

O/432/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3368076
BY WCF LTD
TO REGISTER





AS A TRADE MARK IN CLASS 31
AND
IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 416435
BY LAKELAND AGRI LIMITED

BACKGROUND AND PLEADINGS



1. WCF Ltd (“the applicant”) applied to register the trade mark shown on the front cover of this decision in the UK on 18 January 2019. The application was accepted and published in the Trade Marks Journal on 29 March 2019. The goods for which registration is sought are as follows¹:

Class 31: *Dog Food.*

2. LAKELAND AGRI LIMITED (“the opponent”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent bases its opposition on four earlier marks:

<p>UK00003329176 (“the First Earlier Mark”)</p>  <p>(series of two) Filing date: 03 August 2018 Date of entry in register: 26 October 2018</p>	<p>Class 31: <i>Animal feeds.</i></p>
<p>UK00003329181 (“the Second Earlier Mark”)</p>  <p>(series of two) Filing date: 03 August 2018 Date of entry in register: 16 November 2018</p>	<p>Class 31: <i>Animal feeds</i> Class 35: <i>Retail services connected with the sale of animal feed, milk replacer, fertiliser, animal health products, seeds and sprays, fencing materials, covers and plastic wrapping, agricultural machinery, equipment and components, fuels, all other farming inputs.</i></p>

¹ The specification for which registration was sought was initially *Animal food* (in class 31) but after the opposition was filed the goods were limited to *Dog food* (class 31)

<p>UK00003329187 (“the Third Earlier Mark”)</p>  <p>(series of two) Filing date: 03 August 2018 Date of entry in register: 26 October 2018</p>	<p>Class 31: Animal feeds.</p>
<p>UK00003329183 (“the Fourth Earlier Mark”)</p>  <p>(series of two) Filing date: 03 August 2018 Date of entry in register: 26 October 2018</p>	<p>Class 31: Animal feeds.</p>

3. The opponent argues that the respective goods and services are identical or similar and that the marks are similar.

4. The applicant filed a counterstatement denying the claims made. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

5. The applicant is represented by Ancient Hume Limited. The opponent is represented by FR Kelly. No hearing was requested, but both parties filed submissions in lieu. This decision is taken following a careful perusal of the papers.

THE EVIDENCE

6. The applicant’s evidence consists of a short witness statement by Ms Karen Pollock (with two exhibits) and one by Joanne Leslie Ritzema (with two exhibits). Ms Pollock

is a trade mark paralegal at Ancient Hume Limited. Ms Ritzema is the director of the applicant.

7. The opponent did not initially file evidence although in response to matters contained in the applicant's evidence, it produced a witness statement by Paul Kelly (with one exhibit). Mr Kelly is a trade mark attorney at FR Kelly.

Section 5(2)(b)

8. Section 5(2)(b) of the Act is 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”.

9. The opponent's trade marks have filing dates that are earlier than that of the trade mark in question, and, therefore, they are earlier marks, in accordance with Section 6 of the Act. As the registration procedure for the earlier marks was not completed more than 5 years prior to the date of the application for registration of the contested mark, they are not subject to the proof of use conditions.

10. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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 great degree of similarity between the marks, and vice versa;

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

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

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

12. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

13. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (GC) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

14. The competing goods and services are as follows:

The applicant’s goods	The opponent’s goods and services
Class 31: <i>Dog Food.</i>	Class 31: <i>Animal feeds.</i> Class 35: <i>Retail services connected with the sale of animal feed, milk replacer, fertiliser, animal health products, seeds and sprays, fencing materials, covers and plastic wrapping, agricultural machinery, equipment and components, fuels, all other farming inputs.</i>

15. The applicant denies that the competing goods are identical or similar. In support of this claim, the applicant has put forward evidence² to show that the term “*feed stuff*” means “*any type of food for animals, especially cattle, pigs, sheep, etc*” and that the opponent’s website www.lakeland.ie contains the text “*WHAT IS RUMISMART SUSTAIN? Lakeland RumiSmart is a fully integrated feeding system covering soils, forage production, nutrient supply management, rumen function and animal health*”.

16. The applicant also filed evidence intended to show³:

- That dog food and animal feed for cattle, pigs and sheep are not sold through the same trade channels. In this connection, Ms Ritzema states that the majority of dog food in the UK is sold through retail outlets including pet retailers, pet stores and specialist online pet companies; those retailers, she says, do not sell animal feed for cattle, pigs, sheep and the like. Ms Ritzema also states that, differently from dog food, animal feed is supplied in bulk and sold in farm stores. The only evidence provided in support of those claims is a copy of a presentation⁴ showing that the distribution channels for dog food are split amongst, inter alia, grocery retailers (68%), pet shops (12%) and superstores (7%);
- That the term *animal feed* refers to feed for cattle, calves, pigs, poultry, sheep, etc. In this connection, Ms Ritzema provides 1) webpages from third party companies specialising in animal feed and from the opponent’s website, all of which refer to categories of farm animals, namely beef, calf, sheep and lamb⁵; and 2) a report from Defra⁶ dated 2018 containing animal feed statistics within which the expressions “*animal feed production*” and “*compound animal feed prices*” is used in the context of animals raised in an agricultural setting, with the following categories being listed: cattle and calf feed, pig feed, poultry feed and sheep feed.

² Witness statement of Karen Pollock

³ Witness statement of Joanne L Ritzema

⁴ Exhibit JLR1

⁵ Exhibit JLR2

⁶ Exhibit JLR2

17. The opponent claims that the goods in respect of which the earlier marks are protected, i.e. *animal feeds*, cover the contested *dog food* and, accordingly, the goods are identical. In support of the argument that the goods are identical, Mr Kelly, on behalf of the opponent, produced the following dictionary definitions:

“**Animal:** something that lives and moves but is not a human, bird, fish or insect”

“**Etc:** and other similar things. It is used to avoid giving a complete list.”

18. I can see the point Mr Kelly makes but I do not think that the dictionary definitions of “animal” and “etc” are helpful. The key word here is “feeds” and I do not accept Mr Kelly’s submission that animal feeds and animal food are the same thing. In this regard, I reviewed two English dictionaries⁷. They both include various definitions of “feed”, including the following:

“Animal **feed** is food given to animals, especially farm animals. *The grain just rotted and all they could use it for was animal feed ...poultry feed.*”

“Food eaten by animals that are not kept as pets: *cattle/animal feed.*”

19. Having regard to the evidence filed by the applicant and the dictionary definitions I have mentioned, I agree with the applicant that the natural meaning of “*animal feeds*” is that of food given to farm animals, including poultry, pig, sheep and bovine feed. On that basis, I reject the opponent’s suggestion that anything that is edible and of nutritional value to animals (including dogs) is animal feed. Accordingly, I also reject the claim that the applicant’s dog food falls within the opponent’s animal feeds.

20. As regards the question of whether dog food is similar to animal feeds, although the goods are fed to different species of animals, this does not take away from the fact that the purpose of the goods is the same, i.e. both are categories of foodstuff supplied for the purpose of feeding animals. Further, dog food comprises not only food for dogs

⁷ Collins Online English Dictionary and Cambridge Online English Dictionary

that are kept as pets, but also food for farm dogs, i.e. dogs which are bred specifically for the purpose of working on a farm, so the goods can be offered to the same purchasers, i.e. farmers. Equally, the opponent's animal feeds include foodstuffs derived from hay which is also fed to pets such as rabbits or guinea pigs, so the goods can target the same public, i.e. pet owners. Finally, whilst I noted Ms Ritzema's claims as regards the trade channels being different, they are not adequately substantiated, and I am not persuaded that animal feed stores will not sell dog food, or that pet food shops will not offer items of animal feeds that can be feed to small pets, so the goods can travel through the same trade channels. **Overall, the goods are similar to a low to medium degree.**

21. With regards to the opponent's services in class 35, the opponent did not make any specific submissions over and above the general point that "*dog food*" is similar to "*retail services connected with the sale of animal feed*"⁸. Nonetheless, having compared the goods and services at issue, I find that the *animal health products* to which the opponent's *retail services* relate include health supplements for dogs, such as, for example, multivitamins. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

22. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

"9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services

⁸ Paragraph 7 of submissions in lieu

for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

23. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*⁹, and *Assembled Investments (Proprietary) Ltd v. OHIM*¹⁰, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*¹¹, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered)."

⁹ Case C-411/13P

¹⁰ Case T-105/05, at paragraphs [30] to [35] of the judgment

¹¹ Case C-398/07P

24. Accordingly, I find that the applicant's *Dog Food* is similar to a low degree to the opponent's *Retail services connected with the sale of animal health products*.

The average consumer and the nature of the purchasing act

25. I next consider who the average consumer is for the contested goods and the way in which those goods are purchased. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

26. 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.”

27. The average consumer of the applicant's goods is the general public who owns a dog. The purchase will be primarily visual, after examining packaging on shelves or via a website, although I do not discount the potential for an aural element to the purchase, such as a discussion with a vet or sales assistant. The goods are relatively inexpensive and are purchased frequently. The consumer will consider characteristics such as the type of dog food, ingredients and suitability for their dog, for example. Overall, the average consumer will pay a medium level of attention during the purchasing process.

Distinctive character of earlier mark

28. 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).”

29. The opponent has not filed any evidence of use and therefore I am only able to consider the position based on inherent characteristics.

30. The opponent claims that the word LAKELAND does not have any meaning or direct significance in respect of any of the goods (and services) at issue and that the earlier marks have at least a medium degree of distinctive character. It also points out that the definition of Lakeland produced by Ms Pollock in her witness statement as “*being of or belonging to the Lake District or any similar area of countryside*” does not

result in the word LAKELAND being devoid of distinctive character or being seen as an indicator of geographical origin.

31. I agree with the opponent that all of the four earlier marks have a medium degree of distinctive character. The word LAKELAND, which is the dominant element in the earlier marks (see below), is neither descriptive nor allusive of a characteristic of the goods (and services) at issue. Further even if the word LAKELAND is perceived as a geographical location, there is no evidence of any connection between LAKELAND and animal feeds (or retail services connected with the sale of animal health products)¹² so it has a medium degree of distinctive character. Finally, the applicant claims, in its submissions, that the word LAKELAND “*is a word that traders may wish to use to indicate proximity to an area of countryside similar to the Lake District*”, however, the opponent’s marks are registered and I am not aware of any application to invalidate the opponent’s marks based on absolute grounds.

Comparison of marks

32. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

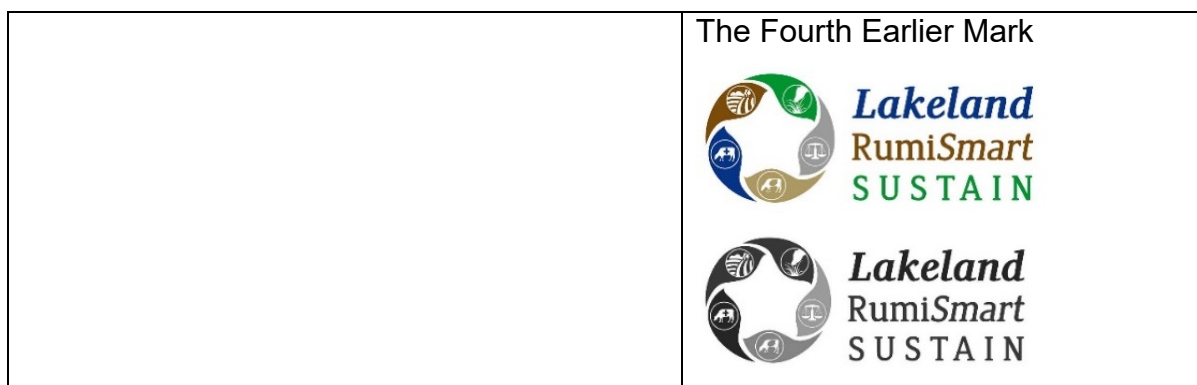
“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in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

¹² *Newport Creek*, BL -O-22316

33. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

34. The respective trade marks are shown below:

Applicant's mark	Opponent's marks
	<p>The First Earlier Mark</p>  
	<p>The Second Earlier Mark</p>  
	<p>The Third Earlier Mark</p>  



35. In my view, of the four earlier marks, the Second and Third Earlier Mark are the most similar to the applicant's mark because they do not have the extra star/leaves device element and the words "RumiSmart SUSTAIN" which are present in the First and the Fourth Earlier Marks (and which have no counterpart in the applicant's mark). Further, the word "FEEDS" in the Third Earlier Mark is descriptive in relation to the goods for which the mark is registered, i.e. animal feeds. The Second Earlier Mark contains the word element "AGRI" which will be understood as a shortening of "agriculture" and will also be perceived as a descriptive element in the context of the opponent's retail services, which relate to the sale of farming and agricultural products. I will therefore deal first with the Second and Third Earlier Mark which I consider present the best case for the opponent. I will make the comparison based upon the second marks in the series, which are not in colour so, notionally, cover use of the marks in black, white and colour.

36. The applicant's mark consists of the two words 'LAKELAND' and 'HERITAGE' written on a white banner. The words are presented in bold, in blue and in capital letters with the word 'LAKELAND' being placed above the word 'HERITAGE'. Due to its larger size and position, the word 'LAKELAND' is the dominant and distinctive element of the mark. Bearing in mind the meaning of the word 'HERITAGE', i.e. *"anything that has been transmitted from the past or handed down by tradition"*¹³, this element is likely to be seen as either an allusive reference to a traditional brand or product or an indirect indication in relation to the kind, quality or other characteristic of the goods. For these reasons, although the word 'HERITAGE' is not entirely non-distinctive, it will be seen as subordinate to the word 'LAKELAND' (a perception which

¹³ Collins English Dictionary

is reinforced by its smaller size and position within the mark). The banner element is purely decorative and will have little or no impact in the overall impression of the mark.

33. The opponent's Third Earlier Mark is a composite arrangement consisting of the word 'LAKELAND' written in bold, in title case letters. This element is positioned above the word 'FEEDS', which is written in white, in smaller capital letters and is incorporated within a black rectangular background. The mark also includes a figurative element consisting of the silhouette of a bulrush, represented in white and incorporated within another black rectangular background. The word "FEEDS" will be seen as descriptive given the animal feeds goods covered in the specification and therefore carries little or no weight in the overall impression of the mark. The device element is smaller than the word 'LAKELAND', which is the most distinctive element of the mark, and will also carry less weight. In this connection, I bear in mind that when marks consist of both verbal and figurative elements, in principle, the verbal element of the mark usually has a stronger impact on the consumer than the figurative element. This is because the public does not tend to analyse signs and will more easily refer to the marks in question by their verbal element than by describing their figurative elements.

37. The same considerations apply to the Second Earlier Mark, the only difference being the presence of the word 'AGRI' (instead of the word 'FEEDS') which will also be perceived as a descriptive element within the mark.

Visual similarity

38. Visually, the marks coincide in the element 'LAKELAND' that constitutes the most dominant element of each mark. The marks differ in the additional elements 'FEEDS' and 'AGRI' (only present in the opponent's marks), and 'HERITAGE' (only present in the applicant's mark), in their stylisation, and their figurative elements, all of which are of less importance than the coinciding word element 'LAKELAND' as explained above. As the differing elements in the marks are less distinctive than the coinciding element, **the marks are visually similar to, at least, a medium degree.**

Aural similarity

39. Aurally, the pronunciation of the marks coincides in the sound of the word 'LAKELAND' which is present identically in them. The pronunciation differs in the sound of the verbal element 'HERITAGE' in the applicant's mark. The words 'FEEDS' and 'AGRI' in the opponent's marks are descriptive and will not be articulated. Further, the coinciding element 'LAKELAND' in the applicant's mark is the first verbal element and will be identified as the main brand since the word 'HERITAGE' will be seen as an allusive reference to the goods. **The marks are aurally similar to, at least, a medium degree.**

Conceptual similarity

40. In its written submissions, the applicant states that its mark conveys the message of 'LAKELAND HERITAGE', which has no counterpart in the opponent's mark. It also states that the its mark has its own "conceptual hook" which the opponent's marks do not share. The opponent states that the marks are conceptually similar to a high degree, in so far as they have the word 'LAKELAND' in common. **In my view, the marks are conceptually similar to a very high degree.** The element 'LAKELAND' in both marks has significance independent of the elements 'HERITAGE' and 'FEEDS'/'AGRI' which, due to their allusive and/or descriptive connotations and their size and position within the marks, will be seen as subordinate to the element 'LAKELAND'¹⁴.

Likelihood of confusion

41. 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 marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make

¹⁴ *Bimbo*, paragraph 25

direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

42. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

43. I have found the parties’ goods and services to be similar to a low and low to medium degree. I have identified the average consumer to be the public who own a dog. The goods will be purchased by visual means (although I do not discount an aural component). I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the earlier marks to have a medium degree of inherent distinctive character; this also applied to the word ‘LAKELAND’ alone.

44. I have found the applicant’s mark and the opponent’s Second Earlier Mark and Third Earlier Mark to be visually and aurally similar to, at least, a medium degree, and conceptually similar to a very high degree. Bearing these factors in mind, I find that there is a risk of indirect confusion. Even if the average consumer recognises that the marks are different, she/he would consider that the marks are related and originate from the same, or an economically linked, undertaking. Although the goods and services are similar only to a low and low to medium degree, they belong to the same sector, i.e. food for animals and retail services connected with the sale of animal products; this fact, combined with the presence of the identical and distinctive element ‘LAKELAND’ in the parties’ marks, will, in my view, lead the average consumer to assume that the later mark is a brand extension of the earlier marks. **There is a likelihood of indirect confusion.**

45. As the opposition has succeeded based on the Second Earlier Mark and the Third Earlier Mark, I do not consider it proportionate or necessary to consider the opponent’s claim in relation to the other two earlier marks.

OUTCOME

46. The opposition has succeeded; the application cannot proceed to registration.

COSTS

47. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances, I award the opponent the sum of £800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

£100 for the official fee for the notice of opposition;

£200 towards the cost of completing and filing the notice of opposition;

£300 towards the cost of filing evidence and considering the other party's evidence *(this takes account of the fact that the parties' evidence was very light)*;

£200 towards the cost of written submissions in lieu of a hearing.

48. I order WCF Ltd to pay LAKELAND AGRI LIMITED the sum of £800. This to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 10th day of September 2020

T Perks

For the Registrar,

the Comptroller-General