

O/573/22

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3619886
BY FANG ZHONGSHUO**

TO REGISTER:

Crazy Felix

AS A TRADE MARK IN CLASS 18

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 426454 BY
SOCIÉTÉ DES PRODUITS NESTLÉ S.A.**


BACKGROUND AND PLEADINGS

1. Fang Zhongshuo (“the applicant”) applied to register **Crazy Felix** as a trade mark in the United Kingdom on 1 April 2021. The application was accepted and published on 28 May 2021 in respect of the following goods:

Class 18

Dog leashes; Clothing for pets; Collars for pets; Dog collars; Dog coats; Dog clothing; Dog shoes; Collars for cats; Animal leashes; Animal harnesses; Covers for animals; Animal covers; Backpacks; Haversacks; Shoulder bags; Rucksacks for mountaineers; Shoulder straps; Backpacks [rucksacks]; Card wallets; Alpenstocks; Muzzles.

2. On 9 July 2021, the application was opposed by Société des Produits Nestlé S.A. (“the opponent”). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and concerns all the applied-for goods. The opponent is relying on the following UK Trade Marks (“UKTM”):

Mark	Goods relied on
UKTM 685375 (“the FELIX word mark”) FELIX Filing date: 7 January 1950 Date of entry in register: 7 January 1950	<u>Class 31</u> <i>Animal food.</i>
UKTM 800980176 (“the FELIX logo mark”)  Filing date: 6 August 2008 Date of entry in register: 5 October 2009 Priority claimed from Swiss Trade Mark 575089, filed on 2 April 2008.	<u>Class 31</u> <i>Animal foodstuffs, animal litter.</i>

3. The opponent claims also to rely on *Animal litter* for the FELIX word mark. However, this mark is not registered for those goods and so it is not entitled to do so, even if it has used the FELIX word mark for those goods.

4. Under section 5(2)(b), the opponent claims that the marks are visually, aurally and conceptually highly similar, and that the goods covered by the marks are similar and/or complementary. Consequently, it claims that there exists a likelihood of confusion on the part of the relevant public in the UK.

5. Under section 5(3), the opponent claims to have a substantial reputation in the earlier marks and that use of the contested mark would ride on the coat tails of this reputation and would confer an unfair advantage on the applicant who would be seeking to associate itself with the opponent and its reputation. The opponent further claims that such use would cause detriment to the repute of the earlier marks as it would have no control over the quality of the goods provided under the contested mark. It would also, argues the opponent, erode the distinctiveness of the earlier marks as it would diminish their attractiveness and strength. The opponent claims that it is likely that it would suffer a decrease in revenue.

6. On 13 October 2021, the applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of the use made of the earlier marks.

EVIDENCE AND SUBMISSIONS

7. Only the opponent filed evidence. It comes from Rebecca Marshall, Senior Brand Manager of Nestlé Purina, an affiliate company and licensee of the opponent, and is dated 7 January 2022. Her evidence goes to the use and reputation of the earlier marks. The opponent also filed written submissions in lieu of a hearing on 26 April 2022. I shall refer to the submissions and evidence during the course of my decision. Neither party requested a hearing, so I have taken this decision after a careful consideration of the papers.

REPRESENTATION

8. In these proceedings, the opponent is represented by CMS Cameron McKenna Nabarro Olswang and the applicant by Isabelle Bertaux.

DECISION

Section 5(2)(b)

9. Section 5(2)(b) of the Act is as follows:

“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.”

10. An “earlier trade mark” is defined in section 6 of the Act. The relevant subsection reads as follows:

“(1) In this Act an ‘*earlier trade mark*’ means-

(a) a registered trade mark or international mark (UK) 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

...”

11. The marks the opponent relies on qualify as earlier marks under this provision. As they both completed their registration procedures more than five years before the date of the application for the contested mark, they are subject to the proof of use provisions set out in section 6A of the Act:

“(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in sections 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section ‘*the relevant period*’ means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form (the 'variant form') differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[(5) Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

..."

12. Section 100 of the Act is also relevant and is as follows:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

Proof of use

13. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

"114. *The law with respect to genuine use.* The CJEU has considered what amounts to 'genuine use' of a trade mark in a series of cases: Case C-40/01

Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are

manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

15. Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts, although the UK has left the EU.

16. The FELIX logo mark is a UK comparable mark and therefore the practice set out in Tribunal Practice Notice (“TPN”) 2/2020 applies. This states that where use and reputation fall to be considered at any time before IP Completion Day (31 December 2020), I am to take into account use in the EU of the corresponding EU Trade Mark (“EUTM”) or International Registration designating the EU (“IR(EU)”) until IP Completion Day.¹

17. The relevant period for the proof of use assessment is the five years ending with the date of application for the contested mark. This is 2 April 2016 to 1 April 2021.

¹ Paragraph 4.

Evidence

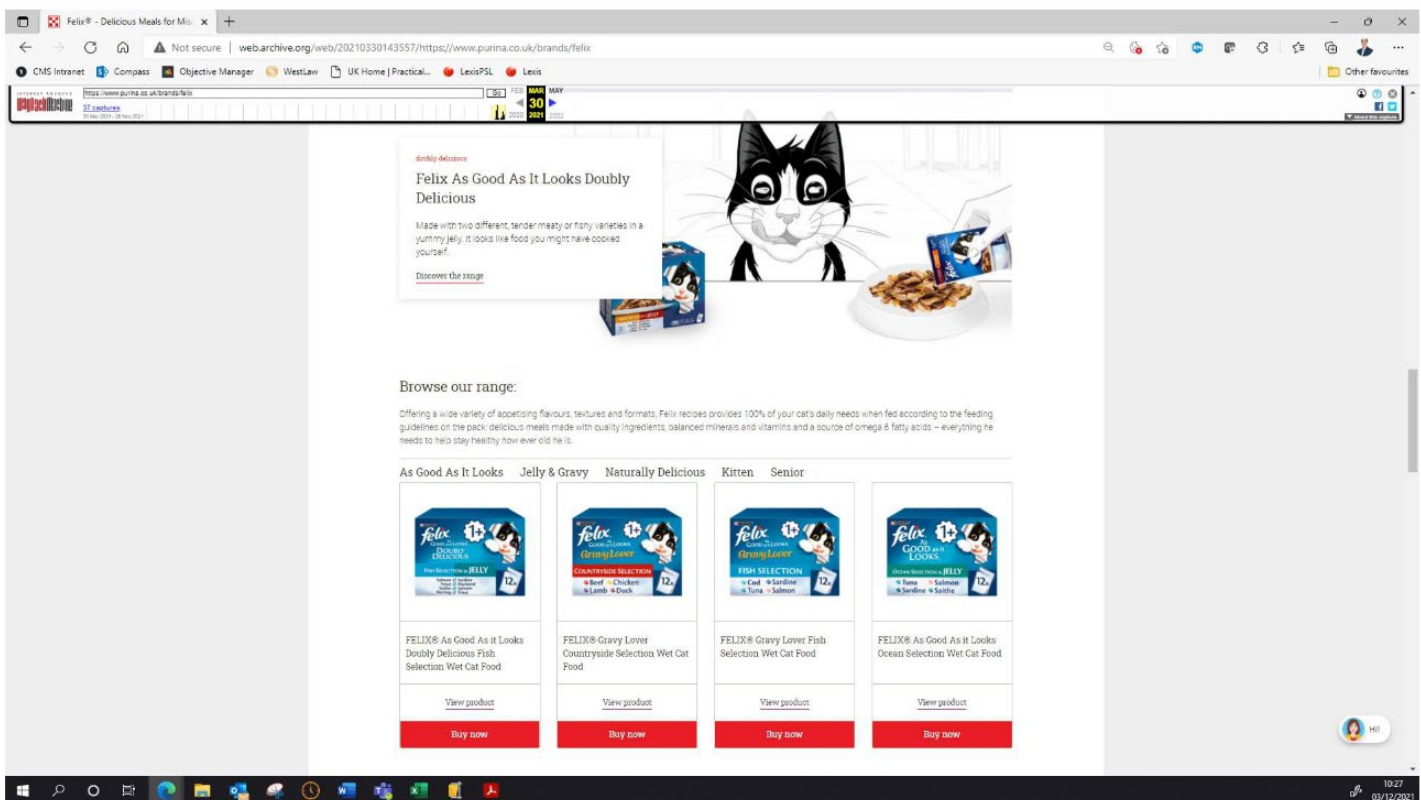
18. Ms Marshall states that the FELIX brand name has been in use in the UK for more than seventy years. In 1988-89, an advertising relaunch saw the introduction of a mischievous black and white cat to represent the brand. The marks have been used in relation to cat food and the FELIX logo mark appears prominently on the packaging. I have reproduced examples from both ends of the relevant period below:²



² Exhibit RM-2, pages 4 and 33

19. The goods are sold in the major supermarket chains and petshops and are also available online from retailers and the Purina website. A selection of screenshots dated between 1 November 2016 and 30 March 2021, obtained via the Wayback Machine, shows how the marks are used. All but one of these websites are directed towards UK consumers, with the last (BritSuperstore) stating that it delivers British products to customers all over the world. I cannot tell from the screenshot whether there is an option to purchase the goods in euros.³

20. The screenshot from the Purina website is dated 30 March 2021 and shows both the word and the logo mark in use.⁴

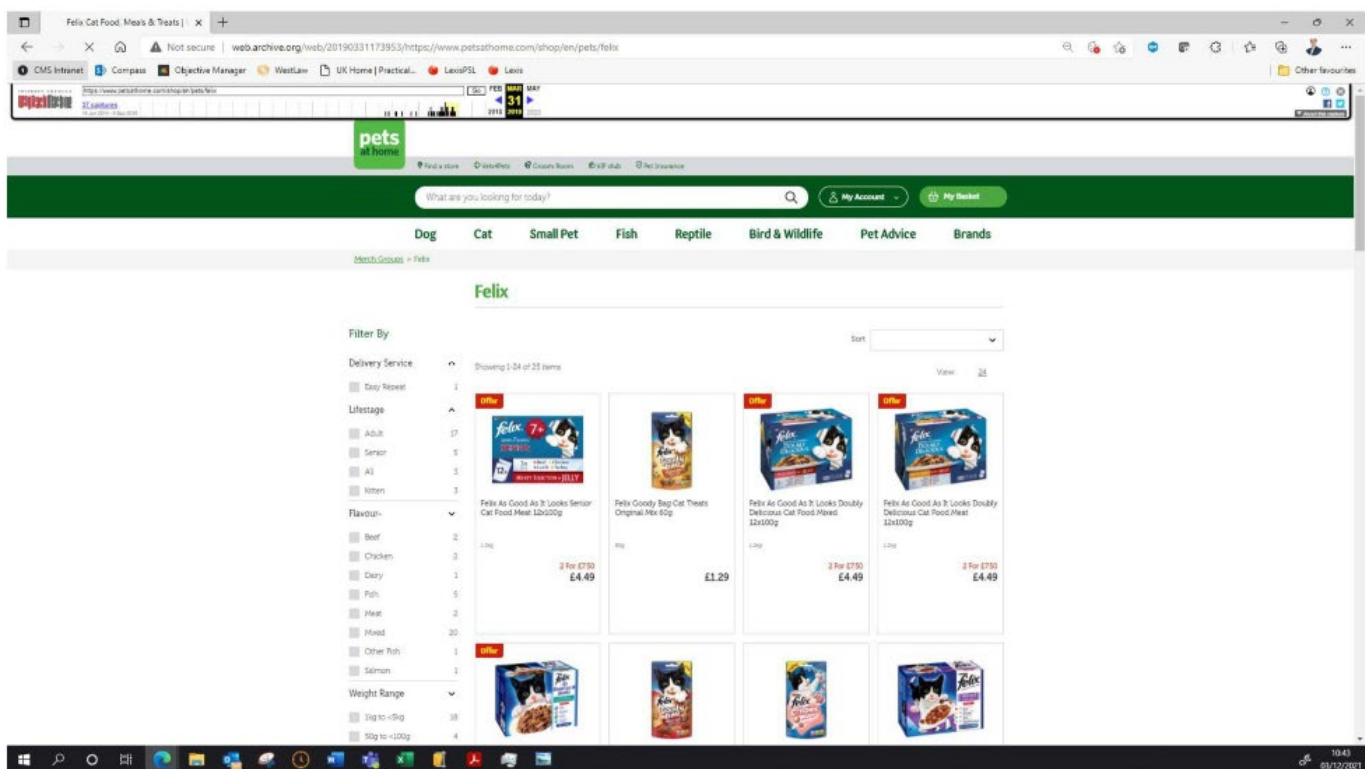


21. The word mark is also used as a brand heading on the Pets at Home website, dated 31 March 2019.⁵

³ Exhibit RM-3.

⁴ Exhibit RM-3, page 2.

⁵ Exhibit RM-3, page 3.



22. Ms Marshall has given me no sales figures or invoices, but she has adduced a number of market research reports which give an indication of the scale of the opponent's business in the UK. The size of the UK pet food industry is large. In 2016, it was estimated to be £2.47 billion, rising to £2.85 billion in 2020, with about half of this sum accounted for by cat food. The FELIX brand has around a 20% share of the UK market for cat food.⁶ Another report, however, suggests it might be even higher (between 26% and 27%) with sales reaching £243 million - £248 million in each of the 52-week periods ending with 14 October 2017, 13 October 2018, 12 October 2019 and 10 October 2020.⁷ A further report, from Kantar, states that between 3 and 3.75 million households per year purchased FELIX-branded products.⁸

23. Estimated expenditure on TV and press advertising is shown in the table reproduced below.⁹ This includes sponsorship of the ITV show *You've Been Framed* between January 2018 and March 2020. In 2018, the show had an average 2.7m viewers per episode; in 2019, there were, on average, 1.9m viewers per episode. A

⁶ Exhibit RM-4.

⁷ Exhibit RM-5.

⁸ Exhibit RM-6.

⁹ Paragraph 4.7 and Exhibit RM-13.

report on the sponsorship states that in 2018 35 million people had seen one or more sponsorship ident and that 66% of women aged 35 or over had seen the campaign.¹⁰

Year	2017	2018	2019	2020	2021
Expenditure (£)	2,540,000	1,675,000	2,145,000	2,740,000	1,475,000

24. An additional £2 million was spent over the relevant period on marketing in supermarkets, including Tesco, Asda and Sainsbury's, for example through coupons at tills, in-store sampling, direct mail and advertising on supermarket websites.¹¹

Analysis

25. There is little evidence on use in the rest of the EU. The brand was introduced to (unnamed) European markets in the 1990s.¹² A brand awareness report (which I shall return to later) indicates that FELIX-branded goods are sold in EU Member States including Germany and Italy, but I have no information on the levels of any such sales.

26. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union ("CJEU") noted that:

"36. It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase 'in the Community' is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.

...

¹⁰ Exhibit RM-12.

¹¹ Paragraphs 4.3 and 4.4 and Exhibit RM-10.

¹² Exhibit RM-1.

50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national mark.”

...

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

27. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited* [2016] EWHC 52, Arnold J (as he then was) reviewed the case law since *Leno* and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in

Leno are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument is not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that 'genuine use in the Community will in general require use in more than one Member State' but 'an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State'. On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in

terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

28. The General Court (“GC”) restated its interpretation of *Leno* in *TVR Automotive Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-398/13, paragraph 57. This case concerned national (rather than local) use of what was then known as a Community trade mark (now an EUTM). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM or an IR(EU) in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM or IR(EU). This applies even where there are no special factors, such as the market for the goods or services being limited to that area of the EU.

29. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the comparable mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the EU during the relevant five-year period. In making this assessment, I am required to consider all relevant factors, including

- The scale and frequency of the use shown;
- The nature of the use shown;
- The goods and services for which use has been shown;
- The nature of those goods/services and the market(s) for them; and
- The geographical extent of the use shown.

30. The evidence shows significant sales of cat food within the UK, and the brand awareness reports show that efforts were being made to maintain a market in the EU:

“Both Felix and Whiskas have relatively high awareness and consideration compared to all the competition. They compete most closely in DE and the UK.”¹³

¹³ Exhibit RM-15, page 3.

“The picture is similar for repurchase to loyalty. Felix overperforms in DE and the UK and competes with Whiskas closely, whilst Whiskas continues to have a clear lead in FR, IT and RU.”¹⁴

“Felix in FR is very slightly lower than expected.”¹⁵

31. The FELIX logo mark is used on all the cat food packaging and advertising material, as seen, for example, on the banner advertising used on the Tesco website in 2018:¹⁶



32. As can be seen above and on the packaging shown in paragraph 18, the FELIX logo mark appears with a PURINA figurative mark. In *Colloseum Holdings AG v Levi Strauss & Co*, Case C-12/12, the CJEU held that:

“32. ... the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

...

35. Nevertheless, ... a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1).”

33. I find that the FELIX logo mark remains capable of being used as an indication of origin when used with the PURINA mark. There is another point that I need to address,

¹⁴ Exhibit RM-15, page 7.

¹⁵ Exhibit RM-15, page 7.

¹⁶ Exhibit RM-10, page 20.

and this relates to the colour of the mark. The FELIX logo mark is registered in black. Such a registration protects the use of the mark in any colour: see *Specsavers International Healthcare Limited & Ors v Asda Stores Limited*, [2014] EWCA Civ 1294, paragraph 5, and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, paragraph 47. However, it is not appropriate notionally to apply complex colour arrangements to a mark registered in black and white.

34. The FELIX logo mark frequently appears with the words in one colour, often white, and the paw print device in another, often red. This can be seen on the examples of packaging in paragraph 18. I shall therefore consider whether this is an acceptable variant form of the logo mark. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to this test. He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EUIPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

35. I consider that the slightly stylised word FELIX is the dominant and distinctive element of the logo mark. The paw print is small, and the difference in colour does not in my view alter the distinctiveness of the mark as registered. Consequently, I find that this is an acceptable variant of the FELIX logo mark.

36. The FELIX word mark appears less frequently than the logo mark. The main evidence of its use can be found in the website screenshots, examples of which I have reproduced in paragraphs 20 and 21. The word mark is also used on social media. A tweet dated 22 October 2020 from @catslikefelix begins: “*Introducing NEW Felix Pick ‘n’ Mix*”.¹⁷ The Twitter account has 2,157 followers, although it is not clear at what date or where the followers are located. The Facebook account has over 1.378 million

¹⁷ Exhibit RM-9, page 3.

followers, but the same caveats apply.¹⁸ Later in the same exhibit, it can be seen that a Facebook post from 18 January 2017 received 2,700 likes and 288 comments.¹⁹

37. I find that both marks have been used in the relevant territories during the relevant period for cat food. As the specifications of both marks cover goods that are not shown within the evidence, I must consider what would be a fair degree of protection. In *Euro Gida Sanayi ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, summed up the law as follows:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”²⁰

38. In *Property Renaissance t/a Titanic Spa v Stanley Dock Hotel Ltd t/a Titanic Hotel Liverpool & Ors* [2016] EWHC 3103 (Ch), Carr J said:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

¹⁸ Exhibit RM-9, page 2.

¹⁹ Exhibit RM-9, page 11.

²⁰ Pages 10-11.

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

39. In my view, the average consumer would view cat food as an independent subcategory of goods within the broader term *Animal food* or *Animal foodstuffs*. Therefore, I find that a fair specification for the word and logo marks respectively would be *Cat food* or *Cat foodstuffs*.

Section 5(2)(b): the principles

40. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the CJEU 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 BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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; and

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

41. It is settled case law that I must make my comparison of the goods on the basis of all relevant factors. These may include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Goods are complementary when

“... 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.”²¹

42. The goods to be compared are shown in the table below:

²¹ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

Earlier goods	Contested goods
	<u>Class 18</u> <i>Dog leashes; Clothing for pets; Collars for pets; Dog collars; Dog coats; Dog clothing; Dog shoes; Collars for cats; Animal leashes; Animal harnesses; Covers for animals; Animal covers; Backpacks; Haversacks; Shoulder bags; Rucksacks for mountaineers; Shoulder straps; Backpacks [rucksacks]; Card wallets; Alpenstocks; Muzzles.</i>
<u>Class 31</u> <i>Cat food (Word mark)</i> <i>Cat foodstuffs (Logo mark)</i>	

43. In *SEPARODE Trade Mark*, BL O-399-10, Geoffrey Hobbs QC, sitting as the Appointed Person, stated:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”²²

44. I shall first compare the earlier goods with the applicant’s *Clothing for pets; Collars for pets; Collars for cats; Animal leashes; Animal harnesses; Covers for animals; Animal covers; Muzzles*. These terms cover goods that could be used with or on cats, although I accept that in the case of some of these products there may be a degree of reluctance on the part of the animal. I agree with the opponent that they will have the same end consumer and share trade channels, being sold either in specialist pet product retailers or the same aisle or area of general stores such as supermarkets.

²² Paragraph 5.

The purpose, nature of the goods and method of use, however, are different, and they are not in competition. The opponent submits that they are complementary, but, returning to the explanation given by the GC in *Boston Scientific*, I do not see that the opponent's goods are necessary for the use of the applicant's (or vice versa) in such a way as to lead the consumer to believe that they are the responsibility of the same undertaking. Taking all these factors into account, I consider that there is a low degree of similarity between the earlier and the contested goods.

45. The next group I come to is comprised of *Dog leashes; Dog collars; Dog coats; Dog clothing; Dog shoes*. These are further removed from the earlier goods than the group I have just considered. While they may indeed share trade channels, the end user is different, being a dog rather than a cat. If there is any similarity between the goods, it is very low.

46. The opponent has admitted that *Alpenstocks* are dissimilar to the earlier goods.

47. The opponent submits that *Backpacks; Haversacks; Shoulder bags; Rucksacks for mountaineers; Shoulder straps; Backpacks [rucksacks]; Card wallets* have a low degree of similarity to its own goods. First, it argues that the goods are complementary because of the merchandising possibilities. The opponent has indeed, at least before the relevant period, sold a number of products featuring the Felix cat character, including tea towels, bags for life, mouse mats and slippers.²³ Again, though, I do not consider that these are complementary goods in the trade mark sense. Secondly, the opponent submits that all the above goods, with the exception of *Card wallets*, are available from the same retailers as its own goods. It refers me to screenshots annexed to its submissions in lieu of a hearing to support this argument. There is nothing in the evidence filed during the evidence round itself that goes to this point and the opponent has not made any request to submit additional evidence. Consequently, I shall not take these annexes into account. Any overlap in trade channels is likely in my view to be small and not sufficient to overcome the differences in nature, purpose, method of use and end user. I find that these goods are dissimilar.

²³ Exhibit RM-7.

48. If there is no similarity between the goods, there can be no likelihood of confusion under section 5(2)(b): see *eSure Insurance Limited v Direct Line Insurance Plc*, [2008] EWCA Civ 842 CA, paragraph 49. The section 5(2)(b) ground therefore fails with respect to *Backpacks; Haversacks; Shoulder bags; Rucksacks for mountaineers; Shoulder straps; Backpacks [rucksacks]; Card wallets; Alpenstocks*. I shall return to these goods under section 5(3). Section 5(2)(b) continues in respect of *Dog leashes; Clothing for pets; Collars for pets; Dog collars; Dog coats; Dog clothing; Dog shoes; Collars for cats; Animal leashes; Animal harnesses; Covers for animals; Animal covers; Muzzles*.

Average consumer and the purchasing process

49. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”²⁴

50. The goods that remain at issue under this section are (for the opponent) cat food and (for the applicant) accessories for cats and other animals. The average consumer will be an animal-owning member of the public and the frequency of purchase will vary. Food will be bought often as it is used every day. The other goods will still be purchased relatively frequently as they are subject to wear and tear and will need to be replaced fairly regularly. All the goods are relatively inexpensive, but the consumer will still consider the nutritional content of the food and its suitability for their cat. When buying the applicant’s goods, the consumer will be assessing the fit of the product and

²⁴ Paragraph 60.

its quality. Taking account of all these factors, I find that the average consumer will be paying a medium degree of attention during the purchasing process.

51. The goods are sold in bricks-and-mortar supermarkets or specialist pet stores and their online equivalents. The consumer will therefore see the mark in use on the goods themselves or in images on websites. They may also have seen promotional material in print media, online or in television and billboard advertising. In such circumstances, visual considerations will dominate. However, I do not discount the aural impact of the mark, as the consumer may have received word-of-mouth recommendations or may seek the advice of sales assistants.

Comparison of marks


52. It is clear from *SABEL* (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 in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”²⁵

53. It would be wrong, therefore, artificially to dissect the 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 created by the marks.

²⁵ Paragraph 34.

54. The respective marks are shown below:

Earlier marks	Contested mark
FELIX 	Crazy Felix

Comparison with the FELIX word mark

55. The earlier mark is a single word – the male forename FELIX – and so the overall impression of the mark necessarily lies in that word. The opponent submits that “Felix” is the dominant and distinctive element of the contested mark. The applicant disagrees and contends that the mark contains no dominant or distinctive element. The first word is an adjective applying to the second word to describe an individual named Felix who is crazy. The distinctive character of the contested mark lies in the combination of the two words, with neither more dominant than the other.

56. Visually, the earlier mark consists of five letters, while the contested mark contains two words, each of five letters, with the second word identical to the earlier mark. The applicant submits that it is established that the average consumer pays more attention to the beginning of the mark. The courts have indeed found that this tends to be the case: see, for example, *El Corte Inglés, SA v OHIM*, Joined Cases T-183/02 and T-184/02, paragraphs 81-83. However, this is not a hard and fast rule. In other cases, the courts have found that common elements at the end of marks may be sufficient to create a likelihood of confusion: see *Bristol Global Co Ltd v EUIPO*, Case T-94/14. I will come to an assessment of the likelihood of confusion later, but for the moment I take into account the shared word FELIX and find that the marks are visually similar to a medium degree.

57. The earlier mark will be pronounced as “FEE-LICKS” and the contested mark as “CRAY-ZEE FEE-LICKS”. The aural similarity arises from the third and fourth syllable of the contested mark being identical to the earlier mark. The difference is the additional syllables “CRAY-ZEE” at the beginning. I find that the marks have a medium degree of aural similarity.

58. The applicant submits that the marks share no conceptual content while the opponent submits that:

“38. In addition, the Earlier Marks have a highly distinctive conceptual meaning due to the use made of them since the 1950s: the average consumer is familiar with ‘Felix’ as a black and white cat. ...

39. Due to the conceptual meaning associated with FELIX in the petcare industry and due to the use made by the Opponent of the Earlier Marks, the dominant and distinctive element of the Contested Mark will be ‘Felix’ and, accordingly, the Earlier Marks and Contested Mark should be considered conceptually similar to a high degree.”

59. In *Retail Royalty Company v Harringtons Clothing Limited*, BL O/593/20, Philip Harris, sitting as the Appointed Person, considered a similar argument. In that case, the opponent argued that the letters “AE” had, through their use, acquired an independent conceptual significance which would mean that the average consumer would always perceive them as meaning “AMERICAN EAGLE”. He said:

“74. The Opponent is trying to equate reputation in a trade mark sense with conceptual meaning. They are not the same thing. Reputation can mean different things, and in trade mark law the term is sometimes used loosely, but in this context, it concerns the factual extent to which a sign is recognised by a significant part of the public as a *trade mark* [original emphasis].

75. In contrast conceptual meaning is, in simple terms, something akin to recognition in dictionaries (beyond a mere trade mark acknowledgement) or

a level of immediately perceptible notoriety/independent meaning, outside the confines of a purely trade mark context, of which judicial notice can be taken. Whilst a trade mark's reputation might evolve or be converted into a conceptual meaning (possibly to its detriment in terms of genericity), it needs to be properly proven.

76. It is true that there are cases where an extensive reputation has been parlayed into conceptual meaning (for example C-361/04 P *PICASSO/PICARO* and C-449/18 *MESSI*) but these are the exception rather than the rule and depend on their own facts. Furthermore, the 'reputation' element in those cases related to the fame attached to the names of the individuals for their roles in society, rather than specifically to a trade mark function. In other words, it was a different sort of reputation."

60. I am not persuaded that the reputation of the Felix cat character has achieved such a level of notoriety outside the trade mark context that it has been converted into a conceptual meaning. In my view, the average consumer will recognise FELIX as a male forename and as such it can describe any individual with that name. The GC considered the conceptual content of names in *Luciano Sandrone v EUIPO*, Case T-268/18. It said:

"84. Similarly, according to the case-law, conceptual similarity means that the signs at issue convey analogous semantic content (judgment of 11 November 1997, *SABEL*, C-251/95, EU:C:1997:528, paragraph 24).

85. Therefore, a first name or a surname which does not convey a 'general and abstract idea' and which is devoid of semantic content, is lacking any 'concept', so that a conceptual comparison between two signs consisting solely of such first names or surnames is not possible.

86. Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname,

or where that first name or that surname has a clear and immediately recognisable semantic content.

87. The Court has thus previously held that the relevant public would perceive marks containing surnames or first names of persons as having no specific conceptual meaning, unless the first name or surname is particularly well known as the name of a famous person (see, to that effect, judgments of 18 May 2011, *IIC v OHIM – McKenzie (McKENZIE)*, T-502/07, not published, EU:T:2011:223, paragraph 40; of 8 May 2014, *Pedro Group v OHIM – Cortefiel (PEDRO)*, T-38/13, not published, EU:T:2014:241, paragraphs 71 to 73; and of 11 July 2018, *ANTONIO RUBINI*, T-707/16, not published, EU:T:2018:424, paragraph 65).

88. In the present case, the Board of Appeal did not identify any concept with which the first name and surname in question could be associated. Not have the parties put forward any such arguments.

89. Therefore, the mere fact that the relevant public will associate the sign the registration of which is sought with a first name and a surname and thus with a specific, imaginary or real person, and that the earlier mark will be perceived as designating a person called Luciano is irrelevant for the purposes of a conceptual comparison of the signs at issue.”

61. Following this case law, I find that the earlier mark has no conceptual content. The contested mark will bring to mind someone called Felix who is crazy, which has a number of possible meanings, including *foolish or irrational; wildly excited; out of control; fantastic; strange; ridiculous; outrageous; excessive*.²⁶ Considering the marks as wholes, I find them to be conceptually dissimilar.

²⁶ *Collins English Dictionary*, www.collinsdictionary.com/dictionary/english/crazy, accessed on 25 June 2022.

Comparison with the FELIX logo mark

62. The FELIX logo mark consists of the word FELIX in black lower case, slightly rounded letters, rising diagonally from left to right. The font itself is not an unusual one. Above the letter “l” is a small paw print device. The word makes the largest contribution to the overall impression of the mark, although the device and presentation make a small contribution.

63. The visual differences between the marks lie in the presentation of the word FELIX and the paw print device in the earlier mark, and the addition of the word “CRAZY” in the contested mark, which is a plain word mark. In *LA Superquimica v EUIPO*, Case T-24/17, the GC held that such plain word marks protected the word or words contained in the mark in whatever form, colour or font.²⁷ Consequently, I find that the marks are visually similar to a low to medium degree.

64. The word “FELIX” is the only element of the earlier mark that will be articulated, and so I adopt the findings I made in paragraph 57 above. The marks are aurally similar to a medium degree.

65. The device in the earlier mark will be identified as an animal’s paw print. It has no counterpart in the contested mark. As regards the verbal element of the earlier mark, I adopt the analysis made in paragraphs 58 to 61 above, and find the marks to be conceptually dissimilar.

Distinctive character of the earlier marks

66. In *Lloyd Schuhfabrik Meyer*, 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

²⁷ Paragraph 39.

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 Alternberger* [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).”

67. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

68. The applicant submits that the earlier marks have an average level of inherent distinctiveness. The opponent notes that the marks have no particular meaning in connection with the goods for which they are registered. I agree: the average consumer will, as I have already noted, understand that FELIX is a male forename. The FELIX word mark has, in my view, an average level of inherent distinctiveness. I consider that this is also the case with the FELIX logo mark. The mark will be viewed as a whole and will not be artificially dissected by the consumer; nevertheless, the greater contribution towards its overall impression is made by the word. I acknowledge that in the context of cat food a paw print device may be allusive, but this plays only a minor role in the mark.

69. The opponent also submits that the inherent distinctiveness of the earlier marks has been enhanced through the use made of them and refers to the factors highlighted

by the CJEU in *Lloyd Schuhfabrik* (cited above). I have already discussed some of these when considering whether the opponent had proved it had genuinely used the marks. In the years leading up to the date of application for the contested mark, the marks had an estimated 20-28% of the UK cat food market and FELIX was the highest selling brand and significant sums have been spent in promoting the marks (over £2 million per year on advertising in the press, TV and other media and £2 million on supermarket promotions and advertising between 2016 and 2021). The evidence also shows that use has been longstanding, with the black and white cat Felix being introduced in 1988-89 and the FELIX logo mark used on packaging from at least 2007 and the earliest example of the FELIX logo mark minus the paw print device dating from 1997:²⁸



70. The opponent submits that very few pet owners (who make up the relevant public in this opposition) would be unfamiliar with the earlier marks. I have already referred to the brand's sponsorship of the popular ITV show *You've Been Framed* and the numbers of individuals exposed to the campaign. Exhibit RM-14 contains a brand awareness report produced by Kantar covering the period April to July 2020. This shows that FELIX had a brand awareness rating of 95 in a survey of cat food brands, below only Whiskas on 98.²⁹ In 2021, Kantar ranked FELIX as the most meaningful of the cat food brands.³⁰ Ms Marshall also includes in her evidence some examples of awards won by marketing campaigns in 2017, 2018 and 2020.³¹

²⁸ Exhibit RM-2, pages 47 and 51.

²⁹ Page 3.

³⁰ Exhibit RM-15.

³¹ Paragraphs 4.15-4.16.

71. On the basis of the evidence filed, I agree with the opponent's submission that the distinctiveness of the marks has been enhanced to a very high level for cat food.

Conclusions on likelihood of confusion

72. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa. I keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have in their mind.

73. For convenience, I summarise my findings below:

- The average consumer is an animal-owning member of the public who will be paying a medium degree of attention during the purchasing process;
- The visual aspects of the marks will dominate, although aural aspects may also be relevant;
- There is a low degree of similarity between the opponent's *Cat food* and the applicant's *Clothing for pets; Collars for pets; Collars for animals; Animal leashes; Animal harnesses; Covers for animals; Animal covers and Muzzles;*
- There is at best a very low degree of similarity between the opponent's *Cat food* and the applicant's *Dog leashes; Dog collars; Dog coats; Dog clothing and Dog shoes;*
- The remaining contested goods are dissimilar to the opponent's *Cat food*;
- The contested mark is visually and aurally similar to the FELIX word mark to a medium degree and conceptually dissimilar;
- The contested mark is visually similar to the FELIX logo mark to a low to medium degree, aurally similar to the logo mark to a medium degree and conceptually dissimilar; and
- The earlier marks have a very high level of distinctive character.

74. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Iain Purvis QC, sitting 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 recognised 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)."

75. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition."³²

76. He also said:

"As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."³³

77. The applicant submits that the marks are not sufficiently similar to create a likelihood of confusion. The opponent submits that there is a strong risk of direct and indirect confusion. In my view, there are sufficient differences between the marks for the average consumer not to mistake one for another, even taking into account the possibility that they may recall them imperfectly. I make this finding on the basis that the consumer will consider the mark as a whole and that the overall impression of the contested mark lies in the combination of the two words.

³² Paragraph 12.

³³ Paragraph 13.

78. I move on to considering whether there is a likelihood of indirect confusion. The opponent submits that:

“48. ... when consumers of the Applicant’s goods refer to the Contested Mark, they will instantly link this with the Opponent’s Earlier Marks and conclude that the Contested Mark is provided or endorsed by or associated with the Opponent. **This is particularly true given the personality-driven branding adopted by the Opponent when marketing the Earlier Marks ..., such as the use of adjectives like ‘clever’ and ‘mischievous’ in combination with the Earlier Marks.**

...

52. In the event that the Registry finds no direct confusion between the Contested Mark and the Earlier Marks, a finding of indirect confusion is appropriate for the following reasons:

(a) ... the common element between the Contested Mark and the Earlier Marks (namely ‘Felix’) is strikingly distinctive and the average consumer would assume that no-one other than the Opponent would be using it in a trade mark at all.

(b) The inclusion of ‘Crazy’ is the addition of a non-distinctive element to the Earlier Marks and is of the kind which the average consumer would expect to find in a sub-brand or brand extension of the Opponent. This is particularly true given the clear focus in brand campaigns of the Opponent on personality traits of Felix the cat. The average consumer is therefore likely to consider that ‘Crazy Felix’ is another offshoot of the core FELIX brand. ...

(c) For the reasons noted above, the inclusion of 'Crazy' by the Opponent would appear entirely logical and consistent with a brand extension of the Earlier Marks."³⁴

79. The opponent has, in my view, shown that the FELIX marks have a very high level of distinctiveness for *Cat food*. Nevertheless, I am not persuaded that the word FELIX is so distinctive that the average consumer would assume that no one else would use it in a trade mark context. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor QC (as he then was), sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element.³⁵ The goods at issue are different in physical nature and manufacturing processes which would guard against an assumption of an economic connection being made. It seems to me more likely that the contested mark would bring the earlier marks to mind, given the shared trade channels and the high level of distinctiveness of the earlier marks, but as Mr Mellor pointed out this would be mere association, rather than confusion.

80. The opponent's other arguments do not advance its position any further. I disagree the average consumer would assume that the inclusion of "Crazy" was a brand extension, either because it is a non-distinctive element that could be expected to be found in a sub-brand or brand extension or because it is entirely logical or consistent with a brand extension of the earlier marks.

Outcome of section 5(2)(b)

81. The opposition under section 5(2)(b) fails.

Section 5(3)

82. Section 5(3) of the Act is as follows:

³⁴ The emphasis is the opponent's.

³⁵ Paragraph 81.4.

“A trade mark which –

(a) is identical with or similar to an earlier trade mark,

[...]

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EU) in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

83. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07) and *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09). The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29, and *Intel*, paragraph 63.

d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods and/or services, the extent of the overlap between the relevant consumers for those goods and/or services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or that there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68. Whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77.

g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oréal*, paragraph 40.

i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

Reputation

84. In *General Motors*, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

85. Earlier in my decision I found that the earlier marks had acquired an enhanced level of distinctive character through the use that was made of them. The factors that were relevant to that assessment are the same as those I must consider when deciding whether the opponent has shown that the marks have a reputation. As the FELIX logo mark is a comparable mark, I must consider its reputation in the EU up to IP

Completion Day and in the UK from then until the date of application for the contested mark. In *Whirlpool Corporation & Ors v Kenwood Limited* [2009] ETMR 5 (HC), Mr Geoffrey Hobbs QC, sitting as a Deputy Judge of the High Court, held that the United Kingdom could be regarded as a substantial part of the Community.³⁶ The evidence that I have already discussed – the market share, promotional activity, brand awareness – leads me to find that the opponent’s marks had a strong reputation for *Cat food* at 1 April 2021. The evidence shows activities aimed at building an emotional engagement with the brand through the mischievous character of Felix the cat, including through Augmented Reality experiences on smartphones and in railway stations. This particular campaign won the 2020 Campaign Tech Award for Best Use of Experiential Tech for Physical Experiences. The judges said: “... *this was a fantastic campaign experience capturing a story that cat owners can relate to, bringing an emotional connection to the brand*”.³⁷

Link

86. In assessing whether the public will make the required mental link between the marks, I must take account of all relevant factors, which were identified by the CJEU in *Intel* at paragraph 42 of its judgment. I shall consider each of them in turn.

The degree of similarity between the conflicting marks

I found the contested mark to be visually and aurally similar to the FELIX word mark to a medium degree and conceptually dissimilar and to be visually similar to the FELIX logo mark to a low to medium degree, aurally similar to the logo mark to a medium degree and conceptually dissimilar.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

I found the goods intended for use with animals to be similar to a low degree to the opponent’s *Cat food*, with those specifically designed for dogs to be similar

³⁶ Paragraph 76.

³⁷ Exhibit RM-18, page 4.

to a very low degree. I found the remaining goods to be dissimilar, but note that this is not necessarily fatal to the opponent's section 5(3) claim.

The strength of the earlier marks' reputation

The earlier marks have a strong reputation for cat food.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

I found that the marks had a very high distinctive character, acquired through the use that had been made of them.

Whether there is a likelihood of confusion

I found that there was no likelihood of confusion.

87. While I found that there was no likelihood of confusion, I considered that, where the goods were similar, the contested mark would bring to mind the earlier marks. Therefore, a link is made out for the following goods: *Dog leashes; Clothing for pets; Collars for pets; Dog collars; Dog coats; Dog clothing; Dog shoes; Collars for cats; Animal leashes; Animal harnesses; Covers for animals; Animal covers; Muzzles.*

88. Notwithstanding the high level of distinctive character of the earlier marks and their strong reputation, I consider that the remaining goods are so far removed from *Cat food* that, at best, the contested marks will bring to mind the earlier marks in a manner that is only fleeting. Such a bringing to mind would not be enough for one of the types of damage to arise. A fleeting link has insufficient strength to cause customers of either the opponent or the applicant to alter their economic behaviour, either by avoiding the opponent's services or choosing to buy the applicant's, where they would not otherwise have done so. The section 5(3) ground fails with respect to

Backpacks; Haversacks; Shoulder bags; Rucksacks for mountaineers; Shoulder straps; Backpacks [rucksacks]; Card wallets; Alpenstocks.

Damage

89. Three heads of damage have been pleaded. I shall consider unfair advantage first.

90. Unfair advantage means that consumers are more likely to buy the goods and services of the contested mark than they would otherwise have been if they had not been reminded of the earlier marks. In *L'Oréal SA & Ors v Bellure & Ors*, Case C-487/07), the CJEU said:

“The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark’s image.”³⁸

91. Earlier in the same case, the CJEU also said:

“As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.”³⁹

92. The strength of the reputation and the distinctiveness of the earlier marks is such that, in my view, use of the mark for the goods listed in paragraph 87 would constitute

³⁸ Paragraph 50.

³⁹ Paragraph 41.

an unfair advantage. The relevant public are likely to wonder if the opponent has diversified into pet accessories and so the applicant will not have to spend as much on marketing and promotion to attract the attention of the consumer in a pet shop or the pet section of a supermarket or website. I find that damage is made out.

Outcome of section 5(3) ground

93. As the applicant has not shown that it has due cause to use the contested mark, the section 5(3) ground succeeds in relation to the following goods:

Class 18

Dog leashes; Clothing for pets; Collars for pets; Dog collars; Dog coats; Dog clothing; Dog shoes; Collars for cats; Animal leashes; Animal harnesses; Covers for animals; Animal covers; Muzzles.

Conclusion

94. The opposition has partially succeeded and TM Application No. 3619886 will, subject to a successful appeal, proceed to registration for the following goods:

Class 18

Backpacks; Haversacks; Shoulder bags; Rucksacks for mountaineers; Shoulder straps; Backpacks [rucksacks]; Card wallets; Alpenstocks.

COSTS

95. Both parties have enjoyed some success with the opponent's share being greater (at around 60%). In the circumstances, I award costs to the opponent that take into account this balance of success. The sum that I award to the opponent is £1280 and this is calculated as follows:

<i>Preparing a statement and</i>	
<i>considering the other side's statement:</i>	<i>£240</i>
<i>Preparing evidence:</i>	<i>£600</i>

<i>Preparing written submissions in lieu:</i>	£240
<i>Official fees:</i>	£200
TOTAL:	£1280

96. I therefore order Fang Zhongshuo to pay Société des Produits Nestlé S.A. the sum of £1280, which should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 5th day of July 2022

Clare Boucher
For the Registrar,
Comptroller-General