

O/324/12

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NOS 2510515 AND 2510517
IN THE NAME OF VIVERDI LIMITED

AND

APPLICATIONS FOR DECLARATIONS OF THE INVALIDITY THEREOF
UNDER NOS 83990 AND 84003
BY PARTNERS PET SUPERMARKETS GROUP LTD

Background

1. This decision concerns the following trade mark registrations:

Mark No	Mark	Specification
2510515	PET-SUPERMARKET.CO.UK PETSUPERMARKET.CO.UK (Series of 2 marks)	Class 20 Beds and bedding for pets; kennels and carriers for pets; scratching posts for pets; pet runs; hutches Class 21 Combs and brushes for pets; grooming aids for pets; containers and dispensers for pet food; cages for pets; bird cages; litter boxes and trays Class 31 Foodstuffs for animals; tinned dog food and cat food; dry dog food and cat food; small animal feeds; bird seeds; fish food; treats and biscuits for pets; small animal bedding; animal litter Class 35 Retail services connected with the sale of pet foodstuffs and pet products all provided online or via mail order
2510517	PETSUPERMARKET PET-SUPERMARKET PET SUPERMARKET (Series of 3 marks)	As above.

2. Both stand in the name of Viverdi Limited (“Viverdi”), were applied for on 6 March 2009 and completed their registration procedure on 21 May 2010. Both proceeded to registration on the basis of distinctiveness acquired through use.

3. On 16 February 2011, Partners Pet Supermarkets Group Ltd (“Partners”) filed applications to declare the registrations invalid. In each case the application is made under the provisions of section 47(1) of the Act on the grounds that the trade marks were registered in breach of the provisions of sections 3(1)(b), (c) and (d) of the Act. In short, it claims the marks consist exclusively of words which describe the nature of the goods and services for which they are registered, are not capable of

distinguishing them from those of other undertakings and have become customary in the trade. Further, Partners claims that the evidence filed by Viverdi, of the use made of the marks before the date of the filing of the applications, was insufficient to prove that the marks had acquired distinctiveness.

4. Viverdi filed counterstatements essentially denying the claims made under sections 3(1)(b),(c) and (d) of the Act. In the alternative, it seeks to rely on distinctiveness acquired through use of the mark.

5. The two sets of proceedings were consolidated. Both parties filed evidence and the matter came before me for hearing on 23 July 2012. Viverdi were represented by Mr Ian Silcock of counsel, instructed by Ward Hadaway Solicitors, its legal representatives in these proceedings. Partners were represented by Mr Benet Brandreth, also of counsel, instructed by Keltie.

The evidence

Partners' evidence

6. Stephen Victor Bygrave's witness statement is dated 23 June 2011. Mr Bygrave is chairman of Partners Pets Supermarkets Group Ltd which was incorporated in 1997. It is the successor in business to Partners Pet Supplies Ltd which, he says, started trading as a pet supermarket on 22 August 1992. He states that his company has used the term „pet supermarket', in relation to its business, continuously, since 1992 but considers it to be a generic term. Mr Bygrave states he started his business in 1992 under the name Partners Pet Supermarket with large premises in St Albans, which still trades. He states that the company later started trading on the Internet at partnerspets.com though it is not clear from his witness statement at what date this trade started. At paragraph 2 of his witness statement he states it started trading in 1995, whereas at paragraph 4, he states the site was launched in 1998. Nothing rests on this discrepancy.

7. Mr Bygrave states that since 28 August 1992, his company has continuously used the promotional strapline “your No 1 Pet Supermarket” on promotional and advertising literature and publications as well as on banners within the store.

8. Exhibit SB1 consists of pages taken from the partnerspets.com website. They show a range of goods being offered including pet foods and pet accessories and show the strapline “your No. 1 Online Pet Supermarket”. None are dated and no indication is given of when these pages were downloaded or how long they have been available in this form but I note that page 8 of the exhibit bears a copyright date of 2011.

9. Exhibit SB2 shows photographs of Partners' Bedford store which are said to have been taken in December 1994, the year it opened. Taken from the car park, it shows a large store displaying a sign „opening soon' in the window. The words “your No 1 pet supermarket open 7 days a week” appear prominently on the signage. Also included in this exhibit are photographs said to be of the St Albans store taken in 1997 and which shows similar signage. The exhibit also contains copies of advertisements from various publications. Four are advertisements for the St Albans

store. In identical form, each bears the words “Your No 1 Pet Supermarket” and are taken from the Herts Advertiser of December 2 1992, December 9 1992, December 16 1992 and December 23 1992. An advertisement from the Enfield Advertiser of 13 March 2002 for the Cockfosters’ store contains the same wording. There are also copies of advertisements from: The Bedfordshire on Sunday dated April 6 2008, The Topper dated April 23 2008 and National Animal Welfare Trust of March 2003. All show the same wording as above.

10. At SB3 is a further printout from the company’s website. It is a single page and appears to be a duplicate of the first page of exhibit SB1.

11. Mr Bygrave states he thought up the strapline and incorporated the word supermarket within it because “it is an accurate description of the business which was providing a wide range and variety of pet supplies, food and accessories”. He states the word is used descriptively within the strapline to carry the message that his company is a retailer of a wide range of such goods.

12. At SB4, Mr Bygrave exhibits a copy from an online dictionary (www.dictionary.com) downloaded on 12 May 2011. It gives the following definitions of „supermarket’:

“-noun

A large retail market that sells food and other household goods and that is usually operated on a self-service basis.

Any business or company offering an unusually wide range of goods and services; *a financial supermarket that sells stocks, bonds, insurance and real estate*”

Later on the page is an entry said to be from the Collins English Dictionary, 10th ed. which defines the word supermarket as:

“-n

A large self-service store retailing food and household supplies”

13. Mr Bygrave states he is aware other retailers use the term “pet supermarket” or “supermarket” in relation to their businesses. At SB5 he exhibits the following:

3 pages downloaded on 12 May 2011 from the pawspetsupermarket website. The „welcome message’ states “Paws Pet Supermarket has a wonderful selection of...”;

A page taken from the feedem pet supplies website. Downloaded on 12 May 2011, the site is categorised as an online pet supermarket;

4 pages from the Home Pet Shop website downloaded on 12 May 2011. Under the heading “What we do”, is a description of the company as a place where customers can “select [...] pet products from our online pet supermarket...”

4 pages from the „We are pets’ website downloaded on 14 February 2011. The text contains the phrases “Welcome to We Are Pets-The pet supermarket where you’ll find everything you need for your cherished pet” and “The pet supermarket with 30 years experience...”.

14. Mr Bygrave says that others outside the pet industry use the term pet supermarket and, at SB6, exhibits pages taken from the price comparison website www.supermarketcompare.org.uk on 12 May 2011. These pages urge visitors to the site to “compare household & pet supermarket prices”.

15. Mr Bygrave refers to a dispute between Viverdi and a Miss Shaw of Paws Pets Supermarket which was launched with Nominet on 24 November 2010. Mr Bygrave exhibits the resulting Nominet decision, which is dated 3 May 2011, at SB7 and notes that “one of the reasons the action failed is because the term pet supermarket was found to be generic”. The dispute centred on the claim that the domain name pawspetsupermarket.co.uk was an abusive registration and, as such, its findings are not determinative of questions raised under the Trade Marks Act.

16. There is also a witness statement from Emma Shaw dated 11 July 2011. Miss Shaw states that since 23 September 2009 she has been the Managing Director of Paws Pet Supermarket. She states that she has “been with” Paws Pet Supermarket since 1 June 1997 and it was incorporated on 23 September 2009.

17. Miss Shaw states her company operates an online supermarket business which retails pet supplies. She states the name Paws Pet Supermarket was adopted because “PAWS has an obvious connection with pets and animals, and the term PET SUPERMARKET describes exactly what we do”. She claims the term PET SUPERMARKET is “a generic term used by many traders who are operating supermarkets specialising in pet supplies” though she does not file any evidence in support of this claim.

18. Lastly, there is a witness statement dated 8 August 2011 by Lawrence Wright who is Managing Director and owner of Feed-em Ltd of Guisborough. Mr Wright says he began trading as Feed-em in 1995 and the company was incorporated on 3 October 2003. It originally operated from premises in Guisborough but registered the domain name www.feedem.co.uk around February 2006 following the advent of online retailing. Mr Wright states the company uses the phrase pet supermarket to describe the online service it provides.

19. Mr Wright states his domain name www.FeedemPetSupermarket.co.uk was registered on its behalf on 28 February 2006. He states Feedem Pet Supermarket Ltd was registered at Companies House on 28 October 2010. Both names were adopted, he says, because the term “Pet Supermarket describes exactly what we do”. Mr Wright also states that the term is a generic one used by many traders who are operating supermarkets specialising in pet supplies but he provides no evidence to support this claim.

Viverdi's evidence

20. Viverdi's evidence comes from Mark Berriman, its founder and Managing Director. The evidence consists of five witness statements, viz:

- 1: Dated 14 May 2009 and filed originally during the ex parte examination of trade mark No 2510515;
- 2: Dated 28 September 2009 and filed originally during the ex parte examination of trade mark No 2510515;
- 3: Dated 8 May 2009 and filed originally during the ex parte examination of trade mark No 2510517;
- 4: Dated 28 September 2009 and filed originally during the ex parte examination of trade mark No 2510517;
- 5: Dated 7 October 2011 and filed in respect of the consolidated invalidation proceedings.

21. There is a great deal of repetition across the five witness statements and, for this reason, I do not intend to summarise them individually though I will refer to them, or to specific exhibits within them, as necessary.

22. The evidence shows that Mr Berriman set up Viverdi in 2003. He is its Managing Director. Having first intended to take the business into a different area of trade, he changed his plans and decided to set up an online business selling pet products. Viverdi registered the domain name petsupermarket.co.uk on 14 April 2003 before registering the domain name pet-supermarket.co.uk on 5 May 2004. Mr Berriman developed the first website himself and it was launched in October 2004. It provides online retail services selling products for pets although its physical premises are open to the public for direct sales albeit, at one time at least, it seems, only on the weekend.

23. The company has used a number of logos over the years. They include:



Whilst the logos each differ, not least in respect of the number of differing animals portrayed within them, for the purposes of this decision, I shall refer to them in the singular as “the dog logo”.

24. Mr Berriman gives the following details of sales made by the business both online and direct from its physical premises, along with advertising expenditure for the same periods:

	Online sales £	Other sales £	Total sales £	Advertising expenditure £
2004	15,181	14,108	29,289	3,177
2005	607,337	54,879	662,216	75,792
2006	1,676,796	39,453	1,716,249	160,110
2007	2,454,782	71,961	2,526,743	204,100
2008	4,382,371	82,135	4,464,506	358,679
2009	4,126,159	93,821	4,219,980	382,442
2010	5,885,936	58,934	5,944,870	305,954
2011 to 31 July 2011	4,880,414	31,877	4,912,291	157,655
Total	24,028,976	447,168	24,476,144	1,647,909

25. Mr Berriman states that most of the advertising expenditure Viverdi has incurred relates to online advertising including affiliate marketing and pay per click advertising but also includes some press advertising. He gives no breakdown of this expenditure between the two forms nor does he give details of the sites or press where such advertising was published nor how many people any of its advertising might have reached. In relation to the website, Mr Berriman states that for the period between 1 April 2007 and 25 February 2011 there were 7.7m unique visits made to it, of which 2.9m are said to have been direct visits. Between the date of its launch and 25 February 2011 the pet-supermarket.co.uk website is said to have shipped 405,394 orders direct to customers and had 151,000 registered users.

26. The company has also promoted itself by attendance at the following cat and dog shows: the Supreme Cat Show held at Birmingham NEC in November 2007 and 2008, the Leeds Dog Show held at Harewood House in July 2007 and 2008, the Darlington Dog Show held at Newby Hall in September 2007 and 2008 and Crufts held at the Birmingham NEC in March 2009.

27. Mr Berriman's various witness statements exhibit a variety of promotional and other material. Where it is duplicated, I will make only one reference to it.

First Witness statement:

28. At MB2, Mr Berriman exhibits what he says are corporate branding guidelines showing examples of how the various marks are used on the website and in advertising materials. It would appear therefore, to be material used internally within the company. There are seven, double-sided pages. Some of these show nothing more than the letters of the alphabet or photographs of various animals. One page shows the dog logo. The remaining pages show what appear to be screen shots of website pages, however, given the use of the *lorem ipsum delirium* ... text running through them, text which I'm aware is commonly used in the process of publishing and graphic design as filler text, these pages would support my view that this has been created for use as part of the design process rather than being material which has been published and brought to the attention of the consumer.

29. MB3 consists of a copy of a 4 page leaflet and is said to date from January 2008. The leaflet shows many examples of the dog logo and bears the text "Pet-Supermarket.co.uk is here to offer all you need..." No details are given to show where or how this may have been published or to whom it might have been distributed.

30. MB4 is said to be marketing material for affiliates who assist in marketing the online business. The exhibit consists of a single page and is headed "What's in store for 2009". The page bears the dog logo and states "Pet-Supermarket.co.uk celebrate their 5th Birthday this year...". It also shows the full website address www.pet-supermarket.co.uk. Again, no details are given to show to whom it was sent or whether it was further distributed by them to the end consumer.

31. MB7 is said to be a print showing a banner used at cat and dog shows. Mr Berriman says it makes prominent use of the mark PET-SUPERMARKET.CO.UK, however, this appears only as part of the dog logo or within the full internet address of the company.

32. MB8 is a copy of leaflet said to have been produced for use at the Crufts show which took place in 2009. The leaflet shows the dog logo and urges people to "Visit Pet-Supermarket at CRUFTS Hall 5..."

33. MB9 is a copy of a 2004 photograph showing a billboard advertisement. It takes the form of a simple road map showing the location of the company's premises and because of this was, presumably, displayed relatively close to those premises. The advertisement also shows the dog logo and the website address for the company.

Second witness statement

34. MB1A is said to be copies of promotional leaflets dating from June 2004. Three of the four pages show the dog logo and full website address whilst pages two and three also include the words "Pet Supermarket is run by pet lovers, for pet lovers". No details are provided which enable me to establish how many leaflets might have been issued or to whom.

35. MB2A is a copy of a promotional leaflet said to have been distributed through the website of The Sun. Handwritten on it is the date June 2007. The text is somewhat distorted but I can see the dog logo and full website address. Again, I have no information on who might have accessed it or how many people did so.

36. MB3A is a single page in the form of a promotional email newsletter from moneybackmadness.co.uk. The newsletter, somewhat inconsistently, makes references to PetSuperMarket, Pet-Supermarket and Pet Supermarket and provides a link to Viverdi's www.pet-supermarket.co.uk website. Again, no information is given to show who may have received this material or when.

37. MB4A is a single page print of the GreasyPalm internet page. The date of August 2007 is handwritten on it. It gives details of offers from various companies and organisations, one of which is headed Pet Supermarket. This entry shows the dog

logo and indicates that “Pet Supermarket offers one of the biggest online choices...” Again, no details are given of to whom this might have been sent.

38. MB7A consists of 3 pages. The first two are double-sided and appear to be in the form of a newsletter from Digital Window Ltd. Offers made by a number of companies are promoted. They include one headed “Pet Supermarket –Xmas” which makes four other references to Pet Supermarket. The remaining page is said to be a screenshot and bears the handwritten script “2006 website”. The quality of it makes it difficult to read but I can see references to “online pet shop Pet-Supermarket.co.uk”. Again, no details are provided of any circulation of the newsletter.

39. MB8A is another screen shot on which is handwritten “2008 website”. The dog logo appears prominently at the top of the page. The rest of the page is somewhat cluttered with various publicity material but one entry gives details promoting the introduction of a new service. Under the heading www.yet-supermarket.co.uk (my underlining) is the following text:

“Bringing you prescription medications at Pet-Supermarket prices. Pet-Supermarket has teamed up with...”

40. MB9A is a graphic of the UK showing the spread of 11,743 users of the website, by region, in percentage terms as of August 2007. The map is broken down into 12 areas with users shown to be from each area. The percentages total 109%.

41. MB10A-MB14A consist of various letters and emails. They appear to have been solicited for the proceedings with some being addressed to Mr Berriman and others “to whom it may concern”. Each gives brief details of the writer’s company’s dealings with Mr Berriman and his company. None of the writers have made witness statements.

Fifth Witness statement

42. MB(INV) 2 consists of some 140 pages of press cuttings, the vast majority of which date from 2010 and 2011. I will refer to these in due course. The earliest dated pages are:

Page 140. An article from the www.shieldsgazette.com website dated 26 June 2008. The page contains several pictures of dogs with the dog logo prominently in the centre of the piece. The article reports on the newspaper’s „Great North Dog Walk’ contest, offers readers a chance to win a prize of dog care products from Pet-Supermarket.co.uk and describes how the company sells flea, tick and worming products as well as other health-related and prescription medications. It provides the full web address of the company;

Page 142. An article on which is handwritten „Journal 27.2.09’. The article has a picture of Mr Berriman above it and reports the success of the “South Tyneside-based www.pet-supermarket.co.uk”, which it describes as an “online pet superstore”, in increasing its turnover;

Page 146. (which is duplicated at page 147). An article from the website www.southtynesidetoday.com of 27 November 2006. The article reports on Mr Berriman's website, its establishment and growth, referring to it as www.pet-supermarket.co.uk. The article bears a photograph of Mr Berriman wearing a t-shirt which has the dog logo prominently on the chest;

Pages 148 and 149. A copy of what appears to be a newspaper article bearing the hand written date 8 July 2008. The source of the article is not identified but the author of the piece gives her contact email address at northeast-press. The article reports on a fashion show and refers to one of its main sponsors as being Pet-Supermarket which it describes as an "online supplier of pet products". For those who prefer not to shop online, the article reports that "customers [can] take advantage of the supermarket's fantastic prices" in person as its premises open to the public each weekend. The article shows the logos of the various sponsors of the fashion show and includes the dog logo;

Page 150. An article from the Shields Gazette of 12 July 2007. Showing Mr Berriman in his premises and wearing a t-shirt bearing the dog logo, the article reports on Pet-Supermarket and its business as an online pet store which it describes as being a "specialist pet food operator" which has expanded to sell veterinary products;

Page 156. A page taken from www.shieldsgazette.com on which is handwritten 3 July 2007. The page shows a picture of Mr Berriman "of Pet Supermarket" receiving an award.

43. The remaining pages within the exhibit either bear dates in 2010 and later or are undated. They contain extracts which have been taken from a number of sources. Not all are identified though the vast majority are said to be from online publications. No details are given of the reach or readership of any of them. Many of the articles from different sources are duplicative of each other in content and some pages have been included more than once in the exhibit. The articles break down into those relating to 1) the growth of, or changes made to, Viverdi's business, e.g. its turnover or products, 2) the company's sponsorship of competitions or charities, 3) the company's involvement in helping young people obtain jobs and 4) the company's re-launched website.

44. Many of the extracts are from technical or trade publications (e.g. page 60-catalogue and E Business, page 67-pet food industry.com, page 90-Press Box, page 131-Roam Data Smart m Commerce, page 139- www.petbusinessworld). The articles referring to sponsorship or employment opportunities are said to be from newspapers (whether online or in paper form) which are clearly local to the company's base (e.g. Shields Gazette). No details of readership numbers of any of these publications are provided.

45. MB(INV)3 consists of 5 pages relating to Partners' own website which Mr Berriman states he has captured from internet archives. Mr Berriman states the earliest of the pages is nothing more than a brochure site, which I understand to be a basic and relatively unsophisticated website composed of just a few information

pages. The page exhibited shows contact details for Partners Pet Supermarkets Group Ltd and, amongst other things within the text, warns visitors to the site that "...all Partners Pet Supermarket products are subject to change...". The page bears a copyright date of 1999. Mr Berriman states his research of the internet archive has shown it has a earliest capture date of 15 April 2001.

46. Mr Berriman states that his marks have strong brand recognition. He refers to a survey which "randomly surveyed 266 dog owners attending the Leeds Championship Show at Harewood House" which he says was carried out by his employees "assisted by employees of Proctor & Gamble". At MB15A to his second witness statement, he exhibits a copy of the questionnaire he says was used. It appears to be a questionnaire intended to be completed online as it has drop down boxes for the completion of some questions and has a box with the word „submit' at the end. Whilst, towards the end of the questionnaire, those answering the questions are asked whether they had "heard of Pet-Supermarket.co.uk before today?", the main purpose of it would appear to extract information about their purchasing habits regarding dog food. Mr Berriman acknowledges that the survey was not carried out for trade mark purposes and "may not fully comply with all the requirements of the Manual of Trade Mark Practice, as it was never designed to do so" but claims it "was carried out in a fair way and accurately reflects how well recognised the PET SUPERMARKET brand has become amongst dog owners". These of course, are only part of the relevant public. It is not a survey to which I give any weight as it does not in any way comply with the criteria set out in the head note to *Imperial Group plc & Another v Philip Morris Limited & Another* [1984] RPC 293. For example, no details are given of what instructions, if any, interviewers were given prior to the interviews taking place (if, indeed, interviews did take place at all), I am not told how people were selected or how the form was completed, nor are the completed responses included and no details are given as to how, or by whom, such forms might have been completed.

Decision

The relevant public for the goods and services

47. The goods and services all relate to, or are, various products for pets including, e.g. cats, dogs, birds and fish. The average consumer is therefore a pet owner or someone caring for pets (e.g. a cattery owner).

The objections

48. The objections to the marks are founded on section 3 of the Act, the relevant parts of which state:

“3.-(1) The following shall not be registered-

(a)...

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

49. Whilst the applications for invalidation are based on grounds under sections 3(1)(b), (c) and (d), both parties indicated at the hearing that their submissions were focussed on the objection under section 3(1)(c) of the Act. I go on, therefore, to consider the objection under this ground in the first instance.

The objection under section 3(1)(c) of the Act

50. In *JanSport Apparel Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-80/07*, the General Court (GC) gave a helpful summary of the considerations to be taken into account in relation to Article 7(1)(c) of the regulation, that being the equivalent of section 3(1)(c) of the Act. It said:

“18 Under Article 7(1)(c) of Regulation No 40/94, ‘trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’ are not to be registered. In addition, Article 7(2) of Regulation No 40/94 (now Article 7(2) of Regulation No 207/2009) states that, ‘paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community’.

19 By prohibiting the registration of such signs, that article pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 31).

20 Furthermore, the signs covered by Article 7(1)(c) of Regulation No 40/94 are signs regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired the product or service to repeat the experience, if it proves to be a positive, or avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (Case T-219/00 *Ellos v*

OHIM (ELLOS)[2002] ECR II-753, paragraph 28, and Case T-348/02 *Quick v OHIM (Quick)* [2003] ECR II-5071, paragraph 28).

21 The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer's point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought (see the judgment of 9 July 2008 in Case T-323/05 *Coffee Store v OHIM (THE COFFEE STORE)*, not published in the ECR, paragraph 31 and the case-law cited). Accordingly, a sign's descriptiveness can only be assessed by reference to the goods or services concerned and to the way in which it is understood by the relevant public (Case T-322/03 *Telefon & Buch v OHIM-Herold Business Data (WEISSE SEITEN)* [2006] ECR II-835, paragraph 90).

22 It follows that, for a sign to be caught by the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see Case T-19/04 *Metso Paper Automation v OHIM (PAPERLAB)* [2005] ECR II-2383, paragraph 25 and the case-law cited).

23 It must finally be pointed out that the criteria established by the case-law for the purpose of determining whether a word mark composed of several word elements is descriptive or not are identical to those applied in the case of a word mark containing only a single element (Case T-28/06 *Rheinfelsquellen H. Hövelmann v OHIM (VOM URSPRUNG HER VOLLKOMMEN)* [2007] ECR II-4413, paragraph 21).

51. In *Koninklijke KPN Nederland NV v Het Benelux MerkenBureau* Case C-363/99 the Court of Justice of the European Union (CJEU) stated:

“98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.”

“102. It is also irrelevant whether the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary. The wording of Article 3(1)(c) of the Directive does not draw any distinction by reference to the characteristics which may be designated by the signs or indication of which the mark consists. In fact, in the light of the public interest underlying the provision, any undertaking must be able freely to use such signs and indications to describe any characteristic whatsoever of its

own goods, irrespective of how significant the characteristic may be commercially.”

52. In *Alcon Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-192/03 P* it was held that use after the date of the application could be used to draw conclusions as to the position at the date of application. Such use can also go to the issue of foreseeability in relation to use of the term (see *Wm Wrigley Jr Company Case C-191/01P*).

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53. This registration is for a series of three marks, 1) PETSUPERMARKET, 2) PET-SUPERMARKET (hyphenated) and 3) PET SUPERMARKET all in plain block capitals. All therefore contain the same words in the same order and differ only in respect of the way those words are separated (or not). Mr Silcock sought to submit that the phrase PET SUPERMARKET was a syntactically unusual juxtaposition of words. He referred me to the dictionary references at exhibit SB4 to Mr Bygrave’s witness statement, submitting that because the reference came from an internet address ending in dot com, it could not be excluded that the definitions were American ones rather than British ones. He submitted that people in the UK would not recognise the word supermarket as being a place where items for pets would be sold as the more usual term would be a pet store or pet shop and so the use of the term pet supermarket was somewhat fanciful.

54. I firmly reject his submissions. Domain names ending in dot com are no longer indicative of a non UK website (if they ever were) as is clearly shown by the advertising of other traders’ websites elsewhere in the exhibit. At least one of the dictionary references shown is said to have been taken from the Collins English Dictionary, a dictionary which, in my experience, is often relied on in the UK. It is well known that the ways in which traders carry out their businesses has changed over the years, exemplified by how stores in some retail sectors have eschewed smaller shop premises and moved to larger, sometimes out of town premises where they can carry a larger stock. Also well known is the fact that the supermarkets where a weekly shop is done have expanded from their original “grocery” image to sell a wide variety of different products which would once have been the domain of specialist traders e.g. clothing as well as gardening or animal products.

55. PET and SUPERMARKET are words which, separately, need no explanation as to their meaning to the relevant public. Both are everyday words known to everyone and they are words that would have been understood well before the date of application. They are also words which have a clear meaning when used together, a position that will have existed for very many years. I am supported in my view by exhibit SB2 to Mr Bygrave’s witness statement which shows that Partners were using the phrase Pet Supermarket in its advertising as long ago as 1992 and, indeed, exhibit MB(INV)3 to Mr Berriman’s own (5th) witness statement which shows the words being used in the virtual world on Partners’ website in April 2001, both well before Mr Berriman’s business was formed. Neither the conjoining of the words in the first mark within the series, the hyphenation in the second mark of the series, nor the separation of the two words in the third mark in the series, displaces the natural

meaning that will be seen in these words. Each mark will be taken to refer to a pet supermarket, a supermarket where people can purchase products for pets.

56. I do not consider the marks are, in any way, syntactically unusual when used in relation to the goods and services claimed. The word supermarket is not fanciful, it merely describes a store where one can expect to buy a wide range of goods: in this case a wide range of goods for pets. There is (and was, at the relevant date) a direct and specific relationship between the words which make up each of the marks within the series and all of the goods and services included within the specification. The application against registration no 2510517 based on section 3(1)(c) of the Act succeeds accordingly.

2510515

57. This registration is for a series of two marks, PET-SUPERMARKET.CO.UK and PETSUPERMARKET.CO.UK. The only difference between the two marks is the presence of the hyphen in the first mark in the series.

58. I set out above my findings in respect of the words PET SUPERMARKET whether separated or conjoined. In this registration, both marks of the series also include, as an element at the end of them, the letters and characters .CO.UK.

59. The element .co.uk is well known as indicating a domain name or internet address. The Trade Mark Registry's published practice in relation to the distinctiveness of trade marks which contain domain names is set out in The Examination Guide. The relevant paragraphs state:

"A domain name is a written representation of an Internet electronic address, e.g. www.ipso.gov.uk, which is the Office's web site address. It is commonplace for goods and services to be sold in the UK under such a name, i.e. the domain name is being used as a trade name or trade mark, and the Registrar will, subject to the usual criteria of the Act, permit domain names to be registered as trade marks. Elements of the domain name such as ".com" or ".co.uk" are considered to be totally non-distinctive. As a general rule, one should consider whether the remainder of the mark is descriptive or non-distinctive; if so, there is likely to be an objection under section 3(1)(b) and (c) of the Act.

There may be exceptions. For example TWIST AND SEAL would be liable to an objection for storage jars on the basis that it describes a characteristic of the goods, whereas the addition of ".COM" gives the sign as a whole a trade mark character."

60. This guidance is, of course, just that: guidance and nothing more than that. Each case has to be taken on its own merits. I have found that the words PET SUPERMARKET (whether or not hyphenated or conjoined) are descriptive of a supermarket selling products for pets. In my view the addition of the element .co.uk does have an effect on the marks but only to the extent that it indicates the pet supermarket is an online one. Both the pet supermarket and the co.uk elements are descriptive and that position is not changed by the combination of the two elements.

In my view, the marks forming the series do nothing other than describe to the relevant public that the pet supermarket is one available via the internet. The application against registration no 2510515 based on section 3(1)(c) of the Act succeeds accordingly.

The objection under section 3(1)(b) of the Act

61. In *Koninklijke KPN Nederland NV v Benelux Merkenbureau Case C-363/99*, the CJEU stated:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

62. Article 3(1)(b) of the Directive is the equivalent of section 3(1)(b) of the Act. Insofar as I have found that registration of the trade marks was contrary to section 3(1)(c) of the Act, I must find that it was also contrary to section 3(1)(b) of the Act.

The objection under section 3(1)(d) of the Act

63. In respect of the objection under section 3(1)(d) of the Act I take note of the GC's comments in *Telefon & Buch Verlagsgesellschaft mbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-322/03* where it stated:

“49 Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Mertz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM –Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50 With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51 Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but

on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39)."

64. In *Stash Limited v Samurai Sportswear Ltd* BL O/281/04 Professor Annand, sitting as the appointed person, stated:

"33. In the event, I do not believe this issue of the interpretation of section 3(1)(d) is central to the outcome of the appeal. "Customary" is defined in the Oxford English Reference Dictionary, 1995 as: "usual; in accordance with custom". In my judgment, the Opponent has failed on the evidence to prove that at the relevant date STASH contravened section 3(1)(d) as consisting exclusively of signs or indications which have become customary either in the current language or in trade practices for the goods concerned."

65. In order to succeed under this ground, Partners must establish that at the date of application, the terms PETSUPERMARKET, PET-SUPERMARKET, PET SUPERMARKET, PET-SUPERMARKET.CO.UK and PETSUPERMARKET.CO.UK were in usage in trade sectors covering the trade in the goods or services of the application.

66. Not surprisingly, there is no evidence that anyone other than Viverdi has used the latter two marks (2510515) and I dismiss the objection under this ground in relation to these marks.

67. As for the three marks of 2510517, whilst, as I said earlier in this decision, they differ in terms of the spacing (or not) between the individual words making up the mark, each of the three marks of the series are virtually indistinguishable from the words pet supermarket and they will each be seen as such by the average consumer. Evidence has been filed by Partners to show that a number of other traders also use the words PET SUPERMARKET in relation to their businesses.

68. There is some evidence which shows that Partners was using the words PET SUPERMARKET in the course of its business well before Viverdi made its trade mark application for the same mark, indeed before Viverdi itself came into existence. Mr Berriman, in his evidence, has accepted that this use was made though he does not accept that Partners was trading online at that time. Whether or not Partners was trading online is not a relevant consideration in my decision and, in any event, Viverdi's registration is not limited to the sale of goods via the internet.

69. As for the evidence of the other traders' use of the mark, this evidence is in the form of witness statements from those traders and the exhibits to Mr Bygrave's witness statement at SB5 and SB6. None of them address the situation at the date the applications for registration were made by Viverdi, indeed some appear to post date Viverdi's use.

70. Whilst use by Partners is shown at the relevant date, use by one business alone at the relevant date is not sufficient to show the mark has become "customary" in the current language or in the *bona fide* and established practices of the trade. The ground of opposition against 2510507 brought under section 3(1)(d) fails.

The claim to acquired distinctiveness

71. As I indicated above, Viverdi claims that to the extent that I find against it under section 3(1) of the Act then the marks have acquired distinctiveness through the use made of them.

72. In *Premier Luggage and Bas Ltd v Premier Co (UK) Ltd and Another* [2002] ETMR 69 Chadwick LJ stated:

“51 The relevant question, therefore, is whether the trade mark had acquired a distinctive character through use in connection with products supplied by Premier Luggage either by the date of application, or (if not) by the date of the trial. The judge did not differentiate between those dates –because, as he said at paragraph 21 of his judgment:

“Although the proviso [to section 3(1) of the Act] refers to the mark acquiring distinctiveness prior to the date of the application for registration, section 47 of the 1994 Act provides that, if it is sought to obtain a declaration of invalidity where a mark has already been registered, it is sufficient if a distinctive character has been acquired since registration.”

52 There is, I think, a danger in that approach, because it fails to recognise where the burden of proof lies in the two cases. The position was explained by Jacob J. in the *British Sugar* case, at page 302 (lines 7-12). After pointing out that section 72 of the Act provided that registration of a person as proprietor was prima facie evidence of the validity of the original registration,

Jacob J. went on to say this:

“This clearly casts the onus on he who wishes to attack the validity of the original registration. But once the attacker can show the registration was wrongly made (particularly for non-compliance with section 3(1) (b)-(d)) and the proprietor wishes to rely on the proviso to section 47(1) it is for the proprietor to show that is [sic] mark is distinctive.”

73. Consequently, the material date for proof of use is the date of the hearing and I take into account not only the evidence filed during the initial examination of the application but also that subsequently filed in these proceedings and which relates to use after the date of the application. Consequent upon the findings in relation to sections 3(1)(b) and (c) of the Act, the onus is upon Viverdi to establish that the trade marks have acquired distinctive character through use.

74. In *Windsurfing Chiemsee Produktions und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber and Franz Attenburger* Joined Cases C-108/97 and C-109/97, the CJEU stated:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into

account: 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

75. In *Rautaruukki Oyj v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-269/06, the GC stated:

“43 Article 7(3) of Regulation No 40/94 provides that the absolute grounds for refusal do not preclude the registration of a trade mark if it has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it. In the circumstance referred to in Article 7(3) of Regulation No 40/94, the fact that the sign which constitutes the mark in question is actually perceived by the relevant section of the public as an indication of the commercial origin of a product or service is the result of the economic effort made by the trade mark applicant. That fact justifies putting aside the public-interest considerations underlying Article 7(1)(b) to (d), which require that the marks referred to in those provisions may be freely used by all in order to avoid conceding an unjustified competitive advantage to a single trader (*Shape of a bottle of beer*, paragraph 21 above, at paragraph 41, and *Shape of a sweet*, paragraph 21 above, at paragraph 55).

44 First, it is clear from the case-law that the acquisition of distinctiveness through use of a mark requires that at least a significant proportion of the relevant section of the public identifies the products or services as originating from a particular undertaking because of the mark. However, the circumstances in which the condition as to the acquisition of distinctiveness through use may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data, such as specific percentages (see *Shape of a sweet*, paragraph 21 above, paragraph 56, and case-law cited)...

46 Third, in assessing, in a particular case, whether a mark has become distinctive through use, account must be taken of factors such as, inter alia: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the significance of the investments by the undertaking to promote it; the proportion of the relevant class of persons who, because of the mark, identify the goods as originating from a particular undertaking and statements from chambers of commerce and industry or other trade and professional associations. If, on the basis of

those factors, the relevant class of persons, or at least a significant proportion thereof, identifies the goods as originating from a particular undertaking because of the trade mark, it must be concluded that the requirement for registering the mark laid down in Article 7(3) of Regulation No 40/94 is satisfied (see *Shape of a sweet*, paragraph 21 above, at paragraph 58, and case-law cited).”

76. In *CNH Global NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T 378/07*, the GC stated:

“54 As regards, secondly, sales volumes and advertising material, it must be pointed out that, according to the case-law, they constitute secondary evidence which may support, where relevant, direct evidence of distinctive character acquired through use, such as provided by the affidavits. Sales volumes and advertising material as such does not show that the public targeted by the goods in question perceives the sign as an indication of commercial origin. Accordingly, as regards the Member States for which no other evidence has been produced, proof of distinctive character acquired through use cannot be furnished by the mere production of sales volumes and advertising material (see to that effect *Texture of a glass surface*, paragraph 41).”

77. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J stated:

“With that in mind I must deal with the evidence –for all depends upon the conclusions to be drawn from that. I begin with the original registration. As I have said I do not have to consider whether the mark was rightly registered under the 1938 Act. By virtue of section 105 of the 1994 Act and Schedule 3 paragraph 18(2) it is section 47 of the 1994 Act which sets out the grounds upon which a mark registered under the old Act can be attacked. I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that “use equals distinctiveness”. The illogicality can be seen from an example: no matter how much use a manufacturer made of the word “Soap” as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark. Again, a manufacturer may coin a new word for a new product and be able to show massive use by him and him alone of that word for the product. Nonetheless the word is apt to be the name of the product, not a trade mark. Examples from old well-known cases of this sort of thing abound. The Shredded Wheat saga is a good example: the Canadian case is *The Canadian Shredded Wheat Co. Ltd v Kellogg Co. Of Canada Ltd.* in the Privy Council and the United Kingdom case *The Shredded Wheat Co. Ltd. v Kellogg Co. of Great Britain Ltd.* in the House of Lords. In the former case Lord Russell said:

“ A word or words to be really distinctive of a person’s goods must generally speaking be incapable of application to the goods of anyone else.”

It is precisely because a common laudatory word is naturally capable of application to the goods of any trader that one must be careful before concluding that merely its use, however substantial, has displaced its common meaning and has come to denote the mark of a particular trader. This is all the more so when the mark has been used in conjunction with what is obviously taken as a trade mark.

I do not consider that the evidence filed to support the registration was anywhere near enough to support the conclusion that when the mark was registered, it was distinctive. Yes, it has been used for about 5 years in conjunction with Silver Spoon, but it was not proved that the public regarded it as a trade mark – a reliable badge of trade origin – on its own. Further the use was only for what was essentially an ice cream topping. It did not cover the full range of goods covered by the registration.

What then of the position now? British Sugar rely upon more extensive evidence. First there is a great deal more use of exactly the same type as went on before. Sales figures went on going up – to nearly £3m p.a. Since introduction in 1986, sales over the 10 year period total about £13m. Of which over half have taken place since registration in September 1992. The product has just over 50% of the ice cream topping market sector. Next British Sugar rely upon evidence from Mrs. Nash MBE. She was in public relations at British Sugar. She took telephone enquiries and dealt with letters from the general public. People sometimes complained when a flavour disappeared (blackcurrant did) or wanted information on availability (for instance when the toffee flavour came out, magazines, mainly at British Sugar's instigation, published recipes for making banoffi pie, a dessert made from bananas, toffee and ice cream). She said that customers often referred simply to "your "Treat" range". But of course all the customers concerned, whether writing of telephoning, knew they were dealing with Silver Spoon the manufacturers. I do not think Mrs. Nash's evidence establishes that the general public perceive the word "Treat" to be a badge of trade origin in itself. I think her evidence does show recognition of the word amongst British Sugar customers, but recognition does not necessarily mean recognition as a trade mark."

78. In relation to use as a trade mark Arnold J stated in *Vibe Technologies Ltd's Application* [2009] ETMR 12:

"90...what must be shown is that a significant proportion of the relevant class of persons rely upon the sign in question on its own as indicating the origin of the goods. I do not think, however, that it is essential for the applicant to have explicitly promoted the sign as a trade mark. It is sufficient for the applicant to have used the sign in such a way that consumers have in fact come to rely on it as indicating the origin of the goods. On the other hand, if the applicant has explicitly promoted the sign as a trade mark, it is more likely that consumers will have come to rely upon it as indicating the origin of the goods."

79. Finally, in *Bach and Bach Flower Remedies Trade Marks* Morrit LJ stated, at paragraph 49:

“First, use of a mark does not prove that the mark is distinctive. Increased use, of itself, does not do so either. The use and increased use must be in a distinctive sense to have any materiality.”

80. The marks the subject of these proceedings have an obvious descriptive relevance to (the retailing of) goods for pets sold through a(n internet) supermarket which is the way the average consumer will view those marks. Whilst I have no specific evidence of the size of the market in pet products as a whole, I note that exhibit MB(INV)2 to Mr Berriman’s 5th witness statement, page 36 and 37, which is an article published in petmiles on 10 May 2011 (the substance of which is repeated at pages 41 and 42 in articles taken from other publications), indicates that there are over 40 million pets in the UK. And at page 50 of the same exhibit, an article taken from Pet Product Marketing on March 2011, quotes Mr Berriman as saying that the annual UK pet food market alone amounts to some £2.5 billion. Whilst I do not know what specific animals were included in the definition of „pets’ within both of these articles and, consequently, cannot be sure that each type of animal which are kept as pets are included within them, based on these figures alone, the market for all of the goods and services covered by the registered marks, which cover goods for a wide range of small animals as well as birds and fish, is likely to be enormous.

81. Whilst sales figures have been provided, and which, for the most part have been on a consistently upward trend ranging from just over £29,000 to just under £6million and are suggestive of an increasingly successful business, there is no evidence to show what share Viverdi have of the overall market in the relevant goods and services though it is likely to be relatively small given the figures shown above. My view is supported by the fact that in the period October 2004 to February 2011, a period of more than 6 full years, the website accumulated just 151,000 registered users and shipped less than 406,000 orders. I have no details of how many customers it might have had at its physical premises but, given the sales figures provided, which are far less than those given for sales made via the Internet, they are likely to be significantly fewer in number.

82. The sales figures provided are not broken down in any way (either between each of the marks concerned, or in respect of the various classes of goods and services for which they are registered) and would appear to include goods and/or services which are not covered by the registrations (e.g health-related products and prescription medications).

83. Exhibits MB10A to MB14A to Mr Berriman’s 2nd witness statement consists of various items of correspondence (and which, as I indicated above, have not been put into any proper evidential format). Whilst they are written by people within the trade, they have been written by people whose companies are suppliers to Mr Berriman’s company and who would, therefore, be expected to know of his business.

84. There are numerous examples within the evidence of articles promoting Mr Berriman and his business, though many make no mention of the specific goods in which he trades or refer only to health-related or prescription products which are goods not covered by the registrations. Most of the press articles are from press

local to the north east where his company is based. There is one piece of evidence of what appears to be a promotion via the internet website of a national newspaper (MB2A page 116 to Mr Berriman's 2nd witness statement), however, there is no evidence of how people would have come to access it or how many of the relevant public actually did so.

85. Mr Berriman has provided details of the number of visitors to the PET-SUPERMARKET.CO.UK website along with the number of registered users of that site and the number of orders they have placed. As I indicate above, these numbers appear to be low in terms of the likely market size but, in any event, use of the website is not evidence of any distinctiveness in the marks under consideration.

86. The overwhelming majority of the materials shown in the evidence prominently display the dog logo. In *Société des produits Nestlé SA v Mars UK Ltd Case C-353/03*, the CJEU stated:

“29 The expression ‘use of the mark as a trade mark’ must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking.

30 Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.

32 In the final analysis, the reply to the question raised must be that the distinctive character of a mark referred to in Article 3(3) of the directive may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.”

87. As a consequence, use with other matter, such as the dog logo, may be taken into account. But whether that use assists Viverdi will depend on the circumstances of that use, the nature of the trade mark and the products or services in relation to which it is used. That use must be use as a trade mark and not descriptive use. This is a matter of the perception of the relevant consumer.

88. In this case, the registrations cover five separate marks, albeit that there is commonality of the words pet supermarket within them. Much of the evidence provided is not use by Viverdi itself but is, instead, use by others in preparing articles for newspapers or for online newsletters etc. In some cases, use is made of several ‘versions’ of the mark but this appears to be the result of poor drafting or editing skills by the person creating the article rather than any positive intention by Viverdi to use each one of the series of its registered marks (e.g. MB3A to Mr Berriman's second witness statement, mentioned above). Other articles highlight the company's use of other trade marks (e.g. Milburn) or give no details of the company or the specific

goods or services which it offers. For example, MB(Inv)2 to Mr Berriman's fifth witness statement contains the following:

- Page 72. "[you can win] Milburns pet food from SouthTyneside-based online retailer Pet-Supermarket.co.uk".
- Page 89. "Jarrow-based online pet food [sic] retailer Pet Supermarket.co.uk has just launched its own-brand product under the Milburn's label"
- Page 94. An article on the creation of job opportunities for young people in the South Tyneside area, which indicates the online retailer offers "low priced, high quality goods".
- Page 158. "Jarrow-based online store www.pet-supermarket.co.uk is aiming to raise thousands of pounds...". The article then proceeds to give information about a charity fundraising initiative.
- Page 160. What appears to be an advertisement (source not identified) which includes trade marks of a number of suppliers of pet related products from other manufacturers and suppliers as well as the dog logo. The text of the advertisement reads "get your **paws** on the same brands for less..." and notifies readers of the "Quick & Easy to use website www.pet-supermarket.co.uk"

89. Use of a domain name does not, of itself, equal use of a trade mark which forms a part of that domain name (see Case R710/2002-2, (*Telefonica Moviles SA v Orbseal LLC (Telefonica)*). By far the majority of articles refer to the business as being an internet retailer with many also giving the full internet address of the company (i.e. www.pet-supermarket.com). Whilst others omit the www part of the address, what is shown is indicative of the words of the registrations being used within the text as a form of shorthand to direct readers to the company's website, particularly in view of the fact that the company is overwhelmingly referred to as an internet retailer.

90. Mr Silcock referred me to parts of Mr Berriman's evidence which have been filed in support of his claim that the term pet supermarket has "become uniquely associated with Viverdi's online pet supplies business" and which have been taken from Google Insights. Exhibit MB(INV)22 is a page taken from the Google website which is entitled "How does Google Insights for Search work?". It explains that "Google Insights for Search analyses a portion of worldwide Google web searches from all Google domains to compute the number of searches that have been done for the terms that you have entered, relative to the total number of searches done on Google over time." As Mr Brandreth pointed out, an analysis of „a portion of worldwide searches' is not a complete analysis of searches within the UK and therefore the resultant document is of questionable value, however, for completeness and whilst it is not exactly clear how the results of the search referred to by Mr Berriman have been collated, I go on to consider the document itself, which is exhibited at MB(INV)24.

91. The document shows a graph which has been collated from a particular search term. The search term entered is shown towards the top of the page. Above the search term, the searcher is advised to “use quotation marks to match an exact phrase” and gives the example “table tennis”. The search term used in this document is pet supermarket, without quotation marks, which indicates that the results shown do not relate to the term pet supermarket per se but instead refer to the words pet and supermarket. I am supported in my view by the fact that the “top ten” search results which are shown at the bottom of the page are headed by 1) insurance supermarket (i.e. no reference to pet), 2) pet insurance (i.e. no reference to supermarket) and 3) pet insurance supermarket. This evidence does not assist Viverdi.

92. The evidence also shows that others have used the words PET SUPERMARKET in relation to the sale of products for pets. Mr Bygrave gives unchallenged evidence that Partners began using the words as part of its strapline in 1992 and has provided newspaper advertisements showing use from that year as well as photographs dating from 1994 at SB2. This use pre-dates Viverdi’s first claimed use by some years, indeed it predates Viverdi itself. Other exhibits show use of the words by other undertakings since that time (see, for example, the material at SB5). Mr Berriman suggests that the use by these other undertakings has been adopted in order to enable them to benefit from the success of his company but has provided no evidence which supports this. In my view, the use by others of the words PET SUPERMARKET is no more than a reflection of the general change in trade and is one which was entirely foreseeable.

93. In summary, there is evidence that the mark PET SUPERMARKET (however presented), is used as a descriptive term in relation to the sale of products for pets. Use of the mark PET SUPERMARKET.CO.UK (however presented) is also shown but that use is little more than shorthand to direct readers to the company’s domain name, particularly in view of the fact that the company is overwhelmingly described in those articles as an internet retailer. There is no independent evidence from the trade or the public though there is evidence of use of the words PET SUPERMARKET by a number of undertakings in a descriptive and generic manner, some of which pre-dates Viverdi’s use, which has the effect of educating the public to see the term in this way rather than as an indicator of origin. The use of a website address, whether complete (i.e. with the www element) or partial (without it), does not educate the public to see the term as an indicator of origin in a trade mark sense and the prominent use of the distinctive dog logo throughout the publicity material, as well as on the company’s website, only serves to emphasise this. The sales figures, whilst increasing, are small in relation to the likely size of the market and no details are given which allow me to apportion those sales figures to any particular goods or services of the registrations. Whilst the number of the website’s registered users are given, I have no details of whether they are active users of that website or whether they are part of the relevant public. Evidence of advertising of the respective marks is very limited in terms of both the costs involved and, given the paucity of detail, the reach to the relevant public. In all the circumstances, I do not consider that Viverdi has discharged the onus on it and I reject the claim that any of the marks have acquired distinctiveness as at the date of the hearing in relation to any of the goods

or services for which it was registered. The claim that the marks have acquired distinctiveness through the use made of them fails.

94. In accordance with section 47(6) of the Act, both of the registrations are to be invalidated and are to be deemed never to have been made.

Summary

95. The applications for invalidation of registration Nos. 2510515 and 2510517 succeed.

Costs

96. Partners has been successful and is entitled to an award of costs in its favour. I take into account that this decision relates to two, consolidated, applications. I note the fact that both sides filed evidence and that a hearing has taken place. I also bear in mind that whilst there is some duplication of the evidence, this was a result of two registrations being involved coupled with the re-filing of evidence filed originally during ex parte examination of each of them. Partners, however, would have had to review all of that evidence in order to ascertain its content. With all of this in mind, I award costs on the following basis:

Preparing a statement and considering the other side's statement x 2:	£400
Official fee x 2:	£400
Preparing evidence and considering the other side's evidence:	£800
Preparing for and attendance at the hearing:	£500
Total:	£2100

97. I order Viverdi Limited to pay Partners Pet Supermarkets Group Limited the sum of £2100. 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.

Dated 28th of August 2012

**Ann Corbett
For the Registrar
The Comptroller-General**