

O-514-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3222567
BY JACK & MAGGIE'S LTD FOR THE TRADE MARK**

**PRIMAL
INSTINCT**

IN CLASS 31

AND

**THE OPPOSITION THERETO UNDER NUMBER 409578
BY
NATURAL INSTINCT LIMITED**

Background

1. On 3 April 2017, Jack & Maggie's Ltd ("the applicant") filed trade mark application number 3222567, for the mark shown below, in respect of "*Foodstuffs for dogs and cats; dog food; cat food; bones and chewing bones for dogs; treats (foods) for dogs and cats; Animal foodstuffs; pet food; biscuits for animals; meat and vegetable based foods for animals*", in class 31.

**PRIMAL
INSTINCT**

2. The application was accepted and published in the *Trade Marks Journal* for opposition purposes on 14 April 2017. Natural Instinct Limited ("the opponent") opposes the application under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). For sections 5(2)(b) and 5(3), the opponent relies upon the following two earlier trade marks:

2626609

Natural Instinct
Dog and Cat food as nature intended

Natural Instinct
Dog and Cat food as nature intended

(a series of two marks)

Class 31: *Foodstuffs for dogs and cats; dog food; cat food; dog biscuits; bones and chewing bones for dogs; treats (foods) for dogs and cats; litter for dogs and cats.*

Date of filing: 3 July 2012; completion of registration procedure: 7 December 2012.

European Trade Mark (“EUTM”) 11438074

Natural Instinct
Dog and Cat food as nature intended

Class 31: *Foodstuffs for dogs and cats; dog food; cat food; dog biscuits; bones and chewing bones for dogs; treats (foods) for dogs and cats; litter for dogs and cats.*

Date of filing: 19 December 2012, claiming a UK priority date of 3 July 2012; currently opposed.

3. The opponent claims that the marks are very similar, that the parties’ goods are identical, and that its own mark has an enhanced level of distinctiveness through use, leading to a likelihood of confusion under section 5(2)(b) of the Act.

4. For section 5(3) of the Act, the opponent claims that use of the applicant’s mark would take unfair advantage of the distinctive character, and/or cause detriment to the distinctive character and repute of its mark. It also claims that the similarities between the marks will cause the relevant public to believe that they are either used by the same undertaking or that there is an economic connection between the users.

5. Under section 5(4)(a) of the Act, the opponent claims that use of the applicant’s mark is liable to be prevented under the law of passing off, owing to its goodwill attached to the sign NATURAL INSTINCT, which it claims to have used throughout the UK since May 2009, in respect of the same goods which are covered by its two earlier rights set out above.

6. The applicant filed a defence and counterstatement, denying all the grounds.

7. The opponent is professionally represented by Irwin Mitchell LLP, whilst the applicant is professionally represented by Coffin Mew LLP. Both parties filed evidence. Neither party chose to be heard. The opponent filed written submissions during the evidence rounds and in lieu of a hearing.

Opponent's evidence

9. The opponent's evidence comes from Dr Karl H Brackhaus, who is the opponent's Chairman of the Board. I note that Exhibit KB4 comprises Wayback Machine prints from the internet archive, showing pages from the opponent's website since 2009. The mark has been used in relation to cat and dog food. Exhibit KB5 consists of a list of UK stockists as of the date of Dr Brackhaus' witness statement (24 November 2017), the vast majority of which he states were also stockists at the relevant date (3 April 2017). There are 536 email addresses listed, rather than companies. I can see that some of the emails are to 'Pets at Home', to kennels, vets, dog grooming businesses and other pet shops.

10. Revenue figures in relation to the mark in respect of dog and cat food products are as follows:

Year	Revenue
2017	£7,747,330 (until the end of October)
2016	£8,045,811
2015	£6,364,478
2014	£4,733,330
2013	£3,800,000
2012	£2,458,000
2011	£1,265,000
2010	£563,000
2009	£29,000

11. A selection of invoices is provided in Exhibit KB11 from 2010 to 2017, to customers throughout the UK. Exhibit KB13 comprises images of packaging for the goods.

12. Dr Brackhaus states that it is estimated that the UK pet food market was worth £3 billion in 2016, and that, globally, the market is dominated (80%) by four players (Procter & Gamble, Nestle, Mars and Colgate-Palmolive). The opponent spent

around half a million pounds per year on advertising from 2015 to 2017, by way of features in pet trade publications, local press; attendance at trade and public shows, such as Crufts; and sponsoring the Daily Mirror's Animal Hero Awards, in 2014, and the Battersea Dogs Home Coats and Collars Ball in 2015. Exhibits KB10 and KB14 comprise documentary evidence in support, which also show that the opponent's goods are formulated to replicate cats' and dogs' diets as if they were existing in the wild ("biologically appropriate raw food"). There are many advertorials explaining the health benefits of such a diet.

13. The opponent's pet food won the Pet Industry Award for Pet Specialist Services in 2011 and 2012. In 2016, the opponent was voted the Most Trusted Pet Food Company, Most Welcoming to New Raw Feeders and Top Raw Manufacturer by the readers of Dogs Monthly magazine. The opponent was one of the main official sponsors at Crufts 2017, which took place in March 2017, with about 162,000 visitors. The mark was displayed on entrance doors to the show, on large banners throughout the venue (the NEC, Birmingham) and the mark was visible in television broadcasts of the show on Channel 4. 10.30 million people watched the television broadcasts. Exhibit KB15 is a copy of a photograph of a large stand showing the mark, with large overhead signage, hanging from the exhibition hall's rafters.

Applicant's evidence

14. The applicant's evidence comes from Christopher Adderley, a director of the applicant. His witness statement is dated 13 February 2018. Mr Adderley exhibits (Exhibit CMA1) definitions from the Oxford Living Dictionary of the words 'primal' and 'natural'. I will come back to these later in this decision. Mr Adderley explains that the word PRIMAL in the applicant's mark was "adopted to evoke the diets of ancient wolves before they evolved into dogs and began to be fed kibble (ground meal shaped into pellets). This is reflected in the use of the "Jurassic Park" inspired font for the mark applied for".

15. Mr Adderley gives some evidence to support his views about the distinctiveness of the words NATURAL INSTINCT; particularly, the lack of distinctiveness of NATURAL. Exhibit CMA2 contains printouts from four UK cat and dog food sellers'

websites, both current and from the Wayback Machine, intended to show that the marks were in use at the relevant date. The marks in question are ‘natures:menu real food pets love’, ‘naturediet the finest food – naturally’, ‘Natural Dog Food Company Nature Knows Best’, and ‘Benyfit Natural Pet Food’. For the first two marks, Mr Adderley has filed the company accounts for the past few years, showing several millions of pounds of annual turnover (the company names are the same as the trade marks).

16. Finally, Mr Adderley states that the applicant has been using the mark since shortly prior to the filing date and that he is unaware of any confusion having arisen.

Decision

17. One of the opponent’s earlier rights, the EUTM, is currently opposed. Since the other earlier right (the national UK series mark) is registered for exactly the same goods as the EUTM has been applied for and is in respect of the identical mark to the EUTM (insofar as the first mark in the series is concerned), I propose to confine my consideration of the opposition to the opponent’s UK registration (the opponent’s strongest case).

Section 5(2)(b) of the Act

18. 5(2)(b) of the Act states:

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

(a) ...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

19. The following principles are gleaned from the decisions of the CJEU 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

20. Some of the goods in the parties' specifications are identically worded: *Foodstuffs for dogs and cats; dog food; cat food; bones and chewing bones for dogs; treats (foods) for dogs and cats*. These goods are, self-evidently, identical.

21. The applicant disputes that the parties' goods are identical on the basis that the applicant's specification is wider than the opponent's. This is erroneous. The law requires that goods be considered identical where one party's description of its goods encompasses the specific goods covered by the other party's description (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, GC:

“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”.

22. The following table shows that the remainder of the applicant’s goods are also identical to the opponent’s goods, on this principle:

Opponent’s goods	Applicant’s goods
foodstuffs for dogs and cats	animal foodstuffs
foodstuffs for dogs and cats	pet food
dog biscuits	biscuits for animals
foodstuffs for dogs and cats	meat and vegetable based foods for animals

23. In summary, all of the parties’ goods are identical.

The average consumer and the purchasing process

24. 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*.

25. The applicant submits that the goods sold by the parties are ‘human grade’ pet foods (which appears to contain constituents that would be fit for consumption by humans) and that the average consumer (buying for their pets) of such goods is discerning and careful. That may be the case, but the specifications for both parties’ marks covers pet food at pet foods of all kinds and price points (or cat and dog food at large). The average consumer will pay a reasonable degree of attention to the

purchase of food for their cat or dog; it will not be an impulse purchase, but nor will it entail a high degree of attention. The purchase will be primarily visual, after examining packaging on shelves or via a website, although I do not discount the potential for an aural element to the purchase, such as a discussion with a vet or sales assistant.

Comparison of marks

26. I will make the comparison based upon the first mark in the earlier series of marks which is not in colour so, notionally, covers use of the mark in black, white and colour.

27. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

28. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Earlier mark	Applicant's mark
	

29. The overall impression of the earlier mark is dominated by the words Natural Instinct. The strapline beneath them, while not negligible, is descriptive and smaller within the mark, carrying less weight than Natural Instinct. The applicant has pointed out that the ‘r’ in the word Natural contains a leaf; however, I think this would go unnoticed by the average consumer, who would not examine the mark closely enough to spot it.

30. The applicant’s mark consists of PRIMAL INSTINCT, presented on two lines. The words are visually of equal length, although INSTINCT has more letters (the applicant submits that the size of the letters have been adjusted in order to present them equally). Despite the words appearing on two separate lines, they are dictionary words which will be read as though on one line; as per *Ella Valley Vineyards (Adulam) Ltd v OHIM*, T-32/10, in which the GC stated:

“43 Although, as the Board of Appeal stated, in the mark applied for the word ‘ella’ is larger than ‘valley’ and it is positioned above the latter, it must be held that the configuration of the mark applied for is such that those two words cannot be perceived separately. It must be held that the words ‘ella’ and ‘valley’ are both contained within the black rectangle and are written with the same font and the same colour. Thus, on account of the contiguity of those two words in the black rectangle, and their identical font and colour, and despite the difference in size, the relevant public will perceive the expression ‘ella valley’ as an indissociable whole. In that connection, it should be recalled that, according to settled case-law, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Case C-532/10 P *adp Gauselmann v OHIM* [2011] ECR I-0000, paragraph 24 and the case-law cited).”

Neither word carries more weight than the other; the overall impression is of the combination PRIMAL INSTINCT.

31. The applicant submits that its mark is in 'Jurassic' font. I assume this is a reference to the 'Jurassic Park' films. What can be said is that the letters are striking, with a bold outline and white centres, and that they have a certain rudimentary, primitive nature about them. The earlier mark is in fairly ordinary serifed font, with some of the letters joined together, whilst the strapline has the impression of having been handwritten. The single point of visual similarity lies with INSTINCT, albeit stylistically different. Weighing this single point of similarity against the differences, there is a low degree of visual similarity between the marks.

32. I doubt whether the average consumer, when referring to the earlier mark verbally, would articulate 'Dog and Cat food as nature intended'. The earlier mark will be referred to as 'Natural Instinct'. As visual presentation does not come into play in speech, the aural comparison is based just upon the words in the parties' respective marks. The second word in each mark is identical, whilst the first is completely different in sound. Bearing in mind that, generally speaking, it is the beginnings of marks which have the most impact, I find that there is no more than a moderate degree of aural similarity between the marks.

33. The opponent's position, reflected in its submissions, is that 'Instinct' has an independently distinctive role within its mark. It takes this view because it considers 'natural' and 'primal' to be qualifying words. However, that does not mean that 'Instinct' has an independently distinctive role. The applicant's evidence is partly focused on showing that 'Natural' is low in distinctive character. I consider that both of these views ignore the unitary meaning created by the combination of 'natural instinct', and of 'primal instinct'. These are words which have meaning in combination.

34. The applicant has filed evidence to show that natural and primal have different meanings. Exhibit CMA1, from oxforddictionaries.com gives the following definitions, the most relevant of which are:

Natural: “existing in or derived from nature; not made or caused by humankind...having had a minimum of processing or preservative treatment...having an innate skill or quality...coming instinctively to a person.”

Primal: “relating to an early stage in evolutionary development; primeval.”

35. Whilst it is the marks as wholes which must be considered, I think that the words ‘natural’ and ‘primal’ evoke different responses, even in combination with ‘instinct’. Primal is a much more visceral word than natural. It will resonate with average consumers as denoting something primitive. So, although what the marks have in common is that they denote behaviour that comes naturally, the applicant’s mark evokes a particular impression: that of an instinct which goes back to prehistory.

36. I will bring forward these points when I come to make the global assessment as to whether there is a likelihood of confusion.

Distinctive character of the earlier mark

37. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*¹ 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).

¹ 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).”

38. The applicant has filed evidence to support its view that NATURAL does not have any distinctive character. The only part of the earlier mark which is a point of similarity between the marks is INSTINCT. However, because I have found that NATURAL INSTINCT has a meaning as a unit, rather than two separate, unrelated words, I will assess the distinctive character of the unit. In the context of pet food, whilst the mark is not directly descriptive, it is not hard to grasp the idea that the food is natural rather than overly processed and will appeal to the animal’s natural, instinctive behaviour. Inherently, the mark (particularly when considered with the explanatory strapline) is of low to moderate distinctive character.

39. One of the principles which must be taken into account in deciding whether there is a likelihood of confusion is that 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. With this in mind, I need to assess whether the use made by the opponent of its mark has improved the low to moderate inherent distinctiveness level of the mark. The relevant date for this assessment is the filing date of the contested application. The mark has been consistently used in the format in which it is registered and has had reasonably wide exposure in relation to dog-related publications and events, notably Crufts. However, whilst showing a healthy growth, the turnover is not substantial. The UK pet food market was worth £3 billion in 2016. The opponent’s turnover for that year was approximately £8 million.

40. Distinctive character is a measure of how strongly the mark identifies the goods of the opponent, not simply that it is known. It includes taking into account, as set out in *Lloyd*, the inherent characteristics of the mark. I have found the mark inherently to be of low to moderate distinctive character. Given that the opponent has not had a turnover of several million pounds until recently, I find that the most that the opponent can claim is that the inherent distinctive character of its mark has been enhanced through use to a moderate level (as opposed to low to moderate). This is only in relation to dog food; evidence of use has not been shown for the remainder of the goods, in which case the inherent distinctiveness of the mark, in relation to goods other than dog food, is low to moderate.

Likelihood of confusion

41. 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 authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. I have found that the goods are identical.

42. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law,

the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

43. As set out earlier in this decision, I do not agree with the opponent that ‘instinct’ plays an independently distinctive role in either mark. The marks have meanings as units. Those meanings indicate natural behaviour but, in my view, the applicant’s mark has another layer of resonance; one of primitive, evolutionary behaviour. This message is reinforced by the visual form of the letters, which have a primitive appearance, in sharp contrast to the gentler, serifed form of the earlier mark. The purchasing process is primarily visual, bringing to the fore these visual differences between the marks.

44. Whilst there is, on the face of it, a level of conceptual similarity, as explained, there is an extra dimension to the concept of the applicant’s mark. Primal does not strike me as a word normally encountered in the field of pet food; it is evocative and

striking. In contrast, even without the applicant's evidence, I would regard 'natural' as a popular word for pet food which is unprocessed. The opponent's strapline supports the unprocessed image.

45. The marks are visually similar to only a low degree and aurally similar to no more than a moderate degree. Whilst the goods are identical, I believe that the differences between the marks, the average degree of attention during a primarily visual purchase, and the fact that the earlier mark is distinctive (through use) to no more than a moderate degree (and only for dog food) are sufficient to avoid the marks being imperfectly recalled. There is no likelihood of confusion in the direct sense; i.e. one mark being mistaken for the other.

46. I will also consider whether there is confusion in the indirect sense. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

47. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, said at paragraph 81:

“In particular, it is important that the detail of each of the sub-paragraphs does not provoke the tribunal into too detailed an analysis of what I believe should

be an emulation of an instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier mark in mind.”

48. I consider that, in particular, the very different visual form of the marks means that the average consumer is not likely to think that they are sub-brands or variants of the same, or an economically linked, undertaking. Mr Mellor, in the case referred to above, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element.

49. There is no likelihood of confusion. The opposition fails under section 5(2)(b) of the Act.

Section 5(3) of the Act

50. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

51. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

52. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its mark has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the three types of damage claimed (unfair advantage and detriment to distinctive character and repute) will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. In this case, the goods are identical.

53. The first condition is reputation. For its section 5(3) ground, the opponent relies upon all the goods of its registration. The CJEU gave guidance in relation to assessing reputation in *General Motors*:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

54. His Honour Judge Hacon, in *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC) stated “Reputation constitutes a knowledge threshold”. It is a question of how many of the potential consumer of the goods know of the earlier mark. The opponent states that the UK market for pet food was worth £3 billion in 2016. The opponent had a very small share of this in that year, which was its best year at £8.4 million². Having said that, Dr Brackhaus states that the global market is dominated (80%) by four companies: Proctor & Gamble, Nestle, Mars and Colgate-Palmolive, from which I infer that this is the general position in the UK. The remaining market share will be occupied by smaller players, but that does

² A 0.0375% share.

not mean that they are little-known, particularly if what they are offering is different from the more traditional type of pet food. In this regard, it is clear from the rest of the evidence that the opponent has undertaken extensive marketing activities, including at Crufts, which is broadcast on mainstream television, to tap into the market for pet food which replicates the type of food a dog (and the evidence is almost all in relation to dogs) would pursue instinctively if in the wild. I find that the earlier mark has met the requirement to show that it had a reputation in the UK at the relevant date, but only in relation to dog food.

55. The list of factors set out by the CJEU in *Intel*, to be taken into account in determining whether there is a link, includes, as separate factors, the strength of the earlier mark's reputation and the degree of distinctive character, whether inherent or acquired by use. I have already said that the mark is distinctive through use to no more than a moderate degree. There is no inconsistency between this finding and the finding of reputation because the latter is concerned with a knowledge threshold, whilst the former is concerned with how strongly the mark identifies the goods of the earlier mark as emanating from a single undertaking. Although the mark has had a turnover of several million pounds, it has achieved this only recently. At the relevant date, the mark's level of distinctive character was not strong and neither was its reputation.

56. A further factor is the degree of similarity between the marks and the goods. The goods for which there is a reputation, dog food, are identical to some of the applicant's goods. I have given my view about the marks above. Whilst a link may be found even though there is no likelihood of confusion³, other factors, such as market share, strength of distinctive character and strength of reputation do not point in the opponent's favour; neither does the level of similarity between the marks. I do not think there will be a link, even in relation to the identical goods (dog food), and, therefore, also no link in relation to any of the other goods of the application. However, even if I am wrong about that, any calling to mind by consumers of the earlier mark would be fleeting, before being dismissed. Such a link would not be strong enough to cause any of the types of damage claimed.

³ *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P.

57. As the conditions of section 5(3) of the Act are cumulative, the ground fails.

Section 5(4)(a) of the Act

58. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

59. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “a substantial number” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

60. I find that the opponent had sufficient goodwill in dog food at the date of application, which is the relevant date (there being no evidence of use filed by the applicant), to bring the complaint of passing off.

61. The opponent does not appear to me to be in any better a position than in respect of the section 5(2)(b) ground. The opponent's sign cannot be said, on the evidence, to be a household name, or to enjoy such a level of reputation that the distance between the marks matters less. In *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5, in the Court of Appeal, Jacob LJ said:

"16 The next point of passing off law to consider is misrepresentation. Sometimes a distinction is drawn between "mere confusion" which is not enough, and "deception," which is. I described the difference as "elusive" in *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40. I said this, [111]:

"Once the position strays into misleading a substantial number of people (going from 'I wonder if there is a connection' to 'I assume there is a connection') there will be passing off, whether the use is as a business name or a trade mark on goods."

17 This of course is a question of degree—there will be some mere wonderers and some assumers—there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former.

18 The current (2005) edition of Kerly contains a discussion of the distinction at paras 15–043 to 15–045. It is suggested that:

"The real distinction between mere confusion and deception lies in their causative effects. Mere confusion has no causative effect (other than to confuse lawyers and their clients) whereas, if in answer to the question:

'what moves the public to buy?', the insignia complained of is identified, then it is a case of deception."

19 Although correct as far as it goes, I do not endorse that as a complete statement of the position. Clearly if the public are induced to buy by mistaking the insignia of B for that which they know to be that of A, there is deception. But there are other cases too—for instance those in the Buttercup case. A more complete test would be whether what is said to be deception rather than mere confusion is really likely to be damaging to the claimant's goodwill or divert trade from him. I emphasise the word "really."

62. The use of the application would not cause a substantial number of the opponent's customers to be misled into purchasing the applicant's goods, believing that they are provided by the opponent. The section 5(4)(a) ground fails.

Overall outcome

63. The opposition fails. The application may proceed to registration

Costs

64. The applicant has been successful and is entitled to a contribution to its costs on the scale published in Tribunal Practice Notice 2/2016. The breakdown is as follows:

Considering the notice of opposition and preparing a counterstatement	£400
Considering the other side's evidence and preparing evidence	£800
Total	£1200

65. I order Natural Instinct Limited to pay to Jack & Maggie's Ltd the sum of **£1200**. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of August 2018

Judi Pike
For the Registrar,
the Comptroller-General