

BL O/581/21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3608286

BY

THE BUFFALO CO. PET COMPANY LTD

TO REGISTER THE FOLLOWING TRADE MARK:



AND

OPPOSITION NO. 426078 THERETO

BY

BLUE BUFFALO ENTERPRISES

Background and pleadings

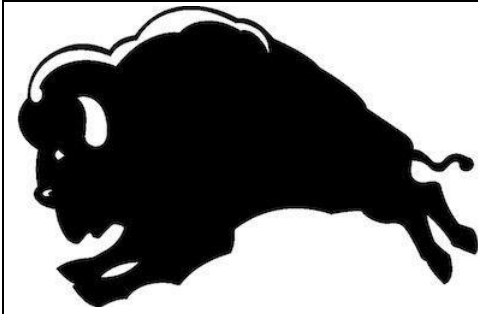
1. On 11 March 2021, The Buffalo Co. Pet Company LTD, (the “Applicant”) applied to register the trade mark shown on the cover of this decision. The contested trade mark application was accepted and published for opposition purposes in the Trade Marks Journal on 7 May 2021. Registration of the mark is sought in respect of the following goods:

Class 31 *Dog treats [edible].*

2. On 9 August 2021, Blue Buffalo Enterprises (the “Opponent”) opposed the application under Sections 5(4)(a), 5(3) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The Opponent was advised via correspondence on 14 December 2021 that the Section 5(4)(a) and Section 5(3) grounds were deemed to be withdrawn as neither evidence nor submissions supporting the claims had been filed within the allocated time.

3. The Section 5(2)(b) objection remained and was raised on the basis of two earlier United Kingdom Trade Marks (UKTMs):

UKTM 801236838 (the -838 mark) BLUE BUFFALO	Filing date: 28 October 2014 Receiving date: 17 October 2020 Registration date: 10 May 2017
Class 31: <i>Cat food; cat treats; dog biscuits; dog food; dog treats; pet food; pet treats.</i>	
UKTM 917369166 (the -166 mark)	Filing date: 19 October 2017 Receiving date: 17 October 2020 Registration date: 6 February 2018



Class 31: *Cat food; Cat treats; Dog biscuits; Dog food; Dog treats; Pet food; Pet treats.*

4. Since the filing dates of both earlier marks predate that of the contested application, the Opponent's marks are considered to be "earlier marks" in accordance with section 6 of the Act. However, as neither mark has been registered for a period of five years or more before the filing date of the application, they are not subject to the use requirements specified within section 6A of the Act. The Applicant's request in their TM8 for proof of use is not, therefore, pertinent. As a consequence, the Opponent may rely upon any or all of the goods and services for which the earlier marks are registered without having to show that it has used the marks at all.

5. For the purposes of this opposition the Opponent relies upon all of the goods for which both of the earlier marks are identically registered. The opposition is aimed against the entire list of applied for goods, i.e., *Dog treats [edible]*.

6. On 15 September 2021, the Applicant filed a counterstatement denying the grounds of opposition in the following terms:

"... the only similarity with the marks is the word BUFFALO. The Opponent does not have exclusive rights in the word BUFFALO. The images in the marks are completely different. Overall the marks are not visually, aurally or conceptually identical or similar and therefore there would be no confusion on the market place. There would be some cross over with the specification, however only minimal and not enough for the consumer to assume that there is a connection between the two companies."

7. Only the Applicant filed submissions, which were received on 9 March 2022.

8. The Applicant provided a brief background as to the establishment of its company in 1987. The Applicant asserted that the marks at issue are not conceptually similar. The Applicant argued that this is due to the concept of the contested mark being that of the head of a buffalo, in a red colour, which does not evoke the same concept as either of the Opponent's marks, the first of which consists of the side image of a leaping buffalo (earlier mark -166) with the second consisting of the words BLUE BUFFALO (earlier mark – 838).

9. The Applicant claimed that the only similarity between the marks at issue is that they both contain the word BUFFALO. The Applicant contended that overall the marks are neither visually, aurally nor conceptually similar, and that no consumer would assume a connection or association between the two companies.

10. The Applicant accepted that both their goods and the goods of the Opponent cover *dog treats*, and are therefore similar. However, the Applicant argued that there are a large number of companies on the market which include the word BUFFALO in their branding for dog treats. According to the Applicant, this is because the products contain Buffalo meat, and it is therefore a descriptive element in each mark. The Applicant submitted that this proves there is room for co-existence on the market.

11. No hearing was requested. Only the Opponent provided submissions in lieu of a hearing, dated 7 June 2022.

12. In its submissions, the Opponent argued that the goods at issue are directed at the public at large, who will likely have a level of attention that is lower than average given the everyday nature and low price of the goods. The Opponent argued that there is clear identity between the goods at issue, as the contested goods use the same wording in the specification as the registered goods.

13. The Opponent contended that the word BUFFALO, which is included in both the application and the earlier mark -838, has an average degree of distinctive character for the goods at issue. In reply to the Applicant's claim that Buffalo is an ingredient of dog treats, the Opponent submitted that this has not been proven with evidence. The Opponent argued that the remaining elements of the contested mark 'THE', 'CO', and 'EST 1987' are generic and do not inform the public as to the origin of the goods. In addition, these elements are shorter than the dominant verbal element 'BUFFALO'.

The Opponent submitted that the figurative element in the contested mark is a co-dominant element, and reinforces the concept of a buffalo.

14. The Opponent argued that from a visual perspective the difference caused by the presence of the four letter word 'BLUE' in the earlier mark -838 does not significantly reduce the visual similarities between the marks.

15. From an aural perspective, the Opponent argued that the figurative element of the contested mark will not be spoken, nor would the remaining non-distinctive word elements 'EST 1987'. As such, the contested mark will be read as THE BUFFALO CO., whilst the earlier mark -838 will be read as 'BLUE BUFFALO', and the earlier figurative mark -166 will be referred to as BUFFALO. As a result, there is a high degree of aural similarity between the marks at issue.

16. As for the conceptual perspective, the Opponent argued that the figurative element of the contested mark reinforces the notion of the word element 'BUFFALO'. The Opponent disagreed with the Applicant's submission that the buffalo head in the contested mark is conceptually different from the running buffalo in the earlier mark -166. The Opponent argued that because the concept of a buffalo is evoked in each mark, the marks at issue are conceptually highly similar.

17. In light of all of the above, the Opponent argued that there is a likelihood of direct confusion, particularly when considering the notion of imperfect recollection. In the alternative there is at least a likelihood of indirect confusion, as the consumer would think the contested mark is a brand extension of the earlier mark.

18. Both parties are professionally represented. The Applicant is represented by Serjeants LLP, and the Opponent is represented by Bird and Bird LLP.

Decision

Section 5(2)(b)

19. Section 5(2)(b) of the Act 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”.

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

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

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

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

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

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

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

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

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

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

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

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

21. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Comparison of goods

22. Both of the Opponent's earlier marks have the same specification, i.e., *Cat food; cat treats; dog biscuits; dog food; dog treats; pet food; pet treats.*

23. The parties' respective specifications are therefore:

Earlier mark(s)	Application

Class 31 <i>Cat food; cat treats; dog biscuits; dog food; dog treats; pet food; pet treats.</i>	Class 31: <i>Dog treats [edible].</i>
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24. It has been established by the General Court (GC) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that:

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

25. The general category term *dog treats* under the earlier marks clearly encompass the contested *Dog treats [edible]*. I therefore find the goods at issue to be identical.

Comparison of marks


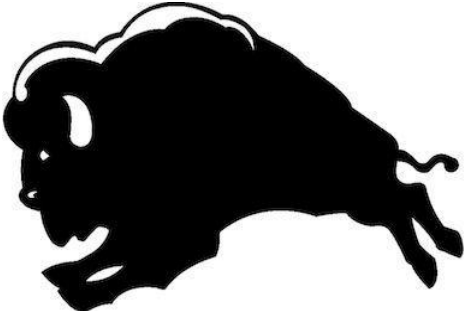
26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

27. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

28. There does not appear to be an earlier mark that would offer the Opponent an obvious better chance of success, as each earlier mark contains a different element contained with the contested mark, e.g., the word BUFFALO in -838 and an image of a buffalo in -166. Each mark shall therefore be used for comparison purposes.

29. The respective trade marks are shown below:

Earlier trade mark – 838	Contested trade mark
BLUE BUFFALO	 <p data-bbox="927 1346 1193 1400">EST 1987</p> <p data-bbox="850 1462 1279 1525">THE BUFFALO CO.</p>
Earlier trade mark – 166	
	

30. The overall impression of the Opponent's earlier mark -838 derives from the combination of verbal elements BLUE BUFFALO. Each element will be readily understood in the English language, with the word BLUE representing a colour, and the word BUFFALO representing a large, horned, bovine land mammal. The mark is presented in a standard typeface, with neither element being larger or more stylised than the other. As such, neither element is considered to be more eye-catching or dominant. According to the Applicant, buffalo meat is used as an ingredient in the goods at issue, and is therefore descriptive. The Opponent correctly identified that this submission had not been proven in evidence. Relying on my own general knowledge and personal experience, which I am entitled to do,¹ I am aware that buffalo meat is used as an ingredient in relation to such goods. It is possible that a certain number of average consumers may also be aware of this fact. However, I am not entirely convinced that the use of buffalo meat in relation to the goods at issue is so universally well known that I may take judicial notice of it. I therefore prefer to take a more cautionary approach, and will proceed on the basis that whilst some consumers may consider the term BUFFALO to be descriptive, the majority will not (especially as the Applicant has not proven otherwise). The combination of elements hang together, with the word BLUE functioning as an adjective for the noun BUFFALO, creating the overall impression of a buffalo that is blue in colour.

31. The overall impression of the Opponent's earlier mark -166 is that of a buffalo, facing left, in either a running or leaping pose. The depiction is clearly that of a buffalo, due to its identifiable horns and hump, and I believe the average consumer will recognise it as such.

32. The contested mark contains a red, forward-facing rendition of the head/skull of a horned bovine animal. Either side of the head/skull in an aged-looking font are the elements EST and 1987. Below the head/skull are the words THE BUFFALO CO., in the same font as EST and 1987, although they are a slightly larger size. The elements EST and CO. are likely to be understood by the average consumer as being short-form versions of the words 'Established' and 'Company' respectively. The combination of word elements in the contested mark create the impression of a company called buffalo, that was established in 1987. I do not find it likely that the combination of words

¹ *esure Insurance Ltd v Direct Line Insurance Plc*, [2008] EWCA Civ 842

THE BUFFALO CO will universally be perceived as being entirely descriptive in relation to the goods at issue, as it has not been unquestionably proven that the average consumer is aware that buffalo meat is used in relation to pet foods and treats etc. That having been said, I do consider it possible that a certain number of consumers may perceive the words in either a descriptive or highly allusive context as referring to a company dealing with buffalo (the animal). The use of the word BUFFALO in the contested mark removes any ambiguity as to which bovine animal the figurative red head/skull belongs, confirming it unequivocally as being buffalo. Due to its striking colour, and larger size than the other elements, it is the image of the buffalo head/skull which is the more eye-catching and dominant element in the contested mark. I also consider it to be the more distinctive element, as certain consumers may perceive the combination of words as being descriptive or allusive, and therefore non or lowly distinctive.

Visual similarity

-838

33. Each marks contains the word BUFFALO, which is the extent of the visual similarity. The marks visually differ in relation to the remaining elements in each mark. The earlier mark has the additional word BLUE, which has no counterpart in the contested mark. The contested mark has the four additional terms EST 1987, and THE CO. In addition, the contested mark contains a visually dominant figurative element of a red buffalo head/skull, which also has no counterpart in the earlier mark.

34. In my opinion, the marks are visually similar to a low degree.

-166

35. The earlier mark does not contain any of the word elements that are present within the contested mark. The figurative element of the earlier mark is a leaping or running buffalo in black, whilst the figurative element of the contested mark is the head/skull of a buffalo in red. Aside from the difference in colour, the representations of the buffalo are noticeably different, with one depicting a side image of an entire animal and the other depicting a frontal image of a part of an animal. The only detail in which the figurative elements clearly coincide is the fact that each depiction has horns.

36. In my opinion, the marks are not visually similar to any degree.

Aural similarity

-838

37. Aurally, the signs are similar insofar as they both contain the word BUFFALO, which will be pronounced identically in each mark. The marks therefore share the same three syllables BUFF-A-LO. The earlier mark contains the additional one syllable word BLUE, which has no counterpart in the contested mark, whilst the contested mark contains the additional nine syllables present in the remaining word elements EST-NINE-TEEN-EIGHT-Y-SEV-EN-THE-CO. It is possible that a certain number of consumers would not pronounce the elements EST 1987, as they will perceive them to be secondary and purely descriptive/informational. However, as identified by Mr Philip Harris acting as the Appointed Person in BL O-115-22 *Purity Hemp Company*, the descriptiveness of a word does not of itself render an element negligible or aurally invisible. Therefore, it should be considered to have some aural impact. The word BUFFALO will be spoken second in the earlier mark and fourth in the contested mark. The figurative element in the contested mark will not be enunciated and so has no impact on the mark's aural aspect.

38. In my opinion, the marks are aurally similar to no more than a medium degree.

-166

39. The earlier mark consists of a figurative element, and does not contain any word elements. A figurative mark without word elements cannot, by definition, be pronounced. Further, it is not necessary to examine the aural perception of a figurative mark without word elements, and compare it to the aural perception of another mark.²

40. The marks therefore cannot be compared aurally.

Conceptual similarity

-838

² *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, T- 424/10, paragraphs 45-47.

41. The word BLUE is a known colour, and the word BUFFALO is a known animal. Due to the construction of the combination of word elements, which hang together, the word BLUE functions as an adjective for the noun BUFFALO, and subsequently creates the concept of a buffalo which is blue. It is possible that a certain number of consumers, who are aware that buffalo meat is used in relation to the goods at issue, may interpret the mark to indicate that the buffalo meat comes from a buffalo which is blue-ish in colour. Undoubtedly no consumer would literally believe a buffalo is wholly blue, but a consumer could be forgiven for believing/assuming the buffalo has a greyish-blue hue, similar to the colour of dogs which are described as being "blue". In the alternative, the average consumer may perceive the combination as a distinctive and fanciful concept with no relation to the goods at issue.

42. The conceptual impact of the word elements in the contested mark is that of a company called BUFFALO that was established in 1987. A certain number of average consumers may perceive the element BUFFALO as conveying the descriptive or allusive message that the company uses buffalo in their goods. However, this is unlikely to be a universally held view, and many consumers may simply interpret the word BUFFALO to refer to name of the company. The figurative element in the contested mark has the concept of a red bovine head/skull. In consideration of the overall impression of the mark, including its word elements, the bovine creature in question will likely be perceived as intended to be a buffalo.

43. The marks are conceptually similar insofar as they both convey the concept of a buffalo to some degree, with the concept of the buffalo in the contested mark being limited to that of only one body part, i.e., the head/skull. For those consumers who do not perceive the concept of a buffalo to be a descriptive or allusive element then it shall be perceived as being wholly distinctive. The colour of the buffalo in each respective mark is different, as is the image of the animal. The head/skull of a red buffalo is a uniquely distinctive concept, as is the concept of an entire blue buffalo.

44. In my opinion, the marks are conceptually similar to between a low and medium degree.

-166

45. The conceptual impact of the earlier mark rests in a relatively accurate depiction of a leaping/running buffalo. The buffalo is black (or uncoloured), and would likely be perceived as a non-fanciful rendition of the animal. The marks are conceptually similar insofar as they both convey the concept of a buffalo to some degree, with the concept of the buffalo in the contested mark being limited to that of only one body part, i.e., the head/skull. The earlier mark's concept of an entire "realistic" buffalo in motion is different from that of a fanciful, red buffalo head/skull.

46. In my opinion the marks are conceptually similar to between a low and medium degree.

Average consumer and the purchasing act

47. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.³ In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

The goods at issue are pet food and pet treats, and are considered to be everyday products insofar as they are bought and consumed frequently, or on a daily basis. They fall within a generally affordable price range of inexpensive items. The purchaser of the goods will be an owner of a pet. Some pet owners take a certain degree of care when purchasing the food their pet would eat, but equally there are a number of pet owners who choose a basic version. I believe in the majority of instances it is a fairly

³ *Lloyd Schuhfabrik Meyer*, Case C-342/97

casual purchase. As a result, I believe the overall level of attention will most likely be medium. The goods will predominantly be sold in a supermarket or pet store, and may also be purchased via a magazine or online using a website. I consider it likely that the purchasing process will be predominantly visual in nature, however, I do not discount the possibility of an aural component in the purchasing process, for example when a consumer verbally asks a sales assistant for guidance.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

49. The opponent has made no claim that its earlier marks have acquired an enhanced degree of distinctive character, nor filed any evidence of use that may indicate such

an effect. My assessment of the degree of distinctive character of the earlier marks is therefore to be made only on the basis of their inherent features.

50. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

51. In my opinion, there may be a minority of average consumers who perceive the element BUFFALO in the earlier mark -838 as being purely descriptive or allusive of an ingredient in the goods at issue, and would ipso facto attribute all distinctiveness of the earlier mark to the element BLUE. However, I consider this to be a small minority of consumers, and in reality I believe the majority of respective average consumers would perceive the sign as hanging together to create the distinctive concept of a buffalo that is blue in colour. I therefore find the distinctive character of the earlier mark -838 to lie in the combination BLUE BUFFALO as a whole, the concept of which is distinctive to a medium degree. As to the earlier mark -166, the concept is that of a

running/leaping buffalo. As with the average consumer in relation to the earlier mark - 838, there may be some who find it to be indicative of a characteristic, but the majority will find it to be distinctive to a medium degree.

Likelihood of Confusion

52. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

53. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The factors include the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

54. In *Quelle AG v OHIM*, Case T-88/05, the General Court found that visual similarity (and difference) is most important in the case of case of goods that are self selected or where the consumer sees the mark when purchasing the goods. The Court stated that:

“68... If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs

(*NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 49).

69. Likewise, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (*BASS*, paragraph 56 supra, paragraph 55, and Case T-301/03 *Canali Ireland v OHIM – Canal Jean (CANAL JEAN CO. NEW YORK)* [2005] ECR II-2479, paragraph 55). That is the case with respect to the goods at issue here. Although the applicant states that it is a mail order company, it does not submit that its goods are sold outside normal distribution channels for clothing and shoes (shops) or without a visual assessment of them by the relevant consumer. Moreover, while oral communication in respect of the product and the trade mark is not excluded, the choice of an item of clothing or a pair of shoes is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion (*NLSPORT, NLJEANS, NLACTIVE and NLCollection*, paragraph 53 supra, paragraph 50). The same is true of catalogue selling, which involves as much as does shop selling a visual assessment of the item purchased by the consumer, whether clothing or shoes, and does not generally allow him to obtain the help of a sales assistant. Where a sales discussion by telephone is possible, it takes place usually only after the consumer has consulted the catalogue and seen the goods. The fact that those products may, in some circumstances, be the subject of discussion between consumers is therefore irrelevant, since, at the time of purchase, the goods in question and, therefore, the marks which are affixed to them are visually perceived by consumers.”

55. Following an assessment of the information provided by the parties as well as my own interpretation of the pertinent case law, I have found the average consumer to pay a medium degree of attention during the purchasing process, due in part to the fact that the goods at issue are relatively inexpensive, everyday consumer items. I have also identified that I consider the purchasing process to be predominantly a visual one, and so the visual similarity of the marks at issue, or lack thereof, is the most

pertinent consideration (although I am of course aware that all factors must be taken into account when making a global assessment). With that in mind, I have found the earlier mark -838 to be visually similar to the contested mark to only a low degree, whilst I have found the earlier mark -166 to have no visual similarity at all.

56. From a purely visual perspective, I consider it to be quite clear that the marks are very different. The earlier marks either contain only the words BLUE BUFFALO or only an image of a running/leaping buffalo, whilst the contested mark contains a combination of figurative and verbal elements which, as have been analysed, are markedly different from those of the earlier marks. By comparing the marks on a global assessment, it appears to me to be self-evident that the inclusion of the additional verbal elements EST 1987, and THE CO., in conjunction with the addition of a distinctive red buffalo head/skull, neither of which have a counterpart in either of the earlier marks, create noticeable visual, aural⁴ and conceptual differences between the marks, to the extent that the average consumer is unlikely to directly confuse them. I therefore find there to be no likelihood of direct confusion.

57. Having found there to be no likelihood of direct confusion, I shall now consider the possibility of indirect confusion. It should be borne in mind that a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion.⁵ Further, there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.⁶

58. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

⁴ Whilst it is arguable that the elements EST 1987 and THE _ CO. are descriptive or at least allusive, that does not render them negligible or “aurally invisible”, and they must therefore be taken into consideration.

⁵ In *Liverpool Gin Distillery Limited v Sazerac Brands LLC [2021] EWCH Civ 2017*, paragraph 13, Arnold LJ approved this “consolation prize statement” as made by James Mellor QC’s (sitting as the Appointed Person) statement in *Cheeky Italian Ltd v Sutaria (O/219/16)* paragraph 16.

⁶ *Ibid*, Arnold LJ’s words at paragraph 13.

other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

59. In *L&D SA v OHIM* [2008] E.T.M.R. 62, the Court of Justice of the European Union stated that:

“55 Furthermore, inasmuch as L & D further submits that the assessment of the Court of First Instance, according to which the silhouette of a fir tree plays a predominant role in the ARBRE MAGIQUE mark, diverges from the case-law of the Court of Justice, it need only be stated that, contrary to what the appellant

asserts, that case-law does not in any way show that, in the case of mixed trade marks comprising both graphic and word elements, the word elements must systematically be regarded as dominant.”

60. In *Metamorfoza d.o.o. v EUIPO*, Case T-70/20, EU:T:2021:253 the General Court compared two figurative marks, both of which contained the words “Museum of Illusions”. In holding that the words were weakly distinctive and that they were no more dominant than the figurative elements, it pointed out that:

“57 According to the case-law, the public will not generally consider a descriptive or weakly distinctive element forming part of a composite mark to be the distinctive and dominant element in the overall impression conveyed by that mark (see judgment of 5 April 2006, *Madaus v OHIM – Optima Healthcare (ECHINAID)*, T-202/04, EU:T:2006:106, paragraph 54 and the case-law cited; judgment of 28 October 2009, *CureVac v OHIM – Qiagen (RNAiFect)*, T-80/08, EU:T:2009:416, paragraph 49).

58 It does not therefore automatically follow that, where a sign consists of both figurative and word elements, it is the word element which must always be considered to be dominant. In certain cases, in a composite sign, the figurative element may therefore rank at least equally with the word element (see, to that effect, judgment of 24 October 2018, *Grupo Orenes v EUIPO – Akamon Entertainment Millenium (Bingo VIVA! Slots)*, T-63/17, not published, EU:T:2018:716, paragraph 43 and the case-law cited”).

61. The contested mark is a combination mark, containing both verbal and figurative elements. I have previously considered whether a certain consumer would consider the element BUFFALO in THE BUFFALO CO. to be purely descriptive or at least allusive in relation to the goods at issue, and I ultimately decided that such a view would not be unanimous. The words THE BUFFALO CO. therefore certainly contribute to the overall impression of the contested mark. That having been said, I maintain the view that I consider the figurative element of a red buffalo head/skull to be the more dominant and distinctive element of the mark, due in part to its size and striking colour. This will especially be the perception for that group of consumers who do indeed dismiss the verbal elements as being descriptive or allusive. As the case law above

indicates, particularly *L&D SA v OHIM*, word elements are not automatically or systematically regarded as dominant, and I believe the immediate imprint in the mind of the consumer upon seeing the contested mark will be of the distinctive red buffalo head/skull.

-166

62. The buffalo head/skull is red, and is of a style and artistic impression which is drastically different from the black/colourless buffalo figure in earlier mark -166, which is a more true-to-life rendition. Comparing the two figurative elements, one is an accurate side view of an entire animal leaping or running, whilst the other is a frontal image of only part of the same animal, in red. I do not believe it is reasonable to assume that all renditions of the same animal are going to cause confusion in the mind of the consumer. I do not believe a real-life image of a lion would automatically be confused with an artistic rendition of only one part of its anatomy in the colour green, for example. I do not believe that the figurative elements in each mark could be considered to be a “common element”, as they are so visibly and conceptually different. It must also be considered that other than for a minority group of consumers, the additional word elements in the contested mark also possess a certain degree of distinctive character, and refer to a company called BUFFALO that was established in 1987. This additional information, which has no counterpart in the earlier marks, cannot, in my opinion, be considered to be part of an obvious or logical brand extension, and I do not think any reasonably well informed, circumspect and observant consumer would dismiss it as such.

63. I find the overall impression of the contested mark, created by its combination of distinctive figurative and verbal elements, to be significantly different from that of the earlier mark -166, which is limited to a running buffalo. As a result, I find that there is no likelihood of indirect confusion with the earlier mark -166.

-838

64. The earlier mark -838 does not have any figurative elements. It possesses the concept and overall impression of an entire buffalo that is blue in colour. In

comparison, the figurative image in the contested mark is the head/skull of a buffalo, that is clearly red. Both a blue buffalo and a red buffalo head/skull are fanciful, and are also quite distinct from one another. In my opinion, although the marks conceptually coincide insofar as they refer to or evoke a buffalo (or part thereof), they are nevertheless unique and different from one another due to the colour and body part of the animal. In addition, the contested mark has the concept of a company called BUFFALO established in 1987, which has no counterpart in the earlier mark.

65. The conceptual difference of a blue buffalo and the head/skull of a red fanciful buffalo in conjunction with a company called BUFFALO established in 1987 would likely offset any aural or visual similarities between the marks, which I have in any case previously found to be no more than medium and low respectively. It is important to bear in mind that the visual aspect is the most important for the purchasing process of the goods at issue, and the low degree of similarity in this regard is impactful in the assessment of a likelihood of confusion.

66. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This would be mere association rather than indirect confusion. The fact that the only common element the contested mark and earlier mark -838 share is the term BUFFALO is therefore not enough, in and of itself, to find indirect confusion. This is especially so in the mind of those consumers for whom the element could have a descriptive or allusive purpose.

67. The additional figurative element of a red head/skull in the contested mark, in combination with its additional verbal elements which are not aurally negligible, are not elements that could be considered non-distinctive (either independently or as a combination), and so they are not elements which one would expect to find in a sub-brand or brand extension, nor are they elements which are entirely logical and consistent with a brand extension. As a result, I find that there is no likelihood of indirect confusion with the earlier mark -838.

68. In my opinion, the overall impressions of each of the three marks are distinctive and different, one resting on the notion of a fanciful blue coloured buffalo, another on a running/leaping true-to-life buffalo, and the other on a red head/skull in conjunction with a company called BUFFALO established in 1987. In my opinion, any similarities are isolated and fleeting rather than a fair reflection of the overall impression of each mark, and would not, I argue, cause a consumer to conclude that the owners of the marks are in any way related. I therefore find there to be no likelihood of indirect confusion between the contested mark or either of the Opponent's earlier marks.

Costs

69. As the opposition has failed, the Applicant has been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. In the circumstances I award the applicant the sum of £850 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the statement of grounds and preparing a counterstatement	£250
Preparing submissions and considering the submissions in lieu	£600
Total	£850

I therefore order Blue Buffalo Enterprises to pay The Buffalo Co. Pet Company LTD the sum of £850. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 7th day of July 2022

Dafydd Collins, For the Registrar