

**O-338-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3079439  
BY  
ASHISH SUTARIA**

**TO REGISTER THE TRADE MARK**



**IN CLASS 43**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 600000196  
BY  
CHEEKY ITALIAN LIMITED**

## BACKGROUND


1. On 30 October 2014, Ashish Sutaria (the applicant) applied to register the trade mark shown on the cover page of this decision, in class 43 of the Nice Classification system.<sup>1</sup> The specification stands as follows:

**Class 43**

Services for providing food and drink; catering services, mobile catering services.

2. The application was published on 21 November 2014. Cheeky Italian Limited (the opponent) filed notice of opposition against the application under the fast track opposition procedure.

3. The opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon UK trade marks 3016730 and 3017287, shown below:

| Mark details and relevant dates  | Services relied on  |
|--|---|
| <p><b>Mark:</b></p>  <p><b>Filing date:</b> 5 August 2013</p> <p><b>Date of entry in the Register:</b><br/>1 November 2013</p> | <p><b>Class 43</b></p> <p>Services for providing food and drink; Bar, restaurant and catering services; Mobile catering services; Hotel catering services; Consultancy services relating to food and food preparation; Contract food services; Arranging of wedding receptions [food and drink]; Corporate hospitality (provision of food and drink).</p> |
| <p><b>Mark:</b></p> <p><b>Cheeky</b></p> <p><b>Filing date:</b> 8 August 2013</p> <p><b>Date of entry in the Register:</b><br/>13 June 2014</p>  | <p><b>Class 43</b></p> <p>Mobile catering services; Arranging of wedding receptions [food]; Corporate hospitality (provision of food); all of the aforesaid services in relation to outside or mobile catering services.</p>  |

4. On 17 October 2014, the applicant filed a counterstatement, denying the ground of opposition.

5. Rules 20(1)-(3) of the Rules (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4) does. It reads:

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<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions.

7. No leave was sought in respect of these proceedings.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken.

9. A hearing was neither requested nor considered necessary. The applicant filed written submissions, which I will refer to as necessary, below.

## **DECISION**

10. The opposition is brought under section 5(2)(b) of the Act which reads as follows:

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

### **Section 5(2)(b) case law**

11. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

#### The CJEU cases

*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; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

#### 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, in certain circumstances, be dominated by one or more of its components;

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

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

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

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

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

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

### **The average consumer and the nature of the purchasing act**

12. In accordance with the above cited case law, I must determine who the average consumer is for the services at issue and also identify the manner in which those services will be selected in the course of trade.

13. 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.”

14. Outside catering services are normal everyday services provided to members of the general public. They may also be commissioned by businesses providing catering on a regular basis or as part of a particular event or function. A member of the public buying food or drink is likely to pay no more than an average level of attention to the purchase, whereas a business commissioning the services or a member of the public hiring, for example, wedding caterers, is likely to pay an above average level of attention to what is not a casual purchase. They may need to consider, inter alia, the nature of the event, cost and venue. In both cases the purchase is likely to be primarily visual, being made from advertising leaflets, flyers and websites and in the case of a member of the general public, possibly at the point of sale. However, I do not rule out the potential for oral use of the mark.

**The opponent’s earlier marks**



15. I will deal first with the opponent’s mark 3016730 for .

**Comparison of services**



16. The services to be compared are as follows:

| The opponent’s services   | The applicant’s services  |
|---|---|
| <p><b>Class 43</b><br/>           Services for providing food and drink; Bar, restaurant and catering services; Mobile catering services; Hotel catering services; Consultancy services relating to food and food preparation; Contract food services; Arranging of wedding receptions [food and drink]; Corporate hospitality (provision of food and drink).</p> | <p><b>Class 43</b><br/>           Services for providing food and drink; catering services, mobile catering services.</p> |

17. The opponent’s specification includes, ‘services for providing food and drink; catering services; Mobile catering services’. These are clearly identical to the applicant’s services.

## Comparison of marks

18. The marks to be compared are as follows:

| The opponent's mark   | The applicant's mark   |
|---|--|
|  |  |

19. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components<sup>2</sup>, but 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.

20. The opponent's mark consists of the words 'Cheeky Italian' presented in title case. 'Cheeky' is presented above the word 'Italian' with both words the same size. The words are outlined in pink and both are rotated anticlockwise resulting in the mark as a whole slanting up to the right. The word 'Italian' lacks distinctiveness in respect of the services at issue, accordingly, it is the first word 'Cheeky' which plays a greater role in the overall impression of the mark.

21. The applicant's mark consists of the words 'The Cheeky Indian' and 'Indianish Street Food'. The two largest words in the mark are 'Cheeky Indian' presented in title case. There is a degree of stylization in that the "double e" within the word is presented as part of a face as the letters each contain a pupil and have a moustache underneath them. The first word of the mark, 'The' is presented above the 'ee' of the word 'Cheeky' and is smaller than the words 'Cheeky Indian'. The tittle of the second 'i' in the word 'Indian' takes the form of a four pointed star. The words 'Indianish Street Food' are considerably smaller than the rest of the mark and sit below the word 'Indian'. The words 'Indian' and 'Indianish Street Food' are descriptive of the services in class 43 and accordingly, lack distinctiveness. The stylization of the mark plays a small role in the overall impression but it is the word 'Cheeky' which plays the greatest role in the overall impression of the mark.

### Visual similarities

22. Visually, the elements I have identified in the preceding paragraphs as contributing to the respective overall impressions of the marks result in a number of differences between them. Not least, the stylised face within the word 'Cheeky' contained in the application. With regard to visual similarity, this rests in the fact that both mark contain the word 'Cheeky' and that in both marks it has a dominant position being the first word in the opponent's mark and the furthest left in the application. In conclusion, there is a moderate degree of visual similarity between them.

<sup>2</sup> *Sabel v Puma AG, para.23*

## **Aural similarities**

23. Both marks contain common English words which will be known to the average consumer. The applicant's mark will be articulated, 'The Cheeky Indian'. It is unlikely that 'Indianish Street Food' will be spoken as it is simply descriptive of the services. The opponent's mark will be articulated in full, as 'Cheeky Italian'.

24. Clearly the marks coincide to the extent that they both contain the word 'Cheeky'. They differ in that the applicant's mark starts with 'The' and ends with 'Indian' and while the opponent's ends with the word 'Italian'.

25. The marks are aurally similar to a moderate degree.

## **Conceptual similarities**

26. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.<sup>3</sup> The assessment must be made from the point of view of the average consumer.

27. Both marks contain the word 'Cheeky' which will be understood by the average consumer to mean insolent or impertinent, usually in an amusing or endearing way. Whatever the exact interpretation the average consumer gives the word, it will be the same in respect of both marks.

28. The additional word 'Italian' in the opponent's mark, combined with the word 'Cheeky', creates an overall impression of either an Italian individual who is cheeky or of an establishment/caterer serving Italian cuisine called 'cheeky'.

29. The application contains the additional words, 'The' and 'Indian' which, combined with the word 'Cheeky' may be seen as referring to an individual (particularly with the addition of the definite article) or, alternately, it may convey the conceptual impression of a particular establishment specializing in Indian cuisine called 'cheeky'.

30. These marks are conceptually similar to a medium degree.

## **Distinctive character of the earlier mark**

31. In determining the distinctive character of a trade mark it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify its goods as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

32. The second word of the opponent's mark, the word 'Italian' may be seen to describe the type of cuisine offered by the services in class 43 but in combination with the word 'Cheeky', the mark as a whole is a trade mark possessed of a medium degree of inherent distinctive character.

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<sup>3</sup> 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.

## Likelihood of confusion

33. In assessing the likelihood of confusion, I must adopt the global approach advocated by case-law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>4</sup> I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to 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.

34. I note that in its submissions the applicant draws my attention to twelve marks on the UK Trade Mark Register which contain the word 'Cheeky' and are registered in class 43. It has long been established that state of the register evidence of this type does not assist the applicant. It does not indicate whether the marks are being used, or give any indication of the goods [or services] on which any use has been made or what agreements may be in place between those parties. It is not, therefore, an indicator of whether or not there will be confusion in the market place in relation to the respective trade marks.<sup>5</sup> Consequently, I will not consider this submission any further.

35. Earlier in this decision I concluded that the marks share a moderate degree of visual and aural similarity and a medium degree of conceptual similarity. I have found the earlier mark to have a medium degree of inherent distinctive character. I have found the applicant's services in class 43 to be identical to the opponent's services in the same class.

36. Taking all of these factors into account, the differences between the marks are such that I do not find there to be direct confusion, where one mark is mistaken for the other. With regard to indirect confusion, I am mindful of *L.A. Sugar Limited v By Back Beat Inc*<sup>6</sup>, in which Mr Iain Purvis Q.C. sitting as the Appointed Person noted 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:

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<sup>4</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

<sup>5</sup> see Jacob J in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 and the General Court in *Zero Industry Srl v Office of Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)*, Case T-400/06 and *GfK AG v Office of Harmonisation in the Internal Market (trade Marks and Designs)(OHIM)*, Case T-135/04

<sup>6</sup> Case BL-O/375/10



(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).”

37. In my view, the change of the last word of each mark from Italian to Indian (or vice versa) does fall squarely within the types of indirect confusion identified in *LA Sugar*, particularly the brand extension point. If the average consumer were familiar with either mark and encountered the other they would simply conclude that one was a ‘Cheeky’ outlet providing Italian cuisine and the other was a ‘Cheeky’ retailer providing Indian cuisine leading to such a connection between them that would result in a belief that the services are being provided by an economically linked undertaking.

## **CONCLUSION**

### **38. The opposition succeeds under section 5(2)(b) of the Act.**

39. Having reached such a conclusion I need not go on to consider the opponent’s second mark as this would put them in no better position.

## **COSTS**

40. The opposition having succeeded, the opponent is entitled to a contribution towards its costs. The award stands as follows:

Preparing a statement and considering the other side’s statement: £300

Official fee: £100

Total: £400

41. I order Ashish Sutaria to pay Cheeky Italian Limited the sum of £400. 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 23rd day of July 2015**

**Ms Al Skilton  
For the Registrar,  
The Comptroller General**