

O-182-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3267041
BY PAUL LEVINE TO REGISTER:**

The Inner Wolf

AND

The Inner Wolf Dog Education Centre

(SERIES OF TWO)

AS TRADE MARKS IN CLASS 41

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 411698 BY ROBERT DAWES**

BACKGROUND & PLEADINGS

1. On 30 October 2017, Paul Levine (“the applicant”) applied to register the above trade mark series for the following services:

Class 41: *Advisory services relating to training; Animal training*

The application was published for opposition purposes on 17 November 2017.

2. On 19 February 2018, the application was opposed in full by Robert Dawes (“the opponent”). The opposition is based on sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the following trade mark:

United Kingdom Trade Mark (“UKTM”) 3094278:

Inner Wolf

Filing date: 13 February 2015

Registration date: 8 May 2015

In his Notice of Opposition¹, the opponent indicates that he relies upon all goods and services for which his mark is registered, namely:

Class 31: *Animal beverages; Mixed animal feed; Synthetic animal feed; Animal feedstuffs; Animal feed preparations; Animal feeds; Pet beverages; Foodstuffs for pet animals; Pet animals; Pet food for dogs; Pet foods; Pet foods in the form of chews; Pet foodstuffs; Pet food; Foodstuffs for pet animals; Edible pet treats; Food (Pet -).*

Class 44: *Advisory services relating to the care of pet animals; Care of pet animals; Grooming salon services for pet animals; Pet grooming services; Grooming (Pet -); Pet grooming.*

¹ Question 1 of the form TM7 asks: “Which goods or services covered by the earlier trade mark are relied upon for the opposition?”

3. Explaining the basis for the opposition, the opponent states that:

“... ‘The Inner Wolf Dog Education Centre’ was brought to my attention as branding ‘Inner Wolf’ in their business operations – In a business category that we operate in.”

When asked by the applicant’s business owner whether it could continue to use the adopted name on account of the distance between the respective businesses, the opponent explained that he took issue against this as:

“... potentially I may want to grow my business into a national franchise, and also having more than one Inner Wolf would be very confusing”.

4. The applicant filed a counterstatement in which it denies, inter alia, that the respective trade marks are identical, that the parties operate in the same business category or that the competing goods and services are identical or indeed similar. It ultimately denies that there exists a likelihood of confusion on the part of the public.

5. The applicant in these proceedings is currently represented by Reddie & Grose LLP² and the opponent is unrepresented. Only the opponent filed evidence and neither party asked to be heard. Only the applicant filed written submissions in lieu of a hearing. This decision is taken following a careful reading of all the papers which I will refer to, as necessary.

Pleaded grounds

6. As above, the opposition has been brought under sections 5(1), 5(2)(a) and 5(2)(b) of the Act. I propose to proceed, at least initially, on the basis of section 5(2)(b), given that this ground does not demand an identity between the competing marks. I will return to consider the matter of identity only if appears necessary.

² The applicant was originally unrepresented but appointed Reddie & Grose LLP prior to filing written submissions. The registry received notification of the appointment on 9 January 2019.

DECISION

7. Section 5(2)(b) of the Act reads 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.”

8. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. With a filing date of 13 February 2015, the opponent’s mark qualifies as an earlier trade mark under the provisions outlined above. In accordance with section 6A of the Act, as the mark had not been registered for five years or more at the publication date of the application, it is not subject to the proof of use requirements. Consequently, the opponent is entitled to rely upon all goods and services he has identified.

Preliminary issue

Goods and services relied upon by the opponent

10. The opponent's expression of which goods or services covered by his registration are relied upon for the opposition appears somewhat contradictory. As indicated at paragraph 2, by way of selecting the appropriate checkbox, the opponent states that he relies upon *all goods and services* for which his mark is registered. However, he goes on, at the same question, to specify that he relies upon *advisory services relating to the care of pet animals*. Such specificity is not generally required where *all* goods and services of the earlier specification are relied upon; rather where the opponent intends to rely upon only a selection.

11. In its written submissions, the applicant makes the following observation:

"20. At Q1 of the Opponent's TM7 in response to the question "*Which goods or services covered by the earlier trade mark are relied upon for the opposition?*" the Opponent has ticked the box for "All goods and services". However, the Opponent has also listed "*Advisory services relating to the care of pet animals*" in the section of the form reserved for indicating that only specific goods and services are being relied upon in the opposition.

21. At Q5 of the Opponent's TM7 and at paragraph 3 of the Witness Statement of Robert Dawes dated 14 September 2018 specific reference is made to "*Advisory services relating to the care of pet animals*". No reference is made to the Opponent's remaining services in Class 41 or indeed the Class 31 goods covered by the Opponent's registration.

22. In light of this, we submit that it was the Opponent's intention for the opposition to be based on "*Advisory services relating to the care of pet animals*" only."

12. Whilst I understand the applicant's approach, I am not prepared to assume, nor accept, that the opponent intends to rely solely on his advisory services. The opponent

has expressly selected 'all goods and services' when asked which he intends to rely upon and this is not something which can be dismissed merely because he refers independently to only one of his services. I will, therefore, proceed on the basis that the opponent relies upon all goods and services for which his mark is registered, though, as will be seen shortly, it may only appear necessary to consider a limited number when it comes to the goods and services comparison.

The opponent's evidence

13. The opponent's evidence comprises a witness statement from Mr Robert Dawes dated 14 September 2018 with supporting exhibits EX1 to EX6 and additional witness statements from two of his customers, Mrs A Bithell and Mr James Beard. Given that the mark relied upon by the opponent is not subject to the proof of use provisions outlined in section 6A of the Act, I do not propose to summarise the evidence in any real detail, though a brief overview is provided below.

14. In his statement, Mr Dawes confirms that he is the sole proprietor of *Inner Wolf* and that his role within the company is a Puppy Foundation Advisor. He offers workshops and advice in relation to canine nutrition, first aid and microchipping. The *Inner Wolf* trade mark was first used in the UK in 2015 and has been used in relation to *advisory services relating to the care of pet animals*.

15. Exhibited in EX1 to EX4 and EX6 are a variety of certificates and accreditations which support the opponent's suitability for his existing role. Enclosed at EX5 is a copy of the registration certificate awarded in respect of the opponent's earlier mark.

16. Both additional witness statements are comprised primarily of positive customer feedback provided in relation to the services provided by the opponent. Mrs Bithell's statement is dated 18 September 2018 and Mr Beard's is dated 16 September 2018.

17. That concludes my summary of the evidence, insofar as I consider it necessary.

Section 5(2)(b) - Case law

18. The following principles are gleaned from the decisions of the courts of the European Union 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 Office for Harmonisation in the Internal Market (Trade Mark and Designs) ("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.

The principles:

(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 greater 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

19. I deal first with an issue raised by each of the parties, which is the classification of the opponent's *advisory services relating to the care of pet animals*, which I note is currently registered in class 44 of the earlier specification. In his Notice of Opposition, the opponent claims:

“I was misguided in my trademark application, I was advised to put our advisory services into class 44, when in fact the correct class for dog training is 41. I believe I deserve the right to put our services into the correct class, so I can continue to grow my business whilst protecting my brand.”

20. In the opponent's witness statement, he further explains that:

"4. ...I was advised to protect my brand and services by obtaining intellectual property. The trade mark I own in class 44 UK00003094278 (EX5) was advised to me by a business professional that would offer an umbrella of protection of the advisory services relating to the care of pet animals that we offer – including dog training (EX6).

...

6. I believe I should be given the opportunity to apply for a trade mark in class 41, and be able to protect my dog training service."

21. The applicant refers to several cases³ regarding the interpretation of specifications, and particularly the relevance of the Nice Classification system when making such assessments. It makes the following assertions in its written submissions:

"29. ...it is permissible to rely on the Nice Classification to assist in the understanding and interpretation of the services in question.

30. The term "*advisory services relating to the care of pet animals*" is arguably somewhat ambiguous. It could relate to advice on nutritional care, advice on medical care (i.e. veterinary care), or perhaps advice on other topics.

31. Assessing the Opponent's specification with reference to the Nice Classification confirms the scope of the services in this class and therefore the parameters of the Opponent's monopoly. It is clear that the Opponent's services in Class 44 do not extend to the Applicant's services in Class 41, for the following reasons:

- The Nice Classification Explanatory Note for Class 44 states as follows:

³ Cases include *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16, *Fil Ltd v Fidelis Underwriting Ltd* [2018] EWHC 1097 (Pat), *Altecnic Ltd's Trade Mark Application* [2001] EWCA Civ 1928, *Pathway IP SARL v Easygroup Ltd* [2018] EWHC 3608

“Class 44 includes mainly medical care, hygienic and beauty care given by persons or establishments to human beings and animals; it also includes services relating to the fields of agriculture, horticulture and forestry.”

- The same Explanatory Note explicitly states that “animal training services” are not included in Class 44.
- In the UKIPO’s Trade mark cross search list, Classes 41 and 44 are only cross searched for the following sub-classes:

Class 41.02: Health club and leisure services

and

Class 44.01: Saunas, massage, solariums.

32. It is clear from the above that the respective services are not identical.

33. In terms of whether the respective services are similar, as stated above the services “Advisory services relating to the care of pet animals” in Class 44 and “Animal training” in Class 41 are not cross searched on examination. This indicates that the respective services possess different characteristics and are neither competing nor complementary in nature.”

22. Though I bear in mind the applicant’s submissions and the various cases it has cited, it remains so that respective goods or services being listed in the same class of the Nice Classification is generally not an indication of similarity and nor are goods or services to be regarded as *dissimilar* from each other on the ground that they appear in different classes. The Nice Classification typically serves purely administrative purposes and, as such, does not in itself provide a basis for drawing conclusions as to the similarity of goods and services. That said, in *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), Carr J. considered when it was appropriate to take the class(es) in which the trade mark was registered into account in revocation or invalidation proceedings when deciding whether a description covered the goods and/or services shown in the

evidence. After considering the judgments of the High Court in the *Omega 1*⁴ and *Omega 2*⁵ cases, the judge made the following provisional judgement:

- (i) the class number should only be taken into account where the meaning of the disputed term is not sufficiently clear and precise;
- (ii) where the term is sufficiently clear and precise on its face, the fact that the description covers goods/services that may also be (or should have been) registered in other classes is irrelevant to the scope of protection afforded to the term, or to questions of use of the mark in relation to those goods/services;
- (iii) Where the term is not sufficiently clear and precise, the class number may be relied on to construe the proper scope of the registration, i.e. to narrow the possible meanings of the registered description to only goods/services falling in the registered class(es).

23. In *Pathway v Easygroup* this meant that 'rental of office equipment' in class 35 had been correctly construed as covering only rental services proper to this class. Therefore, use of the mark in relation to rental of photocopying machines was relevant. However, use of the mark in relation to rental of office furniture was irrelevant because those rental services were not proper to class 35. By contrast, the registered description 'provision of office facilities' was sufficiently clear and precise on its face that it was unnecessary to resort to the class number to construe the meaning of the words. Therefore, the registered mark covered the provision of any office facilities, irrespective of whether such services were proper to class 35. In the current case, the opponent has registered its earlier mark for *advisory services relating to the care of pet animals*. I do not consider the term to be lacking such clarity and precision that its remit is rendered ambiguous and, consequently, do not find it necessary to consult the Nice Classification system for clarification. The identity or similarity of the goods and services in question must be determined on an objective basis.

24. The competing goods and services are as follows:

⁴ *Omega 1* [2010] EWHC 1211 (Ch)

⁵ *Omega 2 cases* [2012] EWHC 3440 (Ch)

Opponent's goods and services	Applicant's services
<p data-bbox="201 271 738 779"><u>Class 31</u>: Animal beverages; Mixed animal feed; Synthetic animal feed; Animal feedstuffs; Animal feed preparations; Animal feeds; Pet beverages; Foodstuffs for pet animals; Pet animals; Pet food for dogs; Pet foods; Pet foods in the form of chews; Pet foodstuffs; Pet food; Foodstuffs for pet animals; Edible pet treats; Food (Pet -).</p> <p data-bbox="201 842 738 1088"><u>Class 44</u>: Advisory services relating to the care of pet animals; Care of pet animals; Grooming salon services for pet animals; Pet grooming services; Grooming (Pet -); Pet grooming.</p>	<p data-bbox="770 271 1302 360"><u>Class 41</u>: Advisory services relating to training; Animal training.</p>

25. Aside from his claim to a coincidence in the parties' respective 'business categories', the opponent has not commented directly on the relationship between the competing goods and services.

26. In its submissions, the applicant claims that neither of its applied for services are similar to the opponent's *advisory services relating to the care of pet animals* on the basis that:

“40. Whilst the two services share a common nature (in that they are both advisory services) they meet entirely different needs and address distinct issues. They differ in terms of their intended purpose, their respective users and channels through which they are supplied.”

27. When assessing similarity, I am guided by the relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, which were as follows:

- (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.

28. In *Kurt Hesse v OHIM*, Case C-50/15 P, the Court of Justice of the European Union (“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 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”.

Animal training

29. To my knowledge, *animal training* is utilised with a view to encourage or maintain a certain standard of behaviour from the given animal. *Advisory services relating to the care of pet animals*, and indeed the care itself, are likely to be selected more so to benefit the animals’ wellbeing. Though there is a distinction between the two, I find the

relationship between them to be relatively close; in my view, ensuring an animal undergoes appropriate training for its behaviour to comply with an expected or required standard is tied closely to ensuring that an animal receives a suitable level of care. Whilst training can, and is, delivered directly to the animal, there is also a likelihood that animal *owners* will receive a degree of training, allowing them to continue to apply the same or similar methods beyond the allocated training period, which will likely give rise to a similarity in the services' users. That said, I appreciate that, as the applicant seeks registration for animal training at large, its services are not limited to owners of pets or domesticated animals in the same way as the opponent's. In light of the relationship between the services, I would not consider it unlikely for them to reach the market via the same, or similar, trade channels. I do not consider the services to be directly competitive; consumers could not suitably substitute one for the other. Training services are likely to target behaviours, whereas advisory services relating to care typically target health and general welfare (though 'care' does allow a wider remit). Whilst the goods are not strictly complementary, I would not find it unreasonable or unlikely for consumers to expect that a provider of animal training would also be suitably placed to offer advisory services in respect of wider animal care (of which training could be just one branch). Weighing all factors, I find there is a similarity between the respective services to a degree between low and medium.

30. In light of the above finding, I do not find it necessary to assess *animal training* in relation to any of the remaining goods or services relied upon by the opponent (despite concluding that he was entitled to rely upon them all) as it would be unlikely to place him in any better position.

Advisory services relating to training

31. Though the above applied for service does not specify an immediate relationship with animals, its broad nature means that the term could, and would, incorporate advisory services relating specifically to *animal* training. On that basis, my findings remain much the same as those made in the previous paragraph. If anything, the respective services are brought closer in this case as both are, by definition, *advisory* services. Still, I would pitch the similarity at a medium degree and no higher.

The average consumer and the nature of the purchasing act

32. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

33. The average consumer for the services at issue in these proceedings is a member of the general public, predominantly those who own pets and other animals, with the services likely to be the subject of self-selection from websites or traditional advertisements, for example. For this reason, visual considerations are likely to play the largest role in the selection process. I do not, however, discount aural considerations as it would not be unusual for recommendations to be made orally by advisors within a related industry, for example, or indeed amongst consumers themselves. Furthermore, in my experience, it is fairly common for arrangements to be made via telephone.

34. The services in play are likely to be purchased relatively infrequently and, though prices will inevitably vary, the cost attributable is unlikely to be particularly low. A number of factors are likely to be borne in mind when selecting the service, course duration or geographical location, for example, but particularly the reputation of the provider as consumers will be conscious of maintaining their animal’s welfare. Such factors, when paired with what I understand generally to be a fairly high level of affection most owners bestow upon their animals, lead me to conclude that the

purchase will be reasonably well considered, with consumers maintaining at least a medium degree of attention.

Comparison of trade marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 at paragraph 34 of its judgment in *Bimbo SA v OHIM*, Case C-591/12P, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

36. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade marks
Inner Wolf	The Inner Wolf and The Inner Wolf Dog Education Centre (series of two)

37. The overall impression of the opponent's mark lies in the unit formed by the combination of the two word elements it comprises, namely *Inner* and *Wolf*, with neither word dominating the mark and it having no further components to rely on.

38. The first of the applicant's series marks consists solely of three dictionary words; *The Inner Wolf*. Again, it is likely to be the unit formed by their combination that signifies the mark's overall impression.

39. The second of the applicant's marks incorporates the additional words *Dog Education Centre*. Given that these are likely to be viewed as descriptive of the available services, the mark's overall impression is likely to remain predominantly in the term *The Inner Wolf*, although the rest of the mark will not be ignored completely during the analysis.

Visual comparison

40. The applicant's first series mark differs from the opponent's only in the inclusion of the word *The*, which it positions at the beginning of the mark. Notwithstanding the adopted positioning and the fact that the applicant's mark contains an additional three-letter word, I find the visual similarity between the respective marks to be of a high degree.

41. The applicant's second series mark comprises a total of six words, two of which ('Inner' and 'Wolf') are identical to those which constitute the opponent's mark and are presented in the same order. Still, there are four words remaining, of varying lengths, none of which have counterparts in the opponent's mark. Overall, factoring in what I have found in respect of the mark's overall impression and the significance of the *The Inner Wolf* element, I consider the visual similarity to be of a medium degree.

Aural comparison

42. Each of the marks consist of common English language words which the average consumer will be familiar with and accustomed to the pronunciation of. The opponent's mark is likely to be articulated in a total of three syllables, specifically INN-ER-WOLF.

43. The applicant's first series mark, when articulated, will comprise four syllables, namely THE-INN-ER-WOLF, the latter three of which represent the aural extent of the opponent's mark. On that basis, I find the marks' aural similarity to be of a high degree.

44. The second series mark, where fully articulated, will be aurally composed of eleven syllables, specifically THE-INN-ER-WOLF-DOG-ED-YOU-CAY-SHUN-CENT-ER. Despite a resulting discrepancy of eight syllables, I must bear in mind what dominates the mark's overall impression (i.e. *The Inner Wolf*). On that basis, I find the aural similarity to be of at least a medium degree. I use 'at least' because, in my experience, consumers do not necessarily elect to articulate elements which are considered to be wholly descriptive or allusive. Consequently, I would not find it unlikely nor unusual for consumers to articulate the applicant's second series mark as only THE-INN-ER-WOLF, giving rise to a further finding of high aural similarity.

Conceptual comparison

45. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

46. Neither party has commented upon the conceptual significance of the competing marks.

47. The opponent's mark comprises the words 'Inner Wolf'. Both are ordinary dictionary words which will, independently, be readily understood by the average consumer. Taking into account what I believe to be the average consumer's perception of wolves, together the words are likely to evoke a concept of an instinctive and perhaps predatory characteristic (likely internalised by an animal or human) which has the potential to be 'released'. The applicant's first series mark comprises identical words preceded by the word *The* and I note the applicant's submission regarding the impact this has, insofar as it changes 'Inner Wolf' from an abstract concept to a determined article. In my view, the addition of *The* has very little bearing on the

conceptual significance of the applicant's mark and, as such, I find it likely that consumers will retrieve the same concept from *The Inner Wolf* as it will from *Inner Wolf*. If I am wrong in that and the additional word will, as the applicant submits, result in the series mark being seen as a 'determined article', even so, in my view, the concept created remains fairly abstract. Reducing *Inner Wolf* (at large) to *The Inner Wolf* is still not particularly tangible; consumers are likely to interpret it in precisely the same way, as a reference to an internal animalistic quality. Weighing all factors, I find the marks to be conceptually identical or, if this is not the correct approach, they are at least highly similar.

48. Much of the reasoning in my previous paragraph also applies to my assessment of the applicant's second mark. I have found that its overall impression lies predominantly in the words *The Inner Wolf*. Its remaining word elements, namely *Dog Education Centre*, allow consumers an insight into the available services, but do little when it comes to providing a conceptual identifier. For that, consumers will continue to rely on *The Inner Wolf*. Consequently, I find the marks to be conceptually similar to at least a high degree.

Distinctive character of the earlier trade mark

49. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, 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).”

50. Without evidence to aid my assessment of the distinctive character of the opponent’s earlier trade mark, I have only its inherent characteristics to consider. It is widely accepted, although just a rule of thumb, that words which are invented often possess the highest degree of distinctive character, whilst words which are allusive or suggestive of the goods and/or services relied upon generally possess the lowest.

51. When considered in respect of the contentious services for which it is registered, I do not find the opponent’s mark to be by any means allusive. Though I acknowledge that all of the opponent’s goods and services relate to animals and that the mark itself refers directly to an animal (i.e. a wolf), wolves are typically wild and not often domesticated, so on the face of it, reference to a wolf has very little relationship with the items listed in the opponent’s specification; even less so when preceded by the word *Inner*. That being so, the mark exclusively comprises two well known dictionary words. All things considered, I find the opponent’s mark to possess a normal degree of inherent distinctiveness.

Likelihood of confusion

52. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is

also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion.

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

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

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

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

54. Confusion can be direct or indirect. Mr Iain Purvis Q.C., as the Appointed Person, explained the difference between the two in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where he stated:

"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.””

55. Earlier in this decision I reached the following conclusions:

- When considered in respect of the opponent’s *advisory services relating to the care of animals*, the applicant’s *animal training* is similar to a low to medium degree and its *advisory services relating to training* are similar to a medium degree;
- The average consumer is likely to be a member of the general public, particularly pet owners, who will select the services predominantly by visual means. I do not discount the significance of an aural element;
- Consumers are likely to apply a medium degree of attention when selecting the services at issue;
- The competing trade marks are visually similar to a high degree in respect of the first series mark and a medium degree in respect of the second;
- The competing trade marks are aurally similar to a high degree in respect of the first series mark and a degree between medium and high in respect of the second (depending on the extent to which the applicant’s mark is articulated);
- The opponent’s trade mark possesses a normal degree of inherent distinctive character.

56. To properly assess the likelihood of confusion, I must adopt the global approach advocated by the case law and take account of each of the above conclusions. I keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them retained in their mind.

57. What I keep in mind when making my assessment are the significant similarities between the respective trade marks, not only from a visual and aural perspective but in the overall impressions they convey and what I have found to be a highly similar (if not identical) conceptual message. I begin with the applicant's first series mark, which differs from the opponent's in only the word *The*. In my view, such an apparent closeness between the marks is likely to engage a likelihood of direct confusion in any instance whereby at least a low level of similarity is found between the respective goods and/or services. I reach this conclusion notwithstanding the rule of thumb regarding the importance of the *beginning* of marks, on which consumers generally apply more importance. Still, I do not believe anything turns on the word *The*. Consumers familiar with the earlier mark, when faced with the later mark being utilised in a related field, are likely to directly confuse the two. I find it highly unlikely that the consumer will readily identify the difference in the inclusion (or absence) of *The*, even when selecting services which may encourage a level of attention which is higher than normal; they will simply mistake the latter mark for the former.

58. I move now to the second series mark, which I have found to have a lesser degree of visual and aural similarity (at least when articulated in its entirety). I begin by noting that the additional words in the second mark (*Dog, Education and Centre*) do not grant it any further distinctiveness. Instead, when considered in respect of the services at issue, the consumer is likely to view the mark's additional elements as purely descriptive. Their impression of the mark itself, and where their focus will lie, remains in *The Inner Wolf*. It is the combination of *Inner* and *Wolf* which represents the common, and most distinctive, element of each of the competing marks, which, in my view, consumers will readily identify. Keeping in mind the effects of imperfect recollection and the descriptive nature of the second mark's latter elements, I find that consumers are likely, again, to encounter direct confusion. If I am wrong in that and the differences between the respective marks are sufficient to bypass direct confusion, I find it likely that the distinctive nature of the marks' common element and the relationship between the conflicting services will encourage consumers to erroneously conclude that the marks originate from the same undertaking. In other words, they will be subject to indirect confusion.

Conclusion

59. Given that I found a likelihood of confusion under section 5(2)(b) of the Act on the basis that the respective marks are highly similar, it would appear to be of no real benefit to the opponent if I were to go on to assess the merits of its claim to identity in any real detail. However, if I were to express a brief view on the matter, bearing in mind the case law on identity, I would have found the first mark to be identical (given that the word THE is so often overlooked) but not the second.

60. The opposition has succeeded and, subject to any successful appeal, the application will be refused.

Costs

61. As the opponent has been successful, it is entitled to a contribution toward its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the opponent on the following basis:

Official fee (form TM7):	£100
Preparing a Notice of Opposition:	£150
Preparing evidence and considering the other side’s submissions:	£350 ⁶
Total:	£600

62. I order Paul Levine to pay Robert Dawes the sum of £600. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

⁶ This amount falls below the scale indication as the evidence filed had limited relevance to the proceedings.

Dated 8 April 2019

**Laura Stephens
For the Registrar**