

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2183820  
BY PHOENIX PET FOODS LIMITED  
TO REGISTER THE TRADE MARK:**



**IN CLASS 31**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No 49732 BY MARS UK LIMITED**

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF Application No 2183820 by Phoenix Pet Foods Limited**  
**to register the trade mark:**

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**in class 31**  
**and**  
**IN THE MATTER OF Opposition thereto under No 49732**  
**by Mars U.K. Limited**

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**Background**

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On 5 May 1998 Phoenix Pet Foods Limited of Co. Cavan, Republic of Ireland applied to register the trade mark:

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in respect of the following goods: *foodstuffs for animals*, in class 31.

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On 6 May 1999 Mars U.K. Limited of Slough filed notice of opposition to this application.

The opponent stated that he is the registered proprietor of the following United Kingdom trade mark registrations.

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- No 749688 which was registered for the trade mark **BUSTER** in respect of: *food for animals* in class 31.

- No 2134690 which is registered for the trade mark:



in respect of: *grains and seeds; live animals, birds and fish; foodstuffs for animals, birds and for fish and preparations for use as additives to such foodstuffs; malt; cuttlefish bone; bones for dogs; litter for animals* in class 31.

- No 2160541 which is registered for the trade mark **FRESHBUSTER** in respect of: *agricultural, horticultural and forestry products, grains and seeds, all included in Class 31; live animals, birds and fish; foodstuffs for animals, birds and for fish and preparations included in Class 31 for use as additives to such foodstuffs; malt; cuttlefish bone; bones for dogs; litter for animals; fresh fruit and fresh vegetables* in class 31.

- No 2178472 which is registered for the trade mark:



in respect of: *veterinary preparations and substances; additives for animal foods; disinfectants; pesticides; powders, sprays and collars, all for killing fleas and all for use with animals; medicated shampoos and detergents all for use with animals* in class 5 and: *agricultural, horticultural and forestry products, grains and seeds, all included in Class 31; live animals, birds and fish; foodstuffs for animals, birds and for fish and preparations included in Class 31 for use as additives to such foodstuffs; malt; cuttlefish bone; bones for dogs, litter for animals; fresh fruit and fresh vegetables* in class 31.

All the above registrations have an earlier filing date than the application in suit.

The opponent stated that the above trade marks are identical to the application in suit and encompass identical goods. Therefore registration of the application in suit would be contrary to Section 5(1). He stated that the above trade marks are similar to the application in suit and encompass identical goods. Therefore registration of the application in suit would be contrary to Section 5(2). The opponent stated that owing to its reputation and goodwill in relation to the above registrations that registration of the trade mark is likely to be prevented by the law of passing off. Registration of the application in suit would, therefore, be contrary to Section 5(4).

The opponent requested an award of costs.

The applicant filed a counterstatement denying the above grounds and seeking an award of costs.

5 Both parties filed evidence. They both agreed that a decision could be made on the basis of the papers filed. Consequently a decision will be taken from a careful study of the papers.

Acting on behalf of the Registrar I duly give the following decision.

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### **Opponent's evidence**

15 The opponent's evidence consists of a statutory declaration by Joanne Sykes, who is the marketing director of Pedigree Masterfoods, a subsidiary of Mars U.K. Limited, dated 20 April 2000. The evidence furnished by the applicant in relation to his trade marks all shows use of the trade mark Breath Buster (often in the form of registration no 2176472) in combination with the house mark Pedigree. It is in used in relation to biscuits for dogs that help to fight bad breath. In such a context Breath Buster very much acts as a descriptor. Taking into account also of its use with a house mark, I do not consider that the evidence furnished by the opponent in relation to use of his trade mark can assist him and, therefore, I will say no more about it.

20 The opponent also stated that he is the only proprietor of registrations in class 31 incorporating the word BUSTER. He asserted that, therefore, he has a monopoly in the word BUSTER in relation to pet foods.

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The opponent also furnished a sample of the packaging for the applicant's goods. He stated that this was predominantly in yellow - however as he only supplied a black and white photocopy this cannot be confirmed. He also stated that BUSTER is shown solus on the packaging. In fact, the word BUSTER appears as a name plate attached to a dog's kennel.

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### **Applicant's evidence**

35 The applicant's evidence consists of a witness statement by Anthony Xavier Gallafent, who is the trade mark attorney of the applicant, dated 20 July 2000. Mr Gallafent commenced by dealing with the evidence of use of the opponent. However, owing to my comments above it is not necessary to rehearse this.

40 Mr Gallafent stated that the opponent's trade mark registration no 749688 was the subject of an application for revocation for non-use. He stated that the evidence did not support the opponent's claim to enjoy a monopoly in the word BUSTER.

45 Mr Gallafent stated that he had been advised by the applicant, via his Irish trade mark attorney, that between September 1998 and December 1999 that goods to the value of approximately £780,000 (Irish) had been sold in the United Kingdom. He stated that the applicant was not aware of any incidents of confusion. He stated that the lack of confusion was indicative that members of the public were not confused. Mr Gallafent stated that the trade mark to be compared was that

which had been applied for, not that of the BUSTER nameplate on a dog's kennel. He stated that the respective trade marks are not identical.

5 Mr Gallafent referred to dictionary definitions of BUSTER when used as a combining form. He stated that the application in suit gives rise to the concept of the ownership of some bangers (or sausages) by a dog called BUSTER. He submitted evidence to show that in Australia and the USA that BUSTER is ranked as the twenty ninth and sixteenth popular name for a dog respectively.

10 He stated that the opponent had not demonstrated any reputation in any of his trade marks.

### **Submissions of the opponent**

15 The opponent stated that he had proved use of the word BUSTER and that it is this word that distinguishes his products. He stated that in registration nos 2134690 and 2178472 that BUSTER is the predominant element of the trade marks. The opponent stated that the popularity of BUSTER as a name for a dog in Australia and the USA is irrelevant to the position within the United Kingdom. He stated that there is no evidence that the word BUSTER is in any way  
20 descriptive or non-distinctive for animal foodstuffs. The opponent asserted that the applicant had taken an element of one of more his registrations and added non-distinctive elements to it.

### **Decision**

25 The grounds of opposition pursued by the opponent are those under sections 5(1), 5(2) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

#### Section 5:

30 (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

35 (2) A trade mark shall not be registered if because -(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or (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  
40 the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

45 (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade....

The term 'earlier trade mark' is defined in section 6 of the Act as follows:

"6.- (1) In this Act an "earlier trade mark" means -

- 5 (a) a registered trade mark, international trade mark (UK) or Community trade mark 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."

10 **Preliminary issues**

On 18 October 2000 the applicant advised that registration no 749688 had been cancelled. On 9 November 2000 the opponent confirmed that the registration no 749688 had been voluntarily cancelled. He commented that this had no substantial impact on the opposition since he still  
15 relied upon registration nos 2160541, 2134690 and 2178472.

It would appear that the opponent has accepted that he can no longer rely on registration no 749688. Although he does not state this directly. I need, therefore, to consider whether this registration should be taken into account in the instant proceedings.

20 There are two registry decisions, of which I am aware, on this issue. Mr Probert in *Club Soda* (unreported O/230/98) found that the question should be determined as at the date of the application for the trade mark and, therefore, a subsequent revocation of a trade mark would not affect the status of that trade mark as an "earlier trade mark". However, Mr Knight in *Transpay*  
25 (2001) 6 RPC 191 found that when the matter comes to be determined, the Hearing Officer should take account of all facts that are before him. Thus, in the circumstances of that case, he found that a trade mark on which the opponents sought to rely should not be considered as an earlier trade mark because it had lapsed after the date of the application but before the matter came to be determined.

30 It seems to me that the approach taken by Mr Knight is the one to be preferred and I adopt the reasoning given in his decision. In the instant case the adoption of this approach would seem particularly appropriate. Prior to the voluntary surrender of the registration a revocation action for non-use was launched by the proprietor of the application in suit. It would not seem correct  
35 that a registered proprietor could avoid the potential effects that a revocation action might have in other proceedings by surrendering the registration which was the subject of the revocation action. In such a case the issues in question would not be tested and the registered proprietor could dispose of his registration by surrender but still make use of it in other proceedings; relying upon the fact that the registration was extant at e.g. the date of the filing of an application for  
40 registration of a trade mark.

Consequently registration no 749688 will not be considered in relation to the instant proceedings.

45 In the submissions of the opponent reference is made to registration no 2156114. This registration was not referred to in the statement of grounds of the opponent. The opponent has made no request to amend the statement of grounds to include it. I, therefore, will take no cognisance of this registration in the instant proceedings. (It is also to be noted that even in the opponent's letter

of 9 November 2000 - referred to above - he made no reference to this registration; even though he listed the earlier registrations upon which he relied.)

5 **Section 5(1) objection**

None of the trade marks of the earlier registrations of the opponent are identical to the application in suit. This ground of opposition is, therefore, dismissed.

10 **Section 5(2) objection**

As the respective trade marks are not identical the objection under Section 5(2) must relate to Section 5(2)(b).

15 In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;

25 (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224; 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph  
30 27.

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;

35 (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;

40 (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;

45 (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not

sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;

(h) further, 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; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

I have three earlier registrations of the opponent to consider. Registration nos 2160541 and 2178472 have other matter which clearly puts them at a greater distance from the application in suit than registration no 2134690. Therefore, if the opponent does not succeed in relation to registration no 2134690 he would not be able to succeed in relation to his other two registrations. I, therefore, consider it necessary to only consider registration no 2134690.

### Comparison of goods

The goods of the specification of the earlier registration are: *grains and seeds; live animals, birds and fish; foodstuffs for animals, birds and for fish and preparations for use as additives to such foodstuffs; malt; cuttlefish bone; bones for dogs; litter for animals* in class 31.

The goods of the specification of the application in suit are “*foodstuffs for animals*” included in class 31.

Consequently the goods of the application in suit are completely subsumed by those of the earlier registration. **The respective goods are, therefore, identical.**

### Comparison of signs

The trade marks to be compared are as follows:

Earlier registration:



Application in suit:



The point of similarity between the respective trade marks rests on the word BUSTER. In the



application in suit this word is in the plural or possessive form. In the earlier registration BUSTER is in title case, in the application in suit it is in upper case. I do not consider that anything turns upon this.

5 The application in suit includes the rubric “Chewy Sausages for your Dog”; which appears to me to be a description of the product. The word BANGERS is a commonly used term for sausages, although it may be argued that in relation to animal foodstuffs it is somewhat unusual.

10 The device of a dog with a string of sausages is in a cartoon style. However, as the goods are sausages for dogs it could also be seen as a descriptor to some extent, if visual rather than written.

15 The applicant has argued that the conceptual association of his trade mark is that of sausages owned by a dog called BUSTER. I am not certain how this assists the case of the applicant. Equally the trade mark of the opponent when in use could have a similar connotation e.g. BUSTER’S dog food, which equally could be in the form of sausages or bangers.

20 In the earlier registration the device element is clearly subsidiary in size and position to the word element. Part of the device element might be seen as a biscuit but equally could be seen simply as a geometric device.

25 I have to consider the respective trade marks in their entirety. However, in considering the overall impressions of the respective trade marks I also have to bear in mind their distinctive and dominant components. I consider that BUSTER is an important element of both trade marks, indeed it is the most distinctive element of both trade marks. In the application in suit the rest of the matter is to a lesser or greater extent descriptive. I also have to take into account normal and fair use of the earlier registration, which could include e.g use in relation to sausages for dogs.

30 Owing to the large number of different elements in the application in suit and its overall impression, I consider that the respective trade marks are not visually similar.

35 However, taking into account that BUSTER is the distinctive and dominant component of the respective trade marks, I consider that the respective trade marks enjoy both an oral and conceptual similarity.

Consequent upon the above I consider that the respective trade marks are similar.

40 In considering the issue of likelihood of confusion I have taken into account that the respective trade marks encompass identical goods and so have considered the principle of interdependency of signs and goods. Consequent upon this I do not consider that the visual lack of similarity outweighs the oral and conceptual similarity; especially when normal and fair use is taken into account.

45 The opponent claimed a reputation in relation to his earlier trade marks. As I have stated above I do not find that he has established any form of reputation in relation to the trade marks as actually registered. Therefore, the opponent cannot benefit from a claim to the public recognition or reputation of his earlier trade marks. However, I consider that registration no 2134690 enjoys a good degree of inherent distinctiveness. BUSTER is not descriptive of the goods and, even if

one accepted the applicant's arguments about it being the name for a dog, it would still only be distantly allusive to the goods.

5 The applicant has referred to an absence of confusion within the market place. However, this argument does not take into account upon which goods the opponent currently uses his trade mark on and upon which goods he might use it on at some later stage. Owing to the breadth of the specification this could encompass all types of animal foodstuffs. It is also to be noted that the turnover figures of the applicant are very low. I would also have to exercise some caution as to the validity of the figures, which have been provided at third hand and are "approximate". It is also very difficult to identify where someone has been confused, unless they directly contact one of the parties. The fact that the applicant knows of no instances of confusion, therefore, has had no sway in my decision.

15 The opponent referred to the use of BUSTER solus on packaging. The only issue before me relates to the consideration of the actual trade mark of the application in suit.

20 The opponent has claimed a monopoly in relation to the use of BUSTER in relation to animal foodstuffs owing to several registrations that include the word BUSTER. However, for this to effect the likelihood of confusion it is necessary for the consumer to be aware of this; it is the situation in the market that counts. The evidence of the opponent shows use of BREATH BUSTER in relation to biscuits to counter bad breath in dogs. Such usage in no way establishes that the word BUSTER simpliciter would be identified with the opponent.

25 The opponent has made an allegation against the opponent by stating:

"...it is clear that the applicants have taken the distinctive element of one or more registrations in the name of the opponent e.g. 2134690; they appropriated the distinctive element and added to it a number of non-distinctive elements."

30 The opponent has put forward no evidence to support these claims. The validity of this allegation is certainly less than "clear" to me. I have attached no weight to this unsupported allegation and it has had no influence on my decision.

35 **Taking into account all the above I consider that there is a likelihood of confusion and I uphold the objection under Section 5(2)(b).**

#### **Section 5(4)(a) objection**

40 I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the *Wild Child case (1998) 14 RPC 455*. In that decision Mr Hobbs stated that:

45 "The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art. 4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have

asserted against the applicant in accordance with the law of passing off".

5 "A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd v Borden Inc [1990] RPC 341 and Erven Warnink BV v J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

10 "The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

15 (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

20 (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

25 The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed .....". The relevant date is therefore the date of the filing of the application in suit.

30 The opponent has failed to prove that at the relevant date that he had established a reputation or goodwill in his trade marks.

**The ground of opposition under Section 5(4)(a) is, therefore, dismissed.**

**As a result of the above findings the application is rejected in its entirety.**

5 The opponent is entitled to a contribution towards his costs and I therefore order the applicant to pay him the sum of £635. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

10 **Dated this 18 day of September 2001**

15 **D.W.Landau**  
**For the Registrar**