

O-226-09

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2446454

BY WESLEY EDMUND

TO REGISTER AS A SERIES OF TRADE MARKS:

PETMATE

AND

petmate

IN CLASSES 6, 18, 20 & 35

AND

IN THE MATTER OF OPPOSITION NO 95421 BY

PET MATE LTD & DOSKOCIL MANUFACTURING CO, INC

TRADE MARKS ACT 1994

**In the matter of application No 2446454
by Wesley Edmund
to register a series of two trade marks in classes 6, 18, 20 & 35**

and

**In the matter of opposition No 95421 by
Pet Mate Ltd & Doscocil Manufacturing Co, Inc**

Background

1. On 12 February 2007 Mr Wesley Edmund applied to register a series of two trade marks. The application details are shown below:

PETMATE

and

petmate

Class 06: Identification tags of metal for animals.

Class 18: Leads (Leather-) Leads for animals Leads made of leather Leashes [leads] for animals Clothing for pets Coats for dogs Collars for dogs.

Class 20: Beds for domestic pets Beds for household pets Beds for pets Carriers for transporting domestic pets [other than cages] Feeding mats for domestic pets Household pets (Nesting boxes for-) Hutches for pets Kennels for household pets Materials for use as beds for domestic pets Nesting boxes for household pets.

Class 35: Advertising services provided over the internet Compilation of advertisements for use as web pages on the internet Compilation of directories for publishing on the Internet.

2. On 13 August 2007 opposition to the registration of Mr Edmund's application was made, jointly, by Pet Mate Ltd ("PM") and Doscocil Manufacturing Company, Inc ("DMC"). The opposition is based on grounds under sections 5(1), 5(2), 5(3),

5(4)(a) and 3(6) of the Act; summarised briefly, the grounds are pleaded on the following basis:

Sections 5(1), 5(2)(a) & 5(2)(b) – That the application is likely to be confused with two of PM’s earlier trade marks for the words PET MATE which cover goods in classes 9, 19, 21 & 28.

Section 5(3) – That the same earlier trade marks have a reputation of which an unfair advantage is being taken and which reduce the ability of the earlier trade marks to distinguish a unique source of pet products.

Section 5(4)(a) – That a goodwill possessed by the joint opponents (which is associated with the signs PET MATE/PETMATE) would lead to any use by the applicant being liable to be prevented by virtue of the law of passing-off.

Section 3(6) – That the applicant does not have a *bona fide* intention to use the mark.

3. Mr Edmund filed a counterstatement denying the grounds of opposition. He states, effectively, that he invented the name PETMATE and was the first to register it. Mr Edmund filed no evidence whereas the joint opponents did; the joint opponents’ evidence is summarised below. **Parts of the evidence have been granted confidentiality from third parties and so the public version of this decision will contain redactions in relation to the confidential evidence as per rule 59(4) of The Trade Marks Rules 2008.** Neither side requested a hearing. Only the joint opponents filed written submissions, although, I will take into account the observations that Mr Edmund made in his counterstatement.

The evidence

Statutory declaration of Christopher Peter Kirk

4. Mr Kirk is the managing director of PM. He describes PM as a “major manufacturer and supplier in the pet products industry”. He states that it does not supply pet food which, he says, is a distinct business with different channels of trade. He states that trade began under the PET MATE name in June 1986 and that the name is a house brand with other signs used under this umbrella (CAT MATE, DOG MATE, FISH MATE). **REST OF PARAGRAPH REDACTED.**

TABLE REDACTED

The above figures do not relate solely to sales in the UK; Mr Kirk states in his statutory declaration that export sales are also made.

5. Mr Kirk refers to sales via its licensee DMC of DMC's own range of pet products which, mostly, do not compete with PM's products. He states that between them, a broad range of non-food pet products have been sold. He refers to promotion that has taken place at trade fairs and provides in Exhibit CPK3 copies of catalogues and pictures of stands so used. A range of goods are offered, but the primary ones appear to be a cat feeder and a cat flap. The catalogues go back to at least 1987.

6. Mr Kirk states that Mr Edmund is well aware of PM's registration and the use that has been made by PM and DMC. He refers to previous contact between the parties in relation to other trade mark issues. He concludes by referring to Mr Edmund's application insofar as it relates to services in class 35. Mr Kirk is concerned that Mr Edmund may regard registration for these services as justification for using the domain names (petmate.eu, petmate.biz, petmate.org.uk, petmate.info & petmate.co.uk) to trade under the PETMATE name in connection with products within the scope of PM's PET MATE trade mark registrations or to pass off those services as being connected with the substantial business in pet products established over many years by PM and DMC.

Affidavit of Robert Morgan

7. Mr Morgan is DMC's "Executive Vice-President – Marketing, Product Development and Sales". He states that DMC is a major manufacturer of non-food pet products in the United States. Gross turnover (presumably worldwide) for the year to June 20 2007 was \$270 million. A current catalogue of DMC's goods is shown in Exhibit RM1; Mr Morgan states that similar catalogues would have been available prior to the application date in question here. The Pet Mate name is used throughout, it shows various pet products (for dogs and cats) such as bedding, enclosures and cages, feeding devices and litter trays, portable pet carriers. He believes that Mr Edmund would have been aware of DMC's activities.

8. Mr Morgan states that sales have been made in the UK since 1993. He states that although DMC own trade marks in the US and elsewhere, it found another company (PM) had already registered PET MATE in the UK. DMC, therefore, trades in the UK under license from PM in relation to the goods that DMC sells in the US. DMC has UK distributors including Interpet Ltd, Pets at Home Ltd and Pet Play Pads. Mr Morgan states that promotion is conducted primarily through its catalogues and that its products have been exhibited at trade fairs on the stands of Interpet and Pet Play Pads (Exhibit RM2 contains photographs of the stands including a sign which incorporates the words Pet Mate).

REDACTED

10. He concludes his evidence by referring to contact with Mr Edmund, however, as I see little relevance to this in relation to the pleaded grounds of opposition I will say no more about it here.

Statutory declaration of Richard David Peters

11. Mr Peters is the managing director of Interpet Ltd who, he says, are one of the largest suppliers of pet accessories in the UK. Interpet are trade rivals of PM but are also one of the UK distributors for DMC. He states that as well as large suppliers in the UK (such as Interpet and PM) there are a number of smaller companies. He states that at retail level this is also the case as goods may be sold in large outlets such as garden centers, DIY stores or large pet supermarkets, but there are also smaller pet stores where non-pet food products of all kind are jumbled together on the shelves. He contrasts this to pet food which, he says, is mainly sold through foods retailers (supermarkets). He refers to the sales of DMC's Pet Mate brand in the UK since 1993. He is also aware of PM's trade and understands that the two have an agreement between them.

REDACTED

13. Extracts from sales catalogues are shown in Exhibit RDP2 from 2002, 2004 & 2005 and show a range of goods such as pet feeders, kennels, pet carriers & litter trays. He also refers to attendance at trade shows. He estimates that around £20,000 is spent, annually, on the promotion of Pet Mate goods via catalogues, trade shows etc.

Statutory declaration of Susan Jayne Gibson

14. Ms Gibson is an “operation manager” of PamPurredPets which she says is a sizable business of 32 stores selling pet products. She states that PM’s Pet Mate brand is well known to her as she makes significant purchases of them. She does not know Mr Edmund but states that if he supplied pet products using the same name she would find it very confusing.

Statutory declaration of Peter Biron Hoole

15. Mr Hoole is a partner in the business of Wolfit that runs two “smallish” high street pet stores. He states that small stores such as his carry a large range of pet products from different suppliers on their shelves alongside each other. He is aware of PM’s PET MATE products and buys from them. He is also aware of DMC’s goods but does not buy them to the same extent. He states that he would be surprised to see anyone else using this brand for pet products unless PM had agreed to it.

Statutory declaration of Michael John Deans

16. Mr Deans is the trade mark attorney working on behalf of the joint opponents. Mr Deans’ evidence relates to Mr Edmunds already registered trade mark 1349330 (for the same trade marks as applied for in the application in suit but for other goods including pet food). Reference is made to Mr Edmund’s comments (in his counterstatement) that this mark was used by a company called John M Clegg & Co. Ltd and was originally registered by Alexander Finlay (Manufacturing) Limited, and that this business was transferred to newly purchased and purpose built premises as “Pet food Distributors Ireland” (the business name was not provided). Mr Deans says that he has checked these businesses in order to request details of their use. He states, based on information from the Companies Registry, that John M Clegg & Co. Limited was wound up on 9 March 2001 and its last annual return filed on 31 December 1999 (so he infers that it did not trade after January 1999), that Alexander Finlay (Manufacturing) Limited was wound up on 20 March 1992 and its last accounts filed on 31 March 1989 (he states that if this company only began to trade during 1988 then it must have traded merely for a few months) and, finally, that no reference to Petfood Distributors Ireland was found.

The section 5(1) & 5(2) grounds of opposition

17. Two trade marks are relied upon, the details of which are set out below:

Case details	Relevant dates	Specification
UK registration 1390264 for the mark: PET MATE	Filing date: 01 July 1989 Registration date: 20 January 1995	Class 19: Gates, doors, flaps, all for providing access for animals to and from enclosures; flaps for use by cats and/or dogs; frames and parts and fittings for all the aforesaid goods; all included in Class 19. Class 21: Containers, feeding devices and drinking devices; all for use by animals and all included in Class 21.
CTM ¹ registration 954446 for the mark: PET MATE	Filing date: 14 October 1998 Registration date: 03 December 2004	Class 09: Time controlled pet feeders; time controlled feeders for fish; parts and fittings for all the aforesaid goods. Class 19: Non-metallic doors, gates and flaps all for providing access for animals; parts and fittings for all the aforesaid goods. Class 21: Water bowls, food bowls and containers; feeding devices for pets; animal enclosures; animal pens for domestic use; collapsible animal pens and enclosures; feeding equipment for animals. Class 28: Exercise and play equipment for animals.

Proof of use regulations

18. In opposition proceedings, earlier marks for which the registration procedure was completed before the end of the five year period ending with the date of publication of the applied for mark, may only be relied upon to the extent that they have been used (or that there are proper reasons for non-use)². Mr Edmund's mark was published on 11 May 2007. As can be seen from the above

¹ Community Trade Mark

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

table, only registration 1390264 completed its registration procedure before the end of the relevant five year period. However, a statement of use covering all the goods for which the mark is registered has been made and Mr Edmund did not ask for proof to support the statement of use. In the circumstances, both earlier marks can be relied upon to the extent set out in the above table.

The section 5(1) ground

19. I will deal with this briefly. This is because a claim under this ground requires identity both between the marks and between the respective goods (and services). Whilst it can be argued that there is identity between the marks³, notably with the first mark in the applied for series (although I will come back to this point), there does not appear to be identity between the goods and services. I say this because there is no overlap between the classes sought for registration and the classes covered by the earlier marks. This, self evidently⁴, means that there must be some difference between the goods and services given that they fall in different classes. Whilst this does not rule out the possibility that the goods are similar, this, nevertheless, means that the goods are not identical. **I will not consider the ground under section 5(1) any further, it is hereby dismissed.**

The section 5(2)(a) & (b) grounds - legislation and the relevant authorities

20. Section 5(2) of the Act states:

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

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

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

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

21. When reaching my decision I have taken into account the guidance provided by the ECJ in a number of judgments germane to this issue, notably: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000]

³ Bearing in mind the judgment of the European Court of Justice (“ECJ”) in *LTJ Diffusion SA v Sadas Vertbaudet SA* (Case C-291/00) (“*Sadas*”)

⁴ Unless there has been some classification change of which I have not been advised.

E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). The above judgments set out the primary principles to be applied in matters such as these; I will refer to them, when relevant, in more detail later in this decision.

The average consumer and the purchasing act

22. As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who this is. It is clear that the vast majority of the goods and services covered by the respective specifications relate to products aimed at the pet market, such as leads, enclosures, feeding devices, bedding etc for domestic animals. Whilst the earlier marks have some broader terms including products for animals generally (so including non domestic animals) there is no need to assess the average consumer further (to farmers etc.) given that this does not improve the joint opponents' position. The average consumer in relation to the products for the pet market will, therefore, be members of the general public, but particularly those who own or look after pet animals.

23. The case-law informs me that the average consumer is to be regarded as reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). Although this general presumption can change depending on the particular goods (or services) in question (see, for example, the decision of the CFI⁵ in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)) there is nothing in the case before me to conclude that the average consumer would display a higher or lower degree of attention than the norm during the purchasing act in question. The evidence from the joint opponents (which is not challenged) highlights that sales of pet products and accessories are made through a fragmented retail environment ranging from pet supermarkets, to sales in garden centers and do-it-yourself stores, to small pet shops. There is no evidence to suggest that visual considerations apply significantly more than oral considerations. Nevertheless, I bear in mind that most consumer goods are normally self-selected from a shelf by the eye, however, this does not mean that aural considerations should be ignored completely.

Comparison of the marks

24. The first mark in the applied for series consists of the word PETMATE in no particular form of presentation. The earlier marks both consist of the words PET MATE. The marks are, therefore, virtually identical, the only difference being that the words PET MATE are conjoined in the applied for mark. Considering the visual, aural and conceptual similarities⁶, the marks are aurally and conceptually

⁵ The Court of First Instance of the European Communities

⁶ Assessment against these factors is what the ECJ calls for – see *Sabel BV v. Puma AG*, paragraph 23.

identical. Although, visually, the marks are not literally identical, I am mindful of the comments of the ECJ in *Sadas* where the ECJ answered the question put to it thus:

“In those circumstances, the answer to the question referred must be that Article 5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

25. The difference between the marks here is so small that it may go unnoticed by the average consumer. I therefore find the first mark in the series to be identical to the applied for mark or, even if I am wrong on this, they are, at the very least, similar to an extremely high degree. This view on similarity also extends to the second mark in the applied for series. Although this mark is stylised in a particular font, it does not mask the fact that the mark consists, essentially, of the word “petmate”. This mark is also extremely similar to the earlier marks.

Comparison of the goods and services

26. All relevant factors relating to the goods/services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

27. Other factors may also be taken into account such as, for example, the distribution channels concerned (see, for example, paragraph 53 of the judgment of the CFI in Case T-164/03 *Ampafrance S.A. v OHIM – Johnson & Johnson GmbH (monBeBé)*). I also take into account the decision in *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281, where Mr Justice Jacob stated:

“...I think the following factors must be relevant in considering whether there is or is not similarity:

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

28. I will make my assessment with reference to the goods and services sought to be registered by Mr Edmund. Looking firstly at the various leads, collars and leashes covered by the goods in class 18, I note that the goods covered by the earlier marks include feeding bowls etc. and exercise and play equipment for animals. It is clear that some of the criteria set out by Jacob J are met in that the respective users are the same as are the respective trade channels. Although there is a degree of similarity in terms of uses (they are all pet products or accessories), the specific uses of the particular goods being compared, together with their method of use and specific nature, are not particularly similar. It seems to me that there is a degree of similarity but only a moderate one. The same applies to ID tags (class 6), animal clothing (class 18) and bedding for pets (class 20).

29. In relation to hutches and kennels (class 20), I note that the earlier marks cover animal pens and enclosures. This strikes me as very similar given that the purpose of both sets of products is to house an animal in some way. Again, the respective users and channels of trade are the same. These goods are highly similar. In relation to animal carriers (class 20) this is, essentially, a portable form of enclosure and, therefore, is reasonably similar for similar reasons. The application also covers nesting boxes. Although not an enclosure for a pet animal, this strikes me as serving a similar purpose (providing some form of habitat for an animal) and are also likely to be sold via the same trade channels; I find there to be a moderate degree of similarity here.

30. In relation to feeding mats (class 20), I note that the earlier marks cover feeding equipment such as water and food bowls. Although not the same, the purpose of the goods relates to the feeding of pet animals. The users and the channels of trade are also the same. I consider these goods to be reasonably similar.

31. The final consideration lies with Mr Edmund's services in class 35. These are:

"Advertising services provided over the internet; Compilation of advertisements for use as web pages on the internet; Compilation of directories for publishing on the Internet"

32. Mr Edmund has provided an explanation of what he means by the respective services he lists. He states in his counterstatement:

"Petmate.info – Currently we are building an information directory for petmate.info. This directory will be, when complete, a source of information for pet owners. It will contain advice on pet care, and have a directory for pet hotels; kennels and catteries and a full listing of all UK and Ireland Veterinary Services and a forum for the exchange of pet information. This site will contain both free and paid for advertising. I believe this fully complies with Class 35 as being advertising services provided over the internet and for compilation of webpages or directories on the internet."

33. It is clear from the above that Mr Edmund's services are not in the nature of business services to, for example, devise advertisement strategies in the same way that a traditional advertising agency would. The services listed, taken with the explanation, converge to cover, essentially, the provision of information (and advertisements) relating to service providers in the pet field. I consider it appropriate to consider this as the paradigm example of Mr Edmund's services given that this is what he intends to provide under the service.

34. Clearly there is no physicality to the service so there is no similarity in terms of nature. The service is utilised in a different manner to the goods (although, goods can of course be sold on a website). However, the target consumer is the same and there is some similarity (albeit small) in terms of purpose as both assist pet owners provide for the care for their pets. The bringing together of a range of service providers (albeit for information purposes) draws an analogy in my mind with the case-law involving the retail of goods compared to the goods themselves (with such case-law⁷ considering that the goods were similar to the service). I accept, however, that the link is not so great here. I come to the view that whilst there are some clear differences, they are not sufficient to say that there is no similarity at all between the services and the goods of the earlier marks. I must, therefore, go on to consider a likelihood of confusion⁸. My finding is one of similarity, albeit of only a very small degree.

⁷ See, for example, the judgment of the CFI in Case T-116/06, *Oakley Inc. v. OHIM*

⁸ See the decision of Mr Arnold QC (sitting as the Appointed Person) in BL O/305/05 where such a principal was applied in analogous circumstances.

Distinctive character of the earlier trade marks

35. The distinctiveness of the earlier marks is another factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent point of view, the mark PET MATE has some suggestive qualities. On this, the word PET needs no explanation. The word MATE, in the context of the mark, will be seen as some form of reference to a friend. The goods of the earlier mark are not friends for pets in a literal sense, however, some form of suggestive metaphorical reference may be taken in relation to products that are used by pets to help feed or house them etc. The suggestive quality is, however, quite a loose one and I come to the view that the mark, from an inherent point of view, has a reasonable degree of distinctive character.

36. In terms of the use made of the earlier marks, I must consider not only the use made by PM, but also the use made by DMC given that the latter is using the mark in the UK upon licence. The evidence filed is significant. The turnover, on the face of it, seems substantial (even taking into account that some of PM's sales are export sales). Although it is not contextualised against the market as a whole, it is supported by a wide ranging customer list of those who stock the various products and there is evidence from the trade that the mark is well known in the relevant field. In my view, this use does enhance the degree of distinctive character of the earlier marks to result in the mark being regarded as one of a high degree of distinctiveness.

Mr Edmund's earlier mark

37. Mr Edmund is the proprietor of a trade mark registration filed in 1988 (which, therefore, predates PM's earlier marks) in relation to the same series of marks as per the application in suit here and is registered in relation to goods including animal food. He also claims in his counterstatement that he (or companies connected with him) have used the mark on "a range of pet food and pet accessories" on "branded greyhound racing jackets". With reference to this claimed use, I note that most of this is said to have taken place in Northern Ireland.

38. Despite the above claim, Mr Edmund has filed no evidence in these proceedings. There is nothing at all to support the claim of use and, even if I accepted that some use had been made, there is nothing to demonstrate the scale of such use and the impact that it would have had on the average consumer. The question I must answer relates to the likelihood of confusion on the part of the average consumer of the goods and services in question. As I cannot assess this aspect of Mr Edmund's defence from the viewpoint of the average consumer then I cannot see how this can have any significance on the decision I must make. Also of no real relevance is the fact that Mr Edmund has a

registration that predates PM's mark and that he may have been the first to "invent" the mark – the average consumer will be unaware of this.

Likelihood of confusion

39. It is clear that the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

40. The respective goods and services are similar to varying degrees. Considering the position firstly in relation to the goods sought for registration, there can be no doubt that for highly similar goods (such as hutches and kennels) there must be a likelihood of confusion (indeed, I would say confusion is inevitable) given the identity/near identity of the marks together with the high degree of distinctive character of the earlier marks. In relation to the goods that are only moderately similar, it seems to me that the degree of similarity between the goods is enough for the consumer to regard them as simply being an extension or related product range to the goods of the other. Even if the goods are sold in large pet supermarkets where the various product ranges may be on separate shelves, the sharing of an identical and distinctive trade mark will be put down to economic connection rather than co-incidence.

41. In relation to the services, the position is more finely balanced. However, the identity/near identity of the marks together with the highly distinctive nature of the earlier marks and their reputation is enough to persuade me that confusion is likely. It seems to me that someone encountering a PETMATE website that provides information on complementary service providers in the pet field would view that website as having a connection with the PETMATE brand which is known in the relevant field by the average consumer. The service would be seen as an extended service providing help and assistance to identify relevant service providers that the consumer may also be interested in by bringing together the names (including advertising) of such service providers in a trade directory type website.

42. Taking the above into account, the opposition under section 5(2) succeeds in relation to all of the goods and services of the application. This, effectively, disposes of the opposition. However, I will give some brief views on the other grounds of opposition

The section 5(4)(a) ground of opposition

43. There are three elements (often referred to as “the classic trinity”) to consider in a claim for passing-off⁹, namely: 1) goodwill, 2) misrepresentation and 3) damage.

44. I have no doubt that the joint opponents possess the relevant goodwill in the UK due to the use that has been made of the sign PET MATE in relation to various non-food pet products. I am also sure, consistent with my findings in relation to section 5(2) above, that the pet product buying public (and other businesses within the trade) would believe that the goods sold under Mr Edmund’s mark were in fact the goods and services of the joint opponents. In relation to damage, some of the goods may be in competition with each other (for example, kennels and enclosures) and direct loss of sales could result. In relation to other items whereby the goods and services would be seen as an expansion of trade/service, I am mindful of the comments in *Ewing v Buttercup Margarine Co Ltd*, 34 RPC 232 where it was stated:

“To induce the belief that my business is a branch of another man’s business may do that other man damage in all kinds of ways. The quality of goods I sell; the kind of business I do; the credit or otherwise which I might enjoy – all those things may immensely injure the other man who is assumed wrongly to be associated with me.”

45. Although there is some difficulty in applying this principle to this case because Mr Edmund has provided no evidence as to the nature of his trading and I cannot, therefore, comment on the way in which he might conduct his business, I am of the view that there is, at the least, a strong case that the joint opponents’, given their standing and reputation with the relevant field, will be exposed to a risk of significant damage. **The section 5(4)(a) ground of opposition would, therefore, also succeed.**

⁹ See *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341:

The section 5(3) ground of opposition

46. Some of my findings under section 5(2) follow through to this ground of opposition. This is because if the use of the marks (in relation to their respective specifications) would cause confusion then, so long as the earlier marks have a reputation¹⁰, a link¹¹ will also be made. In relation to reputation then, given my findings on the distinctiveness of the earlier marks, it seems to me that the test set out in *Chevy* is met in that a significant part of the public concerned with the goods of the earlier mark will know of it. As stated earlier, this is supported by the level of sales, the broad range of retailers taking and selling goods, all of which is supported by the evidence from the trade.

47. The joint opponents refer to unfair advantage being taken of its reputation, or that detriment could be caused to its earlier marks' reputation or distinctive character. These three possibilities are often referred to¹² as free-riding, tarnishing and dilution respectively. I can certainly see unfair advantage given that if a consumer believed that Mr Edmund's goods were those of the joint opponents (with the joint opponents' possessing an established and known brand with a reputation) then this would attract consumers to buy such goods without Mr Edmund having to invest in any marketing initiatives himself.

48. This also applies in relation to Mr Edmund's services he seeks to register. I say this because even if I am found to be wrong on my assessment of the similarity between the goods of the earlier mark and Mr Edmund's services, the target consumer would still be aware of the reputation of the earlier mark, they would still be aware of the fact that both the goods and the service relates to pets and their well-being and these factors would combine to cause the consumer to believe that the services were connected with the joint opponents' in some way. This, in turn, would result in consumers reaching Mr Edmund's website more easily and willingly (because they know of the PET MATE name from the joint opponents' use), and will more readily use the service that Mr Edmund intends to offer for the same reason.

¹⁰ See *General Motors Corp v Yplon SA* [2000] RPC 572 ("*Chevy*") where the ECJ stated:

"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."

¹¹ *Intel Corporation Inc v CPM (UK) Ltd* ("*Intel*") (C-252-07)

"The fact that for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks."

¹² See, for example, Case C-487/07, *L'Oréal SA v Bellure NV*

49. In relation to tarnishing, this is a more difficult head of damage for the joint opponents to succeed on given the ECJ's definition of what this must constitute¹³. There is nothing inherent in the goods and services that Mr Edmund intends to offer that would tarnish the joint opponents. I also have some difficulty with the claim to dilution because my primary finding is that the average consumer will confuse the respective uses and believe that the respective goods or services come from the same of an economically linked undertaken. If this is the case then it can hardly be said that "the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so" (see *Intel and L'Oréal SA v Bellure NV*). However, if I am wrong on my primary finding then dilution would strike me as a very real possibility.

50. In terms of due cause, whilst the applicant may have an earlier trade mark registration for goods in class 31, this would not, of itself, provide a justified due cause for expansion into an area of trade that is much closer to that of the earlier marks reputation and into areas where Mr Edmund's use would feed of that reputation. **The section 5(3) ground also succeeds.**

The section 3(6) ground of opposition

51. Section 3(6) of the Act reads:

"(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

52. The standard underpinning bad faith was set out in *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] R.P.C. 367. It includes dishonesty but also includes dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.

53. The pleading in relation to this ground focuses on the following:

"It is inconceivable that a natural person should manufacture and/or supply such a broad range of pet products and also supply advertising services and web compilations services..."

¹³ Defined most recently as in the above case as:

"As regards detriment to the repute of the mark, also referred to as 'tarnishment' or 'degradation', such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark's power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark."

54. I will deal with this ground briefly. This is because there is, in my view, nothing inconceivable about a natural person being able to offer the goods and services set out. Whilst funding may be needed to do so (although this is not always the case) it is quite possible for an individual businessman to supply quite diverse ranges of goods and services. Furthermore, there is no evidence to suggest that Mr Edmund in particular does not have the capacity to do so. The ground as pleaded fails.

55. I note from the joint opponents' written submissions that further arguments relating to bad faith were introduced including "history" between the respective parties. However, I do not regard this as being part of the pleaded case and I shall say no more about it.

Conclusion

56. Given my findings under section 5(2)(a)/(b), 5(4)(a) & 5(3), the opposition to Mr Edmund's application for registration succeeds.

Costs

57. The joint opponents have been successful and are entitled to a contribution towards their costs. I hereby order Mr Wesley Edmund to pay, jointly, Pet Mate Ltd and Dorskocil Manufacturing Company, Inc the sum of £1800. This sum is calculated as follows:

Filing notice of opposition & statement of case	£300
Official fee for the above	£200
Considering counterstatement	£200
Filing evidence	£800
Filing written submissions	£300
Total	£1800

58. I note that the joint opponents asked for costs above the scale, however, I see nothing in the case before me to justify such a finding.

59. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of July 2009

**Oliver Morris
For the Registrar
The Comptroller-General**