

O/0866/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003821207
IN THE NAME OF PETC US 1 LLC FOR THE TRADE MARK:

MIGHTY PAW

IN CLASSES 8, 9, 16, 18, 21, 28, 31 AND 35
AND THE OPPOSITION THERETO UNDER NO. 436654 BY PRIMEUR LIMITED

AND IN THE MATTER OF REGISTRATIONS NOS. UK00003471807 AND
UK00003471817

IN THE NAME OF PRIMEUR LIMITED
FOR THE TRADE MARKS:



&

MIGHTY PAWS

IN CLASSES 12, 18, 20, 21, 24, 27 AND 28
AND THE APPLICATIONS FOR DECLARATIONS OF INVALIDITY THERETO
UNDER NOS. 505976 AND 505975 BY PETC US 1 LLC

Background and pleadings

1. This dispute concerns three consolidated cases; one case is an opposition (**436654**), the others are two applications for invalidity (**505976** and **505975**). The parties to the invalidations are **PETC US 1 LLC** (“PETC”) and **Primeur Limited** (“Primeur”). PETC was also the applicant in the opposition proceedings, although PETC’s trade mark application has now been assigned to Boundless EC US LLC (“Boundless”).¹ The only relevance of this transfer of ownership is in relation to the issue of costs, to which I will return. However, throughout the proceedings the applicant in the opposition had been PETC.² Therefore, I will continue to refer to PETC as the applicant in the opposition proceedings.

The opposition by Primeur to PETC’s trade mark application

2. On 18 August 2022, PETC applied to register the following trade mark:

Trade Mark No. UK00003821207 (“the ‘207 mark”)

MIGHTY PAW

Goods and services:

Class 8: *Clippers for dogs and pets.*

Class 9: *Dog whistles; bells.*

Class 16: *Printed instructional materials relating to animals and pets, including pet care; printed matter and publications; magazines; bags for disposing of pet waste.*

Class 18: *Dog apparel; dog clothing; dog coats; dog hats and capes; dog collars; electronic pet collars; pet hair bows; bags for carrying pets; dog collars*

¹ Assignment dated 29 July 2024

² Including the hearing of 5 June 2024

and leads; dog leashes; pet harnesses; coats and clothing for animals; back packs and bags for animals; bags; travelling bags; canvas, vinyl and leather pouches for holding disposable bags to place pet waste in.

Class 21: *Grooming aids and toothbrushes; combs; brushes; sponges; animal cages; flea combs; plastic containers for dispensing food and drink to pets; food and drink containers for animals; dog food scoops; brushes for pets; combs for animals; grooming tools for pets, namely, combs and brushes; pet brushes; deshedding combs for pets; pet feeding and drinking bowls; pet litter boxes; pet cages and crates; household containers for storing pet food; scoops for disposal of pet waste; cups and mugs.*

Class 28: *Games, toys and playthings for animals.*

Class 31: *Foodstuffs and beverages for animals; pet treats; pet snacks; edible chews for animals; rawhide chews.*

Class 35: *Retail, mail order, electronic and on-line retail services connected with the sale of clippers for dogs and pets, dog whistles, bells, printed instructional materials relating to animals and pets, including pet care, printed matter and publications, magazines, bags for disposing of pet waste, dog apparel, dog clothing, dog coats, dog hats and capes, dog collars, electronic pet collars, pet hair bows, bags for carrying pets, dog collars and leads, dog leashes, pet harnesses, coats and clothing for animals, back packs and bags for animals, bags, travelling bags, canvas, vinyl and leather pouches for holding disposable bags to place pet waste in, grooming aids and toothbrushes, combs, brushes, sponges, animal cages, flea combs, plastic containers for dispensing food and drink to pets, food and drink containers for animals, dog food scoops, brushes for pets, combs for animals, grooming tools for pets, namely, combs and brushes, pet brushes, deshedding combs for pets, pet feeding and drinking bowls, pet litter boxes, pet cages and crates, household containers for storing pet food, scoops for disposal of pet waste, cups and mugs, games, toys and playthings for animals, foodstuffs and beverages for animals, pet treats, pet snacks, edible chews for animals, rawhide chews.*

3. PETC's application was published in the Trade Marks Journal on 09 September 2022 for opposition purposes and subsequently opposed in full by Primeur on 04 October 2022. The latter claims that the application offends under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The following registered trade mark is relied upon, which is an 'earlier mark' as per Section 6 of the Act:

Trade Mark no. UK00003471817 ("the '817 mark")

MIGHTY PAWS

Filing date: 03 March 2020

Registration date: 09 August 2020

Goods and services:

Class 12: *Fitted liners in cargo areas of vehicles; vehicle covers.*

Class 18: *Luggage and carrying bags; umbrellas and parasols; walking sticks; collars, leashes; clothing for animals; animal carriers [bags]; Bits for animals [harness]; blankets for animals; clothing for pets; pet collars; collars for pets bearing medical information; covers and wraps for animals; pet leashes; feed bags for animals; fly masks for animals; harness for animals; leads for animals; pet hair bows; pet shoes; pet bellybands; bags for carrying animals; covers for animals; leashes for animals; parts and fittings for all the aforesaid goods.*

Class 20: *Animal bedding; hard beds and baskets; upholstered mats, cushions, mattresses and bedding, all for animals; kennels and carriers for animals; pet scratching posts and pads; pet doors and flaps (non-metal); hutches; runs; parts and fittings for all the aforesaid goods.*

Class 21: *Grooming aids and toothbrushes; food feeding troughs; combs; brushes; sponges; animal cages; bird cages; parts and fittings for all the aforesaid goods; household utensils and containers; cleaning instruments and cloths; litter trays, litter scoops; flea combs.*

Class 24: *Textiles and substitutes for textiles; household linen; curtains of textile or plastic; Beach towels; Children's towels; Pet towels; Face towels; Face towels of textiles; Football towels; Golf towels; Hand towels; Hand towels of textile; Hand-towels made of textile fabrics; Hooded towels; Household linen, including face towels; Kitchen towels; Large bath towels; Tea towels; Terry towels; Towel sets; Towel sheet; Towels; Towels made of textile materials; Turkish towel.*

Class 27: *Rugs, mats and matting; carpets; vehicle mats, covers, liners and carpets; Rugs for animals; floor coverings and artificial ground coverings; feeding mats; parts and fittings for all the aforesaid goods.*

Class 28: *Games, toys and playthings for animals; parts and fittings for the aforesaid goods.*

4. Primeur asserts that the marks at issue are highly similar, that the goods and services are identical or highly similar and that there is a likelihood of confusion, including the likelihood of association. Consequently, it asks that the application for PETC's mark be refused under Section 5(2)(b).

5. PETC filed a counterstatement in which it denies the grounds of opposition. It also denies the validity of the earlier mark, referring to its application for a declaration of invalidity filed against the same (details of which are set out below).

The applications for invalidity filed by PETC against Primeur's trade mark registrations.

6. On 05 April 2023, PETC filed an application to invalidate Primeur's trade mark registration '817, i.e. the earlier mark. On the same day, PETC filed an application to invalidate another trade mark registration owned by Primeur, details of which are set out below:

Trade mark no. UK00003471807 ("the '807 mark")



Filing date: 03 March 2020

Registration date: 09 August 2020

7. The specification of the '807 mark is identical to that of the '817 mark.

8. Both applications for invalidation rely on Section 47(2)(b) on the basis of Section 5(4)(a) of the Act. PETC claims that it has used the sign, MIGHTY PAW, throughout the UK since January 2019 in relation to the following goods and services:

Clippers for dogs and pets.

Dog whistles; bells.

Printed instructional materials relating to animals and pets, including pet care; printed matter and publications; magazines; bags for disposing of pet waste.

Dog apparel; dog clothing; dog coats; dog hats and capes; dog collars; electronic pet collars; pet hair bows; bags for carrying pets; dog collars and leads; dog leashes; pet harnesses; coats and clothing for animals; back packs and bags for animals; bags; travelling bags; canvas, vinyl and leather pouches for holding disposable bags to place pet waste in.

Grooming aids and toothbrushes; combs; brushes; sponges; animal cages; flea combs; plastic containers for dispensing food and drink to pets; food and drink containers for animals; dog food scoops; brushes for pets; combs for animals; grooming tools for pets, namely, combs and brushes; pet brushes; deshedding combs for pets; pet feeding and drinking bowls; pet litter boxes; pet cages and

crates; household containers for storing pet food; scoops for disposal of pet waste; cups and mugs.

Games, toys and playthings for animals.

Foodstuffs and beverages for animals; pet treats; pet snacks; edible chews for animals; rawhide chews.

Retail, mail order, electronic and on-line retail services connected with the sale of clippers for dogs and pets, dog whistles, bells, printed instructional materials relating to animals and pets, including pet care, printed matter and publications, magazines, bags for disposing of pet waste, dog apparel, dog clothing, dog coats, dog hats and capes, dog collars, electronic pet collars, pet hair bows, bags for carrying pets, dog collars and leads, dog leashes, pet harnesses, coats and clothing for animals, back packs and bags for animals, bags, travelling bags, canvas, vinyl and leather pouches for holding disposable bags to place pet waste in, grooming aids and toothbrushes, combs, brushes, sponges, animal cages, flea combs, plastic containers for dispensing food and drink to pets, food and drink containers for animals, dog food scoops, brushes for pets, combs for animals, grooming tools for pets, namely, combs and brushes, pet brushes, deshedding combs for pets, pet feeding and drinking bowls, pet litter boxes, pet cages and crates, household containers for storing pet food, scoops for disposal of pet waste, cups and mugs, games, toys and playthings for animals, foodstuffs and beverages for animals, pet treats, pet snacks, edible chews for animals, rawhide chews.

9. PETC claims that use of Primeur's trade mark registrations will lead to misrepresentation and damage to the goodwill vested in its business, including damage through loss or diversion of sales and dilution of PETC's MIGHTY PAW brand. Consequently, it asks that Primeur's trade marks be invalidated under Section 5(4)(a).

10. Primeur filed a counterstatement in each invalidity proceedings. In its counterstatements, Primeur conceded that the signs at issue are highly similar and that the goods and services are identical, similar or complementary, but denied the

claim that PETC has used the sign MIGHTY PAW and it is the owner of earlier unregistered rights in the UK, requesting proof of goodwill.

11. Given the relationship between the opposition and the applications for invalidity, they were consolidated on 14 August 2023 under Rule 62(1)(g) of the Trade Marks Rules 2008 after receipt of the Forms TM8 and counterstatements in each case.

12. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. A hearing took place before me on 5 June 2024, by video conference. PETC was represented by Kendal Watkinson of Counsel instructed by IP Lane. Primeur was represented by Alan Fiddes of Murgitroyd & Company.

The evidence

13. Primeur's evidence-in-chief consists of the witness statement of Jennifer Douthwaite who is the managing director of Primeur. Ms Douthwaite gives evidence about the use of the mark MIGHTY PAWS by Primeur; her witness statement is dated 15 October 2023 and is accompanied by four exhibits, being those labelled EXH 1 – EXH 4.

14. PETC's evidence-in-chief consists of the witness statement of Richard Cohen who is the director of PETC. Mr Cohen's evidence is principally directed at supporting PETC's claims of use and goodwill. His evidence is dated 19 October 2023 and is accompanied by 13 exhibits, being those labelled EXH1 – EXH13.

15. PETC also filed evidence in reply in the form of the witness statement of Jandan Aliss who is a trade mark attorney and partner at IP Lane, the firm representing PETC in these proceedings. Mr Aliss' statement contains some criticisms to Ms Douthwaite's evidence, it is dated 21 December 2023 and it is accompanied by three exhibits, being those labelled JA1 – JA3.

The approach

16. Both parties agreed at the hearing that the passing off ground under Section 5(4)(a) is the determinative ground in this case, as the opposition stands or falls on the results of the invalidity actions. To be precise, the only invalidity action that counts for the purpose of the opposition is that directed against the earlier mark. However, the key issue identified by the parties at the hearing was essentially whether there is sufficient earlier goodwill, and both parties agree that if there is, both invalidity actions should succeed given the identity/similarity between the goods and services and the high level of similarity between the marks. Should PETC be successful in its application for invalidation of the earlier mark relied upon within the opposition, the opposition will fall away.

17. Accordingly, it is convenient to begin with PETC's applications for invalidation against the '807 and '817 marks, after which I will turn to Primeur's opposition.

RELEVANCE OF EU LAW

18. The provisions of the Act relied upon in these proceedings are assimilated law, as they are 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.

DECISION

19. Section 5(4)(a) states:

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

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

20. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

21. The relevant parts of section 47 state:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

22. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

The relevant date

23. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of Section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

24. The *prima facie* relevant date for assessing whether PETC has sufficient goodwill to sustain its action for passing off is the filing date of the registrations subject to the applications for invalidity. The ‘817 mark and ‘807 mark hold the same filing date of 03 March 2020. Accordingly, PETC must show that it had sufficient goodwill at this date to bring the claims.

25. The *Advanced Perimeter* case also establishes that where the contested mark (i.e. in this case Primeur’s ‘817 mark and ‘807 mark) was used prior to the date in which it was filed for registration, the relevant date will be that of the start of the behaviour complained about, i.e. the first external act about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off.³

26. In this case, Primeur filed evidence about when it started making use of the contested marks; however, that evidence shows that the MIGHTY PAWS brand was developed in early 2020 with the first sales pitch being made to the UK retailer The Range in April 2020 and the products being supplied later in 2020. The first use appears, therefore, to be later than the filing date of the contested marks and, as such, does not alter the relevant date. Further, at the hearing, Mr Fiddes, on behalf of Primeur, conceded that Primeur’s evidence is entirely irrelevant for the determination of the invalidity actions, confirming his position that the relevant date is 03 March 2020. It follows that neither Ms Douthwaite’s evidence about the alleged use of the contested marks, nor Mr Alliss’ evidence aimed at discrediting it, are relevant in these

³ See *Smart Planet Technologies, Inc. v Rajinda Sharma* BL O/304/20.

proceedings; however, I will come back to Ms Douthwaite's evidence insofar as it was part of Ms Watkinson's oral submissions.

27. As it will be recalled, the parties agreed that if PETC manages to prove that it had sufficient goodwill at the relevant date to sustain its claims for passing off, the invalidity actions should be successful. It follows that there is no need for me to consider anything beyond the existence of a protectable goodwill in this case.

Goodwill

28. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

29. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

30. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

31. It is also important to note that in order to be protectable, goodwill must be more than trivial in extent. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is

enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

32. In *Smart Planet Technologies, Inc. v Rajinda Sharma* (BL O/304/20), Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“... a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

33. After reviewing the evidence relied on to establish the existence of a protectable goodwill Mr Mitcheson found as follows:

“The evidence before the Hearing Officer to support a finding of goodwill for Party A prior to 28 January 2018 amounted to 10 invoices issued by Cup Print in Ireland to two customers in the UK. They were exhibited to Mr Lorenzi’s witness statement as exhibit WL-10. The customers were Broderick Group Limited and Vaio Pak.

37. The invoices to Broderick Group Limited dated prior to 28 January 2018 totalled €939 and those to Vaio Pak €2291 for something approaching 40,000 paper cups in total. The invoices referred to the size of “reCUP” ordered in each case. Mr Lorenzi explained that Broderick Group Limited supply coffee vending machines in the UK. Some of the invoices suggested that the cups were further branded for onward customers e.g. Luca’s Kitchen and Bakery.

38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

39. Further, no evidence was adduced from Cup Print to explain how the business in the UK had been won. Mr Rousseau submitted to me that the average consumer in this case was the branded cup supplier company, such as Vaio Pak or Broderick Group. No evidence was adduced from either of those companies or from any other company in their position to explain what goodwill could be attributed to the word reCUP as a result of the activities and sales of Cup Print or Party A prior to 28 January 2018.

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time. The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

34. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its

goodwill and reputation may be small. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, the Court of Appeal in England and Wales held that the defendant had passed off its LUMOS nail care products as the claimant's goods. The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were small, of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. As at the relevant date (October 2010) the Claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, "*very limited*", the claimant's goodwill was found to be sufficient to entitle it to restrain the defendant's trade under LUMOS.⁴

35. I now turn to PETC's evidence.

The evidence of goodwill

36. Mr Cohen says that the 'MIGHTY PAW' brand was first introduced in the USA in April 2015 by another company called Warters Edge LLC and was subsequently purchased by PETC in December 2021. Whilst Mr Cohen says that the 'MIGHTY PAW' products have been available for purchase in the UK since as earlier as 2016 via platforms such as Amazon.co.uk, the only details given in his evidence about sales are for the years 2019 to 2022.⁵

37. The fact that the brand was originated in the USA is reflected in some evidence which is poorly focused and not particularly helpful. For example, Mr Cohen refers to two US registrations for the trade marks 'MIGHTY PAW' and 'MIGHTY PAW BY DOG LOVERS FOR DOG LOVERS' which were filed in 2017;⁶ this evidence is clearly irrelevant for the purpose of establishing that PECT had, at the relevant date, a business with customers in the UK capable of giving rise to a protectable goodwill in

⁴ See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); (COA)

⁵ EXT-3

⁶ EXT -1

this jurisdiction.⁷ Likewise, the evidence relating to PECT's website (www.mightypaw.com) indicates that it is mainly targeted at US consumers as it shows the price of the goods in US dollars; although some of the webpages exhibited show the selection "*United Kingdom (USD \$)*", which suggests that it is possible to buy the goods from the UK, there is nothing to indicate that the website is targeted at UK consumers.

38. Other evidence, although relating to the UK, is after the relevant date and does not assist in determining the question of whether PECT had goodwill in the UK at the relevant date. In particular, the UK turnover derived from sales subsequent to the relevant date of 03 March 2020 and amounting to nearly £21K in 2020, nearly £23K in 2021 and just over £81K in 2022, cannot be taken into account. At the hearing Ms Watkinson pointed out that the evidence establishes that sales for 2019 totalled £33,627.33 and that from January 2020 to March 2020 sales totalled approximately £6,500. She further added that since the goods in question are low-cost items with an average cost of approximately £9.50, these figures represent the sale of approximately 4,200 items between January 2019 and March 2020.

39. I also observe that whilst the webpages from www.mightypaw.com display a variety of MIGHTY PAW branded products for pets (e.g. chews, harnesses, collars, leashes, treats, treats pouches, car belts, clips, bowls, nail clippers, training clickers, grooming rakes, grooming gloves, grooming scissors, bells, splash mats, pet sprays and pet supplements) as well as hoodies and t-shirts, the "Sales Summaries" document exhibited by Mr Cohen shows that most of the products sold through Amazon UK were whistles, safety belts and training clickers (a fact pointed out by Mr Cohen himself).⁸

40. Finally, the evidence includes examples of Amazon UK customer reviews relating to a MIGHTY PAW dog seat belt product⁹ and copy of an advert for a MIGHTY PAW doorbell which was published on the US Vanity Fair magazine in December 2022;¹⁰

⁷ *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others*, [2015] UKSC 31

⁸ EXT-5

⁹ EXT-12

¹⁰ EXT-13

however, as the advert is targeted at the US consumers and is dated after the relevant date, it does not assist in establishing goodwill in the UK at the relevant date.

Conclusion on goodwill

41. The onus is on PETC to establish that, at the date of filing of Primeur's trade marks, i.e. the relevant date, it had sufficient goodwill in the sign relied upon that it could prevent the use (and registration) of Primeur's trade marks under the law of passing-off.

42. At the hearing, Ms Watkinson focused on the date that PETC first started using the sign 'MIGHTY PAW'. The case, as it was presented, was clearly directed at showing that PETC had used the brand 'MIGHTY PAW' since 2019, before any relevant use by Primeur in 2020.

43. However, for PETC to succeed in its passing-off action, it is not enough to show that its use of the unregistered sign 'MIGHTY PAW' predates Primeur's use of the contested registrations. As it was correctly pointed out by Mr Fiddes in his reply, use is not the same as goodwill or reputation. Here the question is not "who has started the use of the sign first?" but whether PETC had sufficient goodwill to prevent the use of Primeur's trade marks at the relevant date of 3 March 2020.

44. Regarding the test for goodwill, without suggesting that it is more onerous in an invalidity than in an opposition, in *Dixy Fried Chickens (Euro) Ltd, Re* [2003] EWHC 2902 (Ch) Mr Justice Laddie, significantly, noted that before one can invalidate a registration based on Section 5(4)(a), it must properly substantiate the claim to goodwill with relevant credible evidence. He stated:

"Once registered, a trade mark is presumed to be valid. It is for this respondent to prove otherwise. When a s. 5(4)(a) attack is being run, the attacker must prove on a balance of probabilities that the use of the mark can be prevented by an action for passing off. As Pumfrey J explained in *REEF Trade Mark* [2002] RPC 19, the Registrar is entitled to receive sufficient evidence at least to raise

a prima facie case that the attacker's reputation extends to the goods comprised in the specification of goods for the registered mark. He also said:

"Thus evidence will include evidence from the trade as to reputation; evidence as to the manner in which goods are traded or the services supplied; and so on." (para 27)

In other words, mere assertion is not enough. Before one can invalidate a registration and thereby deprive a trader of his exclusive rights, one must produce relevant credible evidence of sufficient weight. This is the same as the requirement for a "genuine and properly substantiated likelihood of confusion" referred to in WILD CHILD Trade Mark [1998] RPC 455."

45. These are cancellations based on the ability to prevent the use of presumed validly registered trade marks through the law of passing-off. It is not possible for an applicant for invalidity just to say "*because we have established on the evidence that our use of the mark predates the proprietor's use of its marks the invalidity actions should succeed*", which is, in effect, my understanding of PETC's case. Further to this argument, Ms Watkinson referred to the sales figures prompted by my invitation to comment on the value of the goods sold. She conceded the point that the turnover, being approximately £40,000, might "*not seem like a huge amount*", but argued that in the context of the products being sold - which are low-cost products selling for just less than £10 per item - it translates in a large number of goods being purchased, which Ms Watkinson calculated as being in the range of 4,200 items over a period of 14 months. Finally, Ms Watkinson referred to the total sales of PETC's products for the years 2019 to 2022, which amount to £160,437.32, to PETC's products featuring in the Vanity Fair magazine, which, Ms Watkinson stated, "*is a well-known magazine, widely accessible in the UK*" and to the positive reviews received by PETC attesting to the quality and effectiveness of the products sold under and by reference the sign 'MIGHTY PAW'.

46. The fact that PETC's sales might have increased after the relevant date cannot improve PETC's position at the relevant date. By the relevant date, PETC had sold approximately £40,000 worth of whistles, safety belts and training clickers. The goods

were sold through Amazon UK, the only distribution channel through which PETC goods were made available to the UK public. Whilst there are some customer reviews, there is no evidence of repeat purchases; further, the reviews refer to the inherent quality of the goods and none of the reviews indicates that the goods were selected because of the strength of the brand 'MIGHTY PAW'. There is no evidence that PETC's goods were promoted in the UK and there is no indication of marketing spend. Length of use is also relevant to establishing recognition by the public, and in this case, there is only a short period of prior use of about 14 months. Finally, the evidence about the Vanity Fair advert has no weight since it relates to the USA and is dated in 2022 (i.e. two years after the relevant date), so it cannot retrospectively contribute to the goodwill PETC must show to have generated (if any) by March 2020.

47. Although in *Lumos* goodwill was established on the basis of what was considered a very limited number of customers and small sales, the goods were high-end skin products which were originally sold at £120 per bottle, and there was evidence that the products were being used in 20 aesthetic clinics, and in 21 beauty salons. Further, there was evidence that the goods were targeted at a small part of the total skincare market, namely a niche described as "anti-ageing serums" and the judge found that a very modest goodwill had been generated in the LUMOS mark in relation to skincare products, and that such goodwill related to a particular niche within that market.

48. Indeed, the size of the market for the goods concerned is a relevant consideration. This is because the sales volumes must be considered not only in absolute terms but also in the context of the relevant industry, i.e. in terms of what proportion of the relevant market is occupied by the sign. Further, the smaller the market for the goods, the more likely is that slighter trading activities may suffice than for goods which target larger markets. This approach was confirmed in *Smart Planet Technologies*, where it was concluded that the sale of 40,000 cups was insufficient to achieve a protectable goodwill because it was a tiny share of the relevant market:

"38. Mr Rousseau urged me not to dismiss the sales figures as low just because the product was cheap. I have not done so, but I must also bear in mind the size of the market as a whole and the likely impact upon it of selling 40,000 cups. Mr Lorenzi explained elsewhere in his statement that the UK market was

some 2.5 billion paper coffee cups per year. That indicates what a tiny proportion of the market the reCUP had achieved by the relevant date.

[...]

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.”

49. In this case there is no evidence about the size of the industry for whistles, safety belts and training clickers for dogs and/or other animals. However, given that the UK is a nation of dog owners, I expect the market for these goods to be very large indeed.

50. Taking all of the above into account, my conclusion is that PETC has not proven that there was a sufficient goodwill in the mark ‘MIGHTY PAW’ to support its claim of passing off.

51. The invalidity actions based on Section 5(4)(a) fail at the first hurdle.

OUTCOME

52. At the hearing both parties agreed that the marks are highly similar, and the goods are identical or highly similar or complementary. Hence, it was common ground that the opposition would stand or fall together with the results of the cancellation actions.

53. As I found that the invalidity action against Primeur’s earlier mark has failed, I also find that Primeur’s opposition against PETC’s trade mark no. UK00003821207 is successful.

54. Accordingly, I find that:

- PETC’s cancellations against Primeur’s trade mark registrations nos. UK00003471807 and UK00003471817 fail. These registrations will remain validly registered;
- Primeur’s opposition to PETC’s trade mark application no. UK00003821207 succeeds, and the application will be refused registration.

COSTS

55. Primeur has been successful in both invalidity actions and in the opposition. It is therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notices 4/2016 (in relation to the opposition) and 1/2023 (in relation to the cancellations).¹¹ In the circumstances, I award Primeur the sum of £400 for the opposition and the sum of £2,100 for the cancellations, calculated as follows:

Costs for the opposition	
Preparing and filing the TM7 in the opposition	£200
Official fees for the opposition	£200
Total for the opposition	£400
Costs for the cancellations	
Preparing and filing the TM8s and counterstatements in the two cancellations	£500
Reviewing the other party’s evidence in the cancellations ¹²	£600
Preparing for and attending a hearing	£1,000
Total for the cancellations	£2,100

56. The reason why I have split the costs in this way is that the new applicant in the opposition, i.e. Boundless, has undertaken to cover the costs for which the original applicant PETC - who is also the cancellation applicant - is liable, in the event that the

¹¹ TPN 1/203 contains a revised scale of costs, which are the first increases since 2016. The new scale applies to proceedings commenced on, or after, 1 February 2023. Both cancellations were filed on 5 April 2023.

¹² I did not award any costs for the evidence filed by Primeur as it was not relevant.

opposition is successful.¹³ However, the assignment of PETC's trade mark application no. UK00003821207 to Boundless has no cost consequences on the cancellations.

57. Accordingly:

- I order PETC US 1 LLC to pay Primeur Limited the sum of £2,100. 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.
- I order Boundless EC US LLC to pay Primeur Limited the sum of £400. 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 6th day of September 2024

TERESA PERKS

For the Registrar

¹³ On 03 September 2024 IP Lane confirmed that the new applicant:- (1) has had sight of any forms or evidence filed; (2) stands by the statements made in the counterstatement and confirm that where the name of the original applicant appears, this should be read as though it is made in the new name; (3) is aware of and accepts the liability for costs for the whole proceedings in the event that the opposition is successful.