

O-415-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2593623
BY PETFACE LIMITED
TO REGISTER THE
TRADE MARK**



IN CLASSES 20 & 28

AND:

**OPPOSITION THERETO UNDER NO. 102842
BY JACK WOLFSKIN AUSRÜSTUNG FÜR DRAUSSEN GMBH & COKGAA**


BACKGROUND

1. On 7 September 2011, Petface Ltd (“PL”) applied to register the trade mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 14 October 2011 for the following goods in classes 20 and 28:

Animal bedding; hard beds and baskets; upholstered mats, cushions, mattresses and bedding, all for household pets; kennels, hutches and carriers for animals; scratching posts and pads; pet doors and cat flaps (non-metal); pet runs; parts and fittings for all the aforesaid.

Games, toys and playthings for animals; parts and fittings for the aforesaid goods.

2. On 3 January 2012, Jack Wolfskin Ausrüstung für Draussen GmbH & CoKGaA (“JW”) filed a notice of opposition directed at all of the goods in PL’s application. JW relies upon a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). JW relies upon the following registered trade mark:

Trade Mark	No.	Application Date	Registration Date	Goods and services relied upon
	E9274648	27.07.10	10.01.2011	<p>18 - Leather goods for animals (included in class 18), in particular leashes and collars; clothing for animals; harness for animals; collars for animals; blankets for animals (except clothing).</p> <p>20 - Beds, cushions and couches for household pets; kennels for household pets.</p> <p>21 - Transport cages and boxes for pets; cages and litter trays for pets; bowls for animals (including for folding or collapsing).</p> <p>22 - Tents for animals.</p> <p>35 – Wholesale and retail services in relation to toys for pets.</p>

3. In relation to the competing trade marks, in its notice of opposition JW says:

“3. The opposed trade mark comprises the words Outdoor Paws and an animal paw device, superimposed on a background of three triangles, possibly stylised mountains.

4. The animal paw comprises a broadly triangular pad at the base, two parallel toes/pads slightly above and to the left and right of the base, with two further toes/pads directly, and slightly higher, above the base. The four toes/pads are all parallel to each other and point perpendicular to the pad at the base.

5. The OUTDOOR PAWS element of the mark serves to emphasise, via the descriptive element OUTDOOR, the nature of the goods. It also effectively restates/duplicates the “paw” brand with the word appearing alongside the device.

6. The mountains provide an incidental background and are a comparatively weak component of the logo, unlikely to be readily recollected by the customer, serving primarily to further emphasise the “outdoor” nature of the mark.

7. The earlier trade mark is also an animal paw. The device comprises a broadly triangular pad at the base, two parallel toes/pads slightly above and to the left and right of the base, with two further toes/pads directly, and slightly higher above the base. The four toes/pads are all parallel to each other and point perpendicular to the pad at the base. Self evidently, the mark will be referred to/recollected as “paw”.

8. Overall, the marks are similar.”

4. In relation to the competing goods and services JW argues that:

Animal bedding; hard beds and baskets; upholstered mats, cushions, mattresses and bedding, all for household pets; kennels, hutches and carriers for animals; parts and fittings for all the aforesaid

are identical to the following goods in its registration:

Blankets for animals (except clothing) – class 18;

Beds, cushions and couches for household pets; kennels for household pets – class 20;

Transport cages and boxes for pets; cages for pets – class 21;

Tents for animals – class 22.

5. If the above goods are not considered identical, JW argues that they should be considered similar. Insofar as the remaining goods in class 20 are concerned i.e.

Scratching posts and pads; pet doors and cat flaps (non-metal); pet runs; parts and fittings for all the aforesaid,

JW argues that these goods are similar to the following goods in its registration:

Leather goods for animals (included in class 18), in particular leashes and collars; harness for animals; collars for animals;

Kennels for household pets – class 20;

Transport cages and boxes for pets; cages and litter trays for pets; bowls for animals (including for folding or collapsing) – class 21.

6. In relation to PL's good in class 28 i.e.

Games, toys and playthings for animals; parts and fittings for the aforesaid goods,

JW argues that these goods are similar to the following goods and services in its registration:

Clothing for animals; blankets for animals (except clothing) – class 18;

Beds, cushions and couches for household pets – class 20;

Wholesale and retail services in relation to toys for pets – class 35.

7. On 16 March 2012, PL filed a counterstatement in which the basis of the opposition is denied. In relation to the competing trade marks, it says:

“3...The representation of the paw of the opposed application can be distinguished on the basis that it is a different shape and colour and is not orientated to the right as depicted in the representation of the earlier trade mark. Furthermore, the paw print of the opposed application does not include claws, which indicates the paw of the opposed application has originated from a different animal to that of the representation of the paw of the earlier trade mark.

4. It is denied that the verbal elements OUTDOOR PAWS serves to emphasise the nature of the goods. The verbal element OUTDOOR is not used to designate that the goods of the application are exclusively for outdoor use.

5. The opposed trade mark will be referred to as OUTDOOR PAWS whereas the earlier trade mark is composed of a figurative element which cannot be pronounced and thus not subject to a phonetic assessment. Since the earlier

trade mark cannot be pronounced, the respective trade marks are not phonetically similar.

6. Where [JW's] trade mark is verbalised it is likely to be referred to as "Jack Wolfskin" rather than "paw print". To the extent that [JW's] trade mark is referred to as "paw print", this is phonetically dissimilar to OUTDOOR PAWS."

8. In relation to its goods in class 20 PL says:

"8...[JW] has not provided any justification that these goods are similar. The mere fact that the goods are for pets is not sufficient for a finding of similarity. The goods "scratching posts and pads; pet doors and cat flaps (non-metal); pet runs; parts and fittings for all the aforesaid" serve a different purpose and are of a different nature to the goods identified by [JW]. Furthermore [these goods] are not in competition nor are they complimentary to the goods identified by [JW]".

9. In relation to the likelihood of confusion PL says:

"11...The fact that both trade marks include a paw print is not sufficient to find a likelihood of confusion. It is clear that the paw prints have not originated from the same animal and the paw of [JW's] trade mark is much more real life than the paw print in [PL's] trade mark. The differences between the representations of the paws is significant.

12. It is generally accepted that where a trade mark consists of verbal and figurative elements, the principle has been established that the word element of the trade mark has a stronger impact on the consumer than the figurative element as the average consumer will most readily refer to a trade mark by its verbal element. As already noted, OUTDOOR PAWS can clearly be distinguished from PAW PRINT.

13. The fact that both trade marks contain a device of a paw print does not render the trade marks conceptually similar, bearing in mind the different representations of the device of the paw and given the additional elements of [PL's] trade mark.

14. The dominant and distinctive element of [PL's] application is the verbal elements OUTDOOR PAWS. The relevant public will refer to the opposed trade mark by the verbal elements and will not verbalise the trade mark as "paw" or "paw print."

15. The goods of [PL's] trade mark all relate to pets and therefore the device of a paw for use in connection with such goods is low in distinctive character and will be perceived by the average consumer as a decorative element of the trade mark. Furthermore, it is likely that paw prints are commonplace and used extensively by other undertakings in connection with the sale of pet related

products. Whilst [JW] is entitled to object to the registration of a similar paw print, they do not enjoy a monopoly right over the use and registration of a paw print which bears no resemblance to their registered trade mark.”

10. Both parties filed evidence. While neither of the parties asked to be heard, both filed submissions in the course of proceedings and in lieu of attendance at a hearing; I will refer to these submissions as necessary below.

EVIDENCE

JW’s evidence

11. This consists of two witness statements, dated 22 May 2012, from Christopher Morris, a trade mark attorney at Burges Salmon, JW’s professional representatives in these proceedings. Mr Morris says:

“3. In its counterstatement [PL] denies the similarity of a range of goods covered by the application with the goods on which the opposition is based.”

12. Exhibits CM1, CM2 and CM3 consist of pages downloaded from www.petsathome.com on 22 May 2012 i.e. after the material date in these proceedings. The page exhibited as CM1 bears the heading: “Cat Flaps, Carriers & Kennels” and shows a cat flap being sold alongside, inter alia, cat carriers and cat kennels. The page exhibited as CM2 bears the heading “Cat Beds & Furniture” and shows, inter alia, cat beds, cat blankets, cat climbers, cat heat pads, cat scratching deterrents and cat scratching posts being sold alongside one another. The page exhibited as CM3 bears the heading “Dog Kennels, Pens & Flaps” and shows, inter alia, dog flaps and doors, dog kennels and dog pens and gates being sold alongside one another. Exhibit CM4 consists of 5 pages downloaded from www.amazon.com and www.amazon.co.uk on 21 May 2012 showing PL’s trade mark in use on a range of dog toys and a dog travel mattress. In its submissions dated 22 May 2012, JW says of this exhibit:

“35. Exhibit CM4 shows the tag showing the opposed mark in its entirety is attached differently to different items and will consequently be presented at a different angle. The paw device solus is also produces on the items themselves at different angles.”

13. Exhibit CM5 consists of 5 pages downloaded from www.jack-wolfskin.co.uk on 21 May 2012 which Mr Morris says shows:

“4...[JW’s] paw print trade mark used in a range of colours.”

JW’s trade mark can be seen in use on, inter alia, footwear in yellow, blue, white and green.

PL's evidence

14. This consists of two witness statements. The first, dated 26 June 2012, is from Peter Johnson, PL's Managing Director. Mr Johnson says:

"1. On 26 May 2012 [i.e. after the material date in these proceedings] I conducted an Internet search looking for generic use of a paw print on pet related products and accessories..."

15. Attached to Mr Johnson's statement are 27 exhibits each of which contains an extract (or extracts) from a range of websites. While it is not necessary for me to summarise this evidence here (I will comment upon it later in this decision), in its written submissions dated 18 July 2012 PL says of this evidence:

"14. The [statement of Mr Johnson] evidences the fact that a paw print is used commonly as a decorative element on pet related products or pet products which incorporate the shape of a paw print."

16. The second witness statement, dated 18 July 2012, is from Heather Williams, a trade mark attorney at Appleyard Lees, PL's professional representatives in these proceedings. Ms Harrison explains that on 12 July 2012, she conducted a search in classes 20 and 28 for devices of "paws", "feet", "paw prints" and "footprints" and for the word "paw*" in relation to pending and registered trade marks which have effect in the UK. The results of her investigations revealed 94 trade marks which include the device of "paws", "feet", "paw prints" and "footprints" as part of the trade mark (exhibit HJW1) and 27 trade marks which incorporate the word "paw", "pawz", "paww" or "paws" as part of the trade mark (exhibit HJW2). Once again while it is not necessary for me to summarise this evidence here, I note that in its written submissions of 18 July PL says of this evidence:

"17. Accordingly, the device of the paw print and the word "Paws" in isolation appear to be low in distinctive character in the context of the goods applied for."

17. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

18. Section 5(2)(b) of the Act reads as follows:

"5(2) A trade mark shall not be registered if because -

(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, or

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

19. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

20. In these proceedings, JW is relying upon the registered trade mark shown in paragraph 2 above, which has an application date prior to that of the application for registration; as such, it qualifies as an earlier trade mark under the above provisions. As PL’s application for registration was published for opposition purposes on 14 October 2011, and as JW’s earlier trade mark was registered on 10 January 2011, JW’s earlier trade mark is not subject to proof of use as per The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

21. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 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] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing process

22. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and services and then to determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. The goods at issue are all for use in connection with animals (including household pets) or are wholesale and retail services associated with the sale of toys for pets. In its submissions of 22 May JW said:

“24. There are, in general, comparatively few restrictions on pet and animal ownership in the UK and the average pet owning consumer for the goods is the general public or the “man on the street”.

23. In their submissions PL agree with JW’s views in this regard. I also agree that the average consumer will be a member of the general public who is also, for the most part, likely to be the owner of a pet or animal. As to the manner in which the goods and services are selected, my own experience suggests (and the evidence appears to confirm) that this is likely to consist primarily of a visual act having encountered the trade marks in, for example, a traditional retail setting or on the pages of a website. As to the degree of care and attention that will be displayed by the average consumer when selecting the goods and services at issue, in its submissions of 22 May JW said:

“25. The goods are at the lower end of the costs spectrum so a purchase is unlikely to be given lengthy consideration. The level of care and attention taken by the consumer will be relatively low.

26. For products of the type covered by [PL’s] application, it is submitted that the consumer will know the broad product type she wishes to purchase (a new lead, a new bed etc), but that they are unlikely to have a particular brand in mind (as contrasted with pet food or medicines, where a brand loyalty, based on the preferences or reactions of the pet may develop).

27. The consumer will not, therefore, be on the lookout for a particular brand.”

24. In its submissions of 18 July PL said:

“20...The relevant public i.e. pet owners are likely to be particular about the products they purchase for their pets and take considerable time before making a purchasing decision. Pet owners typically dote on their pets and therefore will take time choosing a product and will inevitably develop brand loyalty in connection with a brand as with many other category of goods. The well known

saying that a dog is man's best friend certainly supports the contention that care will be taken before making a purchasing decision."

25. JW responded to these comments in its submissions of 5 September. It said:

"19. [PL] provides no supporting evidence for its contention that pet owners are a particularly discerning public which will take particular care before making a purchasing decision.

20. The evidence which was supplied includes examples of many products of a very low cash value e.g. a cushion for £5.50, a blanket for £5.99, a dog bed for £12 and so on.

21. It is submitted the evidence does not support the theory of a consumer who is more usually circumspect and observant."

26. Not surprisingly, the parties' views on this issue differ, ranging from "relatively low" (JW) to a "considerable time" (PL). In reality, the position is, for the most part, likely to be somewhere between the two. Insofar as the goods are concerned, the evidence shows that the price of these can vary from just a few pounds (for, for example, a toy for a pet) to a not insignificant sum (such as £75 for a dog bed). While all of the material provided by both Mr Morris (for JW) and Mr Johnson (for PL) was downloaded after the material date in these proceedings, I see no reason to suppose (and none has been suggested) that the position in the relevant market was significantly different prior to the material date. In those circumstances, I think the degree of care the average consumer will display when selecting the goods is likely to vary depending on the cost of the item being selected and the importance of ensuring that the item being selected is suitable (in terms of, for example, size, material, safety issues and compatibility with existing items) for use by the animal/pet concerned. Considered overall, and given the relationship that is well known to exist between a not insignificant number of pet owners and their pets, I think that the average consumer is likely to pay a reasonable level of attention to the selection of even relatively inexpensive items and that this level of attention is likely to rise somewhat as the cost, complexity and importance of the item increases.

27. While I have no evidence or submissions in relation to the degree of care the average consumer is likely to take when selecting, for example, a retail outlet specialising in the sale of toys for pets, factors such as opening times and proximity to the average consumer (in the real world) and cost of items, breadth of items available, refund policy etc (in both the real and virtual worlds) are all likely to be factors the average consumer will have in mind when making their selection. Considered in the context of the goods at issue and my comments above, and much like with the selection of the goods themselves, I think the average consumer will pay a reasonable level of attention to the selection of, for example, a retailer selling toys for pets.

Comparison of goods and services

Goods and services relied upon by JW	PL's goods
<p>18 - Leather goods for animals (included in class 18), in particular leashes and collars; clothing for animals; harness for animals; collars for animals; blankets for animals (except clothing).</p> <p>20 - Beds, cushions and couches for household pets; kennels for household pets.</p> <p>21 - Transport cages and boxes for pets; cages and litter trays for pets; bowls for animals (including for folding or collapsing).</p> <p>22 - Tents for animals.</p> <p>35 – Wholesale and retail services in relation to toys for pets.</p>	<p>20 - Animal bedding; hard beds and baskets; upholstered mats, cushions, mattresses and bedding, all for household pets; kennels, hutches and carriers for animals; scratching posts and pads; pet doors and cat flaps (non-metal); pet runs; parts and fittings for all the aforesaid.</p> <p>28 - Games, toys and playthings for animals; parts and fittings for the aforesaid goods.</p>

28. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (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.

29. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 the GC said:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

30. Having considered the parties submissions, I find that:

“Animal bedding; hard beds and baskets; upholstered mats, cushions, mattresses and bedding, all for household pets; parts and fittings for all the aforesaid”

in PL’s application in class 20, are either identical or highly similar to:

“Blankets for animals” and “Beds, cushions and couches for household pets”

appearing in JW’s registration in classes 18 and 20. I also find that:

“Kennels, hutches and carriers for animals” (and their associated parts and fittings)

in PL’s application in class 20, are either identical or highly similar to:

“Kennels for household pets” and “Transport cages and boxes for pets” and “cages for pets” in JW’s registration in classes 20 & 21.

31. That leaves the following goods in PL’s application in class 20:

“Scratching posts and pads; pet doors and cat flaps (non-metal); pet runs; parts and fittings for all the aforesaid”.

32. In its notice of opposition JW argued that these goods were similar to:

“Leather goods for animals (included in class 18), in particular leashes and collars; harness for animals; collars for animals”;

“Kennels for household pets”;

“Transport cages and boxes for pets; cages and litter trays for pets; bowls for animals (including for folding or collapsing)”.

33. In its submissions dated 22 May JW said:

“18. The witness statement and supporting exhibits demonstrate that the goods at issue are not only sold by the same specialist entities, and hence through the same channels of trade, but are in fact located in the same sections of a website (the e-commerce equivalent of proximity on a shelf) and are sold to the same users.

19. The respective goods are also clearly complementary. All of the goods listed form part of the “basics” items which a pet owner would need to purchase to be able to adequately look after a pet.”

34. In its submissions of 18 July PL said in relation to the goods which remain:

“12..are not indispensable or important for the use of the goods relied upon by [JW]. These goods are not complimentary or in competition, do not share the same nature or intended purpose.

The fact that the products in question are pet products which can be found on the same website does not render the goods similar. The nature of these goods can be distinguished as well as the intended purpose of the goods, for example, beds/kennels of [JW’s] trade mark which are intended as resting/sleeping places for pets is dissimilar to the purpose of a cat flap or pet door which is intended to allow a pet to enter and exit a house on their own without needing to solicit help from their owner.

A scratching post is intended to prevent pets from scratching and damaging furniture which consequently has a different nature and intended purpose to [JW’s] goods.

A pet run is normally used outside and is intended to be an area for pets to exercise in a larger space. Therefore the purpose of a pet run i.e. exercise can be distinguished from sleep/rest which is the purpose of [JW’s] goods.”

35. As all of the goods in PL’s application which remain are, like JW’s goods, for use by or in connection with animals/pets, the users of the competing goods will be the same

i.e. animal/pet owners. While the physical nature, intended purpose and method of use of the competing goods may differ, the evidence shows that the competing goods are all retailed by the same undertakings via their (predominantly specialist) websites. Insofar as one specialist undertaking is concerned (i.e. petsathome), on its website it groups “Cat Flaps” with “Carriers & Kennels” and “Pens & Flaps” with “Dog Kennels”. Similarly, it groups what it calls “Cat Furniture” (which includes “Cat Scratching Deterrents” and “Cat Scratching Posts”) with “Cat Beds”. While I accept that this represents the practice of only one undertaking, there is no evidence (nor any submissions) to suggest that this undertaking’s practice in this respect is in any way atypical, and it is, I think, not unreasonable for me to assume that traders in this field know what products are (for whatever reason) best grouped together. While there is no suggestion that the remaining goods are in competition with JW’s goods and services, JW argues that the competing goods are complementary. In relation to complementary goods and services, I note the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 i.e.

“82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraNAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

36. I am not persuaded that the goods which remain are (in the sense identified in *Boston Scientific*) complementary i.e. indispensable or important. However, given the evidence provided, I am prepared to accept that the similarity in the users of the competing goods, combined with the similarity in the trade channels through which the goods are likely to reach the market and keeping in mind the way in which petsathome groups products on its website and the fact that all of the goods are animal related are, when taken together, sufficient for me to conclude that there is a degree of similarity between the competing goods (particularly with kennels and transport cages for pets) albeit, perhaps, only a relatively low degree.

37. Finally, insofar as PL’s goods in class 28 are concerned i.e. “Games, toys and playthings for animals; parts and fittings for the aforesaid goods”, I note the comments of the Court of First Instance (now the General Court) in *Oakley, Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-116/06. In that case the conflict was between an earlier mark which was registered for goods in classes 18 and 25 and a later mark which had been registered for “Retail and wholesale services, including on-line retail store services; retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks and wallets”. The GC upheld OHIM’s decision that the goods in classes 18



and 25 were similar to “retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks, and wallets” as there was a complementary relationship between the retail of the goods and the goods themselves. The Court said:

“54 Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau-und Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.”

38. In line with the rationale provided in the above case, I find PL’s goods in class 28 to be similar to JW’s retail services relating to toys for pets in class 35.

Comparison of trade marks

39. The trade marks to be compared are as follows:

JW’s trade mark	PL’s trade mark
	

40. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

41. JW's trade mark consists exclusively of a device which both parties agree is a paw print. As it is presented in black and white and as no part of the device is highlighted or emphasised in any way, there are no dominant elements, the distinctiveness of JW's trade mark lies in its totality.

42. PL's trade mark contains the words "Outdoor" and "Paws" The word "Outdoor" is presented in title case and appears above the word "Paws" which is also presented in title case; the words are presented in white and red respectively. These words are accompanied by devices of what appears to be three triangles presented in grey, black and red and a device of a paw print also presented in red with the pad and toes outlined in white. All of these elements are contained in a rectangle and set against a black background. Although PL's trade mark is presented in a range of colours, as JW's trade mark is presented in black and white this does not, for the reasons given by Mann J in *Specsavers International Healthcare Ltd v Asda Stores Ltd* (No. 2) [2011] FSR 1, assist PL in distinguishing the competing trade marks..

43. In its submissions of 22 May JW said:

"7. The other verbal and graphical elements [in PL's application other than the device of a paw] are OUTDOOR PAWS and a device of three mountains, both of which evoke and emphasise the outdoors nature of the goods covered by the application.

8. In its counterstatement [PL] denies that the OUTDOOR element is used "to designate that the goods of the application are exclusively for outdoor use." However, no explanation for possible alternative meanings are offered.

9. Words should be given their common meaning and it is submitted that that the average consumer will inevitably take OUTDOOR to refer, in some way, to the outside and will have an expectation that the goods are aimed at that market or at least are for outdoor use.

10. Since this component is entirely descriptive...the most distinctive element of [PL's trade mark] is PAWS. The consumer will consequently perceive the brand in [PL's trade mark] as PAWS, with the mark as a whole denoting an outdoor range within that overarching brand."

44. In its submissions of 18 July PL said:

"3. The verbal element OUTDOOR may evoke the impression that the goods can be used outside. However, it is denied that the verbal element OUTDOOR is descriptive of the goods of the application i.e. "Animal bedding; hard beds and

baskets; upholstered mats, cushions, mattresses and bedding, all for household pets; scratching posts and pads” are predominantly intended for indoor use.

4. [PL’s good in class 28] are also products which can be used indoors. Accordingly, the relevant public will perceive [PL’s] trade mark as a fanciful trade mark and not one which conveys a statement that the goods...are exclusively for outdoor use to the exclusion of indoor use.

5...The device of a paw and the verbal element “paws” [in PL’s trade mark] is relatively low in distinctive character.

6...It is denied that the most distinctive element of [PL’s trade mark] is “paws”. The element of [PL’s trade mark] which is the most dominant is the two verbal elements OUTDOOR PAWS...

17. [In view of the evidence provided by PL] the device of the paw print and the word “Paws” in isolation appear to be low in distinctive character in the context of the goods applied for.

45. The words “Outdoor Paws” (in combination) and the device of a paw are the dominant elements of PL’s trade mark. The devices of three triangles (if indeed that is what they are) the first of which is partially obscured by the paw device, the rectangular border and black background are features which are likely to go largely unnoticed by the average consumer. Given its well known meaning, the word “Outdoor” appearing in PL’s trade mark can only be interpreted by the average consumer in one way. However, in the context in which it appears in PL’s trade mark, the word “Outdoor” qualifies the word “Paws” and creates, in my view, a distinctive totality which hangs together – what after all are “Outdoor Paws”?

46. Insofar as the device of a paw and the word “Paws” appearing in PL’s trade mark are concerned, PL’s evidence (which in terms of material date I have commented upon above) indicates that the device of a paw and the word “Paws” are commonly used by a number of traders in relation to a range of goods and services for animals/pets, and also that these elements feature in a range of different trade marks in different ownerships in relation to such goods and services. Although in its submissions of 5 September JW (by reference to the comments of Jacob J in *Treat*) cautioned me about the reliance on state-of-the-register evidence, I note that in its submissions of the same date it said:

“11. It is clear that in many cases these paw devices are for decorative effect. It is not clear, however, whether the packaging of the products bears, for example, a paw print acting as a brand identifier.

12. Notwithstanding the above, the fact that some types of paw print can be used decoratively on particular products does not in any way preclude the ability of ALL paw prints to function as trade marks.”

47. Whilst JW is in principle correct, it can come as no surprise to anyone that the device of a paw print and the word “Paws” were likely to be used by a wide range of those trading in the field of animal/pet products and services. While I think I would have been prepared to accept as much without evidence, PL’s evidence puts the matter beyond doubt. In those circumstances (and keeping JW’s views above in mind), while the device of a paw print in PL’s trade mark is a dominant element, if it has any distinctive character at all, it can, in my view, only be a very low degree. More likely, it will be seen by the average consumer as an indication of the type of goods to which the trade mark will be applied i.e. goods for animals/pets. I will now approach the visual, aural and conceptual comparison with the above conclusions in mind.

Visual similarity

48. The only point of visual similarity between the competing trade marks results from the device of a paw. The differences in the respective paw devices outlined by PL in its counterstatement, combined with the other features in PL’s trade mark which are alien to JW’s trade mark, results in only a very low degree of visual similarity between the competing trade marks.

Aural similarity

49. It is arguable if JW’s trade mark will be articulated at all. However, if it is, it will, in my view, be referred to as either “paw” or “paw print”, whereas PL’s trade mark will be referred to as “Outdoor Paws.” In the former situation there will be no aural similarity. However, if JW’s trade mark is referred to as “paw” there will be a reasonable degree of aural similarity and a somewhat lesser degree of aural similarity if it is referred to as “paw print”.

Conceptual similarity

50. As JW’s trade mark will be seen as a paw or paw print that is the conceptual image that is likely to fix itself in the average consumer’s mind. As PL’s trade mark also conveys an image which focuses on the word “Paw”, there is, as a consequence, a reasonable degree of conceptual similarity between the competing trade marks.

Distinctive character of JW’s earlier trade mark

51. I must now assess the distinctive character of JW’s trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which it has been registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v*

Huber and Attenberger Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As JW have not provided any evidence of the use they may have made of their earlier trade mark, I have only its inherent characteristics to consider. Having already concluded above that the device of a paw has (at best) only a very low degree of inherent distinctive character when considered in relation to the goods and services at issue in these proceedings, it follows that, absent use, I reach a similar conclusion in relation to the degree of distinctive character present in JW's earlier trade mark.

Likelihood of confusion

52. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of JW's trade mark as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the average consumer of the goods and services at issue in these proceedings was a member of the general public who will also, for the most part, be the owner of a pet or animal;
- the average consumer would select the goods and services by primarily visual means and would pay a reasonable level of attention when doing so;
- PL's goods and JW's goods and services are either identical or similar, with the degree of similarity ranging from highly similar to relatively low;
- JW's trade mark has no dominant elements the distinctive character lying in the trade mark as a whole;
- the words "Outdoor Paws" is the distinctive and dominant element of PL's trade mark;
- the device of a paw in PL's trade mark is a dominant element of its trade mark, but is at best possessed of only a very low degree of distinctive character;
- the competing trade marks are visually similar to a very low degree;
- there is either no aural similarity or (depending on if and how JW's trade was articulated by the average consumer) at best a reasonable degree of aural similarity;

- there is a reasonable degree of conceptual similarity between the competing trade marks;
- when considered in the context of the goods and services at issue, JW's earlier trade mark is, absent use, possessed of only a very low degree of inherent distinctive character.

53. I must now apply these conclusions to the matter at hand. Although I have concluded that there is a reasonable degree of conceptual similarity between the competing trade marks, I also concluded that this concept results from an element which is, at best, very low in distinctive character. Consequently, I have no hesitation concluding that the similarity in concept arising from this element will not, given the significant visual and aural differences between the competing trade marks result in a likelihood of either direct or indirect confusion and JW's opposition fails accordingly.

Conclusion

54. JW's opposition has failed and PL's application will, subject to any appeal, proceed to registration.

Costs

55. As PL has been successful it is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to PL on the following basis:

Preparing a statement and considering JW's statement:	£300
Preparing evidence and considering and commenting on JW's evidence:	£600
Written submissions:	£300
Total	£1200

56. I order Jack Wolfskin Ausrüstung für Draussen GmbH & CoKGaA to pay to Petface Limited the sum of **£1200**. This sum is to 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 23rd day of October 2012

C J BOWEN
For the Registrar
The Comptroller-General