

O-490-13

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION BY BARKING BREW LTD
UNDER NO 2632956
FOR REGISTRATION OF A SERIES OF TWO TRADE MARKS:**

Barkers Brew

BARKERS BREW

AND

**IN THE MATTER OF OPPOSITION NO. 104285 THERETO
BY SOCIETE DES PRODUITS NESTLE S.A.**

THE BACKGROUND AND THE PLEADINGS

1) On 28 August 2012 Barking Brew Ltd (“the Applicant”) filed application no. 2632956 to register the following series of marks for the following goods:

Barkers Brew

BARKERS BREW

Class 31: Pet food, pet foods, foodstuffs for pet animals; pet food for dogs; food preparations for dogs; dog food.

The application was published in the Trade Marks Journal on 28 September 2012. On 22 January 2013 the Applicant informed the Trade Marks Registry that it had changed its name to R2 Pets Ltd.

2) Société des Produits Nestlé S.A. (“the Opponent”) opposes the registration of the Applicant’s mark on grounds under sections 5(2)(b) and 5(3) of the Trade Mark Act 1994 (“the Act”).

For the purposes of its claims under section 5(2)(b) and 5(3) the Opponent relies on the following series of trade marks registered under the number 2137189 for the following goods:

BAKERS



Class 31: Foodstuffs for animals, birds and for fish; supplements for the aforesaid goods.

3) The series of marks relied on by the Opponent was filed on 27 June 1997, and completed its registration procedure on 6 October 1999. The consequences of these dates are that: i) the Opponent's marks constitutes earlier marks in accordance with section 6 of the Act, and ii) they are subject to the proof of use conditions contained in section 6A of the Act, the registration procedure having been completed more than five years before the publication of the Applicant's mark. The relevant period during which genuine use must be proved is 29 September 2007 to 28 September 2012.

4) The Applicant filed a counterstatement, denying the grounds of opposition, and requiring the Opponent to prove use of its marks for *foodstuffs for animals*. The Opponent filed evidence. No evidence was filed by the Applicant. The Opponent requested a hearing, and the matter came to be heard before me on 18 July 2013. At the hearing the Opponent was represented by Mr Dale Carter of Nestlé UK Ltd, a member of the Nestlé group of companies and licensee of the Opponent. The Applicant filed written submissions in lieu of appearance at the hearing.

5) The Opponent's best case lies in a comparison of the Opponent's word mark BAKERS with the Applicant's mark BARKERS BREW, and I shall make my assessment accordingly. Comparisons with the other marks place the Opponent in no better position.

THE EVIDENCE

6) The evidence consists of two witness statements of 24 April 2013, the first being from Mr Dale Carter, Trade Mark Advisor in the Legal Department of Nestlé UK Ltd, and the second from Ms Emma Walker, Category Marketing Manager for dry dog food in Nestlé Purina Petcare (UK) Ltd. Both these companies are affiliated companies and licensees of the Opponent.

7) Exhibit **DC3** to Mr Carter's witness statement consists of print-outs from the Global New Products Database of Mintel, a provider of market intelligence, showing details of the respective launches of a substantial range of dry dog food products under the BAKERS mark between 1997 and the date of publication of the Applicant's mark. **Exhibit EW1** to Ms Walker's witness statement consists of an extract from the Opponent's www.bakerscomplete.co.uk website – "THE BAKERS STORY" – containing an account of the history of the BAKERS brand aimed at the general public, describing use of the brand in connection with dog food since 1991, and providing the opportunity to play back the television commercials promoting the brand over the years. Ms Walker also attaches to her witness statement a large number of exhibits showing: television commercials transmitted between 1995 and 2012 promoting dog food products under the BAKERS mark; sales invoices for substantial volumes of the Applicant's dog food products supplied to various outlets of large supermarket chains and Pets at Home at locations throughout Britain from 2009 to 2012. Ms Walker states that by 1999 BAKERS had become the number one selling pet food in the dry dog food category in the UK, with sales in the region of £18.5 million, and that, following investment in the brand, sales had reached around £65 million by 2005. A graph based on data sourced from the Pet Food Manufacturers Association and from the Opponent's records in **Exhibit EW4** shows sales of the Opponent greatly exceeding sales generally in the dry dog food category. Exhibits **EW13-EW16** show sales of the BAKERS Complete range of dry

dog food products to retailers (comprising supermarkets, convenience stores and forecourts, and known as SIG Pet Outlets) who provide electronic point of sale data to companies who use it to calculate overall market share. These exhibits show sales of BAKERS Complete dry dog food exceeded £97.5 million in 2009, rising in 2010 to above £98.5 million and rising again in both 2011 and 2012 to exceed £100 million. The Opponent's share of the total pet food market in the UK is shown as amounting to 6% or more from 2010 to 2012, and its share in the complete dry dog food category amounting to nearly 50% in that period. A breakdown of figures in **Exhibit EW17** indicates that of the almost £105 million sales of BAKERS Complete products in 2012, 92.7 million was through major multiples (such as Tesco, Asda, Morrisons, Sainsburys and Waitrose), with sales to Tesco amounting to over 30%. Total sales figures actually exceed the figures provided in Exhibits **EW13-17**, since these do not include sales through specialist and discounter channels (e.g. Pets at Home, Jolleys, Lidl, Poundland). Data given in Exhibit **EW20** on the distribution of the BAKERS Complete range of dry dog food to SIG Pet Outlets indicates that it could be found in all major UK supermarkets in 2012.

8) Figures provided in **Exhibit EW21** show that the Opponent spent, annually, between £2.8 and 3.6 million on advertising pet food under the BAKERS brand in the UK between 2008 and 2009. **Exhibit EW22** contains written and video materials illustrating the significant amount of advertising the Opponent has undertaken in relation to its BAKERS brand since 2008 on television and in the print media, including national and mass circulation titles.

9) In February 2012 (six months before the application date of the mark in suit in August 2012) the Opponent launched a novel television commercial designed to appeal specifically to dogs by incorporating high frequency sounds audible to dogs but not humans (the "dogvert"). The dogvert was transmitted between 13 February and 18 March 2012 and aroused very considerable interest in the media. **Exhibit EW31** comprises documents detailing the launch plan for the dogvert and the results of the advertising promotion (including circulation figures for newspapers, radio listening figures, and key figures relating to the campaign's reach and coverage). Although these are internal documents of the Opponent, Ms Walker states that the data was sourced from the Daily Express, Daily Mail, Daily Mirror, Metro, the Daily Telegraph, the Sun, Express.co.uk and Twitter. **Exhibits 27-30** contain data showing the extensive coverage the dogvert received in the UK media: press (including the mass circulation dailies), television (including programmes such as Channel 4 News, BBC Breakfast, etc.), radio and online, and indicating that the BAKERS brand was widely referenced in this coverage. It is clear from the data provided in these exhibits that the dogvert advertising campaign, and the substantial media attention it generated, resulted in considerable exposure of the general public in the UK to the BAKERS brand on a national scale.

PROOF OF GENUINE USE

10) As stated earlier, the proof of use provisions apply to the Opponent's Mark. The use conditions are set out in section 6A(3) of the Act as follows:

"...The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.”

11) Section 100 is also relevant; it reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

12) In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (CJEU) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

"(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the

purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

13) The relevant period for my assessment is the five year period ending on the date of publication of the Applicant’s mark, namely 29 September 2007 to 28 September 2012. The Opponent is required to prove that during this period, and in relation to the relevant goods, there was genuine use by it, or with its consent, of its mark.

14) I find that the evidence provided by the Opponent, as outlined in paragraphs 6 to 9, has amply proved genuine use of the mark in suit during the material period.

FAIR SPECIFICATION

15) Having found that there has been genuine use, I must now consider what would be a fair specification for the goods for which genuine use has been shown. The specification must not be pernickety¹. It is necessary to consider how the relevant public are likely to describe the goods². The General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 held:

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category

¹ See *Animal Trade Mark* [2004] FSR 19.

² See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32.

concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

16) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods concerned"

17) In the present case the Opponent has proved use of a range of dog food products, but I think that confining the specification narrowly to *dog food* would be too pernickety here. Bearing this in mind, and having regard to the purpose and use of the products, and the perceptions of the average consumer, I consider that *dog food; foodstuffs for pet animals* would be a fair specification, and for the purposes of the opposition I shall confine my comparison of the goods to this specification.

SECTION 5(2)(b)

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

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

19) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *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] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbHv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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."

Comparison of the goods

23) When comparing the respective goods, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05 – “Meric”*) even if there are other goods within the broader term that are not identical.

24) I have found *dog food; foodstuffs for pet animals* to be a fair specification for the goods for which the Opponent has proved genuine use. It is obviously identical with *foodstuffs for pet animals* in the Applicant's specification. *Pet food* and *pet foods* in the Applicant's specification either fall within the ambit of the Opponent's *foodstuffs for pet animals* or are synonymous with it, and are thus identical with it. The Applicant's *pet food for dogs; food preparations for dogs* and *dog food* all clearly fall within the ambit of the Opponent's *dog food; foodstuffs for pet animals*, and are thus identical with it. (It is perhaps worth pointing out that even if I had restricted the specification of the Opponent's goods to a narrower category such as just *dog food*, this would still have led to a finding that the Opponent's and Applicant's goods are identical on the basis of the guidance in *Meric*).

The average consumer and the purchasing process

25) According to the case-law, the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

26) The average consumer in this case will be a member of the general public who owns a pet. The evidence suggests that the purchasing process for pet food will typically consist of the selection of the goods from the shelf in a retail outlet, probably as part of the family shopping. The selection process will therefore be predominately visual, but I do not ignore the potential for aural use of the marks during the purchasing process, and aural considerations will not be ignored in my analysis. I consider that the average pet owner will pay more than the lowest degree of

attention when selecting the food best suited to their pet. However, pet food is an everyday item that is not very expensive; consequently, its purchase will not involve a very carefully considered decision, so there is some increased scope for the effects of imperfect recollection.

The distinctiveness of the earlier mark

27) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

28) As the possessive form of a common English surname, BAKERS has no more than an average degree of inherent distinctiveness in relation to the relevant goods. However, I find that the evidence provided in the witness statements of Mr Carter and Ms Walker establishes that at the time of application for the mark in suit the Opponent’s mark had acquired a high degree of enhanced distinctiveness in the UK through use in relation to pet food.

Comparison of the marks

29) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are shown below.

The Applicant’s Mark	The Opponent’s Mark
BARKERS BREW	BAKERS

30) In the parties’ submissions my attention was drawn to potential meanings of the words BARKERS and BAKERS. BARKER can mean “a tout, at an auction, sideshow, etc., who calls out for custom to passers-by.” It can also refer to “an animal that barks.” Similarly, BAKER can bear the meaning “a person who bakes and sells bread, cakes etc.” Therefore BAKERS might be seen as a reference to those in the baking trade or (more likely) the possessive form of the surname BAKER (without the grammatically correct apostrophe). In connection with pet food the word BARKERS is not descriptive in the way that, for example, the word DOGS could be. Because of its potential canine associations the word BARKERS might theoretically be argued to have some allusiveness in connection with dog food, but I do not think that this will strike the average consumer in practice. Used in connection with pet food, I consider that the average consumer will see both BARKERS and BAKERS simply as the possessive forms of common English surnames.

31) BREW is not a word which would naturally be used to describe solid dog food, whether dry or wet. At the hearing Mr Carter invited me to consider the potential descriptiveness of the word BREW in relation to a notional liquid dog food product. I consider that, though words such as “mixture” or “blend” might be said to have a descriptive function in relation to either solid or liquid dog food, it would be unnatural and strained to regard the word BREW in that light, even with regard to liquid pet food products. Nevertheless, BREW is a word which can conjure up the idea of a mixture of ingredients. Its use in connection with dog food is fanciful.

32) The Opponent’s mark consists exclusively of the word BAKERS, which is therefore its sole element for the purposes of comparison. I have already found that the word BARKERS is not descriptive or allusive of any of the Applicant’s goods. It has an average degree of distinctiveness. I consider that its unusual and fanciful use in the context of pet food gives BREW at least a moderate degree of distinctiveness, and that BARKERS qualifies BREW to produce a composite term, together jointly forming the dominant and distinctive element of the Applicant’s mark.

33) Visually, the first word of the Applicant’s mark differs from the Opponent’s mark by only one letter (R), which is situated towards the middle of the word. The first two letters in BAKERS and BARKERS are identical, and they share the same ending: -KERS. However, the Opponent’s mark consists of only one word of six letters, whereas the Applicant’s mark consists of two words of seven and four letters respectively. There is a reasonable degree of visual similarity between the marks. Aurally, the Opponent’s mark will be pronounced BAY-KERS; the Applicant’s mark will be pronounced BAR-KERS-BROO. There is a moderate degree of aural similarity between the marks. For a conceptual meaning to be relevant in a mark, it must be one capable of immediate grasp. This has been emphasised in a number of judgements of both the GC and the CJEU (see, for example, *Ruiz Picasso v OHIM* [2006] ETMR 29). I have already found that, used in connection with pet food, the average consumer will perceive both BARKERS and BAKERS simply as the possessive forms of two common English surnames. Beyond the fact that they will both be seen as surnames, there is no conceptual similarity between them. I have found that, despite its allusiveness, the unusual and fanciful use of the word BREW give it at least moderate distinctiveness in the Applicant’s mark, and I consider that overall this gives a modest conceptual difference between the marks.

Likelihood of confusion

34) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), 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.

35) The Opponent urged me to consider that, when it comes to the visual comparison of a mark, it is, in general, the first component of word marks that is more likely to catch the consumer’s attention. In support of this proposition the Opponent drew my attention to the case law cited by the GC in paragraph 36 of *Hipp*

& Co KG v OHIM Case T-41/09. There is a rough rule of thumb that the consumer normally attaches more importance to the beginnings of word marks, and in this case it is the more similar element which appears at the beginning of the Applicant's mark. However, this is no more than a rule of thumb. Each case must be considered on its merits. My assessment must take account of the overall impression created by the marks³. This also applies with regard to the Opponent's proposition that the GC has also emphasised that common or similar endings of signs have an important role to play in consumer perception, in support of which it cited *Devinlec Développement Innovation SA v OHIM* Case T-147/03 ("*Devinlec*") at paragraph 72. In *Devinlec* the GC held that although the consumer often attaches importance to the first part of words, his visual attention may focus just as much on the last letters of the signs, in view of the limited length of those signs. It should be noted that in *Devinlec* the verbal elements of the marks to be compared consisted in both cases of a single word. In the present case, the marks consist of one and two words respectively, the endings of which – -KERS and BREW – are quite different.

36) The Opponent also submitted that BARKERS retains an independent distinctive role within the mark BARKERS BREW such that a likelihood of confusion could arise between the marks at issue (where the goods are identical) notwithstanding that the element reproduced in the composite mark is not identical. The GC considered this in *Bimbo SA v OHIM* Case T-569/10:

"96 According to the case-law, where goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein (Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37). There may also be a likelihood of confusion in a case in which the earlier mark is not reproduced identically in the later mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé v OHIM - Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 60)".

In *Aveda Corporation v Darbur India Ltd* [2013] EWHC 589 (Ch) Arnold J followed *Bimbo*, deciding that the decision in *Medion v Thomson* (C-120/04) can also apply in cases where the composite sign incorporates a sign which is similar to, rather than identical with, the earlier trade mark:

47 In my view the principle which I have attempted to articulate in [45] above is capable of applying where the consumer perceives one of the constituent

³ Cf. *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-438/07:

"23 Admittedly, the consumer normally attaches more importance to the first part of words (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 81). However, that argument cannot hold in all cases (see judgment of 16 May 2007 in Case T-158/05 *Trek Bicycle v OHIM – Audi (ALL TREK)*, not published in the ECR, paragraph 70 and the case-law cited) and does not, in any event, cast doubt on the principle that the assessment of the similarity of marks must take account of the overall impression created by them."

parts to have significance independently of the whole, but is mistaken as to that significance. Thus in *BULOVA ACCUTRON* the earlier trade mark was ACCURIST and the composite sign was *BULOVA ACCUTRON*. Stamp J. held that consumers familiar with the trade mark would be likely to be confused by the composite sign because they would perceive ACCUTRON to have significance independently of the whole and would confuse it with ACCURIST.

48. On that basis, I consider that the hearing officer failed correctly to apply *Medion v Thomson*. He failed to ask himself whether the average consumer would perceive UVEDA to have significance independently of DABUR UVEDA as a whole and whether that would lead to a likelihood of confusion.”

37) I have found that the average consumer will perceive both BAKERS and BARKERS simply as the possessive forms of names. I bear in mind the well-known tendency of the human eye to see what it expects to see and the human ear to hear what it expects to hear⁴. However, BAKER and BARKER are both common English surnames which the average consumer in the UK is used to distinguishing. Moreover, I have found that BREW has at least a moderate degree of distinctiveness in connection with pet food, and that BARKERS qualifies BREW to produce a composite term, the two words together jointly forming the dominant and distinctive element of the Applicant’s mark. The words BARKERS BREW hang together; their balanced rhythm and alliteration also support this coherent quality. In keeping with my finding that the Applicant’s mark consists of a coherent composite term, I do not consider that the average consumer would normally regard BARKERS as having a significance independent of the whole mark BARKERS BREW. BREW is not, for example, the kind of purely descriptive word, like LITE or COMPLETE, which would normally be expected to indicate a product extension in connection with pet food. Even bearing in mind the identity of the goods, my findings on the nature of the average consumer and the purchasing process, the principle of imperfect recollection and the fact that that the Opponent’s mark has a high degree of acquired distinctiveness, I find there is no likelihood that the marks will be confused, or that the average consumer will consider the relevant goods provided under the respective marks to be the responsibility of the same or an economically linked undertaking. **The ground of opposition under section 5(2)(b) is dismissed.**

SECTION 5(3)

38) Section 5(3) of the Act reads:

“A trade mark which-

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

⁴ See the comment of Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11

The scope of Section 5(3) has been considered in a number of cases, most notably: *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] FSR 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, C.A. *Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Davidoff & Cie SA v Gofkid Ltd (Davidoff)* [2003] ETMR 42, *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd (Adidas-Salomon)* (C-408/01), *Intel Corporation Inc v CPM (UK) Ltd ("Intel")* (C-252-07), *L'Oreal v Bellure NV* [2009] ECR I-5185 and in *Specsavers International Healthcare v Asda Stores Ltd.* [2012] EWCA Civ 24. I will refer, when relevant, to these cases and the legal principles that they lay down.

Reputation

39) In order to succeed under this ground the earlier mark must have a reputation. In *General Motors Corp v Yplon SA (CHEVY)* [1999] ETMR 122 and [2000] RPC 572 Chevy the CJEU 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.”

In making this assessment all the relevant factors must be taken into account, including the duration, extent and geographical area of use of the mark, and the scale and scope of investment in promoting the mark (see *CHEVY* at paragraph 41).

40) The evidence, as outlined in paragraphs 6 to 9 shows that the Opponent has for several years offered a wide range of dry dog food products under the mark BAKERS in large volumes throughout a large part of the United Kingdom. Sales of the dry dog food products under the Opponent's mark exceeded £100 million in both 2011 and 2012, giving them 6% or more of the total pet food market and nearly 50% of the market in the dry dog food category between 2010 and 2012. The products are available in all major supermarket chains over a geographical spread extending throughout Britain. They have been widely advertised under the mark on television and in the print media in the UK. A particular television commercial for the products transmitted between 13 February and 18 March 2012 excited widespread comment, offering further evidence of the wide exposure of the general public in the UK to the BAKERS brand, the brand being referenced in items in news and magazine programmes in national network television, local radio and the British print media, including the mass circulation dailies. It can be inferred from all this that at the date of application for the mark in suit the Opponent's mark possessed the requisite reputation for pet food among a significant part of the relevant public. In fact it had a strong reputation.

The “link”

41) In addition to the earlier mark having a reputation, a link must be made between the respective marks. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

In *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07) (“Intel”), the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case....

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

42) Having assessed the matter against the above criteria, I come to the view that a link will not be made. Although there is reasonable visual and moderate aural similarity between the marks, the goods are identical, the earlier mark has acquired distinctiveness, and its reputation is strong, I take the view that the relevant public will not bring BAKERS to mind if they encounter BARKERS BREW as a trade mark in relation to dog food. The UK consumer is used to distinguishing between common English surnames and in the applicant’s mark BARKERS qualifies BREW. The composite term ‘hangs together’ and militates against the applicant’s mark being compared as simply BARKERS. I am not persuaded that the average consumer will call the earlier mark to mind in this case. I therefore find that no link has been established. Where no link is made the requirements of section 5(3) cannot be met. **The ground of opposition under section 5(3) is dismissed.**

OUTCOME

43) **The opposition fails in its entirety and the Applicant’s mark can proceed to registration.**

COSTS

44) In a letter of 25 March 2013 the Opponent put the Applicant on notice that it intended to seek recovery of costs off the normal scale in respect of the Applicant's proof of use request and its denial that the Opponent's mark has a reputation in the UK. It asserted that this was an abuse of process, because it would be known to the Applicant that the Opponent's BAKERS brand is sold through the UK in virtually all major retailers and pet stores. Mr Carter appends to his witness statement an email he sent to the Applicant's agents of record on 8 November 2012 putting the Applicant on notice of the Opponent's BAKERS mark, pointing out that BAKERS is the UK's number one selling dry dog food and that it has been sold and marketed in the UK for several years and referring the Applicant to the www.bakerscomplete.co.uk website for further information on the BAKERS brand. Mr Carter also appends a page from the website, showing a link to "THE BAKERS STORY", which I infer corresponds to the material I have described in paragraph 7.

45) In the light of the information available on the Opponent's website, and the widespread availability of the Opponent's products through major retailers, I accept that the Applicant must have known of the Opponent's reputation for dry dog food, and that the Applicant therefore acted unreasonably in asking for proof of that reputation. I consider that denial of costs is sufficient and proportionate, given that the Opponent lost. Accordingly, I make no award of costs.

Dated this 5th day of December 2013

**Martin Boyle
For the Registrar,
The Comptroller-General**