

O-366-21

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3448737
BY MATINA GMBH
TO REGISTER**

WOLF OF WILDERNESS

AS A TRADE MARK IN CLASSES 3, 18, 20, 21, 24, 28, 31

AND

**OPPOSITION THERETO
UNDER NO. 419673
BY MULTIFIT TIERNÄHRUNGS GMBH**

Background and pleadings

1. On 3 December 2019, Matina GmbH (“the applicant”) applied to register the trade mark shown below under number 3448737:

WOLF OF WILDERNESS

2. The application was published for opposition purposes on 13 December 2019 for the following goods:

Class 3 Detergents and care products for pets, in particular shampoos for pets [non-medicated grooming preparations].

Class 18 Muzzles; dog leashes; collars for animals; nose bags [feed bags]; dog clothing; dog shoes; covers for animals.

Class 20 Kennels for household pets; dog kennels; inflatable pet beds; portable beds for pets; dog beds; sleeping pads; dog baskets; cushions for pets; drinking bottles for pets.

Class 21 Pet feeding bowls; pet feeding and drinking bowls; brushes for pets; pet carriers; cages for household pets.

Class 24 Sleeping bags.

Class 28 Toys for pets; toys for dogs; imitation bones being toys for dogs; gymnastic and sporting articles; educating toys for pets.

Class 31 Animal foodstuff; foodstuffs for dogs; dog biscuits; chew bones.

3. MULTIFIT Tiernahrungs GmbH (“the opponent”) filed a notice of opposition on 3 March 2020. The opposition, which is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”), is directed against all the goods in the application. For its claim under sections 5(2)(b), the opponent relies upon the following European Union (“EU”) registrations:¹

¹ Although the UK has now left the EU, as these proceedings were commenced before 31 December 2020, the UK’s departure from the EU does not impact upon the opponent’s ability to rely upon the EU trade marks.

Mark 1: WILDERNESS (“word mark”)

EU application no. 013654901

Filing date: 19 January 2015

Goods:

Class 5 Veterinary preparations and additives for foodstuffs for animals, in particular those caring for animals' teeth; Medical dog treats for tooth care; Disinfectants; Nutritional supplements, Diet nutrition.

Class 28 Toys for domestic pets.

Class 31 Foodstuffs for animals; Foodstuffs and fodder for animals; Animal litter; Hay; Straw; Sand (litter for animals), in particular bird sand; Plants for indoor aquaria; Chew bones and chew sticks for domestic animals, in particular non-medical dog treats for tooth care.

Mark 2:

(“figurative mark”)



EU registration no. 012504056

Filing date: 15 January 2014

Registration date: 10 June 2014

Goods relied upon:

Class 30 Medical dog treats for tooth care.

Class 28 Toys for domestic pets.

Class 31 Foodstuffs for animals; Foodstuffs for animals; Chew bones and chew sticks for domestic animals, in particular non-medical dog treats for tooth care.

4. The applicant has put the opponent to proof of use of its figurative mark. The opponent had indicated in its Form TM7 that it intended to rely on its figurative mark in respect of all of the goods for which that mark is registered. However,

in its evidence, the opponent claims use of the mark only in relation to *foodstuffs for animals; foodstuffs for animals; chew bones and chew sticks for domestic animals, in particular non-medical dog treats for tooth care* in Class 31. Therefore, in determining on which goods the opponent is entitled to rely, I will consider the evidence of use on the basis of those goods in respect of which it has claimed use in Class 31.

5. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion including a likelihood of association arising from the claimed similarity between the parties' marks and the identity or similarity of the goods at issue.
6. Under section 5(3), the opponent relies only upon its word mark. The opponent's claim is that the word mark has a reputation in the UK and Europe for the following goods:
 - Class 5 Medical dog treats for tooth care.
 - Class 28 Toys for domestic pets.
 - Class 31 Foodstuffs for animals; Foodstuffs for animals; Chew bones and chew sticks for domestic animals, in particular non-medical dog treats for tooth care.
7. The opponent claims not only that the use of the applicant's mark will cause the relevant public to believe that the competing marks are used by the same undertaking or an economically linked undertaking, but also submits that the applicant's mark will gain an unfair advantage by virtue of the reputation of the earlier mark, and the use of the applicant's mark will erode the earlier mark's distinctiveness.
8. Given their dates of filing, the trade marks upon which the opponent relies qualify as earlier trade marks in accordance with section 6 of the Act.
9. The applicant filed a counterstatement denying the grounds of opposition.

10. The opponent is represented by HGF Limited and the applicant is represented by White & Case LLP. Only the opponent filed evidence which I will summarise to the extent I consider necessary. A hearing was held on 4 March 2021. Ms Jennifer Dixon, Counsel, appeared on behalf of the applicant and Mr Richard Wylie, of HGF Limited, appeared for the opponent.

Evidence

11. The opponent's evidence consists of a witness statement dated 29 September 2020, by Mr Heiko Bücken, the Managing Director of the opponent company.

12. Exhibit 1 contains images taken from the website *www.real-nature.com*. Mr Bücken claims that the opponent uses the figurative mark on a range of products including pet food, pet treats and pet chews. The quality of the images provided are poor, but I can just about make out the mark on product packaging that appear to be of pet foods.

13. Mr Bücken's states that the opponent recorded sales in excess of EUR 287 million during 2014 – 2019 from the sale of goods under the "Real Nature Wilderness brand". According to Mr Bücken, Germany and Austria are the biggest market for the opponent's goods.

14. Mr Bücken states that the goods bearing the figurative mark are sold online and in-store through Maxi Zoo and Fressnapf, one of the largest retailers of pet products in the world.²

15. Brochures of Fressnapf and Maxi Zoo from the years 2016 – 2019 are provided in evidence as Exhibit 4. The brochures are from various EU countries such as Germany, Austria, and Ireland, and mostly show the use of the figurative mark on products' packaging that appear to be of pet foods. On some of the packaging, the mark is displayed with neither an image of a dog head nor strapline "pure quality for dogs". No circulation figures for the brochure have

² According Mr Bücken, Maxi Zoo is a part of Fressnapf group. See witness statement para 11.

been provided. Therefore, it is not possible to ascertain how many customers (prospective or otherwise) have seen the brochure.

16. Exhibit 5 is a collection of sample invoices issued by “Brit”, who according to Bücken, is the supplier of the opponent. The invoices are from the years 2015 – 2019. All the invoices are addressed to Fressnapf in Germany and identify goods by reference to the mark “Real Nature Wilderness”.

17. Exhibit 6 and 7 contains the opponent’s marketing materials, and screenshots of video advertisement aired in Germany. The exhibits show use of the figurative mark on pet food cans and bags for pet food. The marketing materials are in German and are from the years 2016 and 2017. The opponent, however, has not provided the circulation figures for the marketing materials, nor viewership details of the video advertisement. Mr Bücken claims that the opponent invests a significant amount of money in promoting its word and figurative marks in the Europe. However, the evidence gives no figures as to the advertising expenditure spent during the relevant period.

18. Posts dated between 2014 – 2019 from Maxi Zoo’s Facebook account for the Republic of Ireland are in evidence as Exhibit 8. Mr Bücken has highlighted various pet food packaging that he claims are goods bearing the figurative mark on sale in shops in Ireland.

19. Exhibit 10 consists of a number of blogs, articles and reviews by third-parties concerning dog foods bearing the figurative mark. The documents are dated between 2015 – 2017 and consistently refer to the opponent’s mark as “Real Nature Wilderness”.

Proof of Use

20. The opponent’s figurative mark is subject to proof of use. The relevant statutory provisions are as follows:

Section 6A of the Act states:

“(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), (b) or (ba) in relation to which the conditions set out in section 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

21. Section 100 of the Act is also relevant, which reads:

“100. 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.”

22. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....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 P *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 Bunderversvereinigung 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 Merken 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 P *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].”

23. As the earlier mark is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Marken BV v Hagelkruis Beheer BV*, Case C149/11, that applies to trade marks subject to proof of use in the EU are relevant. The court 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.”

And:

“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 trade mark."

And:

"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 13 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)".

24. At paragraphs 57 and 58, the court held that:

"Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions

are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the mark concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

25. In *Awareness Limited v Plymouth City Council*,⁷ Mr Daniel Alexander, QC, sitting as the Appointed Person, observed that a “tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive”.

26. Pursuant to section 6A of the Act, the relevant period for assessing whether there had been genuine use of the earlier mark is the 5-year period ending with the date of application of the contested mark, i.e. 4 December 2014 – 3 December 2019.

27. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.³

28. The opponent has demonstrated sales that are spread over the entire five-year period. The evidence also shows the use of the mark in the registered form across the EU, including Germany, France, Austria and Ireland. I also note that the opponent had sold the products bearing the mark through “one of the world's largest retailers of pet products”. The turnover figures indicate sales at around 1.8 million Euros in 2014, increasing considerably to around 69 million Euros in 2019. According to Mr Bucker, the total sales figures for the relevant period was more than 287 million Euros, and it concerned the revenue generated under the “Real Nature Wilderness brand”. Raising concerns about Mr Bucker's use of the term “brand”, Ms Dixon argued that “brand” is a nebulous concept. I agree, there is vagueness in the use of the word “brand”. There is no indication that the turnover figures presented in the witness statement or the

³ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

total sales figures from the opponent's business records concern sales generated under the figurative mark. I can see reference to the term "brand" in an article titled "Real Nature Wilderness dry food in a practical test" that Mr Bückler has exhibited as Exhibit 10. The article is published on the website www.tierfutter-wiki.de, and it describes the Real Nature brand as natural and species-appropriate food that includes "countless types of cat and dog food".⁴ The brochures show that the sign "Real Nature Wilderness" is used in relation to goods for dogs and cats. Where the goods target cats, the opponent has used a different sign that comprises the words "Real Nature Wilderness" and an image of a cat head. It seems likely that the turnover figure Mr Bückler has provided include those generated from the use of the mark in the registered form as well from the use of the sign "Real Nature Wilderness" with an image of a cat. This would account for the reference to the Real Nature Wilderness "brand" as opposed to the figurative mark directly. Although Mr Bückler has not provided any breakdown figures, the product description on the invoices, when considered alongside the product packaging images on the brochures, suggests that the opponent had sold a substantial quantity of the products bearing the figurative mark to the retailers during the relevant period. There are many examples that Mr Wylie also cited from the invoices. I note that in 2015, the opponent sold over 3,000kg of dog food marked as "wide savannah adult wild boar, lamb and", bearing the figurative mark to the retailer Fressnapf. The quantities of that particular dog food sold under the figurative mark were nearly 2,000kg in 2018. Considering the evidence as a whole, I am satisfied that the opponent has demonstrated genuine use of the mark sufficient to create and maintain a market in the EU for the products in evidence.

29. The next step is to decide whether the extent of use entitles the opponent to rely upon all the goods for which it has claimed use. The opponent has claimed genuine use of the mark in relation to *foodstuffs for animals; chew bones and chew sticks for domestic animals, in particular non-medical dog treats for tooth care* in Class 31. The evidence suggests that the figurative mark is used only in relation to dog food. On the opponent's website, the figurative

⁴ See page 1/7

mark appears under a tab identified by a picture of a dog, and it describes “Real Nature Wilderness” as “dry and wet dog food”.⁵ The product description on the invoices and the product packaging shown on the brochures also suggest that the mark is used only in relation to dog foods. There is some evidence of the use of chew snacks for dogs labelled as “lamb ears”, for example, which I understand is a type of dog food. I also understand that chew snacks are also used as non-medical dog treats for tooth care. However, it is not clear whether the evidence demonstrates the use of the mark in relation to chew bones for dogs. To my mind chew bones also belong to the same group of snacks for dogs for which the opponent has demonstrated the use of the mark. Therefore, I give the opponent the benefit of the doubt.⁶ However, I am not satisfied that the opponent has demonstrated the use in relation to the broad specification namely, *foodstuffs for animals; chew bones and chew sticks for domestic animals*. Therefore, I must devise a fair specification. In arriving at a fair specification, I bear in mind the law summed up by Mr Geoffrey Hobbs Q.C. as Appointed Person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*:

“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.”⁷

30. I consider that the average consumer would describe the category of goods upon which the use has been shown as:

Class 31 - Foodstuffs for dogs; chew bones and chew sticks for dogs, in particular non-medical dog treats for tooth care

Section 5(2)(b)

⁵ Exhibit 1

⁶ [2015] EWCA Civ 220

⁷ BL O/345/10

31. 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”.

Case law

32. The following principles are gleaned from the judgments 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 C3/03, *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 the 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 to mind the earlier mark, is not sufficient;

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

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

Comparison of goods

33. When making a comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

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

34. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

35. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

36. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

37. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court held that the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application or vice versa.

38. The opponent relies on two earlier marks. I have already concluded that the opponent is only entitled to rely on foodstuffs for dogs; chew bones and chew sticks for dogs, in particular non-medical dog treats for tooth care under its figurative mark. The respective specifications are listed below:

Applicant's goods	Opponent's goods
<p><u>Class 3</u></p> <p>Detergents and care products for pets, in particular shampoos for pets [non-medicated grooming preparations].</p> <p><u>Class 18</u></p> <p>Muzzles; dog leashes; collars for animals; nose bags [feed bags]; dog clothing; dog shoes; covers for animals</p> <p><u>Class 20</u></p> <p>Kennels for household pets; dog kennels; inflatable pet beds; portable beds for pets; dog beds; sleeping pads; dog baskets; cushions for pets; drinking bottles for pets.</p> <p><u>Class 21</u></p> <p>Pet feeding bowls; pet feeding and drinking bowls; brushes for pets; pet carriers; cages for household pets.</p>	<p>Word Mark</p> <p><u>Class 5</u></p> <p>Veterinary preparations and additives for foodstuffs for animals, in particular those caring for animals' teeth; Medical dog treats for tooth care; Disinfectants; Nutritional supplements, Diet nutrition.</p> <p><u>Class 28</u></p> <p>Toys for domestic pets.</p> <p><u>Class 31</u></p> <p>Foodstuffs for animals; Foodstuffs and fodder for animals; Animal litter; Hay; Straw; Sand (litter for animals), in particular bird sand; Plants for indoor aquaria; Chew bones and chew sticks for domestic animals, in particular non-medical dog treats for tooth care.</p> <p>Figurative Mark</p> <p><u>Class 31</u></p> <p>Foodstuffs for dogs; chew bones and chew sticks for dogs, in</p>

<p><u>Class 24</u></p> <p>Sleeping bags</p> <p><u>Class 28</u></p> <p>Toys for pets; toys for dogs; imitation bones being toys for dogs; gymnastic and sporting articles; educating toys for pets.</p> <p><u>Class 31</u></p> <p>Animal foodstuff; foodstuffs for dogs; dog biscuits; chew bones.</p>	<p>particular non-medical dog treats for tooth care.</p>
---	--

39. As the specification covered by the opponent's word mark is broader than its figurative mark, I will first compare the opponent's goods covered by its word mark with all of the contested goods. Mr Wylie argued that various pet products sit next to each other in brochures and are generally sold by the same undertaking. I agree and will bear that in mind during my assessment of similarity between the competing goods.

Contested goods in Class 3

Detergents and care products for pets, in particular shampoos for pets [non-medicated grooming preparations]

40. The applicant's goods mentioned above are pet care products used to keep pets clean, healthy and hygienic, while veterinary preparations in the earlier mark are medicines used to prevent or treat diseases. The nature of the goods is likely to coincide as all these goods are, broadly speaking, chemical preparations. Their method of use is also likely to be the same as they can be applied to skin or hair. The applicant's goods are likely to be sold through pet retailers or supermarkets, so is the case with non-prescription veterinary goods.

The competing goods are, therefore, likely to share channels of trade. The users are the same. However, the goods are neither complementary nor do they compete. Considering these factors, I find that the competing goods are similar to a medium degree.

Contested goods in Class 18

Muzzles; dog leashes; collars for animals; dog clothing; dog shoes; covers for animals

41. The above-mentioned goods covered by the application are used to keep dogs under control or protect them. The nature, purpose and method of use of these goods are different from foodstuffs for animals in the earlier mark. However, the goods are likely to overlap in trade channels and users. Based on those factors, I find that the competing goods are similar to a low degree.

Nose bags [feed bags]

42. Nose bags [feed bags] covered by the applicant's specification are designed to feed animals like horses in public places to eliminate spillage from eating. The nature, purpose and method of use of the applicant's goods differ from foodstuffs for animals covered by the opponent's specification. The opponent's foodstuffs are indispensable or important for the use of the applicant's feed bags and the average is likely to think that both goods originate from the same undertaking. The channels of trade and users are likely to coincide. Considering these factors, I find that the competing goods are similar to a medium degree.

Contested goods in Class 20

Kennels for household pets; dog kennels

43. The nature, purpose and method of use of the above-mentioned goods are different from foodstuffs for animals covered by the opponent's specification. However, the applicant's goods are likely to share users and channels of trade. Considering these factors, the competing goods are similar to a low degree.

Inflatable pet beds; portable beds for pets; dog beds; sleeping pads; dog baskets; cushions for pets;

44. The applicant's above-mentioned goods are various types of beddings for pets/dogs whose nature, purpose and method of use are different from foodstuffs for animals covered by the opponent's specification. Their channels of trade and users are likely to overlap. On that basis, I find that the competing goods are similar to a low degree.

Drinking bottles for pets

45. The term drinking bottles for pets in the application appears to have been misclassified; it is appropriate to Class 21. I will, therefore, consider these goods together with the other goods in Class 21 in the application.

Contested goods in Class 21

Pet feeding bowls; pet feeding and drinking bowls, drinking bottles for pets

46. The nature, purpose and method of use of the applicant's pet feeding and drinking bowls and drinking bottles are different from foodstuffs for animals. Animal foodstuffs in wet, dry or liquid form are indispensable for the use of the applicant's goods. The average consumer is likely to think that the goods originate from the same undertaking. The competing goods are, therefore, complementary in the sense described by the case law. The users are the same, and the channels of trade are likely to overlap. The goods do not, however, compete. Considering these factors, I find that the competing goods are similar to a medium degree and not to a high degree, as argued by the opponent.

Brushes for pets

47. Due to the overlap in users and channels of trade, I find that the applicant's goods are similar to foodstuffs of animals covered by the opponent's specification to a low degree.

Pet carriers; cages for household pets

48. These goods do not share nature, purpose and method of use with foodstuffs for animals which are intended for consumption. The users and channels of trade are likely to overlap. They are neither complementary nor do they compete. Considering these factors, I find that the goods are similar to a low degree.

Contested goods in Class 24

Sleeping bags

49. I agree with the opponent that the term sleeping bags are apt to cover sleeping bags for pets used to keep pets warm and comfortable. Ms Dixon argued that the applicant's goods are sold ordinarily through shops that sell sleeping bags for hiking or camping for humans. In the absence of evidence, I am not convinced that this is the case. Given that the applicant's goods are aimed at pets, it is more likely that the channels of trade of the applicant's goods overlap with the opponent's foodstuffs for animals. The users are the same. The nature, purpose, method of use of the competing goods differ. They are neither complementary in the sense described by the case law, nor do they compete. Considering these factors, I find that the goods are similar only to a low degree.

Contested goods in Class 28

Toys for pets; toys for dogs; imitation bones being toys for dogs; gymnastic and sporting articles; educating toys for pets

50. The applicant concedes that toys for pets covered by the application are identical to toys for pets in the opponent's specification. I also find that the remainder of the applicant's goods namely, *toys for dogs; imitation bones being toys for dogs; educating toys for pets* falls within the broad category of

the term “toys for pets” covered by the opponent’s mark and are, therefore, identical under the *Meric* principle. *Gymnastic and sporting articles* is a broad term and include gymnastic and sporting articles such as balls, hoops, ropes and rings which are also used as toys for pets. On that basis, I find that the competing goods are identical under the *Meric* principle. If I am wrong on this finding, then the applicant’s *gymnastic and sporting articles* are similar to the opponent’s toys for pets to a high degree.

Contested goods in Class 31

Animal foodstuff; foodstuffs for dogs; dog biscuits; chew bones

51. The applicant admits that the competing goods in Class 31 are identical. I agree. The applicant’s *animal foodstuff; foodstuffs for dogs; dog biscuits; chew bones* are either identically contained in the opponent’s specification or falls under the broad category of the term “animal foodstuffs” covered by the opponent’s trade mark.

Goods covered by the opponent’s figurative mark

52. I now turn to the goods covered by the opponent’s figurative mark.

Contested goods in Class 3

53. The nature, purpose and method of use of the applicant’s *detergents and care products for pets, in particular shampoos for pets [non-medicated grooming preparations]* are different from foodstuffs for dogs covered by the opponent’s specification. The competing goods are neither complementary nor do they compete. The applicant’s detergents and care products are likely to be sold alongside or in shelves in close proximity to foods stuffs for animals in supermarkets or retail pet shops. The competing goods are, therefore, likely to share channels of trade. The users are the same. Considering these factors, I find that the goods are similar to a low degree.

Contested goods in Classes 18, 20, 21, 24 and 31

54. I have already concluded that all of the applicant's goods in Classes 18, 20, 21, 24 and 31 are either identical or similar to foodstuffs for animals covered by the word mark to varying degrees. Foodstuffs for animals include foodstuffs for dogs. Therefore, my conclusion on the degree of similarity between the competing goods applies equally here except for nose bags [feed bags] in Class 18 covered by the application.

Nose bags [feed bags] in Class 18

55. As mentioned earlier in the decision, nose bags are usually used to feed horses. It does not appear nor there is evidence that nose bags in the application are used to feed dogs. Therefore, the opponent's foodstuffs for dogs are neither indispensable nor important for the use of the applicant's goods. The goods are not complementary in the sense described by the case law. However, nose bags are likely to share channels of trade and users with foodstuffs for dogs covered by the figurative mark. On that basis, I find that the competing goods are similar to a very low degree.

Contested goods in Class 28

56. *Toys for pets; toys for dogs; imitation bones being toys for dogs; educating toys for pets* in the application include toys for chewing. The earlier mark covers chew bones for dogs. The competing goods, therefore, share nature and method of use. The goods, however, differ in their purpose because foodstuff for dogs in the earlier mark is used to satiate hunger while a toy is used to entertain pets/dogs. The users are the same. The goods are likely to be sold through the same distribution channels. Considering these factors, I find that the competing goods are similar to a medium degree. *Gymnastic and sporting articles* are toys such as ropes or rings used to perform gymnastic or play sports. I do not think chew bones are used as a gymnastic and sporting article. On that basis, I find that the nature, purpose and method of use of the competing goods differ. They are neither complementary nor do they compete.

However, the competing goods are likely to share channels of trade and users. Weighing up these factors, I find that the competing goods are similar to a very low degree.

The average consumer and the nature of the purchasing act

57. It is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer.

58. 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”.

59. I consider that the average consumer of respective parties' goods is a member of the pet-owning general public. The goods are most likely to be chosen from supermarkets or pet shops, or after perusal of the internet or from catalogues/brochures. Visual considerations are, therefore, likely to dominate the purchase process. There may be aural considerations when the choice is made further to references or recommendations.

60. The specifications of the respective marks cover a range of goods for pets such as shampoos, muzzles, pet beds, toys or pet foods. Mr Wylie argued that the level of attention of the average consumer is low as the consumer spends only

a relatively small amount of time for the purchase of the competing goods. Ms Dixon, on the contrary, argued that the level of attention of the average consumer is medium and, citing the decision in *Avnet Incorporated v Isoact Ltd*, further argued that the consumers display a high degree of attention during online purchase.⁸ As agreed by the parties, the goods covered by the competing trade marks are low value goods bought for pets. I think the level of attention paid during the purchase process is likely to vary according to the category of the goods. The average consumer is likely to select pet feeding bowls and brushes in Class 21, cushions and beds in Class 20, sleeping bags in Class 24 and pet toys in Class 28 in a casual manner paying only a low degree of attention. However, the selection of the remainder of the goods in the respective specifications such as pet food, kennels or shampoos is likely to attract a medium degree of attention. These goods are unlikely to be an impulsive purchase. The average consumer is likely to pay some care and attention to ensure to choose the right pet food or pet cage. However, the purchase process is unlikely to entail a high degree of attention even if purchased online.

Distinctiveness of the earlier marks

61. The distinctive character of the earlier marks must be considered. The more distinctive they are, either inherently or through use, then potentially the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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

⁸ [1998] FSR 16

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).”

62. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods have the lowest. Distinctiveness can also be enhanced through use of the marks. Mr Wylie indicated at the hearing that the opponent did not intend to press its case on enhanced distinctiveness. Therefore, it is only necessary for me focus on the inherent distinctiveness.

63. I will first consider the position in relation to the opponent’s figurative mark.

64. Although the applicant accepts the distinctiveness of the figurative mark, I must still assess the degree of distinctiveness because the more distinctive the earlier mark, the greater potential the likelihood of confusion (to the extent that the distinctiveness arises from a similar element shared by the marks at issue). There are a number of elements in the figurative mark. The image of a dog head and the strapline “pure quality for dogs” possesses no distinctiveness in relation to food stuffs for dogs. The words “Real Nature” is descriptive of foodstuffs for dogs because the words are likely to be understood as referring

to the natural ingredients contained in the food.⁹ In relation to the distinctive character of the word “wilderness”, the opponent argues that the word wilderness possesses a medium degree of distinctive character. Although Mr Wylie elaborately took me through the EUIPO decision on the assessment of the distinctive character of the word “wilderness”, the decision is not binding upon me.

65. Distinguishing between the words wild and wilderness, Mr Wylie further argued that the word wilderness has no descriptive meaning in relation to the opponent's goods and that the consumers are likely to use the word wild and not wilderness to refer to a product from the wild. I agree that wilderness is not a readily used term to describe any characteristics of a product. Mr Wylie's argument, however, does not suggest that the word lacks any allusive character. I think the term wilderness is not particularly distinctive in relation to foodstuffs for dogs. The expression conjures up the idea of a somewhat remote natural landscape. In relation to dog food, the word wilderness is likely to call to the average consumer's mind food found in the natural environment or the nutritional characteristics of wild food. Considering the mark as a whole, I find that the mark's distinctiveness is limited; it possesses a distinctive character between low and medium.

66. I now turn to the opponent's word mark. The applicant submits that the distinctiveness of the word “wilderness” is “very low – enough to just pass the distinctiveness threshold when examined by the EUIPO but no more distinctive than that.” Bearing in mind the allusive nature of the term wilderness, I find that the mark possesses only a lower than medium degree of distinctive character in relation to foodstuffs for animals in Class 31 and no more than a medium degree of distinctive character in relation to the remainder of the goods.

Comparison of marks

⁹ The descriptive nature of the words “Real Nature” in relation to food for animals in Class 31 was considered by the GC in Case T - 458/1. I see no reason why similar considerations should not apply to this case.

67. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the 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.”

68. It would be wrong, therefore, artificially to 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.

69. The trade marks to be compared are as follows:

Opponent’s trade mark	Applicant’s trade mark
<p data-bbox="336 1496 746 1532">Word Mark – WILDERNESS</p> <p data-bbox="336 1608 579 1644">Figurative Mark -</p> 	<p data-bbox="962 1496 1225 1532">Wolf of wilderness</p>

70. I will first consider the position in relation to the figurative mark.

Figurative mark

71. The opponent's figurative mark consists of a number of elements. An image of a Labrador head, the words "Real Nature" and "Pure quality for dogs" appear one below the other on a rectangle in vertical orientation on the left-hand side of the mark. The words "Real Nature" is mildly stylised, mixing letter casing. To its right, the word "WILDERNESS" in capital letters is presented in a rectangle in horizontal orientation. The letters forming the word "WILDERNESS" is presented in a faded pattern and the rectangle on which it is presented occupies almost two-thirds of the total area of the mark. Due to its size and position, I think, the overall impression of the mark is dominated by the word "WILDERNESS". A lesser role is played by the words "Real Nature". In relation to foodstuffs for dogs, the image of a dog head plays a much weaker role in the overall impression of the mark. Due to the small font size and rather generic message, the contribution of the strapline to the overall impression of the mark is negligible.

72. The applicant's mark is a word mark for "Wolf of Wilderness". The opponent argues that the word "wilderness" is the dominant element in the applied-for mark, and it possesses an independent distinctive role within that mark. In contrast, the applicant submits that the words constituting the mark forms an "alliterative phrase". I agree with the applicant. I think the combination of the words hangs together to form a unit. The overall impression the trade mark conveys and its distinctive character lies in its totality.

73. Visually, the marks coincide in the word "WILDERNESS". However, there are a number of other elements in the opponent's mark such as the words "Real Nature" and a dog head that are absent from the applicant's mark. The applicant's mark also contains the additional words "wolf of". Considering the similarities and differences and my assessment of the overall impression of the respective marks, I find that the marks are visually similar to a low degree.

74. In an aural comparison, it is well-established that when a trade mark consists of a combination of words and figurative components, the trade mark is most

likely to be referred to by the words. At the hearing, Mr Wylie argued that the aural similarity between the marks are high as wilderness is the only part in the figurative mark that is likely to spoken. I disagree. The nature of the strapline and font size of the words pure quality for dogs means that they are unlikely to be verbalised. Although the phrase Real Nature is descriptive of the opponent's goods, it is readily noticeable in the mark and could still play a role in the aural comparison of the marks.¹⁰ As evidence suggests, the figurative mark is consistently referred to as Real Nature Wilderness. The manner in which the mark is described on the opponent's website, brochures or third-party blog posts is likely to influence how the average consumer may articulate the mark. Considering these factors, in my view, a proportion of the average consumer is likely to articulate the opponent's mark as "Real Nature Wilderness". The competing marks, therefore, coincide in the pronunciation of the word wilderness, present as the last word in the respective marks. The difference in the pronunciation of the words Real Nature and wolf of at the beginning of the marks render the aural similarity between the marks at a degree that is low. Due to its more dominant and the distinctive role in the mark, I also factor into account that some average consumers may verbalise only the wilderness element in the opponent's mark. In those circumstances, the marks coincide in the pronunciation of the word wilderness which is the last word in the applicant's mark. Considering these factors, I find that the marks are aurally similar to a medium degree.

75. In a conceptual comparison, the opponent's mark evokes more than one concept. For goods intended for dogs, the concepts evoked by the image of a dog head and the strapline are not likely to be particularly strong. The most likely concept that strike the average consumer from the words "real nature" is the natural ingredients present in the food. As already mentioned, the word wilderness in the mark is likely to evoke the concept of food found in natural environment or land in a natural state (wilderness). In contrast, the applicant's mark suggests the concept of a wolf in the wild. Even though there is a concept

¹⁰ In HH hotels O/235/20, the Appointed Person held that the Hearing Officer was right to assess the marks as a whole- even though the word HOTELS may be descriptive of the services, it still plays a role in the aural and visual comparison of the marks.

of wildland present in both marks, as argued by Ms Dixon, the concept that is evoked by the applicant's mark is that of a wild wolf. The words "of wilderness" qualify a wolf, and as rightly noted by Mr Wylie, a wolf is expected to be in the wilderness. Therefore, in my view, it is the concept of wolf that is particularly strong in the applicant's mark. Considering these factors, I find that marks are conceptually similar to a low degree.

Word Mark

76. Turning to the opponent's word mark, I find that the overall impression and the distinctiveness of the mark lie in the word "Wilderness.

77. On visual similarity, the opponent argued that the marks are similar to a high degree because the earlier mark is reproduced in its entirety in the contested mark."¹¹ The applicant argues that the degree of similarity between the marks is low as the reader's eye are drawn to the first two words. Visually the opponent's mark is wholly contained in the applicant's mark and the word "wilderness" occupies over half of the applicant's mark. However, the word arises at the end of the applicant's mark, which also contains the additional words "Wolf of" at the beginning of the mark, and that contributes to a certain degree of visual difference between the marks. Weighing up the similarities and differences and my assessment of overall impression of the marks, I find that the marks are visually similar to a medium degree.

78. In an aural comparison, the applicant's mark will be pronounced as three words. The marks coincide in the pronunciation of the word "wilderness" which is the last word in the applicant's mark. Considering these factors, I find that the marks are aurally similar to a medium degree.

79. Conceptually, the applicant's mark evokes the concept of a wolf that lives in the wild, while the concept evoked by the opponent's mark is that of a wildland or possibly, in relation to goods in Class 31, food having a natural origin. I have

¹¹ See the statement of grounds.

already concluded that the concept of wilderness is not particularly strong in the applicant's mark as the focus is likely to be on a wolf. Applying those conclusions, I find that the marks are conceptually similar to a low degree.

Likelihood of confusion

80. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the trade marks or vice versa (*Canon* at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent's trade marks, as the more distinctive those trade marks are, then potentially the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

81. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertaking being the same or related).

82. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he 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”.

83. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., 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. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

84. I will first consider the position in relation to the opponent’s figurative mark. I have found that the competing goods are either identical or similar to varying degrees. The goods are likely to be selected with a low to medium degree of attention. I also found that the marks are visually, and conceptually similar to a low degree and aurally similar to a low or medium degree depending on how the average consumer articulates the mark.

85. Mr Wylie argued that as wolf refers to the ancestor of a dog, the “wolf of” element in the applicant’s mark will be ignored by the average consumer leading to a direct confusion. I disagree.

86. In the applicant’s mark, the words “wolf of” are prominent, just like the word wilderness. While perceiving the mark as a whole, the average consumer would notice the presence of those words at the beginning. The opponent’s mark contains several elements. When considering the figurative mark as a whole, the words “Real Nature”, although descriptive, still play a role in the mark. Even where some average consumers verbalise only the wilderness element in the figurative mark, the presence of the additional elements at the beginning of the applicant’s mark are sufficiently prominent to avoid a likelihood of direct confusion.

87. Now I turn to indirect confusion. Mr Wylie argued that the applicant's mark would lead to indirect confusion on the following bases identified by Mr Purvis QC in *LA Sugar*, namely:

(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.).¹²

88. I find that the points of differences between the competing marks, visually, aurally and conceptually, are sufficient to dispel the impact of similarity between the marks as wholes that results from the presence of the common element wilderness. In the applicant's mark, this common element does not retain an independent distinctive role. Instead, it blends with the words "wolf of" to form a phrase with its own meaning. The conceptual focus of the applicant's mark is likely to be on a wolf that is found in the wilderness. I also bear in mind that the distinctive character of the identical or similar elements in the competing marks is key in determining a likelihood of confusion.¹³ In that respect, I do not find that wilderness is so strikingly distinctive in the context of animal products that the consumer would have no reason to think that anyone else is using that word in relation to foodstuffs for dogs. It is not such an uncommon word that the average consumer would assume that the applicant's mark is a brand extension or sub-brand of the opponent. Nor does the applicant's mark simply add non-distinctive elements to the opponent's mark; instead, there are clear visual, aural and conceptual differences that excludes any likely perception of sub-branding. When identical goods are purchased with a medium degree of

¹² See O-375-10

¹³ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

attention, the average consumer is unlikely to put the similarities arising from the common word wilderness down to the same or economically related undertakings. The distance between the marks, including the clear concept of a wolf, is such that the average consumer who pays a medium degree of attention is unlikely to think that the goods come from the same or economically linked undertakings. There is no likelihood of indirect confusion.

89. I will next consider the position in relation to the opponent's word mark. Earlier in this decision, I concluded that the competing goods are either identical or similar to varying degrees. I also concluded that the competing marks are visually and aurally similar to a medium degree and conceptually similar to a low degree. I found that the earlier mark is inherently distinctive to a low degree to a medium degree.

90. In my view, the additional letters "wolf of" at the beginning of the applicant's mark are sufficiently prominent to avoid a likelihood of direct confusion. That leaves only indirect confusion to be considered.

91. The visual and aural differences between the marks arise due to the words "wolf of" as the first elements of the applicant's mark. In my view, it is to those words the average consumer's eye is likely to be drawn first. Moreover, the conceptual difference between a wolf in a wild area as opposed to a wild/uninhabited region establishes that the difference between the marks arises not only from a visual and aural point of view but also from a conceptual point of view. Even when encountered with identical goods, the average consumer who pays a low degree of attention is likely to differentiate between the marks. Due to the limited distinctive character of the word wilderness, it is unlikely for the average consumer to think that the undertakings that use the word "wilderness" as or part of their trade marks are the same or economically linked undertakings. A likelihood of confusion is even less likely where a medium degree of attention is paid to the purchase process of identical goods. The average consumer is unlikely to put the similarities between the marks down to the same or related undertakings. Accordingly, I find no likelihood of confusion, either direct or indirect, with respect to all goods covered by the application.

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

The section 5(3) grounds of opposition

93. Section 5(3) states:

“(3) 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 (EC), 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.

94. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

95. The relevant case law can be found in the following judgments of the CJEU:

Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas Salomon, Case C-487/07, L’Oreal v Bellure, Case C-323/09, Marks and Spencer v Interflora and Case C383/12P, Environmental Manufacturing LLP v OHIM.

96. 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 Saloman*, 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/services, the extent of the overlap between the relevant consumers for those goods/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 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/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/services for which the earlier mark is registered, or a serious risk that this will happen in 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 of the earlier mark; *L'Oreal v Bellure NV*, 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 (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

97. In *General Motors* the CJEU held that:

“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.”

98. As the earlier mark is an EUTM, I also keep in mind the guidance of the CJEU in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, where the court held that:

“20. By its first question, the national court in essence asks the Court, first, to clarify the meaning of the expression ‘has a reputation in the Community’, by means of which, in Article 9(1)(c) of the regulation, one of the conditions is laid down which a Community trade mark must fulfil in order to benefit from the protection accorded by that provision and, second, to state whether that condition, from a geographical point of view, is satisfied in a case where the Community trade mark has a reputation in only one Member State.

21. The concept of ‘reputation’ assumes a certain degree of knowledge amongst the relevant public.

22. The relevant public is that concerned by the Community trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector (see, by way of analogy, *General Motors*, paragraph 24, with regard to Article 5(2) of the directive).

23. It cannot be required that the Community trade mark be known by a given percentage of the public so defined (*General Motors*, by way of analogy, paragraph 25).

24. The degree of knowledge required must be considered to be reached when the Community trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark (*General Motors*, by way of analogy, paragraph 26).

25. In examining this condition, 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 (*General Motors*, by way of analogy, paragraph 27).

26. In view of the elements of the main proceedings, it is thus for the national court to determine whether the Community trade mark at issue is known by a significant part of the public concerned by the goods which that trade mark covers.

27. Territorially, the condition as to reputation must be considered to be fulfilled when the Community trade mark has a reputation in a substantial part of the territory of the Community (see, by way of analogy, *General Motors*, paragraph 28).

28. It should be noted that the Court has already ruled that, with regard to a Benelux trade mark, it is sufficient, for the purposes of Article 5(2) of the directive, that it has a reputation in a substantial part of the Benelux territory, which part may consist of a part of one of the Benelux countries (*General Motors*, paragraph 29).

29. As the present case concerns a Community trade mark with a reputation throughout the territory of a Member State, namely Austria, the view may be taken, regard being had to the circumstances of the main proceedings, that the territorial requirement imposed by Article 9(1)(c) of the regulation is satisfied.

30. The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community”.

99. Ms Dixon argued that the evidence does not support reputation of the word mark wilderness, and that the word “Wilderness” in almost every instance appears alongside “Real Nature”.

100. I have already concluded that the opponent’s evidence demonstrates genuine use of its figurative mark in relation to *foodstuffs for dogs; chew bones and chew sticks for dogs, in particular non-medical dog treats for tooth care* in Class 31. The opponent relies on the same evidence to claim reputation in the word mark “wilderness”, which is one of the elements of its figurative mark. For the purpose of assessing reputation under section 5(3), I will focus only on those goods for which the opponent has demonstrated the use.

101. According to Mr Wylie, the opponent’s evidence shows significant sales and reputation of the mark wilderness in the EU, in particular in Ireland. Citing *Iron & Smith kft v Unilever NV*, Mr Wylie also argued that the threshold of knowledge of the mark required in the UK is low once reputation has been established in the EU.¹⁴ He further argued that due to the free movement of people across the borders of the Republic of Ireland and the Northern Ireland, a commercially significant part of the public in the UK would be aware of the opponent’s Wilderness mark.

102. Throughout the evidence, the opponent has demonstrated the use of its figurative mark that incorporates the word “WILDERNESS”. Although this element is the distinctive and more dominant element of the figurative mark, there is no indication in the evidence that the “wilderness” element alone has recognition among the relevant public. The mark is consistently referred to as “Real Nature Wilderness” in brochures/blogs/invoices and even on the opponent’s website. The invoices from Google on advertising show no more than the use of the words “Real Nature” as a keyword. The full extent of the use of the mark wilderness is also not clear from the evidence as the turnover figures relate to the sale of goods under the “Real Nature Wilderness brand”. There is no information about the amount spent on marketing the wilderness

¹⁴ C-125/14

mark either. Considering the evidence as a whole, I am not satisfied that the significant part of the public recognises the mark wilderness for the opponent's goods. Even if there is a recognition, I think it is likely to be based upon the knowledge of the various components which make up the figurative mark, particularly, as evidence suggests, the elements "real nature" and "wilderness". Without a reputation, the section 5(3) ground fails at the first hurdle. Even if I am wrong on this finding, I am not satisfied that the opponent has demonstrated, by way of evidence, that the wilderness mark is known by a commercially significant part of the public in the UK. The mark appears to have been used outside the UK, predominantly in Germany, Austria and France, for about 5 years prior to the relevant date. There is limited evidence of the use of the mark in the Republic of Ireland. Mere assertion that the relevant public in the Northern Ireland may have come across the mark due to the free movement of the people across the borders is not enough. In the absence of evidence, I reject Mr Wylie's argument that a commercially significant part of the relevant public in the UK would have a basis from which to make a mental link with the mark.

103. The opposition under section 5(3) fails.

Conclusion

104. The opposition has failed. The application will proceed to registration for all the goods.

Costs

105. The applicant has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice ("TPN") 2/2016. I award costs to the applicant on the following basis:

Official fee: £200

Considering the notice of opposition and

filing the counterstatement:	£200
Considering the other party's evidence:	£500
Preparing for and attending hearing:	£600
Total:	£1,500

106. I order MULTIFIT Tiernahrungs GmbH to pay Matina GmbH the sum of £1,500. This sum is to be paid within two months of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th May 2021

Karol Thomas
For the Registrar
The Comptroller-General