

**O/0060/24**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3761113**

**BY BARKING BRAINS LTD**

**AND**

**OPPOSITION 435009**

**BY PET FOOD (UK) LTD**

## BACKGROUND AND PLEADINGS

1. This is an opposition by Pet Food (UK) Ltd (“the opponent”) to an application filed on 2<sup>nd</sup> March 2022 (“the relevant date”) by Barking Brains Ltd (“the applicant”) to register BARKING BRAINS (“the contested mark”) as a trade mark.

2. The application covers goods and services in classes 18, 25, 41, 42 and 44. However, shortly before the hearing described below the applicant indicated it was removing the goods in class 18 from its application in order to narrow the issues in dispute. Consequently, it is only necessary to set out the goods/services in the other classes. These are:

Class 25: Clothing, footwear, headgear.

Class 41: Education; educational services; provision of training; educational research; instruction services; organisation of exhibitions and conferences; publication of books and texts; training of animals.

Class 42: Scientific research; research and reports in scientific fields; medical research; veterinary research; scientific research in the field of psychology.

Class 44: Veterinary services; psychology services; animal assisted therapy.

3. The opponent’s grounds of opposition are based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). However, at the hearing the opponent’s representative accepted that the opposition based on s.5(4)(a) (which protects rights in relation to unregistered trade marks) stood or fell with the other two grounds.<sup>1</sup> Consequently, I will focus on the opposition based on sections 5(2) and 5(3) of the Act, which are as follows:

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<sup>1</sup> In this connection, I note that the evidence of the opponent’s witness, Mr Bushell, claims that the opponent has acquired goodwill in relation to, inter alia, “*advice relating to pets.*” The opponent’s earlier registered marks are not registered for such services. However, the section 5(4)(a) ground still cannot broaden the opponent’s case because the goodwill as pleaded in the notice of opposition does not include “*advice relating to pets.*”

*“(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.*


*(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 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.*

*(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”*

4. The opponent is the proprietor of the following earlier trade marks:

<i>Trade Mark</i>	<i>Filing &amp; Registration Dates</i>	<i>Goods/Services</i>
No. 2552720 <b>BARKING HEADS</b>	12/07/2010  08/10/2010	Class 18: Pet leads; collars for animals  Class 20: Pet beds; dog kennels; kennels for household pets  Class 28: Toys for domestic pets  Class 31: Foodstuffs for animals

<p>No. 3583379</p> 	<p>22/01/2021 28/05/2021</p>	<p>Class 18: Pet leads; collars for animals; harnesses, clothing for pets; muzzles; bags; rucksacks.</p> <p>Class 20: Beds for pets; kennels for pets; cushions for pets; containers, not of metal, for storage or transport; scratching posts for cats.</p> <p>Class 28: Toys and playthings for pets.</p> <p>Class 31: Foodstuffs for animals; alimentary preparations included in Class 31 for use as additives to foodstuffs for animals; litter for animals.</p>
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5. According to the opponent, the contested mark is similar to the earlier marks, *clothing for pets* (for which the earlier '379 mark is registered in class 18) is similar to the applicant's goods in class 25, and there is a likelihood of confusion. Consequently, registration of the contested mark in class 25 would be contrary to section 5(2)(b) of the Act.

6. Additionally, the earlier marks have acquired a reputation in the UK in relation to *foodstuffs for animals* as a result of their use since 2010. The opponent claims that use of the contested mark would, without due cause, take unfair advantage of, and/or be detrimental to, the reputation or distinctive character of the earlier marks. Consequently, the registration of the contested mark in relation to all the goods/services covered by the application would be contrary to section 5(3) of the Act.

7. The applicant filed a counterstatement denying the grounds of opposition. I note, in particular, that the applicant put the opponent to proof that:

- earlier trade mark 2552720 was put to genuine use during the five years ending on the relevant date, and
- the goods in class 25 covered by the application are similar to any of the goods for which the earlier marks are registered.

8. Both sides seek an award of costs.

## **REPRESENTATION**

9. Ward Hadaway LLP represent the applicant. The opponent is represented by Bailey Walsh & Co. LLP. A hearing took place (remotely) on 12<sup>th</sup> January 2024 at which Ms Kendal Watkinson appeared as counsel for the applicant. Mr Philip Stephenson of Bailey Walsh appeared on behalf of the opponent.

## **THE EVIDENCE**

10. The opponent's evidence comes from Will Bushell, who is the Managing Director of the company. According to Mr Bushell, the BARKING HEADS brand was launched in 2008 targeting the premium, high protein content dogfood market. UK turnover under the BARKING HEADS brand in 2020 and 2021 amounted to £7.5m and £9.3m, respectively. Barking Heads dog food has been stocked at PETS AT HOME (a major UK retailer of pet products) since at least 2017.<sup>2</sup> The turnover in 2021 was roughly double the turnover in 2017. The packaging of the product bears the composite '379 mark. However, as one would expect, the accompanying descriptions refer to it simply as BARKING HEADS.

11. The opponent spends around £700k per annum advertising BARKING HEADS products. This includes the cost of the opponent's website barkingheads.co.uk. Historical pages from the website are in evidence which show, inter alia, that the BARKING HEADS word mark is used as such as well as part of the composite '379 mark.<sup>3</sup> The opponent maintains a YouTube channel.<sup>4</sup> The pages in evidence from 2023 include a TV advertisement for BARKING HEADS, which was shown in association with Channel 4's 'Bake Off: The Professionals' program. The advert received over 200k views on YouTube between 2021 and 2023. I also note that an article published in August 2021 on the website of The Independent national newspaper referenced the opponent's dog food as a competitor in the market for quality dog foods.<sup>5</sup>

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<sup>2</sup> Exhibit WB3 to Mr Bushell's statement consists of copies of pages from the website of PETS AT HOME dated April 2019 showing that BARKING HEADS dog food on sale at around £5 per Kg.

<sup>3</sup> See exhibit WB2

<sup>4</sup> See exhibit WB4

<sup>5</sup> See exhibit WB5

12. The applicant's evidence consists of a witness statement by Dr Kathy Murphy, who is the sole director the applicant. Ms Murphy is a neuroscientist and veterinary surgeon by profession and has been in the veterinary and pet industry for 24 years. The applicant's core business is veterinary behaviour neuroscience and animal training. The applicant's customers are people interested in animal behaviour such as trainers, behaviourists and interested dog owners. Dr Murphy says the applicant also intends to provide, ancillary to the core business, some clothing under the brand BARKING BRAINS. In her experience, *"the field of veterinary services and animal behaviour and training is a specialised field and these are not services which are typically (if ever) provided by dog food manufacturers, or under dog food brands."*

13. Dr Murphy also says she has *"..never heard of the Opponent or the mark BARKING HEADS or the dog food products bearing this mark and none of my colleagues have heard of the Opponent or their brand either."* She points out that the UK pet food market as a whole is estimated to be worth in the region of £3.8bn for 2023<sup>6</sup> and the opponent's turnover must be seen in this context.

14. Dr Murphy's evidence is that she has *"..not seen or experienced a single instance of confusion from my customers confusing, or even making any connection between, the Opponent's mark and products and the Company's mark and its goods and services. Nor has the Company, nor I, ever received any communication or queries from customers in this regard, or otherwise demonstrating any confusion of customers between the two brands."*

15. The opponent did not file evidence in reply.

## **THE SECTION 5(2)(b) GROUND OF OPPOSITION**

16. The opponent's closest mark is the '720 word mark. However, this is not registered for any goods that are similar to the applicant's goods in class 25, which is the now the only class at which the opposition under section 5(2) of the Act is directed. Additionally, the '720 word mark is subject to proof of use under section 6A of the Act,

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<sup>6</sup> Sourced from UK Pet Food (previously known as the Pet Food Manufacturers' Association) website

and there is no evidence of any use of the mark in relation to goods in class 18. Consequently, the opponent's only chance of success under section 5(2) depends on the composite '379 mark. This mark was only registered in 2021. Therefore, it is not yet subject to the proof of use requirements. This means that the opponent can rely on the earlier registration of this mark in relation to all the goods for which it is registered.

### **Comparison of goods**

17. The opponent relies on the registration of the earlier '379 mark in relation to *clothing for animals* in class 18 which it submits is similar, albeit to a low degree, to *clothing, footwear, headgear* in class 25. It is common ground that the latter covers goods for use by humans (only). The applicant denies there is any similarity between such goods.

18. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case,<sup>7</sup> for assessing similarity are:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

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<sup>7</sup> [1996] R.P.C. 281

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

19. Human clothing is worn to keep the body warm, to protect it from the elements, to improve the user's appearance, and for modesty. At least the first two purposes also apply to animal clothing.

20. The respective users of the goods are obviously different, although the customers overlap because animal clothes are bought by their owners.

21. The physical nature of the goods is similar because both goods are typically made from natural or man-made materials, such as wool, leather or nylon.

22. The trade channels appear completely different. There is no evidence that clothing, footwear and headgear for humans is marketed through the same trade channels as clothing for animals. It follows the goods are not stocked in proximity to one another.

23. The goods are not competitive or complementary.

24. I have my doubts there is any real similarity between these goods. However, for present purposes I will proceed on the basis they are similar to a low degree.

25. I note in passing that the '379 mark is also registered in relation to *bags*. The opponent has not argued that such goods are similar to clothing. I am aware of cases where such goods have been found to be similar to clothing. However, as these are adversarial proceedings in which I must remain neutral, it would be inappropriate for me to find a better case for the opponent than the one it has chosen to advance. I assume the opponent has decided to argue its case the way it has because it considers that *clothing for animals* represents its best case. Therefore, for present purposes I will proceed on the basis that *bags* are no more similar to (human) clothing than *clothing for animals*.

### **Status of EU case law**

26. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained



EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

### **Global assessment**

27. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

#### *The principles*

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

### **Average consumer and the selection process**

28. Ms Watkinson asked me to take into account that the “*context*” of the applicant’s proposed use of the contested mark in relation to clothing etc. was as a side line to its core services. It is well established that it is necessary to consider all the

circumstances in which the mark applied for might be used if it were registered.<sup>8</sup> The specific use the applicant currently has in mind is, therefore, irrelevant.

29. Although the average consumer's level of attention will vary depending on the cost and exact nature of the goods, clothing etc. in class 25 is usually selected by members of the general public paying an average level of attention.

30. The goods are likely to be selected primarily by eye from shelves, advertisements, webpages etc. However, word of mouth orders/recommendations will also play some part in the selection process. Therefore, the way the marks sound also matters, albeit to a lesser degree than the way they look.

### **Distinctive character of the earlier '379 mark**

31. The opponent submits that the earlier '379 mark is highly distinctive. When I asked Mr Stephenson to explain why he relied on (1) the extensive use made of the mark and (2) the stylisation of the dog's head device element. However, there is no evidence of use of the mark in relation to class 18 goods. It follows that the mark cannot have become more distinctive as a result of such use. The distinctiveness of the device of a dog's head cannot assist the opponent either. This is because it is a point of difference, rather than a point of similarity, between the marks. I was told that the BARKING HEADS mark was coined as a play on the name of the band called Talking Heads. However, I do not think that would be apparent to average consumers of animal clothing etc., so that is also irrelevant.

32. The words BARKING HEADS do not describe animal clothing etc. in class 18. Neither word is particularly distinctive on its own. Indeed, as the applicant points out, the word BARKING is strongly associated with dogs and, therefore, low in distinctiveness in relation to products for dogs. However, the combination of BARKING and HEADS is novel and fairly memorable. Therefore, I find that the relevant element of the earlier mark for present purposes – the words – have a 'normal' or average degree of distinctive character in relation to animal products and animal clothing in class 18.

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<sup>8</sup> See *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, CJEU, Case C-533/06

## Comparison of marks

33. In *Bimbo SA v OHIM*<sup>9</sup> the CJEU stated 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.”*

34. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
	BARKING BRAINS

35. I find that the word and device elements of the earlier mark are equally dominant from a visual perspective. Conceptually, there is little distinction between them because the device complements the message of the words, i.e. a dog's head giving the impression of a dog barking. Aurally, the mark will be pronounced BARK-ING-HEADS.

36. The contested mark shares the word BARKING as the opening element. The second word - BRAINS - bears little resemblance to HEADS, although it is same length, also has a letter A as the third letter, and also ends with an S. The device element of the earlier mark has no counterpart in the contested mark. In my view, the marks are visually similar to only a low degree.

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<sup>9</sup> Case C-591/12P

37. The device does not come into the aural comparison. Consequently, the common word BARKING creates a higher degree of aural similarity between the pronounceable elements of the marks. The aural difference between BRAINS and HEADS counters this to some extent, but not strongly. This is partly because it comes towards the end of the marks (from an aural perspective). I find the marks are aurally similar to a medium degree.

38. Conceptually, although the words BRAINS and HEADS have different (obvious) meanings, the brain is largest organ in the head and is strongly associated with it, e.g. head injury/brain injury. In my view, the marks are conceptually similar to a high degree.

### **Likelihood of confusion**

39. Taking into account:

- (1) The low degree of similarity between the respective goods;
  - (2) The low degree of visual similarity between the marks:
  - (3) The fact the goods will primarily be selected by eye;
  - (4) The average degree of distinctiveness of BARKING HEADS for animal products, particularly dog products;
  - (5) That the average consumer will pay, at least, a normal degree of attention during the selection process;
- I find there is no likelihood of direct confusion, whether through imperfect recollection or otherwise.

40. I also reject the likelihood of indirect confusion. This type of confusion assumes that consumers are aware of the difference between BARKING BRAINS and BARKING HEADS, but recognises the possibility that they may regard the later mark as a variant of the earlier mark and used by the same or a related undertaking. However, there is no evidence that consumers are accustomed to undertakings marketing animal clothes also selling human clothing etc. under the same mark, let

alone using variant marks for their respective lines of goods. Mr Stephenson did try and give such 'evidence' himself by way of submissions in reply at the hearing. It was inappropriate to try and give evidence under the guise of submissions. The proper course was to make an application for leave to file late factual evidence by way of a witness statement. Trying to provide additional factual information at the hearing was also unfair. This is because the applicant had already filed its evidence. Therefore, the allocated time for the applicant to file evidence in response had passed.

41. As it turned out, the claimed fact – that Barbour sells human and pet clothing – would not have assisted the opponent's case for two reasons. Firstly, the mere fact that one well-established brand for, inter alia, clothing also sells an item of clothing for pets (even if true) does not show that this is an established practice in the perception of average consumers. Secondly, the earlier mark here is not a well-established outdoor clothing brand like Barbour.

42. I therefore reject the opponent's section 5(2)(b) ground of opposition.

### **THE SECTION 5(3) GROUND OF OPPOSITION**

43. The opponent's earlier '720 mark is more similar to the contested mark than the '379 composite mark. Therefore, the opponent's best case under section 5(3) rests on the word mark. I will examine the opponent's section 5(3) case accordingly.

44. As I noted earlier, the opponent's reliance on the '720 mark is subject to proof of its use in accordance with section 6A of the Act. The relevant period is 3<sup>rd</sup> March 2017 to 2<sup>nd</sup> March 2022. The applicant accepts that the opponent has shown genuine use of the mark in relation to *foodstuffs for animals*. There is no evidence of use of the earlier marks in relation to any of the other goods for which the marks are registered. Consequently, I find the earlier '720 mark has been put to genuine use in relation to *foodstuffs for animals*.

45. The relevant case law under section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and*

*Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. 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* and *Environmental Manufacturing, paragraph 34*.

(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 of 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*).

46. The applicant disputes that the opponent's evidence establishes that the '720 mark had a reputation at the relevant date with a significant part of the relevant public. The applicant points out that the pet food market is huge with annual turnover in the £billions. The opponent's turnover does not, it is said, represent a significant proportion of that market. Indeed, the applicant's director, who has long experience as a veterinary practitioner, had never heard of the opponent prior to these proceedings.

47. The opponent contends that (1) its turnover under BARKING BRAINS is substantial, (2) the product is stocked by a major national retailer, indicating it is a significant player in the dog food market, (3) the product has been advertised on TV, (4) the pet food market is larger than the market for the opponent's goods (foodstuffs



for dogs), and (5) the applicant's director's lack of knowledge of the opponent's mark is irrelevant.

48. In my view, this is a borderline case. There is merit in the applicant's criticisms of the opponent's evidence, which could undoubtedly have been more informative, e.g. as to the geographic spread of the use, and the timing and reach of any TV advertising. However, on balance, I find the evidence (just) sufficient to establish that BARKING HEADS had a qualifying reputation at the relevant date amongst a significant proportion of the public concerned with *foodstuffs for dogs*. The significant (if not vast) turnover figures, the fact the brand had been stocked by a major retailer of pet products over the 5 years leading up to the relevant date, and the existence of at least some TV advertising since at least 2021, persuades me that the mark was known to a significant proportion of consumers for *foodstuffs for dogs* at the relevant date. The market for pet food is significantly larger than the market for dog food. I am not persuaded that the earlier mark had the necessary presence in the wider market. The opponent uses another brand – MEOWING HEADS – for its cat food, which tends to confirm that dog food has its own market within the broader market for pet food.

## **Link**

49. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in Intel are:

### *The degree of similarity between the conflicting marks*

50. The applicant accepts that the word marks are similar to a low degree.

51. I have already considered the aural and conceptual similarity between the words and found them to be similar to a medium and high degree, respectively. I find the word marks are visually similar to be medium degree.

### *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*

52. The applicant's goods in class 25, i.e. clothing, footwear, headgear (for humans) are dissimilar to *foodstuffs for dogs*. The respective markets appear entirely distinct and distant.

53. The applicant's services in classes 41, 42 and 44 include *training of animals, veterinary research and veterinary services*, as well as other descriptions which include, or closely relate to, those descriptions. Dr Murphy's evidence is that "*the applicant's customers are people interested in animal behaviour such as trainers, behaviourists and interested dog owners.*" I recognise the latter means there is an overlap with consumers of *foodstuffs for dogs*. In this connection, I note Dr Murphy's evidence that "*the field of veterinary services and animal behaviour and training is a specialised field and these are not services which are typically (if ever) provided by dog food manufacturers, or under dog food brands.*"

54. Dr Murphy is not, of course, an independent witness. However, she appears to have relevant experience and her evidence appears credible. Further, the opponent has not challenged her evidence with evidence that directly contradicts it. In these circumstances, I can give some weight to her evidence, which accords with my own experience as a dog owner.

55. It is true that exhibit WB4 to Mr Bushell's statement shows six videos on the opponent's YouTube channel purporting to contain advice from a vet I will call Dr M. However, (1) the YouTube page in question was downloaded on 16<sup>th</sup> March 2023 (i.e. over a year after the relevant date), (2) the content of the videos has not been placed in evidence, (3) the oldest post was only a year before (i.e. probably still after the relevant date), (4) the most popular videos (on pet bereavement) had only been viewed 150 times, and (5) there is no evidence that anyone paid to view these videos, or that they constitute the provision of veterinary services. It seems more likely that these are really free information videos used to promote the opponent's core products. Therefore, I do not find this evidence sufficient to undermine my provisional conclusion that the services in classes 41, 42 and 44 are not usually provided by traders in *foodstuffs for dogs*.

56. I find that the applicant's services in classes 41, 42 and 44 are dissimilar to *foodstuffs for dogs*. This is because although they may be provided for dogs, the

nature, purpose and method of use is different, and the goods/services are not in competition or complementary.<sup>10</sup> The most that can be said is that because the services are also for dogs they are not as distant from *foodstuffs for dogs* as, for example, clothing for humans.

*The strength of the earlier mark's reputation*

57. The earlier mark has a modest reputation in relation to *foodstuffs for dogs*.

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

58. For the same reasons given in paragraph 32 above, I find that the words BARKING HEADS have a medium degree of inherent distinctive character in relation to *foodstuffs for dogs*. The evidence shows that the distinctiveness of the mark has been enhanced through use. In my view, the mark had a fairly high (but not the very highest) level of distinctive character at the relevant date.

*Whether there is a likelihood of confusion*

59. In my judgment, there is no likelihood of confusion. This is mainly because of the relatively modest extent of the reputation of BARKING HEADS, the distance between the goods and services, and the absence of evidence of any significant overlap in the channels of trade. The high level of attention likely to be paid by users of *veterinary research* and *veterinary services* and similar services in classes 42 and 44, also mitigates the likelihood of confusion as far as those services are concerned. This conclusion is consistent with Dr Murphy's evidence that no confusion has so far come to light as a result of the parties' concurrent use of their marks.

*Conclusion on link*

60. I find that average consumers of the goods/services at issue would not make a link between the marks.

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<sup>10</sup> In the relevant sense that the goods are indispensable or important for the use of the services, or vice versa, in such a way that consumers may expect them to originate from the same or related undertakings. See, for example, *Boston Scientific Ltd v OHIM*, Case T-325/06 (the General Court).

61. If I am right about that, the section 5(3) ground of opposition is bound to fail because, absent such a link, there is no possibility of unfair advantage or detriment.

62. However, even if I am wrong about the absence of a link, the section 5(3) ground would still fail. This is because the opponent's section 5(3) case is primarily predicated on a likelihood of confusion. Admittedly, the opponent's pleaded ground of opposition is a little ambiguous in this respect, but the case presented at the hearing was clearer. Mr Stephenson's skeleton argument put it like this:

*"14. Use of the application in suit will take an unfair advantage of the Opponent's earlier trade marks, not least because; he Applicant will benefit from the significant marketing investment that has been made by the Opponent.*

*15. Given the high similarity between the Application and the Opponent's registrations relied upon, it is inevitable that the average consumer would establish an economic connection between the same. This is bound to damage the distinctive character and reputation of the Opponent's marks which they have worked hard to establish.*

*16. Furthermore, this affects the economic behaviour of the relevant public, for the reasons that they are more likely to purchase the goods and services offered under the Application in the mistaken belief that those goods and services are offered by, endorsed or in some way economically connected with the Opponent.*

*17. Notwithstanding the above, the consumer is less likely to purchase the goods offered under the earlier trade mark registrations if the ability of the marks to distinguish the Opponent's goods from a third party's goods is be reduced."* (emphasis added)

63. It seems clear that the claims of unfair advantage/detriment to reputation are contended to be the result of a likelihood of confusion about there being an economic connection between the users of the marks. Mr Stephenson agreed when I summarised the opponent's case this way at the hearing.<sup>11</sup> I rejected the likelihood of

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<sup>11</sup> See page 12 of the transcript

confusion at paragraph 59 above. It follows that even if use of the contested mark were to create a link of the lesser 'bringing to mind' type, the specific consequences the opponent's complains about would not follow.

### **Unfair advantage/detriment**

64. The point made at paragraph 17 of the skeleton argument could arise independently of the outcome of the claimed likelihood of confusion. It was not pursued that way at the hearing. However, for completeness, I would have rejected the claim that use of the contested mark would be detrimental to the distinctive character of the earlier mark. This is because such a claim requires evidence of a change in the economic behaviour of consumers of the opponent's goods, or the serious risk of such a change in the future. This requires "*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.*"<sup>12</sup> Absent a likelihood of confusion, the opponent's dilution case is entirely based on supposition. There is no rational reason to believe that average consumers of *foodstuffs for dogs* will be any less disposed to select products marketed under BARKING HEADS simply because some of them may be reminded that BARKING BRAINS is a mark used by another undertaking for (human) clothes and/or certain dog related services in classes 41, 42 and 44.

65. The section 5(3) ground of opposition therefore also fails.

### **THE SECTION 5(4)(a) GROUND OF OPPOSITION**

66. The opposition under section 5(4)(a) also fails. This is because, absent a likelihood of confusion, there is no prospect of the opponent establishing that use of the contested mark in relation to goods/services in classes 25, 41, 42 & 44 would constitute a misrepresentation to the public. And absent misrepresentation, a claim of passing off would be bound to fail.

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<sup>12</sup> See paragraph 43 of the judgment of the CJEU in *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, applied by the national courts, see, for example, *Monster Energy Co v Red Bull GmbH* [2022] EWHC 2155 (Ch)

## **COSTS**

67. The opposition has failed in classes 25, 41, 42 & 44. The applicant is therefore entitled to a contribution towards its costs.

68. I will take into account that the opposition was also directed at registration of the contested mark in relation to goods in class 18. The applicant only dropped those goods from its application shortly before the hearing. The opponent incurred costs in pursuing this aspect of its opposition. And this part of the opposition would probably have succeeded based on the earlier '379 mark because of the identity of the respective goods. In any event, by deleting class 18 from the application the applicant has effectively conceded this aspect of the opponent's case. Therefore, as far as the written stages on the opposition are concerned, including preparation of the applicant's skeleton argument, the overall result is that the applicant is successful in classes 25, 41, 42 & 44. However, the opponent should be treated as having succeeded in class 18.

69. The goods in class 18 were no longer in issue at the hearing. Therefore, for the purposes of assessing costs for the hearing itself, the applicant should be treated as having been wholly successful.

70. As noted at paragraph 40 above, the opponent's representative tried to give evidence in the guise of submissions at the hearing. He continued to try and do so even after I asked him to focus his reply on submissions.<sup>13</sup> This kind of behaviour risks turning hearings into a free-for-all. It is to be discouraged. I will do so by awarding maximum scale costs for a half day hearing (but not including preparation of the skeletons) against the opponent.

71. I assess the costs due to the applicant as follows:

£250 for considering the notice of opposition and filing a counterstatement;

£600 for considering the opponent's evidence and filing evidence in response;

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<sup>13</sup> Transcript reference required

£1700 for the hearing.

72. I therefore order Pet Food (UK) Ltd to pay Barking Brains Ltd the sum of £2550. This sum must be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings if the appeal is unsuccessful or does not proceed.

**Dated 29<sup>th</sup> January 2024**

**Allan James  
For the Registrar**