

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2532892 (“THE DOGS”) BY SAKS
HAIR (HOLDINGS) LTD**

**AND IN THE MATTER OF OPPOSITION NO. 100293 THERETO BY THE LITTLE
WING TRADING COMPANY LIMITED**

**APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF MR
EDWARD SMITH FOR THE REGISTRAR, DATED 22 JUNE 2011**

DECISION


Introduction

1. This appeal concerns an opposition by The Little Wing Trading Company Limited (“**the Opponent**”) against an application made on 27 November 2009 by Saks Hair (Holdings) Ltd (“**the Applicant**”) to register the words THE DOGS as a trade mark in relation to a range of goods in Class 3 and services in Class 44 (“**the Application**”). By a decision issued on 22 June 2011 (“**the Decision**” – BL O-220-11), the Registrar’s Hearing Officer, Mr Edward Smith, rejected the opposition. The Opponent now appeals pursuant to section 76 of the Trade Marks Act 1994 (“**the Act**”).
2. The opposition was brought under section 5(2)(b) of the Act, based on the following four earlier trade marks:
 - (1) UK registration no. 2415346 for the word mark “Bulldog”, filed on 1 March 2006 and registered on 18 August 2006;
 - (2) UK registration no. 2426014 for the sign shown below, filed on 30 June 2006 and registered on 29 December 2006;



- (3) CTM registration no. 6014179 for the word mark BULLDOG, filed on 18 June 2007 and registered on 15 May 2008; and

- (4) CTM registration no. 6014195 for a sign that looks identical to the one shown under (2) above, except that it appears to be very dark brown (rather than black) on white, filed on 18 June 2007 and registered on 20 May 2008.
3. Section 5(2)(b) of the Act provides that a trade mark shall not be registered if because 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.
4. The marks to be compared in this case are:

Application	earlier trade marks
THE DOGS	Bulldog / BULLDOG or 

5. The specification of goods and services is the same for each of the earlier marks (subject to one minor difference mentioned below) and the opposition relates to the entire specification. So the comparison is between the following sets of goods and services:

Application	earlier trade marks
Class 3: Soaps, perfume, eau-de-cologne, toilet waters, essentials oils, shaving preparations, aftershave lotions, shaving foams, non-medicated preparations, (non-medicated bath salts, and bath oils), anti-perspirants; deodorants for personal use, depilatories, dentifrices, mouth washes; cosmetics, suntanning and suncreening preparations; preparations for the hair, shampoos, conditioners, hair lotions, hair sprays, non-medicated preparations for the care of the skin, hands, scalp and the body; skin cleansing preparations; creams and lotions for the skin; talcum powder; nail varnish and nail varnish removers nail preparations and artificial nails and adhesives therefor; preparations for	Class 3: Toiletries; body deodorant, anti-perspirants, shower gel; body wash, facial cleanser, facial scrub; facial wash, hand wash, soaps; skincare preparations; body moist* spray; spot sticks; moisturisers; body lotion, body moisturiser, facial moisturiser; shaving gel, shaving oil, shaving cream, shaving foam, shaving spritz, shaving soap, shaving stones; after-shave; after-shave gel, after-shave balm; hair removal preparations and creams, depilatory preparations, depilatory wax; hair care preparations; shampoo, conditioner, hair gel, hair wax, hair spritz, hairspray; perfumery; eau de toilette; essential oils; cosmetics; dentifrices; lip balm; moustache wax; cosmetic kits; sunscreen preparations.

<p>preparing such nails; artificial eyelashes and adhesives therefor.</p> <p>Class 44: Hairdressing and beauty salon services, beauty treatment services.</p>	<p>Class 5: Anti-bacterial and medicated face, hand and skin washes; medicated preparations for the face, hands and skin; abrasive fluids for dental use; abrasive materials for dental use (other than floss); abrasive media for dental purposes (other than floss); abrasive pads for dental use; abrasive paste for dental use; abrasive powder for dental use; abrasive substances for dental use (other than floss); abrasives (dental-); adhesion promoters for dental use; adhesive cements for dental use; adhesive compositions and preparations for dental use; adhesives for affixing dental prosthesis; adhesives for dental use; anti-microbial, antiseptic and medical mouthwash preparations (gargles) for oral hygiene purposes; colouring reagents for revealing dental plaque; cotton for dental purposes; dental bonding material; dental health gum (medicated); dental rinses, medicated; tablets for dental use in indicating tartar on the teeth.</p>
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(* Note that “body moist spray” is the wording used in all of the specifications for the earlier marks except for UK trade mark no. 2415346 which uses the term “body mist spray”, which I suspect was the intended description, but nothing turns on this.)

6. Both parties filed evidence and written submissions at first instance. Neither side requested a hearing so the Hearing Officer decided the matter on the papers.
7. However, on the appeal, both parties were represented: the Opponent by Guy Tritton, instructed by Forrester Ketley & Co.; and the Applicant by Fiona Clark, instructed by Ladas & Parry LLP. I received detailed arguments from both sides, both written and oral.

The Decision

8. The Decision took a conventional form. The Hearing Officer first set out the details of the Application and of the Opponent’s earlier marks. He then summarised the Opponent’s evidence, comprising a witness statement given by its co-founder and Managing Director, Simon Duffy, explaining the history of use of the earlier marks and exhibiting examples of them in use and press coverage of the BULLDOG brand of male grooming products. Mr Duffy also exhibited a document provided by the Applicant to the Opponent, which analysed the UK market for barbers and hairdressing salons for men and showed how “THE DOG’S” (sic.) might be presented in use. The “background and pleadings” section of the Decision ended by mentioning the Applicant’s evidence, comprising a witness statement from Graham Farrington, a trade mark attorney and partner of Ladas & Parry LLP, which exhibited the results of a search of trade marks having effect in the UK in Class 3 in respect of toiletry goods which contain the term DOG or DOGS. He recorded the

Applicant's concession that this was merely "state of the register evidence", intended to show that, as far as the Register is concerned, the Opponent does not have a monopoly in Class 3 of marks containing the word DOG or DOGS.

9. The Hearing Officer then set out the text of section 5(2)(b) and recorded the fact that none of the earlier trade marks were subject to the proof of use requirement under section 6A of the Act. He stated his view that the Opponent's best case would lie in respect of the word only mark, but that "for the avoidance of doubt" his overall finding would be the same whichever mark was relied on. He mentioned that the device mark appeared to be in a different colour on the OHIM register from the UK register, but that this made no difference. From my own examination of the two images, the UK mark is in black and white while the CTM is arguably very dark brown and white. I suspect that this may simply reflect the use of a different scan of the same mark. However, nothing turns on this. I agree that the word marks are the ones to focus on.
10. At paragraph 28 of the Decision, the Hearing Officer set out the summary of the guidance from case law of the Court of Justice of the European Union ("CJEU") that has been developed by the Registry and approved by the Court of Appeal in *Specsavers v Asda* [2012] FSR 19 at [52], in relation to the principles that apply to the global assessment of the likelihood of confusion. There is no disagreement as to these, and it is not necessary for me to repeat them here.
11. In relation to the notional "average consumer" through whose eyes the likelihood of confusion must be judged, and the nature of his purchase, the Hearing Officer stated the following:
 29. The average consumer for Wing's products will be the general, toiletry buying, public. They are not specialist items and are bought from a range of retail outlets, including supermarkets, chemists and small retail shops. In general they are low cost items and may not receive the highest level of attention in the purchase. Certain of the items, notably connected with shaving, may be regarded as being gender specific but others would be bought by either sex.
 30. The average consumer for Saks goods and services will also be the general public. In their case, the specification also includes the services in Class 44 but these are not specialist technical services, but services one may expect in almost every high street or indeed, offered on a mobile basis. Nonetheless, I think it fair to say that hairdressing services may often engender a degree of personal loyalty such that casual and purely opportunistic access is, if not entirely unlikely, then less likely than a more considered access.
 31. These observations will be factored into my considerations below, as and when appropriate.
12. The Hearing Officer then compared the goods and services covered by the parties' respective trade mark registrations and application, first setting out the applicable

case law and principles, which are not in issue on this appeal and so I do not repeat them. He concluded that the goods covered by the Application in Class 3 were identical to those covered by the earlier trade marks, because they either matched them directly or they comprised goods that fell within a broader category of goods listed in the specification for the earlier mark. In relation to the services covered by the Application in Class 44, he concluded that they were similar to the hair care products, such as hair gel or hairspray, in the Opponent's specification. These findings are not contested on appeal.

13. Before comparing the marks, the Hearing Officer recorded (at paragraph 39) that it was clear from the case law that he had to “undertake a full comparison (taking account of visual, phonetic and conceptual similarities and dissimilarities), from the perspective of the average consumer” and that “Both marks need to be considered in their totalities and overall impression ..., taking account of distinctive and dominant elements”.
14. On the visual comparison, which is not contested by the Opponent, the Hearing Officer concluded that both pairs of marks (i.e. THE DOGS v BULLDOG and THE DOGS v the earlier device mark) are “similar to a moderate degree”, taking the similarities and dissimilarities into account (paragraphs 40-41).
15. On the phonetic comparison, which again is not contested, the Hearing Officer concluded that the respective marks “share a moderate degree of phonetic similarity” (paragraph 42).
16. The conceptual comparison is under the microscope in the appeal and therefore I set out the Hearing Officer's analysis verbatim, as follows:

43. By conceptual similarity, it is meant ‘semantic’ conceptual similarity and it is under this head that the parties’ positions most obviously diverge. Plainly, both Wing’s device and word marks invoke a particular breed of dog, the bulldog. Wing’s position is that the ‘the’ element in Saks’ mark is entirely ‘devoid of distinctive character’ and thus has ‘no effect on the overall conceptual character of the mark’. Saks’ position is that the definite article, ‘the’, cannot be ignored or downplayed. It is important to also recognise that the plural of dog is used, as in “dogs”. Saks’ says the term, ‘the dogs’, may lead, in the average consumers’ mind to a number of alternative allusions or connotations. In everyday vernacular language the term, ‘the dogs’ is used to describe greyhounds taking part in greyhound racing. Alternatively, the term ‘the dogs’ could be seen as a shortened version or abbreviation of the vulgar term, ‘the dogs testicles’ or ‘bollocks’. Finally, the term ‘the dogs’ could also be seen as a shortened version of ‘going to the dogs’, as in a deterioration of something.

44. I agree with Saks’ that neither the definite article nor the pluralised version can be ignored or otherwise downplayed in the totality of its mark. On that basis, I believe that it is likely the average consumer will see any one or combination of the allusions referred to by Saks, since they are, and I accept them to be, based in everyday language. None of those specific allusions are shared by Wing’s mark. Wing’s mark,

'Bulldog', imparts allusions of 'Britishness' ('British Bulldog'), being a specific breed of dog famed for being sturdy and thick set, perhaps fierce even.

45. Insofar then as both parties' marks have general canine origin or allusion, they can be said to be conceptually similar, but that is as far as it goes. Saks' mark has, as I have said, additional possible allusions based upon everyday language. On that basis I find that the respective marks are conceptually similar but only at a high level of generality and thus to a low degree.

17. Moving on to the assessment of overall similarity, the Hearing Officer reiterated that the marks each had to be "analysed in their totalities". In particular, he stated his view that, in the Application, "the definite article, THE is not an independent element in the term THE DOGS, but contributes to the 'whole' (paragraph 48) but he rejected the Opponent's submission that the THE is "insignificant" in the mark applied for, such that its presence may go unnoticed by the average consumer.

18. Before reaching his conclusion on overall similarity, the Hearing Officer stated:

50. As regards the particular mode of selection of these goods and services and the question whether visual or aural processes may predominate and thus the overall assessment needs to be weighted in some way, it is likely that visual selection be the most common. Many of the products are the subject of self selection. This is not to say that aural selection will be totally absent, it is likely for example that hairdressing and beauty salons for example may be recommended aurally.

19. He then concluded:

51. In all the circumstances, and taking the visual, aural and conceptual assessments overall, I find the respective marks share a low to moderate degree of similarity.

20. The last section of the Decision is headed "*Likelihood of confusion*" and comprises a detailed and quite lengthy (eight paragraph) summary of the Hearing Officer's reasoning on this overall issue.

21. First, he looked at the distinctive character of the earlier trade marks. He remarked that none of the qualities attributed to the bulldog breed of dog (as discussed at paragraph 44 of the Decision, reproduced above) resonate any particular connection to hair products or toiletries. Therefore, viewed "purely on an *inherent* basis", the earlier marks were all "inherently distinctive, at least to an above average level" (paragraph 53).

22. As far as the alleged acquired distinctiveness of the earlier marks was concerned, the Hearing Officer said:

54. The evidence establishes that prior to November 2009 (being the material date of filing), the earlier marks had garnered a large measure of mainstream and niche press attention. Some of that attention being focussed upon the nature of the business, in particular its start-up nature, but also the nature and quality of the product, chiming as it apparently has with an increased interest in male grooming and natural products. The products are stocked in several very large supermarkets and there have also been

awards and trade exhibitions. Against that, the overall sales figures of £2,000,000 between 2007/08 and 2009/10 do not appear to be huge. To make the case for enhanced distinctiveness, I would have expected Wings to put their sales figures into an overall context of the total UK market. It has not done so and so the case is somewhat diminished as a result. It must also be remembered that Wings only started up in 2006 and has only had under four years exposure of its mark. Balancing all these factors, I have not been persuaded that Wing can rely on an enhanced level of distinctiveness through use at the date of the opposed application. I may just mention that even if I had been persuaded there was an enhanced level of distinctiveness, it would not have made any difference to my overall conclusion of likelihood of confusion.

23. The Hearing Officer mentioned two matters that he did not take into account in his overall assessment, being the exhibit relating to the Applicant's intended use of their mark alongside phrases and slogans some of which were also used by the Opponent, and the Applicant's evidence of the state of the Register, since this did not necessarily reflect the conditions of the market place (paragraphs 55-56).

24. He summed up his conclusions as follows:

57. So, I have found that the respective goods in Class 3 are identical. The services in Class 43 are similar. I have found the earlier marks to be distinctive on an above average level and that this level of distinctiveness is not enhanced through use. I have made observations on the respective average consumers, namely that they are also identical and I have found the purchasing process not to be particularly considered. Finally, I have found the respective marks to share a moderate to low degree of similarity overall. Needless to say that in making a global assessment, it is not a 'tick box' exercise, whereby if I find more factors in Wing's favour, it wins. All factors must be weighed in the evaluation of likelihood of confusion.

58. Taking all the relevant factors into account, including of course the doctrine of 'imperfect recollection' whereby marks are not to be considered side by side, I find there will be no likelihood of confusion in this case. In particular, I consider the conceptual analysis to be of some significance and the only connection to be of general canine origin or allusion is something of a telling factor, but as I have said, this is not to ignore or downplay in any way, all the other factors.

25. Accordingly, he rejected the opposition and ordered the Opponent to pay the Applicant £1,200 as a contribution towards its costs of defending the opposition.

Approach to this Appeal

26. As the parties both agree, the role of the Appointed Person is to review the Decision, not to re-hear the case. I should show "a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle": *REEF Trade Mark* [2002] EWCA Civ 763, [2003] RPC 5 at [28]. A decision does not contain an error of principle merely because it could have been better expressed.

27. I bear in mind the observation of Daniel Alexander QC (sitting as a Deputy High Court Judge) in *Digipos Store Solutions Group Ltd v Digi International Inc.* [2008] EWHC 3371 (Ch) at [6] that:

In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference.

28. As Floyd J (as he then was) said in *Galileo International Technology, LLC v European Union (formerly European Community)* [2011] EWHC 35 (Ch) at [14]:

... unless I am satisfied that the Hearing Officer made an error of principle, I should be reluctant to interfere. I should interfere if I consider that his decision is clearly wrong, for example if I consider that he has drawn inferences which cannot properly be drawn, or has otherwise reached an unreasonable conclusion. I should not interfere if his decision is one which he was properly entitled to reach on the material before him.

Grounds of Appeal

29. The Opponent submitted a lengthy statement of grounds with its Notice of appeal, which made wide-ranging criticisms of the Hearing Officers' reasoning. It is easiest to set out first the matters which were not specifically criticised, which were:

- (1) the findings in relation to identity and similarity of goods and services;
- (2) the identity of the relevant average consumer;
- (3) the assessment of the visual similarity of the marks in issue; and
- (4) the assessment of the aural similarity of the marks.

30. That leaves matters raised in relation to:

- (1) the conceptual similarity of the marks in issue;
- (2) the overall similarity of the marks in issue;
- (3) the inherent distinctiveness of the earlier marks;
- (4) the acquired distinctiveness of the earlier marks; and
- (5) the overall assessment of the likelihood of confusion.

31. Mr Tritton stressed in his skeleton argument and oral submission that at the heart of the appeal was the contention that the Hearing Officer failed to recognise that there were three key facts which militated strongly in favour of a finding of likelihood of confusion:

- (1) that BULLDOG is inherently very distinctive *in relation to the goods for which it is registered*;
- (2) that the marks are conceptually very similar as well as being moderately visually and aurally similar; and
- (3) that the goods are identical.

32. I shall pick up the detailed grounds raised and the submissions made in the skeleton argument and at the hearing as I consider each of the five areas of contention in turn.

(1) Conceptual similarity of marks

33. The Opponent criticised the Hearing Officer’s analysis of conceptual similarity as set out at paragraphs 43-45 of the Decision (which I have set out at 16 above), arguing that he got diverted from the obvious conceptual linkage that both marks have ‘canine connotations’ when he suggested that the Mark could refer to a shortened version of the vulgar term, ‘the dogs testicles’ or ‘bollocks’, or alternatively ‘going to the dogs’, and that he artificially dissected the Mark into its component parts THE and DOGS.
34. The point being made by the Hearing Officer was that he was not comparing BULLDOG with just DOG or DOGS, but THE DOGS, and that the definite article, THE, would not be ignored by the average consumer and would potentially lead to additional or alternative connotations to just DOG or DOGS. In doing so I do not believe that he dissected the Mark; on the contrary, he considered the meaning of THE DOGS as a whole, as he was meant to do. Whether many people would think of any of the expressions mentioned above when faced with the Mark is not clear to me, though I would not say that the Hearing Officer was wrong to consider them. The connotation of greyhound racing, which the Hearing Officer also considered would appear to me more likely. Overall, however, while he found that the average consumer would see “any one or a combination of the allusions” referred to, he plainly did not miss the common canine connotation, since he said at paragraph 45: “Insofar as both parties’ marks have general canine origin or allusion, they can be said to be conceptually similar...”.
35. The Opponent suggested that the Hearing Officer should have applied the logic of the CJEU in Case C-191/01 P *Wrigley v OHIM (DOUBLEMINT)* [2003] ECR I-12447 in which the Court held that a sign would be considered descriptive if at least one of its meanings is descriptive. In other words, if one of the possible meanings of a mark applied for is the same as one of the possible meanings of an earlier mark relied on to oppose it, the assessment of conceptual similarity should be based on that common meaning. I do not believe that the CJEU would have intended its decision in *DOUBLEMINT* to be applied in this way. There, the Court was

considering the bar to registration of signs that are descriptive of the goods or services for which they are applied, pursuant to article 7(1)(c) of Regulation No. 40/94/EC (now Regulation No. 207/2009/EC on the Community trade mark, and equivalent to section 3(1)(c) of the Act). The purpose of that provision is to prevent the registration of signs that should be left available for use by other traders to describe the relevant goods or services. The test under section 5(2)(b), on the other hand, deals with a completely different question of the impact on the average consumer of the two marks that are under comparison. I do not see any reason why it would be appropriate to restrict that assessment to just one possible meaning of each mark, which happens to support one or other party's case, if the average consumer is likely to perceive others. The common meaning, if there is one, should of course be taken into account, but other likely concepts should not be ignored. In any event, as I have already indicated, there is no doubt that the Hearing Officer did appreciate the common canine concept of both parties' marks.

36. In his arguments about conceptual similarity, Mr Tritton stressed that this should have been found to have been far higher because of the fact that none of the goods or services covered by either of the marks have anything to do with dogs. Therefore, the canine allusion of each mark would be particularly noticeable. However, that is a point which only comes into play when considering the overall assessment of the combined effect of the respective similarities of the marks and the goods/services. At the first stage of considering the similarity of the marks, the matter is judged by reference to the respective marks only, without consideration of the goods/services to which they will be applied. While this may be a slightly artificial exercise, it is one that is conventionally conducted as one of the two steps (similarity of goods/services being the other step) to test the suggestion that confusion might occur, before looking at the overall assessment of whether confusion is likely given the respective similarities of both marks and goods/services. The Hearing Officer cannot be criticised for taking the usual step by step approach.
37. I doubt if the Hearing Officer's finding at this point would have been any different, even if he had ignored the specific alternative connotations of THE DOGS that the Applicant suggested. Given that the Opponent's earlier marks plainly connote a particular breed of dog, emphasised in the case of the device marks by the image of a bulldog's head, and that THE DOGS – if taken as a literal reference to dogs – either refers to greyhounds (because of the common use of “the dogs” to refer to greyhound racing) or refers to a collection of dogs of unspecified breed, it was perfectly reasonable for the Hearing Officer to find similarity “only at a high level of generality and thus to a low degree”. Another hearing officer might perhaps have increased this to a moderate level of similarity, but Mr Smith's approach was plainly within the range that could reasonably be taken and he has made no obvious error that would justify re-assessing the matter.

(2) Overall similarity of marks

38. By the time of the hearing, the Opponent's main objection in relation to the Hearing Officer's assessment of overall similarity of the parties' marks was based on the objection to his finding of only a low degree of conceptual similarity. In Mr Tritton's submission, had the Hearing Officer found the conceptual similarity to be high, then – when combined with his findings of moderate visual and aural similarity – the overall similarity would have been found to be moderate to high, rather than (as he found at paragraph 51) “low to moderate”. Having failed to persuade me that the Hearing Officer was wrong in relation to conceptual similarity, this argument inevitably fails.
39. Although not pursued at the hearing, in the Statement of Grounds the Opponent had also suggested that the Hearing Officer's conclusion of overall “low to moderate” similarity was mistaken because he found the marks to be “moderately similar” in two out of the three specific assessments of visual, aural and conceptual similarity, and therefore the finding of a “low degree” of similarity should not have brought the overall assessment down. I reject this criticism. As the Hearing Officer said at paragraph 57 of the decision, this is not a “tick box exercise” where one counts up the factors in one side's favour over the other. It is an overall assessment in which the Hearing Officer balances a variety of factors that may not have equal weight. His finding of low to moderate similarity of the marks was well within the bounds of reasonableness and accordingly this ground fails.

(3) Inherent distinctiveness of BULLDOG

40. Mr Tritton's argument about inherent distinctiveness of the earlier marks *in relation to the goods for which they are registered* properly belongs here. He submitted that the word BULLDOG and the device mark is “very distinctive” for such goods. But, even if I were to agree with him, he needed to persuade me that the Hearing Officer had erred in some way, or made an unreasonable finding, in his own assessment. He tried to do this by pointing out that the Hearing Officer seemed to assume that the word BULLDOG could not be considered of very high distinctiveness because it was not an invented word, like KODAK; whereas – in the context of the goods that were completely unrelated to bulldogs – BULLDOG was, in his submission, as distinctive as an invented word like KODAK could be.
41. I do not take the Hearing Officer's comments in relation to KODAK and BULLDOG as saying that a word with a real meaning could never be held to be as distinctive as an invented word. And, even if he had done so, I do not need to make a finding about that myself, since all he actually did was to mention KODAK as an

example of a very distinctive word when setting the scene for his consideration of the earlier marks. He expressly took into account the point Mr Tritton made about bulldogs having no particular connection with hair products and toiletries (see paragraph 53 of the Decision), which operated in the Opponent's favour, resulting in his finding that the earlier marks were "inherently distinctive at least to an above average level".

42. Mr Tritton asserted that there is no difference between the inherent distinctiveness of BULLDOG in relation to the goods in Classes 3 and 5 for which it is registered and the inherent distinctiveness of KODAK for photographic films or cameras. That is a matter of opinion, and it is an opinion on which the Hearing Officer differed. He was perfectly entitled to differ, as long as he took the correct approach, which I find that he did.

(4) Acquired distinctiveness of BULLDOG

43. In the Statement of Grounds the Opponent asserts that the Hearing Officer did not give enough weight to the Opponent's evidence, particularly as to its level of sales, range of retail stockists and press coverage. It also criticises the Hearing Officer's comment that he "would have expected [the Opponent] to put their sales figures into an overall context of the total UK market", stating that this is not a requirement laid down by statute or in the case law.
44. Dealing with the last point first, while it is not a statutory requirement to submit evidence to put sales figures in context in order to establish enhanced distinctiveness through use, there is no doubt that this can be helpful, and indeed this has been expressly suggested by the CJEU in a number of cases, most clearly in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee Produktions- und Vertriebs GmbH v Franz Attenberger* [1999] ECR I-02779. There, the Court said (at [49]) that "in determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings". It went on to say (emphasis added):

51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

45. Thus the Hearing Officer was quite right to say that evidence to put the Opponent's sales figures into context would have been helpful. In doing so, he did not ignore the

rest of the evidence, but simply was unpersuaded that it was enough to establish enhanced distinctiveness.

46. Mr Tritton did not deal with the evidence of use in any detail at the hearing, and dealt with it only very briefly in his skeleton. His essential point was that, to the extent that the earlier marks were not “100% distinctive” inherently, then perhaps they could be said to have been 90% distinctive, with the remaining 10% made up with the help of the evidence of use. On behalf of the Applicant, Ms Clark pointed out that some of the evidence of use post-dated the filing date for the Application. She also highlighted the fact that most of the prominent examples of press coverage of the Opponent’s BULLDOG brand showed images of the earlier device marks in use, rather than just the word marks, thus enhancing the “butch imagery” which was not shared by the Applicant’s mark.

47. I confess that, having gone through the evidence of use and press coverage myself, I found it slightly surprising that the Hearing Officer did not find the evidence of use sufficient to establish some level of enhanced distinctiveness due to the likely exposure of the relevant average consumer to the earlier marks. However, he plainly read the evidence, summarising it in some detail, and its quantity and impact was not such that I could say his conclusion was an unreasonable one. Further, the Opponent itself did not appear unduly surprised as to his assessment and, as I say, did not press this point on appeal to any significant extent.

48. Further, the Hearing Officer expressly made the point that, “even if I had been persuaded there was an enhanced level of distinctiveness, it would not have made any difference to my overall conclusion of likelihood of confusion”. Given that he had already found that the earlier marks already had above average inherent distinctiveness, this is not surprising. Had I been deciding the case, and made a finding of enhanced distinctiveness, I too would have come out with the same final result.

(5) Overall assessment of likelihood of confusion

49. The Opponent’s primary objection to the Hearing Officer’s overall assessment of the likelihood of confusion was that it was based on incorrect findings in relation to conceptual similarity (and thus overall similarity) and the distinctiveness of the earlier marks. Having decided not to interfere with those aspects of the Decision, this ground of appeal gives me no basis for interfering with the overall assessment either.

50. The Opponent made two additional specific points:

- (1) first, it said that the doctrine of imperfect recollection had not been properly factored into the decision; and

(2) secondly, it argued that the Hearing Officer was wrong to ignore the evidence about the Applicant's intended use of its mark.

51. On the first point, Mr Tritton argued that imperfect recollection was likely to mean that a consumer who had seen one of the earlier marks would have the general concept of dogs lodged in his mind, which would effectively be sparked off when faced with the mark THE DOGS on identical or similar products at a later date.

52. This was a submission that the Hearing Officer had plainly taken into account, given his earlier finding that both parties' marks "have general canine origin or allusion", and his repetition of that point in his concluding paragraph 58. He also expressly referred to the doctrine of imperfect recollection in the same paragraph. So I cannot agree with the Opponent's submission.

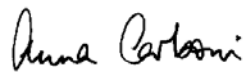
53. As to the evidence of how the Applicant might use its mark, the Opponent contended that exhibit SD9 showed that the Applicant intended to reinforce the canine allusion engendered by its mark by presenting it alongside statements like, "a man's best friend", which in turn reinforced the conceptual similarity of the two parties' marks and the fact that the Hearing Officer should have ignored the alternative allusions of THE DOGS (i.e. "the dogs' bollocks" or "going to the dogs"). In my view, the Hearing Officer was correct to ignore this piece of evidence in assessing the overall likelihood of confusion. This was a presentation of the Applicant's branding ideas, which dated from a stage when it had five possible alternative brands for a men's hairdressing salon (the other four having nothing to do with dogs). It did not even show the mark applied for, since the presentation was a stylised version of "THE DOG'S" (i.e. with the addition of an apostrophe in "DOG'S").

54. Indeed, Mr Tritton expressly stated at the hearing, "I am not asking you to consider anything other than the mark applied for when considering the question of what the mark is"; he thus effectively revised the point in the written grounds to say that, if one of the likely ways of using the mark would emphasise the canine allusion, then the fact that this coincided with the allusion of the earlier marks should lead to a finding of high conceptual similarity and this increase the likelihood of confusion. As I have already indicated, I believe that the Hearing Officer took all of the relevant factors into account in conducting the necessary global assessment of the marks, the goods/services and the materials before him, and that he did not fall into error in the way that he did this.

Conclusion

55. In conclusion, I reject the Opponent's appeal and will order that the Application should proceed to registration.

56. The Opponent's appeal having failed, I shall leave the Hearing Officer's decision as to costs in place: the Opponent to make a contribution of £1,200 towards the Applicant's costs. In addition, I order the Opponent to pay a contribution to the Applicant's appeal costs of £1,000. The combined sum of £2,200 will be payable within 14 days.



ANNA CARBONI

28 June 2013

The Appellant (Opponent) was represented by Counsel, Mr Guy Tritton, instructed by Forrester Ketley & Co.

The Respondent (Applicant) was represented by Counsel, Ms Fiona Clark, instructed by Ladas & Parry LLP.