

O-253-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2647893
BY RAW LASAN LIMITED TO REGISTER THE TRADE MARK**



IN CLASS 43

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 400490
BY JABBAR KHAN**

BACKGROUND

1) On 7 January 2013, Raw Lasan Limited (“the applicant”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the following mark:



2) The application is in respect of the following list of services in Class 43:

Restaurant services; restaurant services incorporating licensed bar facilities; cocktail lounge services; bar services; public house services; wine bar services; wine club services; provision of information relating to bars and restaurants; cafe services; snack bar services; club services for the provision of food and drink; night club services [provision of accommodation]; night club services [provision of food]; catering services.

3) The application was published in the Trade Marks Journal on 5 April 2013 and on 4 July 2013, Jabbar Khan (“the opponent”) filed notice of opposition to the application. Following several amendments, the first ground of opposition is:

The Opponent contends that there is a risk that consumers are likely to confuse the Opponent's earlier trade mark LASAN RESTAURANT (AND DEVICE) and the opposed mark as a result of their phonetic similarities (RAW Lasan Lounge Bar and Restaurant v. LASAN RESTAURANT) and the fact that the services in question are identical and similar. The opposed application should therefore be refused registration in accordance with Section 5(2)(b) of the Trade Marks Act 1994.

4) The opponent relies on the following two earlier marks:

Mark and relevant dates	List of services
<p>2560077</p>   <p>(series of 2 marks)</p> <p>Filing date: 29 September 2010 Registration date: 7 January 2011</p>	<p>Class 43: <i>Restaurant services</i></p>
<p>2431017</p>  <p>Filing date: 25 August 2006 Registration date: 16 February 2007</p>	<p>Class 43: <i>Restaurant services</i></p>

5) The opponent also relies on the same marks in respect of further grounds based upon Section 5(3) and Section 5(4)(a) of the Act.

6) The applicant subsequently filed a counterstatement denying the opponent's claims and putting it to proof of use in respect of the second of its marks.

7) Only the opponent filed evidence (and also written submissions) in these proceedings. Both sides ask for an award of costs. Neither side requested to be heard, but I give my decision after careful consideration of the papers.

Opponent's Evidence and Proof of Use

8) In respect to the grounds based upon Section 5(2)(b), the opponent filed evidence in support of his claim that genuine use has been made of the earlier mark 2431017 within the relevant period. This period is calculated as the five years ending on the date of publication of the contested mark (Section 6A(3)(a)). In this case that date is 5 April 2013. It is not, as Mr Khan says in his witness statement, "calculated as 5 years from the date we filed the opposition proceedings on 10th July 2013". However, this discrepancy is of no consequence because, for the reasons of procedural economy, I will consider Mr Khan's case based upon his other earlier mark (2560077) that is not subject to the proof of use provisions. Insofar as I need to go on to consider the evidence in support of the grounds based upon Section 5(3) and Section 5(4)(a) of the Act, I will do so, as appropriate, later in the decision.

DECISION

Section 5(2)(b)

9) Section 5(2)(b) reads:

"(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."

10) In reaching my decision under this ground I bear in mind that the Court of Justice of the European Union ("the CJEU") has issued a number of judgments which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd (O/330/10)*, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead

rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) 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 of that mark;

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

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

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

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

(k) if the association between the marks 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."

Comparison of services

11) In assessing the similarity of services, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods

and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

'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.'

12) Other factors may also be taken into account such as, for example, the distribution channels of the goods (and, by analogy, services) concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

13) I also bear in mind the following guidance of the General Court ("the GC") in *Gérard Meric v OHIM*, T-133/05:

"29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)."

14) It is self evident that the opponent's *restaurant services* are identical to the services covered by the same term in the applicant's specification. Further, the term also includes the services covered by the applicant's *restaurant services incorporating licensed bar facilities*. Therefore, I find that these terms are also identical.

15) The applicant's terms *cafe services; snack bar services; club services for the provision of food and drink; catering services* all involve the preparation of food and presentation of that food to the consumer and consequently share the same nature and intended purpose as the opponent's *restaurant services*. Further, such services are often provided by the same traders. They may also be in competition with the consumer making a choice between the informal dining offered by a cafe and dining in the more formal environment of a restaurant. I also recognise that some restaurants are more informal than others bringing the respective services into even more direct competition. Taking all of this into

account, I conclude that these services share a high level of similarity with the opponent's services.

16) In respect of the applicant's *cocktail lounge services; bar services; public house services; wine bar services; ... night club services [provision of food]*, these are all services that are often provided alongside the preparation and offering of food and meals. Premises providing such services will also commonly provide restaurant style services. Therefore, whilst these services are not identical to the opponent's *restaurant services*, they may share trade channels and may be in competition with each other. Consequently, I conclude that the respective services share a reasonably high degree of similarity.

17) The applicant's *wine club services; night club services [provision of accommodation]* appear to have very little, if any, similarity to restaurant services. Their nature, intended purpose, methods of use, and trade channels are all different to those of *restaurant services*. Neither are they in competition with each other, nor is one service important for the operation of the other and, consequently, they are not complementary in the sense described by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06.

18) Finally, the applicant's *provision of information relating to bars and restaurants* are different to restaurant services per se. Their respective nature, purpose and methods of use are all different. It is not normal for the provider of information to also be the provider of restaurant services, and certainly the relevant consumer would not consider approaching the provider of one of these services expecting to access the other service. The fact that such information relates to restaurants is insufficient reason to find similarity. To find otherwise would lead to a clearly incorrect approach where, for example, the service of publishing newspapers would be similar to any service that may be written about in the newspaper. I conclude that there is no similarity.

The average consumer



19) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

20) As suggested by the opponent in its written submissions, the average consumer, in respect of services related to the provision of food and drink, is likely to be an ordinary member of the public. I agree. The cost of such services is not normally prohibitive to most members of the public, but I do recognise that

some restaurant services, for example, may be much more expensive and with a commensurately smaller number of consumers. The purchasing process will generally involve a reasonable level of consideration and, as the opponent suggests, may sometimes include impulse purchases where the consumer walks in off the street. I also recognise that at the other end of the spectrum, some restaurants for example will be chosen only after more consideration. Visual considerations are an important part of the purchasing act. The average consumer will encounter the marks on, for example, signage in the high street, in advertisements in magazines, or on posters. However, as restaurants etc may be recommended by word of mouth, aural considerations also play a part in the selection process.

Comparison of marks

21) The earlier mark consists of a series of two marks. I do not consider that the differences between the two marks forming the series will materially effect the outcome of these proceedings. Therefore, for procedural economy I will restrict my comparison of the applicant’s mark (and later, my consideration of the likelihood of confusion) with the first mark in the series. For ease of reference, the respective marks are:

Opponent’s mark	Applicant’s mark
	

22) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. 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; in relation to this the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97 stated:

“27. In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.”

23) There cannot be an artificial dissection of the marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of the them and is deemed to be reasonably well informed and reasonably circumspect and observant . The assessment of the similarity of the marks must be made by reference to the perception of the relevant public.

24) The applicant's mark comprises a number of separate components. The word "RAW" dominates with each of the three letters being represented in its own box. The middle of these three boxes includes, in addition to the letter "A", the word "Lasan" in a handwritten-type text. This appears in a smaller text, under the letter "A" of the word "RAW". In addition, at the bottom of the mark is a narrow, dark strip in which appear the words "Lounge Bar and Restaurant". These words are descriptive and therefore constitute a non-distinctive part of the mark. Whilst the word "raw" is a well-understood dictionary word, it has no obvious meaning in the context of the services at issue. Further, the word "Lasan" has no obvious meaning. With this in mind, the distinctive character resides in the word "RAW", the word "Lasan" and the get-up of the background comprising the three boxes. As I have said, the word "RAW" is the dominant distinctive element, but the word "Lasan" is also an independent distinctive element.

25) The opponent's mark comprises three distinct elements, a device of a leaf, the word "Lasan" and the word "Restaurant". The word "Restaurant", by virtue of its descriptive nature is not a non-distinctive element. The dominant distinctive element is the word "Lasan" by virtue of its prominent position and size within the mark. The "leaf" device element is less dominant, but is, nevertheless, an independent distinctive element.

26) Visually, the applicant's mark has the word "RAW", the "three box" device and the bottom banner (containing the words "Lounge Bar and Restaurant"), elements that are all absent in the opponent's mark and which creates a visible impression that differs in many ways from that of the opponent's mark. The opponent's mark also has the "leaf" device that is absent in the applicant's mark. However, both marks contain the word "Lasan", albeit in different scripts and they also share the descriptive word "restaurant". Taking all of this into account, I conclude that there is some visual similarity because of the common words "Lasan" and "restaurant" but that this is on the low side.

27) Aurally, the applicant's mark is likely to be articulated as "Raw Lasan" and the opponent's mark as "Lasan". The other elements of both marks are unlikely to be referred to aurally. With this in mind, I conclude the respective marks share a reasonably high level of aural similarity.

28) Conceptually, the opponent's mark will be understood as a reference to a restaurant because of the presence of that word in the mark. The decorated leaf

device will also create a conceptual hook. The word “Lasan” has no immediate meaning (although the opponent points out in its written submissions that it means “garlic” in Gujarati) and will not contribute to the conceptual identity of the mark. The applicant’s mark contains the word “RAW” that will be understood as the ordinary dictionary word meaning natural state or strong and undisguised¹ etc etc, and the words “Lounge Bar and Restaurant”. The other elements will not contribute to the conceptual identity. Taking all of this into account, there is little by way of conceptual similarity other than the common reference to “restaurant” in both marks. I conclude that any conceptual similarity is on the low side.

Distinctive character of the earlier trade mark

29) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

30) The word “Lasan” does not appear to have any meaning and as such, it is endowed with a high level of inherent distinctive character. Whilst there is evidence of use that would suggest that its distinctive character has been enhanced, in light of the already high level of inherent distinctive character, any enhancement will not influence the outcome of these proceedings.

Likelihood of confusion

31) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

32) In *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch) Arnold J undertook an analysis of case law regarding the application of the principals set out by the CJEU in *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04. In *Medion*, the CJEU stated that the 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, but this 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

¹ "raw." *Oxford Dictionary of English*. Ed. Stevenson, Angus. : Oxford University Press, 2010. *Oxford Reference*. 2010. Date Accessed 23 May. 2014 <http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en

more of its components. Insofar as they relevant to the current case, Arnold J stated:

“44. I entirely accept the basic proposition which the Court of Justice has repeated many times, namely that the assessment of likelihood of confusion must be made by considering and comparing each of the signs as a whole. As the Court of Justice recognised in *Medion v Thomson*, however, there are situations in which the average consumer, while perceiving a composite sign as a whole, will recognise that it consists of two signs one or both of which has a significance which is independent of the significance of the composite whole. Thus when the well-known pharmaceutical company Glaxo plc acquired the well-known pharmaceutical company Wellcome plc, the average consumer of pharmaceutical goods confronted with the composite sign GLAXO WELLCOME or GLAXOWELLCOME would perceive the significance of both the whole and its constituent parts and conclude that this was an undertaking which combined the two previously separate undertakings (see *Glaxo Group Ltd v Glaxowellcome Ltd* [1996] FSR 388). The essence of the Court of Justice's reasoning in *Medion v Thomson* is that an average consumer of leisure electronic products confronted with the composite sign THOMSON LIFE could perceive both the whole and its constituent parts to have significance and thus could be misled into believing that there was a similar kind of connection between the respective undertakings.”

33) I have already found that the word “Lasan” in the applicant’s mark is an independent and distinctive part of the applicant’s mark and it is the dominant and distinctive element of the opponent’s mark. I have found that there is a level of similarity between many, but not all, of the respective services. Further, I have found that the respective marks, when considered as a whole, share a low level of visual similarity, a reasonably high level of aural similarity and a low level of conceptual similarity. I have also found that the relevant consumer is the general public and that the purchasing act may vary from the casual to well considered and is likely to be mainly visual in nature, but I do not ignore that sometimes aural consideration may be a factor. The opponent’s mark is endowed with a high level of distinctive character.

34) When all of the above is factored into the global analysis together with the guidance provided in *Medion* and *Aveda*, I find that there is a likelihood of confusion in respect of all the services where I have found identity or similarity. Whilst the presence of the RAW element of the applicant’s mark will remove the likelihood of direct confusion where one mark is confused with the other, there is a likelihood of indirect confusion where the consumer will assume that the respective services originate from the same or linked undertaking. This is because of the prominence of the highly distinctive word “Lasan” in the opponent’s mark and because the same word also has an independent

distinctive role in the applicant's mark. Upon encountering one of these marks the consumer will perceive a link with the other mark such that they will assume that the providers are economically linked.

35) In summary, the opposition succeeds in respect of the following services:

Restaurant services; restaurant services incorporating licensed bar facilities; cocktail lounge services; bar services; public house services; wine bar services; ...; cafe services; snack bar services; club services for the provision of food and drink;...; night club services [provision of food]; catering services

36) The opposition fails in respect of the following:

Wine club services; provision of information relating to bars and restaurants; night club services [provision of accommodation]

Section 5(3) and Section 5(4) (a)

37) My finding in respect to Section 5(2)(b) of the Act decide the case in respect of most of the applicant's services (listed in paragraph 35 above). However, I will comment briefly upon the opponent's claims under Section 5(3) and Section 5(4)(a), insofar as they may apply to the applicant's remaining services (listed in paragraph 36 above). The opponent's evidence illustrates that its mark has been used in respect of a well regarded restaurant in Birmingham. It has been promoted UK wide a number of television programmes such as *The F Word* on Channel 5, the BBC programme *Great British Menu*, as well as in national press such the *Sunday Times*. This is all suggestive of a strong local reputation and goodwill in respect of restaurant services and this may extend to a lesser extent to elsewhere in the UK.

38) Taking this evidence into account, I find that the distance between the opponent's reputation and goodwill and the services listed in paragraph 39, above, would not be bridged. As a result, the applicant's mark stands for these services and the opponent's case will be no more successful under Section 5(3) and Section 5(4)(a) than it has been under Section 5(2)(b) of the Act. Therefore, it is not necessary to consider these grounds further.

COSTS

39) The opposition having been largely successful, the opponent is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place but that it did file written submissions in lieu of attendance. I award costs on the following basis:

Preparing Notice of Opposition and considering other side's statement (including official fee)	£500
Preparing and filing evidence	£500
Filing written submissions	£400
TOTAL	£1400

40) I order Raw Lasan Limited to pay Jabbar Khan the sum of £1400. 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 9th day of June 2014

**Mark Bryant
For the Registrar,
the Comptroller-General**