

**O/0793/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3753418  
BY KYNETEC UK LIMITED**

**TO REGISTER:**

**PetTrak**

**AS A TRADE MARK IN CLASS 35**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 434700 BY  
AVID IDENTIFICATION SYSTEMS INC.**

## BACKGROUND AND PLEADINGS

1. On 10 February 2022, Kynetec UK Limited (“the applicant”) applied to register **PetTrak** as a trade mark in the United Kingdom in respect of the following services:

### Class 35

*Market research and analysis; market research and analysis in the animal health industry; market research and analysis in the pet industry; market research and analysis in the veterinary industry; market research and consultancy services; market research and consultancy services in the animal health industry; market research and consultancy services in the pet industry; market research and consultancy services in the veterinary industry; market investigation services and tracking study services; market investigation services and tracking study services in the animal health industry; market investigation services and tracking study services in the pet industry; market investigation services and tracking study services in the veterinary industry; compilation of statistics and information; compilation of statistics and information in the animal health industry; compilation of statistics and information in the pet industry; compilation of statistics and information in the veterinary industry; Providing consumer product information.*

2. On 1 July 2022, the application was opposed by Avid Identification Systems Inc. (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and concerns all the services in the application. The opponent had also brought claims under sections 5(3) and 5(4)(a). However, two requests were made to extend the deadline for filing evidence and at a Case Management Conference on 13 February 2023 I upheld the preliminary view to refuse the second request for the reasons explained by my letter of 16 February 2023, the text of which can be found in **Annex A** to this decision.

3. Under section 5(2)(b), the opponent is relying on UKTM No. 3411675, **PETTRAC**, which has a filing date of 4 July 2019 and a registration date of 15 November 2019. Partial priority is claimed from US Trademark Nos. 88262847 and 88262849 filed on

15 January 2019 and US Trademark No. 88359930 filed on 27 March 2019.<sup>1</sup> The UKTM is registered for the services listed in **Annex B** to this decision and the opponent is relying on all of them. The mark qualifies as an earlier mark under the provisions of section 6(1) of the Act by virtue of its earlier priority dates. As it was registered less than five years before the filing date of the contested application, the opponent may rely on all the services for which the earlier mark is registered.

4. The opponent claims that the marks are visually highly similar and aurally and conceptually identical and that the services are identical. Consequently, there exists a likelihood of confusion on the part of the public.

5. The applicant filed a defence and counterstatement on 20 September 2022. It admitted that the marks are visually similar and aurally identical, but that the use of a “K” at the end of the contested mark is a notable visual dissimilarity between them. It denies that the services of the respective marks are similar, although it adds that *Collating, capturing, sorting, managing, updating, processing and searching of data in electronic databases* is “*the only service which could be said to be remotely similar to any of [the] services of the Opposed Mark, for example, ‘compilation of statistics and information’.*” The applicant contends that, even if the services are considered similar, any similarity is at such a high level of generality that it would not result in a likelihood of confusion. It also argues that the parties operate in different industry sectors.

6. The matter came to be heard by me via videolink on 4 December 2023. The opponent was represented by Chris Aikens of Counsel, instructed by Dolleymores, and the applicant by Alaina Newnes of Counsel, instructed by Stevens & Bolton LLP.

## **EVIDENCE**

7. The applicant’s evidence comes from Eve Thomas-Richard, Corporate & Legal Officer of the Kynetec Group. Her witness statement, which is dated 17 April 2023, goes to the services provided by the applicant and the differences between the services offered by the parties. It is accompanied by four exhibits.

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<sup>1</sup> It had also relied on an earlier comparable mark, but this was subject to proof of use. Following the CMC, the opposition proceeded on the basis of UKTM No. 3411675 only.

8. The opponent filed evidence in reply in the form of a witness statement from Christopher Lewis, a Chartered Trade Mark Attorney and Partner at Dolleymores, the opponent's legal representatives. His witness statement is dated 19 June 2023 and is a vehicle for presenting exhibits explaining the terms used in the contested specification.

## **DECISION**

9. Section 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because—

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

10. Section 5(2)(b) is assimilated law, as it is derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

11. I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 greater degree of similarity between the marks and vice versa;
- h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i) mere association, in the strict sense that the later mark brings 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; and

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 services**

12. It is settled case law that I must make my comparison of the services on the basis of all relevant factors. These include the nature of the services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Services are complementary when

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

13. In his skeleton argument, Mr Aikens narrowed the opponent’s case to rely on only a subset of the Class 35 services of the earlier mark. The services to be compared are shown in the table below:

Contested services	Earlier services
<p><u>Class 35</u>  <i>Market research and analysis; market research and analysis in the animal health industry; market research and analysis in the pet industry; market research and analysis in the veterinary industry; market research and consultancy services; market research and consultancy services in the animal health industry; market research and consultancy services in the pet industry; market</i></p>	<p><u>Class 35</u>  <i>Collating, capturing, sorting, managing, updating, processing and searching of data in electronic databases; maintaining a registry of information; retail services in relation to pet products; retail services in relation to animal products.</i></p>

Contested services	Earlier services
<i>research and consultancy services in the veterinary industry; market investigation services and tracking study services; market investigation services and tracking study services in the animal health industry; market investigation services and tracking study services in the pet industry; market investigation services and tracking study services in the veterinary industry; compilation of statistics and information; compilation of statistics and information in the animal health industry; compilation of statistics and information in the pet industry; compilation of statistics and information in the veterinary industry; Providing consumer product information.</i>	

14. I noted earlier that the applicant claimed that the two parties operate in different market sectors. However, I must base my assessment of the similarity of the services on the terms that appear in the specifications, as the opponent is able to rely on the full breadth of its registration.

15. In *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), Arnold LJ set out at [56] the following summary of the correct approach to interpreting the terms used in specifications:

“...the applicable principles of interpretation are as follows:

- (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.
- (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

16. In *Avnet Incorporated v Isoact Limited* [1998] FSR 16, cited by Ms Newnes, Jacob J (as he then was) said at [19]:

“... definitions of services ... are inherently less precise than specifications of goods. ...

In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

17. I shall bear this point in mind during my comparison of the services.

18. Mr Aikens submitted that it was possible to group the contested services as follows:

a) *Market research and analysis; market research and analysis in the animal health industry; market research and analysis in the pet industry; market research and analysis in the veterinary industry; market research and consultancy services; market research and consultancy services in the animal health industry; market research and consultancy services in the veterinary industry; market investigation services and tracking study services in the pet industry; market investigation services and tracking study services in the veterinary industry* (referring to these as the “market research services”);

b) *Compilation of statistics and information; compilation of statistics and information in the animal health industry; compilation of statistics and information in the pet industry; compilation of statistics and information in the veterinary industry* (referring to these as “compilation of statistics and information”); and

c) *Providing consumer product information.*

19. These groups were also used by Ms Newnes during her oral submissions. I shall therefore adopt them for the purposes of my analysis.

### *Market research services*

20. Mr Aikens submitted that these services are highly similar to the opponent's *Collating, capturing, sorting, managing, updating, processing and searching of data in electronic databases* because they would be provided to the same users, have the same physical nature (being commonly provided through computer files and reports), and are complementary.

21. He construed the opponent's term to cover "*the provision of systems and techniques, the purpose and effect of which is to enable the efficient and accurate creation and maintenance of electronic databases containing significant amounts of data*".<sup>2</sup> Ms Newnes submitted that "*the service is, in essence, about the creation and maintenance of electronic databases*".<sup>3</sup> I agree with Ms Newnes. In my view, the construction proposed by Mr Aikens goes beyond the core of the possible meanings of the phrase, straying into the design of databases and workflows.

22. I turn now to consider the contested terms. The opponent has adduced Wikipedia entries defining market research and market analysis.<sup>4</sup> I understand from this evidence that market research is a process of systematically gathering information about markets and consumers, analysing and interpreting this information to derive insights, and presenting the results so that they can inform business decisions, for example, on the development and marketing of new products and services. The techniques used to gather and analyse the information include those drawn from the social sciences. I understand market investigations and tracking studies to be types of research. A number of the terms use the phrase "*market research and consultancy*". I construe this wording to refer to consultancy services relating to markets and market research.

23. Mr Aikens submitted that the services would have the same users, namely businesses, including marketing professionals within those businesses; that they would share the same physical nature, both being commonly provided through the transmission of computer files and reports; and that they are complementary. He also argued in his oral submissions that there is some overlap in trade channels. He did not argue that the services shared any similarity in purpose, and I find that the purposes

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<sup>2</sup> Skeleton argument, paragraph 12.

<sup>3</sup> Transcript, page 9.

<sup>4</sup> Exhibit CL1.

are different. The opponent's services are used to store data in an accessible form, maintain, process and search it. The applicant's services would be purchased in order to get information to understand markets, brand performance, customer perceptions, and so on, and to shape business decisions. I agree that the users will be the same and accept that the services are likely to reach the end-user through the transmission of computer files or reports, but the same could be said of a large number of services, from financial advice to scientific analysis to trade mark watch services.

24. The opponent's services are broad, and the data collated, captured, sorted, managed, updated, processed and searched could relate to any subject. It follows that it could include data about the markets covered by the contested services and the behaviour of customers in those markets. At the hearing, Mr Aikens focused on the example of DJS Research<sup>5</sup> to support this argument that the services are complementary and have some overlap in trade channels. I agree that this is an example of a company offering both market research services and data processing services, but it is a single example. There is no evidence to say how common this practice is, and I am reluctant to find, on the basis of just one company, that the services would generally be expected to be made available through the same suppliers and trade channels. I have no doubt that *Collating, capturing, sorting, managing, updating, processing and searching of data* are activities that are carried out by undertakings providing market research, but it does not necessarily follow that these are services that they would offer to third parties.

25. I turn now to complementarity. Ms Newnes submitted that the parties' respective services were not complementary and referred to the passage from *Boston Scientific* that I have already cited. In assessing whether services are complementary, it is the perception of the consumers of the services that must be taken into account: see *Sanco, S.A. v OHIM*, Case T-294/11, at [22]. I accept that the evidence shows that collating, capturing, sorting, managing, updating, processing and searching of information likely to be held in databases is essential for the providers of market research services to be able to supply those services to their customers but it does not follow from this that this customer would perceive database services to be indispensable or important for their use of market research services in such a way that

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<sup>5</sup> See Exhibit CL2, pages 25-27.

they think the responsibility for those services lies with the same undertaking. Consequently, I find that there is no complementarity between the services.

26. Taking all these factors into account, the only factors where I have found some similarity are user and physical nature. In *Unicorn Studio Inc v Veronese (Société par Actions Simplifiée)* [2024] EWHC 1098 (Ch), Mr Iain Purvis KC (sitting as a deputy High Court judge) said:

“23. ... It seems to me the greater the level of generality at which some similarity under *Canon* factors can be found (i.e. both goods are ‘*sold in large department stores*’ or both goods are ‘*used by ordinary people*’) the less relevant could it be to any question of confusion, and any assessment of similarity of goods should take that into account.”

In my view, the similarities are at a comparably general level here. I consider that they are not sufficient for me to find that the services are similar.

#### *Compilation of statistics and information*

27. Mr Aikens submitted that these services are identical to the earlier *Collating, capturing, sorting, managing, updating, processing and searching of data in electronic databases*. Ms Newnes submitted that:

“... judicial notice can be taken of the fact that compilation of statistics and information is more than and is different to simply collecting data points and putting them in an electronic database or maintaining a registry or information. Statistics and information are derived from data and from its analysis. That data can be from a wide variety of sources. The compilation of statistics and information requires independent analysis and thought to compile the relevant statistics and information.”<sup>6</sup>

28. In my experience, the words “statistics” and “information” are frequently used interchangeably with the word “data”. While I accept that there may well be technical differences between them, the consumer of the services would, in my view, understand them to mean substantially the same thing. I consider that *compilation of statistics and*

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<sup>6</sup> Transcript, page 15.

*information* would involve at least the activities of collating, capturing, sorting and processing data. I agree with Mr Aikens that it is likely that the databases will be used to deliver the applicant's services. Consequently, I find that they are identical. However, if I am wrong in this, I find the services to be highly similar.

*Providing consumer product information*

29. Mr Aikens submitted that this term could be construed in one of two ways: "*either this is the provision of information relating to consumers' interaction and consumption of products, or it is the provision of product information to consumers*".<sup>7</sup> Ms Newnes disagreed with the second option put forward by Mr Aikens.

30. I construe the meaning of the phrase as the provision of product information to consumers and consider that this is the more natural interpretation. The first option, in my view, lacks some clarity. It is not worded as "*providing consumer and product information*", but as "*providing consumer product information*". This could mean "*information about consumer products*", but what is a consumer product? It seems to me that all products are consumer products in some sense. If there were no consumers for that product, then no trader would market them in the first place. This is why I construe the term to mean the provision of product information to consumers.

31. I shall compare these services to the opponent's *Retail services in relation to pet products* and *Retail services in relation to animal products*. As the contested term is not restricted, it would include pet and animal products. The users of the services would be the same and I consider there would be an overlap in trade channels, as the consumer would expect to access product information in retail outlets. There is also some similarity in purpose, as the opponent's services are provided to allow consumers to choose and buy goods, while the applicant's services are provided to give the consumers information, which may then help them select goods to buy. The nature of the service differs: the applicant's services concern the provision of information, while the opponent's encompass the bringing together of goods for purchase. I do not find there to be any competition between the services, but there is a degree of complementarity as product information is important to the consumer when they are using retail services and they are likely to think that at least some of that

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<sup>7</sup> Skeleton argument, paragraph 18.

information has been provided by the retailer. I find that the services are similar to a medium to high degree.

32. Where I have found no similarity, there can be no likelihood of confusion under section 5(2)(b) of the Act: see *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA at [49]. The opposition therefore fails in respect of the following services:

*Market research and analysis; market research and analysis in the animal health industry; market research and analysis in the pet industry; market research and analysis in the veterinary industry; market research and consultancy services; market research and consultancy services in the animal health industry; market research and consultancy services in the pet industry; market research and consultancy services in the veterinary industry; market investigation services and tracking study services; market investigation services and tracking study services in the animal health industry; market investigation services and tracking study services in the pet industry; market investigation services and tracking study services in the veterinary industry.*

33. The opposition continues in respect of the following services:

*Compilation of statistics and information; compilation of statistics and information in the animal health industry; compilation of statistics and information in the pet industry; compilation of statistics and information in the veterinary industry; Providing consumer product information.*

### **Average consumer and the purchasing process**

34. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at [60]. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: see *Lloyd Schuhfabrik*, at [26].

35. I shall deal first with the services in Mr Aikens' second group and the opponent's data services. The parties agree that the average consumer of all these services is a

business. Given the wording of the applicant's terms, this business would be one in the animal sector or a veterinary practice. Mr Aikens submitted that they would be likely to be paying an average degree of attention as "[t]here is no evidence that the relevant services are particularly expensive".<sup>8</sup> I acknowledge that there is no evidence on the cost of the services. However, I agree with Ms Newnes that these are services that are likely to have an impact on the performance of the business and would be purchased after some research and consideration. I find that the level of attention paid to be relatively high. The purchase would be made after looking at brochures or other promotional material and websites and I agree that it would be predominantly visual. However, there may also be a role for word-of-mouth recommendations and so I shall not ignore the aural aspects of the marks.

36. The average consumer of the opponent's *Retail services in relation to pet products* and *Retail services in relation to animal products* and the applicant's *Providing consumer product information* is a member of the general public who is a pet owner. There may also be some consumers whose business involve the care of animals. In my view, the average consumer would be paying a medium degree of attention when choosing the retail services. They will consider factors such as the range of goods on offer, location and/or delivery options, and prices. I consider that they may pay a slightly higher degree of attention when choosing providers of consumer product information, depending on the product concerned. For example, I would expect the average consumer to pay more attention to the source of information on food and healthcare products than to the source of information on toys or bedding. That said, I do not consider that the level of attention would be much above medium. The selection process is likely to be largely visual, with the average consumer using websites and printed material.

### ***Comparison of marks***

37. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the

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<sup>8</sup> Skeleton argument, paragraph 23.

marks, bearing in mind their distinctive and dominant components. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks: see *Bimbo*, paragraph 34.

38. The respective marks are shown below:

<b>Contested mark</b>	<b>Earlier mark</b>
PetTrak	PETTRAC

39. Both marks are word marks. In *LA Superquimica v European Union Intellectual Property Office*, Case T-24/17, the GC held at [39] that such plain word marks protected the word or words contained in the mark in whatever form, colour or typeface. The contested mark would, in my view, be perceived by the average consumer as the juxtaposition of two words: “PET” and “TRAK”, with the latter being seen as a misspelling of “TRACK”. Mr Aikens submitted that the earlier mark would also be perceived in the same way, while Ms Newnes argued that it would be seen as a single word with no obvious meaning. I consider that there may be some consumers who think that the earlier mark is a single word with no meaning, but I also take the view that the majority of consumers will identify the mark as being comprised of the words “PET” and “TRAC”, with the latter being a misspelling of “TRACK”, particularly because the services that are similar are all related to pets or other animals.

40. Mr Aikens submitted that the marks are visually highly similar and aurally identical. The applicant has admitted in its pleadings that the marks are aurally identical, so I am unable to make any other finding, despite Ms Newnes’ submissions as to whether the two Ts would be pronounced as a single sound or as two. The applicant also admitted that the marks are visually similar. Both marks are a single seven-letter word, with the only difference being the final letter. I agree with Mr Aikens that they are visually highly similar.

41. Turning now to the conceptual comparison, I find that “PET” will be understood to refer to a domesticated animal, such as a cat or a dog, that is kept as a companion.

Mr Aikens submitted that “TRAC” and “TRAK” would, as I have found, be seen as a misspelling of the word “TRACK”, which the average consumer would understand to mean “*following a trend in data or information or following a product or a service’s progression in a market*”.<sup>9</sup> Ms Newnes submitted that the conceptual meaning of the contested mark was “*of a track (as in road) concerning pets or to track (as in to follow) a pet*”.<sup>10</sup> In my view, Ms Newnes’ second option is the most likely of all the interpretations suggested by the parties in the context of the retail services and provision of consumer product information, although some consumers may think of a track (or road) for pets. In the context of the data services, some consumers may interpret “TRAC/TRAK” in the way suggested by Mr Aikens, as this is one of the purposes the data could be put to. Overall, though, I consider that the average consumer will interpret both marks in the same way and so they are conceptually identical.

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

42. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

“23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

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<sup>9</sup> Skeleton argument, paragraph 27.

<sup>10</sup> Skeleton argument, paragraph 21.

43. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of the mark can be enhanced by the use that has been made of it. However, for reasons that I have already explained, the opponent has filed no evidence of use, and therefore I have only the inherent position to consider.

44. Ms Newnes submitted that the earlier mark had a very low level of distinctive character in so far as it related to services concerning animals, namely *Retail services in relation to pet products* and *Retail services in relation to animal products*. She also argued that the level of distinctive character would be low for the other services, “as ‘track’ alludes to the process of following such data which is one of the purposes of a database or registry and such a database or registry may be for the benefit of, or used by, those responsible for animals”.<sup>11</sup>

45. I shall consider the retail services first. I agree that “PET” is descriptive of the purpose of the goods sold through these services, but do not consider that “TRACK” is descriptive or allusive. The joining of the words and the misspelling must also be taken into account. I find that, for these services, the mark is inherently distinctive to a medium degree.

46. I turn to *Collating, capturing, sorting, managing, updating, processing and searching of data in electronic databases*. In my view, “TRACK” may be slightly allusive of one of the purposes to which these services could be put, namely, monitoring trends in data. The relevant public comprises business and professionals in the animal sector, as these are the consumers who would be likely to encounter both marks. I therefore find that “PET” is descriptive of the subject matter of the data and so the inherent distinctive character of the mark is supplied by the slightly allusive “TRAC(K)”, the juxtaposition and the misspelling. In my view, the level of distinctive character is medium.

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<sup>11</sup> Skeleton argument, paragraph 23.

### ***Conclusions on likelihood of confusion***

47. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the services at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. There is no law setting out precisely what weight should be attached to each of the factors or providing a formula that can be applied to any set of circumstances. However, I am required to take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services or vice versa.

48. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

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

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI', etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

49. In my view, it is the likelihood of direct confusion that is relevant here. If the average consumer recognises that the marks are different, I see no reason why they might assume that there is a connection between the two, where the word "TRACK" is misspelled differently. That would not be a logical brand development.

50. Ms Newnes referred me to two earlier cases. The first of these was the decision of the High Court in *TVIS Limited v Howserv Services Limited & Ors* [2023] EWHC 2589 (Ch), where it found that there was no likelihood of confusion between the marks **VETSURE** and **PETSURE**. However, this case is not on all fours with the present proceedings. The marks in those cases had different beginnings, and it is established case law that the average consumer tends to pay more attention to the beginnings, than to the ends, of marks: see *El Corte Inglés, SA v OHIM*, Joined Cases T-183/02 and T-184/02, at [81]-[82]. In addition, the court found at [83] that **VETSURE** and **PETSURE** were not conceptually similar.

51. The second was the decision of Mr Daniel Alexander QC, sitting as a Deputy Judge of the Chancery Division, in *PlanetArt LLC & Anor v Photobox Limited & Anor* [2020]

EWHC 713 (Ch), in particular his discussion of the impact of a low degree of distinctive character on the likelihood of confusion. I have, however, found the distinctive character of the earlier mark to be medium and so will say no more about this case.

52. Earlier in my decision, I found that the services still in play are identical (or highly similar) and similar to a medium to high degree. The purchasing process would be largely visual, and I found the marks to be visually highly similar. In my view, there could also be a role for word-of-mouth recommendations for at least some of the services, and I found the marks to be aurally identical. In addition, I found the marks to be conceptually identical.

53. The fact that the difference between the marks occurs at the end is, in my view, an important point. I have already referred to the judgment of the GC in *El Corte Inglés*.<sup>12</sup> The average consumer is, in my view, unlikely to remember the precise misspelling of the word “TRACK” even when they are paying a high degree of attention.

54. I find that there is a likelihood of direct confusion in respect of all the services listed in paragraph 33 above.

## **OUTCOME**

55. The opposition is partially successful and Application No. 3753418 is refused for the following services:

### Class 35

*Compilation of statistics and information; compilation of statistics and information in the animal health industry; compilation of statistics and information in the pet industry; compilation of statistics and information in the veterinary industry; Providing consumer product information.*

56. The application may proceed to registration for the following services:

### Class 35

*Market research and analysis; market research and analysis in the animal health industry; market research and analysis in the pet industry; market research and*

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<sup>12</sup> See [48].

*analysis in the veterinary industry; market research and consultancy services; market research and consultancy services in the animal health industry; market research and consultancy services in the pet industry; market research and consultancy services in the veterinary industry; market investigation services and tracking study services; market investigation services and tracking study services in the animal health industry; market investigation services and tracking study services in the pet industry; market investigation services and tracking study services in the veterinary industry.*

## **COSTS**

57. Both parties have enjoyed some success in these proceedings, with the larger part going to the applicant. I therefore make an award of costs to the applicant in line with the scale set out in Tribunal Practice Notice No. 2/2016 and in proportion to the level of success achieved. The total awarded is £1400, which I have calculated as follows:

*£200 for preparing a statement and considering the other side's statement;*

*£400 for preparing evidence and considering and commenting on the other side's evidence;*

*£800 for preparing and attending a hearing;*

***£1400 in total***

58. I therefore order Avid Identification Systems Inc to pay Kynetec UK Limited the sum of £1400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 19<sup>th</sup> day of August 2024**

**Clare Boucher**

**For the Registrar,**

**Comptroller-General**

## ANNEX A

### **Text of the Tribunal's letter following the CMC on 13 February 2023**

A Case Management Conference (CMC) was held on Monday 13 February 2023 at which Chris Lewis of Dolleymores represented the opponent and Greg Adey of Counsel represented the applicant. Elaine O'Hare of the applicant's representatives, Stevens & Bolton, was also in attendance. The CMC was requested following the Registry's refusal to grant the opponent a second extension of time to file evidence.

Had this second extension been granted, the deadline for filing the opponent's evidence would have been 2 February 2023. The evidence was in fact filed on 10 February 2023, along with a request for a retrospective extension of time. I had not seen this request or evidence by the time of the hearing and so I reserved my decision as to whether to uphold or overturn the Registry's refusal. I have now considered this third request. The reasons given for that request are as follows:

*"The Opponent expected to be in a position to file the evidence during the initial extended period it requested which was until 19 February 2023. As the extension was only allowed until 19 January 2023 the Opponent expected this to be a tight deadline for obtaining the relevant evidence from its subsidiary (invoices) and formatting them appropriately for submitting in the proceedings. This proved to be the case and the further extension of time to 2 February 2023 was refused.*

*The Opponent's evidence has been finalised and is submitted along with this extension request which covers the period between the refused extension period and the date the evidence has been submitted."*

Both parties referred to the IPO guidance and the familiar case law on the subject of extensions, namely *AJ and MA Levy's Trade Mark* [1999] RPC 291, *Liquid Force Trade Mark* [1999] RPC 429 and *Siddiqui's Application*, BL O/481/00. Mr Adey had also supplied a copy of the more recent decision of the Hearing Officer in *Alfred & Trade Marks*, BL O/613/20. These cases all stress that, although the time period for filing evidence may be extended, such an extension will not be granted as a matter of course. Rather, it is for the party requesting the extension to justify why it should be granted and these reasons should be strong and compelling. Other principles that I

bear in mind are the need to dispose of cases in a prompt, fair, efficient and proportionate manner, using an appropriate share of the Tribunal's resources.

Mr Lewis stated that the task of collating the evidence had been made more difficult by the fact that the opponent was a US company and had to obtain evidence of use from a UK subsidiary. The CMC was the first point at which this explanation was given. In the TM9 forms, the opponent had instead claimed that the reason for missing the deadline was "*the festive period*". He noted that the evidence was now filed and that a refusal of the extension requests would lead to a potential invalidation application being filed, resulting in longer drawn-out proceedings which would require a greater share of the Tribunal's resources. In his view, the original request for a two-month extension had been realistic and that, if it had been granted, the deadline would have been 19 February and the evidence would have been filed in time.

For the applicant, Mr Adey submitted that the reasons given were not sufficiently full and detailed to justify the exercise of discretion, and that the opponent had had abundant time in which to present its evidence. Any doubt on this point would have been removed when the applicant filed its defence on 20 September 2022. He submitted that the facts that the opponent waited until the final day before filing the first two extension requests and that the third request was filed late, suggested a lack of diligence on the part of the opponent.

Mr Adey also argued that the bar should be set higher on second and third requests than on a first. Mr Lewis disagreed with this position. What mattered, in his view, was the length of time of an extension, not the number of TM9 forms that had been filed. He submitted that two months was not a long extension. However, the length of any requested extension needs to be considered in the context of the reasons given and the guidance that requests will be granted "*in exceptional cases*" (see Tribunal Manual, section 4.9.1). It is my view that the one month granted in response to the first request was generous: after all, "*the festive period*" is entirely predictable and can be factored into a party's plans. But it is the second (and then potentially the third) request that was the subject of the CMC.

I asked Mr Lewis to explain the reasons for the second, and third, request. He suggested that there was some problem with sending the invoices to the US for

processing which meant that the 2 February date was missed. In response to my further enquiries, he thought that the issue might have been something to do with data protection regulation. However, this remains a supposition, and it was apparent that Mr Lewis was not in possession of a full explanation for the delay. If data protection had been the issue, again, this ought to have been foreseeable and factored into the timescale for producing the evidence. Overall, I find myself in agreement with Mr Adey that the reasons given were rather generic and not strong and compelling.

I accept that the evidence is now available but also note that this is not to be a determinative factor in my decision.

I also accept that the opposition may continue under section 5(2)(b) on the basis of the earlier mark which is not subject to proof of use, and that there may be further invalidation proceedings. However, it is also possible that the opposition under section 5(2)(b) based on the mark not subject to proof of use may itself be wholly or partially successful. Therefore, it is not necessarily the case that a further action will be required on essentially the same basis, by way of invalidation.

Consequently, **I uphold the preliminary view to refuse the request of 19 January 2023 for an extension of time in which to file evidence.** The timetable for the remainder of the evidence rounds is as follows:

**Filing of applicant's evidence/submissions: two months from the date of this letter, i.e. 16 April 2023. As this date is a Sunday, the effective deadline is 17 April 2023.**

**On receipt of the applicant's evidence a period of one month will be given for the opponent to notify the Registry whether or not they intend to file evidence of fact in reply. If such a request is received, a further period of one month will be allowed to file any evidence.**

Upon conclusion of the evidence rounds, the parties will be asked if they wish to be heard on this matter.

## **ANNEX B**

### **Specification of the earlier mark**

#### Class 35

Collating, capturing, sorting, managing, updating, processing and searching of data in electronic databases; maintaining a registry of information; retail services in relation to pet products; retail services in relation to animal products; online retail store services in the field of pet and animal identification devices, pet and animal tags, RFID tags worn by pets and animals for identification and recovery; maintaining a registry of information for pet owners, veterinarians, and shelters via a telephone call center; providing medical referral services in the nature of on-call veterinary professionals who refer pet owners to emergency veterinarians and clinics (arranging of commercial and business contracts); information, advice and consultancy regarding the aforementioned services.

#### Class 39

Transport services; pet transport services; animal transport services; pet rescue services; animal rescue services; pet rescue services; animal rescue services; pet rescue information services; animal rescue information services; information, advice and consultancy regarding the aforementioned services.

#### Class 44

Veterinary services; veterinary information services; veterinary consulting services; veterinary referral services; insertion of subcutaneous microchips into pets for purposes of tracking and identification; insertion of subcutaneous microchips into animals for purposes of tracking and identification; veterinary services for pets and other animals, namely, writing of identification numbers in subcutaneous electronic tags and other tags for purposes of identification and recovery; information, advice and consultancy regarding the aforementioned services.

#### Class 45

Security services for the physical protection of tangible property; security services for the physical protection of pets and animals; lost property services; lost property information services; lost property location services; lost property tracking services; lost property return services; pet location services; animal location services; lost pet

location services; lost animal location services; pet tracking services; animal tracking services; lost pet tracking services; lost animal tracking services; information, advice and consultancy regarding the aforementioned services.