

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2197322
BY FARRIERS FRIEND LTD FOR THE REGISTRATION
OF A TRADE MARK IN CLASS 5**

AND

**IN THE MATTER OF OPPOSITION NO 50273 BY
LIFE DATA LABS INC**

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**IN THE MATTER OF Application No 2197322
by Farriers Friend Ltd for the Registration
of a Trade Mark in Class 5**

and

**IN THE MATTER OF Opposition No 50273 by
Life Data Labs Inc**

BACKGROUND

1. On 14 May 1999, Farriers Friend Ltd applied to register the trade mark FARRIER'S FRIEND in respect of the following:-

Class 5

Veterinary preparations and substances; additives and supplements for animal foodstuffs.

Class 31

Additives and supplements for animal foodstuffs.

2. The application for registration was accepted and published for opposition purposes and on 14 October 1999 Life Data Labs, Inc filed a notice of opposition. The grounds of opposition are first of all under Section 5(2)(b) based upon the opponents' trade mark, FARRIER'S FORMULA which is registered in the United Kingdom under No1587177 in respect of:

Nutritional supplements for treatment of the hoof, hair and skin of animals (all included in Class 5).

3. The opponents also have a Community Trade Mark registration No 240598 for FARRIERS FORMULA in respect of the following:

Nutritional supplements for pet and livestock animals (all included in Classes 5 and 31)

4. The opponents also allege that the application for registration in suit was made in bad faith and should therefore be refused under the provisions of Section 3(6) of the Act. Also, that they have common law rights in the trade mark FARRIERS FRIEND such as to require the application to be refused under Section 5(4)(a); and that their trade mark is a well known trade mark and is therefore entitled to protection under the Paris Convention and therefore falls to be refused under the provisions of Section 56, 6(1)(c) and 5(2)(b) of the Act.

5. The applicants for registration admitted the existence of the earlier trade marks standing in the name of the opponents but denied the ground of opposition. Both sides sought an award of costs.

6. Evidence was filed by both the applicants for registration and the opponents and in accordance with the Trade Marks Registry's practise I reviewed the case and notified the parties that, in my view, it was not necessary for a hearing to be held in order that the matters the subject of the dispute could be decided. In the event, David Lutkin & Associates, on behalf of the applicants for registration and D Young & Co on behalf of the opponents stated that they were content for a decision to be taken from the pleadings and evidence filed. But both parties did file written submissions. Having carefully read the pleadings, the evidence filed by both sides and the written submissions submitted on behalf of the parties by their attorneys I give the following decision.

DECISION

7. First of all, I dismiss immediately the allegation that the application for registration was made in bad faith. There is no evidence to support it and therefore the ground of opposition based on Section 3(6) of the act is dismissed.

8. Insofar as the opponents claim that their trade mark FARRIERS FRIEND is well known and therefore entitled to protection under the appropriate provisions of the Paris Convention I do not intend to consider that matter separately. They are in no better position under those provisions than they are under Section 5(2)(b) in respect of the earlier registrations of the trade mark FARRIERS FRIEND.

9. I go on therefore to consider the grounds of opposition based upon Section 5(2)(b) which states:

"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."

10. An earlier trade mark is defined in Section 6(1) which states:-

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

(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;

- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK); or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known mark.

11. In determining the question under Section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *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.

12. 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*, paragraph 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* paragraph 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*, paragraph 23;
- (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*, paragraph 23;
- (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*, paragraph 17;
- (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*, 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*, paragraph 29.

13. In essence the test under Section 5(2)(b) is are there are similarities between the respective trade marks and goods, which would combine to create a likelihood of confusion?

14. In determining whether the goods covered by the application are similar to the goods covered by the opponent's earlier trade marks I consider the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* (1996) ROC 281 (Pages 296, 297 as set out below:

“The following factors must be relevant in consider whether there is or is not similarity:

- (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 ground 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.”

15. Though, in view of the *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* judgement by the European Court of Justice (3-39/97) the TREAT case can no longer be wholly relied upon, the Court said the factors identified by the UK government in its submissions (which are those listed in TREAT) are still relevant in respect of a comparison of goods and/or services.

16. It seems to me that veterinary preparations and substances and additives and supplements for animal foodstuffs in the applicants specification of goods are similar, if not identical goods to nutritional supplements for treatment of the hoof, hair and skin of animals and nutritional

substances for pet or livestock animals contained in the opponents specifications of goods. Both the applicants and the opponents goods are used for treating and maintaining the health of animals. Veterinary preparations and substances must also be considered to be similar goods to nutritional supplements for the treatment of the hoof, hair and skin of animals. Both are to be found in Class 5 and are therefore medicated substances, though it is not always necessary for a professional veterinarian to either prescribe or administer veterinary preparations and substances, some can be bought over the counter and administered by any persons. In my view therefore the same or similar goods are involved in considering the specifications of the earlier trade marks and the applicants' specification of goods.

17. I turn to the respective trade marks. The opponents' trade mark is FARRIERS FORMULA, the applicants' Trade Mark FARRIERS FRIEND. Each has as its first element the word FARRIER. But in relation to the goods at issue that word, which refers to one who has care of horses, does not have much if any distinctive character. The second element of each is an ordinary dictionary word with its own meaning, but each has as its first letter the letter F. The opponents have suggested that on the basis of imperfect recollection, the relevant public would be confused if they saw on a shelf a packet or tub containing a veterinary substance or food supplement bearing the applicants' trade mark FARRIER'S FRIEND when they already knew and trusted similar goods sold under the FARRIER'S FORMULA trade mark. This is because the opponents claim to have a reputation in their trade mark. In his statutory declaration of 22 March 2001, Mr Robert Alexander Eustace, the opponents' distributor, claims to have 3.3% share of the United Kingdom market for all types of horse food and vitamin supplements. This is based upon a national survey undertaken in 1999 which states that the estimate for the total annual expenditure on feeds for horses, namely vitamins, minerals and other supplements is approximately £30 million per year. Thus, as the opponents' sales amounted to £980k in 1999 they claim to have a 3.3% share of the market. I am not given any evidence from any independent source in the trade to underpin Robert Eustaces' statements but, I am prepared to accept that the opponents' trade marks are used to a significant extent in the United Kingdom in respect of the goods covered by specifications set out in their registrations. But, does that mean that confusion of the relevant public is more likely? In my view it does not. It seems to me, considering the trade marks as a whole and taking account of all of the guidance laid down by the Court of Justice, that the relevant public engaged in the trade surrounding veterinary substances and additives and supplements for animal foodstuffs would when encountering the applicants and the opponents' trade marks not take much if any notice of the first element but would rely upon the second to distinguish the two. It is the second element, or the combination of it and the word FARRIER which, in my view, gives the respective trade marks their distinctive character. Therefore, even allowing for imperfect recollection, the opponents' use, the fact that the second elements in each case has the same initial letter, and the same or similar goods are at issue, I do not consider that there is any likelihood of confusion and deception amongst the relevant public if the applicants' trade mark was placed on the register alongside that of the opponents. The grounds for objection based upon Section 5(2)(b) are therefore dismissed.

18. I turn to the grounds of objection based upon Section 5(4)(a) of the Act which states:-

"5.-(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 -

- (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, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

19. I note the guidance proved by the Appointed Person, Mr Geoffrey Hobbs QC, in WILD CHILD [1998] 14 RPC 455. In that decision Mr Hobbs sated that:-

“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguish 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 opponents could then have asserted against the applicant in accordance with the law of passing off”.

“A helpful summary of the elements of an action of 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:

“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;
- (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
- (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.”

20. Both the applicants and the opponents in their evidence supplied information about the respective uses they have made of their trade marks. Though the opponents, as I have acknowledged earlier, have made significant use of their trade mark I am not wholly satisfied that their case for goodwill or reputation has been made out. However, as I have already held that the respective trade marks are not confusingly similar it follows that there is unlikely to be any misrepresentation by the applicants use of their trade mark such as to lead the public to believe that the goods offered under it are the goods of the opponents. Thus, there is unlikely

to be any damage to the opponents. In the circumstances, the ground of opposition based upon Section 5(4)(a) is also dismissed.

21. As the opponents have failed the applicants for registration they are entitled to a contribution towards their costs. I therefore order the opponents to pay to the applicants the sum of **£600**. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of the case with any appeal against the decision is unsuccessful.

Dated this 02 Day of November 2001

M KNIGHT
For the Registrar
The Comptroller-General