

**O/508/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
REGISTRATION NO. 3423979  
FOR THE TRADE MARK:**

**wagmore**

**IN THE NAME OF HAVIK LTD**

**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO  
UNDER NO. 502998  
BY INSPIRED PET NUTRITION LIMITED**

## **BACKGROUND AND PLEADINGS**

1. Havik Ltd (“the proprietor”) is the registered proprietor of UK trade mark registration number 3423979, **wagmore** (“the proprietor’s mark”). The proprietor’s mark was filed on 27 August 2019 and was entered into the register on 15 November 2019. It stands registered in respect of the following goods:

Class 18: Goods made from leather and imitations of leather namely, collars, leads, leashes, muzzles and harnesses for pets and animals; saddlery; clothing for animals; blankets and rugs for animals.

Class 20: Beds, baskets, carriers, cushions, kennels and grooming tables for pets and animals; nesting boxes; beds for household pets; pet cushions; pet furniture; pillows for household pets; portable beds for pets; mattresses for pets; upholstered mats for household pets; pet drying mats; pillow beds for pets.

Class 28: Toys, games and playthings for pets and animals.

Class 31: Food and beverages for animals including pets; animal nutrition products; foodstuffs for animals, animal feed; additives and supplements for animals; flavourings for animal foodstuffs; solids, liquids and pastes prepared for ingestion by animals; complete foods, food supplements and food additives for animals; animal biscuits, treats and chews for animals; vitamin and dietary supplements for pets and animals; bones and other animal derivatives for consumption by animals, algae for animal consumption.

2. On 23 January 2020, Inspired Pet Nutrition Limited (“the applicant”) applied to invalidate the proprietor’s mark pursuant to section 47(2) of the Trade Marks Act 1994 (“the Act”). The application is based upon section 5(2)(b) of the Act and is directed against all the goods listed above.

3. The applicant relies upon its UK trade mark number 1266150, **WAGG** (“the applicant’s mark”). The applicant’s mark was filed on 30 April 1986 and was entered

into the register 2 October 1989. The applicant relies upon all the goods for which its mark is registered, namely:

Class 31: Foodstuffs for dogs and foodstuffs for domestic pets; all included in Class 31, but not including fresh fruit or fresh vegetables or any goods of the same description as fresh fruit or fresh vegetables.

4. The applicant claims that the competing trade marks are highly similar and that the respective goods are identical or highly similar. As a result of these factors, the applicant contends that there is a likelihood of confusion. Accordingly, a declaration of invalidity is sought by the applicant against the proprietor's mark.

5. The proprietor filed a counterstatement denying the ground of invalidation.

6. The applicant is professionally represented by Bailey Walsh & Co LLP, while the proprietor represents itself. Neither party filed evidence in these proceedings, though the applicant filed written submissions during the evidence rounds. I do not intend to summarise these but will refer to them throughout this decision, as and where necessary. Both parties were given the option of an oral hearing. Neither party asked to be heard on this matter, nor did they elect to file written submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers before me, keeping all submissions in mind.

### **PRELIMINARY ISSUE**

7. In its counterstatement, the proprietor submitted that neither its own searches of the register nor the original examination report raised the applicant's mark as similar to its mark, intimating that this supports its argument that there is no likelihood of confusion. In this regard, the proprietor stated:

**Before registering the trade mark WAGMORE several searches were done on the UK trade mark register. At no point did any of the searches highlight the trade mark WAGG as similar.**

**During the trade mark registration process, the Policy Officer dealing with the registration also undertook a number of searches on the relevant trade mark registers. If they had found any UK trade marks that were identical or deemed similar, they would have raised this and notified the corresponding trade mark holder.**

**If a trained and experienced patents officer focused on identifying similar trade marks did not consider WAGG as being a candidate, then I doubt others will either.**

8. I must clarify at this early stage that the fact that the applicant's mark was not included in the results of the online trade mark search facility or raised in the examination report will have no bearing on the outcome of my assessment.

9. The proprietor has provided no evidence of any search results or the terms that were used for the searches. However, these would not be determinative or persuasive if it had. The online search facility – and any results obtained therefrom by its users – is dependent on several variables, including the type of search that was conducted, the key word(s) that were used, the selected search function, the classes which were included and the time range. The registry is not bound by earlier marks that have been identified as part of a search conducted by users of the website; the online search facility is not an exhaustive search of the register and is available for information purposes.

10. Similarly, the initial search conducted during the examination of an application is undertaken to identify potentially similar marks. Nevertheless, it is not an exhaustive search of the register. Moreover, applications for invalidity are not exclusively reserved to only those parties identified by the registry as having potentially similar marks to the applied for (and later registered) marks. A party seeking invalidation will not be prejudiced by the fact that a trade mark examiner did not identify them within their initial search.

11. Ultimately, the matter to be determined must take into account the global assessment of all relevant factors, as identified by the case law. The proprietor's

argument that the applicant's mark was not raised by the online search facility or identified within the examination report will, therefore, have no bearing on the outcome of my decision as to whether there is any likelihood of confusion.

## **DECISION**

### **Legislation**

12. Section 5 of the Act has application in invalidation proceedings by virtue of the provisions set out in section 47. The relevant legislation is as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

13. Sections 5(2)(b) and 5A of the Act read 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,

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

14. 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.”

15. The trade mark relied upon by the applicant qualifies as an earlier trade mark in accordance with the above provisions. Given that the applicant’s mark completed its registration process more than five years before the date of the application for invalidation, it is, in principle, subject to the proof of use requirements as specified in section 47(2B) of the Act. In the application for invalidation, the applicant claimed use of its mark in relation to all the goods for which it is registered. However, the proprietor has not sought to require the applicant to demonstrate proof of use. Consequently, the applicant is entitled to rely upon all its goods in class 31, without having to establish genuine use.

### **Case law**

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

### **Comparison of goods**

17. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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”.

18. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity 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.

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...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”.

20. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Albingia SA v Axis Bank Limited*, BL O/253/18, a decision of the Appointed Person, Professor Phillip Johnson, at paragraph 42).

21. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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 trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

22. The competing goods are as follows:

<b>The applicant's goods</b>	<b>The proprietor's goods</b>
<p>Class 31: Foodstuffs for dogs and foodstuffs for domestic pets; all included in Class 31, but not including fresh fruit or fresh vegetables or any goods of the same description as fresh fruit or fresh vegetables.</p>	<p>Class 18: Goods made from leather and imitations of leather namely, collars, leads, leashes, muzzles and harnesses for pets and animals; saddlery; clothing for animals; blankets and rugs for animals.</p> <p>Class 20: Beds, baskets, carriers, cushions, kennels and grooming tables for pets and animals; nesting boxes; beds for household pets; pet cushions; pet furniture; pillows for household pets; portable beds for pets; mattresses for pets; upholstered mats for household pets; pet drying mats; pillow beds for pets.</p> <p>Class 28: Toys, games and playthings for pets and animals.</p> <p>Class 31: Food and beverages for animals including pets; animal nutrition products; foodstuffs for animals, animal feed; additives and supplements for animals; flavourings for animal foodstuffs; solids, liquids and pastes prepared for ingestion by animals; complete foods, food supplements and food additives for animals; animal biscuits, treats and chews for animals;</p>

	vitamin and dietary supplements for pets and animals; bones and other animal derivatives for consumption by animals, algae for animal consumption.
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23. The applicant has argued that the goods in class 31 of the proprietor's mark are identical to the goods of its earlier mark. Furthermore, the applicant has contended that the goods in classes 18, 20 and 28 of the proprietor's mark are similar to its goods. The proprietor has conceded that there is some similarity between its goods in class 31 and those of the applicant, though it has not specified the level of similarity it believes exists between those goods. I have no submissions from the proprietor regarding similarity or otherwise between its goods in classes 18, 20 and 28 and the goods of the applicant.

Class 18

24. *'Goods made from leather and imitations of leather namely, collars, leads, leashes, muzzles and harnesses for pets and animals; saddlery; clothing for animals; blankets and rugs for animals'* are all examples of pet and animal accessories. Therefore, these goods can be grouped together for the purposes of the comparison as they are all sufficiently comparable to be assessed in essentially the same way and for the same reasons.

25. To my mind, the nature of these goods and those of the applicant are markedly different: the proprietor's class 18 goods consist of leads, collars and the like made from leather (or imitation thereof) as well as blankets and rugs, while the applicant's class 31 goods comprise foodstuffs for dogs and other pets. Moreover, the intended purpose of the respective goods is very different: the proprietor's class 18 goods are for the protection and control of animals, while the applicant's goods provide sustenance and nutrition to animals. In my view, there is also no similarity in the use or method of use of the respective goods. For example, a collar and a lead will be applied to the outer body of an animal to improve safety and control while exercising with their owner, whereas foodstuffs will be consumed by the animal by mouth. Given that the respective goods have distinct uses, there is no competition between them.

Furthermore, the respective goods are not complementary in the sense described by case law; the goods are not indispensable or important to one another. I am prepared to accept that the respective goods will be used by the same consumers, namely, pet and animal owners. Finally, there is a degree of overlap in the respective trade channels through which the goods reach the market. The proprietor's class 18 goods and the applicant's class 31 goods may both be purchased through supermarkets or more specialised pet stores. However, in practice, the respective goods are not likely to be found on the same shelves. The overlap in end users and trade channels are points in favour of the applicant. Nevertheless, balancing these limited similarities against the differences that have been identified above, I find that the proprietor's class 18 goods are similar to the applicant's class 31 goods to a low degree.

#### Class 20

26. *'Beds, baskets, carriers, cushions, kennels and grooming tables for pets and animals; nesting boxes; beds for household pets; pet cushions; pet furniture; pillows for household pets; portable beds for pets; mattresses for pets; upholstered mats for household pets; pet drying mats; pillow beds for pets'* can also be grouped together for the purposes of the comparison, all being examples of pet furniture and furnishings.

27. Again, I consider the nature of these goods to be very different from that of the applicant's goods. The proprietor's class 20 goods consist of, inter alia, beds, baskets, mats and pillows for pets, some of which are made from hard materials, such as plastics or metals, while others are made from soft materials, such as cotton. The applicant's goods, on the other hand, consist of foodstuffs. Moreover, the intended purpose of the respective goods is very different: the proprietor's goods are for the comfort of animals, while the applicant's goods provide sustenance and nutrition to animals. There is also no overlap in use or method of use of the respective goods. For example, beds for pets are laid upon by pets in order to rest or sleep in comfort, whereas animals will consume the foodstuffs by mouth. As a result of their significantly different uses, there is no competition between the respective goods. In addition, the respective goods are not complementary in the sense described by case law; the goods are not indispensable or important to one another. There will be an overlap in respect of the users of the respective goods as they will be used by the same

consumers, namely, pet and animal owners. Furthermore, there is a degree of overlap in the way in which the goods reach the market as the respective goods may all be purchased through supermarkets or pet stores. However, I note that the respective goods are not likely to be found on the same shelves. Notwithstanding the overlap in end users and trade channels, given the various differences that have been identified above, I find that the proprietor's class 20 goods are similar to the applicant's class 31 goods to a low degree.

### Class 28

28. '*Toys, games and playthings for pets and animals*' in the proprietor's specification refer to toys, games and playthings which are specifically designed to entertain, exercise and stimulate animals. When compared with the applicant's class 31 goods, I consider the respective natures to be markedly different. The proprietor's goods are commonly made from non-metallic materials such as plastic or fabric and are available in different shapes, such as balls, ropes or small animals. Conversely, the applicant's class 31 goods consist of foodstuffs for dogs and other pets. The intended purpose of the respective goods is also distinct: the proprietor's goods are for entertaining, exercising or otherwise stimulating animals, whereas the applicant's goods are for sustenance and nutrition. To my mind, neither is there any similarity in the use or method of use of the respective goods. For instance, a ball will be thrown by an owner and collected by a dog, while foodstuffs will be consumed by the animal by mouth. There is no meaningful competition between the respective goods: I can see no reason why the owner of a pet would select a toy or plaything for their pet over food, or vice versa. Moreover, the respective goods are not complementary in the sense described by case law; the goods are not indispensable or important to one another. A point in the applicant's favour is that the end user of the respective goods will be the same, namely, pet and animal owners. Furthermore, the respective goods may reach the market through the same trade channels such as supermarkets or pet stores, though they will not commonly be found on the same shelves. In consideration of the limited similarities and various differences identified above, I find the proprietor's class 28 goods and the applicant's class 31 goods similar to a low degree.

## Class 31

29. The term *'foodstuffs for dogs and foodstuffs for domestic pets; all included in Class 31, but not including fresh fruit or fresh vegetables or any goods of the same description as fresh fruit or fresh vegetables'* in the applicant's specification describes foodstuffs for dogs and other domestic pets. As a result of the limitation, the term does not include those goods which consist of fresh fruit or vegetables. The terms *'food and beverages for animals including pets; animal nutrition products; foodstuffs for animals, animal feed; solids, liquids and pastes prepared for ingestion by animals'* in the proprietor's specification have no such limitation and include all foodstuffs for all animals. As such, the applicant's term is encompassed by these broader categories. Consequently, these goods are identical under the principle outlined in *Meric*.

30. Similarly, the terms *'animal biscuits, treats and chews for animals; bones and other animal derivatives for consumption by animals, algae for animal consumption'* in the proprietor's specification are all foodstuffs for dogs and other domestic animals. None of these terms incorporate fresh fruit or vegetables. Therefore, these terms fall within the applicant's specification of *'foodstuffs for dogs and foodstuffs for domestic pets; all included in Class 31, but not including fresh fruit or fresh vegetables or any goods of the same description as fresh fruit or fresh vegetables'*. Accordingly, these goods are identical under the principle outlined in *Meric*.

31. *'Additives and supplements for animals; complete foods, food supplements and food additives for animals; vitamin and dietary supplements for pets and animals'* in the proprietor's specification are not examples of foodstuffs for dogs and pets per se and, as such, are not identical to the applicant's goods. Despite their lack of identity, the respective goods will have the same method of use, namely, that they will be consumed by animals by mouth. Moreover, the users of the respective goods will be pet and animal owners. In my view, there will also be an overlap in the respective trade channels as the respective goods will reach the market through supermarkets or pet stores. However, I accept that they will not commonly be found on the same shelves. To my mind, there is a degree of overlap in the intended purpose of the respective goods. The purpose of the applicant's goods is to provide sustenance and nutrition, while that of the proprietor's goods is to increase nutritional intake by supplementing

the traditional diet with additional vitamins and minerals. In this connection, the goods under comparison all intend to provide the required nutrients to an animal's diet. Notwithstanding the above, the nature of the respective goods is quite different: the applicant's goods consist of foodstuffs for dogs and other domestic pets, whereas the proprietor's goods are additives and supplements, typically in powder, tablet or liquid form. Although supplements are ordinarily used with foodstuffs in order to increase the nutritional intake of the food, I do not consider the respective goods complementary in the sense outlined in case law; the goods are not indispensable to one another. Finally, there is no meaningful competition between the goods; while animals may be provided a diet with or without supplements by their owners, I can see no reason why an owner would select a supplement per se over foodstuffs, or vice versa. In light of the above, I find that these goods are similar to a medium degree.

32. *'Flavourings for animal foodstuffs'* in the proprietor's specification refers to substances that are added to animal food in order to increase its palatability. While I acknowledge that some flavourings will be additives or chemical compounds used in the manufacturing process of animal food, other flavourings will consist of seasoning which can be purchased as a finished product by pet owners and mixed into animal food. In this regard, there will be some overlap in the nature of the respective goods insofar as they will all be consumables. However, the respective goods are likely to be sold in different forms i.e. the applicant's goods will be a proper foodstuff while the flavourings will be a liquid or powder. In my view, the end user of the respective goods will overlap, in that both can be used by pet and animal owners. Moreover, the method of use of the respective goods will also be the same insofar as they are all used in the feeding process and are consumed by animals by mouth. Although there would be a divergence in trade channels in respect of chemical flavourings used by manufacturers, in relation to the finished flavouring products there will be an overlap in the way in which the respective goods reach the market; the flavourings and the animal food may both be purchased from pet stores, albeit perhaps on different shelves. The respective goods, however, have a somewhat different intended purpose: the proprietor's goods increase the palatability of food and enrich the eating experience of the animal, whereas the applicant's goods provide sustenance and nutrition to the animal. Given that the goods have rather different purposes, I do not consider there to be any meaningful competition between them; while a pet or animal

owner may provide an animal with foodstuffs with or without extra flavourings, I can see no reason why they would select one over the other. Finally, although flavourings are commonly used in combination with foodstuffs, I do not consider the respective goods complementary in the sense described in case law; the goods are not indispensable to one another. Overall, balancing the similarities and the differences outlined above, I find that the goods are similar to a medium degree.

### **The average consumer and the nature of the purchasing act**

33. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

34. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

35. The goods at issue in these proceedings are for pets and animals, consisting of foodstuffs, accessories, furniture and playthings. The average consumer of such goods will be animal-owning members of the general public. The frequency of the purchasing of these goods will vary, from everyday consumable goods such as foodstuffs at one end of the spectrum to larger purchases such as kennels and grooming tables at the other. However, it is not uncommon for the goods at issue to wear due to use by the pet. Therefore, overall, the goods are likely to be purchased

relatively frequently. The purchasing act will not require an overly considered thought process as, overall, they are relatively inexpensive. The consumer will, however, take into consideration factors like nutritional content, suitability, price and quality when selecting the goods as they will wish to ensure that they are purchasing the right product for their pet or animal. Taking the above factors into account, I find that the level of attention of the general public in respect of these goods would be medium. The goods are typically sold in supermarkets, pet stores and their online equivalents, where the goods are purchased after perusing shelves, or viewing information on the internet and advertisements. In these circumstances, visual considerations would dominate. However, I do not discount aural considerations entirely as consumers may receive word of mouth recommendations or wish to discuss product suitability with a sales assistant.

36. Some of the goods at issue in these proceedings, like additives and supplements, for instance, will also be purchased by businesses such as farms. The goods are likely to be purchased frequently for the operation of the farm and for maintaining the health of its livestock. The goods are relatively inexpensive and, therefore, the purchasing act will not require an overly considered thought process. Nevertheless, the business user will consider the suitability, quality and price of the products in accordance with the specific needs of the farm and its livestock. In light of the above, I find that the level of attention of the business user in relation to these goods would be medium. The goods are typically provided to farms by agricultural suppliers and wholesalers, where the goods are purchased after perusing product brochures, viewing information on the internet or a visual inspection of the product. In these circumstances, visual considerations would dominate. However, I do not wholly discount aural considerations as business users may wish to discuss product suitability with a sales representative.

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

37. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

38. I have no submissions from the applicant regarding the distinctiveness of its earlier mark. For its part, the proprietor has accepted that the earlier mark is distinctive, though it has not indicated the level of distinctiveness it believes the earlier mark possesses. The proprietor has, however, contended that the mark is distinctive by virtue of the repeated letter ‘G’, distinguishing the mark from the otherwise non-distinctive verb ‘wag’.

39. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the applicant has not pleaded that its mark has acquired

enhanced distinctive character and has filed no evidence of use. Consequently, I have only the inherent position to consider.

40. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle.

41. The earlier mark is in word-only format and consists of the word 'WAGG'. As the earlier mark is comprised of one plain word, its distinctiveness lies in the word itself. The word 'WAGG', in the context of the goods for which the mark is registered, is likely to be recognised by the average consumer as a misspelling of the word 'wag' – meaning to move or cause to move rapidly to and fro (especially with reference to an animal's tail)<sup>1</sup> – and perceive the mark as a play on the same. As such, I consider the mark to be allusive of pet and animal related goods such as those in the applicant's specification. Accordingly, I find that the earlier mark has between a low and medium level of inherent distinctive character.

### **Comparison of trade marks**

42. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight

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<sup>1</sup> <https://www.lexico.com/definition/wag>

in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

43. Therefore, it would be wrong to artificially dissect the trade marks, though it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

44. The competing trade marks are as follows:

<b>Applicant’s mark</b>	<b>Proprietor’s mark</b>
WAGG	wagmore

45. The applicant has submitted that the dominant element of both marks is the word ‘WAG’ and that the proprietor’s mark “wholly contains the earlier trade mark”. In this connection, the applicant has argued that the competing marks are visually similar to the extent that both share the common prefix ‘WAG’. Furthermore, the applicant has contended that the first syllable of the contested mark will be pronounced identically to the earlier mark. Conceptually, the applicant has claimed that the competing marks are similar as they both “suggest a wagging tail in their dominant word element WAG”.

46. Conversely, the proprietor has submitted that the common element ‘WAG’ is a common dictionary word with “little or no distinctiveness” and that, instead, the marks should be considered in their wholes. In this regard, the proprietor has contended that it is the additional elements in both marks which provide the marks with their distinctiveness. The proprietor has disputed the applicant’s argument that the earlier mark is wholly contained with the contested mark, highlighting that the marks only share the first three letters. Visually, the proprietor has contended that the marks are different, given that the earlier mark has four characters and the proprietor’s mark has seven. Similarly, the proprietor has intimated that there are aural differences between

the competing marks, citing the fact that the proprietor's mark has two syllables. Conceptually, the proprietor has argued that the common element 'WAG' will bring to mind "either dogs wagging their tails or the wives of footballers" in both marks.

#### Overall impression

47. The earlier mark is a plain word consisting of the word 'WAGG'. As this is the only element of the mark, the overall impression is dominated by the word itself.

48. The proprietor's mark is also a plain word mark comprising the conjoined word 'wagmore' with no other elements. The overall impression of the mark lies in the conjoined word itself.

#### Visual comparison

49. Visually, the competing marks are similar insofar as they have a common three-letter string 'W-A-G', in the same order, at the beginning of the marks. I do not consider the difference created by the use of uppercase and lowercase in the respective marks to be significant since notional and fair use allows word-only marks to be presented in any standard font or case. However, there are points of visual difference between the marks. Firstly, the applicant's mark contains a double letter 'G', which is not replicated in the proprietor's mark. Moreover, the proprietor's mark also includes the word 'more', which has no counterpart in the applicant's mark. The proprietor's mark is also noticeably longer in length than the applicant's mark. In light of the above and bearing in mind my assessment of the overall impressions, I consider there to be between a low and medium degree of visual similarity between the marks.

#### Aural Comparison

50. Aurally, the applicant's mark consists of one syllable, i.e. ("WAG"), while the proprietor's mark comprises two syllables, i.e. ("WAG-MOOR"). The applicant's mark and the first syllable of the proprietor's mark are indistinguishable in the way in which they will be articulated. However, the extra syllable in the proprietor's mark has no

counterpart in the pronunciation of the applicant's mark. Taking into account the overall impressions, I consider that the marks are aurally similar to a medium degree.

### Conceptual comparison

51. Conceptually, the applicant's mark will be perceived as a misspelling or play on the word 'wag' and understood by consumers to be an allusive reference to an animal rapidly moving its tail to and fro. This is because, notwithstanding the established principle that consumers normally perceive a trade mark as a whole, consumers will break down the mark into verbal elements which suggest a concrete meaning or resemble words known to them.<sup>2</sup> In this regard, consumers will identify the word 'wag' within the word 'WAGG' and will attribute the mark its meaning. In respect of the proprietor's mark, despite the mark being conjoined, consumers will still readily identify the words 'wag' and 'more' within the mark. This is because they are ordinary dictionary words, with which consumers would be familiar. The word 'wag' within the mark will also be understood as an animal rapidly moving its tail to and fro, while the word 'more' will be understood to mean a greater or additional amount or degree.<sup>3</sup> When combined, the mark is somewhat evocative of an animal wagging its tail more (whether that be more frequently, for longer periods of time, or more than usual). The sense of 'more' is lacking from the conceptual meaning conveyed by the applicant's mark. However, both marks will convey the concept of an animal wagging its tail and, as a result, I consider the marks conceptually similar to between a medium and high degree.

### **Likelihood of confusion**

52. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor 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 vice versa. As I mentioned above, it is

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<sup>2</sup> *Usinor SA v OHIM*, Case T-189/05

<sup>3</sup> <https://www.lexico.com/definition/more>

necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that they have retained in their mind.

53. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related.

54. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

55. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask *in what does the distinctive character of the earlier mark lie?* Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

56. Earlier in this decision I concluded that:

- The proprietor's goods in classes 18, 20 and 28 are similar to the applicant's goods in class 31 to a low degree;
- Some of the proprietor's goods in class 31 are identical to those of the applicant, while others are similar to a medium degree;
- Average consumers of the goods at issue are likely to be animal-owning members of the general public, while some of the goods would also be purchased by businesses such as farms;
- Both groups of consumers would demonstrate a medium level of attention during the purchasing act;
- The purchasing process for the goods would be predominantly visual in nature, though I have not discounted aural considerations;
- The earlier mark possesses a low to medium level of inherent distinctive character;
- The competing marks are visually similar to between a low and medium degree, aurally similar to a medium degree and conceptually similar to between a medium and high degree.

57. I acknowledge that the competing marks share the identical string 'W-A-G' at the beginning of the marks, a position which is generally considered to have more impact due to consumers in the UK reading marks from left to right.<sup>4</sup> Nevertheless, there are differences between the marks which, to my mind, would not be overlooked by the average consumer during the purchasing process. As previously identified, a feature of the applicant's mark which is not replicated in the proprietor's mark is the repeated letter 'G'. More significantly, the word 'more' in the proprietor's mark has no

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<sup>4</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

counterpart in the applicant's mark. In my view, these additional word elements contribute to the overall impressions of the respective marks and would not go unnoticed by consumers. In my judgement, taking all the above factors into account, the differences between the competing trade marks are likely to be sufficient to avoid the average consumer mistaking one trade mark for the other, even on goods which I have found to be identical. Accordingly, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion.

58. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

59. I have borne in mind that these examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.

60. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

61. Applying the principles from the above case law, due to the differences between the marks previously outlined, I do not believe that the average consumer will assume the opponent and the applicant are economically linked undertakings on the basis of the competing trade marks. I am unconvinced that the average consumer would assume a commercial association between the parties, or sponsorship on the part of the opponent, merely because of the shared string ‘W-A-G’. This element is not so strikingly distinctive that consumers would assume that only the applicant would be using it in a trade mark; to the contrary, I have found this element to be allusive of pet and animal products. In my view, neither the lack of a repeated letter ‘G’ nor the addition of the word ‘more’ to the allusive word ‘wag’ in the proprietor’s mark are wholly non-distinctive alterations or characteristic of any brand extensions with which consumers would be familiar. To my mind, the differences between the marks are not conducive to a logical brand extension. I can see no reason why the competing trade marks would be perceived in this manner, even for goods that I have found to be identical. Therefore, there is no likelihood of indirect confusion.

## **CONCLUSION**

62. The application for invalidation under section 5(2)(b) of the Act has failed. Subject to any successful appeal against my decision, the proprietor's mark will remain registered in the UK.

## **COSTS**

63. As the application for invalidation has been unsuccessful, the proprietor is entitled to a contribution towards its costs. The proprietor is unrepresented and submitted a completed cost proforma to the Tribunal on 10 September 2020 outlining the number of hours spent on these proceedings. The proprietor has claimed 10 hours for preparing its Notice of Defence and 5.5 hours for considering the forms filed by the applicant. Only one ground and one earlier mark were relied upon for the purposes of the application and, on this basis, I consider the hours claimed to be high.

64. In the circumstances, I consider a costs award for the following number of hours to be reasonable:

Preparing Notice of Defence	3 hours
Considering forms filed by the applicant	2.5 hours
<b>Total</b>	<b>5.5 hours</b>

65. In relation to the hours expended, I note that the Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour. I see no reason to award anything other than this. I therefore award the proprietor the sum of **£104.50** (5.5 hours at £19.00 per hour).

66. I hereby order Inspired Pet Nutrition Limited to pay Havik Ltd the sum of **£104.50**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 14th day of October 2020**

**James Hopkins  
For the Registrar,  
The Comptroller-General**