

O/958/22

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3606321
BY DEEPAK SONGRA**

TO REGISTER:



ROYAL & PAW

AS A TRADE MARK IN CLASSES 3, 5, 28, 31, 35 & 44

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 425886 BY
ROYAL CANIN SAS**

BACKGROUND AND PLEADINGS

1. Deepak Songra (“the applicant”) applied to register the trade mark shown on the front cover of this decision in the United Kingdom on 8 March 2021. The application was accepted and published on 30 April 2021 in respect of the following goods and services:

Class 3

Pet shampoos; Pets (Shampoos for -); Pet stain removers; Shampoos for pets; Pet odor removers; Deodorants for pets; Non-medicated pet shampoos; Perfumery products.

Class 5

Pet odour neutraliser; Diapers for pets; Vitamins for pets; Pet odor neutralizer; Disposable pet diapers; Dietary pet supplements in the form of pet treats; Sanitary pants for pets; Medicated shampoos for pets; Dietary supplements for pets; Antiparasitic preparations for pets.

Class 28

Pet toys; Toys for pets; Toys for domestic pets; Pet toys containing catnip; Ball launchers for pets; Toys for pet animals; Sports equipment for pets.

Class 31

Pet beverages; Pet foodstuffs; Pet food; Food (Pet -); Pet foods; Pet rabbit food; Beverages for pets; Edible pet treats; Pet food for dogs; Foodstuffs for pet animals.

Class 35

Retail services in relation to pet products.

Class 44

Pet grooming; Grooming (Pet -); Pet grooming services; Pet hospital services; Pet bathing services; Grooming of pets; Pet beauty salon services; Care of pet animals.

2. On 30 July 2021, the application was opposed by Royal Canin SAS (“the opponent”). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) and concerns all the goods and services in the application.

3. Under section 5(2)(b), the opponent is relying on the following UK Trade Marks (“UKTMs”):

Earlier Mark	Goods and services relied upon
UKTM No. 908272239 (“earlier figurative mark”)  Colour claimed: Red Filing date: 30 April 2009 Registration date: 12 January 2010	<u>Class 5</u> <i>Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use; hygienic bandages, sanitary panties or sanitary towels in particular for animals; antiparasitic collars for animals, antiparasitic preparations, air freshening preparations, animal washes, deodorants, other than for personal use, repellents for animals, lotions for animals, nutritional additives for animals; disinfectants made from essential oils, air purifying preparations made from essential oils; air freshening preparations; air purifying preparations; animal washes bath preparations, medicated; bath salts for medical purposes; dietetic foods adapted for medical purposes / dietetic food preparations adapted for medical purposes; dietetic substances adapted for medical use; disinfectants for hygiene purposes; dog lotions; dog washes; medicines for veterinary purposes.</i> <u>Class 31</u> <i>Foodstuffs for animals; beverages for animals, edible chews for animals, sanded paper for animals (litter), aromatic sand for animals (litter), strengthening animal forage, malt; animal foodstuffs; by-products of the processing of cereals, for animal consumption / residual products of</i>

Earlier Mark	Goods and services relied upon
	<i>cereals for animal consumption; dog biscuits; draff; edible chews for animals; meal for animals; protein for animal consumption.</i> <u><i>Class 35</i></u> <i>Dissemination of advertisements; public relations; business information and consultancy for consumers, retailing of animal foodstuffs and goods for animals.</i> <u><i>Class 44</i></u> <i>Veterinary services; hygienic and beauty care for human beings or animals; Medical services; hospital services; animal grooming; health care; medical assistance; pet grooming; veterinary assistance.</i>
UKTM No. 801264344 ("earlier word mark") ROYAL CANIN Filing date: 12 June 2015 Registration date: 12 July 2016 Priority date: 16 December 2014¹	<u><i>Class 5</i></u> <i>Veterinary and sanitary products and substances; dietetic foodstuffs for veterinary use; dietetic substances for veterinary use; nutritional additives for animals; vitamins for animals; vitamin supplements for animals; food supplements for animals; protein supplements for animals; nutritional supplements for animals; medicated animal foodstuffs; medicated edible chews for animals.</i> <u><i>Class 31</i></u> <i>Edible chews for animals; foodstuffs and beverages for animals, birds and fish.</i>

3. The opponent claims that the contested mark is highly similar to the earlier figurative mark and similar to the earlier word mark, and that the goods and services are identical or highly similar. As a result, it claims that there is a likelihood of confusion, that is increased as a result of the enhanced distinctiveness of the earlier marks

¹ Priority is claimed from French Trade Mark No. 14 4 142 200.

4. Under section 5(3), the opponent claims that the marks have a reputation for the following goods:

Earlier Mark	Goods
UKTM No. 908272239 (“earlier figurative mark”)	<u>Class 5</u> <i>Dietetic substances adapted for medical use; dietetic foods adapted for medical purposes / dietetic food preparations adapted for medical purposes; dietetic substances adapted for medical use.</i> <u>Class 31</u> <i>Foodstuffs for animals; beverages for animals, edible chews for animals, animal foodstuffs; by-products of the processing of cereals, for animal consumption / residual products of cereals for animal consumption; dog biscuits; draff; edible chews for animals; meal for animals; protein for animal consumption.</i>
UKTM No. 801264344 (“earlier word mark”)	<u>Class 5</u> <i>Veterinary and sanitary products and substances; dietetic foodstuffs for veterinary use; dietetic substances for veterinary use; nutritional additives for animals; vitamins for animals; vitamin supplements for animals; food supplements for animals; protein supplements for animals; nutritional supplements for animals; medicated animal foodstuffs; medicated edible chews for animals.</i> <u>Class 31</u> <i>Edible chews for animals; foodstuffs and beverages for animals, birds and fish.</i>

5. The opponent claims that the marks are known by a significant part of the public concerned by the goods set out in the above table, and that in view of this reputation and the similarity of the marks, the relevant public would believe that the marks were

used by the same undertaking or that there was an economic connection between the users of the marks. The opponent asserts that use of the contested mark without due cause would take unfair advantage of the earlier marks' reputation by feeding on their fame, riding on their coat-tails and/or free-riding on the investment made by the opponent in the earlier marks. In addition, or in the alternative, the opponent claims that use of the contested mark without due cause is likely to be detrimental to the distinctive character of the earlier marks by weakening their ability to identify goods and services as originating from the opponent's business.



The opponent asserts that this sign has gained substantial goodwill in the UK and that any use of the contested mark for the goods and services in the application has the capacity to cause deception and confusion, including inducing customers to believe that the goods and services sold under the contested mark emanate from, or are associated with, the opponent, causing damage to the opponent's business.

7. On 14 December 2021, the applicant filed a defence and counterstatement denying the claims made. He did not put the opponent to proof of use of the earlier marks.

EVIDENCE AND SUBMISSIONS

8. Only the opponent filed evidence. This is in the form of a witness statement from Karen Gurney, Finance Director UK & Ireland at Royal Canin Europe, of Royal Canin SAS, dated 11 May 2022. It is accompanied by 12 exhibits. The evidence goes to the claimed reputation and goodwill of the earlier marks.

9. Neither party requested to be heard and both filed written submissions in lieu of a hearing on 16 August 2022. This decision has been taken following a careful consideration of the papers.

REPRESENTATION

10. In these proceedings, the opponent is represented by Hogan Lovells International LLP and the applicant represents himself.

DECISION

Section 5(2)(b)

11. Section 5(2) of the Act is as follows:

“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.”

12. An “earlier trade mark” is defined in section 6(1) of the Act, the relevant part of which reads:

“(a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

13. Both earlier marks completed their registration procedures more than five years before the date of the application for the contested mark (“the relevant date”). The applicant chose not to request proof of their use and so the opponent may rely on all the goods and services listed in the table in paragraph 3 of this decision.

14. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):²

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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;

² Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision refers to the trade mark case law of EU courts.

- 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 greater 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; and
- 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.

Comparison of goods and services

15. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These may include the nature of the goods and

services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Goods and services are complementary when

“... 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.”³

16. Section 60A of the Act states that:

“(1) For the purposes of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

17. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the

³ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

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.”⁴

18. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated that:

“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 für 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.”⁵

19. In *SEPARODE Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”⁶

⁴ Paragraph 12.

⁵ Paragraph 29.

⁶ Paragraph 5.

20. In making my comparisons, I have borne these authorities in mind.

Class 3

21. The applicant's *Pet shampoos*, *Pets (Shampoos for -)*, *Shampoos for pets* and *Non-medicated pet shampoos* are used to keep a pet clean. They are similar in physical nature to *Animal washes*, covered by the earlier figurative mark, as both are liquids, and will be used in the same way. They also share the same users and end users and are likely to be sold through the same trade channels. I interpret the opponent's term to cover medicated *Animal washes* and the applicant's to cover non-medicated *Shampoos*. This is because the opponent's term sits in Class 5 of the Nice Classification, while the applicant's sits in Class 3.⁷ Where the terms could refer to goods in numerous classes, it is permissible to use the class headings as an aid to interpretation: see *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)* [2018] EWHC 3608 (Ch), paragraph 94. On this basis, I find that there is only limited competition between the goods, as a consumer would tend to buy medicated products to address specific problems and non-medicated goods would not be directly substitutable. I find that the goods are similar to a high degree.

22. The specification for the earlier word mark also covers goods in Class 5. I consider that there is some overlap in purpose between the applicant's *Shampoos* and the opponent's *Sanitary products and substances*, as the opponent's goods are also used to keep people or animals clean. As above, however, I am interpreting the applicant's term as covering non-medicated goods and the opponent's as covering medicated goods. There will also be some shared users and trade channels, and some of the opponent's goods will be similar in physical nature to those of the applicant. I find that there is a medium degree of similarity between them.

⁷ The heading for Class 3 is *Non-medicated cosmetics and toiletry preparations; non-medicated dentifrices; perfumery, essential oils; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations*. The heading for Class 5 is *Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for human beings and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides*.

23. In my view, the average consumer would construe the terms *Pet stain removers* and *Pet odor removers* to refer to cleaning products designed for removing stains and smells from carpets, upholstery and other surfaces, to which they would be applied. The purpose and method of use would then be different from those of the goods covered by both of the earlier marks that I have considered in the previous two paragraphs. I would, however, expect there to be shared trade channels, as the applicant's goods would be sold through specialist pet stores and in the pet aisles of supermarkets. There is no competition or complementarity between them. I find that there is a very low degree of similarity between the goods.

24. I have also considered whether a comparison of these goods with *Retailing of animal foodstuffs and goods for animals*, also covered by the earlier figurative mark, improves the opponent's position. In my view, the average consumer would understand the phrase "*goods for animals*" to refer to goods that are intended to be used by, or in connection with, an animal. This would include *Pet stain removers* and *Pet odor removers*. It is clear from the case law⁸ that, where the applicant's goods are to be compared to the opponent's retail services, the retail services will be different in nature, purpose and method of use from those goods. Despite these differences, where there is some complementarity and shared trade channels, retail services *may* be similar to goods. It is equally clear that complementarity alone will not suffice for a finding of similarity, where from the consumer's point of view, the retail services of the applicant would not normally be offered by the same undertaking as the goods. Furthermore, I note that I must not treat the retail services as goods, although consideration of the retail services normally associated with the opponent's goods should be made. In my view, the consumer would expect some stores offering the opponent's retail services to sell *Pet stain removers* and *Pet odor removers* under the same sign. Consequently, there is some complementarity and shared trade channels. I find that there is a medium degree of similarity between the applicant's *Pet stain removers* and *Pet odor removers* and the opponent's *Retailing of animal foodstuffs and goods for animals*.

⁸ See *Oakley, Inc. v OHIM*, Case T-116/06, paragraphs 46-57; *Sanco SA v OHIM*, Case C-411/13 P, *Assembled Investments (Proprietary) Ltd v OHIM*, Case T-105/05, upheld in *Waterford Wedgwood Plc v Assembled Investments (Proprietary) Ltd*, Case C-398/07 P, and the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Tony Van Gulck v Wasabi Frog Ltd*, BL O/391/14.

25. The applicant's *Deodorants for pets* would, in contrast, be applied to the animal itself in order to make it smell more pleasant. The specification for the opponent's earlier figurative mark includes the term *Deodorants, other than for personal use* in Class 5. To aid my interpretation of this term, I shall again resort to the Nice Classification. The Explanatory Note to Class 5 states that the class includes "*deodorants, other than for human beings or for animals*". I shall therefore compare the applicant's term with the opponent's *Animal washes*, as it seems to me that this is likely to result in a greater degree of similarity between the goods. *Deodorants for pets* overlap in purpose with *Animal washes*, and the user and end user are the same. I consider that the goods would be sold through the same trade channels and there may be a degree of competition, although, as I have already noted, the medicated nature of the opponent's goods means that this will be very limited. I find that there is a medium degree of similarity between the applicant's *Deodorants for pets* and the *Animal washes* covered by the earlier figurative mark.

26. Turning to the earlier word mark, I find that there is a degree of similarity in purpose between the opponent's *Sanitary products and substances* and the applicant's *Deodorants for pets*. The purpose of the opponent's goods is, as I have already noted, to keep people or animals clean, while the applicant's goods are used to remove unpleasant smells from a pet animal. I have also found that the opponent's Class 5 goods are medicated, while the applicant's Class 3 goods are not. There will be a degree of overlap in trade channels and method of use, but any competition will be very limited, given the differences in purpose and nature of the goods. I find that there is a low degree of similarity between the goods.

27. The final Class 3 term that I must consider is *Perfumery products*. I shall compare these first to the opponent's *Air purifying preparations made from essential oils* that are covered by the earlier figurative mark. The purpose of the applicant's goods is to impart a pleasant aroma to an individual, a product or the air. They do this by masking unwanted odours. By contrast, the opponent's *Air purifying preparations* remove or neutralise odours or contaminating substances.⁹ There is likely to be very limited

⁹ See the explanatory note on "030215: air fragrancing preparations" at <https://www.wipo.int/classifications/nice/nclpub/en/fr/>, accessed on 30 October 2022.

overlap in users, and I consider that the trade channels will not be shared. There will be a limited degree of competition as the user may decide to buy a product that masks an odour or one that removes it. I find that there is at most a low degree of similarity between these goods.

28. The applicant's *Perfumery products* would include products that are used for masking pet odours. The reasoning in paragraph 24 above, in which I compared *Pet stain removers* and *Pet odor removers* to *Retailing of animal foodstuffs and goods for animals*, is applicable here and I find there to be a medium degree of similarity between the opponent's services and the applicant's goods in so far as they relate to animals. I accept that there will be a large number of goods covered by the applicant's *Perfumery products* that do not fall into this category and, if necessary, I shall return to this point later in my decision.

29. I do not consider that there is any similarity between the applicant's *Perfumery products* and the goods covered by the earlier word mark.

Class 5

30. The applicant's *Pet odour neutraliser* and *Pet odor neutralizer* are products that remove pet odour from the air and so are included in the more general categories of *Air freshening preparations* and *Air purifying preparations*, that are found in the specification of the earlier figurative mark. They are identical per *Meric*. However, I find that none of the goods covered by the earlier word mark are similar.

32. The remaining contested goods in this Class are included in broader terms found in the specifications of the earlier marks, as indicated in the table below. They are identical per *Meric*.

Contested Goods	Broader category (earlier figurative mark)	Broader category (earlier word mark)
<i>Diapers for pets, Disposable pet diapers, Sanitary pants for pets.</i>	<i>... sanitary panties or sanitary towels ... for animals.</i>	<i>Sanitary products.</i>
<i>Vitamins for pets, Dietary pet supplements in the form of pet treats, Dietary supplements for pets.</i>	<i>Nutritional additives for animals.</i>	<i>Food supplements for animals.</i>
<i>Medicated shampoos for pets.</i>	<i>Animal washes.</i>	<i>Veterinary and sanitary products and substances.</i>
<i>Antiparasitic preparations for pets.</i>	<i>Antiparasitic preparations.</i>	<i>Veterinary ... products and substances.</i>

Class 28

32. The contested *Pet toys, Toys for pets, Toys for domestic pets, Pet toys containing catnip, Ball launchers for pets, Toys for pet animals, Sports equipment for pets* are all products that would be bought by owners to entertain or exercise their pets. They share trade channels with the opponent's *Retailing of animal foodstuffs and goods for animals* and in my view there is some complementarity as the average consumer would expect the supplier of the service to sell its own brand of toys under the same mark. I find that the applicant's Class 28 goods are similar to a medium degree to the Class 35 retail services of the earlier figurative mark.

33. Turning to the word mark, I will compare the applicant's Class 28 goods with the opponent's Class 31 *Foodstuffs and beverages for animals, birds and fish*. The users and end-users of the goods are the same as those of the opponent's goods, and they would also be sold through the same trade channels, such as pet shops and supermarkets. However, the purpose, nature of the goods and methods of use are different, and they are not in competition or complementary. Taking all these factors into account, I consider that there is a low degree of similarity between these goods and those of the opponent.

Class 31

34. The applicant's *Pet beverages* and *Beverages for pets* are included in the opponent's *Beverages for animals*, which can be found in both earlier specifications, and so are identical per *Meric*.

35. The applicant's *Pet foodstuffs*, *Pet food*, *Food (Pet -)*, *Pet foods*, *Pet rabbit food*, *Edible pet treats*, *Pet food for dogs* and *Foodstuffs for pet animals* are *Meric* identical to the opponent's *Foodstuffs for animals*, which again can be found in the specifications of both the earlier marks.

Class 35

36. The applicant's *Retail services in relation to pet products* are *Meric* identical to the opponent's *Retailing of animal foodstuffs and goods for animals*, which is a term in the specification of the earlier figurative mark.

37. It is my view that the applicant's retail services would be supplied through the same trade channels as the *Foodstuffs for animals* covered by the opponent's earlier word mark and that there is also complementarity, as the average consumer would not be surprised to see, for example, a large pet store or supermarket selling foodstuffs under its own name. I find that there is a medium degree of similarity between the applicant's retail services and the opponent's foodstuffs.

Class 44

38. All the applicant's Class 44 services are identical to terms included in the specification of the earlier figurative mark, either because they are self-evidently identical (*Pet grooming*, *Grooming (Pet -)*, *Pet grooming services* and *Grooming of pets*) or per *Meric*, as indicated below:

Applicant's Services	Includes	Included by
<i>Pet hospital services.</i>		<i>Veterinary services; Hospital services.</i>
<i>Pet bathing services; Pet beauty salon services.</i>		<i>Hygienic and beauty care for ... animals.</i>
<i>Care of pet animals</i>	<i>Pet grooming</i>	

39. Some of the goods covered by the earlier word mark may be used during the provision of the applicant's Class 44 services. In particular, *veterinary ... products* would be used in pet hospitals. The users and distribution channels will coincide, but the nature, method of use and purpose will not be the same. I do not consider that there will be complementarity, given the specialist nature of the goods and services. The average consumer would not expect the same undertaking to be responsible for both. I find that the contested Class 44 services are dissimilar to the goods covered by the earlier word mark.

Average consumer and the purchasing process

40. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

"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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."¹⁰

41. The average consumer of the goods and services at issue would be a pet owner, or a pet-related business such as a breeder, groomer, proprietor of a boarding kennel or cattery, or veterinary practice. The goods would all be bought from specialist retailers, such as pet shops, or supermarkets and their online equivalents. The

¹⁰ Paragraph 60.

consumer may also have been exposed to advertising on television or in print media. Foodstuffs will be bought often as they are used every day, while the remaining goods will still be purchased fairly frequently. Most are relatively inexpensive, and the consumer will select them from the shelves or a website. They will therefore see the mark when they choose which products to buy.

42. I accept that pharmaceutical and veterinary preparations may be more costly than the rest of the goods. They may also be obtained on prescription from the veterinary practice, although some will be selected from the shelves or purchased from behind a counter. In this last case, the aural impact of the mark will be important. It may also have a role to play during the purchasing of the other goods, although that would be largely a visual process. The professional consumer is likely to select the goods from websites or printed promotional material. They may also discuss their purchases with a sales representative.

43. When choosing a supplier of the Class 35 retail services, the consumer will be considering the range of goods on offer, the prices charged, convenience of the location or delivery options, and any special offers or services provided. The consumer may have been exposed to advertising on television or in print, come across an online retailer when browsing the internet, or seen signage when out and about. Again, the visual element of the mark will be significant, although the possibility of word-of-mouth recommendations means that I cannot ignore the aural element.

44. I consider that word-of-mouth recommendations may be significant when choosing the Class 44 services, but the businesses supplying such services may also advertise through social media, websites and publications. The services will be purchased less frequently than the goods, although I acknowledge that grooming services in particular will be used on a regular basis to maintain the appearance and comfort of the pet.

45. It is my view that the average consumer will pay at least an average degree of attention when buying food for a pet animal and a higher than average degree of attention when purchasing nutritional supplements, medicines or services that are related to the welfare of those animals, namely the Class 44 services. When buying

the non-consumable goods and choosing retail services, the level of attention paid will be average.

Comparison of marks

46. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”¹¹

47. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

48. The respective marks are shown below:

Earlier marks	Contested mark
	

¹¹ Paragraph 34.

Overall impression of the marks

49. The contested mark is a composite mark made up of a device above the words “ROYAL & PAW” which are shown in black capital letters in a standard typeface. The applicant submits that *“My trademark is very distinctive and conceptual in design as it is in the form of a Paw Print within the crown as well as a totally different font style as compared to the opposition”*. I see that the device is a crown which has been formed by superimposing a white paw print on a gold pentangle, with a curved gold line below. The height of the device is slightly more than that of the letters. I consider that some average consumers will see both crown and paw, as they are reinforced by the words below the device. However, I believe that it is more likely that consumers will first notice the crown, given the curved gold line which would be seen as representing its base. In my view, identifying the paw requires a closer look and the sort of detailed attention that the average consumer is unlikely to pay to the mark. Where a trade mark contains figurative and verbal elements, it is the verbal elements that tend to be considered more distinctive: see *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37. I acknowledge, though, that this is not a hard and fast rule.¹² Given its size relative to the mark as a whole and its contrasting colour, I consider that the device makes a significant contribution to the overall impression of the mark. If it is not equal to the contribution of the words, it is not much lower. Within the verbal element, “ROYAL” will have a slightly larger role, as the average consumer also tends to pay more attention to the beginning of marks: see *El Corte Inglés, SA v OHIM (MUNDICOR)*, Cases T-183/02 and T-184/02, paragraphs 81-83. In addition, “PAW” alludes to the end users of the goods and services at issue.

50. The earlier figurative mark consists of the words “ROYAL CANIN” in red capitals, with slightly stylised “A”s. “CANIN” is French for “canine”, but the average consumer is unlikely to be aware of this. However, the similarities between these words leads me to find that the average consumer is likely to believe that “CANIN” is an alternative, or even an incorrect, spelling of “canine”. “ROYAL” serves to qualify “CANIN”. Spanning the letters “L” and “C” is a device containing red dots and a curved red line forming the shape of a crown. Both the device and the words contribute to the overall impression

¹² See, for example, *Metamorfoza d.o.o. v EUIPO*, Case T-70/20, paragraphs 57-58.

of the mark. Bearing in mind the case law I have quoted in the previous paragraph and the size of the device relative to the words, it is my view that the larger role will be played by the words, which will be seen as a unit. The overall impression of the word mark lies solely in the words as a unit.

Comparison with the earlier figurative mark

51. Both marks contain crown devices and “ROYAL” as a first word. The words that follow are different, and in the contested mark the words are separated by the ampersand symbol. The stylisation of the letters and of the crown device also differ,¹³ and the earlier mark is red, in contrast to the gold, white and black of the contested mark. Taking both marks as wholes, I find that there is a low to medium degree of visual similarity between them.

52. Turning now to the aural comparison, I consider that the earlier figurative mark will be pronounced “ROY-ULL KAY-NINE” or “ROY-ULL KA-NIN”. The contested mark will be pronounced “ROY-ULL AND PAW”. In both cases, the device will not be able to be spoken. The number of syllables in both marks is the same, and the first two of these are identical. I find that the marks are aurally similar to a medium degree.

53. The crown device and word “ROYAL” in both marks evoke the idea of monarchy and, more generally, magnificence. I have already found that the average consumer is likely to believe that “CANIN” refers to a dog, and so the earlier mark will bring to mind a magnificent, or royal, dog. “PAW” in the contested mark also brings to mind an animal. I find that the marks are conceptually similar to a high degree.

Comparison with the word mark

54. Registration of a word mark protects the words contained in the mark, whatever form, colour or typeface are used: see *LA Superquímica v EUIPO*, Case T-24/17, paragraph 39. The words in the contested mark are presented in black in a standard

¹³ In *The Royal Academy of Arts v Errea Sport SpA*, BL O/010/16, Mr Iain Purvis QC, sitting as the Appointed Person, held that two representations of the same thing may have no visual similarity.

typeface, which could also be used by the opponent for its mark. Together with the identical beginning, this points to a slightly greater degree of visual similarity between these marks than I found in my earlier comparison, but the absence of a device points in the opposite direction. Overall, I find that there is a low degree of visual similarity between the marks.

55. The absence of a device does not affect the aural comparison between the marks and so I adopt the findings I made in paragraph 52 above.

56. As the device conveys the same meaning as “ROYAL”, I adopt my findings on the conceptual comparison between marks made in paragraph 53 above.

Distinctive character of the earlier mark

57. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Alternberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and

statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

58. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

59. The opponent submits that the earlier marks have a high level of inherent distinctive character, and that this has been enhanced through use. I shall consider inherent distinctiveness first.

60. I have already found that the earlier word mark brings to mind a royal or magnificent dog. In the case of the goods and services aimed towards dogs, the mark is allusive both of the end-user and of high quality. However, the unconventional (at least to an English speaker) spelling of “canine” raises what would have been a low degree of inherent distinctiveness to a medium level. Where the goods and services are aimed at other animals, the inherent distinctiveness of the mark is slightly higher than medium.

61. Turning now to the earlier figurative mark, I consider that the device and stylisation slightly raise the inherent distinctiveness of the mark to just above medium for dog-related goods and services, and to fairly high for goods and services intended for other animals.

Has the inherent distinctiveness of the earlier marks been enhanced through use?

62. In her witness statement, Ms Gurney says that the opponent was founded in France in 1968 by a veterinarian who had

“... the vision of a pet food company grounded in science; based on the principles of acquiring knowledge about pets, maintaining respect for them

at all times and, most importantly, creating advanced cat food and dog food made to satisfy the needs of the pet.”¹⁴

63. She adds that it has worked in partnership with leading veterinary schools and universities, veterinarians and breeders to develop its products, which at the date of the witness statement included 250 dry and 120 wet pet food formulas.¹⁵ The opponent claims to be the first company to have produced age- and size-specific dog food in 1997 and breed-specific cat and dog food in 1999 and 2002 respectively.¹⁶ These goods are, Ms Gurney states, sold through veterinary practices and specialist pet stores.

64. Exhibit KG2 contains extracts from Royal Canin’s Feline Product Book of June 2017 and Canine Product Book from November 2018. These books contain product details and are intended for use by veterinary practices. They show the mark in use on the packaging of the goods:¹⁷



¹⁴ Paragraph 14.

¹⁵ Paragraphs 24-25.

¹⁶ Exhibit KG1.

¹⁷ Exhibit KG2, page 28.

65. The extracts are supplemented with screenshots from the Royal Canin UK-facing website showing the full range of products available.¹⁸ These were obtained on 3 May 2022, which is after the relevant date of 8 March 2021. However, Ms Gurney states that a “*substantially similar*” range of products was available to UK consumers at the relevant date.¹⁹ This statement has not been challenged. The products shown in Exhibit KG2 consist of dietetic cat and dog food and beverages, and nutritional supplements for dogs. Those shown in Exhibit KG3 are dog and cat food, both dietetic and non-dietetic, milk powder, and nutritional supplements for dogs. Exhibit KG4 shows a similar range of products sold through online pet retailers such as Pets at Home. Again, these screenshots were all obtained after the relevant date but Ms Gurney makes an unchallenged statement that a “*substantially similar*” range of products was available at the relevant date.²⁰

66. The table below contains information on the opponent’s market share in the UK. Ms Gurney clarifies that the figures relate to goods sold to retail consumers through online and offline stores.²¹

Data	2017	2018	2019	2020	2021
UK Main Pet Food Market	Over £2 billion	Over £2 billion	Over £2.1 billion	Over £2.2 billion	Over £2.3 billion
UK Speciality Pet Food Market	Over £500 million	Over £500 million	Over £600 million	Over £600 million	Over £700 million
Royal Canin Sales	Over £69 million	Over £70 million	Over £80 million	Over £100 million	Over £120 million
Royal Canin share of UK Main Pet Food Market	At least 3%	At least 3%	At least 3%	At least 4%	At least 5%
Royal Canin share of UK Speciality Pet Food Market	At least 12%	At least 13%	At least 13%	At least 14%	At least 16%

¹⁸ Exhibit KG3.

¹⁹ Paragraph 34.

²⁰ Paragraph 40.

²¹ Paragraph 43.

67. Figures for sales via veterinary practices are shown below:²²

Calendar Year (Full)	2016	2017	2018	2019	2020	2021	Total
Royal Canin	Value (£) Total %	Value (£) Total %	Value (£) Total %	Value (£) Total %	Value (£) Total %	Value (£) Total %	Value (£) Total %
Total UK sales of pet food products via veterinarians	105,510,573	101,636,685	99,649,717	98,469,111	101,796,705	110,288,111	617,351,103
UK sales of (non-Royal Canin) pet food products via veterinarians	53,968,246 51.1%	49,927,030 49.1%	47,118,519 47.3%	44,756,104 45.5%	45,719,634 44.9%	44,991,319 40.8%	286,480,852 46.4%
UK sales of Royal Canin pet food products via veterinarians	51,542,328 48.9%	51,709,855 50.9%	52,531,198 52.7%	53,713,007 54.5%	56,077,071 55.1%	65,296,792 59.2%	330,870,251 53.6%

69. The opponent has engaged with the public through a variety of social media accounts, its website, advertising and sponsored articles in sources such as *The Guardian*, cosmopolitan.com/uk, countryliving.com/uk, *Sunday Times*, *The Observer*, *The Daily Telegraph* and *Good Housekeeping* (all examples from 2017 and 2018), and sponsorship of the Crufts Dog Show in March 2018.²³ The earlier figurative mark appears on the adverts and sponsored content, as shown in the examples below:²⁴

²² Paragraph 44.

²³ Exhibits KG7-KG10.

²⁴ Exhibit KG9, pages 1 and 8.

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70. The Royal Canin brand has also been featured in articles, blogs and publications and a sample is provided in Exhibit KG11. The earliest of these thirteen articles is dated 4 March 2017 and the latest 22 July 2021. Five out of the thirteen have a date later than the relevant date. The articles are taken from sources such as *The Sunday Times*, *The Daily Telegraph*, *The Scottish Daily Mail* and websites aimed at veterinary professionals and business in the petcare sector.

71. Taking the evidence as a whole, I consider that the use described above, notably the level of sales, market share and promotional activity in widely read publications, has enhanced the distinctiveness of the earlier marks in so far as they relate to foodstuffs for cats and dogs, including dietetic food. I am not persuaded that distinctiveness of the marks has been enhanced in relation to beverages or nutritional supplements. The advertisements and articles focus on the food products, and the majority of the goods shown on the invoices are also food.

72. The opponent's evidence focuses on the goods in respect of which it claims a reputation and goodwill, as it was not asked to prove use of all the goods and services relied upon. I am unable to find that the distinctiveness of either earlier mark has been enhanced for any of the services or for goods other than *Foodstuffs for cats and dogs* (both marks) and *Dietetic foods for cats and dogs, adapted for medical purposes* / *Dietetic food preparations for cats and dogs, adapted for medical purposes* (earlier figurative mark) and *Dietetic foodstuffs for cats and dogs, for veterinary use* (earlier word mark).

Conclusions on likelihood of confusion

73. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services or vice versa.

74. Confusion may arise in one or more of several different ways: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraphs 16-17. For example, the consumer

may mistake one trade mark for another (frequently termed “direct confusion”). They rarely have the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have in their mind. They might see one mark days, weeks or months after having seen the other. Alternatively, they might recognise that the marks are different, but assume that they belong to the same undertaking or that there is some other connection between them.

75. The opponent submits that the average consumer will be directly confused, as they will be buying the goods and services in what is a largely visual purchasing process and, for at least some of the goods and services, they will be paying a low degree of attention. This submission is based on a high degree of visual similarity between the marks and identity or high similarity between the goods and services. The opponent also submits that the average consumer is likely to be indirectly confused and may think that the opponent has joined with a company called PAW to co-brand a range of goods and/or services, or that the contested mark denotes a sister company, or a sub-brand, of the opponent. The applicant disagrees with the opponent.

76. I shall deal first with direct confusion with the earlier figurative mark. I found a lower degree of visual similarity between the marks and, while I found that some of the goods and services were identical to goods and services covered by the earlier figurative mark, I found the remaining goods and services to be similar to either a high or a medium degree. I also found that the distinctiveness of the earlier mark was at a medium to high level, depending on which goods and services were being considered.

77. There are several points I need to make here. First, a finding that the earlier mark enjoys a high level of distinctive character does not automatically lead to a finding of confusion. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis QC, sitting as the Appointed Person, pointed out that the level of distinctive character is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.²⁵ The similarities between the marks come down to the word “ROYAL” at the start of a string of eleven characters (including spaces) and a crown device centred above those words. There are stylistic

²⁵ Paragraph 39.

and syntactical differences with the opponent's verbal element appearing as a unit, while the applicant's consists of two separate words joined with an ampersand. On balance, I consider that the earlier mark's enhanced level of distinctive character will not significantly increase the likelihood of confusion.

78. The second point I will make is that I am required to assess the likelihood of confusion on the basis of the notional and fair use of both marks in relation to all the goods and services for which the earlier mark is entitled to protection and in respect of which the contested mark might be used if registered: see *Roger Maier & Anor v ASOS* [2015] EWCA Civ 220, paragraph 78. The fact that the opponent might have provided no evidence of use in relation to a particular good or service is in this instance immaterial, as it was not put to proof of use of the earlier marks.

79. It is my view that where the goods and services are identical, there will be a likelihood of confusion, as the average consumer will mistake one mark for another. I have taken account here of the interdependency principle so that even where the visual similarity between the marks is low, the identity of the goods will lead the consumer to be mistaken. The similarity between the marks is not sufficient to my mind for the consumer to be mistaken where the goods are merely similar. The section 5(2)(b) ground therefore succeeds in relation to the following goods and services:

Class 5

Pet odour neutraliser; Diapers for pets; Vitamins for pets; Pet odor neutralizer; Disposable pet diapers; Dietary pet supplements in the form of pet treats; Sanitary pants for pets; Medicated shampoos for pets; Dietary supplements for pets; Antiparasitic preparations for pets.

Class 31

Pet beverages; Pet foodstuffs; Pet food; Food (Pet -); Pet foods; Pet rabbit food; Beverages for pets; Edible pet treats; Pet food for dogs; Foodstuffs for pet animals.

Class 35

Retail services in relation to pet products.

Class 44

Pet grooming; Grooming (Pet -); Pet grooming services; Pet hospital services; Pet bathing services; Grooming of pets; Pet beauty salon services; Care of pet animals.

80. Turning now to the remaining goods in Classes 3 and 28, I am unpersuaded that, if the average consumer recognises that the marks are not the same, they will assume that there is a connection between them. I see no reason why “ROYAL & PAW” would be a logical sub-brand of “ROYAL CANIN”, or why they would be seen as sister companies. It is not “ROYAL” on its own that gives the earlier mark its distinctiveness. Neither can I see why the opponent would just use “ROYAL” in a co-branding exercise with another company. I do not believe that the average consumer would be confused in any of these ways.

81. The earlier word mark puts the opponent in no better a position. I found there to be a lower degree of similarity between this mark and the contested mark than I found for the earlier figurative mark. I also found that the level of similarity for all the remaining goods was lower.

82. The opposition succeeds under section 5(2)(b) for the goods and services listed in paragraph 79 above.

Section 5(3)

83. Section 5(3) of the Act is as follows:

“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 European Union trade

mark or international trade mark (EU) in the European Union) 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.”

84. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L’Oréal SA & Ors v Bellure & Ors* (Case C-487/07) and *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09). 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 Salomon*, 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 and/or services, the extent of the overlap between the relevant consumers for those goods and/or 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 that 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 and/or 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 and/or services for which the earlier mark is registered, or a serious risk that this will happen in the 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'Oréal*, 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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

Reputation

85. In *General Motors*, the CJEU held that:

“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 services 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.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

86. The factors that I must take into account when assessing whether the earlier marks have reputations are the same as those I needed to consider when dealing with the question of enhanced distinctiveness. I found that in the case of both marks the use shown was sufficient to enhance their inherent distinctiveness for *Foodstuffs for cats and dogs* (both marks) and *Dietetic foods for cats and dogs, adapted for medical purposes / Dietetic food preparations for cats and dogs, adapted for medical purposes* (earlier figurative mark) and *Dietetic foodstuffs for cats and dogs, for veterinary use* (earlier word mark).

87. The territorial aspects are, however, different. Under enhanced distinctiveness, it was the UK that was the relevant territory, as it was through the eyes of the average consumer in the UK that the mark needed to be considered. The marks the opponent claims to have a reputation are comparable marks which were brought onto the UK register following the end of the Brexit transition period. Tribunal Practice Notice (“TPN”) 2/2020 states that:

“where it is asserted that a comparable mark has a reputation under section 5(3), and that reputation falls to be considered at any time before IP Completion Day, use of the corresponding EUTM in the EU will be taken into account in determining whether the comparable mark had a reputation at the relevant date.”

88. The relevant territory is therefore the EU up to IP Completion Day (31 December 2020) and the UK from 1 January 2021 to 8 March 2021.

89. I have already noted that the bulk of the opponent’s evidence concerns sales and other activities in the UK, although I acknowledge the filing of invoices for sales in Germany and Ireland. The CJEU held in *Pago International GmbH v Tirolmilch Registrierte GmbH*, Case C-301/07, that a single Member State could, in principle, constitute a substantial part of the territory of the EU.²⁶ In *Whirlpool Corporation & Ors v Kenwood Limited* [2009] ETMR 5 (HC), Mr Geoffrey Hobbs QC, sitting as a Deputy Judge of the High Court, held that:

“Article 9(1)(c) provides protection for Community trade marks which have a reputation ‘in the Community’. Kenwood suggested that this means a reputation across the Community as a whole or at least a large area of it. I do not agree. In the case of a trade mark registered at the national level, protection of the kind provided by art. 9(1)(c) can be claimed for trade marks which have a reputation in the sense that they are known by a significant part of the public concerned by the products or services covered by that trade mark in the territory of registration. Since the territory of registration is

²⁶ Paragraph 30.

part of the Community, the trade mark has a reputation in the Community. The trade mark does not cease to have a reputation in the Community if the national registration is either subsumed within a Community trade mark registration under art. 34(2) of the CTMR on the basis of a valid claim to seniority or duplicated by a Community trade mark registration. In principle, a Community trade mark should not receive less protection than a national trade mark with a reputation in the same territory. I think that the aim should generally be to prevent conflict occurring in any substantial part of the Community and that the United Kingdom can for that purpose be regarded as a substantial part of the Community, with or without the addition of France and Germany. It thus appears to me that Whirlpool's Community trade mark has a reputation in the Community."²⁷

90. I am satisfied that the opponent has a strong reputation for the goods set out in paragraph 86 above.

Link

91. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU in *Intel* at paragraph 42 of its judgment. I shall consider each of them in turn.

The degree of similarity between the conflicting marks

I refer here to the findings that I made under section 5(2)(b) in paragraphs 46-56 above.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

All the contested goods and services relate to pets, as do the goods for which the earlier marks have reputations. I cannot simply adopt the findings I made under section 5(2)(b) as the opponent has fewer goods, and no services, in play

²⁷ Paragraph 76.

under this ground. The applicant's Class 31 goods are either identical or highly similar to the opponent's goods, while the applicant's *Vitamins for pets*, *Dietary pet supplements in the form of pet treats* and *Dietary supplements for pets* overlap in purpose and share the same trade channels, users and end users as the opponent's *Dietetic foods*. I find them to be similar to a medium degree. The remaining goods and services share the same users and end-users, and will share some trade channels. However, the nature of the goods and services and their method of use differ, and I do not consider there to be competition or complementarity. I find that the remaining goods and services are similar to the opponent's section 5(3) goods to a low degree.

The strength of the earlier mark's reputation

As noted in paragraph 91 above, I find that the earlier marks have a strong reputation. The opponent was founded with the aim of creating "advanced" cat and dog food based on a scientific understanding of their needs.²⁸ The range of foods sold under the earlier marks creates this image in the mind of the public and that image has been reinforced through the tone and content of the advertisements and sponsored articles.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

I refer here to the findings that I made under section 5(2)(b) in paragraphs 57-72 above.

Whether there is a likelihood of confusion

Under section 5(2)(b), I found there to be a likelihood of confusion where the goods and services were identical.

92. A likelihood of confusion automatically results in a link and the goods to which this finding applies are listed below:

²⁸ See paragraph 64 above.

Class 31

Pet foodstuffs; Pet food; Food (Pet -); Pet foods; Pet food for dogs; Foodstuffs for pet animals.

93. Under section 5(2)(b), I found that there was no likelihood of confusion where the grounds were merely similar. However, I remind myself that the CJEU held in *Intra-Press SAS v OHIM*, Joined cases C-581/13 P and C-582/13 P, that the level of similarity required for the public to make a link between the marks for the purposes of section 5(3) may be less than the level of similarity required to create a likelihood of confusion.²⁹ The similarities in presentation and the initial word “ROYAL” are, in my view, sufficient for the public to make a link, given the strong reputation of the earlier marks and the fact that all the goods and services relate to pets. This would not include the applicant’s *Perfumery products* in so far as they do not relate to pets.

Damage

94. The opponent claims that damage would occur either as a result of the applicant gaining an unfair advantage or through the dilution of the earlier marks. I shall consider unfair advantage first.

95. Unfair advantage means that consumers are more likely to buy the goods and services of the contested mark that they would otherwise have been if they had not been reminded of the earlier marks. In *L’Oréal*, the CJEU said:

“The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation 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

²⁹ Paragraph 72.

marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image.”³⁰

96. Earlier in the same case, the CJEU also said:

“As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It 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.”³¹

97. Where there is a likelihood of confusion, the applicant would gain an unfair advantage through the average consumer mistaking one mark for another, and thus buying the applicant's goods instead of the opponent's. Damage is therefore made out for the goods listed in paragraph 92 above.

98. Turning to the remaining goods and services, I note that the opponent makes no other submissions as to how the applicant might gain an unfair advantage. In its notice of opposition and statement of grounds, it simply cites the text from *L'Oréal* that I have quoted above in paragraph 95.

99. In *Argos Limited v Argos Systems Inc* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour for the goods and/or services offered under the later trade mark was required to establish unfair advantage. This may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later trade mark: see *Claridges Hotel Limited v Claridge Candles Limited & Anor* [2019] EWHC 2003 (IPEC).

³⁰ Paragraph 50.

³¹ Paragraph 41.

100. The opponent has not presented me with any submissions as to how this might occur, and so I find that unfair advantage has not been made out for the remaining goods.

101. I shall now consider the opponent's claim that there will be detriment to the distinctive character of the mark. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12 P, the CJEU stated that:

“34. According to the Court's case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words '[i]t follows that', immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the earlier mark; it could thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81, and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of 'change in the economic behaviour of the average consumer' lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers' perceptions. The mere fact that consumers note the presence of a new sign similar to an

earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.

38. The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39. The General Court found, at paragraph 62 of the judgment under appeal, that ‘the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the earlier mark’s ability to identify the goods for which it is registered as coming from the proprietor of that mark’.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No. 207/2009 and the Court’s case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account

of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.”

102. The sum total of the opponent’s submissions on this point is that:

“The Earlier Marks are each highly distinctive and the use of the Application would dilute any distinctive character in the mark.”³²

103. I accept that direct evidence of a change in consumers’ economic behaviour is unlikely to be available, and that, in such an instance, a change in behaviour can be inferred from the inherent probabilities of the situation: see *32Red Plc v WHG (International) Limited & Ors* [2011] EWHC 665 (Ch), paragraph 133. The only inference I have been invited to make, though, is that the public is likely to believe that the services come from the same undertaking or that there is an economic link between the parties. Detriment to distinctive character has not been made out.

104. The applicant has not shown that it has due cause to use the contested mark and so the section 5(3) ground succeeds in relation to the following goods:

Class 31

Pet foodstuffs; Pet food; Food (Pet -); Pet foods; Pet food for dogs; Foodstuffs for pet animals.

Section 5(4)(a)

105. Section 5(4)(a) of the Act states that:

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

³² Written submissions, paragraph 69.

(a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met

...”

106. Subsection 4(A) is as follows:

“The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

107. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”³³

³³ Page 406.

108. *Halsbury's Laws of England* Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged are likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Relevant Date

109. In *Advanced Perimeter Systems v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*, BL O/212/06:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”³⁴

110. The applicant has not claimed to have used the contested mark before the date of application (8 March 2021), and so this is the relevant date.

Goodwill

111. The opponent must show that it had goodwill in a business at the relevant date and that the sign relied upon is associated with, or distinctive of, that business.

³⁴ Quoted in paragraph 43 of BL O-410-11.

112. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

113. I do not propose to repeat here the analysis I have already made of what is shown by the evidence. I am satisfied that at the relevant date the opponent had goodwill in *Foodstuffs for cats and dogs* and *Dietetic foods for cats and dogs, adapted for medical purposes* / *Dietetic food preparations for cats and dogs, adapted for medical purposes* and that the figurative sign was distinctive of that goodwill.

Misrepresentation

114. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is:

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product].

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 RPC 97 at page 101."

115. Although the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer", it is unlikely, in the light of the Court of Appeal's decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different outcomes. Under section 5(2)(b), I found that only where the goods and services were identical would there be a likelihood of confusion. This finding was influenced by the operation of the interdependency principle. For all other goods, the marks were too far apart for the consumer to be confused, and I consider that the differences are sufficient to avoid a substantial number of the relevant public being misled into believing that the applicant's goods and services are those of the opponent, given that the evidence shows that the sign has only been used in relation to the goods identified in paragraph 113 above. I find that misrepresentation is only made out for those goods.

Damage

116. The opponent submits that damage could occur through "*diversion of sales, tarnishment of reputation or erosion of the distinctiveness of the Royal Canin Device Mark*".³⁵ I consider that, as a result of the misrepresentation, there is likely to be a diversion of sales from the opponent to the applicant.

117. The section 5(4)(a) ground succeeds in relation to the following goods:

Class 31

Pet foodstuffs; Pet food; Food (Pet -); Pet foods; Pet food for dogs; Foodstuffs for pet animals.

³⁵ Written submissions, paragraph 74.

Outcome

118. The opposition has been partially successful and UKTM Application No. 3606321 will, subject to the outcome of any appeal, proceed to registration for the following goods:

Class 3

Pet shampoos; Pets (Shampoos for -); Pet stain removers; Shampoos for pets; Pet odor removers; Deodorants for pets; Non-medicated pet shampoos; Perfumery products.

Class 28

Pet toys; Toys for pets; Toys for domestic pets; Pet toys containing catnip; Ball launchers for pets; Toys for pet animals; Sports equipment for pets.

119. Registration is refused for the following goods and services:

Class 5

Pet odour neutraliser; Diapers for pets; Vitamins for pets; Pet odor neutralizer; Disposable pet diapers; Dietary pet supplements in the form of pet treats; Sanitary pants for pets; Medicated shampoos for pets; Dietary supplements for pets; Antiparasitic preparations for pets.

Class 31

Pet beverages; Pet foodstuffs; Pet food; Food (Pet -); Pet foods; Pet rabbit food; Beverages for pets; Edible pet treats; Pet food for dogs; Foodstuffs for pet animals.

Class 35

Retail services in relation to pet products.

Class 44

Pet grooming; Grooming (Pet -); Pet grooming services; Pet hospital services; Pet bathing services; Grooming of pets; Pet beauty salon services; Care of pet animals.

COSTS

120. Both parties have enjoyed some success in these proceedings, with the greater part going to the opponent, who is entitled to a contribution towards its costs in line with the scale set out in TPN 2/2016. The award is calculated as follows:

Preparing a statement and considering the other side's statement: £350

Preparation of evidence: £900

Preparation of submissions in lieu of attendance at a hearing: £400

Reduction by 33% to reflect relative success: -£550

Official fees: £200

TOTAL: £1300

121. I therefore order Deepak Songra to pay Royal Canin SAS the sum of £1300, which should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 3rd day of November 2022

Clare Boucher

For the Registrar,

Comptroller-General