

O/235/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2567475**

**BY**

**PETKIND PET PRODUCTS INC**

**TO REGISTER THE TRADE MARK:**

**PETKIND**

**IN CLASSES 3, 5, 18, 20, 21, 28, 31 AND 35**

**AND**

**THE OPPOSITION THERETO**

**UNDER NO 101803**

**BY**

**NÖLKEN HYGIENE PRODUCTS GMBH**

1) On 20 December 2010 Petkind Pet Products Inc (PPP) filed an application to register the trade mark PETKIND (the trade mark). This opposition only concerns the following goods:

*external applied oils for pets, namely conditioners for skin, coat, joints and bones; conditioners; cleaning preparations and deodorizers; natural ointments for pets countering any of eye irritation, dryness and infection; coat and skin sprays namely sprays for any of making the coat shiny and smooth, reducing skin irritation, soothing skin and countering any of itching, ticks, fleas and mites; cosmetics and eye treatment, namely anti-stain and tear remedies; cosmetic treatments and solutions, namely, moisturizers, insect repellants, lotions, healing balms and detanglers; non-medicated grooming preparations for pets, namely, shampoos, conditioners, and aromatics; pet shampoos, conditioners and cleansers; cleaning preparations and deodorizers for reducing mold and mildew in animal containers such as crates and kennels;*

*medicated shampoos for pets, medicated grooming preparations for pets, pet feed supplements, herbal anti-itch and sore skin ointments for pets; probiotics namely ingestible bacterial cultures for supporting and improving the health of the digestive system of a pet; ingestible bacterial cultures for increasing the level of lactic acid in a pet; antibiotic ointments for countering any of eye irritation, dryness and infection; medicated grooming preparations for pets, namely medicated shampoos, conditioners and cleaners; flea collars; flea powders; disinfectants for animal coats, enclosures and shelters.*

The above goods are in classes 3 and 5 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 20 April 2011 Nölken Hygiene Products GmbH (Nölken) filed a notice of opposition to the registration of the application in respect of the class 3 and 5 goods. Nölken relies upon section 5(2)(b) of the Trade Marks Act 1994 (the Act), which states:

“(2) A trade mark shall not be registered if because -  
.....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

It relies upon international registration no 870744 with protection in the European Union. The trade mark is



and is registered for:

*body care products; cosmetics; shampoos; moist care tissues and moist cleansing tissues impregnated with cosmetic lotions; soaps; perfumes; cotton wool sticks; all aforesaid goods meant for animals;*

*pharmaceutical body care preparations, dogs lotions; washing preparations; disinfectants for hygiene purposes; preparations for destroying vermin; collars having a vermin destroying effect; tissues impregnated with pharmaceutical lotions; all aforesaid goods meant for animals; lotions for veterinary purposes.*

The above goods are in classes 3 and 5 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3) PPP does not deny that the respective goods are identical or similar. It states that the respective trade marks are visually, aurally and conceptually distinct and that there is no likelihood of confusion. PPP states that Nölken cannot own a monopoly in trade marks containing the word pet in relation to pet products. PPP denies the ground of opposition.

4) No evidence was adduced. Both sides furnished written submissions.

***Average consumer, nature of purchasing decision and standard for likelihood of confusion***

5) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”. The average consumers of the products of PPP will be pet owners. The average consumers of the goods of Nölken will be animal owners, a large number of whom will be pet owners. The goods for pet/animal health will be bought with some care as the purchaser will wish to make sure how the product is used and what contraindications there may be. Such products may also be prescribed by a vet, which will be the result of an educated decision. The nature of this category of goods will limit the effects of imperfect recollection. Cleaning, cleansing products and the like will be bought with less care but the purchaser is still likely to take care as to the suitability of the product and how it is to be applied to the animal. The effects of imperfect recollection will be limited, if not to the same extent as for the first category of goods.

6) The respective goods, if not supplied by a vet, are likely to be bought from a pet shop or a pet supermarket. In the former case the products may well not be on self-service shelves and so may be requested orally. In the latter case the products are likely to be on shelves and so purchased by the eye. Consequently, aural and visual confusion will be of equal importance.

### **Comparison of goods**

7) PPP has not contested that the respective goods are identical or similar. The respective goods are clearly identical or highly similar.

### **Comparison of trade marks**



**PETKIND**

8) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>ii</sup>. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components<sup>iii</sup>. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant<sup>iv</sup>. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public<sup>v</sup>.

9) Nölken submits that the first part of trade marks has greater importance than the last part(s) and so the pet element of the two trade marks is of more importance than the second elements. This is not always the case<sup>vi</sup>; it is dependent upon the nature of the trade mark. Pet is descriptive of the goods of both trade marks and so will have little significance upon its own in the trade marks. Petline lacks distinctive character, being descriptive of a line of goods for use in relation to pets (see by analogy *DKV Deutsche Krankenversicherungs AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-19/99<sup>vii</sup>*). The trade mark of Nölken although filed in colour is not limited to colour. Consequently, the distinctive component, if not the dominant component, is the crown device and the distinctiveness of the trade mark lies in its get-up. The dominant, but not distinctive component, of the trade mark is petline. The kind component of PPP's trade mark is allusive to products that are kind to pets eg do not upset or aggravate them when used. Neither component

of PPP's trade mark, on its own, is distinctive; the distinctiveness lies in the trade mark as a whole; there is no single dominant component.

10) The trade marks share the descriptive component pet. The second elements are phonetically and visually different. The second elements are conceptually dissonant. The crown device of Nölken's trade mark, the distinctive component, is alien to the trade mark of PPP.

11) Owing to the direct relationship between pet and the goods of the registration and the application and the differences and conceptual dissonance between the trade marks, the similarity between the trade marks is very limited.

### **Conclusion**

12) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>viii</sup>. In this case the respective goods are identical or highly similar. The sequitur of the identity/high similarity is not that the trade marks have to be very different to avoid a finding of likelihood of confusion<sup>ix</sup>.

13) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion<sup>x</sup>. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public<sup>xi</sup>. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings<sup>xii</sup>. The distinctive character of the earlier trade mark is extremely limited, the word element lacks distinctive character. In *The European Ltd v The Economist Newspaper Ltd* [1998] ETMR 307 Millett LJ stated:

“Although he did not have the benefit of the decision, he did in my opinion faithfully carry out the instructions of the European Court of Justice in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1 to the effect that:

“The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case. That global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind in particular their distinctive and dominant components . . . the average consumer normally

perceives a mark as a whole and does not proceed to analyse its various details. In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public. The more distinctive the earlier mark, the greater will be the likelihood of confusion."

The converse, of course, follows. The more descriptive and the less distinctive the major feature of the mark, the less the likelihood of confusion."

However, it is necessary to bear in mind the judgment of the Court of Justice of the European Union (CJEU) in *L'Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-235/05 P the CJEU stated:

"43 It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

45 The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

14) The only common element of the trade marks is the descriptive element *pet*<sup>xiii</sup>. This is not an element by which the average consumer will identify the goods of Nölken. PPP submits that Nölken cannot claim a monopoly in the word

pet for the goods under consideration. The issue of likelihood of confusion must be made on the basis of the global appreciation; whether or not Nölken is claiming a de facto monopoly in the word pet is not pertinent to this consideration.

**15) Taking into account all the pertinent factors, there is not a likelihood of confusion and the ground of opposition is dismissed.**

### **Costs**

16) PPP having been successful it is entitled to a contribution towards its costs. Costs are awarded upon the following basis:

Preparing a statement and considering the other side's statement:	£200
Written submissions:	£200
Total:	£400

**Nölken Hygiene Products GmbH is to pay Petkind Pet Products Inc the sum of £400. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.**

**Dated this 14<sup>th</sup> day of June 2012**

**David Landau  
For the Registrar  
the Comptroller-General**

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<sup>i</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* Case C-342/97.

<sup>ii</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>iii</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>iv</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

<sup>v</sup> *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

<sup>vi</sup> See *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-438/07.

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“23 Admittedly, the consumer normally attaches more importance to the first part of words (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 81). However, that argument cannot hold in all cases (see judgment of 16 May 2007 in Case T-158/05 *Trek Bicycle v OHIM – Audi (ALL TREK)*, not published in the ECR, paragraph 70 and the case-law cited) and does not, in any event, cast doubt on the principle that the assessment of the similarity of marks must take account of the overall impression created by them.

<sup>vii</sup> 26. In this case, the sign is composed exclusively of the words 'company' and 'line, both of which are customary in English-speaking countries. The word 'company' suggests that what is in point are goods or services intended for companies or firms. The word 'line' has various meanings. In the insurance and financial services sector it denotes, amongst other things, a branch of insurance or a line or group of products. They are thus generic words which simply denote a line of goods or services for undertakings. Coupling them together without any graphic or semantic modification does not imbue them with any additional characteristic such as to render the sign, taken as a whole, capable of distinguishing the applicant's services from those of other undertakings. The fact that the word 'Companyline' as such does not appear in dictionaries whether as one word or otherwise does not in any way alter that finding.

27. Consequently, the sign 'Companyline' is devoid of any distinctive character.”

<sup>viii</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

<sup>ix</sup> See *Meda Pharma GmbH & Co KG c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)* Dans les affaires jointes T-492/09 et T-147/10:

« 50 La requérante soutient que, en cas d'identité de produits, il est nécessaire, pour exclure tout risque de confusion, que les signes présentent une plus grande différence que dans une situation où l'écart entre les produits est important. Or, dans les circonstances de l'espèce où l'identité des produits n'est pas contestée, la chambre de recours aurait dû conclure au risque de confusion, à l'instar de ce qui a été considéré dans la décision R 734/2008-1 de la première chambre de recours de l'OHMI, du 14 septembre 2009 (Alleris et Allernil). Selon la requérante, plusieurs décisions de l'OHMI démontrent que les décisions attaquées s'écartent de la pratique décisionnelle de l'OHMI, ce qui viole les principes d'égalité et de non-discrimination.

51 Il ressort de la jurisprudence que l'OHMI est tenu d'exercer ses compétences en conformité avec les principes généraux du droit de l'Union. Si, eu égard aux principes d'égalité de traitement et de bonne administration, l'OHMI doit prendre en considération les décisions déjà prises sur des demandes similaires et s'interroger avec une attention particulière sur le point de savoir s'il y a lieu ou non de décider dans le même sens, l'application de ces principes doit toutefois être conciliée avec le respect du principe de légalité. Au demeurant, pour des raisons de sécurité juridique et, précisément, de bonne administration, l'examen de toute demande d'enregistrement doit être strict et complet afin d'éviter que des marques ne soient enregistrées de manière indue. C'est ainsi qu'un tel examen doit avoir lieu dans chaque cas concret. En effet, l'enregistrement d'un signe en tant que marque dépend de critères spécifiques, applicables dans le cadre des circonstances factuelles du cas d'espèce, destinés à vérifier si le signe en cause ne relève pas d'un motif de refus [voir, en ce sens, arrêt de la Cour du 10 mars 2011, *Agencja Wydawnicza Technopol/OHMI*, C-51/10 P, non encore publié au Recueil, points 73 à 77, et la jurisprudence citée, et arrêt du Tribunal du 22 novembre 2011, *LG Electronics/OHMI (DIRECT DRIVE)*, T-561/10, non publié au Recueil, point 31).

52 Or il apparaît que, dans la présente affaire, la chambre de recours a correctement pris en compte les circonstances de l'espèce. À cet égard, elle a, à juste titre, constaté l'identité des produits concernés en l'espèce, elle a aussi retenu une similitude très faible des signes en cause sur les plans phonétique et visuel et une impossibilité de comparaison de ces mêmes signes sur



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le plan conceptuel, comme il ressort des points 40, 41 et 46 ci-dessus. Dès lors, comme le soutient à juste titre l'OHMI, l'identité entre les produits désignés est compensée par un très faible degré de similitude entre les signes en cause et la chambre de recours a pu conclure à bon droit à l'absence de tout risque de confusion, d'autant que le degré d'attention du public est accru et qu'il n'est pas démontré que la marque antérieure présente un caractère distinctif élevé. »

<sup>x</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>xi</sup> *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

<sup>xii</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.

<sup>xiii</sup> In *Bundesverband der Deutschen Volksbanken und Raiffeisenbanken eV (BVR) g Harmonisierungsamt für den Binnenmarkt (Marken, Muster und Modelle) (HABM)* Case T-197/10 the GC considered the issue of similarity and likelihood of confusion where trade marks coincide in relation to descriptive or non-distinctive elements:

“48 Diese Rügen des Klägers können jedoch das Ergebnis der Beschwerdekammer nicht in Frage stellen, wonach zwar zwischen den einander gegenüberstehenden Zeichen eine „gewisse Ähnlichkeit“ auf begrifflicher Ebene vorliege, diese jedoch schwach bleibe. Genauso wie sich nämlich die Begriffe „Austria“ und „Leasing“ oder die Abkürzung „Gesellschaft m.b.H.“ jeweils auf Österreich, Mietkaufverträge oder eine Gesellschaftsform beziehen, verweist der Begriff „Raiffeisen“ in allerdings weniger offenkundiger, jedoch ebenso bedeutsamer Weise, was die Prüfung auf begrifflicher Ebene angeht, auf eine Art genossenschaftlicher Organisation im Bankensektor, die durch die von Friedrich Wilhelm Raiffeisen im 19. Jahrhundert entwickelten Grundsätze geleitet wird. Zudem übernimmt die Beschwerdekammer zwar die Auffassung, dass das Wortelement „Raiffeisenbank“ der älteren Marke von den angesprochenen Verkehrskreisen als Hinweis auf den Namen „einer bekannten Gruppe regionaler Banken, die Raiffeisenbanken, verstanden“ werde, doch seien diese „Raiffeisenbanken“ dem Publikum nicht im Zusammenhang mit Österreich oder einer österreichischen Bankengruppe bekannt, die sich von den Ideen von Friedrich Wilhelm Raiffeisen leiten lasse. Bankengruppen nach dem von diesem erdachten Konzept gebe es in verschiedenen Ländern.

49 Der Begriff „Raiffeisen“ hat nämlich eine beschreibende Bedeutung, die auf eine Art genossenschaftlicher Organisation verweist und die für den Kläger in Deutschland ebenfalls Kennzeichnungskraft hat, denn die von dieser Organisation in diesem Land angebotenen Dienstleistungen werden durch eine Bildmarke gekennzeichnet, die diesen Begriff verwendet. Eine andere Bildmarke kann jedoch diesen Begriff ohne Weiteres enthalten, wenn dieser auf begrifflicher Ebene nur auf seine beschreibende Bedeutung oder zumindest auf einen Wirtschaftsteilnehmer, der mit dieser Art genossenschaftlicher Organisation in einem anderen Land als Deutschland tätig ist, hinweist. ....

... 61 Außerdem kann sich die Beurteilung der Verwechslungsgefahr entgegen dem Vorbringen des Klägers nicht mit der Feststellung begnügen, dass der Begriff „Raiffeisen“ möglicherweise als dominierender Bestandteil der älteren Marke betrachtet, oder, wie der Kläger ausführt, einem Bestandteil gleichgestellt werden kann, der eine selbständig kennzeichnende Stellung in der angemeldeten Marke im Sinne des in Randnr. 56 des vorliegenden Urteils angeführten Urteils Medion hat. Aus dem Vorstehenden ergibt sich nämlich, dass die Beschwerdekammer davon ausgegangen ist, dass die anderen Elemente der älteren Marke und der angemeldeten Marke bei der Beurteilung der Verwechslungsgefahr eine Rolle spielten. Sie hat die einander gegenüberstehenden Bildmarken zu Recht insgesamt geprüft, ohne sie auf den einzigen Begriff zu reduzieren, der in jeder dieser Marken enthalten ist.

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62 Überdies legt der Kläger, da es „Raiffeisen-Bankengruppen“ in verschiedenen Ländern, wie Österreich und Deutschland, gibt, nicht überzeugend dar, aus welchen Gründen die maßgeblichen Verkehrskreise, bei denen in Bezug auf die Finanzdienstleistungen ein höherer Grad an Aufmerksamkeit vorliegt (vgl. Randnr. 20 des vorliegenden Urteils), die in Deutschland niedergelassenen „Raiffeisenbanken“ gedanklich mit den in Österreich niedergelassenen „Raiffeisenbanken“ in Verbindung bringen könnten.

63 Im Ergebnis ist davon auszugehen, dass die Beschwerdekammer zu Recht aufgrund der Ausführungen in der angefochtenen Entscheidung zu dem Ergebnis gelangt ist, dass unter Berücksichtigung der maßgeblichen Verkehrskreise und trotz der Ähnlichkeit der beanspruchten Dienstleistungen die zwischen den Zeichen bestehenden Unterschiede in Anbetracht des Gesamteindrucks ausreichend sind, um jede Verwechslungsgefahr auszuschließen.”