existence of a "link"):

> "36) The Opponent also submitted that BARKERS retains an independent distinctive role within the mark BARKERS BREW such that a likelihood of confusion could arise between the marks at issue (where the goods are identical) notwithstanding that the element reproduced in the composite mark is not identical. The GC considered this in *Bimbo SA v OHIM* Case T-569/10:
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> > "96 According to the case-law, where goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein (Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37). There may also be a likelihood of confusion in a case in which the earlier mark is not reproduced identically in the later mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé v OHIM - Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 60)".
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> In *Aveda Corporation v Darbur India Ltd* [2013] EWHC 589 (Ch) Arnold J followed *Bimbo*, deciding that the decision in *Medion v Thomson* (C-120/04) can also apply in cases where the composite sign incorporates a sign which is similar to, rather than identical with, the earlier trade mark:
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> > "47 In my view the principle which I have attempted to articulate in [45] above is capable of applying where the consumer perceives one of the constituent parts to have significance independently of the whole, but is mistaken as to that significance. Thus in *BULOVA ACCUTRON* the earlier trade mark was ACCURIST and the composite sign was BULOVA ACCUTRON . Stamp J. held that consumers familiar with the trade mark would be likely to be confused by the composite sign because they would perceive ACCUTRON to have significance independently of the whole and would confuse it with ACCURIST.
> > 48. On that basis, I consider that the hearing officer failed correctly to apply *Medion v Thomson*. He failed to ask himself whether the average consumer would perceive UVEDA to have significance independently of DABUR UVEDA as a whole and whether that would lead to a likelihood of confusion."

37) I have found that the average consumer will perceive both BAKERS and BARKERS simply as the possessive forms of names. I bear in mind the well-known tendency of the human eye to see what it expects to see and the human ear to hear what it expects to hear. However, BAKER and BARKER are both common English surnames which the average consumer in the UK is used to distinguishing. Moreover, I have found that BREW has at least a moderate degree of distinctiveness in connection with pet food, and that BARKERS qualifies BREW to produce a composite term, the two words together jointly forming the dominant and distinctive element of the Applicant's mark. The words BARKERS BREW hang together; their balanced rhythm and alliteration also support this coherent quality. In keeping with my finding that the Applicant's mark consists of a coherent composite term, I do not consider that the average consumer would normally regard BARKERS as having a significance independent of the whole mark BARKERS BREW. BREW is not, for example, the kind of purely descriptive word, like LITE or COMPLETE, which would normally be expected to indicate a product extension in connection with pet food. Even bearing in mind the identity of the goods, my findings on the nature of the average consumer and the purchasing process, the principle of imperfect recollection and the fact that that the Opponent's mark has a high degree of acquired distinctiveness, I find there is no likelihood that the marks will be confused, or that the average consumer will consider the relevant goods provided under the respective marks to be the responsibility of the same or an economically linked undertaking. **The ground of opposition under section 5(2)(b) is dismissed.**

[…]

42) Having assessed the matter against the above criteria [Case C-252/07, *Intel Corporation Inc. v. CPM United Kingdom Ltd* [2008] ECR I-8823, paras. 41 – 42], I come to the view that a link will not be made. Although there is reasonable visual and moderate aural similarity between the marks, the goods are identical, the earlier mark has acquired distinctiveness, and its reputation is strong, I take the view that the relevant public will not bring BAKERS to mind if they encounter BARKERS BREW as a trade mark in relation to dog food. The UK consumer is used to distinguishing between common English surnames and in the applicant's mark BARKERS qualifies BREW. The composite term 'hangs together' and militates against the applicant's mark being compared as simply BARKERS. I am not persuaded that the average consumer will call the earlier mark to mind in this case. I therefore find that no link has been established. Where no link is made the requirements of section 5(3) cannot be met. **The ground of opposition under section 5(3) is dismissed.**"

## Discussion

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

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

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

27. Mr. Malynicz referred me to 2 earlier decisions of Mr. Geoffrey Hobbs Q.C. sitting as the Appointed Person in *CARDINAL PLACE Trade Mark*, BL O/339/04[3] and *CANTO Trade Mark*, BL O/021/06[4], as similarly expressing the same point that marks must be compared as wholes, considering the blend of meaning given by the composite mark against the single term.

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

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

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

    2) The extent and circumstances of public recognition of BAKERS on the UK market (Case C-C-252/12, *Specsavers International Healthcare Ltd and Others v Asda Stores Ltd*, 18 July 2013, paras. 34 – 41, Case T-47/06, *Antartica Srl v. OHIM* [2007] ECR II-0042, paras. 48 – 60, confirmed on appeal Case C-320/07 P [2009] ECR I-0028) which would have included a wide and varied range of BAKERS + sub-brand pet foods/treats.

    Both were significant because they would have contributed to the overall impressions of the respective marks in the minds of the pet-owning public, when those marks were encountered in use on the UK market in relation to pet foods.

[3] CARDINAL PLACE geographical whereas CARDINAL religious.
[4] ERIC CANTONA CANTO name + nickname rather than house mark + sub brand or invented word.

## Conclusion

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

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

32. My decision in this appeal is, therefore, as follows:

    (1) The Opponent's appeal against the Hearing Officer's refusal of the opposition under Section 5(2)(b) and 5(3) of the Act is allowed.

    (2) Opposition number 104285 to Trade Mark Application number 2632956 in Class 31 is remitted to the Registrar for determination by a different Hearing Officer.

    (3) The Hearing Officer's decision as to the costs of the opposition proceedings is set aside.

    (4) The costs of this appeal are to be treated as costs incurred in the opposition proceedings, and the question of how and by whom they are to be paid is reserved for determination by the Registrar as part of his decision on costs at the conclusion of the proceedings in the Registry.

Professor Ruth Annand, 3 November 2014

Mr. Simon Malynicz of Counsel instructed by Nestlé UK Limited appeared for the Opponent/Appellant.

The Applicant/Respondent did not appear and was not represented.