

O/0050/23

TRADE MARKS ACT 1994

IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3434707  
BY AFFINITY PETCARE, S.A.  
TO REGISTER THE TRADE MARK:

**REAL.**

IN CLASS 31

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 419875  
BY REAL PET FOOD COMPANY SINGAPORE PTE. LTD.

## **Background and pleadings**

1. On 8 October 2019, **Affinity Petcare, S.A.** (“the applicant”) applied to register the trade mark displayed on the cover page of this decision in the UK, under number 3434707 (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 20 December 2019. Registration is sought for the following goods:

Class 31: Animal foodstuffs; animal feed preparations; pet food; beverages for pets; fodder; fortified food substances for animals; wheat proteins for animal food; bedding materials for animals; live animals; edible treats for animals; malt.

2. On 20 March 2020, **Real Pet Food Company Singapore Pte. Ltd.** (“the opponent”) filed a notice of opposition. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods of the application. To support its claim the opponent relies upon the following trade marks:



EU trade mark number: 15876832<sup>1</sup>

Filing date: 30 September 2016

Registration date: 30 March 2020

(“the first earlier mark”)

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<sup>1</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, such as the first earlier mark, 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.



UK trade mark number: 3188527

Filing date: 30 September 2016

Registration date: 7 February 2020

("the second earlier mark")

3. The first earlier mark is registered in respect of goods and services in classes 31 and 35. The second earlier mark is registered in respect of services in class 35. For the purposes of the opposition, the opponent relies upon all of those goods and services, namely:

**First earlier mark**

Class 31: Foodstuffs for animals; pet food; grains for animal consumption; edible chews for animals; yeast for animal consumption.

Class 35: Presentation of goods on communication media, for retail purposes; advertising and promotional services; retailing and wholesaling of goods being retailing and wholesaling of food and accessories for animals and pets, including online; all aforementioned services in this class relating exclusively to foodstuffs and fodder for animals, pet food, grains for animal consumption, edible chews for animals, yeast for animal consumption, accessories for pets.

## **Second earlier mark**

Class 35: Advertising and promotional services; all aforementioned services in this class relating exclusively to foodstuffs and fodder for animals, pet food, grains for animal consumption, edible chews for animals, yeast for animal consumption, accessories for pets.

4. Given the respective filing dates, the opponent's marks are earlier marks, in accordance with section 6 of the Act. However, as neither had been registered for five years or more at the filing date of the application, they are not subject to the proof of use requirements specified within section 6A of the Act. Consequently, the opponent may rely upon all of the goods and services for which the earlier marks are registered without having to establish genuine use.

5. The opponent essentially argues that the goods of the contested mark are identical or similar to the goods and services of the first earlier mark and similar to the services of the second earlier mark. Moreover, the opponent claims that the earlier marks and the contested mark are similar due to the shared word "Real". On this basis, the opponent contends that there is a likelihood of confusion.

6. The applicant filed a counterstatement denying the ground of opposition. The applicant denies that the marks are similar and denies that the goods and services are identical or similar, with the exception of its "Animal foodstuffs; animal feed preparations; petfood; fodder; wheat proteins for animal foods; edible treats for animals".<sup>2</sup> It disputes that there is a likelihood of confusion.

7. The opponent is professionally represented by Noerr Alicante IP, S.L., whereas the applicant is professionally represented by Murgitroyd & Company. Neither party elected to file evidence. However, the opponent filed written submissions during the evidence rounds. Whilst I do not intend to summarise these, I have taken them into

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<sup>2</sup> Counterstatement, paragraph 6

consideration and will refer to them as and where appropriate during this decision. This decision is taken following a careful perusal of the papers.

8. 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 case law.

## **Decision**

### **Section 5(2)(b)**

9. 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.”

## Case law

10. I am guided by the following principles which 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.

### **My approach**

11. The only difference between the marks is that one is in colour and the other is in greyscale; moreover, the services of the second earlier mark appear to be less similar to the goods of the contested mark than the goods and services of the first earlier mark. For that reason, I will only consider the first earlier mark from here onwards. If the opposition fails based on the first earlier mark, then it follows that the opposition would also fail based on the second earlier mark.

## Comparison of goods and services

12. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

13. Put simply, this means that whether the goods and services are in the same or different classes is not decisive in determining whether they are similar or dissimilar. Therefore, what matters is the actual goods and services at issue and whether they are similar or not having regard to the case law that follows.

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

“In assessing the similarity of the goods or services concerned, [...] 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”.



15. 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.

16. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the

category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Meric')*, the General Court (“the GC”) stated 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”.

18. For the purposes of considering the issue of similarity of goods or 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 *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

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 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. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in

circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he was then), sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes”,

whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

21. The goods and services to be compared are outlined at paragraphs 1 and 3.

22. In its counterstatement, the applicant admits that the terms “animal foodstuffs; animal feed preparations; petfood; fodder; wheat proteins for animal foods; edible treats for animals” in the application are identical/similar to the goods of the first earlier mark.<sup>3</sup> However, it is unclear what terms the applicant concedes are identical and what terms it concedes are similar, or the level of similarity that it accepts exists between them. Therefore, I will proceed to conduct a comparison, though I bear in mind the applicant’s admission that there is at least some similarity between these terms and the opponent’s goods.

#### *Animal foodstuffs*

23. The term “foodstuffs for animals” in class 31 of the first earlier mark is an alternative way of expressing the above term. As a result, these goods are identical.

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<sup>3</sup> Counterstatement, paragraph 6.

*Pet food; fortified food substances for animals; fodder; edible treats for animals*

24. The above terms are all particular examples of foodstuffs for animals. As such, they are encompassed by the broad term “foodstuff for animals”, which appears in class 31 of the first earlier mark. Accordingly, I find that the respective goods are *Meric* identical.

*Malt*

25. Malt is commonly used for animal feed as well as in food and drink for human consumption. As such, this term would be encompassed by the terms “foodstuff for animals; grains for animal consumption” in class 31 of the first earlier mark. Consequently, the goods are *Meric* identical.

*Wheat proteins for animal food; animal feed preparations*

26. These terms in the applicant’s specification are not examples of animal food per se but, rather, ingredients that are added to (or used to produce) animal food. As such, they are not identical to the opponent’s goods. Nevertheless, the respective goods have the same method of use, namely, that they will be consumed by animals. There is also a degree of overlap in the intended purpose of the respective goods as both ultimately provide nutrition and sustenance to animals. Moreover, the users of the respective goods will be animal owners. In my view, there will also be an overlap in trade channels as the respective goods will reach the market through supermarkets or pet stores. However, I accept that they may not be found on the same shelves but are likely to be in fairly close proximity to one another. Notwithstanding the above, the nature of the respective goods is quite different: the applicant’s goods consist of foodstuffs for animals, whereas the proprietor’s goods are additional ingredients added to (or used to produce) animal food. Although the applied-for goods are ordinarily used with foodstuffs, I do not consider the respective goods complementary in the sense outlined in case law; the goods are not indispensable to one another and, even if they were, consumers would not believe that the responsibility for them lies with the same undertaking. Finally, there is no meaningful competition between the goods as wheat

protein for animal food and animal feed preparations cannot be supplemented for animal food per se, and vice versa. In light of the above, I find that these goods are similar to a medium degree.

#### *Beverages for pets*

27. "Beverages for animals" is not identical to "foodstuff for animals" in class 31 of the first earlier mark as they differ in nature and method of use as one is for animals to drink and the other being for animals to eat. However, they overlap in intended purpose insofar as beverages for animals and foodstuff for animals are both products that nourish and sustain animal life. Trade channels will be the same as both goods will be sold in, for example, retail outlets such as pet stores and in the pet aisles of supermarkets. Although these are not likely to be on the same shelves, they are likely to be sold in close proximity to one another. Users would be the same as animal owners that purchase food for animals are also likely to purchase beverages for animals. The goods are not in competition as animal food will be unable to quench the thirst of animals. Neither are the goods complementary; although both are important to sustain animal life, animal food is not important or essential to animal beverages and vice versa. In light of this, I find that the goods are similar to a medium degree.

#### *Bedding materials for animals*

28. The nature, method of use and intended purpose of the applied-for goods are entirely dissimilar to that of "foodstuff for animals" in class 31 of the first earlier mark; one is eaten for the purpose of providing sustenance and the other is for animals to use when resting or sleeping. In my judgement, and without any evidence to the contrary, I do not consider it common for the same undertakings to produce both of these goods. Moreover, although I accept that there may be a degree of overlap in trade channels (to the extent that they may both be sold in pet stores), they will typically be found in different areas of those outlets. The goods are not competitive in nature as bedding is unable to satisfy the need for sustenance, and vice versa. Neither are the goods complementary as bedding materials are not indispensable or important to foodstuff for animals. Although users will be the same, i.e. animal owners, this is not enough to engage similarity. As a result, overall, I find that the goods are dissimilar.

### *Live animals*

29. Live animals would include both livestock and pets. The nature, method of use and intended purpose obviously differs to “foodstuff for animals” in class 31 of the first earlier mark as one is for the nourishment of animals whereas the other is the animal itself. The trade channels differ as a company producing foodstuff for animals would be unlikely to raise or sell them. However, I accept that in limited circumstances some pets (such as hamsters and guinea pigs) will be sold in the same outlets as animal foods, such as pet stores. Nevertheless, where this is the case, they are not sold in the same sections. Moreover, the majority of animals will not be sold at pet stores. Users would be the same given that owners of live animals would need to purchase food to keep them alive. The goods do not occupy competitive roles, nor are they complementary as although food is indispensable to live animals, consumers are unlikely to believe that they are offered by the same undertakings. Taking everything into account, I find that the goods are dissimilar.

30. For the avoidance of doubt, I have also considered the other goods and services relied upon across the specifications of the earlier marks and none puts the opponent in a more favourable position.

31. As some degree of similarity between the goods is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition must fail against goods of the application that I have found to be dissimilar, namely:<sup>4</sup>

Class 31: Bedding materials for animals; Live animals.

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

32. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion,

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<sup>4</sup> *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA  
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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: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

33. 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. (as he then was) 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.”

34. Due to the nature of the goods at issue in these proceedings, it is necessary to identify two groups of relevant consumers, namely, members of the general public that own animals and farmers or agricultural businesses.

35. Animal owning members of the general public are likely to purchase the goods rather frequently for their animals' everyday consumption. The goods are relatively inexpensive and, as such, I find that the purchasing process is likely to be more casual than careful; it will not require an overly considered thought process. However, when selecting the products, consumers will consider factors such as nutritional content, dietary requirements, quality and costs. Taking the above factors into account, I find that the general public will demonstrate an average level of attention in respect of these goods. The goods are typically sold in retail outlets, such as supermarkets, pet stores and their online equivalents. In such outlets, the goods will be displayed on shelves from which they will be self-selected by consumers. A similar process will apply to websites, where consumers will select the goods after viewing images and information displayed on a webpage. In the foregoing circumstances, visual

considerations would dominate, though I do not discount aural considerations entirely, as it is possible that consumers will have conversations with sales assistants or receive word of mouth recommendations.

36. As indicated above, the goods may also be purchased by farmers and agricultural business owners. For these consumers, the goods are likely to be frequent purchases for the ongoing operation of farming. The goods most likely will be bought in large quantities at a moderate expense, as such, I find that the purchasing process is likely to be more careful than casual. In addition to the factors considered by the general public during the selection process, these consumers will need to consider the suitability of the products in accordance with the specific farm and livestock requirements. Farmers will be mindful of producing the best quality livestock and by-products; due to this increased responsibility and liability, it is my view that consumers from the business community will demonstrate an above average level of attention when purchasing these goods. Businesses are likely to purchase the goods from agricultural distributors and wholesalers, as well as through online channels. In these circumstances, the goods are likely to be purchased after a visual inspection of the product, or after viewing information in brochures or on the internet. As such, the purchasing process will be largely visual in nature. However, businesses may also engage in discussions with salespersons about the products. Therefore, I do not discount aural considerations entirely.

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

37. The distinctive character of a trade mark can be measured only, first, by reference to the goods in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. 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. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Dictionary words which do not allude to the goods will be somewhere in between. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion, the more distinctive the earlier mark, the greater the likelihood of confusion.

39. Further, although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use (nor was it required to do so). Consequently, I have only the inherent position to consider.

40. The first earlier mark comprises the words “Real PeT FOOD company”, in green on a black rounded triangle. Within the earlier mark, the word “Real” is positioned at

the top in large, script typeface, followed by the words “PeT FOOD” below in slightly smaller, standardised font. Underneath this is the word “company” in smaller lettering. In my view, the words would be understood in combination as referring to either a company that offers pet food that does not contain any artificial ingredients or preservatives, or to an entity responsible for providing the pet food that is genuine, rather than an imitation or artificial. Therefore, the word “Real” is strongly allusive of the characteristics of the goods that the company is selling or the entity selling the goods. Consequently, the distinctive character predominantly lies in the words in combination. The black background device and particular fonts used also provide a contribution but will be seen as decorative, as will the green colour of the words. Overall, it is considered that the earlier mark possesses a relatively low degree of inherent distinctive character.

### **Comparison of the marks**

41. It is clear from *Sabel BV v. Puma AG*<sup>5</sup> that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. [...] 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.”

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

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<sup>5</sup> Case C-251/95, paragraph 23

due weight to any other features which are not negligible and therefore contribute to the overall impressions they create.

43. The respective trade marks are shown below:

First earlier mark	Contested mark
	

#### Overall impressions

44. The first earlier mark encompasses the words “Real PeT FOOD company”, in green on a black rounded triangle. Within the earlier mark, the word “Real” is positioned at the top in large, script typeface, followed by the words “PeT FOOD” underneath in slightly smaller, standardised front. Below this is the word “company” in smaller lettering. All four words, together, dominate the overall impression, but, due to the size and positioning I accept that the word “Real” might have slightly more impact. The black background device will be seen as decorative and will play a lesser role, as will the stylisation and the colour of the words. However, they still contribute to the overall impression.

45. The contested mark is also a figurative mark and consists of the word “REAL” in black, standardised font. At the end of the word “REAL” is a black dot or full stop. The overall impression of the mark predominantly lies in the word “REAL”, while the black dot/full stop provides a much smaller contribution.

### Visual comparison

46. The competing marks are visually similar as they share the identical word “Real/REAL”, albeit that the word is presented in different cases and fonts within the respective marks. This similarity appears at the beginning of the respective marks, a position which is generally considered to have more of an impact due to consumers in the UK reading from left to right.<sup>6</sup> The marks differ in length as the earlier mark contains three additional words “PeT FOOD company”. The earlier mark also contains a black rounded triangular background that is not present in the contested mark, though I remind myself that this decorative element plays a lesser role in the earlier mark. In addition, the contested mark includes a black dot/full stop at the end of the word element that is not duplicated within the earlier mark. The letter colouring also differs, green in the earlier mark and black in the contested mark. Taking into account the overall impressions, I find that the competing marks are visually similar to between a low and medium degree.

### Aural comparison

47. The contested mark consists of a single syllable i.e. “REAL”. Consumers will make no attempt to articulate the black dot/full stop at the end of the word element. The first earlier mark comprises six syllables i.e. “REAL-PET-FOOD-COM-PA-NEE”. The first syllables of the competing marks are identical. However, the earlier mark contains five additional syllables which are not replicated in the contested mark. Overall, I find that the marks are aurally similar to between a low and medium degree.

### Conceptual comparison

48. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>7</sup> In the contested mark, the word “REAL” would be perceived as meaning genuine or not fake. In relation to the goods, it is strongly

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<sup>6</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>7</sup> *Ruiz Picasso v OHIM* [2006] E.T.M.R 29.

allusive of the quality. For example, alluding to pet food which contains natural rather than artificial ingredients. Bearing in mind there is no rule that requires determination of a single meaning,<sup>8</sup> the word “Real” in the earlier mark could refer to the pet food itself, or the entity responsible for providing the pet food, i.e. a company that provides ‘real’ pet food or a ‘real’ company that provides pet food. As a result, there is an overlap in the concept of the word “REAL/Real” in relation to pet food, however, the earlier mark also provides a concept that is not replicated within the contested mark. Bearing in mind my assessment of the overall impressions, I find that the marks are similar to a medium degree.

### **Likelihood of confusion**

49. Whether there is a likelihood of confusion must be assessed globally, taking into account a number of factors. 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. It is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be aware of 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.

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

51. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C. (as he was then), as the Appointed Person, explained that:

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<sup>8</sup> *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496

“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.

17. 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).”

52. These examples are not exhaustive but provide helpful focus.

53. I have found that the applicant’s goods are identical or similar to at least a medium degree to those of the earlier mark. I have found that relevant consumers of the goods will include animal owning members of the general public and farmers/agricultural business owners. I have found that members of the general public that own animals would pay an average level of attention, whilst farmers/agricultural business consumers would pay an above average level of attention when selecting the goods. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations. The overall impression of the contested mark lies in the word “REAL”, whilst in the earlier mark, the combined wording dominates the overall impression. I have found that the earlier mark and the contested mark are visually and aurally similar to between a low and medium degree, and conceptually similar to a medium degree. I have also found that the earlier mark has a relatively low level of inherent distinctive character.

54. I acknowledge that the word “Real” has the most impact and appears at the beginning of the first earlier mark. I appreciate that this word is also replicated in the contested mark. However, I do not consider that the differences between the marks will be overlooked by consumers, given the additional words “PeT FOOD company” and the overall presentation of the earlier mark, i.e. the combination of the black rounded triangular background, green lettering and stylised font. As a result, it is unlikely that the marks will be misremembered upon a visual inspection, which is of heightened importance given that I have found the purchasing process to be predominantly visual in nature.<sup>9</sup> Aurally, the additional words within the earlier mark create an added point of difference. Furthermore, even though there is a conceptual overlap in the shared word “Real”, the earlier mark, when taken in combination, summons a concept related to the genuineness of the company that provides the goods, or a company that provides food made with only natural ingredients. In my

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<sup>9</sup> *Quelle AG v OHIM*, Case T-88/05

judgement, taking all the above factors into account, the differences between the marks are likely to be sufficient for consumers – even those paying no more than an average level of attention – to differentiate between the marks, even in relation to identical goods. It follows that, notwithstanding the principles of imperfect recollection and interdependency, there is no likelihood of direct confusion.

55. That leaves indirect confusion to be considered. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.<sup>10</sup>

56. Furthermore, in *Liverpool Gin*<sup>11</sup> Arnold LJ affirmed the position of Mr James Mellor Q.C (as he then was) sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16) that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion” and found that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

57. As explained above, consumers will recognise the common word “Real”. However, I do not believe that consumers will assume that the applicant and the opponent are economically linked undertakings on the basis of the competing trade marks merely because of the shared word “Real”. The word “Real” is not so strikingly distinctive that consumers would assume that only the opponent is using it in a trade mark. To the contrary, it is relatively low in distinctive character. The common word is strongly allusive of a characteristic of the goods or the entity responsible for providing these goods. Moreover, in my view, collectively, the differences between the competing marks are not conducive to any logical brand extensions; adding or removing all of these elements changes the entire ‘get up’ of the competing marks considerably. Furthermore, the earlier mark when viewed as a whole has a different conceptual meaning. Accordingly, consumers paying (at least) an average degree of attention would fail to see any link between the marks over and above the word “Real” which

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<sup>10</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

<sup>11</sup> *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 13



would be seen as coincidental and attributed to different undertakings merely using the same allusive messaging in relation to their goods. In my view, this remains the case even in relation to goods that are identical. Therefore, I find that there is no likelihood of indirect confusion.

### **Conclusion**

58. The opposition under section 5(2)(b) of the Act has failed. Subject to any appeal, the application will proceed to registration in the UK in respect of all the applied-for goods.

59. This decision has been reached on the basis of the first earlier mark only. As discussed above (paragraph 11), the only difference between the earlier marks is the use of greyscale/colour. Given that the services of the second earlier mark are less similar to the goods of the contested mark, it is not necessary to consider the opponent's reliance on it. The second earlier mark does not improve the opponent's position.

### **Costs**

60. The applicant has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Annex A of Tribunal Practice Notice 2 of 2016. Applying this guidance, I award the applicant the sum of **£200** for considering the notice of opposition and preparing a counterstatement.

61. Accordingly, I hereby order Real Pet Food Company Singapore Pte. Ltd. to pay Affinity Petcare, S.A. the sum of **£200**. This sum is to be paid within twenty-one days of the expiry of the appeal period, or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17<sup>th</sup> day of January 2023**

**Sarah Wallace  
For the Registrar**