

**BL O/0265/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003780811**

**BY NOVA DOG CHEWS LIMITED**

**TO REGISTER THE TRADE MARK:**



**IN CLASS 31**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 600002514**

**BY KIWOKO PET, S.L.U.**

## BACKGROUND AND PLEADINGS

1. On 25 April 2022, NOVA DOG CHEWS LIMITED (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 13 May 2022. The applicant seeks registration for the following goods:

Class 31 Pet food; dog food; cat food; edible dog chews; edible chews for animals; pet food in the form of chews, snacks, treats; Foods flavoured with chicken for feeding dogs; Foodstuffs for dogs; Pet food for dogs; Dog food; Food for dogs; Foodstuff for dogs; Dog foods; Foods flavoured with liver for feeding dogs; Cheese flavoured foodstuffs for dogs; Foods in the form of rings for feeding to dogs; Bones for dogs; Food preparations for dogs; Foods containing chicken for feeding dogs; Dogs; Foods flavoured with beef for feeding dogs; Food for racing dogs; Dog treats [edible]; Edible dog treats; Edible chews for dogs; Chewing bones for dogs; Canned foodstuffs for dogs; Canned foods for dogs; Milk for use as foodstuffs for dogs; Litter for dogs; Foods containing liver for feeding dogs; Dog biscuits; Biscuits (Dog -); Biscuits for dogs; Digestible chewing bones for dogs; Foods containing beef for feeding dogs.

2. The application was opposed by KIWOKO PET, S.L.U. (“the opponent”) on 11 August 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade mark:



UK registration no. UK00917922328

Filing date 25 June 2018: Registration date 7 December 2018.

Relying upon all of the goods for which the mark is registered, namely:

Class 5      Dietary supplements for pets; Vitamin supplements for pets; Medicated supplements for pet food; Nutritional supplements for animals; Dietary supplements for animals.

Class 31      Foodstuffs for pets (dogs and cats).

3. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result, the opponent's earlier mark was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

4. The opponent claims that there is a likelihood of confusion because the marks are visually, aurally and conceptually similar and the goods are identical or similar.

5. The applicant filed a counterstatement denying the claims made.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought to file any evidence in respect of these proceedings.

8. Rule 62 (5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings

requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

9. The opponent is represented by Trademarkit LLP, and the applicant is represented by Murgitroyd & Company Limited. A hearing was neither requested nor considered necessary, however, the opponent filed submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

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

## **DECISION**

11. Section 5(2)(b) reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(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.”

12. The earlier mark had not completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at s.6A of the Act do not apply. The opponent may rely on all of the goods it has identified without demonstrating that it has used the mark.

## Section 5(2)(b) case law

13. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

14. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended

purpose and their method of use and whether they are in competition with each other or are complementary.”

15. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut for Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

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

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

18. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

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



20. I consider that the applicant's following goods fall within the broader category of "foodstuffs for pets (dogs and cats)" in the opponent's specification, and are therefore identical on the principle outlined in *Meric*:

"Pet food", "dog food", "cat food", "edible dog chews", "edible chews for animals", "pet food in the form of chews, snacks, treats", "foods flavoured with chicken for feeding dogs", "foodstuffs for dogs", "pet food for dogs", "dog food", "food for dogs", "foodstuff for dogs", "dog foods", "foods flavoured with liver for feeding dogs", "cheese flavoured foodstuffs for dogs", "foods in the form of rings for feeding to dogs", "bones for dogs", "food preparations for dogs", "foods containing chicken for feeding dogs", "dogs, foods flavoured with beef for feeding dogs", "food for racing dogs", "dog treats [edible]", "edible dog treats", "edible chews for dogs", "chewing bones for dogs", "canned foodstuffs for dogs", "canned foods for dogs", "milk for use as foodstuffs for dogs", "foods containing liver for feeding dogs", "dog biscuits", "biscuits (Dog -)", "biscuits for dogs", "digestible chewing bones for dogs", "foods containing beef for feeding dogs".

21. The remaining term in the applicant's specification is "litter for dogs". These goods are used to manage a dogs toileting/waste disposal. The opponent's "foodstuffs for pets (dogs and cats)" is used to feed animals. Therefore the method of use, nature and purpose of the goods clearly differ. I note that there would be an overlap in user; the general public who own pets, and that there may be an overlap in distribution channels as a supermarket may sell both goods located within the same aisle. However, I also consider that these goods would be sold within specialist pet stores, where the goods would be located in different aisles. The goods are neither in competition, nor complementary. Therefore, I consider that the goods are similar, but to a low degree.

### **The average consumer and the nature of the purchasing act**

22. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the

manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

23. The average consumer for the goods will be the general public who own a pet. The cost of the goods in question is likely to be relatively low and they will be purchased relatively frequently. The average consumer will take various factors into consideration such as the cost, quality, and suitability for its pet’s needs. Specifically for foodstuffs for pets, the owner will also consider its ingredients, as their pet may have specific dietary requirements. Therefore, the level of attention paid during the purchasing process will be medium.

24. The goods are likely to be obtained by self-selection from the shelves of a pet store, supermarket or online equivalent. Alternatively, the goods may be purchased following perusal of advertisements. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to purchase through advice sought from a sales assistant or through word-of-mouth recommendations.

### **Comparison of the trade marks**

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

conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

26. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

27. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
	

28. The opponent's mark is comprised of the words “TRUE origins”, in a stylised brown font. The word “TRUE” is presented at the top/beginning of the mark, presented in upper-case making it larger than the word “origins” below it, presented in lower-case and underlined. These words are encased in a cream, square background, with the bottom edge not completely straight and presented like a ripped piece of paper. I note

that the opponent submits that the “TRUE” element has a “low level of distinctiveness since it has a laudatory function and is a common-place word within commercial brands and advertising”. However, I consider that, for the reasons I will come to discuss below, the word “origins” by itself is also not highly distinctive and therefore is not the dominant and distinctive element of the mark. I consider that the wording “TRUE origins” as a whole plays a greater role in the overall impression of the mark, with the square device and stylisation playing a lesser role.

29. The applicant’s mark is comprised of the word “origins”, presented in front of a tree device, with the letter “g” forming part of the trunk. I note that the crown of the tree is presented in the colour green at the top of the mark, with the roots of the tree presented at the bottom of the mark. The tree device, therefore, encases the word “origins”. Although the eye is naturally drawn to the element of the mark that can be read, given the size and positioning of the tree device, which is the biggest part of the mark, and is vertically right in the centre of the mark, I consider that it plays a roughly equal role in the overall impression with the word “origins”.

30. Visually, the marks coincide in the word “origins”, both presented in lower-case and similar typefaces (as indicated by the letter “g” in both marks). This acts as a visual point of similarity. However, the opponent’s mark begins with the word “TRUE”, which due to being presented in upper-case, is slightly bigger in size than the word “origins”, which is underlined. The words are also presented on a square cream background. The applicant’s mark includes the tree device which is large and central in placement within the mark. I also bear in mind that the average consumer tends to pay more attention to the beginning of the marks. Therefore these all act as visual points of difference. Consequently, I consider that the marks are visually similar to between a low and medium degree.

31. Aurally, the opponent’s mark will be pronounced as TRUE OR-RIDGE-ENS. The applicant’s mark will be pronounced as OR-RIDGE-ENS (the tree device will not be articulated). Therefore, the beginning of the marks differ aurally. However, as the marks overlap in the pronunciation of “origins”, they are aurally similar to a medium degree.

32. Conceptually, the words “TRUE” and “origins” are ordinary dictionary words with recognisable meanings. The opponent submits that the words “origins” and “TRUE origins” “have basically the same meaning”. However, I consider that in the context of the opponent’s goods, the words “TRUE origins” could be indicative that the goods are “true”, and/or genuine, and therefore composed of nutritional ingredients, with no hidden nasty substances.

33. The device in the applicant’s mark will be recognised as a tree. I note that this device symbolises the idea of nature, and therefore could indicate to the average consumer that the mark as a whole means that the goods originate from nature, or are naturally sourced.

34. Regardless, as both marks share the concept of “origin”, I consider that the marks are conceptually similar to a medium degree.

#### **Distinctive character of the earlier trade mark**

35. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested

by the undertaking in promotion of the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

36. I also find the guidance set out in *Formula One Licensing BV v OHIM*<sup>1</sup> to be useful in this case:

“41. ....it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

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<sup>1</sup> Case C-196/11P

37. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

38. As highlighted above, the opponent's mark is comprised of the words "TRUE origins", presented against a square cream background. I consider that the words "TRUE origins" are indicative that the opponent's goods are "true", and/or genuine, and therefore composed of nutritional ingredients (with no hidden nasty substances).

39. As per *Formula One*, the earlier mark must be considered to have at least some distinctive character. Consequently, I consider that the distinctiveness of the opponent's mark lies in the combination of the words "TRUE" and "origins". I note that these words are stylised and presented against a square cream background, which is simple and banal in nature, and thus I do not consider that this adds significantly to the distinctiveness of the mark. Therefore, as the opponent's mark, as a whole, is highly allusive of the opponent's goods, I consider that it is inherently distinctive to a low degree.

### **Likelihood of confusion**

40. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct

comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

41. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a low and medium degree.
- I have found the marks to be aurally similar to medium degree.
- I have found the marks to be conceptually similar to a medium degree.
- I have found the opponent's mark to be inherently distinctive to a low degree.
- I have identified the average consumer to be members of the general public with pets who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods to be identical or similar to a low degree.

42. I take into account the decision *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) in which the court confirmed that if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.

43. Therefore, taking all of the above case law into account, I consider that it is important to ask, 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

44. As established above, the average consumer does not dissect the mark. The marks will be viewed as a whole. The opponent's mark, as a whole, is composed of the words "TRUE origins", which is highly allusive of the opponent's goods, presented in a stylised typeface against a cream square background.



45. In this instance, the common elements between the marks, the word “origins”, is low in distinctiveness, as it simply alludes to the “origin” of the goods. Therefore, even bearing in mind the principle of imperfect recollection, the differences between the two marks will take on a greater significance for the average consumer than they might have otherwise.<sup>2</sup> The stylisation in the opponent’s mark, including the stylised typeface, the underline and the square cream background, may not be very remarkable, however, they are visual points of difference. I also note that the beginning of marks tend to make more of an impact than the ends. I, therefore, do not consider that the average consumer would overlook the word “TRUE” at the beginning of the opponent’s mark, which as noted above, is bigger in size due to being presented in upper-case. I also do not consider that the average consumer would overlook the tree device, which is big in size, placed centrally within the mark, and frames the word “origins”, in the applicant’s mark. This is particularly the case given the lower visual similarity (to between a low and medium degree) between the marks, and the predominantly visual purchasing process. The marks’ aural and conceptual similarity is higher than its visual similarity. However, again, this is because the marks share a common element which is low in distinctiveness. The tree device in the applicant’s mark conveys the conceptual message that the goods are naturally sourced, which creates a conceptual point of difference between the marks. It is therefore clear that the marks, as a whole, are not identical. As highlighted above, the marks have distinguishing features between them which become more significant due to both of the marks being lower in distinctiveness. Therefore, taking all of the above into account, I do not consider that there is a likelihood of direct confusion.

46. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the

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<sup>2</sup> *Nicoventures Holdings Ltd v. The London Vape Co Ltd* [2017] EWHC 3393 (Ch) Paragraph 36

other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

47. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria (O/219/16)*, where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

48. Mr Purvis KC in *L.A Sugar Limited* sets out that there are three main categories of indirect confusion and that indirect confusion ‘tends’ to fall in one of them.<sup>3</sup> I note that the opponent hasn’t provided any submissions as to what category this case would fall within. I also bear in mind that the examples set out by Mr Purvis are not exhaustive.

49. However, having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. Even though the marks share the common element; “origins”, as highlighted above, this element is highly allusive of the opponent’s and applicant’s applied for/registered goods. Therefore, I do not think that the common element is of such a level of distinctiveness that the average consumer would believe that only one undertaking would use it in relation to foodstuffs for pets or dog litter. It is more likely to be viewed as a coincidence, especially, and as highlighted above, the average consumer does not dissect the mark, it will be viewed as a whole.

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<sup>3</sup> Paragraphs 16 & 17 of *L.A Sugar Limited v By Black Beat Inc*, Case BL-O/375/10

Consequently, I do not consider that the average consumer would think that the applicant's trade mark was connected with the opponent, or vice versa. Even if the opponent's mark is brought to mind, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. Therefore, I consider there is no likelihood of indirect confusion.

## **CONCLUSION**

50. The opposition is unsuccessful, and the application may proceed to registration.

## **COSTS**

51. Award of costs in fast track proceedings are governed by TPN 2/2015. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances, I award the applicant the sum of **£200** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
<b>Total</b>	<b>£200</b>

52. I therefore order KIWOKO PET, S.L.U. to pay NOVA DOG CHEWS LIMITED the sum of 200. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 10<sup>th</sup> day of March 2023**

**L FAYTER**

**For the Registrar**