

O-297-10

TRADE MARKS ACT 1994

**APPLICATION No. 2477049 BY CAROLINA JAMES
TO REGISTER THE TRADE MARK 'SUPERBUNNY'**

AND

OPPOSITION No. 97943 BY BURGESS GROUP PLC

**TO REGISTRATION OF THE TRADE MARK IN CLASSES 20, 24 AND 31
ON THE BASIS OF VARIOUS EARLIER MARKS/RIGHTS INCLUDING THE TERM
'SUPA RABBIT'**

Background

1. On 14 January 2008, Carolina James (“the applicant”) applied to register the trade mark SUPERBUNNY in Classes 3, 14, 20, 21, 24 & 31.

2. The trade mark application was accepted and published for opposition purposes on 20 June 2008. On 22 September 2008, Burgess Group plc (“the opponent”) filed Form TM7 (Notice of Opposition) to the registration of the trade mark in classes 20, 24 & 31. The goods covered by those classes of the application are:

Class 20:

Furniture, mirrors, picture frames, goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

Class 24:

Textiles and textile goods, not included in other classes, bed and table covers.

Class 31:

Agricultural, horticultural and forestry products and grains (not included in other classes); live animals; fresh fruits and vegetables, seeds, natural plants and flowers, foodstuffs for humans and animals, malt.

3. The grounds of opposition are, in summary, that the opponent is the proprietor of the following earlier UK trade marks:

2180309 BURGESS SUPA RABBIT EXCEL (which is also registered as an earlier Community trade mark under No. 2621415),

2461809 SUPA,

2463843 SUPAPET/SUPA PET (series of two marks),

- which are all registered in Class 31 for ‘foodstuffs for animals’ and also in the case of 2461809 and 2463843, for ‘foodstuffs for small animals and domestic pets’.

4. The opponent claims that the opposed mark is similar to the earlier marks and that the goods in classes 20, 24 and 31 are similar to the goods for which the earlier marks are registered. Consequently, there is a likelihood of confusion and the application should be refused under s.5(2)(b) of the Act.

5. Further, the opponent claims to have built up a goodwill and reputation under the signs SUPA RABBIT and SUPA RABBIT EXCEL in respect of a trade in foodstuffs for animals and that use by the applicant of the mark SUPERBUNNY in relation to the goods covered by classes 20, 24 and 31 of the application would therefore cause deception and constitute passing off. Consequently, registration should be refused under s.5(4)(a) of the Act.

6. For the sake of completeness, I should mention that the grounds of opposition which accompanied the Form TM7 included several other earlier trade marks with the prefix SUPA that are registered in the opponent's name. These marks were not listed in the related section of the Form TM7 and therefore it was not clear whether or not the opponent was relying on these additional earlier marks. This approach appeared to me to be unsatisfactory, both because of the uncertainty it created as to the scope of the s.5(2) grounds of opposition, and because it potentially left the opponent with the option of relying on earlier marks in respect of which it had not made the statement of use required by Rule 17(5)(d) of the Trade Mark Rules 2008. Consequently, this was one of the matters discussed at a case management conference held on 7 June 2010. At that conference I directed that unless the opponent applied to amend the Form TM7 so as to make it clear that it relied upon these marks as earlier trade marks, the reference to them in connection with the pleaded s.5(2) grounds should be struck out of the accompanying grounds of opposition. The opponent's representative indicated that no such application would be made. Consequently, the reference to these additional earlier marks was struck out.

7. The applicant had earlier filed a counterstatement:

- i) denying that there is any likelihood of confusion or deception as a result of the use of the opposed trade mark,
- ii) requiring the opponent to prove that earlier trade mark 2180309 had been put to genuine use in the UK in the five years preceding the date of publication of the opposed mark (the other earlier marks listed in the Form TM7 had all been registered for less than 5 years at the date of publication of the opposed mark),
- iii) drawing attention to web sites which show that the opponent's goods are sold alongside the goods of another party using the mark BELVEDERE SUPER RABBIT, and alongside other animal foodstuffs bearing the mark SUPA, and relying on this to demonstrate that there is no likelihood of confusion with, or deception from, the applicant's mark.

The Evidence

8. The opponent's evidence consists of two witness statements by Paul Miley, who is the Managing Director of Burgess Pet Care, a division of the opponent company, a witness statement by Christy Anne Scott, who is a rabbit owner, and a witness statement by Jennifer Good, who is a trade mark attorney in the firm of Urquhart-Dykes & Lord LLP, which represents the opponent in these proceedings.

9. Mr Miley gives evidence that in the early 1990s the opponent introduced a range of animal feeds under brands including SUPA RABBIT, SUPA HAMSTER & SUPA DOG. A picture of the original products is attached to Mr Miley's statement (as exhibit PM1). The picture shows packets of various animal feeds, one of which is BURGESS SUPA RABBIT. Although separated from the various product names,

including SUPA RABBIT, in each case the name 'Burgess' is given roughly equal prominence.

10. Mr Miley says that the packaging has changed over the years, but that the name SUPA RABBIT remained a prominent feature of the branding of the relevant product. In 1998 the opponent introduced an extruded rabbit food under the name BURGESS SUPA RABBIT EXCEL. There is an example of the branding for this product in PM2, which appears to me to be fairly representative of subsequent use made of this mark. It looks like this.



11. However, it appears from a copy of a web page from 2009 in exhibit PM5 (and from some invoices from 2007/8 exhibited as PM2 to Mr Miley's second statement), that the opponent continued to offer rabbit food under variant marks, such as BURGESS SUPA RABBIT DELUXE.

12. Mr Miley provides sales figures which show that between 2004 and 2008 the opponent sold between £3.7m and £4.37m worth of animal food per annum bearing the mark SUPA RABBIT. During this period the opponent spent between £177k and £458k per annum promoting the product. Some examples of marketing are provided as exhibit PM2 to Mr Miley's first statement, but it is not clear from these where the opponent has promoted its products.

13. The opponent's products are available for sale through specialist pet retailers, such as Pets at Home, and independent pet food stores throughout the UK. The goods are also sold over the Internet.

14. Exhibit PM2 to Mr Miley's second statement includes copies of sales invoices from 2007/8 which include the SUPA RABBIT EXCEL and SUPARABBIT DELUXE products. In each case the customer's details are redacted. However, judging from the amounts involved, these invoices were sent to other traders rather than to

individual pet owners. The products are listed on the invoices under the above names. The BURGESS name appears prominently in the top corner of each invoice.

15. Exhibits PM4 and PM5 to Mr Miley's first statement consists of copies of pages from three web sites which feature the opponent's products. The first is Bunny Basics. The page from this site is dated May 2006 and features a positive review of 'Burgess Supa Rabbit Excel'. The second is Ciao!. There are two pages from this site, which appear to date from 2003/4. The reviews are headed 'Supa Rabbit Excel', although the text of the reviews mentions 'Burgess Supa Rabbit Excel'. The third is petplanet and appears to date from 2009. The product reviewed is listed as 'Burgess Supa Rabbit Excel'. One of the posted comments states "Felix loves Burgess Supa". The fourth is Chemist Direct. This also appears to be from 2009. The page in evidence features a packet of the product, which is listed as 'Supa Rabbit Excel'. The name 'Burgess' is visible on the accompanying picture of the product. The sixth is Farmway online. It is not clear when this page was created. It promotes 'Burgess Supa Rabbit Deluxe Rabbit Food'. The seventh is VetMedUK.com. The web page appears to be from 2009. The opponent's product is listed as 'Burgess Supa Rabbit Excel'.

16. Exhibit PM6 to Mr Miley's first statement consists of 10 letters from people mostly involved in the retailing of the opponent's product. A letter dated 4 June 2009 from Lucy Nixon of Pets Pantry is typical. It states:

"Burgess Supa Rabbit Excel has been on the market for a number of years and is our best selling extruded rabbit food. We find it to be the best on the market and recommend it to all our rabbit owners. The brand has many loyal customers and has a very strong reputation."

17. All the writers refer to the opponent's product as 'Burgess Supa Rabbit Excel'.

18. In his second witness statement, Mr Miley explains that the opponent provided the writers of these letters with an example of the kind of statement that it was looking for and this is why many of the letters adopt similar wording.

19. Christine Ann Scott gives evidence that she visited a veterinary surgery in Glasgow in February 2006 to have her rabbit checked. The vet recommended that she feed her rabbit on "SUPA RABBIT EXCEL from Burgess" and provided her with a free sample. Ms Scott took this advice and was pleased with the result on her rabbit's health.

20. In response to the applicant's claim that the opponent's marks already co-exist with a number of other SUPER- (or phonetic equivalents of Super) marks in the names of third parties, Ms Good gives evidence that the opponent "has co-existence agreements with a number of [unnamed] parties". She says that a number of these agreements are subject to confidentiality clauses, and she exhibits (as JG2) a copy of an undertaking received from Higher Nature Limited, which the applicant had pointed out markets an animal feed under the name SUPERDOG in competition with another of the opponent's products (Burgess Supa Dog).

21. The applicant, Ms James, gives evidence that she traded on a very small scale under the mark SUPERBUNNY in the past selling, inter alia, rabbit supplies. However, she has not traded since she suffered a serious illness in 2001.

22. Ms James provides (as exhibit CJ3 to her statement) copies of Internet extracts showing numerous uses by third parties of names including SUPER or SUPA in relation to animal food. The most relevant of these show that a competitor of the opponent markets a rabbit food under the names Mr Johnson's Belvedere Super Rabbit (and My Super Rabbit), and that another trader markets animal food products, including rabbit feed, under the mark Superpet. Ms James acknowledges that the examples she provides come from uses made of these marks after the date of the opposed application ("the relevant date"), but she claims that the volume of uses and the laudatory meaning of "super" indicates that the widespread use of SUPER shown in the extracts is likely to be representative of uses both before and after the relevant date.

23. Ms James also provides (as exhibit CJ5) copies of pages from the IPO and OHIM web sites showing numerous registrations of trade marks in Class 31 which include the word SUPER or its phonetic equivalent.

24. Finally, Ms James provides (as exhibit CJ7) an extract from the Pet Food Manufacturers Association's web site which shows that the annual market for rabbit food in the year 2008 was £43m. This helpfully places the use claimed by the opponent in context and suggests that it amounted to around 10% of the relevant market.

The Hearing

25. The matter came to be heard on 12 July 2010 when the applicant was represented by Mr Simon Malynicz of Counsel, instructed by Forrester Ketley & Co, and the opponent was represented by Mr Alan Fiddes of Urquhart-Dykes & Lord LLP.

The Section 5(2) Grounds

26. The relevant part of s.5 is 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.

27. It is common ground that the marks listed in paragraph 3 above are "earlier trade marks" for the purposes of s.5.

28. I will start by considering the opposition based on earlier mark 2461809, SUPA. As I indicated earlier, the registration process for this mark had not been completed five years prior to the publication of the opposed mark. Consequently, the proof of use requirement set out in s.6A does not apply.

29. In my consideration of whether there is a likelihood of confusion between the earlier mark and the applicant's mark, I take into account the guidance from the settled case law of the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v OHIM* C-334/05 P (LIMONCELLO). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes (and ears) of the average consumer of the services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (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; *Sabel BV v Puma AG*,
- (e) 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; *Shaker di L. Laudato & C. Sas v OHIM*
- (f) beyond the usual case, it is quite 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; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,
- (g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,
- (h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(k) if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

Similarity of Goods

30. The earlier SUPA mark is registered for foodstuffs for animals and domestic pets. The application covers the heading for class 31, namely:

“Agricultural, horticultural and forestry products and grains (not included in other classes); live animals; fresh fruits and vegetables, seeds, natural plants and flowers, foodstuffs for humans and animals, malt.”

31. Insofar as the application covers ‘foodstuffs for animals’ it is self evident that the respective goods are identical. Further, I am satisfied that each of the other products listed in class 31 of the application, except for ‘foodstuffs for humans’ and ‘malt’, may be used to feed animals. In most cases this is self evident, but even in the case of ‘live animals’ it is common knowledge that certain animals are fed on other live animals, eg snakes eat mice, reptiles eat insects. Consequently, apart from the two exceptions I have identified, I find that the respective descriptions of goods in class 31 cover identical goods.

32. All relevant factors should be considered in deciding whether the remaining goods in classes 20, 24 and 31 are similar to the applicant’s goods, as per *Canon* where the ECJ stated at paragraph 23 of its judgment that:

“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.

33. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06*, the General Court stated that goods are “complementary” when:

“.....there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”

34. I first assess the similarity of the non-identical goods in class 31 of the application – foodstuffs for humans and malt. Foodstuffs for animals and foodstuffs for humans can be very similar in nature, both being foods consisting of, or processed from, mainly natural ingredients. The intended purpose is also similar, although the products would reach their markets through entirely different trade channels. The respective users would mostly be different, although pet owners will

purchase both types of foodstuffs. The respective goods are obviously not in competition. Overall, I find that there is a low degree of similarity between foodstuffs for animals and foodstuffs for humans. There is no evidence before me that malt is used as (or in) animal feed. Even if it used as an ingredient in animal feed, this does not necessarily make malt similar to the finished product. On the evidence before me (or rather the lack of it), I find that there is no similarity between these goods.

35. Mr Fiddes sought to persuade me that certain of the goods covered by classes 20 and 24 of the application are also similar to foodstuffs for animals, essentially on the basis that they may all be for animals, are therefore sold through the same trade channels, and are complementary to one another. I am not persuaded by this line of argument. I accept that some of the terms covered by classes 20 and 24 of the application, eg “goods of plastic” and “textile goods” cover goods for animals. For example, a dog kennel could be a good of plastic and a dog blanket could be a textile good. However, other than for the fact that these goods and animal feed are intended for the same consumer and ‘end user’, they have nothing in common. Accordingly, at most, there is only a very low degree of similarity between such goods. The position might be a bit different for certain other goods, such as feeding bowls, which would also be covered by “goods of plastic” in class 20 of the application. These goods are ‘complementary’, in the ordinary sense of that word, to animal feed, but as Mr Malynicz pointed out, the case law requires more. In particular, it is necessary that the relationship between the respective goods causes consumers to believe that they tend to originate from the same trade source. Consequently, the General Court held in Case T-105/05 that wine glasses are not complementary to wine. There is no evidence before me which causes me to believe that relevant consumers expect animal food and feeding bowls to originate from the same trade source. Consequently, I find that such goods are not complementary and there is, at most, only a very low degree of similarity between them.

Similarity between the Marks

36. The marks SUPA and SUPERBUNNY are of different lengths and share only the first 3 letters. Consequently, although the beginning of both marks is the same, there is only a small degree of overall visual similarity between them, and although closer to the ear (because the letters ‘A’ and ‘ER’ would sound similar), still only a modest degree of overall aural similarity.

37. The marks have a degree of conceptual similarity because the meaning of SUPA is likely to be equated to SUPER, which is the first word in the applicant’s mark. Even so, the meaning of SUPER is not the same as the meaning of SUPERBUNNY, even for rabbit food, because the latter mark also brings to mind the thought of a ‘bunny’. Consequently, although the marks are conceptually similar, they are by no means conceptually identical.

38. Overall, I find that there is a low degree of similarity between the marks.

Distinctive Character of the Earlier Mark

39. On the face of it, the word SUPA has low distinctive character because its visual and (more so) phonetic resemblance to the SUPER means that it is liable to be seen

as a misspelling of that word rather than as an invented or meaningless one. The meaning of the word SUPER needs no explanation from me. It is plainly a word which may serve, in trade, to designate the quality of the products and, as such, has very little capacity to distinguish the goods of one undertaking from those of other undertakings.

40. There is no evidence of use of SUPA alone as a trade mark. The opponent claims that the distinctiveness of its SUPA mark has been enhanced as a result of its use as part of other marks, including SUPA RABBIT. It is well established that a mark can acquire a distinctive character as a result of its use as a part of, or in conjunction with, other marks: see the ECJ's judgment in *Nestle S.A. v Mars UK Ltd (Have a Break)*, ECJ, Case C-353/03. However, whether a particular mark has acquired a distinctive character (or in this case, an enhanced level of distinctive character) as a result of such use is a question of fact to be determined on the evidence. I do not find that the opponent's use of SUPA as part of the other two marks listed in paragraph 3 has resulted in the mark SUPA alone acquiring a strongly distinctive character for animal food. Accordingly, I conclude that that mark still has only a low level of distinctive character.

The Average Consumer

41. The average consumer in this case is an animal owner. As the evidence shows, such consumers take a reasonable amount of care when selecting the food best suited to their animal or pet in keeping with their characterisation as "reasonably observant and circumspect". I find that, in this case, the average consumer in question would pay at least an average level of attention when selecting the products at issue. Mr Fiddes submitted that traders in animal foods should also be considered as average consumers. Although I accept that such traders could also be considered as consumers, trade intermediaries are less significant in this case than end consumers. This is because it is likely that those who trade in the goods will pay a particularly high a level of attention when selecting the goods that they stock and therefore are, if anything, less likely to be confused by similarities between their suppliers' marks than are their customers. Consequently, in practice it matters little whether or not there is a second category of average consumer.

Likelihood of Confusion

42. I find that the weak distinctive character of the mark SUPA combined with the low level of overall similarity between the marks is sufficient to exclude the likelihood of confusion notwithstanding the identity between the opponent's goods and some of the applicant's goods. It follows that I also reject the opposition where the respective goods are only similar.

43. In my view, there is no likelihood of an average consumer of animal food directly mistaking SUPA for SUPERBUNNY or imperfectly recollecting the one mark for the other. They are too different for that. Further, there is no likelihood of association (in the sense of indirect confusion) because the most distinctive feature of the earlier mark, the misspelling of SUPER as SUPA, is not present in the applicant's mark. Consequently, there is insufficient reason to suppose that an average consumer paying a reasonable degree of attention will mistakenly assume that SUPERBUNNY

is a variant mark used by the undertaking which trades under the SUPA mark, or by an undertaking which is economically linked to it.

44. I therefore reject the ground of opposition based on s.5(2)(b) insofar as it is based on earlier trade mark 2461809.

45. I turn next to consider the opposition based on earlier trade marks SUPAPET and SUPA PET, which are registered as a series of two marks under 2463843. Again, the marks had not been registered for five years at the date of publication of the opposed mark so the proof of use requirement in s.6A of the Act does not apply.

46. I can deal with the opposition based on these marks quite briefly. This is because, with the following variations, my findings in respect of earlier mark 2461809 also apply to these marks. I accept that SUPAPET(S) is a slightly stronger mark than SUPA alone. Set against that there is, if anything, less similarity between SUPAPET(S) and SUPERBUNNY than there is between SUPA and SUPERBUNNY. This is because, although the respective marks are more equal in length, the second word in SUPAPET(S) – PET(S) - bears no visual or aural resemblance to the second word in the later mark - BUNNY. Consequently, bearing in mind also the visual difference between SUPA and SUPER, there is only a low level of overall visual and aural similarity between the marks SUPERBUNNY and SUPAPET(S).

47. The respective marks are slightly more similar from a conceptual perspective, both combining the idea of superiority with pets in general, or 'bunnies' in particular. However, neither concept is particularly distinctive in the context of a trade in animal food such as to outweigh the visual and aural differences between the marks.

48. Accordingly, with these adjustments to my reasoning, I come to the same conclusion on the ground of opposition based on earlier mark 2463843 as I did with the ground based on 2461809. The opposition based on 2463843 is therefore also rejected.

49. This brings me to the third earlier trade mark on which a s.5(2)(b) ground of opposition is based – BURGESS SUPA RABBIT EXCEL. This mark is registered both as a national trade mark under 2180309 and as a Community trade mark under 2621415. The registration procedure for the earlier national trade mark was completed on 30 April 1999, more than five years prior to the date of publication of the opposed mark. Consequently, in accordance with s.6A of the Act the opponent is only able to rely upon the earlier national mark to the extent that it satisfies the requirement for the mark to have been put to genuine use. By contrast, the registration procedure for the corresponding Community trade mark was completed on 20 November 2003, less than five years prior to the date of publication of the opposed mark. Consequently, that registration is not subject to the use requirement in s.6A of the Act.

50. In practice it is only necessary to consider the objection by reference to the earlier Community trade mark. If the opponent succeeds on the basis of the earlier CTM, determining whether it can also rely upon the identical national mark would be a pointless exercise. Similarly, if the opponent cannot succeed on the basis of the earlier CTM it will be no better off relying on the national registration, even if it does

satisfy the use requirements. Consequently, in the interests of procedural economy I propose to examine the s.5(2)(b) ground based on the earlier mark BURGESS SUPA RABBIT EXCEL solely by reference to the Community trade mark registration.

51. The Community trade mark is registered for foodstuffs for rabbits. I adopt my earlier analysis and findings about the similarity of the respective goods in relation to earlier mark 2461809, which is registered for a specification of goods which is very slightly wider, but materially the same. It follows that my earlier findings regarding the characteristics of the average consumer also apply here.

Similarity of Marks

52. It is self evident that there is a very low level of overall visual and aural similarity between the marks SUPERBUNNY and BURGESS SUPA RABBIT EXCEL. The high point of the opponent's case is that there is a higher level of conceptual similarity between applicant's mark and the SUPA RABBIT element of the earlier mark. Mr Malynicz submitted that even this was not a particularly high level of similarity because whereas RABBIT is a straightforward functional description of the animal, BUNNY is an informal and affectionate name for it. Traders in animal foods are more likely to describe their product using functional descriptions, such as rabbit food, rather than as 'bunny' food. Therefore whereas the SUPA in SUPA RABBIT will most likely be taken as a reference to the quality of the feed product, the SUPER in SUPERBUNNY is equally likely, or more likely, to be taken as a reference to the 'bunny' itself.

53. As with visual and aural similarities, it is necessary to assess conceptual similarities and differences by comparing the marks as wholes. The word BURGESS is plainly a name, beyond which it has no meaning. The word EXCEL is a laudatory word. In the context of the opponent's mark as a whole, its presence builds on the laudatory message already suggested by the use of the word SUPA. In the context of a trade in rabbit food, the overall meaning seems to be of a superior rabbit food marketed by someone called BURGESS.

54. The applicant's mark may also be taken as a reference to a superior rabbit food, but for the reasons given by the applicant's representative, it may also be taken as a reference to a superior 'bunny'. I therefore conclude that although there is a degree of conceptual similarity, the similarity between them (as wholes) is not of a particularly high degree. I find that there is a low level of overall similarity between the marks.

Distinctive Character of the Earlier Mark

55. Taking account of the use made of it, I find that the earlier mark as a whole has an above average level of distinctive character. However, I am not persuaded that the SUPA RABBIT element is the dominant or most distinctive element of the earlier mark. BURGESS is more dominant because of its position at the beginning of the mark, and more distinctive because it is the element of the earlier mark which speaks most loudly as to the trade source of the goods. By contrast, the SUPA RABBIT EXCEL elements are partly descriptive or laudatory. However, I recognise that even if it is not the most dominant and distinctive element of the earlier mark, the

SUPA RABBIT element could still play an independent distinctive role in the composite mark as per the *Medion* case. Of course, the facts in that case were the reverse of those here. In the *Medion* case the earlier mark retained an independent distinctive role in the later composite mark. However, I see no reason why the same approach should not be applied, by parity of reasoning, to the reverse situation in which the later mark consists of an element (or is similar to an element) which, exceptionally, has been shown to have an independent distinctive role in an earlier composite mark.

56. This does not mean that SUPA RABBIT could be treated as though it had been registered as a separate mark. Rather, the question is whether the SUPA RABBIT element of the earlier mark has an independent distinctive role within the composite mark BURGESS SUPA RABBIT EXCEL, which thereby increases the likelihood of confusion between that mark as a whole and SUPERBUNY.

57. The evidence on this point is mixed. The nature of some of the usage of SUPA RABBIT within the composite mark (with a degree of separation from BURGESS and EXCEL) lends support to the claim that it has an independent distinctive role within the composite mark. The evidence of Ms Scott also provides a small degree of support for the claim.

58. On the other hand, the ten letters in exhibit PM6 to Mr Miley's first statement suggest that the writers of those letters view the opponent's composite mark as a whole. Further, as Mr Malynicz pointed out, the fact that the wording of those letters was suggested by the opponent itself implies that at the time that the evidence was solicited, it viewed its composite mark in the same way.

59. In my view, the best evidence is that found in exhibits PM4 and PM5 to Mr Miley's first statement, which shows how third parties have identified the opponent's mark in normal commerce (described at paragraph 15 above). Again the evidence is mixed. There are a couple of instances where third parties have (at least initially) identified the opponent's product as SUPA RABBIT EXCEL, but the weight of this evidence shows that third parties generally refer to the opponent's mark as BURGESS SUPA RABBIT EXCEL. None refer to it as just SUPA RABBIT. This evidence therefore accords with the case law of the Court of Justice described above, that trade marks are normally perceived as a whole.

60. I therefore reject the claim that the SUPA RABBIT element of the earlier mark has an independent distinctive role within the earlier composite mark.

Likelihood of Confusion

61. I do not intend to attach any weight to the 'state of the register' evidence provided by the applicant or to the evidence of third parties using SUPER or SUPA as part of branding for other animal food products, including in one case SUPER RABBIT. To the extent that this shows that SUPER is capable of being used as a laudatory word, the evidence tells me nothing beyond the obvious and is therefore irrelevant. To the extent that it purports to show actual use of SUPER by third parties it either does not do so (in the case of the state of the register evidence) or does not do so prior to the relevant date. Consequently, there is no need for me to consider

Ms James's evidence that some of the uses shown in evidence may be subject to co-existence agreements with the opponent.

62. In my judgment, the low degree of similarity between the marks when compared as wholes combined with the fact that SUPA RABBIT is not the dominant or most distinctive element of the earlier mark carries more weight than the identity of some of the respective goods. The opponent's best case is that consumers will either misremember its mark as SUPERBUNNY or else wrongly assume that SUPERBUNNY is another in the opponent's family of marks. The first proposition depends not only on the consumer misremembering SUPA RABBIT as SUPERBUNNY, but also on the missing words BURGESS and EXCEL failing to alert the consumer that applicant's mark is not the one seen or heard before. I do not think that an average consumer paying a reasonable degree of attention is likely to be confused in this way. The second proposition depends on the consumer being familiar with the opponent's 'family' of SUPA marks and mistakenly assuming that SUPERBUNNY is another member of it. However, a person with sufficient familiarity with the opponent's products to know that there are a number of marks including the word SUPA is also likely to know some of the following:

- a) the family 'link' is SUPA not SUPER;
- b) the word SUPA is usually combined with a functionally descriptive word, like RABBIT;
- c) the family is also identified by the consistent use of the word BURGESS.

63. Additionally, the likelihood of association with the mark BURGESS SUPA RABBIT EXCEL must also take account of the effect of the absence of the word EXCEL in the applicant's mark, although I do not attach much weight to this factor alone. The combination of these factors is, however, sufficient for me to find that the second proposition is also unlikely. Consequently, I find that there is no likelihood of confusion, including the likelihood of association.

64. The s.5(2)(b) ground of opposition based on earlier UK trade mark 2180309 and earlier Community trade mark 2621415 is therefore also rejected.

The Passing Off Right Case

65. Section 5(4)(a) of the Act states that a trade mark shall not be registered:

".....if, or to the extent that, its use in the United Kingdom is liable to be prevented 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"

66. The requirements to succeed in a passing off action are well established and are summarised in *Halsbury's Laws of England* 4th Ed at paragraph 165 as follows:

"1) that the claimant's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods offered by the claimant are goods of the defendant;

3) that the claimant has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

67. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff 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 feature 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 successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court 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 plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;

(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 confusion or 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."

68. I would add one further point to this analysis of the law. The test is whether, on the balance of probabilities, a substantial number of persons would be deceived by the use of the mark applied for: *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473. The test is qualitative rather than quantitative. As noted by the Court of Appeal in *Reed v Reed* [2004] RPC 40, this is much the same as the average consumer test in trade mark law. The intention of both is to exclude those consumers who are exceptionally prone or resistant to confusion.

69. The opponent claims to own a protectable goodwill identified by the signs SUPA RABBIT and SUPA RABBIT EXCEL. It will be apparent that there is a degree of overlap between the s.5(4)(a) grounds and the grounds I have already considered and rejected under s.5(2), particularly those based on registrations of SUPA and BURGESS SUPA RABBIT EXCEL. Nevertheless, there are a couple of aspects of the s.5(4)(a) ground which require me to reassess the matter. In particular, the fact that the opponent can rely on all its branding including the word SUPA under this heading, including SUPA DOG, SUPA HAMSTER etc. to show that SUPA RABBIT is distinctive of it, and the fact that the opponent has used SUPA RABBIT in branding that does not include the word EXCEL, means that the s.5(4)(a) opposition could succeed where the s.5(2)(b) opposition failed.

70. There is no doubt that the opponent enjoys a substantial goodwill in the field of animal feed. There is no evidence that its reputation is for anything more than animal feed. The word SUPA has very limited inherent distinguishing power because it is an obvious misspelling of the laudatory word SUPER, which is plainly not a word that the public would rely upon, by itself, to identify the goods of any particular undertaking. In my judgment, the evidence indicates that the opponent's goodwill is generally identified by the combination of the words BURGESS and SUPA and not SUPA RABBIT or SUPA RABBIT EXCEL alone. That is not to say that the use by third parties of those signs would not be regarded as a misrepresentation. However, the required assessment should start with a comparison between the signs which the opponent uses and which are distinctive of it - BURGESS SUPA RABBIT and BURGESS SUPA RABBIT EXCEL – and the mark applied for, and take account of all the relevant facts and circumstances, including the opponent's use of other marks including the word SUPA.

71. I have already given my reasons for finding that SUPERBUNNY would not be confused with BURGESS SUPA RABBIT EXCEL. For much the same reasons, and taking account of the additional factors mentioned above, I do not find that the applicant's use of SUPERBUNNY would cause deception amongst a substantial number of the opponent's customers or potential customers having regard to its established goodwill under the signs BURGESS SUPA , BURGESS SUPA RABBIT and BURGESS SUPA RABBIT EXCEL. Consequently, the use of the mark applied for would not constitute a misrepresentation and thereby amount to passing off.

72. In these circumstances, the s.5(4)(a) ground of opposition must also be rejected.

Conclusion

73. The opposition is rejected.

Costs

74. The opposition having failed, the applicant is entitled to a contribution towards its costs. The applicant's representative asked me to take into account that the opponent vexed the applicant by submitting as part of its evidence in reply, computer generated sales lists which occupied more than two ring binders, all of which had to be read. The opponent's representative submitted that the applicant had brought this on itself by questioning the sufficiency of its evidence in chief to support its claim to enjoy a reputation under the mark BURGESS SUPA RABBIT EXCEL. In my view, there is some truth in both submissions. The applicant did nitpick the opponent's initial evidence and the opponent's response was to deluge her with unnecessary computer print outs (the redacted invoices mentioned above was all that was necessary). However, I do not think that much time should have been spent analysing the computer print outs, which were very repetitive, and I do not consider that the opponent's response was disproportionate to the point where I would be justified in awarding costs on a compensation basis. I have, however, taken account of the volume of evidence filed in making the following assessment.

75. I order the opponent to pay the applicant the sum of £2150. This is made up of:

- £300 - for considering the notice of opposition and filing a counterstatement
- £800 - for considering the opponent's evidence and filing evidence in support
- £300 - for the case management conference and the other work occasioned by the opponent's request to strike out much of Ms James's evidence
- £750 - for the substantive hearing, including the preparation of the skeleton.

76. The above sum to be paid within 7 days of the end of the period allowed for appeal.

Dated this 18th Day of August 2010

**Allan James
For the Registrar**