

O-414-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO 2 489 747 IN THE  
NAME OF ORGANIPETS LIMITED TO REGISTER IN CLASSES 03, 18, 28 AND  
31 THE SERIES OF TRADE MARKS: Organipets, OrganiPets, ORGANIPETS**

**AND**

**OPPOSITION THERETO UNDER NO 98 664  
BY THE ORGANIC PET FOOD COMPANY**

## TRADE MARKS ACT 1994

In the matter of trade mark application NO 2 489 747 in the name of Organipets Limited to register in classes 03, 18, 28 AND 31 the series of trade marks: Organipets, OrganiPets, ORGANIPETS

and

Opposition thereto under NO 98 664  
By The Organic Pet Food Company

### Background and Pleadings

1. Organipets Limited (the applicant) applied to register the series of trade marks Organipets (as shown above) on 11<sup>th</sup> June 2008. The application was published in the Trade Marks Journal on 31<sup>st</sup> October 2008 in respect of the following goods:

Class 03:

*Shampoo; medicated shampoo; soaps; perfumery; hair lotions; cosmetics; all the aforesaid goods being organic and being for use on animals.*

Class 18:

*Leads, leashes and collars for animals.*

Class 28:

*Toys for pet animals.*

Class 31:

*Food and foodstuffs for animals; non-medicated supplements for food and foodstuffs for animals; nutritional supplements for food and foodstuffs for animals; pet food; dog biscuits; edible treats for animals; edible chews for animals; ingredients for the aforesaid goods; animal litter; all the aforesaid goods being organic.*

2. The Organic Pet Food Company Limited (the opponent) oppose the registration of the applicants trade mark on the basis of several grounds of opposition under the Trade Marks Act 1994 ("the Act). Firstly, on the basis of Section 3(1)(c) in that the applicant's trade mark is descriptive of the kind, quality and/or nature of the goods to which it relates. Secondly, under Section



5(2)(b) of the act on the basis of its earlier trade marks, in respect of *organic foodstuffs for animals* in class 31 (United Kingdom trade mark No 2 463 459) and leather and imitations of leather in class 18 (Community trade mark No 6 305 221). In this regard the opponent argues that the marks are similar, the goods are identical and/or similar and so there is a likelihood of

confusion. Further, that there have been instances of confusion between the respective trade marks. Finally, under Section 5(4)(a) of the Act based upon the earlier trade marks as shown above, ORGANIC PET, THE ORGANIC PET, The Organic Pet Food Co Limited and [www.theorganicpet.co.uk](http://www.theorganicpet.co.uk) in respect of *the sale of organic products for dogs and cats, in particular the sale of organic food for pets*. Specifically, the opponent claims that it has acquired goodwill in its business associated with the aforementioned names and that use of the applicant's trade mark will cause confusion which will be damaging to the opponent's business.

3. The applicants filed a counterstatement, denying the grounds of opposition. It argues that the trade mark applied for is distinctive and has also become distinctive through use; that they have use and their own registrations of the "organipets" trade mark made prior to the earlier registered trade marks relied upon and finally, that they have common law rights from before the opponents used its mark. Evidence was filed by both sides and no hearing was requested. I therefore make this decision based upon a careful reading of the papers.

### **The Opponent's evidence**

4. This is comprised of a witness statement, dated 28<sup>th</sup> October 2009, from Rozanne Gallon, a Director of the opponent company. It contains a mixture of evidence and submissions. The following relevant points are contained therein:
  - The trade mark applied for is a fairly obvious combination of the words "organic" and "pet" indicating that the products are for pets and are organic. As such, it is openly descriptive and offends against Section 3(1)(c) of the Act. In the alternative, it is heavily suggestive of such products and this is, according to Ms Gallon, supported by exhibit RG1 which is copies of the applicant's website regarding the supply of organic pet products.
  - The class 03, 18 and 31 specifications filed by the applicant are identical to those contained within the opponent's trade marks. The class 28 specification applied for is similar.
  - A proper comparison between the marks should focus on the words "organic pet" and "organipets", which are visually, phonetically and conceptually similar, the result being a likelihood of confusion. The paw device in the opponent's trade marks is used throughout the pet industry as supported by exhibit RG3. The same arguments apply to the element "the" in the opponent's marks which is a standard linguistic marker.
  - There have been instances of confusion between the respective trade marks as complained of by the applicant on previous occasions. Exhibits RG4 and 5 are presented in support which is allegedly evidence produced by the applicant during the ongoing dispute between the parties and which contain emails from prospective customers following an article regarding organipets in the national press and also correspondence in respect of a notable retailer in respect of the respective trade marks.
  - Ms Gallon explains that her trade marks were first used in the UK in May 2007 and which has expanded rapidly since. In 2008, the opponent's were one of

the finalists in the HSBC “Start Up Stars” competition, designed to recognise and award businesses which have developed rapidly from start-ups into successful, established businesses. The competition was co-sponsored by Sky News and the Daily Express newspaper and recognition of this is displayed on the opponent’s website, as supported by exhibit RG7. The business currently supplies to Waitrose and a number of large retailers, independents, vet practices and private customers. Approximate turnover is £22,000 from 2007-2008; £110,000 from 2008-2009. Exhibit RG8 are examples of the marketing and advertising materials produced. These include copies of labels, product packaging, advertisements and press and PR articles. Further, the opponent’s claim to take stands at most leading dog and cat shows, though this is not supported in evidence.

### **The applicant’s evidence**

5. This is a witness statement, dated 17<sup>th</sup> February 2010, from Rebecca Dobson, a trade mark associate with Chapman Molony, the applicant’s representatives in these proceedings. She describes an internet search, performed on 3<sup>rd</sup> February 2010 for the term “organic pet food”, the results of which are shown at exhibit RD1. The relevance of this is not explained, but I note that it demonstrates that organic pet products exist.
6. The applicant has also filed submissions during its evidence round, which though they have been fully taken into account, I will not summarise here. Rather I will refer to them as and when necessary during my decision.
7. I should comment that in its counterstatement, the applicants claimed to have been using its marks and related rights prior to any relied upon by the opponent in these proceedings. This has also been claimed during its submissions. However, this is a bare assertion which is not supported by any evidence, be it witness statements or otherwise.

## **DECISION**

### **Descriptiveness of trade mark application – Section 3(1)(c) of the Act**

#### **The law**

8. Section 3(1) (c) of the Act reads:

“3. -(1) The following shall not be registered –

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.

9. The relevant date at which the assessment as to whether any, or all, the grounds of objection is, or are, made out is the date of application for the trade mark under attack, being 11<sup>th</sup> June 2008.
10. There are now a number of judgments from the Court of Justice of the European Union (CJEU) which deal with the scope of Article 3(1) (c) of First Council Directive 89/104 (recoded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1) (c) of the Community Trade Mark Regulation (“the CTMR”), whose provisions correspond to Section 3(1) (c) of the UK Act. The following main guiding principles, relevant to this case, are noted below:

-subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark – *Wm Wrigley Jr & Company v OHIM* – Case 191/01P (*Doublemint*) paragraph 30;

-thus, Article 7(1)(c) (Section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all – *Wm Wrigley Jr v OHIM*, paragraph 31;

-Section 3(1) (c) of the Act excludes signs which may serve, in trade, to designate the kind of goods or other characteristics of goods. It follows that in order to decide this issue it must first be determined whether the mark designates a characteristic of the goods in question;

-it is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods or services in question. It is sufficient that it could be used for such purposes – *Wm Wrigley Jr v OHIM*, paragraph 32;

-to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for – *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04 at paragraph 24;

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### **Preliminary remarks**

11. The opponent relies upon evidence from the applicant’s website showing that the products sold were organic. It argues that this supports its position as regards Section 3(1)(c). I cannot see how this evidence is supportive, as in any case the specification of goods applied for clearly states that the products

are organic. The evidence to my mind therefore does not add anything to the opponent's cause.

12. The question then arises as to whether "ORGANIPETS", is, or was in 2008, capable of 'designating a characteristic' of the products for which it is applied for. The opponent argues that it is a fairly obvious combination of the words "organic" and "pets" which convey the message to the relevant consumer, that the products are aimed at pets and made from organic ingredients. In order to reach a finding, I must consider the matter from the perspective of the relevant consumer in respect of these products. To my mind, the opponents best case rests upon those goods for which it is widely accepted can be organically produced or which contain organic ingredients, namely the cosmetic goods in class 03 and foodstuffs (and related products) in class 31. If the opponent does not succeed in respect of these goods, it is unlikely to succeed in respect of the remaining items applied for, for which it is less clear that an organic status would be expected by the consumer, or indeed that it would be desirable. The relevant consumer for such items is the general public who own pets. What level of attention is expected to be displayed? To my mind, there will be a range. In respect of foodstuffs, these are everyday items and are likely to be purchased frequently and so in respect of such items, the level of attention may well be fairly low, though this can be tempered by pets who are in a particular age group or who have a particular condition and so for whom, specialist food may be desired potentially leading to a higher degree of attention being displayed. I consider that the same rationale applies to the applied for goods in class 03, fairly low but with potential for higher in the event that the animal requires more specialist products. On the whole, I would expect the pet owning public to display a low to medium degree of attention.
13. In considering the matter from the viewpoint of the goods in question, namely a variety of pet products and from the perspective of the pet owning public, I note that the element ORGANI is likely to be understood as referring to and meaning organic. In respect of foodstuffs and cosmetic products for animals, the word Organic is clearly descriptive. Likewise, the element PETS is descriptive as these products are designed for pets. However, the mark applied for is not these separated elements, each of which is descriptive. Rather it is the combination ORGANIPETS. To my mind, this combination of elements alters matters in that the combination as a whole, although arguably strongly evocative is not directly descriptive. I would be left with the question: what are "organipets" and how would the combination really be understood? When one considers the meaning of the combination, it literally conveys the idea of domestic animals, being themselves organic in some way or created or produced organically. Moving away from the literal meaning, I accept that the combination is allusive, perhaps strongly so. However, in my view, on balance it is more than the sum of its parts and the manner in which it will be understood is therefore a step away from directly describing any of the goods in question. I conclude therefore that the combination ORGANIPETS is not descriptive of the kind, quality or nature of the goods applied for and so is acceptable under Section 3(1)(c) of the Act as it has at least some degree of distinctiveness. This ground of opposition therefore fails.

## The proof of use provisions

14. The contested trade mark was published on 31<sup>st</sup> October 2008. The earlier trade marks were registered on 8<sup>th</sup> February 2008 and 13<sup>th</sup> August 2010 (the latter with a filing/priority date of 7<sup>th</sup> August 2007) respectively. As a five period has not elapsed prior to the publication of the contested trade mark, the proof of use provisions do not apply. I must therefore make a notional assessment based on the earlier specification of goods and services as they are registered.

## Likelihood of confusion – Section 5(2)(b) of the Act.

15. The relevant parts of section 5 of the Act read as follows:

(2) A trade mark shall not be registered if because –

(a) .....

(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.

16. In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

## **Comparison of the goods**

17. When making the comparison, all relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:



“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

18. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

19. The earlier goods are:

**Class 18:**

*Leather and imitations of leather*

**Class 31:**

*Organic foodstuffs for animals.*

The contested goods are:

**Class 03:**

*Shampoo; medicated shampoo; soaps; perfumery; hair lotions; cosmetics; all the aforesaid goods being organic and being for use on animals.*

**Class 18:**

*Leads, leashes and collars for animals.*

**Class 28:**

*Toys for pet animals.*

**Class 31:**

*Food and foodstuffs for animals; non-medicated supplements for food and foodstuffs for animals; nutritional supplements for food and foodstuffs for animals; pet food; dog biscuits; edible treats for animals; edible chews for animals; ingredients for the aforesaid goods; animal litter; all the aforesaid goods being organic.*

**Comparison of goods in class 03:**

20. The contested goods are those which clean animals, enable them to smell pleasant or are otherwise for cosmetic use. This is entirely different in nature and purpose to any of the earlier goods. Further, there is no complementary relationship between them nor are they in competition with one another. However, the users and distribution channels are likely to coincide as all will be aimed at pet owners and be sold via the same channels of trade, be it a pet shop, a specialist website or a specified area of a supermarket. For this reason, there is a degree of similarity between them. However, in the absence of any intrinsic similarity between these goods, I assess the degree of similarity as being very low.

**Comparison of goods in class 18:**

21. The earlier goods are the raw materials leather and imitations of leather which can be used to produce a wide range of products. The contested goods are leads, leashes and collars for animals which are used to manage, control and identify an animal and can be produced from the earlier materials. However, the contested goods are the end products, which have undertaken a particular process and/or transformation from the raw material into an end product. Though they may therefore coincide in nature as leads, collars etc can be made from leather and imitations thereof, their respective purposes are quite different. Further, the end users will differ in that the earlier goods will be aimed at manufacturers of end products where as the contested goods are the end products and are aimed at pet owners. By extension, the distribution channels will also differ. They are dissimilar.
22. In respect of the remaining earlier goods, namely organic foodstuffs for animals, these contested goods are entirely different in nature and purpose and there is no complementary or competitive relationship. As above however, it is likely that the users and distribution channels will coincide. They are similar, albeit to a very low degree.

**Comparison of goods in class 28:**

23. The contested goods are those which seek to exercise, stimulate and entertain animals. They wholly differ in nature and purpose to any of the earlier goods and are neither complementary nor competitive. Again, they will coincide in end user and distribution channels. They are also, therefore, considered to be very lowly similar.

**Comparison of goods in class 31:**


24. The earlier goods are organic foodstuffs for animals. Likewise, the contested goods, with the exception of animal litter, are all either foodstuffs, supplements to be used as foodstuffs or ingredients for foodstuffs, all in respect of animals. It is clear that these goods are identical.

25. The purpose of the contested animal litter is to act as an absorbent for animal waste to enable convenient and effective disposal and to control odour. It is often composed of clay, paper or wood shavings. It is entirely different in nature and purpose to any of the earlier goods. Further, they are neither complementary nor competitive. As above, it is true that the users of foodstuffs for animals and animal litter will coincide as will the distribution channels. They are similar to a very low degree.

**Comparison of the marks**

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

27. The respective trade marks are shown below:

	Organipets OrganiPets ORGANIPETS
Earlier trade marks	Contested trade mark

28. The earlier trade mark is a figurative trade mark, including the verbal element “the organic pet” (the words “organic pet” appearing in a stylised script) and

the device of a paw print. The contested series of trade marks (“the contested trade mark”) is a word mark. They coincide in that each contains the letters “organi” and “pet”. They differ in respect of the device element of the contested trade mark, the other stylised features, namely the typeface of the verbal element employed in the earlier trade mark and the additional word “the”, which have no counterpart in the contested trade mark. The contested trade mark also includes the plural “pets” rather than “pet” in the earlier sign. As such, I consider them to have to have important differences visually and so though they are similar, this is to a low degree.

29. Aurally, the marks coincide in respect of the same letters as already described. However, in my view there is a difference in impact from that considered as part of the visual perspective. The differences, namely the additional word “the” in the earlier trade mark and the plural pets and the missing letter “c” in the contested trade mark have some aural impact. However, this is limited, due to the coincidence in the majority of the letters and respective syllables of the signs. There is a high degree of aural similarity.
30. Conceptually, the earlier sign will be understood as referring to a singular domestic animal that is organic in some way. The contested trade mark is highly likely to be understood in the same manner, albeit in respect of more than one animal. However, nothing turns on this point and I consider them to be conceptually identical.

### **Distinctive and dominant components**

31. I have already found the contested trade mark to be distinctive for the goods in question.
32. The contested trade mark has no dominant component and will be appreciated instantly as a complete whole. The most dominant component of the earlier sign is clearly the paw print device, though bearing in mind the nature of the goods in question, namely those aimed at pets, the paw print is very low in distinctive character. As regards dominance, I note however that the verbal elements The Organic Pet are also clearly visible within the sign.
33. The applicant argues that the verbal elements of the earlier sign are non-distinctive for the goods in question as they are descriptive. This is a similar (because the contested trade mark mark is ORGANI & PETS) argument to that proposed by the opponent in respect of the trade mark applied for and which has already been considered and dismissed above. I am of the view that the same rationale applies in respect of the earlier trade mark as I have already found them to be conceptually identical. Having decided in this manner, I must also fully consider the degree of distinctiveness of the earlier trade mark as the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

34. In order to assess the degree of distinctiveness, I must also consider the impact of the use of the mark made by the opponent. I consider that the evidence, though it demonstrates that there has been trade under the earlier trade marks, does not provide any supported information on the extent of such use. The material that has been submitted does not provide any indication as regards the degree of recognition of the trade mark among the relevant public. Furthermore, there are only unsupported indications concerning the volume of sales, no indications as regards the market share of the trade mark and only limited indications on the extent to which it has been promoted. As a result the evidence does not show that the trade mark is known by a significant part of the relevant public. As such, the evidence does not demonstrate that the earlier trade marks have an enhanced degree of distinctive character. To my mind, though the earlier trade mark is not directly descriptive of the goods for which it is protected and so has a degree of distinctiveness, it is strongly allusive, at least in respect of organic foodstuffs for animals. The paw print present does not help its cause. This allusiveness is such that although I cannot find it to be totally devoid of distinctive character, I consider the mark to only possess a low degree of distinctive character. The impact of this will be considered further below in the global assessment.
35. The sum of all this is that though the marks have important visual differences, they remain highly similar aurally and are conceptually identical. Based on the aural similarity and conceptual identity, and taking account of the lower level of visual similarity, I conclude therefore, that overall the marks are similar to a relatively high degree.

### **The average consumer**

36. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter- Ikea Systems BV v OHIM* (Case T-112/06)).
37. I have already made a number of findings as regards the average consumer above. In essence, I consider them to be the public at large who are pet owners displaying a low to medium degree of attention.

## **Global Assessment – Conclusions on Section 5(2)(b)**

38. Some of the contested goods, namely the majority of those in class 31 have been found to be identical. The earlier trade mark has been found, at least in respect of the class 31 goods, to be lowly distinctive. However, this is only one factor which I must consider in the round. In these proceedings, the marks are relatively highly similar overall. Further, they are to be applied to identical goods in class 31. Bearing these facts in mind, I consider it likely that there will be confusion, both in respect of the relevant public mistaking one trade mark for the other and in believing them to be economically linked.
39. The remaining goods have been found to be only similar to a very low degree. Further, the marks are not identical as there are important visual differences and the earlier trade mark has only a low degree of distinctive character. To my mind, for the very low degree of similarity of goods to be effectively counteracted and for confusion to then be likely, either the marks would need to be identical or so highly similar as to be almost identical or the earlier trade mark would need to have acquired an enhanced distinctive character. Neither is present in this case and this absence, in my view, weighs against there being a likelihood of confusion. The opposition under section 5(2)(b) therefore fails, except in respect of the following goods:

*Food and foodstuffs for animals; non-medicated supplements for food and foodstuffs for animals; nutritional supplements for food and foodstuffs for animals; pet food; dog biscuits; edible treats for animals; edible chews for animals; ingredients for the aforesaid goods*

## **Final Remarks**

40. I note that the opponent has also filed evidence in respect of actual instances of confusion between the respective trade marks. This is purported to be from the applicant though the context in which the evidence was produced is unclear. The applicant, on its part, argues that the materials are not relevant to these proceedings. In any case, evidence of actual confusion is not required (though can, in certain circumstances, be helpful) to succeed under Section 5(2)(b) as the matter to be considered is a notional assessment, based upon whether or not confusion is likely to occur. Further, the opponent is not under any obligation provide evidence of actual confusion and indeed, the absence of such evidence has no impact on the notional assessment made under Section 5(2)(b) of the Act. The point of including these comments is to emphasise that though the evidence filed by the opponent is supportive of the conclusion I have reached above, it has not been definitive in enabling me to reach the said conclusion. In the event that the evidence had not been included, the similarity of the marks, together with the identical nature of the class 31 goods, would in any case, have led me to conclude that confusion was likely if the marks are used in relation to foodstuffs for animals.

41. As the opponent has not been totally successful under Section 5(2)(b), I will go on to consider its claim under Section 5(4)(a) of the Act as the basis of the claim differs, at least in respect of the comparison of goods and services. Further, bearing in mind the success the opponent has achieved under Section 5(2)(b), I will consider the claim only in respect of the other goods which have already been found to be only lowly similar.

### **Passing off - Section 5(4)(a)**

42. Section 5(4)(a) reads as follows:

“5.-(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, or

(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”.

43. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponent’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponent; and

(3) that the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.


### **The Relevant Date**

44. The relevant date for determining the opponent’s claim will be the filing date of the application in suit (*Last Minute Network Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Joined Cases T-114/07 and T-115). The earlier right must have been acquired prior to that date (Article 4.4(b) of First Council Directive 89/104 on which the UK Act is based). The relevant date in date in these proceedings therefore, is 11<sup>th</sup> June 2008.

## Goodwill

45. I note that in the notice of opposition, the opponents claim that the earlier



trade mark , THE ORGANIC PET, The Organic Pet Food Co Limited and [www.theorganicpet.co.uk](http://www.theorganicpet.co.uk) attract a protectable goodwill in respect of the following goods: *the sale of organic products for dogs and cats, in particular the sale of organic food for pets*. In order to make an assessment of whether or not goodwill exists in such activities, I must be in possession of sufficient information to reach an informed conclusion. I also bear in mind that there are three elements (often referred to as “the classic trinity”) to consider in a claim for passing-off, namely: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position quite succinctly when he stated:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labeling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff... Thirdly he must demonstrate that he suffers, or in a quia timet action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

46. In relation to goodwill, this was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

“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.”



47. It is also worth noting that to qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature<sup>1</sup>. However, being a small player does not prevent the law of passing-off from being relied upon as it can be used to protect a more limited goodwill<sup>2</sup>.
48. In considering the opponent's evidence, I note that much of the evidence relates to the goods themselves, namely organic pet foods and snacks. There is also evidence in articles relating to the supply of products to supermarkets such as Waitrose and Sainsbury's (dated 2007). There is further evidence demonstrating that food products were offered for sale by the opponents at events such as Crufts in 2008, where the opponent's stand number are also specifically mentioned. In addition, there is advertisement evidence from events such as "Discover Dogs" in 2007 and 2008 in respect of food items (in this example, dog biscuits) together with information as to how the product can be purchased (on line, by telephone etc). The opponent's stand number at the 2008 event is also mentioned. Other advertisements in "Independent Lifestyle" Magazine in 2008 are in respect of the sale of food products. There is also an article in a local newspaper, The Harron Observer, which confirms that as well as supplying Waitrose and Sainsbury's with products, the opponent commenced selling via their own website in September 2008.
49. Bearing in mind all of the above, I am persuaded that at the relevant date, the opponent had acquired a goodwill in their business. However, I note that the evidence does not support this finding in respect of all the goods claimed. By this I mean that the evidence demonstrates goodwill only in respect of the sale of organic food products for pets and not, crucially, organic pet products at large. Bearing in mind the nature of the business to which the goodwill here attaches, I fail to see how the opponents are in any better position under Section 5(4)(a) than they are under Section 5(2)(b). Even if additional denominations are relied upon, the essence of them all remains "the organic pet". For the same reasons that there would be no confusion under section 5(2)(b), there is also no misrepresentation under Section 5(4)(a). The opposition therefore fails to the same extent that it failed under Section 5(2)(b). This means that the application may proceed for:

**Class 03:**

*Shampoo; medicated shampoo; soaps; perfumery; hair lotions; cosmetics; all the aforesaid goods being organic and being for use on animals.*

**Class 18:**

*Leads, leashes and collars for animals.*

**Class 28:**

*Toys for pet animals.*

**Class 31:**

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<sup>1</sup> *Hart v Relentless Records* [2002] E.W.H.C. 1984

<sup>2</sup> See, for instance, *Stannard v Reay* [1967] F.S.R. 140, *Teleworks v Telework Group* [2002] R.P.C. and *Stacey v 2020 Communications* [1991] F.S.R. 49).

*Animal litter; being organic.*

## **COSTS**

50. In these proceedings, both the opponents and applicants have achieved a measure of success. I order therefore, that each party should bear its own costs

**Dated this 23rd day of November 2011**

**Louise White  
For the Registrar,  
The Comptroller-General**