

BL O/0421/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3751130

BY ZEUGMA TURKISH CUISINE LTD

TO REGISTER THE TRADE MARK:

Didsbury Zeugma Cuisine

IN CLASS 43

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 432058

BY BEKIR YIRTAR

BACKGROUND AND PLEADINGS

1. On 04 February 2022, ZEUGMA TURKISH CUISINE LTD (“the applicant”) applied to register in the UK the trade mark shown on the cover page of this decision, under number 3751130 (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 18 March 2022, in respect of the following services:

Class 43 Restaurants; Restaurant services; Grill restaurants; Delicatessens [restaurants]; Tourist restaurants; Fast food restaurants; Carvery restaurant services; Providing restaurant services; Take-out restaurant services; Fast-food restaurant services; Bar and restaurant services; take-away restaurant services; Salad bars [restaurant services]; Booking of restaurant seats; Restaurant and bar services; Take-away restaurant services; Provision of food and drink in restaurants; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Making reservations and bookings for restaurants and meals; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Restaurant services for the provision of fast food.

2. On 22 March 2022, Bekir Yirtar (“the opponent”) filed a notice of opposition, opposing the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon its United Kingdom trade mark number 2590107, ‘ZEUGMA’ and ‘Zeugma’ (series of two marks) (“the earlier mark”). The earlier mark was filed on 03 August 2011, and became registered on 04 November 2011, in respect of the following services:

Class 43: Restaurant and/or café services; take away services; services for the provision of food and drink; catering services.

3. Under section 5(2)(b), the opponent claims that the marks are confusingly similar and the services are identical or similar and therefore a likelihood of confusion exists. In accordance with section 6A of the Act, the earlier mark is subject to proof of use; the opponent made a statement of use in relation to all the services relied upon.

4. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of the earlier mark.

5. The opponent is represented by RevoMark; the applicant, originally represented by Amicus Solicitors Ltd, now represents itself.

6. Only the opponent filed evidence. Neither party requested a hearing, nor did they file written submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

EVIDENCE

7. The opponent filed evidence in the form of the witness statement of Bekir Yirtar (“opponent”), dated 21 October 2022, and his corresponding six exhibits (BY1- BY6). Whilst I do not intend to summarise the evidence here, I have read all of the evidence and will return to it to the extent I consider necessary in the course of this decision.

RELEVANCE OF EU LAW

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

DECISION

Proof of use

9. I will begin by assessing whether, and to what extent, the evidence supports the opponent’s statement that it has made genuine use of its mark in relation to the services for which it is registered. The relevant period for this purpose is the five-

year period ending with the date of the application in issue, namely 05 February 2017 to 04 February 2022.

10. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not

the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

11. The onus is on the opponent, as the proprietor of the earlier mark, to show genuine use because Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

12. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114. The Court of Justice of the European Union (CJEU) has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer*, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky - Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C- 495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Behher BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH &*

Co KG [EU:C:2013:592], [2014] ETMR, Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

Form of the mark

13. Before I consider whether the opponent has demonstrated sufficient use in relation to its mark, I will first consider the marks shown within the evidence, and if I consider these to be use of the mark as registered, or to be acceptable variants of the same.

14. The opponent's registration is for the series of two word only marks 'ZEUGMA' and 'Zeugma'. Where it has used its registration as registered, that will clearly be use on which the opponent can rely. In addition, it is noted from the evidence that the opponent's registration has also been used in the following ways:



15. Section 6A(4)(a) of the Act enables an opponent to rely on use of a mark “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, the Court of Justice of the European Union (“CJEU”) found that “use of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark”, but that “a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”.

16. As can be seen from above, the way the variants are written differs from the registered form. In *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, BL O/281/14, Iain Purvis QC (as he then was), sitting as the Appointed Person, stated:

“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalisation which appears in the Register of Trade Marks. See for example *Present-Service Ullrich GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-66/11 at [57]. A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or hand-writing as opposed to print) from that which appears in the Register while remaining ‘identical’ to the registered mark.”

17. As the registered trade mark (series of two) is in word only format the distinctive character of the mark resides in the words ‘ZEUGMA’ and ‘Zeugma’. As shown above, with the exception of marks 1 and 2, the signs presented as trade marks in the opponent’s evidence includes figurative versions of the mark, incorporating colour and a stylised font. However, I bear in mind that as the registered trade mark (series of two) are word marks, fair and notional use of the mark allows it to take on a different presentation, such as a different colour, font or letter case, and therefore, on this basis, I consider that marks 3 and 4 shown above, are acceptable variants of the marks as registered.

18. Furthermore, whilst I acknowledge that the registration is for the words ‘ZEUGMA’ and ‘Zeugma’, it is noted that there is use in the opponent’s evidence of this word accompanied by the additional non-distinctive words, ‘The’ and ‘Restaurant’ (see marks 1 and 2 above). However, I am of the view that these marks will still be perceived as indicative of the origin of the services. I find that the differences in the presentation of marks 1 and 2, does not affect the distinctive character of the registered trade mark (series of two) given that overall, the distinctive and dominant elements of these marks will still be perceived as the word ‘Zeugma’. As such, I find that the distinctive character of the registered words is not affected by presenting them in a different colour, letter case, or font, or by adding the non-distinctive elements ‘The’ and ‘Restaurant’ to the word ‘Zeugma’. Accordingly, I find that marks 1 and 2, shown above, are also acceptable variants of the marks as registered.

Genuine use

19. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the UKTM, in the course of trade, sufficient to create or maintain a market for the services at issue during the relevant five-year period.

20. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹

21. The opponent claims to have used its registered trade mark (series of two), 'ZEUGMA' and 'Zeugma' in relation to the following services:

Class 43: Restaurant and/or café services; take away services; services for the provision of food and drink; catering services.

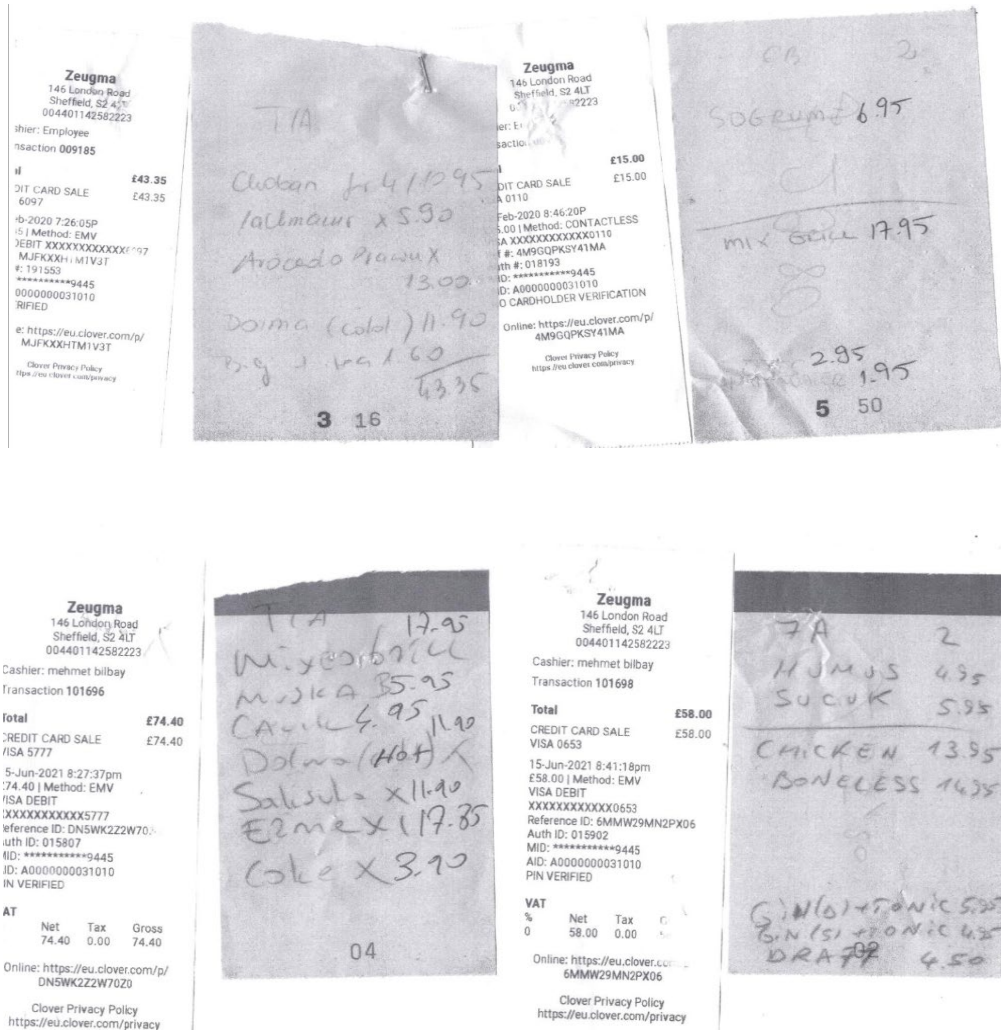
22. In his witness statement Mr Bekir Yirtar ("the opponent"), states that in 2004 he opened a restaurant business called 'ZEUGMA' ("the earlier mark"), at 146 London Road, Sheffield, which has been continuously trading for the past 17 years. Mr Yirtar adds that the restaurant and takeaway is open seven days a week. Mr Yirtar also states that while Covid had a severe impact on the hospitality sector, he managed to get through it by selling and delivering take away meals.

23. The total turnover figures in respect of the services at issue in Class 43, sold in the UK under the 'ZEUGMA' and 'Zeugma' trade marks between 2015 and 2020 are as follows:

2015 - £150,000
2016 - £180,000
2017 - £200,000
2018 - £200,000
2019 - £230,000
2020 - £100,000

¹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, Case T-415/09

24. The evidence includes eight till receipts (Exhibit BY6), dated between 2020 and 2021, for various amounts, totalling £274.15. As can be seen from the following examples of these receipts, they feature the trade mark at issue and are accompanied by the corresponding food orders:



25. Photographs of the outside and interior of the restaurant are contained in Exhibit BY1. The photographs are undated. The earlier mark is visible on one of the photographs where it is shown on signage placed on the front of the restaurant premises. The mark does not feature on the remaining two photographs (interior of the restaurant premises).

26. Exhibit BY2 relates to a menu containing eight pages. The trade mark at issue is shown on the first page of the menu. There are no visible dates on any of the pages.

27. Exhibit BY3 relates to a copy of a 'Liquor Licence' issued by Sheffield City Council in 2005 (updated in July 2011), issued under the Licencing Act of 2003, regarding the sale by retail of alcohol for consumption on the restaurant premises. The premises details are listed as 'The Zeugma Restaurant' (146 London Road, Sheffield). The exhibit is dated outside the relevant period and therefore I find that this evidence does not assist the opponent in proving use of its mark in the UK during the relevant period.

28. Exhibit BY4 relates to copies of two annual licencing fee requests from Sheffield City Council, issued under the Licencing Act of 2003, regarding the sale by retail of alcohol for consumption on the restaurant premises. The premises details are listed as 'The Zeugma Restaurant' (146 London Road, Sheffield). The annual fee requests are for the periods November 2018 to November 2019; and November 2019 to November 2020.

29. Exhibit BY5 relates to a copy of an invoice issued by 'Nottingham Pest Control' to 'Zeugma Restaurant' (146 London Road, Sheffield), in respect of work carried out in an upstairs kitchen. The invoice relates to pest control services and is dated 21 June 2022 and is therefore dated outside the relevant period.

30. I remind myself that use does not have to be quantitatively significant to be genuine. It is apparent from the evidence that the opponent has used its mark in the UK, during the relevant period. The turnover figures are reasonable in terms of the services at issue and demonstrate that sales have been consistent over the relevant period. As such, I am satisfied that the opponent has attempted to create and maintain a market under the mark (series of two). Accordingly, I am satisfied that the opponent has demonstrated genuine use of its mark.

Fair specification

31. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the services relied upon. *In Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

32. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

The opponent's Class 43 services

33. The opponent relies upon the following services:

Class 43 Restaurant and/or café services; take away services; services for the provision of food and drink; catering services.

34. The use shown by the opponent overwhelmingly relates to *restaurant and/or café services; take away services*, however, there is no evidence of use of the mark in relation to *catering services*. Accordingly, the services would be fairly described by the average consumer as *restaurant and/or café services; take away services; provision of food and drink via restaurant, café and take away service* which would be perceived as identifiable sub-categories of the broader terms relied upon.

35. Accordingly, a fair specification for the earlier marks is:

Class 43 Restaurant and/or café services; take away services; provision of food and drink via restaurant, café and take away services.

Section 5(2)(b)

36. Sections 5(2)(b) and 5A of the Act read 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.

[...]

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Relevant law

37. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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:

The principles

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

38. 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.”

39. Additionally, 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 also include an assessment of the channels of trade of the respective goods or services.

40. Further, in *Kurt Hesse v OHIM*,² the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*,³ the General Court (“GC”) stated that “complementary” means:

“...there is close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

² Case C-50/15 P

³ Case T-325/06

41. In *Gérard Meric v Office for Harmonisation in the Internal Market* ('Meric'), the GC 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 fur 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”.

42. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10), Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

43. In light of my findings above, the competing services are as follows:

Opponent's services	Applicant's services
Class 43 Restaurant and/or café services; take away services; provision of food and drink via restaurant, café and take away services.	Restaurants; Restaurant services; Grill restaurants; Delicatessens [restaurants]; Tourist restaurants; Fast food restaurants; Carvery restaurant services; Providing restaurant services; Take-out restaurant services; Fast-food restaurant services; Bar and restaurant services; take-away restaurant services; Salad bars [restaurant services];Booking of restaurant seats; Restaurant and bar services; Take-away restaurant

	<p>services; Provision of food and drink in restaurants; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Making reservations and bookings for restaurants and meals; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Restaurant services for the provision of fast food.</p>
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Restaurants; Restaurant services; Grill restaurants; Delicatessens [restaurants]; Tourist restaurants; Fast food restaurants; Carvery restaurant services; Providing restaurant services; Take-out restaurant services; Fast-food restaurant services; Bar and restaurant services; take-away restaurant services; Salad bars [restaurant services]; Restaurant and bar services; Take-away restaurant services; Provision of food and drink in restaurants; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Restaurant services for the provision of fast food

44. The opponent's *restaurant and/or café services; take away services; provision of food and drink via restaurant, café and take away services* is identical to the applicant's services listed above, either because of their near identical wording, or because of the principle set out in *Meric*.

Booking of restaurant seats; Making reservations and bookings for restaurants and meals

45. The applicant's services listed above can be described as ancillary services to the opponent's *restaurant and/or café services* and *services for the provision of food and drink*. There are common instances, on a restaurant's web site, for example, where consumers will encounter the applicant's services as well as the opponent's

services. As such, I find that there is an obvious overlap in, at least the users, intended purpose and complementary nature of the applicant's services listed above to those of the opponent. Accordingly, I find that these services are similar to a medium degree.

The average consumer and the nature of the purchasing act

46. 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 (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

47. 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.”

48. The services at issue are those related to the provision of food and drink, for which the average consumer is a member of the general public. The selection of the services is predominantly visual on the basis that they may be chosen after seeing shop fronts, signage and advertising material such as flyers and menus. Word-of-mouth recommendations also play a role and so there is an aural element to the selection.

49. The services are used fairly frequently by the general public and vary in price according to the establishment in which the services are offered and the food and drink offered by those establishments. Consumers will consider factors such as the type of food and drink provided and its suitability for any dietary preferences, as well

as the cost. Overall, I consider that a medium degree of attention will be paid during the purchasing process.

Comparison of the marks

50. 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.”

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

Opponent's mark (series of 2)	Applicant's mark
ZEUGMA Zeugma	Didsbury Zeugma Cuisine

Overall impression

52. The opponent's word-only marks (series of two) comprise the word 'ZEUGMA' presented in capital letters, and the word 'Zeugma' presented in standard sentence case, with a capital first letter, and lower-case letters following. There are no other elements that contribute to the overall impression of the marks which lies in the words themselves.

53. The applicant's word-only mark comprises the words 'Didsbury Zeugma Cuisine' presented in standard upper and lower sentence case with no stylisation or figurative elements. For reasons I will come to discuss in the conceptual comparison, I find that the word 'Zeugma' plays an independent distinctive role within the mark, and as such plays a greater role in the overall impression. The words 'Didsbury' and 'Cuisine', whilst not negligible, play a lesser role in the overall impression.

Visual Comparison

54. Visually, the marks coincide insofar as they share the same word 'ZEUGMA / Zeugma', being the only word element contained in the opponent's marks. The competing marks are visually different in that the applicant's mark contains the additional elements 'Didsbury' positioned at the beginning of the mark, and 'Cuisine' positioned at the end. Accordingly, weighing up the similarities with the differences, keeping in mind that both trade marks contain the same word 'ZEUGMA / Zeugma', I find the marks to be visually similar to a medium degree.

Aural comparison

55. The applicant's mark consists of seven syllables, namely 'Dids-bur-y-Zeug-ma-Cui-sine'. The opponent's marks consist of two syllables, namely 'ZEUG-MA / Zeug-ma'. Aurally, the entirety of the opponent's mark is the same as the applicant's fourth and fifth syllables, however. They differ in respect of the first three and last two syllables in the applicant's mark. Taking this into account, whilst bearing in mind the overall impression of the marks, I find that the marks are aurally similar to a medium degree.

Conceptual comparison

56. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

57. In its counterstatement, the applicant states that conceptually the term 'Zeugma' will be understood as a reference to a particular area of Turkey, along with the food that comes from that area, adding that people of Turkish descent, or of the geographical area, would be aware of this on the basis that Zeugma is part of Turkish culture and lifestyle. Even if a proportion of UK average consumers will understand the meaning of 'Zeugma' as stated by the applicant, there will be another group of consumers who are entirely unfamiliar with this meaning, and for those, the word 'ZEUGMA / Zeugma' contained in the competing marks is likely to be perceived as an invented word with no immediate concept.

58. With regard to the word 'Didsbury' present in the applicant's mark, this will likely be perceived as the geographical origin or location of the services at issue, on the basis that Didsbury is an area in Manchester, England.⁴ As for the word 'Cuisine' present in the applicant's mark, this will be understood as *a style or manner of cooking or a reference to food prepared at a restaurant*.⁵ Consequently, taking into account the services at issue, the average consumer is likely to perceive the words 'Didsbury' and 'Cuisine', as alluding to certain characteristics of the services at issue, namely that they relate to food prepared at a restaurant located in Didsbury.

59. Accordingly, the competing marks share the same word element 'ZEUGMA / Zeugma', and as previously discussed, for those who have knowledge of 'Zeugma' being a geographical area in Turkey, this element of the marks will share the same concept. However, for those consumers who are not aware of this meaning, the word will be perceived as invented, with no concept. Furthermore, as previously

⁴ See witness statement, [paragraph 12]

⁵ www.collinsdictionary.com/dictionary/english/cuisine

discussed, the applicant's mark contains the additional concepts emanating from the words 'Didsbury' and 'Cuisine'. Therefore, taking all the above into account, I find that there is at least a medium degree of conceptual similarity for the group of consumers familiar with the meaning of the word 'Zeugma', but for the group of consumers who perceive the word as invented, the marks are conceptually dissimilar.

Distinctive character of the earlier trade mark

60. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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).”

61. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

62. I will begin by assessing the inherent distinctive character of the earlier trade mark.

63. In its counterstatement, the applicant states that the word 'Zeugma' will be understood as a reference to a particular area of Turkey, along with the food that comes from that area. The applicant adds that people of Turkish descent, or of the geographical area, would be aware of this as 'Zeugma' is part of Turkish culture and lifestyle. Accordingly, the applicant argues that it should not be the case that a sole company only has the right to use this word in their establishment.

64. As previously discussed, I am of the view that the meaning of the mark as stated by the applicant may not be universally known, and therefore I consider there to be a dual finding in relation to the distinctiveness of the mark. For consumers unfamiliar with 'Zeugma' being a geographical location in Turkey and a reference to a particular Turkish cuisine, the mark will be perceived as invented affording it a high degree of inherent distinctiveness. However, where consumers are familiar with the geographical meaning of the word and as a reference to a particular Turkish cuisine, the mark will be perceived as highly allusive for the relevant services. However, as registered marks are assumed to have "at least some distinctive character",⁶ for this group of consumers, I find that the earlier mark will have a low degree of inherent distinctive character.

65. Although the opponent has not pleaded that its marks (series of two) have acquired enhanced distinctiveness through its use in the UK, the opponent has

⁶ *Formula One Licensing BV v OHIM*, Case C-196/11P

stated that its restaurant has continuously traded under the marks 'ZEUGMA / Zeugma' since 2004 and has provided sales figures relating to the services at issue which demonstrate a turnover of £1,060,000, in the UK, between 2015 and 2020. However, the turnover is relatively modest in the market for the services covered and is localised. The use of the mark has not enhanced its distinctive character beyond the inherent levels I have found above.

Likelihood of confusion

66. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor 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. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

67. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and services down to the responsible undertakings being the same or related.

68. Earlier in the decision I concluded that the parties' services range from identical to similar to a medium degree. Furthermore, I found that the marks are visually and aurally similar to a medium degree, and conceptually similar to at least a medium degree for those consumers familiar with the Turkish geographical meaning of the word 'Zeugma' along with the cuisine that comes from that area; for those that perceive the word as invented, the marks are conceptually dissimilar. Additionally, depending on consumers' perception of the word 'Zeugma', I have found that the earlier mark has either a high degree of inherent distinctiveness for consumers who

will perceive the word as invented, or a low degree of inherent distinctiveness for those who are aware of the Turkish geographical meaning and the cuisine that comes from that area. I have concluded that the average consumer will pay a medium degree of attention when selecting the services and that the purchasing process will be predominantly visual, however, I have not discounted aural considerations.

69. Taking into account the above, particularly the visual differences between the marks, namely the addition of the words 'Didsbury' at the start of the applicant's mark and 'Cuisine' at the end, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. Accordingly, I do not consider there to be a likelihood of direct confusion.

70. Having found no likelihood of direct confusion, I now go on to consider indirect confusion.

71. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC (as he then was), as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

72. These examples are not exhaustive but provide helpful focus.

73. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

74. I acknowledge that a finding of indirect confusion should not be made merely because the two marks share a common element. However, it is not sufficient that a mark merely calls to mind another mark:⁷ this is mere association not indirect confusion.

75. Given that the majority of the parties’ services are identical, the potential for the marks to be seen as alternative marks from the same or economically linked undertakings is increased. Whilst consumers will recognise that there is a difference

⁷ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

between the competing marks, they will also recognise the common word 'ZEUGMA / Zeugma' in both marks. Accordingly, whilst the average consumer will identify the differences between the marks, they will also identify the shared word element. Furthermore, I am also mindful of the fact that 'Didsbury' and 'Cuisine' contained in the applicant's mark are fairly weak in distinctive character, as they are likely to be perceived as allusive in respect of the type and geographical location of the services at issue, and therefore their addition to the word 'Zeugma' does little to alter the distinctiveness of the mark as a whole to the extent that consumers would see it as an entirely different undertaking. In relation to average consumers who perceive 'Zeugma' as invented, the word plays an independent and distinctive role within the contested mark. Accordingly, I am satisfied that this group of average consumers would assume a commercial association between the parties due to the shared element 'ZEUGMA / Zeugma'. For example, the applicant's mark comprising the words 'Didsbury-Zeugma-Cuisine, may be perceived as a branch of the same restaurant in Didsbury, or as a variation of the earlier mark which includes the location. Consequently, I consider there to be a likelihood of indirect confusion.

Conclusion

76. The opposition under Section 5(2)(b) of the Act has succeeded. Subject to any successful appeal, the application will be refused.

Costs

77. The opponent has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice ("TPN") 2/2016. I award costs to the opponent as follows:

Notice of opposition fee	£100
Preparing the Notice of Opposition and Considering the counter statement	£300
Preparing evidence	£500

TOTAL

£900

78. I therefore order ZEUGMA TURKISH CUISINE LTD to pay Bekir Yirtar the sum of £900. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 5th day of May 2023

Sam Congreve

For the Registrar