

O/1210/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003790587
BY TUCE ATMACA CONSULTANCY LTD
TO REGISTER:

**PAW
LONDON**
FANCY THINGS FOR COOL KIDS

AS A TRADE MARK IN CLASSES 18, 20, 21, 26, 28, 31 & 35

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 437003 BY
BURCU ÖNER

BACKGROUND AND PLEADINGS

1. On 20 May 2022, TUCE ATMACA CONSULTANCY LTD (“the applicant”) applied to register the trade mark on the cover page of this decision in the UK (“the applicant’s mark”). The applicant’s mark was published for opposition purposes on 22 July 2022 and registration is sought for the following goods and services:

Class 18: Pet leads; Electronic pet collars; Collars for pets; Clothing for pets; Pet hair bows; Bags for carrying pets; Animal harnesses; Straps (Harness -); Leather leashes; Leashes for animals.

Class 20: Pet crates; Pet cushions; Pet furniture; Pet houses; Beds for pets; Inflatable pet beds; Playhouses for pets; Pet grooming tables; Beds for household pets; Grooming tables for pets; Nesting boxes for pets; Portable beds for pets; Kennels for household pets; Cushions for lining pet crates.

Class 21: Electric pet brushes; Automatic pet feeders; Brushes for pets; Pet feeding dishes; Toothbrushes for pets; Pet grooming glove; Cages for pets; Pet feeding bowls; Pet treat jars; Pet drinking bowls; Animal-activated pet feeders; Cages for carrying pets; Trays (Litter -) for pets; Litter trays for pets; Deshedding combs for pets; Deshedding brushes for pets; Feeding vessels for pets; Food containers for pet animals; Pet feeding and drinking bowls; Litter boxes [trays] for pets; Pet paw cleaners, non-electric; Automatic litter boxes for pets.

Class 26: Charms for pet collars; Collar supports.

Class 28: Sports equipment for pets; Toys and playthings for pets.

Class 31: Pet foodstuffs; Pet foods; Beverages for pets; Edible pet treats; Powdered milk for pets; Aromatic sand for pets [litter]; Sanded paper for pets [litter].

Class 35: Wholesale services in relation to pet products; online retail services in relation to pet products; online wholesale services in relation to pet products; retail services in relation to pet products.

2. On 19 October 2022, the applicant's mark was opposed by Burcu Öner ("the opponent"). The opposition is based on section 5(4)(a) of the Trade Marks Act 1994 ("the Act") and is reliant upon the following unregistered trade mark:



("the opponent's sign")

3. The opponent claims to have been using her sign in London since 8 April 2022. The claimed use extends to a wide range of goods and services and these are set out in the **Annex** of this decision.
4. Under this ground, the opponent argues that the applicant's mark is contrary to law, particularly the law of passing off. The opponent claims that the applicant's mark is identical to her own sign and is proposed to be registered for identical or similar goods and services. As a result, the opponent argues that in using its mark, the applicant would misrepresent its goods or services to the public by misleading them into believing that they are goods or services designed, manufactured, marketed and sold by the opponent. It is claimed that this constitutes unfair competition and will create loss and damage on the part of the opponent.
5. The applicant filed a counterstatement wherein it denied the claim against it on the basis that none of the mandatory elements to satisfy claims under section 5(4)(a) have been fulfilled.

6. The applicant is represented by RightPro IP & Legal Consultancy Ltd and the opponent is represented by Burcu Döner. Both parties filed evidence in chief. No hearing was requested and neither party filed any written submissions in lieu of the same. This decision is made following 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 opponent's evidence came in the form of the witness statement of Burcu Döner dated 9 November 2023. Burcu Döner is the legal representative of the opponent and is, therefore, duly authorised to file evidence on her behalf. Their statement is accompanied by five exhibits, being BD1 to BD5, and was adduced to speak to the existence of goodwill in the opponent's sign. While three of the exhibits filed (BD1, BD2 and BD4) are in the Turkish language, I note that certified translations of the same have been provided.
9. The applicant's evidence came in the form of the witness statement of Tuce Atmaca dated 2 February 2024. Tuce Atmaca is the owner and director of the applicant, a position they have held since its incorporation on 7 April 2021. This evidence is accompanied by six exhibits, being those labelled TA1 to TA6, and was adduced to discuss the applicant's actions prior to the filing of its mark and seeking to prove that the opponent's only activity is in relation to manufacturing goods for the applicant's business.
10. I do not intend to summarise the parties' evidence in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Section 5(4)(a)

11. Section 5(4)(a) of the Act reads as follows:

“(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.”

12. 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.”

13. 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)."

14. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,

- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Relevant Date

15. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.C., 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.’ ”

16. The applicant’s mark does not have a priority date. In considering the applicant’s evidence, it is noted that there is evidence that appears to have been adduced to demonstrate that it began using its mark prior to its filing date, being 20 May 2022. I will now assess this evidence to determine whether it can be deemed outward facing use that can be said to be the start of the behaviour complained about.

17. The earliest dated evidence comes via a printout of the applicant’s Etsy account which confirms that the applicant’s account, being one titled ‘PAW LONDON’, was registered with the retailer on 20 April 2021.¹ Following this on 22 July 2021, the applicant registered the domain ‘www.pawlondon.com’ via GoDaddy. Also in July 2021 (though at an unknown date), the applicant registered an Instagram account under the handle ‘@pawlondonofficial’. These actions are confirmed via an invoice regarding the purchase of the domain and a printout of the applicant’s Instagram account showing when it registered its account.² Alongside the Instagram account is a post dated 3 December 2021 which shows the applicant’s mark with the caption ‘Coming Soon’.

18. I note that the applicant sought self-storage units on 24 July 2021 to use to store imported products that it intended to sell in the UK. This is confirmed via a number of invoices from the self-storage rental company relating to the applicant’s ongoing rental of its unit.³ These invoices are dated between 24 July 2021 and 23 February 2022 and are addressed to ‘TUCE ATMACA CONSULTANCY & PAW LONDON’.

19. Also provided is one invoice dated 29 November 2021 that the applicant claims to show the import of a number of the applicant’s goods from Türkiye.⁴ It is noted that this invoice is from the opponent and covers the sale of 110 dog collars, seemingly in three different styles. It is also noted that this invoice (along with others filed by

¹ TA1

² TA3

³ TA2

⁴ TA4

the opponent) is subject to some dispute between the parties that I will discuss further below when considering the issue of goodwill.

20. Lastly in respect of the applicant's own use of its mark there is evidence in respect of advertising. This includes a number of invoices from Conde Nast in respect of classified adverts being placed in various editions of Vogue magazine.⁵ The only invoice that relates to an advert that appeared in Vogue prior to the filing date of the applicant's mark was the May 2022 issue. This is confirmed as being available for sale on 26 April 2022. While this is noted, the actual advert used in the magazine has not been provided so it is not clear to me how the mark at issue has been used.

21. I note that the exhibit wherein advertising is discussed includes evidence regarding a store called Flying Solo. This evidence shows correspondence from Flying Solo to the applicant wherein they sought the applicant's brand to be featured in its New York City store in April 2022. While noted, this relates to potential use in a jurisdiction outside the UK so is of no assistance here. Also in this exhibit is an email from the applicant to an email account associated with the London Makers Market on 13 December 2021. In this email, the applicant requested a stall at an upcoming Christmas Market. This email confirms that the brand only launched five days prior to the email and, further, noted that the request may have come too late for the market that year. While this is noted, there is no response provided and neither is there anything further to confirm whether the applicant was permitted to have a stall at the market in 2022. Without confirmation of this, I will proceed as if it had not.

22. While I appreciate that the evidence shows that the applicant had made concerted efforts to launch its brand in 2021, the majority of it does not cover outward use and neither does it show use of the mark applied for.⁶ For example, the registering of a website or an Instagram account in July 2021 is not, without anything further,

⁵ TA6

⁶ On this point, I note that the Etsy evidence and the Instagram account page show the name 'PAW LONDON'# and omit the words 'FANCY THINGS FOR COOL KIDS'. As such, this evidence does not show the applicant's mark in its entirety.

capable of being considered outward use. On this point, I note that the Etsy and Instagram account paged show the name 'PAW LONDON' and omit the words 'FANCY THINGS FOR COOL KIDS'. As such, this evidence does not show the applicant's mark in its entirety. The issues apply for the evidence regarding the rental of the storage units.

23. In considering the VOGUE evidence, this covers the placement of one advert in the magazine that was released on 26 April 2022, being under one month prior to the relevant date. This could potentially constitute earlier use of the mark that is capable of being the behaviour complained about. However, as above, I have nothing to suggest how this appeared to consumers and without such, I am unable to determine whether this was outward use of the applicant's mark or not. This leaves the only actual evidence of outward use of the applicant's mark being the Instagram post dated 3 December 2021 which was captioned with the words 'Coming soon', indicating that the brand had yet to launch.

24. While I appreciate that the Instagram post is captioned as 'Coming Soon', it does clearly show the applicant's mark. Another point I have borne in mind is the fact that the post only attracted 14 likes. While this would be an issue when it comes to assessing the level of exposure for a trade mark, the question I must consider here is not the success of the launch or the post itself but whether such use is capable of being deemed the beginning of the behaviour complained about. Given that the post includes the mark that is being opposed and that this is its first outward use to consumers, I consider that it is the commencement of an activity that *could* be complained about⁷.

25. As a result of the above and bearing in mind the comments of Mr Alexander Q.C. in the case of *Advanced Perimeter Systems* (cited above), I will proceed to consider the position in respect of goodwill on 3 December 2021 ("the earlier relevant date"). In the event that goodwill exists, I will proceed to consider whether the position as at the filing date of the applicant's mark, being 20 May 2022 ("the

⁷ While I appreciate that the use before me does not expressly show use of the mark on the goods applied for, I consider that in line with paragraph 22 of *RECUP* (BL O/304/20), this activity is one that marks that start of the activities that *could* be complained about.

later relevant date”), was any different. However, in the event that no goodwill existed as at the earlier relevant date, the opponent’s claim will fail.

Goodwill

26. The first hurdle for the opponent is that they need to show that they had the necessary goodwill in the sign relied upon at the earlier relevant date. I remind myself that the opponent claims that her sign enjoys goodwill thanks to its use on a wide range of goods and services, being those set out in the Annex of this decision.

27. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

“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.”

28. 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 off 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.”

29. 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.”

30. 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.”

The opponent's evidence.

31. Goodwill arises as a result of trading activities. The opponent's evidence makes reference to a trade mark they own in Türkiye. A copy of the registration details from the Turkish Patent Institute is provided in evidence.⁸ In addition, the opponent has provided the industrial design registration details for pet collars, again being those registered with the Turkish Patent Office. While this evidence is noted, the existence of registered trade marks or designs are not relevant to the present assessment as they are, by themselves, not capable of demonstrating use in the UK. This applies regardless of whether the marks/designs are UK registrations or those from other jurisdictions.

32. Another exhibit filed is an email from an undertaking called ‘Seven Consultancy’ to a social media influencer wherein it offers to send a gift of a dog collar to the influencer's pet. This email is dated 15 March 2022 and it is noted that the company ‘Seven Consultancy’ is confirmed in the applicant's own evidence of being an email address that Tuce Atmaca (being the owner and director of the applicant) has used (see page 19 of TA6). While this evidence is noted, I fail to see its relevance to the issue of the existence of goodwill on behalf of the opponent.

33. The opponent's evidence goes on to explain that there is a customer relationship between the applicant and the opponent in that the applicant is a reseller of the opponent's goods in the UK. Provided are a number of different invoices for the sale of dog collars and harnesses. I note that the invoices provided are dated 8

⁸ BD1

April 2022, 15 April 2022, 9 May 2022, 18 May 2022, 3 June 2022, 10 June 2022 and 20 June 2022. The invoices are addressed to the applicant from a company referred to as 'Paw Paris'. No breakdown of the invoices has been provided and I note that none are provided from prior to the earlier relevant date. However, when directed at the later relevant date (which may be of relevance later on in my decision), the invoices cover the following sales:

Invoice date:	Total sales:
8 April 2022:	67
15 April 2022:	21
9 May 2022:	1
18 May 2022:	1
Total:	90

34. Despite some of the later invoices including harness, I note that the invoices covered by the above table (being the only invoices filed by the opponent that may be relevant to these proceedings) show the sales of collars only.

35. The opponents' evidence goes on to discuss the nature of her business and the fact that the opponent's company title also includes the name 'Paw Paris'. This business was incorporated in Türkiye on 19 December 2019. A certification demonstrating this from the Turkish Central Registry is provided.⁹ The opponent then mentions the fact that the applicant was only incorporated on 7 April 2021, being one and a half years after the opponent's company was incorporated. The narrative evidence sets out that earlier incorporation of the opponent's company in 2019 followed by the opponent filing a trade mark for 'Paw London' in Türkiye in 2021 can be considered as an indicator that the opponent is the initial creator/owner/user of 'Paw London'. In short, the issue I must consider is whether the opponent's business has accrued a protectable level of goodwill stemming from trading activities in the UK. Neither the incorporation of a company¹⁰ nor the registration of a trade mark (or design) in Türkiye at an earlier date are evidence

⁹ BD5

¹⁰ Though I note that the company includes the name 'Paw Paris' and not 'Paw London', being the branding at issue here.

of trading activities in the UK and do not point to the accrual of any goodwill amongst the UK consumer base. This evidence is, therefore, of no assistance.

36. In addition to the opponent's evidence, I note that the applicant has provided an invoice from the opponent to itself dated 29 November 2021.¹¹ This shows that the applicant purchased 110 collars from the opponent at that time. It is claimed by the applicant that these invoices cover goods sold via an agreement wherein the opponent agreed to manufacture 'Paw London' branded goods for the applicant. As such, it is the applicant's position that this invoice as well as those filed by the opponent are merely import invoices pointing to it acquiring goods that it would then itself sell on in the UK under its own branding.

Assessment of the evidence

37. Before beginning my assessment of the evidence filed, I wish to address one thread of dispute throughout these proceedings. This relates to the invoices filed. I say this because in both parties' evidence, arguments have been raised as to the nature of these invoices. As above, the applicant claims that the invoices cover the shipment of goods that stem from a manufacturing agreement between the parties wherein the opponent produces the goods for the applicant with intention that they are to be sold on by the applicant under the applicant's branding. On the other hand, the opponent claims that the applicant is a reseller of its own goods so any onwards sales in the UK constitute sales by the opponent and, therefore, contribute to the generation of its own goodwill.

38. In respect of this issue, I note that I have no sufficiently solid evidence from either party that demonstrates that it is their argument that reflects the actual position with regard to their relationship. However, for the purpose of this assessment, I will proceed as if the invoices provided constitute trading activities undertaken in the UK by the opponent.¹² I appreciate that this approach greatly benefits the opponent

¹¹ TA4

¹² For the avoidance of doubt, this approach is not to be taken as an acceptance that the opponent's position is the proven one but, as set out here, it is for the purpose of this assessment only.

but the reasons I have taken this approach will become obvious when discussing the actual impact of the invoices on goodwill below.

39. As per paragraph 25 above, the behaviour complained about by the opponent began on 3 December 2021, being an earlier date than the filing date of the applicant's application of 20 May 2022. This is the earlier relevant date and my assessment of the evidence is to be focused on the position as at that date. If goodwill is found to exist at that point, I will move to consider whether the position was any different as at the later relevant date. However, if no goodwill exists as at the earlier relevant date, I would be entitled to find that the opposition fails at that stage.

40. Bearing in mind the approach I am required to take; I wish to clarify that the only evidence that may be considered as trading activities by the opponent prior to the earlier relevant date comes from just one invoice dated 29 November 2021 (being that provided by the applicant at TA4).

41. Having considered this invoice, I have noted a number of issues. Chief amongst these is the fact that the invoice covers dog collars and the goods and services relied upon by the opponent do not include any terms that can reasonably be said to cover the same. On this point, I note that the opponent's specification includes the term "goods made of leather, imitations of leather or other materials, designed for carrying items, namely; bags, wallets, boxes and trunks made of leather or stout leather." It is my view that this term will be construed as covering goods made of leather that are designed for carrying items. In addition, the inclusion of the word 'namely' limits the term to those specific goods that follow it. Plainly, such a term does not cover dog collars and, for the avoidance of doubt, neither do any of the other terms relied upon by the opponent. For this reason alone (and given that this is the only evidence of trading activities), my primary position is that, regardless of any level of use for dog collars, the opponent is not able to prove that she enjoys goodwill in respect of any of the terms she has relied upon. For the sake of completeness, however, I will proceed on the basis that the above term can be interpreted as covering any goods made of leather which, inevitably, will include leather dog collars.

42. Even if it can be said that the invoice covers goods that are relied upon here, I note that it makes no reference to the sign relied upon. While the invoice I am considering here was provided by the applicant, the opponent has not provided any images (or any other form of supporting evidence) showing the goods that it shipped to the applicant, generally, let alone under this invoice. As such, it cannot be said with any accuracy that the goods sold under the invoice were branded with the opponent's sign. On this point, I appreciate that the opponent has provided printouts showing her design registrations in Türkiye. However, these are of no real assistance as (1) they are not confirmed as being the goods sold to the applicant for onward sale in the UK and (2) even where I am able to zoom in on the designs themselves, the sign shown includes the words 'Paw Paris' in a cursive typeface.¹³ This is not the sign relied upon.

43. In addition to the above, it is noted that the invoice is in the name of 'PAW PARIS BURCU ÖNER'. While I appreciate that the latter half of the named entity on the invoice is the name of the opponent, I am not convinced that consumers will perceive the undertaking responsible for the goods covered by the invoice to be the individual, 'BURCU ÖNER'. When assessing goodwill, I remind myself that absent any agreement to the contrary, the goodwill of a business is owned by the undertaking that customers perceive as being responsible for the trade. In the present case, the opponent has provided no evidence as to any agreement as to the ownership of the goodwill between themselves and the entity known as 'Paw Paris'. As such, I am of the view that consumers would perceive the owner of any goodwill generated by the goods sold under the invoice as 'PAW PARIS BURCU ÖNER' and not the opponent as an individual herself.

44. I turn now to discuss the actual level of sales covered by the invoice. My first issue with this is that the invoice is dated 29 November 2021, being just four days prior to the earlier relevant date. There is nothing confirming when these goods were delivered to the applicant and neither is there anything to suggest when they were sold on to end consumers in the UK. The best case in respect of this invoice is that

¹³ See, for example, page 6 of BD2

all of the goods covered by the invoice were both delivered to the applicant and subsequently sold to end consumers in the UK prior to the earlier relevant date. My view is that this is unlikely to have been the case given that there were just four days between these dates. However, the scenario represents the opponent's best case and, even then, I do not consider the volumes sold are sufficient to have generated goodwill by the earlier relevant date. On this point, I acknowledge that 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.¹⁴ However, I do not consider that this is the case here. While no evidence has been provided in respect of the market at issue for dog collars, it is my view that this is a fairly sizeable market that attracts a significant level of sales in any given year. In my view, the sale of just 110 goods prior to the earlier relevant date is exceedingly low and any goodwill generated by these sales would be no more than trivial.

45. While evidence of sales is an important factor to the issue of goodwill, it is not fatal to a claim under section 5(4)(a) if the figures are at such a low level. For example, if sales are low but an opponent is able to demonstrate repeat and consistent custom over a prolonged period of time then it may be sufficient to find goodwill. Further, use over a short period of time may be sufficient if the level of use is somewhat intensive. Lastly, evidence of low sales may be supported by evidence that can point to a level of awareness across the consumer base. Such evidence may include information as to advertising spend or examples of promotional activities undertaken. That being said, the evidence before me in the present case fails to point to any of these scenarios. The use shown covers just one invoice showing a very low level of sales. Said sales would have taken place over a very short period of time in the days leading up to the earlier relevant date. Further, there is nothing before me to demonstrate any marketing efforts by the opponent in advertising her goods in the UK.

46. Taking all of the above into account and considering the position as at the earlier relevant date, I find that even if the invoice covered goods that were relied upon

¹⁴ See *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

here, the opponent has failed to establish that she enjoyed any goodwill in her business, let alone a more than trivial goodwill that was associated with the sign relied upon. Given that there existed no goodwill at this date, it would ordinarily not be necessary for me to proceed to consider the position as at the later relevant date. As a result, I would be entitled, at this stage, to find that the opponent's reliance upon section 5(4)(a) of the Act fails as without goodwill, there can be no misrepresentation. While that may be the case, I consider that it is necessary for me to proceed to consider the position as at the later relevant date. I do so for two reasons. The first is on the basis that it was wrong from me to conclude that the evidence provided was sufficient to demonstrate an earlier date when the behaviour complained about began. Secondly, if it was the case that the applicant acted as a distributor for the opponent in the UK (which is the approach I have adopted in respect of the invoice evidence), then the behaviour complained about could be said to have, effectively, been with the opponent's consent. In these circumstances, it would be reasonable to suggest that any earlier use by the applicant was not capable of being deemed as behaviour complained about because it may be construed as use by the opponent. In either scenario, the sole relevant date for the present proceedings would stand at 20 May 2022 and I will now proceed to consider the overall position in respect of this date.

47. The totality of the evidence as at the later relevant date is that the opponent sold 200 dog collars. This stems not only from the invoice dated 29 November 2021 (that I have discussed above) but from four invoices dated between 8 April and 18 May 2022 that were filed by the opponent. The issues I have discussed above in respect of the invoice dated 29 November 2021 are all applicable to the later set of four invoices. On this point, I will say that like the invoice discussed above, the goods covered by these invoices are not covered by the specification of goods relied upon by the opponent. However, even if they are, the other issues remain relevant. Further, the issue as to the identity of the seller on the invoices is compounded further by the fact that in the later invoices, the seller is listed as 'PAW PARIS' and there is no mention of the opponent's name whatsoever. Adopting the same approach that I have above, namely giving the opponent the benefit of the doubt and taking it as if all of the goods covered by the invoices were (1) goods

relied upon here and (2) sold to end consumers prior to the later relevant date, the total sales figures provided are still far too short of the threshold for proving the existence of a more than trivial goodwill. The total sales show 200 dog collars being sold over a period of six months. This is not an intense level of use by any stretch of the imagination (especially when compared to the size of the market at issue) and neither is it longstanding use.

48. Taking the entirety of the use shown before me into account together with the considerations I have made above regarding the lack of any other supporting evidence (see the points raised at paragraph 45 above, being equally relevant here) and even bearing in mind what I have said about small businesses being able to bring claims of passing off, I find that the opponent's evidence falls short of proving the existence of any protectable level of goodwill in her business as at the later relevant date (which as confirmed above, would have been the sole relevant date).

49. In addition to the level of sales being extremely low and the likely size of the market being large, another factor that weighs against the opponent is the weakness of the sign that is relied upon in the context of the goods sold. On this point, I appreciate that the words 'PAW LONDON' on a bone shaped device are not directly descriptive of the dog collars (or harnesses for that matter),¹⁵ however, I am of the view that they are plainly allusive to the same. As such, I do not consider that the sign relied upon contains distinctive indicators pointing to the opponent. In making this finding, I refer to the case of *McCain International Limited v Country Fair Foods Limited and Another* [1981] R.P.C. 69 (COA) wherein the Court of Appeal found that while a descriptive term may acquire a secondary meaning (as a reference to the source or maker of goods or services and, therefore, distinctive of the provider of those goods or services), any evidence in support of such must be extensive. In that case, the plaintiff's use of the descriptive term 'OVEN CHIPS' was considered to be extensive national use; however, the period of use was far too short (18 months) for a secondary meaning to have been acquired. On this point, I also refer, again, to the case of *RECUP* (cited above) wherein Mr Thomas

¹⁵ Being the only goods that are shown in evidence.

Mitcheson Q.C., sitting as the Appointed Person, set out at paragraph 41 of his decision that:

“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.”

50. I appreciate that the present case is not on all fours with *McCain* or *RECUP* on the basis that the opponent’s sign is clearly not as directly descriptive as the ones complained of in those cases. However, the opponent’s sign is still allusive, meaning that, in my view, the level and longevity of use required in order to give rise to a finding that the opponent’s sign is distinctive of the opponent still needs to be at a higher level than that which is before me. As discussed above, the evidence before me is (at best) demonstrative of the opponent only engaging in low levels of trading activity for a period of approximately 6 months in total (just four days if directed at the earlier relevant date). I find that this is too low a level of use over too short a period of time in order to justify a finding that the opponent’s sign, as at either relevant date, had sufficient goodwill to sustain an action for passing off.

51. Given that the opponent has failed to prove that it enjoys a more than trivial goodwill in its sign as at either relevant date, there can be no misrepresentation and because the section 5(4)(a) ground is the only one relied upon, the opposition hereby fails in its entirety.

CONCLUSION

52. The opposition has failed and, subject to any successful appeal against my decision, the applicant’s mark may proceed to registration for all of the goods and services applied for.

COSTS

53. As the applicant has succeeded, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the

circumstances, I award the applicant the sum of £800 as a contribution towards its costs. The sum is calculated as follows:

Considering the notice of opposition and preparing a counterstatement:	£300
Preparing evidence:	£500
Total:	£800

54. I hereby order Burcu Öner to pay TUCE ATMACA CONSULTANCY LTD the sum of £800. The above sum should 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 20 day of December 2024

A COOPER
For the Registrar

ANNEX

Class 18

Unworked or semi-worked leather and animal skins, imitations of leather, stout leather, leather used for linings, goods made of leather, imitations of leather or other materials, designed for carrying items, namely; bags, wallets, boxes and trunks made of leather or stout leather; key cases, trunks [luggage], suitcases, umbrellas; parasols; sun umbrellas; walking sticks, whips; harness; saddlery; stirrups; straps of leather (saddlery).

Class 20

Furniture, made of any kind of material, mattresses; pillows; air mattresses and cushions, not for medical purposes, water beds, mirrors, beehives, artificial honeycombs and sections of wood for honeycombs, bouncing chairs for babies, playpens for babies, cradles, infant walkers, display boards, frames for pictures and paintings, identification plates, identification tags, nameplates, identification labels made of wood or synthetic materials, packaging containers of wood or plastics, casks for use in transportation or storage, barrels, storage drums, tanks, boxes, storage containers, transportation containers, chests, loading pallets and closures for the aforementioned goods, of wood or plastics, small hardware goods of wood or synthetic materials included in this class, furniture fittings, of wood or synthetic materials, opening and closing mechanisms of wood or synthetic materials, ornaments and decorative goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, beeswax, plastic or plaster namely figurines, holiday ornaments for walls, sculptures, trophies, baskets, fishing baskets, kennels, nesting boxes and beds for household pets, portable ladders and mobile boarding stairs of wood or synthetic materials, bamboo curtains, roller indoor blinds [for interiors], slatted indoor blinds, bamboo strip curtains, bead curtains for decoration, curtain hooks, curtain rings, curtain tie-backs, curtain rods, non-metal wheel chocks.

Class 21

Hand-operated non-electric cleaning instruments and appliances, brushes, other than paintbrushes, steel chips for cleaning, sponges for cleaning, steel wool for cleaning, cloths of textile for cleaning, gloves for dishwashing, non-electric polishing machines

for household purposes, brooms for carpets, mops, toothbrushes, electric toothbrushes, dental floss, shaving brushes, hair brushes, combs, non-electric household or kitchen utensils, included in this class, [other than forks, knives, spoons], services [dishes], pots and pans, bottle openers, flower pots, drinking straws, non-electric cooking utensils, ironing boards and shaped covers therefor, drying racks for washing, clothes drying hangers, cages for household pets, indoor aquariums, vivariums and indoor terrariums for animals and plant cultivation, ornaments and decorative goods of glass, porcelain, earthenware or clay namely statues, figurines, vases, and trophies, mouse traps, insect traps, electric devices for attracting and killing flies and insects, fly catchers, fly swatters, perfume burners, perfume sprayers, perfume vaporizers, electric or non-electric make-up removing appliances, powder puffs, toilet cases, nozzles for sprinkler hose, nozzles for watering cans, watering devices, garden watering cans, unworked or semi-worked glass, except building glass, mosaics of glass and powdered glass for decoration, except for building, glass wool other than for insulation or textile use.

Class 24

Woven or non-woven fabrics; home textile products: curtains, bedspreads, duvet covers, sheets, pillowcases, blankets, quilts, towels; flags, pennants, labels from textile; swaddling blankets; sleeping bags for campers.

Class 31

Agricultural and horticultural products, seeds, forestry products, live animals, fertilized eggs for hatching, plants, dried plants for decoration, fresh garden herbs, dried garden herbs for decoration, animal foodstuffs, malt not for human consumption, sanded paper [litter] for pets, cat litters.

Class 35

Advertising, marketing and public relations; organization of exhibitions and trade fairs for commercial or advertising purposes; development of advertising concepts; provision of an online marketplace for buyers and sellers of goods and services; Office functions; secretarial services; arranging newspaper subscriptions for others; compilation of statistics; rental of office machines; systemization of information into computer databases; telephone answering for unavailable subscribers, Business

management, business administration and business consultancy; accounting; commercial consultancy services; personnel recruitment, personnel placement, employment agencies, import-export agencies; temporary personnel placement services; auctioneering, the bringing together, for the benefit of others, of a variety of goods, namely, Unworked or semi-worked leather and animal skins, imitations of leather, stout leather, leather used for linings, goods made of leather, imitations of leather or other materials, designed for carrying items, namely; bags, wallets, boxes and trunks made of leather or stout leather; keycases, trunks [luggage], suitcases, umbrellas; parasols; sun umbrellas; walking sticks, whips; harness; saddlery; stirrups; straps of leather (saddlery), Furniture, made of any kind of material, mattresses; pillows; air mattresses and cushions, not for medical purposes, water beds, mirrors, beehives, artificial honeycombs and sections of wood for honeycombs, bouncing chairs for babies, playpens for babies, cradles, infant walkers, display boards, frames for pictures and paintings, identification plates, identification tags, nameplates, identification labels made of wood or synthetic materials, packaging containers of wood or plastics, casks for use in transportation or storage, barrels, storage drums, tanks, boxes, storage containers, transportation containers, chests, loading pallets and closures for the aforementioned goods, of wood or plastics, small hardware goods of wood or synthetic materials included in this class, furniture fittings, of wood or synthetic materials, opening and closing mechanisms of wood or synthetic materials, ornaments and decorative goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum, beeswax, plastic or plaster namely figurines, holiday ornaments for walls, sculptures, trophies, baskets, fishing baskets, kennels, nesting boxes and beds for household pets, portable ladders and mobile boarding stairs of wood or synthetic materials, bamboo curtains, roller indoor blinds [for interiors], slatted indoor blinds, bamboo strip curtains, bead curtains for decoration, curtain hooks, curtain rings, curtain tie-backs, curtain rods, non-metal wheel chocks, Hand-operated non-electric cleaning instruments and appliances, brushes, other than paintbrushes, steel chips for cleaning, sponges for cleaning, steel wool for cleaning, cloths of textile for cleaning, gloves for dishwashing, non-electric polishing machines for household purposes, brooms for carpets, mops, toothbrushes, electric toothbrushes, dental floss, shaving brushes, hair brushes, combs, non-electric household or kitchen utensils, included in this class, [other than forks, knives, spoons], services [dishes], pots and pans, bottle openers, flower pots, drinking straws, non-

electric cooking utensils, ironing boards and shaped covers therefor, drying racks for washing, clothes drying hangers, cages for household pets, indoor aquariums, vivariums and indoor terrariums for animals and plant cultivation, ornaments and decorative goods of glass, porcelain, earthenware or clay namely statues, figurines, vases, and trophies, mouse traps, insect traps, electric devices for attracting and killing flies and insects, fly catchers, fly swatters, perfume burners, perfume sprayers, perfume vaporizers, electric or non-electric make-up removing appliances, powder puffs, toilet cases, nozzles for sprinkler hose, nozzles for watering cans, watering devices, garden watering cans, unworked or semi-worked glass, except building glass, mosaics of glass and powdered glass for decoration, except for building, glass wool other than for insulation or textile use, Woven or non-woven fabrics; home textile products: curtains, bedspreads, duvet covers, sheets, pillowcases, blankets, quilts, towels; flags, pennants, labels from textile; swaddling blankets; sleeping bags for campers, Agricultural and horticultural products, seeds, forestry products, live animals, fertilized eggs for hatching, plants, dried plants for decoration, fresh garden herbs, dried garden herbs for decoration, animal foodstuffs, malt not for human consumption, sanded paper [litter] for pets, cat litters enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.