

O-208-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NUMBER
3023372
STANDING IN THE NAME OF
HAKKA RESTAURANTS LTD**

AND

**AN APPLICATION
FOR A DECLARATION OF INVALIDITY THERETO
UNDER NUMBER 500336
BY MR AMIT PATEL**

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THE BACKGROUND AND THE PLEADINGS

1) Bombay wok Ltd was the proprietor of UK trade mark registration 3023372 for the trade mark shown below:

Bombay wok London

The application for registration was filed on 24 September 2013 and completed its registration procedure on 07 February 2014. It is registered in respect of:

Class 43: Fast food restaurant services.

During the course of the proceedings Bombay wok Ltd assigned the mark to Hakka Restaurants Limited who, after indicating a willingness to stand by the claims made and to meet any cost liability I may award, now stand as the Registered Proprietor of the registration.

2) On 17 March 2014 Mr Amit Patel filed application no. 500336 for a declaration of invalidity under Section 47(2) of the Trade Marks Act 1994 (“the Act”) in respect of the above registration, on grounds under section 5(2)(b) of the Act. For the purposes of his claim Mr Patel relies on UK trade mark registration 2633531 (“the earlier mark”). The earlier mark is for the following mark in respect of the following services:

BOMBAY WOK

Class 43: Restaurant services.

3) The significance of the respective dates on which the earlier mark was applied for and on which its registration process was completed is that (1) it constitutes an “earlier mark” for the purposes of section 5(2)(b) of the Act, and (2) it is not subject to proof of use, having, in accordance with section 47(2A)(a) of the Act, completed its

registration procedure within the period of five years ending with the date of the application for the declaration of invalidity.

4) The Registered Proprietor filed a notice of defence and counterstatement, which includes a defence based on a claim that the Registered Proprietor opened its restaurant before Mr Patel opened his restaurant or applied for his mark.

5) The above circumstances do not constitute a valid defence in the present proceedings. This is explained in the *Tribunal Practice Notice TPN 4/2009*, as follows:

“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark”.

In its counterstatement the Registered Proprietor indicated that if the objection against its mark was not withdrawn then a “tribunal case” would be filed to cancel the earlier mark. Despite the objection not being withdrawn, the Register Proprietor has not filed an application to cancel the earlier mark.

Neither the Applicant nor the Registered Proprietor filed submissions or evidence, and neither requested a hearing. I therefore give this decision after a careful review of the papers before me.

Sections 47(2), 47 (2A) and 5(2)(b)

6) Section 47 (2)(a) and (2A) of the Act reads as follows:

“(2) The registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain [...]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.”

7) Section 5(2)(b) of the Act reads as follows:

“5(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”.

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

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

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public will 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

8) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”), the General Court stated that:

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

Meric involved a comparison of goods, but the principle applies equally to services. It is self-evident that the Registered Proprietor’s *fast food restaurant services* in Class 43 are included in the earlier mark’s *restaurant services* in Class 43. They are identical under the guidance in *Meric*.

The average consumer and the purchasing process

9) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear*

Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

10) *Restaurant services* cover a spectrum ranging from expensive restaurants to fast food outlets, but they are, for the most part, normal, everyday services chosen by members of the general public. They will usually involve a reasonable amount of attention, neither higher nor lower than the norm (though, especially in the case of fast food restaurant services, they may include impulse purchases); however, the average consumer is still deemed to be reasonably well informed and reasonably circumspect and observant. Visual considerations are an important part of the purchasing process, the relevant marks being encountered, for example, on signage, on the Internet, in advertisements, *Yellow Pages* listings, etc.; but word-of-mouth recommendations may also play a part, and will not be overlooked in my assessment.

The distinctiveness of the earlier mark

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

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

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

12) As neither party has filed evidence, I have only the inherent characteristics of the earlier mark to consider. Although BOMBAY is not directly descriptive of restaurant services, the name of a place in India establishes an Indian connection, and therefore has a certain allusive quality in relation to Indian cuisine. Similarly, WOK, though not directly descriptive of restaurant services, will be recognised by the average consumer as a cooking implement, though some may be more familiar with it in the context of Chinese rather than Indian cuisine. When the words are combined into an evocative phrase the earlier mark, viewed as a whole, has a normal degree of distinctiveness.

Comparison of the marks

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

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

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

The Registered Proprietor’s mark	The earlier mark
Bombay wok London	BOMBAY WOK

14) Neither of the earlier mark’s components dominates the other. BOMBAY qualifies WOK so that the two hang together in a complete phrase. The distinctiveness of the earlier mark lies in the mark as a whole. This analysis also applies in respect of the words Bombay Wok in the Registered Proprietor’s mark. The average consumer will simply perceive “London” as indicating the geographical base of the undertaking providing the services in question, rather than as a distinctive element of the mark, so the overall impression is strongly dominated by the words Bombay Wok.

15) The Registered Proprietor's mark has been registered in capital case except for the word "wok". However, whether or not letters are presented in upper, lower or capital case is something which is likely to go unnoticed; it is the words BOMBAY WOK which will make the visual impact, rather than the precise typographical presentation. Moreover, I must bear in mind that fair and notional use of the earlier mark will in any case cover use in different fonts and orthographical presentation. The word "London", though it presents a visual difference from the earlier mark, plays such a small role in the overall impression that I regard the marks as visually highly similar.

16) Both marks will be pronounced identically as BOM-BAY-WOK. It is unlikely that "London", being perceived simply as an indication of geographical location, will be pronounced. Even if it were, I still consider there to be a high degree of aural similarity.

17) Conceptually too, London will not be perceived as contributing in a meaningful way to the concept of the Registered Proprietor's mark, beyond indicating the geographical place of the business. The primary concept of the Registered Proprietor's mark will be based upon the words BOBMAY WOK, an allusive combination of words relating to a wok that has its origin, or has some relationship, with Bombay, a concept which is shared by the earlier mark. The marks are, conceptually, virtually identical, or else they are highly similar..

Likelihood of confusion

18) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether the marks are likely to be confused.

19) I have found the earlier mark to have a normal degree of distinctiveness, and the goods of the Registered Proprietor's mark to be identical with those of the earlier mark. I have found at least a high degree of visual, aural and conceptual similarity between the marks. Bearing in mind my finding on the average consumer and the purchasing process, allowing for imperfect recollection, and having regard to the interdependency principle, I consider that there is a likelihood that the average consumer will confuse the marks. The only real difference between the marks consists in the inclusion of the word LONDON in the applied for mark. This is insufficient to distinguish the marks in a trade origin sense. **Accordingly, the Applicant's request for a declaration of invalidity on the basis of section 5(2)(b) of the Act succeeds.**

OUTCOME

20) **For the reasons given above I find that registration no. 3023372 is invalid, in accordance with section 47(2) of the Act, and is deemed never to have been made.**

Costs

26) Mr Amit Patel has been successful and is entitled to a contribution towards his costs. I hereby order Hakka Restaurants Limited to pay Mr Amit Patel the sum of £400. This sum is calculated as follows:

<i>Application fee</i>	£200
<i>Preparing a statement and considering the other side's statement</i>	£200

The above sum should 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 6th day of May 2015

**Martin Boyle
For the Registrar,
The Comptroller-General**