

O-018-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
No. 2573380  
BY RASAB PARNEZ  
TO REGISTER THE TRADE MARK  
MADRAS COTTAGE  
IN CLASS 43**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER No. 102063 BY  
CHICKEN COTTAGE LIMITED**

## BACKGROUND


1) On 25 February 2011 Rasab Parnez (hereinafter the applicant) applied to register the mark MADRAS COTTAGE in respect of the following services:

Class 43: Services for providing food and drink; restaurant services; takeaway services; restaurant services for the provision of fast food and refreshments; booking and reservation services for restaurants

2) The application was examined and accepted, and subsequently published for opposition purposes on 18 March 2011 in Trade Marks Journal No.6879.

3) On 20 June 2011, Chicken Cottage Limited (the opponent), filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the registered proprietor of the following trade mark:

Mark	Number	Date of filing and registration date	Class	Specification
 <p>The text reads: CHICKEN·COTTAGE AIHalall</p>	2442478	23.12.2006 / 11.01.2008	43	Restaurant and take-away services.

b) The opponent contends that the trade mark applied for is visually, phonetically and conceptually similar to its mark above. It also contends that the services are identical and so there is a likelihood of confusion. It contends that the mark in suit offends against Section 5(2)(b).

c) The opponent also contends that due to use from 1994, its reputation in its mark (above) is such that use of the mark applied for would ride on its coattails and take unfair advantage of the distinctive character of its mark. The opponent also claims that use of the mark applied for would be detrimental to its mark. Further, that use of the mark in suit may erode/dilute the distinctiveness of the word "COTTAGE" in its mark and impair the mark's ability to be instantly recognised as indicating the trade mark origin of its services. This will make it less likely that consumers will purchase its services and will result in a corresponding change of economic behaviour causing detriment to its mark. For these reasons the mark in suit offends against Section 5(3).

4) On 26 September 2011, the applicant filed a counterstatement which basically denied the opponent's contentions, but did not put the opponent to strict proof of use. They did however, put the opponent to proof of reputation and confusion.

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard nor did either side provide any written submissions.

## OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 18 May 2012, by Mitchell Willmott the opponent's Trade Mark Attorney. His actual statement consists almost entirely of submissions which I shall not summarise here. The only thing that could be considered evidence in his statement is the definition of the word MADRAS from *Wikipedia* in exhibit MW1, which states "Madras curry or Madras sauce is a fairly hot curry sauce, red in colour and with heavy use of chilli powder." At exhibit MW2 he provides a witness statement dated 12 June 2012, by Sadaf Kazi the franchise co-ordinator of the opponent company. He states that he is authorised to make the statement, and that the information comes from his own knowledge or from the records of the opponent.

7) Mr Kazi states that the company began using its mark in 1994 in Wembley in relation to a restaurant and take-away shop. He states that currently the opponent has 106 branches in the UK, although at the time of the application there were only approximately 86 branches. At exhibits SK3 & 4 he provides print outs which show a number of branches and use of the earlier mark. He also provides pages from *Facebook* where the franchises are publicised. At exhibit SK6 he provides a number of images from *Google*, however these are all dated after the relevant date. He also refers to the mark being shown in a film which was released after the relevant date. Mr Kazi provides the following turnover figures for the business:

Year	Turnover £	Year	Turnover £
2003	1,467,868	2007	2,475,990
2004	1,672,505	2008	2,489,852
2005	1,998,669	2009	2,625,526
2006	2,025,227	2010	4,711,658

8) These figures are not put into context in terms of marketshare etc. It is clear that the turnover figures relate to three companies, Chicken Cottage Limited, Chicken Cottage (Restaurants) Limited and Chicken Cottage (Distributions) Limited. Mr Kazi states that the companies all have the same two directors, but other than this it is not clear if they are legally related. Mr Kazi also states that the opponent spends approximately £70,000 - £90,000 per annum on advertising and promotion, but does not state what this money is spent on, nor does he provide examples.

9) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## DECISION

10) I shall first consider the ground of opposition under Section 5(2)(b) of the Act which reads:

“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.”

11) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

12) The opponent is relying upon its trade mark shown in paragraph 3 above. The mark in suit was applied for on 25 February 2011 and so the opponent’s mark is clearly an earlier trade mark. The applicant did not put the opponent to proof of use under Section 6A of the Act, presumably because it realised that, given the relevant dates in play, it could not request proof of use.

13) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10) Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

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

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

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

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

14) In essence the test under section 5(2)(b) is whether there are similarities in marks and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion

must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the services, the category of services in question, how they are marketed, who the relevant consumer is and the nature of the purchasing act. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the services in their specifications.

**The average consumer and the nature of the purchasing process**


15) As the case law in paragraph 13 above indicates I must determine the average consumer for the services of the parties. I must then determine the manner in which these services are likely to be selected by the said average consumer. Both parties' services broadly speaking consist of restaurant and takeaway services which will be accessed by the whole of the populace. The services included in the specifications of both parties could vary enormously in their prices and the type of food offered. These would range from a chip or burger bar to a cordon bleu restaurant. In terms of prices the range would cover items from under a pound to many hundreds. There are also the issues of dress codes and reservations. Clearly, the amount of attention paid by the average consumer would vary considerably, but even at the cheaper end the average consumer will pay a reasonable amount of attention to the selection of what and where they eat. Selection would, in my experience, initially be visual either by seeing the sign outside the premises or looking in guide books or on-line. However I must also take into account verbal considerations as "word of mouth" will feature as people will recommend places to eat to friends and family, or alternatively warn them off places which they consider do not come up to scratch.

**Comparison of services**

16) The services of the two parties are clearly identical.

**Comparison of the trade marks**

17) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant's Trade Mark	Opponent's Trade Mark
MADRAS COTTAGE	 <p>(The text reads: CHICKEN·COTTAGE AIHalall)</p>

18) It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

### **Distinctive and dominant elements.**

19) The opponent contended:

“7. The opposed application consists of the term MADRAS COTTAGE as [a] word mark and the opponent’s earlier mark consists of the words CHICKEN COTTAGE shown around the outside of [a] circle containing the device of two chicken heads.

8. The word MADRAS shown as the first word in the opposed mark is simply descriptive of restaurant services offering Madras style meals or traditional meals of Madras (the capital city of the Indian state of Tamil Nadu is called Chennai but is also known as Madras) and subsequently it does not possess any level of distinctive [sic] when considered in respect to the applicant’s services.”

And:

“9. Also, and probably more relevant to the general UK consumer, is that the word Madras is more commonly known in the UK as a fairly hot curry sauce. Subsequently, consumers in the UK are likely to see the word MADRAS in the opposed mark as a reference to the type of sauce the applicant typically uses in the preparation of their meals.

The word COTTAGE within the opposed mark has not [sic] direct reference to any of the characteristics of the applicant’s services and subsequently the word COTTAGE is likely to be seen as the prominent and distinctive feature of the opposed mark and its most memorable feature.

10. The opponent’s earlier mark consists of the words CHICKEN COTTAGE. The word CHICKEN is the first word in the mark as it appears at the top of the circle device. General consumers in the UK usually read from left to right and/or top to bottom. The evidence shown in the section 5(3) claim will also show that the word CHICKEN is the first word of the opponent’s earlier mark. The word CHICKEN is also devoid of any distinctive character in respect to the services covered by the opponent’s earlier mark as this simply indicates to consumers that the opponent typically produce[s] foodstuffs consisting predominantly of chicken. Again, the word COTTAGE must be considered the most distinctive and dominant phonetic

feature of the opponent's earlier mark as it does not relate to any of the characteristics of the opponent's services.

The opponent's earlier mark also consists of a circle device that displays the heads of two chickens. The use of the two chicken heads is again [a] reference to the opponent's use of chicken in its dishes and meals.

11. The single dominant and distinctive component in the opponent's earlier mark is the word COTTAGE which appears in the opponent's mark after a word descriptive of a type of foodstuff. The distinctive and dominant feature of the opposed mark is also the word COTTAGE which appears after a word descriptive of a particular type of foodstuff. The marks are therefore phonetically very similar which is likely to cause confusion to the relevant consumer.

12. The visual elements of the opponent's earlier mark do not visually dominate the image that the relevant public keeps in mind. Although they are visible, it is very unlikely that the public would easily recognise and ascribe an origin to the figurative elements of the opponent's earlier trade mark. The relevant public would refer to the signs at issue orally and would remember them as much by their name as by their figurative elements especially as the visual elements merely indicate a type of foodstuff to the consumer which is non-distinctive when used in respect to foodstuffs or services associated with foodstuffs.

13. It is well known that while assessing the likelihood of confusion on the part of the public it is necessary to determine whether the differences established between the visual elements of the conflicting marks outweigh their phonetic and conceptual similarities, taking into account the nature of the services at issue. Pursuant to settled case law, the respective weight to be given to the visual, phonetic or conceptual aspects of the conflicting signs in the course of this assessment may differ according to the objective conditions under which the marks may be present on the market.

In this case, the services at issue are services in Class 43 which are often recommended by word of mouth and referred to orally. Subsequently, the phonetic aspects of the sign in question will generally have greater significance for the relevant public than the visual aspects.

14. Conceptually, the marks are also very similar. As stated in ENERCAP, conceptual similarity is only relevant if it will give rise to the necessary likelihood of confusion. Bearing in mind the phonetic similarities between both marks, the fact that the marks are also conceptually similar will increase the likelihood of confusion. The word elements of both marks are CHICKEN COTTAGE v. MADRAS COTTAGE, the first word in each mark is descriptive of a particular type of foodstuff which precedes the same word COTTAGE. Subsequently, the message that consumers may adduce from both marks is that the restaurants offer foodstuffs in a cottage themed restaurant.



15. 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 confusion. The distinctive character of a trade mark must be assessed by reference to the goods and services in respect of which registration is sought and by reference to the way it is perceived by the relevant public. To put it briefly, there is a high degree of phonetic similarity, a sufficient degree of conceptual similarity and a low degree of visual similarity. As such, there is an overall similarity between the marks.”

20) In considering the marks I take into account the following paragraphs of the *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* [C-120/04] case which read:

“[30] However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

[31] In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.”

21) And also Case T-6/01 *Matratzen Concord GmbH v OHIM* where the GC stated:

“A complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it.”

22) I reject the opponent’s contentions regarding the distinctive and dominant elements of both parties’ marks. The views outlined above are ridiculously simplistic. Just because the word MADRAS is the name of a type of sauce, does not mean that it lacks distinctiveness when used on, broadly speaking, restaurant/takeaway services. The applicant could be offering anything from pork pies and jellied eels to nouvelle cuisine. To my mind the word MADRAS will suggest an Indian/Asian style of cooking at best. A similar view prevails in respect of the opponent’s mark where the word CHICKEN might well be descriptive of the meat content of some dishes but most restaurants do not restrict themselves to a single source of protein but instead offer a variety of products, including vegetarian versions where the term CHICKEN would certainly not be

descriptive. I do not regard the word COTTAGE as being particularly distinctive as restaurants frequently use terms such as “House”, “Palace”, “Empire” etc in their names. The distinctive element of both marks lies within the totality of both words. I accept that the device element of the opponent’s mark emphasises the association with chickens, however, it would not be overlooked by anyone blessed with the gift of sight. I do not believe that either mark has a particular conceptual meaning. In short, whilst the two marks clearly share an element (the word COTTAGE) they are very significantly different visually and phonetically. I accept that the opponent’s mark has a degree of distinctiveness for the services for which it is registered and rely upon the views expressed in *Rewe Zentral AG v OHIM* [2002] ETMR 91, and *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C109/97 [1999] ETMR 585.

23) When determining whether there is a likelihood of confusion I have to take a number of factors into consideration. There is 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 services and vice versa. I must consider whether the opponent’s trade mark has a distinctive nature, the average consumer for the services, the nature of the purchasing process and the issue of imperfect recollection. I must also take into account that these services may be chosen with only a modicum of care. In the instant case the opponent’s mark has a degree of inherent distinctiveness. It has not shown that its mark has any enhanced distinctiveness. The differences between the trade marks are such that even when used on identical services there is no likelihood of confusion on the part of the public, or a likelihood of association with the earlier trade mark. The ground of opposition under Section 5(2)(b) fails.

24) I now turn to consider the ground of opposition under Section 5(3) of the Act which states:

“5(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 3 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.

25) The relevant principles can be gleaned from the case law of the Court of Justice of the European Union. In particular, cases *General Motors Corp v Yplon SA* [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 and *L’Oreal SA and others v Bellure NV and others* - Case C-487/07. These cases show that:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26; but the reputation of the earlier mark may extend beyond the consumers for the goods and services for which it is registered; *Intel*, paragraph 51.

(c) It is necessary, but not sufficient, for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account all relevant factors, including the degree of similarity between the respective marks and between the respective goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Although it is not a necessary factor, a link between the trade marks is necessarily established where the similarity between the marks causes the relevant public to believe that the goods/services marketed under the later mark come from the owner of the earlier mark, or from an economically connected undertaking; *Intel*, paragraph 57.

(f) Where a link is established, the owner of the earlier mark must also establish that it has resulted in the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68: whether this is the case must also be assessed globally, taking account of all the relevant factors; *Intel*, paragraph 79.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel*, paragraphs 76 and 77.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the repute of the earlier mark is caused when the goods or services for which the later mark is used by the third party may be perceived by the public in such a way that the earlier trade mark's power of attraction is reduced; *L'Oreal*, paragraph 40.

(j) Unfair advantage covers, in particular, cases where a third party seeks to ride on the coat-tails of the senior mark in order to benefit from a transfer of the image of the earlier mark, or of the characteristics it projects to the goods/services identified by the later mark; *L'Oreal*, paragraph 41.

26) The onus is upon an opponent to prove that its earlier trade mark enjoys a significant reputation or public recognition and it needs to furnish the evidence to support this claim. In the instant case the opponent filed evidence which it contended showed that it had reputation in its earlier mark for, broadly speaking, restaurant and takeaway services. At paragraph 8 above I set out my concerns with the evidence provided and came to the conclusion that the opponent had not shown reputation in its mark for any service. Thus the opponent fails at the first hurdle, and the opposition under Section 5(3) fails.

## **CONCLUSION**

27) The opposition has failed on both grounds.

## **COSTS**

28) The applicant has been successful and it is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Considering the other sides' evidence	£600
<b>TOTAL</b>	<b>£900</b>

29) I order Chicken Cottage Limited to pay Mr Rasab Parnez the sum of £900. This sum 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 14th day of January 2013**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**