

O/198/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2517462
BY
FLAMIN GRILL LIMITED
TO REGISTER A SERIES OF TWO TRADE MARKS**



IN CLASSES 29, 30 AND 43

AND

**THE OPPOSITION THERETO
UNDER NO 99885
BY
SPIRIT PUB COMPANY (SERVICES) LIMITED**

Background

1. Flamin Grill Limited (“the applicant”) applied to register the following as a series of two trade marks on 29 May 2009:



The application is for:

Class 29: Meat, fish, seafood, poultry and game, all in prepared form; cooked meals and prepared meals in class 29 including cooked meals and prepared meals consisting principally of meat, fish, seafood, poultry, game, cheese, eggs and vegetables; constituents for meals; foods prepared from meat, fish, poultry, seafood and game products; foods prepared from eggs, vegetables and cheese; meat extracts; fruits and vegetables, all being preserved, dried or cooked; salads including fruit salads and vegetable salads; coleslaw; burgers including vegetable burgers, hamburgers, beefburgers, cheeseburgers and chicken burgers; cheese; kebabs; jellies, jams, fruit sauces; desserts, yoghurts; eggs; milk, milk preparations, milk beverages and milkshakes; sausages; edible oils and fats; olive oil; dressings of oil and/or fat; dips; potato products including potato skins, potato fries, potato chips, potato croquettes, potato wedges, potato fritters, hash brown potatoes, potato crisps and potato snacks; soups; pickles and relishes; all being Halal products.

Class 30: Prepared meals in the form of pizzas; prepared meals in the form of pizza pies; pizzas; bakery products including bread, bread filled products, pitta

bread, bagels, pastries, burger buns; cookies, doughnuts, cakes, biscuits and confectionery; pasta; rice; pies including meat pies and vegetable pies, noodles; pasties including meat pasties and vegetable pasties; stir fry prepared meals; cooked meals and prepared meals consisting principally of rice; cooked meals and prepared meals consisting principally of pasta; quiches; pancakes; sauces (condiments) including ketchup, mayonnaise, salad cream, salad dressings, horseradish sauces and tartare sauce; spices, salt, mustard; seasonings; corn chips, tortillas, tacos and snack foods; custard; gravy mixes; sorbets; waffles; puddings; coffee, tea, cocoa, sugar, tapioca, sago, artificial coffee; chocolate based beverages, cocoa based beverages, tea based beverages and coffee based beverages; ice cream; iced tea; all being Halal products.

Class 43: Restaurant and café services providing takeaway food using Halal meat and providing only non-alcoholic drinks; preparation of takeaway food using Halal meat; preparation of non-alcoholic drinks¹.

2. The application was published on 11 September 2009 in the *Trade Marks Journal*, following which an opposition was filed by Punch Pub Company Limited, now Spirit Pub Company (Services) Limited (“the opponent”). The opponent claims that the application offends section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This section states:

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

(a)

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

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

3. The opponent relies upon its registered trade mark number 2514409, claiming that the applicant’s mark is similar to its mark for identical or similar goods and services and that there would be a likelihood of confusion on the part of the public. Details for 2514409 are as follows:

Flaming Grill

Class 43: Services for providing food and drink; restaurant, bar and catering services.

¹ These are the current specifications following amendment by the filing of a Form TM21 on 4 July 2011.

Application date: 23 April 2009; date registration procedure completed: 31 July 2009.

4. The applicant filed a counterstatement, denying the ground of opposition. Both sides filed evidence and written submissions, choosing to have a decision made from the papers rather than attending a hearing.

Evidence

5. Yassir A Mukhtar, who has been a director of the applicant since 2004, has filed a witness statement and supporting exhibits. Mr Mukhtar states that the applicant has used its mark since 2004 in relation to restaurant and café services providing takeaway food using halal meat and providing non-alcoholic drinks and the preparations thereof. Mr Mukhtar also states that the applicant has used the mark on beef burgers, lamb burgers, shawarma, kebabs, cooked chicken, chips, onion rings, humus, falafel, salads and samosas. The applicant's turnover ranges from over £90,000 in 2005, to over £156,000 in 2009 (the year of application). The applicant has sold 40-50,000 menu items per year at an average menu item price of between £3 and £4 each. Advertising expenditure ranges from £1434, in 2005 to £12,000 in 2009; advertising has taken place in London borough directories and local London borough newspapers, but mainly via leaflet distribution (300,000 in 2009). Mr Mukhtar exhibits a photograph of the applicant's shop front, with the mark as signage, and a restaurant and takeaway menu leaflet which shows the mark on the front cover.

6. Mr Mukhtar states that the applicant's premises, on the Great West Road close to Heathrow Airport, means that the applicant's business is known to large number of people travelling in and out of London from surrounding areas. Mr Mukhtar says the applicant's products are Halal and have a wide appeal among the Asian and Arabic community in these geographical areas and beyond through family connections and recommendations. As support for this statement, Mr Mukhtar exhibits prints from the applicant's Facebook page. The opponent rebuts this claim by filing evidence from its trade mark attorney, Alice Davies (at the firm of Murgitroyd and Company). Ms Davies states that her internet search using "the keywords FLAMING, GRILL and HALAL revealed a number of fastfood outlets in the vicinity of the postcode TW3 of West London (the applicant is in TW7). She says that people would not be prepared to or need to travel to visit the applicant's premises for items in the £3-4 price range because there are plenty of similar outlets which are nearer.

Decision

7. The leading authorities which guide me in this Section 5(2)(b) ground are from the Court of Justice of the European Union ("CJEU"): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000]

F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

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

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the

distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

Comparison of goods and services

8. It is necessary for me to determine the level of similarity between the parties' services on account of the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa, as a factor in the global appreciation of the likelihood of confusion².

9. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* 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.”

‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 It is true that goods are complementary if there is a 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 As per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

10. 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 included an assessment of the channels of trade of the respective goods or services.

11. In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that:

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

Jacob J also said, in *Treat*:

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

12. Specifications should not be given an unnaturally narrow meaning, as per *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267. Finally, if goods or services fall within the ambit of terms within the competing specification, they are considered to be identical, as stated by the GC in *Gérard Meric v OHIM*, case T-133/05³.

13. The parties’ respective specifications are:

| Opponent | Applicant |
|--|---|
| <i>Services for providing food and drink; restaurant, bar and catering services.</i> | Class 29: <i>Meat, fish, seafood, poultry and game, all in prepared form; cooked meals and prepared meals in class 29 including cooked meals and prepared meals consisting principally of meat, fish, seafood, poultry, game, cheese, eggs and vegetables; constituents for meals; foods prepared from meat, fish, poultry, seafood and game products; foods prepared from eggs, vegetables and cheese; meat extracts; fruits and</i> |

³ 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 Vedral 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).”

| | |
|--|--|
| | <p><i>vegetables, all being preserved, dried or cooked; salads including fruit salads and vegetable salads; coleslaw; burgers including vegetable burgers, hamburgers, beefburgers, cheeseburgers and chicken burgers; cheese; kebabs; jellies, jams, fruit sauces; desserts, yoghurts; eggs; milk, milk preparations, milk beverages and milkshakes; sausages; edible oils and fats; olive oil; dressings of oil and/or fat; dips; potato products including potato skins, potato fries, potato chips, potato croquettes, potato wedges, potato fritters, hash brown potatoes, potato crisps and potato snacks; soups; pickles and relishes; all being Halal products.</i></p> |
| | <p><i>Class 30: Prepared meals in the form of pizzas; prepared meals in the form of pizza pies; pizzas; bakery products including bread, bread filled products, pitta bread, bagels, pastries, burger buns; cookies, doughnuts, cakes, biscuits and confectionery; pasta; rice; pies including meat pies and vegetable pies, noodles; pasties including meat pasties and vegetable pasties; stir fry prepared meals; cooked meals and prepared meals consisting principally of rice; cooked meals and prepared meals consisting principally of pasta; quiches; pancakes; sauces (condiments) including ketchup, mayonnaise, salad cream, salad dressings, horseradish sauces and tartare sauce; spices, salt, mustard; seasonings; corn chips, tortillas, tacos and snack foods; custard; gravy mixes; sorbets; waffles; puddings; coffee, tea, cocoa, sugar, tapioca, sago, artificial coffee; chocolate based beverages, cocoa based beverages, tea based beverages and coffee based beverages; ice cream; iced tea; all</i></p> |

| | |
|--|--|
| | <i>being Halal products.</i> |
| | <i>Class 43: Restaurant and café services providing takeaway food using Halal meat and providing only non-alcoholic drinks; preparation of takeaway food using Halal meat; preparation of non-alcoholic drinks</i> |

14. The applicant submits that because its goods and services are limited to halal, they are not identical to the opponent's services. It says, in relation to class 43:

“The services of the Earlier Mark in class 43 are not so limited and it is clear that the earlier mark covers services that included food and drink where there is no specificity as to the nature of the food and drink being offered. That makes such services entirely different from those of the Trade Mark and not acceptable to those who require Halal food. In addition, the services of the Earlier Mark include “bar” services – which must include the provision of alcoholic drink, again making the services of the Earlier Mark entirely different from those of the Trade Mark.”

15. This submission cannot be correct; a limitation, by its very nature, defines the scope of something potentially wider (as was the case here before the applicant added the limitation by filing a Form TM21). The opponent's specification is unlimited, therefore it includes all types of food and drink (services), including halal. The average consumer may seek out halal food and drink, which is part of the purchasing process and level of attention he or she pays to that purchase, but halal food and drink is covered by the opponent's specification.

16. Where appropriate, I will group together the applicant's goods or services for comparison purposes⁴. I will start with the applicant's services.

17. Restaurant and café services providing takeaway food using Halal meat and providing only non-alcoholic drinks; preparation of takeaway food using Halal meat; preparation of non-alcoholic drinks.

The opponent's term *services for providing food and drink* is a wide term which encompasses restaurants, cafés, takeaway services and the preparation of drink.

⁴ As per the decision of Mr Geoffrey Hobbs Q.C. , sitting as the appointed person, in *Separode Trade Mark* BL O-399-10, with reference to *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ECR I-1455 at paragraphs [30] to [38]: “The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

As explained above, it makes no difference that the applicant's specification is limited because the opponent's specification is unlimited and covers the provision of all types of food and drink; consequently, all the applicant's services are identical to the opponent's services.

18. In comparing goods with services (the opponent only has cover for services), there is, of course, a difference between the nature of a good and the nature of a service, which also affects the method of use comparison. Goods and services can, however be complementary, share channels of trade and they can be in competition with one another. This is particularly pertinent when considering services which provide food and drink, against food and drink goods which have been prepared. Takeaway services are within the scope of the opponent's services. A takeaway service is complementary to the takeaway, which is a prepared meal. The supply of the goods is essential to the supply of the services; the purpose of both the takeaway and the service is to satiate hunger or thirst; the channel of trade will be the same, and the users will be the same. In relation to restaurants and bars, consumers have a choice whether to visit an establishment where they can eat and/or drink, or they can buy a prepared meal and/or drink and take it home: the users are the same, the goods and services have the same purpose, but this time the goods and services are in competition. There is a high degree of similarity between the opponent's services and the following goods of the application which are either specified as prepared meals or drinks, or are in the nature of prepared meals or desserts for taking away (such as chips, soups, pasties, doughnuts and ice cream):

Class 29

cooked meals and prepared meals in class 29 including cooked meals and prepared meals consisting principally of meat, fish, seafood, poultry, game, cheese, eggs and vegetables;

foods prepared from meat, fish, poultry, seafood and game products; foods prepared from eggs, vegetables and cheese;

salads including fruit salads and vegetable salads; coleslaw

burgers including vegetable burgers, hamburgers, beefburgers, cheeseburgers and chicken burgers; kebabs;

milk beverages and milkshakes;

potato products including potato skins, potato fries, potato chips, potato croquettes, potato wedges, potato fritters, hash brown potatoes, and potato snacks;

soups;

desserts

all being Halal products.

Class 30

Prepared meals in the form of pizzas; prepared meals in the form of pizza pies; pizzas;

bakery products including bread filled products, bagels, pastries; cookies, doughnuts, cakes, biscuits and confectionery;

pies including meat pies and vegetable pies; pasties including meat pasties and vegetable pasties;

stir fry prepared meals; cooked meals and prepared meals consisting principally of rice; cooked meals and prepared meals consisting principally of pasta; quiches;

snack foods;

pancakes; sorbets; waffles; ice cream;

chocolate based beverages, cocoa based beverages, tea based beverages and coffee based beverages; iced tea;

all being Halal products.

19. Dressings of oil and/or fat; dips; pickles and relishes; fruit sauces; all being Halal products

Sauces (condiments) including ketchup, mayonnaise, salad cream, salad dressings, horseradish sauces and tartare sauce; mustard; seasonings; all being Halal products

These items have an affinity with prepared meals, ice cream and desserts which are taken away for immediate consumption. There is a shared channel of trade and a measure of complementarity, although it is not as strong as in the case of the prepared meal itself. There is an average level of similarity between the opponent's services and these goods.

20. Meat, fish, seafood, poultry and game, all in prepared form; constituents for meals; meat extracts; fruits and vegetables, all being preserved, dried or cooked; cheese; jellies, jams; yoghurts; eggs; milk, milk preparations; sausages; edible oils and fats; olive oil; all being Halal products.

Bakery products including bread, pitta bread; burger buns; pasta; rice; noodles; spices, salt; corn chips, tortillas, tacos; custard; gravy mixes; puddings; coffee, tea, cocoa, sugar, tapioca, sago, artificial coffee; all being Halal products.

Although the listed meat, fish, seafood, poultry and game is all in prepared form, I do not consider that this equates to prepared meals; more that it signifies goods in their raw form which have been (for example) filleted, de-scaled, or had the feathers removed. With the exception of corn chips which are more like crisps, all the goods which I have listed in this final category are in the nature of ingredients or goods to which other food goods are added; none of the listed goods are in the nature of prepared meals and so are not in competition or are complementary to takeaway, bar or restaurant services (as opposed to prepared meals and drinks)⁵. In relation to *catering services*, which would be understood by the average consumer as the provision of cooked or prepared meals and drink at a function or event, even then I think it unlikely that there is a complementary relationship in such a way that consumers may think that the same undertaking is responsible for both supplying the unfinished 'raw' food goods (e.g. milk, eggs, meat) and the service. There is no shared nature, purpose or channel of trade, nor meaningful level of complementary or competitive relationship with the goods listed in this paragraph. There is no similarity between these goods and the opponent's services.

Average consumer and the purchasing process

21. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods. The average consumer for the parties' goods and services is the general public; in the applicant's case, those who are looking for halal food. Depending on the nature of the food and drink establishment, the type of food sold and the prices charged, the attention of the consumer will vary. For example, a quick dash into a takeaway will not cause the same level of attention to be paid as choosing to dine at an expensive restaurant, although those who need to ascertain whether the goods are halal, or the establishment is halal, will pay more attention. In the main, the purchaser will pay a reasonable amount but not the highest amount of attention. The purchasing process will be primarily visual, but oral use of the mark may also play a part.


⁵ The GC considered the relationship between finished article and component parts in *Les Editions Albert René v OHIM* Case T-336/03:

"The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular their nature, intended purpose and the customers for those goods may be completely different."

Comparison of trade marks

22. The above authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details. Although the application is for a series of two marks, I will, for convenience, refer to the mark in the singular because the colour element in the first mark in the series makes no difference to the comparison of marks, the opponent's mark being registered without reference to colour⁶.

23. The marks to be compared are:

| Opponent's mark | Application |
|-----------------|---|
| Flaming Grill |  |

24. In the opponent's mark, Flaming describes the Grill, which means that although Flaming is the longer word and is at the beginning of the mark, the combination of the two words creates an indissociable whole; consequently, both words in the opponent's mark constitute the distinctive and dominant components of the mark⁷. In the applicant's mark, the solid circle will simply be

⁶ See the judgment of Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch), paragraph 119.

⁷ See the General Court in *Ella Valley Vineyards (Adulam) Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* T-32/10: "43 Although, as the Board of Appeal stated, in the mark applied for the word 'ella' is larger than 'valley' and it is positioned above the latter, it must be held that the configuration of the mark applied for is such that those two words cannot be perceived separately. It must be held that the words 'ella' and 'valley' are both contained within the black rectangle and are written with the same font and the same colour. Thus, on account of the contiguity of those two words in the black rectangle, and their identical font and colour, and despite the difference in size, the relevant public will perceive the expression 'ella valley' as an indissociable whole. In that connection, it should be recalled that, according to

regarded as background; it is the words, and flame devices, which are dominant. The flame devices are substitutes for letters; the natural inclination is to “read through” the words by approximating the flames to the ‘missing’ letters. The words are the dominant distinctive element in the applicant’s mark, with the flames forming an integral part of the words.

25. The substituted letters in the applicant’s mark impact upon the visual, aural and conceptual comparisons between the parties’ marks. The circle background plays a small part in the visual impression (and no part in the aural and conceptual impression) of the mark. A strict visual comparison between the word elements of the parties’ marks is:

| | | |
|---------------|-----|-----------------|
| Flaming Grill | AND | Flam n Gr ll |
|---------------|-----|-----------------|

However, the positioning of the flame devices creates an impression of substituted letters, a substitution which will cause the average consumer to approximate the incomplete words in the applicant’s mark to words which he or she knows. In the case of “Gr ll”, the natural response will be “Grill”, which is the second word in the opponent’s mark. “Flam n” is less obvious than “Gr ll” because not only is there a flame device instead of a letter, but the word also ends in “n”. The opponent’s “Flaming” and the applicant’s “Flam n” are less similar visually than “Grill” and “Gr ll”. Although the flame devices play the part of replacement letters, they are nevertheless devices which are not present in the opponent’s mark. Balancing all this, there is a reasonable level of visual similarity between the marks.

26. The propensity to ‘read through’ and make sense of words with missing letters, as described above, means that the average consumer will see the applicant’s mark as Flamin Grill. “Gr ll” will be perceived and pronounced as ‘grill’; in the context of ‘grill’, ‘flamin’ is more likely to be pronounced as Flamin(g) than Flammin(g), despite the missing ‘g’ from the end of Flaming. There is a very high degree of aural similarity between the parties’ marks.

27. The substitution role played by the devices in the applicant’s mark has the biggest impact when considering the conceptual impression of the mark. That the devices are (i) flames and (ii) are substitutes for letters in words which resemble “Flaming” and “Grill” prompts an immediate conceptual impression of a

settled case-law, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Case C-532/10 P adp Gauselmann v OHIM [2011] ECR I-0000, paragraph 24 and the case-law cited).”

grill with flames. This must also be the case for the opponent's mark which consists entirely of the words Flaming Grill. The marks are conceptually identical.

28. Overall, there is a reasonably high degree of similarity between the marks.

Distinctiveness of the earlier mark

29. It is important that I consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁸. The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public⁹. The opponent has not filed any evidence of use, so I have only the inherent distinctive position to consider. The opponent's mark is registered for services for providing food and drink; restaurant, bar and catering services. In the context of these services, the earlier mark has strong connotations of a grill with flames, producing flame grilled food. The opponent submits that Flaming Grill is not the normal way of classifying restaurant services and is therefore highly distinctive for these services. I disagree. Flaming Grill may not be the exact term which would be used to describe the provision of food and drink which is 'flame grilled', but it leaves little to the imagination (a restaurant which cooks food on a grill which is flaming) and has no more than a low level of distinctive character for these services.

Likelihood of confusion

30. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I have found that the applicant's goods and services range from identical to not similar to the opponent's services. Where there is no similarity between the opponent's services and the applicant's goods, there can be no likelihood of confusion (*Canon*).

31. I bear in mind the whole mark comparison and the dominant and distinctive elements within the marks. I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. Although the opponent's mark is low in distinctive character, this does

⁸ *Sabel BV v Puma AG* [1998] RPC 199.

⁹ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

not of itself preclude a likelihood of confusion; as per the CJEU judgment in *L'Oréal SA v OHIM* Case C-235/05 P¹⁰:

“43 It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

45 The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

32. For the reasons given earlier, there is also a very high degree of aural similarity between the marks. Although there are visual differences, there is still a reasonable amount of visual similarity between the marks. The average consumer will not consider that the visual differences must mean that different undertakings are responsible for the goods and services, despite there being an identical concept. The identical concept of a flaming grill is likely to cause consumers, who are paying no more than a reasonable level of attention to their purchase, to view the applicant’s mark as a fancier version of the opponent’s mark. Bearing in mind that the comparison between goods and services and between the marks, are interdependent, and even though the opponent’s mark is low in distinctive character, this identical concept, high aural similarity and reasonable visual similarity, when combined with those goods and services which range from identical to averagely similar, will result in a likelihood of confusion. It cannot help the applicant that it has been using the mark (and how it has used it) in the face of a ground brought under section 5(2)(b) for an earlier

¹⁰ See also the comments of Professor Ruth Annand and Daniel Alexander QC, both sitting as appointed persons, in respective cases *AMBROSIA FEEL GOOD PUDS* (BL O/145/12) and *PETMEDS* (BL O/471/11).

registered mark which is not subject to proof of use. It is a test between the two marks and their goods and services on the basis of notional and fair use.

Outcome

33. The opposition succeeds against the following goods and services of the application, for which it is to be refused:

Class 29: Cooked meals and prepared meals in class 29 including cooked meals and prepared meals consisting principally of meat, fish, seafood, poultry, game, cheese, eggs and vegetables; foods prepared from meat, fish, poultry, seafood and game products; foods prepared from eggs, vegetables and cheese; salads including fruit salads and vegetable salads; coleslaw; burgers including vegetable burgers, hamburgers, beefburgers, cheeseburgers and chicken burgers; kebabs; fruit sauces; desserts; milk beverages and milkshakes; dressings of oil and/or fat; dips; potato products including potato skins, potato fries, potato chips, potato croquettes, potato wedges, potato fritters, hash brown potatoes, potato crisps and potato snacks; soups; pickles and relishes; all being Halal products.

Class 30: Prepared meals in the form of pizzas; prepared meals in the form of pizza pies; pizzas; bread filled products, bagels, pastries; cookies, doughnuts, cakes, biscuits and confectionery; pies including meat pies and vegetable pies; pasties including meat pasties and vegetable pasties; stir fry prepared meals; cooked meals and prepared meals consisting principally of rice; cooked meals and prepared meals consisting principally of pasta; quiches; pancakes; sauces (condiments) including ketchup, mayonnaise, salad cream, salad dressings, horseradish sauces and tartare sauce; mustard; seasonings; snack foods; sorbets; waffles; chocolate based beverages, cocoa based beverages, tea based beverages and coffee based beverages; ice cream; iced tea; all being Halal products.

Class 43: Restaurant and café services providing takeaway food using Halal meat and providing only non-alcoholic drinks; preparation of takeaway food using Halal meat; preparation of non-alcoholic drinks.

However, the opposition fails in respect of the following goods of the application, for which it is to be registered:

Class 29: Meat, fish, seafood, poultry and game, all in prepared form; constituents for meals; meat extracts; fruits and vegetables, all being preserved, dried or cooked; cheese; jellies, jams; yoghurts; eggs; milk, milk preparations; sausages; edible oils and fats; olive oil; all being Halal products.

Class 30: Bakery products including bread, pitta bread; burger buns; pasta; rice; noodles; spices, salt; corn chips, tortillas, tacos; custard; gravy mixes; puddings; coffee, tea, cocoa, sugar, tapioca, sago, artificial coffee; all being Halal products.

Costs

34. The opponent has been partially successful and is entitled to an award of costs, adjusted to take account of the proportion of the specifications which the applicant successfully defended¹¹. The cost award breakdown is:

| | |
|---|-------------|
| Preparing a statement and considering the applicant's statement | £200 |
| Opposition fee | £200 |
| Considering the applicant's evidence and filing evidence and written submissions in reply | £500 |
| Preparing submissions in lieu of a hearing | £300 |
| Total: | £1200 |
| Adjustment as a 25% reduction: | - £300 |
| Total | £900 |

35. I order Flamin Grill Limited to pay Spirit Pub Company (Services) Limited the sum of £900. 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 11th day of May 2012

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

¹¹ As per the scale in Tribunal Practice Notice 4/2007.