

BL O/951/22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3687778

BY

HARIS CORP LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:

PitPet

AND

OPPOSITION NO. 429576

BY

PITPATPET LTD

Background and pleadings

1. On 30 August 2021, HARIS CORP LIMITED (the “Applicant”) applied to register the trade mark ‘PitPet’. The contested application was accepted, and published for opposition purposes in the Trade Marks Journal on 1 October 2021. Registration of the mark is sought in respect of the following goods:

Class 18 *Pet leads; Collars for pets; Pet hair bows; Dog collars; Dog leashes; Dog leads.*

Class 21 *Brushes for pets; Pet grooming glove; Pet feeding bowls; Pet treat jars; Pet drinking bowls; Trays (Litter -) for pets; Litter trays for pets; Deshedding brushes for pets.*

Class 28 *Pet toys; Dog toys.*

2. On 22 December 2021, Pitpatpet LTD (the “Opponent”) filed an opposition in which it opposed the application under Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). For the purposes of the Section 5(2)(b) and 5(3) oppositions, the Opponent relied upon the following earlier United Kingdom Trade Marks (UKTMs):

UKTM Number	Mark	Filing & Registration Date	Classes on which opposition is based
918163052	PITPAT	06/12/2019 & 22/05/2020	5, 6, 9, 18, 20, 21, 28, 31, 35, 36, 41, 42, 43, 44, 45.
3072376	PitPat	12/09/2014 & 19/12/2014	9

3072381		12/09/2014 19/12/2014	&	9
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3. The Opponent relied upon all of the goods of the earlier marks UKM 3072376 and UKTM 3072381, but chose to rely upon only some of the goods and services for which the earlier mark UKTM 918163052 is registered (see Comparison of Goods and Services at paragraph 19 for full list).

4. Since the filing dates of the earlier marks predate that of the contested application, the Opponent’s marks are considered to be “earlier marks” in accordance with section 6 of the Act.¹ However, as the earlier mark UKTM 918163052 had not been registered for a period of five years or more before the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely upon any or all of the goods and services for which UKTM 918163052 is registered, without having to show that it has used the mark at all. The earlier marks UKTM 3072376 and UKTM 3072381 had been registered for a period of more than five years before the filing date of the application, and would therefore have been subject to the use requirements specified within section 6A of the Act had the Applicant requested it been proven, which it did not. Therefore, for the purposes of the opposition brought under Section 5(2)(b), the Opponent may rely upon any or all of the goods and services under these earlier marks also.

5. The opposition is aimed against all of the goods in the contested application, which the Opponent claimed are identical or highly similar to those of the earlier marks.

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

6. The Opponent submitted that each of the three earlier marks are “almost identical” to the contested mark. The Opponent stipulated that the earlier marks are aurally and visually similar to a very high degree with the contested mark, and that the only variation between them is the swapping of the letter ‘A’ in the earlier marks to a letter ‘E’ in the contested mark. The Opponent claimed that a conceptual comparison between the marks is not possible, as none of the marks have any meaning. As a result of having no meaning, the Opponent submitted that the earlier marks are conceptually unique.

7. The Opponent identified that both party’s marks were involved in the pet care industry, and that the relevant consumer was the general public. According to the Opponent, due to the nature of the goods and services at issue, the level of attention and degree of care paid by the consumer would be low, with the purchases being made either in physical pet stores or using online shopping platforms.

8. The Opponent provided additional specific submissions in relation to the Section 5(3) opposition. The Opponent claimed that it had “...built a business that has a reputation for quality pet care products and services and has protected their brand accordingly.” The Opponent contended that due to its high degree of similarity with the earlier mark, any use of the contested mark would be gaining an unfair advantage as the consumer would be given the impression that the goods and/or services sold under the contested mark are of a similar quality to those of the Opponent. The Opponent also contended that poorly made products displaying the contested mark could dilute and destroy the reputation of the Opponent. The Opponent stated that it had a large online following, with a significant customer loyalty that could easily be disrupted through the use of the contested mark.

9. Under the Section 5(4)(a) opposition, the Opponent relied upon two marks: the word PITPAT, with first use being claimed as of 1 October 2014; and the figurative mark



with first use being claimed as of 1 October 2014, also. The Opponent submitted that both marks had been used in relation to the following goods:

Class 9 *Pet activity monitor; human activity monitor; animal activity monitor; pet location tracker; human location tracker; animal location tracker.*

Class 21 *Electronic pet feeders; pet feedings bowls; pet feedings dishes; pet drinking bowls; feeding vessels for pets; pet feedings and drinking bowls.*

Class 31 *Dog food; food for dogs; dog treats [edible]; pet food for dogs; pet foods; edible pet treats; food preparations for dogs.*

Class 35 *Maintaining a registry of dog breeds; retail services in relation to pet products; loyalty scheme services.*

10. The Opponent stated that it had used both marks throughout the UK and argued that use of the contested mark "...would be liable to be prevented by virtue of the law of passing off". The Opponent claimed that it has established significant goodwill in relation to the earlier marks through many years of trade in the United Kingdom. The Opponent argued that use of the contested mark would amount to misrepresentation to the public, and likely cause detriment and damage to the Opponent.

11. On 24 March 2022, the Applicant filed a counterstatement setting out its position in the following terms:

1-Our trademark is quite different; Trade marks are case sensitive and both have different cases and spellings and we don't have a big range of classes. PitPet is registered in only three classes.

2-Opponent's trademark is "PITPAT" and ours is "PitPet"

3-Opponent claims in the 6th point of "Comparison of Marks" that the both of the names have no meaning and we have copied it. The origin of the PitPet name is Pit Bull dog; we name it after pitbull dog name and connected it with pets as we deal in pets' products.

4-Claiming for the cancellation on the basis of assumption that "our brand will not offer quality and they will get reputation issues" is simply not logical and acceptable as well as.

Evidence

12. On 6 June 2022, the Opponent filed evidence in support of its opposition, which shall be summarised to the extent I feel necessary.

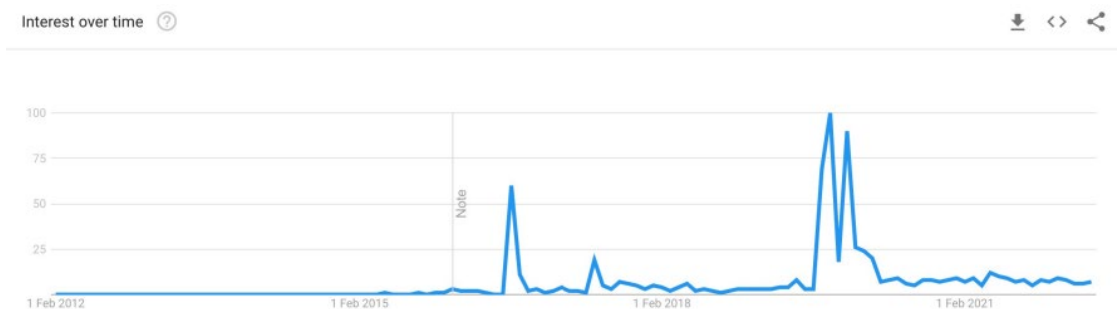
13. The Opponent's evidence contained the witness statement of Mr Andrew Nowell, the Founder, Director and CEO of Pitpatpet Ltd. Mr Nowell explained that the Opponent had been trading as PITPAT since 2 September 2014, and that the name PITPAT had been associated with "...a variety of tangible and intangible goods, and a variety of services, namely but not exclusively, activity monitors, pet food, pet care products, pet toys, membership and loyalty services". Mr Nowell submitted that the goods and services sold under "the PITPAT mark" had been sold via a number of channels in the UK, including brick and mortar stores such as 'Tesco', and online at retailers including 'Pets at Home', 'Argos', and pitpat.com. Submitted with the witness statement were 14 exhibits, including the following:

- Exhibit AN02 – an excerpt from the UKIPO database, containing the details of the Opponent's trade mark UKTM 3714061. This mark has not been included in the original TM7 notice of opposition, nor referred to in its accompanying statement of grounds. In addition, the filing date of this mark is 25 October 2021, making it a later mark than the contested application. Therefore, it shall not be considered as part of the opposition.
- Exhibit AN04 – an excerpt from 'Kickstarter', showing the original crowdfunding campaign initiated on 16 September 2014, and closed on 16 October 2014. Both the word mark PitPat and the figurative mark appear on the webpage as being used in relation to an "activity monitor for dogs". However, it is neither clear nor obvious whether the word PitPat or figurative mark appear on the actual monitor itself. It seems more apparent that the monitors are being marketed with the following "pawprint" image:



As indicated by the Kickstarter website, the "goal" of the crowdfunding was to raise \$63,229. However, by the closing date of the campaign the amount pledged by 104 backers was only \$14,405.

- Exhibit AN05 – four webpage extracts that include the home websites of pitpat.com and petsathome.com, accompanied by captures from waybackmachine.com, showing use on 11 March 2019 (petsathome.com) and 2 July 2020 (pitpat.com). The word PitPat appears on the webpages, as does the figurative mark and pawprint image.
- Exhibit AN06 – a result from ‘GoogleTrends Explore’, reflecting searched for the PITPAT between 5 January 2012 – 1 June 2022:



It is unclear (and has not been explained in the witness statement) whether the number on the left axis represents hundreds or thousands, or the actual number, in which case the “Interest over time” could have potentially peaked at 100 expressions of interest around February 2020.

- AN07 – an extract from the online version of ‘The Independent’. According to the Opponent, the article is titled ‘6 best dog activity trackers’, although this heading does not appear in the extract. The Opponent stated that the article is dated 8 July 2020, although this does not appear in the extract either.
- AN08 – a snapshot of the Opponent’s ‘Instagram’ page, which displays the figurative mark with a strapline “Made for dogs”. The word PitPat also appears, as does ‘pitpatpet’. The snapshot indicates 24, 200 “followers” and 1,702 posts, although there is no indication of when these were accumulated as the snapshot is not dated.
- AN09 – a spreadsheet of search volumes for the term ‘PITPAT’ on Google between September 2014 – April 2022. The date of application of the contested mark is 20 August 2021, and so the information pertaining to the period after

this month shall not be taken into consideration. In addition, it is apparent that the term 'PITPAT' did not receive any searches until February 2016. The peak search period appears to be between February 2020 and February 2021, during which time the term was searched for as many as 30,000 times per month globally and 22,200 times per month in the UK.

- AN12 – on 28 August 2016 Mr Nowell appeared on 'Dragon's Den' in order to seek investment for the PitPat activity monitor. According to the barb.co.uk, the audience viewing figure was 2.82 million viewers.
- AN13 – a YouTube clip of the aforementioned Dragon's Den appearance. The video was published on 5 September 2020, and has received 450,000 views in total.
- AN14 – according to the witness statement, Exhibit AN14 provides details of a television advertising campaign containing the PITPAT trade mark. The witness statement claims that the advertising campaign reached 50.5% of the audiences of the television channels Dave, Ede, W, Alibi and Gold. However, the accompanying graphic does not correlate to such statements. Firstly, the exhibit does not contain any reference to the trade mark, or a specific campaign containing it. Further, the television channels mentioned do not appear. The data that is presented on the graphic has not been particularised, and contains unexplained abbreviations. Finally, no time period of when said advertising campaign occurred has been mentioned.

14. No hearing was requested by either of the parties and therefore this decision is taken following a careful perusal of the papers before me.

15. The Applicant is unrepresented. The Opponent is professionally represented by Basck Limited.

Procedural economy

16. It appears to me that the earlier mark UKTM 918163052 offers the Opponent its greatest chance of success under Section 5(2)(b). This is on the basis that it is a word mark (as is the contested mark); it is registered for the widest specification; it has been

registered for less than five years before the filing date of the application and is therefore not subject to use requirements, meaning it may rely upon the entire list of goods and services for which it is registered. If this earlier mark is found to be dissimilar to the contested mark, the Opponent will be in no better position under Section 5(2)(b) if it were to rely on a mark with a narrower specification (both UKTM 3072376 and UKTM 3072381) and additional figurative elements (UKTM 3072381). Following my analysis of the Section 5(2)(b) grounds of opposition, I shall then turn to Section 5(3) and 5(4)(a) respectively.

Decision

17. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Section 5(2)(b)

18. 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 and services

19. The parties' respective specifications are:

Earlier mark UKTM 918163052	Contested mark
<p><i>Class 5: Dog washes [insecticides]; Dog lotions for veterinary purposes; Vitamins for pets; Dietary supplements for pets; Herbal anti-itch ointments for pets; Animal flea collars; Antiparasitic collars for animals; Pharmaceuticals and natural remedies.</i></p>	
<p><i>Class 6: Metal dog tags.</i></p>	
<p><i>Class 9: Wearable activity trackers; wearable monitors.</i></p>	
<p><i>Class 18: Dog coats; Dog collars; Dog clothing; Dog apparel; Dog leads; Clothing for dogs; Pet leads; Electronic pet collars; Garments for pets; Pets (Clothing for -); Collars for pets; Pet clothing; Collars for animals; Harness for animals; Harnesses for animals.</i></p>	<p><i>Class 18: Pet leads; Collars for pets; Pet hair bows; Dog collars; Dog leashes; Dog leads.</i></p>
<p><i>Class 20: Dog beds; Non-metal dog tags; Beds for pets; Dog kennels.</i></p>	
<p><i>Class 21: Dog food scoops; Automatic pet feeders; Electronic pet feeders; Pet feeding bowls; Pet feeding dishes; Pet drinking bowls; Pet feeding bowls, automatic; Feeding vessels for pets; Pet feeding and drinking bowls; Automatic litter boxes for pets.</i></p>	<p><i>Class 21: Brushes for pets; Pet grooming glove; Pet feeding bowls; Pet treat jars; Pet drinking bowls; Trays (Litter -) for pets; Litter trays for pets; Deshedding brushes for pets.</i></p>
<p><i>Class 28: Dog toys; Toys for dogs; Toy dogs; Pet toys; Toys for pets; Toys for</i></p>	<p><i>Class 28: Pet toys; Dog toys.</i></p>

<p><i>pet animals; Sports equipment for pets; Toys and playthings for pets; Toys for translating feelings of pets; Toys, games and playthings for pet animals; Harnesses for use in sports; Soft toys in the form of animals; Soft toys.</i></p>	
<p><i>Class 31: Dog food; Food for dogs; Dog treats [edible]; Pet food for dogs; Pet foods; Edible pet treats; Food preparations for dogs.</i></p>	
<p><i>Class 35: Maintaining a registry of dog breeds; Retail services in relation to pet products; Retail services in relation to veterinary preparations; Retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Retail services connected with the sale of subscription boxes containing food.</i></p>	
<p><i>Class 36: Insurance brokerage relating to pets.</i></p>	
<p><i>Class 41: Dog shows; Organisation of dog competitions; Training in dog handling; Organisation of dog shows; Teaching of petcare; Teaching of pet care; Training relating to the management of pet exhibitions; Training relating to the management of pet</i></p>	

<p><i>shows; Publication of printed matter relating to pet animals.</i></p>	
<p><i>Class 42: Services for assessing the efficiency of veterinary drugs; Provision of information and data relating to medical and veterinary research and development.</i></p>	
<p><i>Class 43: Dog day care services; Pet boarding services; Pet day care services.</i></p>	
<p><i>Class 44: Veterinary services; Care of pet animals; Advisory services relating to the care of pet animals; Insertion of subcutaneous microchips into pets for purposes of tracking and identification; Veterinary advisory services; Information services relating to veterinary pharmaceuticals; Providing information relating to veterinary services; Information services relating to the veterinary pharmaceutical industry; Advice relating to the feeding of animals; Advisory services relating to the care of animals; Services for the care of pet animals.</i></p>	
<p><i>Class 45: Dog walking services; Lost dog location services; Identification marking for dogs for security purposes; Pet sitting; Microchip security services for pets.</i></p>	

20. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, C-39/97, the court stated at paragraph 23 of its judgment 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”.

21. 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.

22. It has also been established by the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, T- 133/05, that:

“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 für 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”.

Class 18

23. The contested *Pet leads; Collars for pets; Dog collars* and *Dog leads* are registered identically in the earlier mark. I consider the contested *Dog leashes* to be a synonym of *Dog lead*, which is registered in the earlier mark, and is therefore found to be identical.

24. The contested *Pet hair bows* is considered to be either an accessory, garment or item of clothing to be worn by a pet. The earlier mark is registered for *Dog clothing; Garments for pets* and *Dog apparel*. The contested *Pet hair bows* are considered to fall within at least one of these more general categories, and is therefore found to be identical under the *Meric* principle.

Class 21

25. The contested *Pet feeding bowls* and *Pet drinking bowls* are registered identically in the earlier mark.

26. The earlier mark is registered for *Automatic litter boxes for pets*, which I consider to fall within the more general category of the contested *Trays (Litter -) for pets* and *Litter trays for pets*. As a result, the contested *Trays (Litter -) for pets* and *Litter trays for pets* are found to be identical under the *Meric* principle.

27. The contested *Pet treat jars* have the intended purpose of containing pet consumables. The earlier mark is registered for goods including *Pet feeding dishes* and *Feeding vessels for pets*. The intended purpose of such goods is to be a receptacle from which food and treats etc., can be consumed. Whilst being different items, they nevertheless have a similar nature and intended purpose and identical end user. They are therefore considered to be similar to at least a medium degree.

28. The contested *Brushes for pets; Pet grooming glove and Deshedding brushes for pets* are self-evidently items that are used in the brushing, grooming, and deshedding (of hair) of pets. The earlier mark is not registered for identical goods, nor is it registered for goods that would traditionally be considered to be complementary or in competition. However, the contested goods are most likely sold in the same type of retail establishment as the goods of the earlier mark, in particular, the type of goods registered in 18, 20, 21 and 28. In addition, the contested goods share the same channel of trade and end user (pets) as those of the earlier mark, as well as being the same kind of good, i.e., items used by/for a pet. The contested *Brushes for pets; Pet grooming glove and Deshedding brushes for pets* are therefore considered to be similar to at least a low degree.

Class 28

29. The contested *Pet toys; Dog toys* are registered identically in the earlier mark.

Comparison of the marks

30. 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 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.”

31. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks,

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

32. The respective trade marks are shown below:

Earlier mark	Contested mark
PITPAT	PitPet

33. The earlier mark consists of the single term 'PITPAT', which has no meaning in the English language. It is presented in a standard typeface. The overall impression lies in the perception of the single term, which is also where any distinctiveness lies.

34. The contested mark is a conjoined term consisting of the English language words 'Pit' and 'Pet'. The word 'Pit' has the meaning of a large hole dug in the ground, whilst the word 'Pet' has the meaning of an animal that is kept at home for company and pleasure. In relation to the goods and services at issue, the word 'Pet' might strike a chord as being the intended recipient. The Applicant submitted that the word 'Pit' within the contested mark is intended to represent a 'Pit Bull' dog. Considering the nature of the goods and services at issue, I do not dismiss the possibility that an average consumer may perceive the element as meaning this. However, I nevertheless consider it improbable. In my opinion, taking the term 'Pit' and extrapolating it to refer to a Pit Bull dog requires a number of mental steps and processes that I do not believe would happen in the majority of instances. The contested mark is presented in a standard typeface, with neither element being more dominant or distinctive. The overall impression of the mark therefore lies in the perception of the combination of words 'PitPet' as a whole, which does not create a particularly clear message, and which is also where any distinctiveness lies.

Visual similarity

35. The marks are visually similar insofar as they each contain five identical letters, which occupy the first four letter-positions of each mark, as well as the final letter of each mark respectively. The marks differ visually due to a different fifth letter. The marks also differ visually in regard to the use of upper and lower case lettering, with

the earlier mark being entirely upper case, whilst the contested mark is a mixture of upper and lower case letters. In my opinion the use of an upper case first and fourth letter clearly identify the two separate words 'Pit' and 'Pet'. Notwithstanding the perception of two individual words in the contested mark and the perception of one word in the earlier mark, the marks at issue are nevertheless visually similar to a very high degree due to the shared identity of five out of a possible six letters.

Aural similarity

36. The marks are aurally similar insofar as they each contain two syllables, including the identically pronounced first syllable 'PIT'. The marks differ from an aural perspective due to the second syllable of each mark, with it being 'PAT' in the earlier mark and 'PET' in the contested mark. Both second syllables are closed, as they are short terms that contain a vowel but end with a consonant. The aural difference of the respective second syllable is limited to the changing of the central vowel, with the 'A' in the earlier mark sounding like the 'A' of 'Apple', and the 'E' in the contested mark sounding like the 'E' in 'Echo'. The fact that the earlier mark is one seemingly invented term whereas the contested mark consists of two conjoined English language terms has no impact on their aural aspects.

37. The marks are aurally similar to a very high degree.

Conceptual similarity

38. The earlier mark is not a word in the English language, and will likely be perceived as a seemingly invented term. It therefore has no conceptual meaning.

39. The contested mark will be perceived as a combination of 'Pit' (large hole) plus 'Pet' (domesticated animal for companionship). Although the word 'Pet' could be considered to be descriptive or allusive in relation to the goods and services at issue, the combination as a whole does not convey any immediately obvious message, and will likely strike the average consumer as being strange or unusual.

40. Due to the fact that the earlier mark has no obvious conceptual meaning, there can be no conceptual comparison.

Average consumer and the purchasing act

41. 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.² 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.”

42. The goods at issue found to be identical or similar all relate to pets, more specifically (although not exclusively) dogs. The goods at issue are relatively rudimentary objects, and generally speaking are fairly inexpensive. The level of attention of the average consumer will therefore tend to be quite low. Based on the nature of the goods at issue, I consider it most likely that the purchase process will be visual. Whether the consumer is buying a collar, litter tray or toy, the consumer will be using their eyes, and would therefore most likely be making a purchase decision based on the visual appearance of the product. That having been said, I do not entirely discount the possibility that the marks may be spoken, especially when engaging a sales assistant in conversation. As such, I accept that there may be an aural element to the purchasing process.

Distinctive character of the earlier trade marks

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

² *Lloyd Schuhfabrik Meyer*, Case C-342/97

“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).”

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.

44. The distinctiveness of the earlier mark lies in the single term ‘PITPET’. By way of being a seemingly invented word, which has no clear or obvious meaning, I find that it is inherently distinctive to a high degree.

Likelihood of confusion

45. 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 and services down to the responsible undertakings being the same or related.

46. 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 (see *Sabel*, C-251/95, para 22). The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the Opponent's trade mark, the average consumer for the services 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 he has retained in his mind.

47. In *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated that:

“49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

48. In *Quelle AG v OHIM*, T-88/05, the GC found that visual similarity (and difference) is most important in the case of goods that are self-selected or where the consumer sees the mark when purchasing the goods. The Court stated that:

“68... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (*NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, paragraph 53 supra, paragraph 49).

69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55)... The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

49. Having conducted a full analysis and thorough comparison of the marks and their respective goods at issue, I have determined that it is the visual considerations which are of a greater importance in the assessment of a likelihood of confusion, due to the purchasing process of the respective goods being visually dominated. With this in mind, it is important to reaffirm that I have found the marks to be visually similar to a very high degree. It is also important to reaffirm that I did not rule out a part of the relevant public paying attention to the aural aspect of the marks during the purchasing process, in which case I consider the finding of aural similarity to a very high degree to also be of significance.

50. I note the Applicant's submission that the trade marks at issue are case sensitive, meaning they appear to be quite different. I disagree with this submission. It is established in case law that the protection offered by the registration of a word mark applies to the word stated in the application for registration and not to the individual graphic or stylistic characteristics which that mark might possess.³ Therefore, the protection of the earlier mark extends to its use in lower case as 'pitpat' as well as the upper case 'PITPAT'. In my opinion, the use of a combination of upper and lower case letters in the contested mark would have a minor impact overall. I believe the use will serve to indicate that the contested mark consists of the two terms 'Pit' and 'Pet' conjoined, and would be equally similar to either 'PITPAT' or 'pitpat'. In reality, I do not consider the use of a combination of upper and lower case letter in the contested mark to have a significant impact on the levels of visual or aural similarity between the marks at issue, especially when considering their overall impressions as part of their global assessment.

51. In *El Corte Inglés, SA v OHIM*, T-183/02 and T-184/02, the GC noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

"81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters 'lo' which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

³ Radio Regenbogen Hörfunk in Baden v OHIM (RadioCom), T-254/06, paragraph 43.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

52. As I have previously identified, the six-letter marks at issue identically share the first four letters 'PITP'. The marks also end with the identical letter 'T', and so the visual difference is limited to the change of a letter 'A' for a letter 'E'. In keeping with the aforementioned Board of Appeal decision, I feel it entirely accurate and fair to reflect that the marks at issue share the 'root' of 'PETP'. This results in a strong visual similarity between the marks which are, to borrow the wording of the *El Corte Inglés* judgment, "reinforced by the presence of the [identical] letter at the end of the two signs", i.e., the letter 'T' in the current proceedings. In addition, the degree of aural similarity between the marks at issue is very high. In fact, it may be arguable to say that the aural difference between the marks is negligible, limited as it is to the vowel sound in the second syllable. The high degrees of similarities in both the visual and aural aspects of the marks would not be lost on the average consumer, who is considered to be reasonably well informed and reasonably observant and circumspect,⁴ but who must nevertheless rely upon an imperfect picture of the trade marks they kept in their mind. I find it entirely possible that an imperfect picture of the earlier mark PITPAT could be misremembered as PitPet.

53. The level of attention paid during the purchasing process of the goods at issue is not particularly high. Therefore, the very high degrees of aural and visual similarity between the marks will, in my opinion, lead to a likelihood of direct confusion. I believe it is a distinct possibility that when purchasing *dog leads, feeding bowls* or *pet toys*, for example, the average consumer would overlook the minor visual and barely audible differences between the marks, and inadvertently mistake one for the other. This is

⁴ See paragraph 60 of *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*.

especially so when considering that the goods will likely be sold in the same store, and have been found to be either identical or similar from a low to medium degree. As I have mentioned previously, a global assessment includes keeping in mind a number of factors, one of which is the interdependency principle, whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa.⁵ The degrees of similarity and identity between certain goods in the current proceedings would likely offset a lower degree of similarity between marks if it existed. The fact then that the marks at issue have actually been found to be very highly similar in regards to the most pertinent visual and aural aspects only serves to reinforce a finding of a likelihood of direct confusion.

54. Essentially, it is my opinion that the consumer of the goods at issue would likely misremember the earlier mark and directly confuse it with the contested mark. I find it to be a distinct possibility that a consumer buying a dog collar or pet toy sold under the mark PitPet could misremember the visually and aurally very highly similar earlier mark PITPAT that appeared on identical goods they bought previously.

55. In light of the above, I consider there to be a likelihood of direct confusion in relation to all of the contested goods.

56. Therefore, the opposition insofar as it is based on Section 5(2)(b) has been entirely successful in relation to the opponent's earlier UKTM 918163052.

57. For the sake of completeness, I now move on to consider the Section 5(3) ground of opposition.

Section 5(3)

58. Section 5(3) of the Act states:

“5(3) A trade mark which-

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

⁵ *Canon*, C-39/97, para 17

United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

As noted above, the Opponent’s earlier UK marks upon which it relies for the purposes of section 5(3) qualify as earlier trade marks under the provisions of section 6 of the Act

35. The relevant case law can be found in the following judgments of the CJEU: C-375/97, *General Motors*; C52/07, *Intel*; C-408/01, *Adidas-Salomon*; C-487/07, *L’Oreal v Bellure*; C-323/09, *Marks and Spencer v Interflora*; and C-383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*.

59. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks are similar to the applicant's marks. Secondly, that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities

between the marks will cause the relevant public to make a link between them, in the sense of the earlier marks being brought to mind by the later marks. Fourthly, assuming that the first three conditions are met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods or services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

60. The success of an opposition under Section 5(3) depends on the earlier mark(s) having been proven to enjoy a reputation. The concept of 'Reputation' was identified in *General Motors, C-375/97*, where the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. 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.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

61. In *Spirit Energy Limited v Spirit Solar Limited* - BL O/034/20 – Mr Phillip Johnson, as the Appointed Person, held that the opponent had not established a qualifying

reputation for Section 5(3) purposes. The opponent traded in solar energy equipment and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the 5 years prior to the relevant date, it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13m in income. However, there was limited evidence of advertising and promotion, and the amount spent promoting the mark had fallen in the years leading up to the relevant date. Additionally, the mark had only been used in South East England and the Midlands. Taking all the relevant factors into account, the Appointed Person therefore decided that such use of the mark was not sufficient to establish a reputation for the purposes of s.5(3).

62. In *GNAT and Company Ltd & Anor v West Lake East Ltd & Anor* [2022] EWHC 319, HHJ Hacon held that the claimants had not established a qualifying reputation for the purposes of Section 10(3). The claimants had operated a restaurant at the Dorchester Hotel in Park Lane for around four years prior to the relevant date. Turnover was between £5m and £6m each year, which equated to approximately 70,000 customers served per year; advertising spend had varied significantly, from around £5,000 at its lowest to over £47,000. The claimants had provided dining vouchers worth about £17,000 to charities and there had been some press coverage and awards but only 7 such articles appear to have been in evidence. The judge stated that, although it was likely that a spread of individuals across the UK would have read the articles or been made aware of the awards, the claimants' market share was tiny relative to the UK restaurant business as a whole. The advertising sums were also very small in that context and the business was in relation to a single restaurant. The judge concluded that the evidence satisfied the 'geographic' aspect of the test but not the 'economic' one, and that the use was not sufficient to establish that the claimants' mark had a reputation.

Summary of the Opponent's evidence

63. The evidence provided by the Opponent in relation to its claim of reputation has been considered thoroughly, and summarised to the degree I feel necessary between paragraphs 13 and 14 of this decision. In my opinion, the evidence falls short of proving that the Opponent has gained a reputation in relation to the goods and services for

which any of the earlier marks relied upon have been registered. The witness statement of Mr Andrew Nowell, Founder, Director and CEO of the Opponent company Pitpatpet Ltd., claimed that the earlier marks had been associated with "... a variety of tangible and intangible goods, and a variety of services, namely but not exclusively, activity monitors, pet food, pet care products, pet toys, membership and loyalty services", since as early as 2 September 2014. However, none of the evidence submitted shows any use on, or even an association with, the majority of goods or services for which the earlier marks are registered. For example, the evidence does not specifically pertain to *pet food* or *toys*, or services such as *membership* and *loyalty services*. In reality, having reviewed the evidence, it seems to me to be a more accurate and fair reflection to find that the evidence submitted by the Opponent is entirely and exclusively limited to an "activity monitor for dogs".

64. The Opponent submitted that its goods had been sold in brick-and-mortar stores, such as Tesco, and also online via websites, such as Argos. However, no evidence has been submitted in the form of webpages or catalogues or photographs etc., to support this statement in relation to these particular stores. Proof of the availability to purchase goods online has been limited to petsathome.com and pitpat.com (both Exhibit AN05). Another example of where the witness statement has not been supported by its accompanying exhibit is AN07. According to the witness statement, The Independent newspaper included within its '6 best dog activity trackers' the goods of the Opponent. However, the provided article does not appear to specifically include such a category as '6 best dog activity trackers' – a title is not apparent in the article. In addition, the article has not been dated, and it is therefore not possible to categorically include it as proof of reputation gained prior to the date of the contested application (that being 30 August 2021). A number of the other exhibits are also undated or, in the alternative, include information pertaining to a period of time after the date of filing of the contested mark. Were it possible to assume that the exhibits relate to the period of time prior the date of application, the information contained therein would in any case be limited, in my opinion, by way of its probative value. For example, the Instagram post (AN08) shows 24,200 followers of pitpatpet, which I do not consider to necessarily be a particularly large following for a company in the pet world. Also, the Kickstarter crowdfunding page (AN04) serves to indicate that an insufficient number of people supported the Opponent in its goal of raising a financial

sum, which was in any case indicated in USD \$, and therefore not pertinent to the UK. Most notably, the evidence submitted makes no reference to actual sales of any of the goods and services of the earlier mark. The evidence does not include invoices or proof of sale, nor orders or indication of volume sold. It cannot, therefore, be assumed that any sales have occurred.

65. The *General Motors* judgment set out a criteria that would ideally be adhered to in order for a trade mark to have successfully demonstrated that it had acquired a reputation. The criteria established that evidence should identify the market share held by the trade mark, the intensity, geographical extent and duration of its use, and also the size of the investment made by the undertaking in promoting it. Whilst the criteria does not comprise an exhaustive list, it nevertheless serves as a useful tool to indicate the type and fields of evidence that should be submitted. By comparing the evidence submitted by the Opponent to the *General Motors* criterion, it appears to me that it has several apparent deficiencies. For example, no information relating to the market share has been provided, although even if a market share had been claimed, its probative value would have been limited without sales or advertising expenditure to corroborate the claim. Also, the evidence does not display any obvious geographical spread of exposure (frequently indicated through invoices and sale request, that in this case have not been provided) although I accept that certain types of evidence are assumed to be UK-wide (e.g., YouTube, Instagram, Google etc.). As for the size of the marketing investment, the Opponent has failed to include financial evidence relating to any advertising, and promotional or marketing activities intended to raise brand awareness. It is therefore unknown how much was spent in advertising the earlier mark. It is noted that the Opponent referred to a television advertising campaign, which purportedly indicated that the PITPAT trade mark had reached 50.5% of the audiences of Dave, Ede, W, Alibi and Gold channels. However, the accompanying exhibit AN14 does not corroborate this. The trade mark is not mentioned in the campaign metrics. Further, the period of time when the advertising campaign was launched has not been included. Furthermore, the supposed channels are not mentioned.

66. The evidence included two exhibits showing the number of times 'PITPAT' was searched on Google (AN06 and AN09). As indicated during the evidence summary, it could have been explained more thoroughly how these extracts represent information.

Nevertheless, I have gathered my own figures for AN09 in particular, and am not able to decide without a market indicator whether 22,000+ searches a month represents a significant level of interest from within the respective consumer group. Further, the number of searches have not been specified as relating to any particular good or service, and so cannot be adduced to support the Opponent's position.

67. In my opinion, the Opponent's strongest evidence is that which relates to Mr Nowell's appearance on 'Dragon's Den'. When on television, the show is watched by an audience that can cover the entirety of the UK, with a supposed audience number of 2.82 million viewers for Mr Nowell's appearance. The particular episode in which Mr Nowell appeared is also available on YouTube, and as of 5 September 2020 had received 415,507 views. However, this does not necessarily equate to the earlier mark being known by a 'significant part of the public concerned by the products or services covered by that trade mark'. It would have again been useful to know the market share of the product in order to calculate how impactful such viewing figures would be in the relevant trade, but as mentioned previously, this has not been provided. I consider it to be general knowledge (and sufficiently notorious) that one of the UK's most common pets is a dog, with roughly 1 in 3 households owning a dog. I therefore take judicial notice of such a fact.⁶ With this in mind, I am not entirely convinced that the viewing figures provided indicate that a significant part of the relevant public will have been exposed to the earlier mark via the media referred to in the witness statement. As an aside, I find it important to establish that in any case the Dragon's Den related exhibits are not, in and of themselves, sufficient in isolation to prove a reputation for all of the goods and services of the earlier mark.

68. I have found the evidence submitted to be insufficient in proving any kind of reputation of the earlier mark. This includes establishing whether the earlier mark represents goods and/or services that are prestigious or luxurious or innovative or high quality, for example. Because to my mind reputation has not been proven, it is not possible to establish that either unfair advantage or detriment to the distinctive character or suppose repute of the earlier mark has occurred. As explained in case law (see *General Motors*, paragraph 23), it is only where there is a sufficient degree of knowledge of the earlier mark that the relevant public could possibly make an

⁶ *Chorkee Ltd v Cherokee Inc.*, BL O/048/08

association of it with the later mark, to which end the earlier mark may consequently be damaged. Without a degree of knowledge, or “reputation”, it is not possible for damage to have occurred. In addition, other than making the specific statement that damaged has occurred, the Opponent has not indicated or specified how it has or might have been damaged. For example, the Opponent has not provided evidence to establish that the earlier mark has suffered either a current change or potential future risk of change in the economic behaviour of the average consumer, nor has it proven the distinctive character of the earlier mark has been, or could be, weakened by use of the contested mark (see *Intel*, paragraphs 76 and 77).

69. Due to the deficiencies identified above, it is not necessary to consider whether there exists a link between the marks. Whether or not a link exists between the earlier marks and the contested mark (which I neither discount nor assume), the opposition would still be required to prove that the earlier marks enjoy a reputation, which I have concluded they do not.

70. Without having proven that the earlier marks have a reputation, and without having established either damage, unfair advantage, detriment, or weakening of distinctive character to the earlier mark, it is not possible for the Section 5(3) opposition to succeed.

71. The opposition insofar as it is based on Section 5(3) is unsuccessful in respect of all three earlier marks relied upon.

72. I now move on to consider the opposition under Section 5(4)(a)

Section 5(4)(a)

73. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

74. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

75. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

Relevant date

76. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

77. In order to successfully oppose the contested mark under Section 5(4)(a), the Opponent will have to prove that it enjoyed goodwill or had a reputation at the time of filing of the contested mark, i.e., 30 August 2021. Once any goodwill or reputation is established, the Opponent would then have to prove misrepresentation leading to deception or a likelihood of deception, and also/or damage resulting from the misrepresentation.

Goodwill

78. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

79. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge’s finding). Again that shows one is looking for more than a minimal reputation.”

80. In *Smart Planet Technologies, Inc. v Rajinda Sharma* [BL O/304/20], Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

81. After reviewing the evidence relied on to establish the existence of a protectable goodwill Mr Mitcheson found as follows:

“The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi’s witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.

37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of “reCUP” ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca’s Kitchen and Bakery.

38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the

UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

82. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal in England and Wales held that the defendant had passed off its LUMOS nail care products as the claimant's goods. The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. As at the relevant date (October 2010) the Claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, "very limited", the claimant's goodwill was found to be sufficient to entitle it to restrain the defendant's trade under LUMOS.

83. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of

reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

84. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

85. Deciding whether goodwill has or has not been proven is a finely balanced assessment. The evidence in support of the claim must prove more than a “minimal reputation” (see *Hart v Relentless Records*). It must also be more than a “nominal

goodwill”, capable of demonstrating a “significant or substantial” goodwill in order to enable a conclusion that there would be substantial damage caused by any misrepresentation (see *Smart Planet Technologies*).

86. Qualifying and quantifying how such levels of goodwill can be demonstrated requires a thorough assessment and familiarity with the overall impression of the evidence submitted for such purposes. In *Smart Planet Technologies*, Mr Thomas Mitcheson QC, as the Appointed Person did not consider the 10 invoices for two customers equating to € 3,230 to be sufficient to prove goodwill. Mr Mitcheson also identified the fact that no evidence had been adduced from the Opponent to explain how its business had been won (this relates to advertising and marketing expenditures), nor had any evidence been adduced from the customers to apportion goodwill onto the Opponent’s earlier mark. Further, the evidence did not particularise how articles discussing the mark impacted upon the average consumer. The evidence before Mr Mitcheson was arguably stronger than that which has been presented before me in these proceedings, insofar as it at least included invoices, specific clients/customers, and information pertaining to the size of the market (“...some 2.5 billion paper coffee cups per year”).

87. The evidence provided by the Opponent in these proceedings has been summarised in paragraphs 13-14, and assessed for its probative value in paragraphs 64-69. It is clear that the evidence submitted did not provide invoices or market share, nor were its advertising ventures explained for the purposes of indicating how goodwill would be attributed or perceived. As was explained by the EWCA in *Lumos Skincare Limited*, it is not necessary for a business to be large in order to possess goodwill, indeed, sales as low as £2,000 per quarter to a handful of retailer outlets could be sufficient. However, such receipts of sales in the form of invoices have not been provided in the current proceedings.

88. It is clear that “trivial” goodwill is not sufficient for the purposes of succeeding in a claim under Section 5(4)(a). It is also clear to me that the Opponent has provided evidence which does include use of the term ‘PITPAT’ and the figurative version of the mark. I do not believe it can be denied that the Opponent has made some use of the marks, as they appear on Instagram, and on two online retail outlets, etc. However, it

is incumbent on the Opponent to present the evidence in a way that best supports a finding of goodwill in relation to goods "...comprised in the applicant's specification of goods" (see *South Cone Incorporated*, and *Minimax*). I find it a fair reflection to say that if I were to find the Opponent enjoying any goodwill through the mark's appearance on certain online retailers, social media platforms or Dragon's Den etc., it would be exclusively limited to an activity monitor for dogs in Class 9. The contested mark has not been applied for in relation to any good that is remotely similar, as the contested goods do not have a technical nature or use smart software, for example. Rather, they are basic items used for controlling, grooming, feeding or entertaining a pet.

89. I do not consider the Opponent to have proven goodwill in either of its two unregistered rights. In any case, had the evidence been considered to show more than trivial or nominal goodwill, it would have been in relation to goods for which the contested mark has not been applied and which have been found to be dissimilar. The Opponent has therefore failed to satisfy at least one of the three limbs of the classical trinity of tort (see *Discount Outlet*).

90. The opposition, insofar as it is based on Section 5(4)(a) is unsuccessful.

Conclusion

91. The opposition fails entirely in regard to the Section 5(3) and 5(4)(a) grounds pleaded, however, it has been entirely successful under Section 5(2)(b). Subject to an appeal, the contested application will be refused.

Costs

92. The Opponent has been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. In the circumstances I award the Opponent the sum of £1,050 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Fee for the opposition	£200
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Preparing a statement and considering the

counterstatement of the other side	£300
Preparing evidence	£550

93. I therefore order HARIS CORP LIMITED to pay Pitpatpet LTD the sum of £1,050. 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 1st day of November 2022

Dafydd Collins

For the Registrar