

O-185-16

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3072329

BY

QUALITY MEAT SCOTLAND

TO REGISTER THE TRADE MARK

The Scotch Kitchen

IN CLASSES 29, 35, 42, 43 & 44

AND

THE OPPOSITION THERETO

UNDER NO 403861

BY TIHOMIR LALIC

Background and pleadings

1) On 12 September 2014, Quality Meat Scotland (“the applicant”) applied to register the trade mark “The Scotch Kitchen” in the UK. It was accepted and published in the Trade Marks Journal on 28 November 2014 in respect of the following goods and services.

Class 29: Meat

Class 35: Advertising and advertisement services; business information services

Class 42: Creating, designing and maintaining web sites; hosting of digital content on the Internet

Class 43: Provision of food and drink; provision of food and drink in restaurants; provision of information relating to the booking of accommodation

Class 44: Nutritional guidance; provision of information relating to nutrition

2) On 2 March 2015, Tihomir Lalic (“the opponent”) opposed class 43 “Provision of food and drink; provision of food and drink in restaurants”¹. The opposition is on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent is relying upon the following earlier UK trade mark registration no. 2638769 (“the earlier mark”)²:

The logo for 'THE SCOTCH' features the word 'THE' in a small, vertical, sans-serif font to the left of the word 'SCOTCH', which is written in a large, bold, sans-serif font. The 'O' in 'SCOTCH' has a keyhole-shaped cutout in its center.

Mark:

Filing date: 16 October 2012

Publication date: 9 November 2012

Date of entry on register: 18 January 2013

Relied upon services: Class 43 “The provision of food and drink”

3) The opponent argues that the respective services are identical and that due to the phonetic similarities between the respective marks there is a likelihood of confusion, which includes a likelihood of association, amongst members of the general public.

¹ The opposition was not directed against “provision of information relating to the booking of accommodation”.

² The earlier mark also covers class 41 services but these were not relied upon in this opposition.

4) The applicant filed a counterstatement denying the claims made particularly since the only common element (SCOTCH) is low in distinctive character. Further, it argues that the visual impact of THE KITCHEN results in the application longer and renders the respective marks conceptually very different. Therefore, there is no likelihood of confusion between the respective trade marks.

5) Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision.

6) A telephone hearing took place on 14 January 2016, with the applicant represented by Mr Peter Galloway of Morton Fraser LLP and the opponent represented by Matthew Gardner of the Trade Marks Bureau.

Opponent's evidence

Witness statement of Matthew Gardner and exhibits MG1 – MG4

7) Mr Gardner of The Trade Marks Bureau is the opponent's representative.

8) Exhibit MG2 consists of a Google search conducted on 4 August 2015 for "the scotch". Mr Gardner states that the results list refers to the opponent's earlier mark.

9) Exhibit MG3 comprises a Wikipedia extract headed "The Scotch of St. James". It is dated 4 August 2015. It states The Scotch of St. James nightclub was opened on 14 July 1965 and attracted "London's rock elite". It was closed down in the mid 1980s but re-opened in 2012, attracting pop stars and celebrities.

10) Exhibit MG4 consists of various articles that refer to the opponent's mark as THE SCOTCH. These essentially consist of third party reviews of The Scotch nightclub and lists the famous attendees.

DECISION

Legislation

11) Sections 5(2)(b) of the Act is 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

General case law

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

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

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

Application	Earlier mark
Class 43 – Provision of food and drink; provision of food and drink in restaurants	Class 43 – The provision of food and drink

13) It is clear that the respective services are identical. Whilst the application also specifically states that the food and drink is provided in restaurants it is covered by the broader term of the earlier mark and therefore identical.

Comparison of marks


14) 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.”

15) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the

marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

16) The respective trade marks are shown below:

Application	Earlier mark
The Scotch Kitchen	

17) The earlier mark consists of the words THE SCOTCH with a keyhole device within the letter O. The word Scotch is larger and more prominent than the non-distinctive “THE”. “Scotch” is also more prominent than the keyhole device which I do not consider to be dominant or prominent in the mark as a whole. Therefore, I consider the overall impression of the mark to be the words “THE SCOTCH”.

18) The application consists of three words, namely “The Scotch Kitchen”. The overall impression of the mark is a kitchen which may either serve food and drink of Scotch heritage or have some form of Scottish influence.

19) Visually, the application begins with the same words as the earlier mark. The earlier mark does also contain the keyhole device though this is not dominant or prominent in the marks as a whole. The marks are visually similar to an above medium degree, but not high.

20) The application would be pronounced as The Scotch Kitchen and the earlier mark as The Scotch. The key device in the earlier mark will not play any part in the pronunciation. In view of the aforementioned, the only aural difference between the respective marks is the last word, i.e. kitchen. On this basis, I find that the respective marks are aurally similar to a high degree.

21) Conceptually the earlier mark will be remembered as a reference to Scottish people, whisky or something else Scottish related. With regard to the application,

this would be recalled as being a kitchen that either serves Scottish food or possibly as an establishment owned by people of Scottish descent. Regardless of the specific feature or characteristic the overall impression of the respective marks and what would be remembered by the consumers would be “scotch”. They are similar to a medium degree.

Average consumer and the purchasing act

22) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

23) 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 at paragraph 60 in these terms:

“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.”

24) The services in question are the provision of food and drink. These are broad services which would generally be used by the general public and businesses on a less frequent basis. The cost of the services will vary from top-end restaurants to inexpensive fast food outlets. Nevertheless, all of the services will involve a medium degree of care and attention paid when deciding whether to use the services. The relevant marks are likely to be encountered visually on signage, on the internet, in advertisements and brochures, food reviews, etc., but word-of-mouth

recommendations and telephone ordering will also play a part. Therefore, the services would be sought following a visual inspection but I shall also take into account aural references.

Distinctive character of the earlier trade mark

25) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“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).

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).”

26) The opponent has not claimed to have an enhanced distinctive character by virtue of the use made of the mark. It has outlined the history and famous attendees of its bar, but has not provided turnover, marketing or any further evidence to support enhanced distinctive character. Therefore, I must only consider the inherent distinctive character of the mark.

27) The applicant argues that:

“Since the mark is registered in this form so as to be non-descriptive its proprietor cannot now rely upon it to bar others in the trade from using the adjective Scotch. Consequently, the cited mark is vulnerable to an invalidation action based upon the opponent’s own case that it has the right to prevent descriptive use of the term. No such right is conferred by its protection on the register and if this was so then it should never have been registered in the first place!”

28) I agree with the applicant that the mark is not the most distinctive of trade marks. However, I do not consider it to be devoid of distinctive character. It has a low degree of inherent distinctive character since the words do not directly describe the services and the small device of a lock has no bearing on the services in question. For the avoidance of doubt, I maintain that the key device is not dominant in the mark as a whole, but it does contribute a modicum of distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

29) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first 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 opponent’s trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.

30) Earlier in this decision I concluded that:

- The average consumers of the services are the general public, and occasionally businesses. The services would be acquired following a visual perusal, though aural considerations are also taken into account.
- The respective services are identical.
- Visually the marks are similar to an above medium degree but not high. Aurally the marks are similar to a high degree, and conceptually similar to a medium degree.
- I consider the earlier mark to have a low degree of inherent distinctive character.

31) Taking all of the above into consideration I conclude that there is a likelihood of direct confusion. The applicant has argued that the earlier mark is “very low” in distinctive character and therefore confusion would not arise. However, I am mindful of the comments made in *L’Oréal SA v OHIM*, Case C-235/05 P, the Court of Justice of the European Union stated at paragraph 45 that:

“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) I do acknowledge that the earlier mark is at the lower end of the distinctiveness spectrum. However, overall the marks are similar to at least a medium degree. Further, any lesser degree of similarity between the marks would be offset by the services being identical. In view of this, I consider that there is a likelihood of direct confusion. The opposition succeeds.

Conclusion

33) The application shall be refused for all of the opposed class 43 services, namely “Provision of food and drink; provision of food and drink in restaurants”. Since the opposition was not directed against the remaining applied for goods and services, the application shall (subject to appeal) proceed to registration for the following:

Class 29: Meat

Class 35: Advertising and advertisement services; business information services

Class 42: Creating, designing and maintaining web sites; hosting of digital content on the Internet

Class 43: Provision of information relating to the booking of accommodation

Class 44: Nutritional guidance; provision of information relating to nutrition

Costs

34) The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£100
Preparing a statement and considering the other side’s statement	£200
Preparing evidence and considering the other side’s submissions	£300

Total

£600

35) I therefore order Quality Meat Scotland to pay Tihomir Lalic the sum of £600. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of April 2016

MARK KING

For the Registrar,

The Comptroller-General