

O-256-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2539534
BY
DAPPOPINNS LIMITED
TO REGISTER THE TRADE MARK**



IN CLASS 43

AND

**THE OPPOSITION THERETO
UNDER NO 100671
BY
SOTERIS PAPACAOULLAS**

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**In the matter of application 2539534
by DAPPOPINNS Limited
to register the trade mark:**



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under no 100671
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1. On 18 February 2010, DAPPOPINNS Limited (“the applicant”) applied to register the above trade mark for *Restaurant, catering and bar services specialising in the provision of Mexican food and beverages including burritos, fries, jacket potatoes, deserts, milkshakes, juice and coffee*. These goods are in class 43¹. The application was published on 26 March 2010 in the *Trade Marks Journal*.

2. Mr Soteris Papacaoullas² filed notice of opposition to the trade mark application, claiming that registration would be contrary to sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (the Act). He relies upon the following trade mark for both these grounds:

2526274

Papas
Papa’s

(a series of 2 marks)

¹ As per the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

² There was some confusion within the Intellectual Property Office at the pleadings stage as to the name which should appear on the notice of opposition. This was not challenged by the applicant. For the sake of good order, I hereby invoke rule 74 of the Trade Mark Rules 2008: the name of the opponent is Soteris Papacaoullas; it is he who signed Form TM7 and is the proprietor of record for the earlier trade mark and who filed evidence in the proceedings.

Class 43: *Restaurant services and takeaway services specialising in fish and chips.*

3. Mr Papacaoullas' mark was applied for on 17 September 2009 and its registration procedure was completed on 8 January 2010: consequently this is an earlier trade mark which is not subject to proof of use³ because at the date of publication of the application it had been registered for less than five years.

4. Section 5(2)(b) of the Act states:

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

....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Some of Mr Papacaoullas' claims under this ground are framed in language associated with sections 5(3) and 5(4)(a) of the Act (he has referred to passing off, reputation and jeopardy thereof, unfair advantage and misrepresentation). The main points of Mr Papacaoullas' claims which fit section 5(2)(b) more clearly are that:

(i) The establishments protected by his mark provide an identical service to the applicant, also providing identical goods (“fries, jacket potatoes, deserts, milkshake, fruit juice, coffee as well as Mexican food”) in both his restaurants and takeaways.

(ii) Taking the identity of services into account, confusion is extremely likely because the marks are extremely similar, his trade mark being contained within the applicant's trade mark. The additional “Da” is insignificant and it is common knowledge that “Da” means “The”. Mr Papacaoullas claims that he assumes his customers refer to his establishments as “the papa's”.

(iii) He also fears “that the consumer will assume it is our own brand diversifying into Mexican cuisine especially because our registered trade mark is associated with Mexican food because it is offered in our establishments”.

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

5. Section 5(3) of the Act states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

Mr Papacaoullas states:

“The earlier mark has been used for restaurants and takeaways since 1966, and therefore has developed a strong reputation with consumers. This has developed over a long period of time and now serves our establishments well against competitors. It is reasonable to believe that the applicant will unfairly utilise the reputation we have developed with consumers who misinterpret the extremely similar marks. This may also be detrimental to our own establishments in terms of competition and also in quality of goods and service provided. Our reputation may be damaged as a result of poor goods and services which is reasonably foreseeable to assume consumers will associate with our brand and trade mark. This could have a detrimental affect on the establishments we already own as well as new establishments in the foreseeable future, with aims of expansion.”

The heads of damage pleaded are therefore unfair advantage and detriment to the distinctive character and repute of the earlier trade mark.

6. The applicant filed a counterstatement, denying a likelihood of confusion, and highlighting the presence of the chilli pepper in its mark, together with the fact that Mr Papacaoullas' mark consists of a single word. It also points out that the specialisms of each party's service (fish and chips against Mexican food) are different. The applicant also denies that its mark is identical with or similar to an earlier mark which has a reputation.

7. Only Mr Papacaoullas filed evidence and written submissions; the applicant filed nothing beyond its counterstatement. Neither side asked for a hearing, Mr Papacaoullas being content for a decision to be made from the papers on file (the applicant did not respond regarding the choice of a hearing or a decision from the papers).

Evidence

8. Mr Papacaoullas has filed a witness statement dated 2 December 2010. He owns the earlier trade mark which he has licensed to Papa's Fish and Chips, a company which he also owns. The evidence comes from his personal knowledge.

9. The first PAPA'S fish and chip shop restaurant opened in Margate, Kent in 1966. Mr Papacaoullas states that, since then, the company and number of restaurants owned by the company has grown in both size and reputation; in support of this statement, Mr Papacaoullas exhibits the following:

(i) undated web-shots from the website papasfishandchips.com which shows single restaurants in Worksop, Gainsborough, Colchester, Ditton (Kent), Rochester, Folkestone and Weston-Super-Mare. This totals seven restaurants.

(ii) an undated web-shot from the website papasukltd.com, which Mr Papacaoullas states is part of the same restaurant group licensed to use the mark PAPA'S, showing a "Good Eating Guide 2004-2007" certificate of Outstanding Achievement awarded to PAPA'S restaurants.

(iii) a similar undated webshot from the same website in respect of a "Quality Cuisine Guide 2004-2007" certificate awarded to PAPA'S restaurants.

(iv) an undated webshot from the same website showing an oblique photograph of a magazine cover called Somerset Life and what Mr Papacaoullas states is an article in that magazine about PAPA'S restaurants. There is no reference to the date of this article and it is not possible to read it from the exhibit. It is possible to see a picture of PAPA'S signage in a photograph contained within the (unreadable) article. Mr Papacaoullas states that the magazine has a wide readership.

(v) a web-shot which says "Copyright SomersetFood 2007" showing an article entitled Somersetfood.org containing reviews of various restaurants in Weston-Super-Mare, the first of which is for "Papas" fish and chips. It includes the following: "The food was as good as ever, both fish and chips cooked to perfection. Behind the scenes the kitchen was spotless, well deserving of the 5 star 'scores on the doors' award they have recently been awarded."

10. The written submissions filed with Mr Papacaoullas' evidence are from Mr Paul Misselbrook, of Appleyard Lees, the firm of trade mark attorneys representing Mr Papacaoullas in these proceedings. I will not include them here but I will, of course, bear them in mind in reaching my decision.

Decision

11. The leading authorities which guide me in this ground are from the Court of Justice of the European Union (CJEU): *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, *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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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 of the average consumer for the goods/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 therefore 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) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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*,

(k) further, 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*,

(l) but 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*.

Comparison of services

12. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* where the CJEU stated at paragraph 23 of its judgment:

“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.”

The criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 for assessing similarity between goods and services were:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;

- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

When considering the coverage of services, I bear in mind *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16, in which Jacob J⁴ held that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

13. Both parties have framed the wording of their specifications using the word ‘specialising’. Mr Papacaoullas’ specification is *restaurant services and takeaway services specialising in fish and chips*. Using the word ‘specialising’ does not have the same limiting effect as ‘namely’, or ‘all in the nature of’. Restaurants and takeaways may specialise in a certain type of food but that is not to say that the customer can only buy that particular type of food on the premises. Mr Papacaoullas’ specification is to be interpreted as having cover for restaurant and takeaway services *per se*. These comments also apply to the applicant’s specification. The applicant’s specification is to be interpreted as covering *restaurant, catering and bar services* at large. As both parties have cover for *restaurant services* these services are identical. Takeaway services are often provided as an element of a restaurant’s business as an alternative to eating the food in-house. The users, channels of trade and purpose will be the same and the services are in competition (the choice being whether to sit in the restaurant or take the food elsewhere to consume). Restaurant services are highly similar to takeaway services. Many bars now provide a full food menu so that the consumer has the choice whether to go to a restaurant, where the emphasis is on having a meal, or to go to a bar where they can purchase a meal as well as drinks. The two services are in competition, share the same users, purpose, method of use and nature (places to eat and drink). Restaurant services and bar services are highly similar.

14. Catering and takeaways are both in the nature of services which provide food. Their purpose, channels of trade and users will be very close in the case,

⁴ Jacob J also said, in *Treat*: “When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade”.

for example, of outside catering at music festivals, fêtes and the like, where a variety of fast/takeaway food and drink is on offer. The two will be in competition. Catering services and takeaway services are highly similar.

15. To re-cap, the restaurant services of the applicant are identical to those of Mr Papacaoullas, and its other services are highly similar to those of Mr Papacaoullas.


Average consumer and the purchasing process

16. The average consumer for food and drink services is the general public. Depending on the nature of the food and drink establishment, the type of food sold and the prices charged, the attention of the consumer will vary. For example, a quick dash into a takeaway will not cause the same level of attention to be paid as choosing to dine at an expensive restaurant. These are two extremes in a wide variety of types of food and drink provision. In the main, the purchaser will pay a reasonable amount but not the highest amount of attention. The purchasing process will be primarily visual, but oral use of the mark may also play a part.

Comparison of trade marks

17. The authorities direct that, in making a comparison between the marks, I must have regard to each mark’s visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

18. The marks to be compared are:

Mr Papacaoullas’ mark	Application
<p style="text-align: center;">Papas Papa’s</p>	

19. Mr Papacaoullas’ registration is for a series of two marks. Although the spelling is identical, the second of these has a possessive apostrophe which is absent from the first mark. The comparable element of the application also

contains the possessive apostrophe; owing to the presence of the apostrophe, the second mark in Mr Papacaoullas' registration represents the strongest case. I will therefore make the comparison on the basis of the second mark in the series.

20. Mr Papacaoullas' mark consists of a single component which does not separate into distinctive and dominant components. The application consists of the words DA PAPA'S, the 'DA' appearing above PAPA'S, and a device of a chilli, positioned in the top right-hand corner of a roughly drawn rectangular border within which the word and device elements are contained. PAPA'S takes up the greater portion of the mark. The chilli is less dominant than the word element and, in the context of the services, less distinctive. The DA letters are positioned in the top left-hand corner of the mark, whereas the PAPA'S element fills half of the mark. The PAPA'S element is more dominant and distinctive than the remainder of the elements making up the mark as a whole.

21. Although the other elements are not negligible (the 'DA' and the chilli), the single component of Mr Papacaoullas' mark is contained in the applicant's mark as the more dominant and distinctive component of that mark. This reproduction of PAPA'S creates a reasonably high level of similarity between the marks. Aurally, PAPA'S could be pronounced in an Anglophone style: puh-par's, with the stress on the second syllable; alternatively, it could be pronounced in a more Continental style: pa-pa's, with equal stress on each syllable. The presence of the 'DA' means that the marks are not phonetically identical (this element being absent from the earlier mark), but they are highly similar, because the pronunciation of the common element – PAPA - in each mark is the same and because the DA element does not make much difference to the aural impression. Conceptually, the marks both equate to 'Father's'. Although 'papa' is not an everyday way of referring to father ('Dad' being the common form of expression in the UK), I believe the majority of the UK public would still grasp immediately the 'father' meaning. The marks are highly similar from a conceptual point of view. The presence of the DA and the chilli contribute to a Mediterranean/Latin-American impression in the application but the 'father' meaning is the dominant concept. Overall, the parties' marks are highly similar.

Distinctiveness of Mr Papacaoullas's mark

22. It is necessary to consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁵. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public⁶. Mr Papacaoullas' evidence shows seven fish and chip restaurants

⁵ *Sabel BV v Puma AG* [1998] RPC 199.

⁶ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

which, given the size of the market for such services in the UK, is a small amount. It is possible for individual restaurants to achieve a high level of fame, but there is no evidence that this is the case here. There are no details as to the dates of trading for the seven restaurants, so it is not possible to say how many of them had been trading before the relevant date (the date of application for the contested mark) and for how long. There are no turnover figures and/or customer numbers. The evidence falls a long way short of establishing use which would entitle it to an enhanced level of distinctive character so I have only the mark's inherent distinctiveness to consider. Papa would be understood by the vast majority of the general public in the UK as a synonym for 'father', whether that be the more English style of pronunciation (as referred to above) or the more Continental style of pronunciation. Papa has no direct or specific relationship to the services and so has a reasonably high level of inherent distinctive character.

Likelihood of confusion

23. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I have found identity and high similarity between the respective services. I bear in mind the whole mark comparison, the dominant and distinctive elements within the marks, and the effect which the purchasing process has upon the weight of these elements. I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. Both marks share the same dominant distinctive component, the meaning of which is capable of immediate grasp. The conceptual hook in the average consumer's mind will be the same. The marks will be remembered as 'papa' marks. If they are imperfectly recalled, there will be direct confusion. If, however, the average consumer is aware that there is a difference between the marks, their similarities, combined with the close proximity between the services offered under both marks, will still give rise to indirect confusion. There will be a perception that the same undertaking is offering food and drink under a more elaborate/plainer version of its PAPA'S mark. I have not taken into account Mr Papacaoullas' claim that he offers Mexican food in his fish and chip shops; I have found that the restaurant services are identical anyway. I have come to the conclusion that there will be a likelihood of confusion based on notional use of the marks for the services in the specifications.

24. Even if I am found to be wrong in my earlier assessment that "specialising" has no limiting effect in both parties' specifications, there will still be a likelihood

of confusion. The applicant's specification includes a reference to the provision of fries. These are chips; Mr Papacaoullas' specification refers to fish and chips. The average consumer's perception will be that the same undertaking is offering different types of food under the marks (i.e. fish and chips and Mexican). Further, specialising in fish and chips does not mean that the restaurant is a traditional 'chippy'; it could be a restaurant that specialises in fish and chips while offering other types of food. This also works the other way; i.e. a restaurant specialising in Mexican food which also offers other types of food. The services are the same and, with the other factors I have identified, particularly the close proximity of the marks, there will be a likelihood of confusion.

25. The opposition succeeds under section 5(2)(b). There is, strictly, no need for me to assess whether Mr Papacaoullas would also be successful under section 5(3), but I will comment here that his evidence would be insufficient to meet the test for reputation required by that ground, as set out in *General Motors Corporation v Yplon SA* [1999] E.T.M.R. 950:

"24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

26. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it."

Costs

26. Mr Papacaoullas has been successful and is entitled to an award of costs on the following basis⁷:

Preparing a statement and considering the other side's statement	£400
Preparing evidence and submissions	£500

⁷ As per the scale in Tribunal Practice Notice 4/2007.

Opposition fee £200

Total: £1100

27. I order DAPPOPINNS Limited to pay Soteris Papacaoullas the sum of £1100. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of July 2011

**Judi Pike
For the Registrar,
the Comptroller-General**