O/0880/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003634900
BY SHEAR PAWFECTION LTD
TO REGISTER:

AS A TRADE MARK IN CLASS 44

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 426508
BY MRS NATASHA BAINES

BACKGROUND AND PLEADINGS

1. On 30 April 2021, Shear Pawfection Ltd ("the applicant") applied to register the trade mark on the cover page of this decision in the UK. The application was published for opposition purposes on 16 July 2021. The applicant seeks registration for *dog and cat grooming services* in class 44.

2. On 25 August 2021, the application was partially opposed by Mrs. Natasha Baines ("the opponent") in respect of *dog grooming services* in class 44. The opposition is brought under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies on the following trade mark:

UKTM No. 3548357
Filing date: 26 October 2020
Registration date: 19 March 2021
Relying on *Retail services in relation to animal grooming preparations* in class 35 and *Dog grooming services* in class 44.

3. The trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years before the filing date of the application in issue, it is not subject to the use provisions in section 6A of the Act. The opponent can, therefore, rely upon all of the services identified.

4. The opponent makes the following claims:

"The mark holder's mark [sic] clearly shows the image of an animal paw print and the word prominently displayed "Pawfections". In addition, the words "K9" and "Professional Dog Grooming". There is no disputing that the mark is for dog

grooming services for which the mark holder provides a widely recognised first-class service which she has innovatively describes as "Pawfections". The opponent's mark clearly shows the word prominently displayed "Pawfection". This is a direct copy of our client's mark."

5. The applicant filed a counterstatement denying the claims made.[1]

6. The opponent is unrepresented, and the applicant was represented by Anthony Burrows during the course of the proceedings until 30 April 2025. Only the applicant filed evidence. No hearing was requested and neither party filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.

7. 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.

EVIDENCE

8. The applicant's evidence came in the form of the witness statement of Anthony Gregory Burrows, the applicant's appointed representative. The witness statement is dated 6 August 2024 and is accompanied by 4 exhibits, being AGB01-AGB04. The purpose of the evidence is to show that other companies use the term "Pawfections" for their services.

9. I have taken the evidence into account in reaching this decision and will refer to it below, where necessary.

[1] The late TM8 and counterstatement was admitted into the proceedings following decision BL O/0854/23

DECISION

Sections 5(1) and 5(2): legislation

10. Sections 5(1) and 5(2) of the Act read as follows:

> "(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.
>
> (2) A trade mark shall not be registered if because-
>
> > (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
> >
> > (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."

11. Section 5A of the Act states as follows:

> "Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

Section 5(2) case law

12. The following principles are 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 B.V*. Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

My approach

13. I will begin the substance of my decision by first considering whether the opponent's mark and the applicant's mark are identical. I do so because it is a prerequisite of both sections 5(1) and 5(2)(a) that the marks be identical. If they are deemed to be identical then both grounds will proceed, and I will move to consider the comparison of the services. However, if they are not deemed identical then the grounds will fall away, and I will then proceed to consider the section 5(2)(b) ground only.

Identity of the marks

14. In considering the present issue, I remind myself of the case of *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, wherein CJEU held that:

> "54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

15. The competing marks are as follows:

Opponent's mark	Applicant's mark
K9 Pawfections Professional Dog Grooming	ShearPawfection Mobile Pet Grooming Spa

16. The marks clearly contain differences that are not so insignificant that they would be overlooked by consumers. As such, they are not identical meaning that the opponent's section 5(1) and 5(2) grounds fail at the first hurdle.

17. I will now proceed to consider the section 5(2)(b) ground, beginning with a comparison of the services.

Comparison of services

18. The services to be compared are as follows:

Opponent's services	Applicant's services
Class 35: Retail services in relation to animal grooming preparations. Class 44: Dog grooming services.	Class 44: Dog grooming services.

19. Both specifications include the identical term *Dog grooming services.* Therefore, they are self-evidently identical.

The average consumer and the purchasing act

20. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

21. The average consumer for the services at issue is a member of the general public, more specifically, dog owners. The services are likely to be the subject of self-

selection from websites or traditional advertisements. For this reason, visual considerations are likely to play the biggest role in the selection process. I do not, however, discount aural considerations as it would not be unusual for recommendations to be made through word of mouth.

22. The frequency of the purchase and the cost is likely to vary depending on the type of service required. A number of factors are likely to be borne in mind when selecting the service such as cost, suitability for their specific requirements but also the reputation of the provider as consumers will be conscious of maintaining their pet's welfare. Such factors lead me to conclude that the level of attention paid during the purchasing process will be at least medium.

Comparison of the marks

23. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

24. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

25. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the

marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

26. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
K9 Pawfections Professional Dog Grooming	ShearPawfection Mobile Pet Grooming Spa

27. The opponent's earlier mark is a figurative mark that consists of several elements. The word "K9" appears in a standard white font, placed inside a pink figurative paw print device. The word "Pawfections" appears alongside in a standard pink font. In a smaller, grey font, the wording "Professional Dog Grooming" appears below. I keep in mind that in the case of a mark consisting of both word and figurative elements, according to well-established case law, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned.[2] In my view, the wording "K9 Pawfections" (being the largest text element to which the eye is naturally drawn), and the paw device (due to its size and position within the mark), make a roughly equal contribution to the overall impression. The wording "Professional Dog Grooming" plays a lesser role due to its size and position within the mark and on account of it being descriptive of the services provided.

28. The applicant's mark consists of a figurative device of a cat and dog drawn with black and blue brushstrokes. Beneath that is the wording "ShearPawfection" in a

[2] *Migros-Genossenschafts-Bund v EUIPO – Luigi Lavazza (CReMESPRESSO)*, Case T-189/16, paragraph 52

standard black italic font. In a smaller grey italic font below is the wording "Mobile Pet Grooming Spa". The larger wording "ShearPawfections" and the device element play the greater role in the overall impression. Again, the size, position and descriptive nature of the wording "Mobile Pet Grooming Spa" leads me to conclude that this element plays a lesser role in the overall impression.

29. Visually, the wording "Pawfections/Pawfection" are similar with the letter "s" at the end of the earlier mark differentiating them. This word is the second element of both marks. The marks also overlap through use of the word "grooming" though I remind myself that I found this element to play a lesser role in both marks due to its size and position within the respective marks and on account of it being descriptive of the services provided. The marks differ through their remaining verbal elements and figurative elements. The opponent's mark begins with the wording "K9" whereas the applicant's mark begins with the wording "Shear". At this point, I remind myself that the beginning of marks tends to draw more focus.[3] The device elements are also different, one being a dog paw print device and the other being a cat and dog device. The use of colour and stylistic differences add an additional point of difference. Taking into account my earlier findings regarding the marks' overall impressions, I find that the marks have a low degree of visual similarity.

30. In considering the aural impact of both marks, it is my view that the words "Professional Dog Grooming" in the opponent's mark and "Mobile Pet Grooming Spa" in the applicant's mark will not be articulated by the average consumer. In making this finding, I have borne in mind the decision of Mr Philip Harris, sitting as the Appointed Person, in *Purity Hemp Company Improving Life as Nature Intended.*[4] At paragraph 31, he said that the descriptiveness of an element does not in itself render that element negligible or *"aurally invisible".* In the present case, the descriptive wording in both marks is smaller than "K9 Pawfections" and "ShearPawfection", and their articulation would add a further seven and six syllables respectively. I consider that these factors would lead to the consumer

[3] Case T-183/02, *El Corte Ingles, SA v OHIM*
[4] BL O/115/22

articulating the opponent's mark as "K-9 PAW-FEC-SHUNS" and the applicant's mark as "SHEE-UH-PAW-FEC-SHUN". The marks therefore have an identical third and fourth syllable and highly similar fifth syllable though they differ in their first two syllables. Consequently, I find the marks share a low to medium degree of aural similarity.

31. Conceptually, the verbal element "K9" in the opponent's mark will be recognised by consumers as a homophone for "canine". The word "Pawfections" will be seen as a laudatory pun combining the word "paw" with "perfection". The wording "Professional Dog Grooming" will be be recognised as a reference to the dog grooming services that the opponent provides with the paw print device reinforcing this concept.

32. The applicant's wording "ShearPawfection" will be perceived by consumers as a play on words for the well-known phrase "sheer perfection". This is likely to be recognised as a reference pet grooming services that are "sheer perfection" and it is therefore laudatory in nature. This is reinforced by the descriptive wording "Mobile Pet Grooming Spa" and the cat and dog device.

33. Both marks share the concept of an undertaking that provides pet grooming services, though the opponent's mark indicates that it provides dog grooming services only. Consequently, I find there is a high degree of conceptual similarity.

Distinctive character of the earlier mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

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

36. The opponent has not pleaded that its mark has obtained an enhanced level of distinctiveness, nor has it filed any evidence to that effect. Therefore, I have only the inherent position to consider.

37. As previously discussed in the conceptual comparison, the average consumer will perceive the word "K-9" as a homophone for the word "canine" and "Pawfections" will be seen as a pun incorporating the words "paw" and "perfection". Both these elements will be seen a play on words that allude to the services provided. Further, I consider that the term "Pawfections" is laudatory in nature. Although the paw device also alludes to the services offered, its stylisation and presentation alongside the wording "K9 Pawfections" affords it some degree

of distinctiveness. The wording “Professional Dog Grooming” is wholly descriptive of the services. Overall, I find the mark possesses a low degree of distinctiveness.

Likelihood of confusion

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

39. I have found the services to be identical. I have found the average consumer will comprise of dog-owning members of the general public and will pay at least a medium degree of attention during the purchasing process. I found that the services would be selected primarily by visual means, although I did not discount an aural aspect to the purchasing process. I have found the marks to be visually similar to a low degree and aurally similar to a low to medium degree. I have found the marks conceptually similar to a high degree. I have found the earlier mark to hold a low degree of inherent distinctiveness.

40. In relation to assessing the likelihood of confusion where the common element has no or low distinctiveness, I keep in mind that in *Face2FaceHR Partners Limited v Peninsula Business Services Limited, O/0368/23,* Emma Himsworth

K.C., as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin [2015] EWHC 1271 (Ch) and Nicoventures Holdings Limited v The London Vape Co Ltd [2017] EHWC 3303 (Ch),* as well as guidance in the Common Communication on the Common Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non-distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Ms Himsworth summarised the correct approach as follows, at paragraph 44:

> "(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.
>
> (2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.
> (3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.
>
> (4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.
>
> (5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.
>
> (6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical."

41. Having regard to the guidance referred to above, I am of the view that there is no likelihood of direct confusion. This is because given the low degree of distinctiveness of the highly similar element "Pawfections/Pawfection", along with the descriptiveness of the shared element "grooming", the differences in the competing marks will take on a greater significance for the average consumer than they might otherwise, even taking into account imperfect recollection.

Although the stylised aspects of the competing marks are not particularly remarkable, they each create a very different overall impression. I therefore find that these differences along with the different wording such as “K9” versus “Shear” will not go unnoticed by consumers paying at least a medium degree of attention. Whilst I accept that the marks share a similar concept, I remind myself that this concept will be highly allusive when viewed against the dog/pet grooming services provided.

42. I will proceed to consider a likelihood of indirect confusion. I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., 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 recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.
>
> 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)".

43. These examples are not exhaustive but provide helpful focus.

44. I recognise that the Court of Appeal has emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.[5] In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.[6]

45. On reflection of my findings throughout the decision, even when approached in regard to identical services, I see no logical basis on which the average consumer, having identified that the marks are not the same and acknowledged their differences, would be minded to conclude that they originate from a shared or related undertaking. The differences between the marks are not consistent with any of the examples set out *in L. A. Sugar* and I cannot identify any additional basis on which the consumer would reasonably reach that conclusion. Any similarity between the marks' elements, especially where both marks provide a conceptual indication of dog/pet grooming services, would likely be attributed to coincidence rather than shared or related undertakings providing those goods and services. Consequently, I do not consider there to be any likelihood of indirect confusion.

[5] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207
[6] *Duebros Limited v Heirler Cenovis GmbH,* Case BL O/547/17

CONCLUSION

46. The opposition under section 5(2)(b) has failed. Subject to any appeal against this decision, the application will proceed to registration.

COSTS

47. The applicant has succeeded and is entitled to a contribution towards its costs. I note that in the decision for the late-filed Form TM8 in these proceedings, the hearing officer confirmed that costs will be considered at the final determination of the case. As the applicant succeeded at that hearing, I deem it appropriate for me to also award costs in respect of their preparation and attendance in respect of the same. Awards of costs in proceedings commenced on or after 1 July 2016 and before 1 February 2023 are governed by Annex A of Tribunal Practice Notice ('TPN') 1 of 2016. Using that TPN as a guide, I award the applicant the sum of **£1400** as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement:	£200
Filing evidence and submission:	£400[7]
Attending late TM8 hearing and filing skeleton arguments:	£800
Total:	**£1400**

48. I therefore order Mrs. Natasha Baines to pay Shear Pawfection Ltd the sum of £1400. The above sum should be paid within twenty-one days of the expiry of the

[7] I have reduced this to below the scale minimum as the evidence and submissions were light (totalling less than 25 pages) and did not assist me in my decision.

appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 23rd day of September 2025

Catrin Williams
For the Registrar