

O/1005/24

TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO. 3818959
IN THE NAME OF JAMIE WILES AND SIAN WILES
TO REGISTER

Perfectly Pawsome

AS A TRADE MARK IN CLASS 31
AND
OPPOSITION THERETO UNDER NO. 437216
BY
PETS NATURE GMBH

Background and pleadings

1. On 11 August 2022, Jamie Wiles and Sian Wiles (“***the Applicant***”) applied to register in the UK the trade mark shown on the cover page of this decision, under number UK00003818959 (“***the Contested Mark***”). Details of the application were published for opposition purposes on 26 August 2022. Registration is sought for the following goods:

Class 31 Natural dog treats; Natural cat treats; Dog treats; Cat treats; Dog food; Cat food; Dog kibble; Cat kibble; Dog biscuits; Cat biscuits; Raw dog food; Raw cat food; Small animal food Small animal bedding; Animal feed; Natural dried dog treats; Natural dried cat treats; Dried dog food; Dried cat food; Bones for dogs.

2. On 31 October 2022, Pets Nature GmbH (“***the Opponent***”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“***the Act***”). The Opponent relies upon the following UK prior trade mark registration (“***the Earlier Mark***”):

Mark: Pawsome!

registration number: UK00917881619

Filing date: 28 March 2018

Registration date: 13 July 2018

Goods relied upon:

Class 31 Foodstuffs and fodder for animals.

3. For the purposes of the opposition, the Opponent relies upon all of the goods for which the Earlier Mark is registered as indicated above.

4. By virtue of its earlier filing date of 28 March 2018, that registration constitutes an earlier mark within the meaning of section 6 of the Act. As the Earlier Mark had not completed its registration process more than five years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the goods it has identified without having to demonstrate use.

5. In its statement of grounds, the Opponent contends that the respective marks are visually, aurally, and conceptually highly similar and the goods are identical or similar. The opponent submits that the dominant and distinctive element of the respective marks is “Pawsome” and the addition of “Perfectly” in the Contested Mark has only a laudatory function that does not add any distinctiveness to the mark. Due to the similarity between the Contested and Earlier Mark and the identity or similarity of the goods, the Opponent submits that there exists a likelihood of confusion on the part of the public, including the likelihood of association, and that the contested application should be refused under S. 5(2)(b) of the Act.
6. The applicant filed a counterstatement, denying the grounds of opposition. In particular the applicant submits that the combination of “perfectly” and “pawsome”, as a whole, create an impression that differs from the Earlier Mark.

Relevance of EU law

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 and submissions

8. Both the opponent¹ and applicant² filed written submissions and evidence. These will not be summarised here but will be referred to as and where appropriate during this decision. Neither party requested a hearing, but the opponent filed submissions in lieu. This decision is taken following a careful perusal of the papers.

Preliminary considerations

State of the register

¹ Submissions dated 7 August 2023 and 12 December 2023.

² Submissions and witness statement of Alex Pugh dated 10 October 2023.

9. The applicant submits in its defence that several marks on the UK IPO register include 'pawsome'. The applicant did not provide evidence in support of this argument.

10. I note that in the case of *Zero Industry Srl v OHIM*, Case T-400/06, the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy Case T 135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II 4865, paragraph 68, and Case T 29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II 5309, paragraph 71)."

11. The fact that there are several marks containing the word "pawsome" does not provide much assistance in relation to the distinctiveness of the opponent's mark. The applicant has filed no evidence to demonstrate that any of these marks are actually in use in the marketplace and this argument does nothing to assist the applicant as the assessment that I must undertake is based on the perception of the average consumer.

Actual confusion

12. In its counterstatement the applicant argues it is not aware of cases of actual confusion between the competing marks. Although I acknowledge this comment, I must clarify that the absence of actual confusion will not have any bearing on whether there exists a likelihood of confusion between the respective marks. Whilst evidence of actual confusion may be persuasive where it exists, the absence of

confusion in the marketplace is rarely significant.³ This is because the absence of confusion may be down to the earlier mark having only been used to a limited extent, in relation to only some of the goods for which it is registered, or in such a way that there has been no possibility of the one being mistaken for the other.⁴ The provisions of the Act are not merely a reflection of what may be happening in the market. Even where there is no confusion in practice, it remains possible for there to be a finding of a likelihood of confusion.⁵

The opponent does not market in the UK

13. The applicant contends that there cannot be likelihood of confusion between the marks because the Opponent does not trade in the UK.⁶ The applicant provides evidence showing the opponent exclusively ships to Germany, Austria, The Netherlands, Denmark, Belgium and Luxembourg.⁷ However, it is important to note that the opponent's mark is a national right which allows them to enforce it in the UK and the alleged fact that the applicant only trades outside the UK is irrelevant for the purposes of this opposition and to prevent a finding of a likelihood of confusion.

Use of the Contested Mark

14. The applicant provided evidence showing the domain name "perfectlypaswsome.co.uk" was registered on 10 November 2020 and that the applicant started to retail on 4 January 2021 using the Contested Mark on its website (**Exhibit JWSW2** and **Exhibit JWSW3**). The Applicant also provided evidence showing the use of the Contested Mark on its website, marketing materials (**Exhibit JWSW6**), at events such as markets and shows (**Exhibit JWSW7**), and on social media (**Exhibit JWSW9**). This evidence is undated. The applicant also submitted some invoices, dated September/October 2023, showing the use of the Contested Mark (**Exhibit JWSW8**). In the eventuality the applicant provided this evidence to show use of the Contested Mark predating the

³ *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283.

⁴ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220.

⁵ *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41).

⁶ Witness Statement of Alex Pugh dated 10 October 2023.

⁷ Exhibit JWSW10.

opponent's mark, I find the applicant's evidence to be insufficient because the Earlier Mark's registration (13 July 2018) precedes the first documented use of the applicant's mark (10 November 2020).

15. In any case, even if the applicant's evidence had predated the Earlier Mark's registration, such evidence would not have assisted the applicant under section 5(2)(b) of the Act for the reasons given in Tribunal Practice Notice 4/2009 which states (my underlining):

"4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

Decision

The law

16. The relevant parts of section 5 of the Act are as follows:

"5(2) A trade mark shall not be registered if because—

(a) [...]

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

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

“5A 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.”

Case law

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

The Principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

18. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

a) The respective users of the respective goods or services;

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

20. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

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

21. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

22. The competing goods are as follows:

Opponent’s goods	Applicant’s goods
<u>Class 31</u>	<u>Class 31</u>

Foodstuffs and fodder for animals.	Natural dog treats; Natural cat treats; Dog treats; Cat treats; Dog food; Cat food; Dog kibble; Cat kibble; Dog biscuits; Cat biscuits; Raw dog food; Raw cat food; Small animal food Small animal bedding; Animal feed; Natural dried dog treats; Natural dried cat treats; Dried dog food; Dried cat food; Bones for dogs.
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- *‘Natural dog treats; Natural cat treats; Dog treats; Cat treats; Dog food; Cat food; Dog kibble; Cat kibble; Dog biscuits; Cat biscuits; Raw dog food; Raw cat food; Small animal food; Animal feed; Natural dried dog treats; Natural dried cat treats; Dried dog food; Dried cat food; Bones for dogs.’*

23. The above terms fall within the wider scope of the opponent’s “*Foodstuffs and fodder for animals*”. Thus, these goods are identical in line with *Meric*.

- *‘Small animal bedding’*

24. The opponent contends that “*small animal bedding*” and “*foodstuffs and fodder for animals*” are complementary and the public would expect these goods to originate from the same or economically linked undertaking.⁸ The opponent does not elaborate further on this point.

25. I appreciate that the respective goods are different in nature (i.e., the opponent’s goods are foodstuffs whilst the applicant’s bedding for animals is normally made of absorbent material intended for the animals’ comfort). The respective goods do not have the same intended purpose. However, they are likely to be sold via the same trade channels. Further, the competing goods are likely to be sold in the same pet supply establishments and retailers. They may also be sold on the same isle in larger supermarkets. Therefore, I conclude that the opponent’s “*foodstuffs and*

⁸ Submissions dated 7 August 2023.

fodder for animals” are similar to the applicant’s “*small animal bedding*” at least to a low degree.

The average consumer and the nature of the purchasing act

26. It is necessary to determine who the average consumer is for the respective parties’ goods. I must then decide the manner in which these goods 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”.

27. The average consumer of the category of products concerned is deemed to be the reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96, *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31).

28. 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 in question.⁹

29. The average consumer for the goods in Class 31 (foodstuffs for animals) will be members of the general public, mostly pet (or animal) owners or those working with animals (i.e., on farms). The goods will be subject to self-selection from the shelves of retail establishments such as supermarkets or specialist pet/animal stores. Whilst visual factors are, consequently, likely to dominate the selection process, it

⁹ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, (Case C-342/97, para 26).

would not be unusual for sales advisors to provide advice or recommendations orally, so aural considerations cannot be ignored.

30. The goods are generally inexpensive items purchased fairly frequently. That said, consumers will be alive to factors such as ingredients and suitability and, given the responsibility of animal owners and their affection towards their pets, are likely to apply at least a medium degree of attention during the purchasing process.

Comparison of trade marks

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

32. 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”.

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

34. The trade marks to be compared are as follows:

Earlier trade mark	Contested trade mark
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Pawsome!	Perfectly Pawsome
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Overall impression

35. The overall impression of the Earlier Mark resides in the single word of which it is composed (including the exclamation mark).

36. In its counterstatement, the applicant submitted that (my underlining) “[...] *the average consumer will understand ‘pawsome’ to be a play on words, combining ‘paws’ and ‘awesome’. The effect of this will be to draw the consumer’s attention to this word, but the first part of the phrase ‘perfectly’ also makes some contribution to the overall impression of the mark.*” Therefore, the applicant seems to recognise that the dominant and distinctive part of the Contested Mark would be “pawsome” and the addition of “perfectly” merely emphasises the mark’s distinctive element. Thus, I find the overall impression of the Contested Mark resides mainly in “pawsome” with “perfectly” contributing in a laudatory manner to the mark’s overall impression.

Visual similarity

37. The Earlier Mark features the word ‘pawsome’ followed by an exclamation mark. The Contested Mark is comprised of the words ‘perfectly’ and ‘pawsome’, both with capitalised ‘P’. I appreciate that consumers read left to right and that the beginnings of words tend to have more visual impact than the ends.¹⁰ However, in *Bristol Global Co Ltd v EUIPO*, T-194/14 the GC held that “[...] an at least partial identity between two marks may be an indication of their visual similarity.” In the case at hand, the Earlier Mark is almost wholly contained in the Contested Mark; the differences between the respective marks are the word ‘perfectly’, placed at the beginning of the Contested Mark, and the Earlier Mark’s exclamation mark which

¹⁰ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

consumers may overlook entirely or simply not pay that much attention to. Therefore, I find the marks to be visually similar at least to a medium degree.

Aural similarity

38. The Earlier Mark consists of the two-syllable word “paw/some” followed by an exclamation mark (the relevant consumers will not voice the exclamation mark and, thus, it will not impact the mark’s pronunciation). The Contested Mark comprises the three-syllable word “per/fec/tly” and the two-syllable word “paw/some”. The relevant consumers will pronounce “perfectly” with its dictionary meaning and as the first word of two in the Contested Mark. In both marks the relevant consumer is likely to read “pawsome” in the same manner voicing it as the combination of the two dictionary words “paw” and “awesome” (i.e. “po-soom”). Therefore, I find the marks to be visually similar between a medium and high degree.

Conceptual similarity

39. The applicant, in its counterstatement, submitted that “pawsome” does not have a dictionary definition. However, both parties in their submissions indicated that the relevant consumer would understand “pawsome” as a play on words combining “paws” and “awesome”. Therefore, the relevant consumers are likely to understand both marks as conveying a play on the combination “paws” and “awesome”. In the Contested Mark the inclusion of “perfectly” further qualifies “pawsome” giving it a laudatory connotation. Overall, I find the marks to be conceptually similar to a medium degree.

Distinctive character of the Earlier Mark

40. 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)."

41. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

42. Although the distinctiveness of a mark may be enhanced as a result of it having been used in the market, the Opponent has filed no evidence of use of its mark. Accordingly, I have only the inherent position to consider.

43. In its witness statement, the applicant argued that the word "pawsome" is common in relation to pet food retail and submitted evidence showing some uses of this term online (**Exhibit JWSW1**).¹¹ The opponent addressed this piece of evidence arguing that "*only one result, <https://www.thepawsomeco.shop/>, relates directly to pet food. All other results relate to other pet products generally.*" I find the applicant did not provide sufficient evidence to show that "pawsome" is widely used within the relevant market to have a reduced distinctive character.

44. According to the parties' submission, the word "pawsome" derives from the play on the dictionary words "paws" and "awesome"; thus, the Earlier Mark conveys an

¹¹ Witness Statement by Alex Pugh dated 10 October 2023.

allusive message, with a laudatory connotation, in relation to the opponent's goods. I find, overall, the Earlier Mark has an average degree of inherent distinctive character.

Likelihood of confusion

45. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

46. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. The concept of indirect confusion was explained by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10 as follows:

“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”.

47. I have found the respective goods to be identical. The consumer is likely to pay at least a medium degree of attention in their selection. The distinctiveness of the Earlier Mark is average. The marks are visually similar to at least a medium degree,

are aurally similar between a medium and high degree, and are conceptually similar to a medium degree. The purchase of the contested goods is considered to be mainly visual but the potential for aural use is borne in mind.

48. Weighing all these factors, and bearing in mind the effects of imperfect recollection, I find that the average consumer is likely to mistake the Earlier Mark for the Contested Mark. Thus, there is a likelihood of direct confusion.

49. In the event that I am wrong to have found that the marks are likely to be mistaken for one another, I will turn to consider the likelihood of indirect confusion between them.

50. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

51. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.¹² I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.¹³ The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion.¹⁴

52. Bearing all of the above in mind, I am of the view that it is likely that a significant proportion of the average consumers, when confronted with the word "pawsome" in the Contested Mark, will likely consider "perfectly" at the beginning of the mark as a non-distinctive laudatory addition aimed at emphasising "pawsome" and believe that the competing goods originate from the same or economically linked undertakings.

53. Consequently, I consider that there is a likelihood of indirect confusion between the marks at issue.

Conclusion

54. The opposition under section 5(2)(b) succeeds and the application will be refused for all goods.

Costs

¹² *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

¹³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

¹⁴ *Liverpool Gin Distillery*.

55. The opponent has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice (“TPN”) 2/2016. Bearing that scale in mind, I award costs to the Opponent as follows:

Official fee	£100
Preparing the notice of opposition and considering the counterstatement	£200
Considering and commenting on the other side's evidence	£500
Submissions in lieu	£300
Total:	£1,100

56. I order Jamie Wiles and Sian Wiles to pay Pets Nature GmbH the sum of **£1,100**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of October 2024

Andrea Rossi

For the Registrar