

O-247-13

**SUPPLEMENTARY DECISION**

**TRADE MARKS ACT 1994**


**IN THE MATTER OF TRADE MARK APPLICATION 2556916  
BY INTERPET LIMITED TO REGISTER THE FOLLOWING TRADE MARK IN  
CLASSES 3, 5, 10, 16, 18, 20, 21 & 28:**

**MIKKI**

**AND**

**OPPOSITION THERETO (NO 101336) BY MICKI LEKSAKER AB**

1) On 8 February 2013 I issued a substantive decision in these proceedings upholding under section 5(2)(b) an opposition by Micki Leksaker AB (“ML”) against the registration of a trade mark (application no. 2556916) filed by Interpet Limited (“Interpet”); a further ground under section 5(4)(a) was dismissed. The opposition was directed only at the goods in class 28 of the application. In summary, my findings under section 5(2)(b) were that:

- i) The two earlier marks relied on by ML ( & MICKI), both of which were subject to the proof of use conditions, met the use conditions in respect of “children’s games and playthings”.
- ii) That the mark Interpet had applied for (MIKKI) was similar to a reasonably high level to the earlier MICKI mark (which I considered to represent ML’s best case).
- iii) That the goods (toys for domestic pets on the one hand, and children’s games and playthings on the other) were moderately similar to the extent that certain toys for domestic pets may have human type counterparts; for any goods which did not have a human type counterpart then any similarity would be of only a very low degree.
- iv) That weighing all the relevant factors, there was a likelihood of confusion in respect of the moderately similar goods described above, but no likelihood of confusion in relation to anything else.

2) Due to Interpet’s specification containing within its ambit the goods for which I considered there to be a likelihood of confusion, I invited Interpet to file a revised specification. I dealt with the matter thus:

**“Revised specification**

59) I have identified that the broad term of the applied for mark includes some goods which will lead to a likelihood of confusion but some goods which will not. In the circumstances, I invite Interpet to file a revised specification and accompanying submissions detailing any types of goods it wishes to register that:

- a) Fall within the ambit of “toys for domestic pets”;
- b) Fall within the scope of this decision in that the goods so specified have no human/children’s counterpart;
- c) Do not fall foul of the guidance issued by the CJEU in the *Postkantoor* decision;
- d) If the specified goods are exemplified in the evidence, a reference to that appropriate part of the evidence be made.

60) Interpet's written submissions should explain why it considers the terms to be within the scope of my decision. A period of 14 days from the date of this decision is permitted for such action. Upon receipt of the above, ML will be allowed 14 days to comment on any proposed terms and I will then issue a supplementary decision in which I will decide whether any proposed terms are free from objection. If Interpet puts forward no revised terms then I will issue a supplementary decision confirming the outcome as it stands in paragraphs 50 above. In the supplementary decision I will also issue my decision on costs. The appeal period for the substantive and supplementary decisions will run from the date of the supplementary decision."

3) Interpet provided a number of terms for consideration. It stressed that these terms were not being provided as a formal request to amend the application but a proposal for an alternative list of goods for consideration; presumably, this is in order to maintain its full specification in case of appeal. The terms identified were:

- i) Solid chew toys (these cannot be squeaky toys in the absence of an internal void), being toys for domestic pets;
- ii) Animal chew toys, including such toys in abstract shapes and in the shape of sticks, wheels, bones and stars, all being toys for domestic pets;
- iii) Chewing toys with handles, being toys for domestic pets;
- iv) Animal throwing toys, including such toys in abstract shapes and in the shape of sticks, wheels, bones and stars, all being toys for domestic pets;
- v) Throwing toys with handles, being toys for domestic pets;
- vi) Toy throwing sticks, being toys for domestic pets;
- vii) Toy dumbbells, being toys for domestic pets;
- viii) Toy bones, being toys for domestic pets;
- ix) Filled canvas bag toys, being toys for domestic pets;
- x) Rope toys, being toys for domestic pets;
- xi) Toys containing voids for edible treats, being toys for domestic pets;
- xii) Toys for pet birds;
- xiii) Toys for pet rodents.

4) In response, ML accepted that items xi)-xiii) satisfied the requirements I had given, but everything else did not. I will therefore consider in this supplementary decision whether terms i) – x) meet the requirements and whether, ultimately, they are free from objection to the extent that there would be no likelihood of confusion.

5) In terms of the parties' submissions, Interpet submits that all of the goods it has specified fall within the ambit of toys for domestic pets and that they do not fall foul of the *Postkantoor* decision because they do not exclude a particular characteristic. It adds that the requirement to only list goods with no human counterpart is a difficult one, bearing in mind that neither side's evidence really addressed this point and that the only items mentioned at the hearing, by way of example, were products such as flying discs, balls and squeaky toys. Also highlighted was Exhibit IL9 of Ms Hoskins' evidence which illustrates the nature of certain pet toys, evidence which I have borne in mind in the findings I come on to make. ML submits that adding the word "animal" to the front of an item description does not mean that there is no human type counterpart. It does not agree with what Interpet submitted in that the onus is on it to prove that a human type counterpart exists, but, nevertheless, in its submissions it provides material showing the existence of chewing toys for babies (e.g. teething), a toy dumbbell sold by Amazon, a reference to canvas filled bags sold by Turner Sports and a description of a Bulgarian bag (something which I would describe as a sporting/fitness article).

6) Before coming on to the specifics, I should outline my approach. The question of similarity and any evidence relating thereto could and should have been filed during the evidence rounds which have already taken place. I do not intend to re-open the matter now. In my decision I gave an example of a product (flying discs) that could, self-evidently, be very similar in nature, purpose, method of use etc, regardless of whether it was a children's toy or a toy for a pet. It is this counterpart type use which gives rise to the level of similarity described in my decision. If there is nothing in the evidence which illustrates that the goods now specified have a human type counterpart, and if there is nothing which self-evidently and obviously has a human counterpart, then the term will be considered free from objection. This is, of course, subject to the term itself having sufficient clarity and precision. In terms of the materials submitted with ML's submissions, although this could be considered as fresh evidence (although it has not, of course, been provided in proper evidential form) I will not rule it out for the following reasons: i) the type of products are (mainly) ones which could simply have been submitted exist as a notorious fact i.e. of which I could have taken judicial notice; there is nothing unusual in the existence of a toy dumbbell, a filled canvas bag, teething type toys for babies, ii) the Bulgarian bag (the existence of which is not an obvious fact) does not assist as the product is a sporting article not a children's game or plaything. I will now consider the items in question:

- i) *Solid chew toys (these cannot be squeaky toys in the absence of an internal void), being toys for domestic pets; animal chew toys, including such toys in abstract shapes and in the shape of sticks, wheels, bones and stars, all being toys for domestic pets; chewing toys with handles, being toys for domestic pets* – whilst ML highlighted the existence of teething type products for babies, in reality these do not strike me as an equivalent of the terms specified. I consider these terms to be free from objection.
- ii) *Animal throwing toys, including such toys in abstract shapes and in the shape of sticks, wheels, bones and stars, all being toys for domestic pets* – as defined, such goods would include the very thing that I exemplified in my decision to illustrate where counterpart products could obviously exist, namely flying discs. In terms of children’s toys that are thrown, there are obvious examples such as balls and flying discs. However, a wheel-like or star-like throwing toy (which this term goes on to specify) could easily be a flying disc type product. Furthermore, calling something abstract shaped merely masks what they are, and, furthermore, there could be counterparts in the human world. The only part of this term I am willing to say is free from objection would be *animal throwing toys in the shape of sticks and bones, all being toys for domestic pets*.
- iii) *Throwing toys with handles, being toys for domestic pets* – having a handle incorporated into some form of throwing toy strikes me as a feature of a pet toy only, presumably to launch the item afar for the animal to fetch. There is nothing obviously equivalent in terms of the human world. I consider this term to be free from objection.
- iv) *Toy throwing sticks, being toys for domestic pets* – one does not normally throw a stick for a child, toy or otherwise. I consider this term to be free from objection.
- v) *Toy dumbbells, being toys for domestic pets* – whilst it is possible (as the material attached to ML’s submissions highlights) for a children’s dumbbell toy to exist, this does not reflect the reality of the comparison. A children’s toy dumbbell will be a mock weightlifting type product whereas a toy dumbbell for a pet will be quite different, likely a rubber based chewable product. This term is free from objection.
- vi) *Toy bones, being toys for domestic pets* – whilst it is not beyond the bounds of possibility for a bone shaped toy to be created for a child, there is no obvious or self-evident human counterpart. This term is free from objection.

vii) *Filled canvas bag toys, being toys for domestic pets* – it is quite possible, and fairly obvious, that filled canvas bags can be sold for pets or children, whether they are simply bag shaped or whether they are shaped like something else. This term is not free from objection.

viii) *Rope toys, being toys for domestic pets* – Such toys are one of the most obvious things to buy for a pet (usually a pet dog). They are used for pulling upon or throwing so as to be fetched. I see no obvious human counterpart. I consider this term to be free from objection.

7) In view of the above findings, the opposition succeeds in relation to the specification as filed in class 28, and also in respect of the revised list of goods, save for:

*Solid chew toys, being toys for domestic pets; animal chew toys, including such toys in abstract shapes and in the shape of sticks, wheels, bones and stars, all being toys for domestic pets; chewing toys with handles, being toys for domestic pets; animal throwing toys in the shape of sticks and bones, all being toys for domestic pets; throwing toys with handles, being toys for domestic pets; toy throwing sticks, being toys for domestic pets; toy dumbbells, being toys for domestic pets; toy bones, being toys for domestic pets; rope toys, being toys for domestic pets; toys containing voids for edible treats, being toys for domestic pets; toys for pet birds; toys for pet rodents*

8) Subject to appeal, the application should proceed to registration in respect of the above, and also in respect of the unopposed goods in classes 3, 5, 10, 16, 18, 20 & 21.

9) That then leaves the matter of costs. I consider the above to be a balanced outcome. I do not propose to favour either party with an award of costs.

**Dated this 12th day of June 2013**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**