

**O-594-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3123770**

**BY BWR INTERNATIONAL, LLC**

**TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 43:**



**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 405613 BY BUFFALO GRILL**

## **Background and pleadings**

1. On 24 August 2015, BWR International, LLC (“the applicant”) applied to register the



trade mark

for the following services:

Class 43 Restaurant services; café, bar and other establishments for providing food and drink; restaurant, bar, catering, food and drink preparation and service.

2. The application was published for opposition purposes on 9 October 2015. It is opposed by Buffalo Grill (“the opponent”). The opposition, which is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”), is directed against all of the services in the application.

3. Under both sections of the Act, the opponent relies upon its European Union trade mark (“EUTM”) registration no. 11602075 for the following trade mark:



The mark was applied for on 25 February 2013 and its registration procedure was completed on 4 July 2013. The colour red is claimed.

4. Given its date of filing, the opponent’s mark qualifies as an earlier mark in accordance with section 6 of the Act. The mark is registered for a range of goods and services in classes 29, 30 and 43 (reproduced in full as an annex to this decision). The

opponent relies upon all of the goods and services for which the earlier mark is registered.

5. The opponent claims that there is a likelihood of confusion because the marks are visually, aurally and conceptually similar and because the goods and services are identical or similar.

6. Further, the opponent claims that the earlier mark has a reputation for the registered goods and services and that use of the applicant's mark would, without due cause, take unfair advantage of the reputation of the earlier mark. The opponent claims that:

“The Applicant would be able to take advantage of the advertising expenditure and investment in the Registration and mark and would therefore gain a stronger foothold in the market than were they to have to begin their marketing campaign from scratch. This is so called “free-riding” or “riding on the coat-tails””.

8. The applicant filed a counterstatement denying the grounds of opposition. I will return to the applicant's comments later in this decision.

9. Both sides seek an award of costs.

10. Both parties have been professionally represented throughout, the applicant by Roger Moore & Associates Limited, the opponent by Boulton Wade Tennant. Both parties filed evidence. I have read all of the evidence carefully; I will summarise it only to the extent that I consider necessary.

11. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful reading of the papers.

## **Evidence**

### *Opponent's evidence*

12. This consists of the affidavit of Mathieu Queré and accompanying exhibits MQ1 to MQ19a. Mr Queré is the chairman of the executive management board of Buffalo Grill SA. He indicates that he has worked for the opponent, in different capacities, since September 2010.

13. Exhibit MQ1 consists of a copy of a menu said to be in use “currently” (the witness statement is dated 16 June 2016), though the menu is not itself dated. It shows the mark in use in the following form:



Although the menu is in French and not translated, I note that, at page 9, there is a separate section in the menu for “bison”, underneath which are listed “pavé de bison” and “bison burger”.

14. Exhibit MQ2 is a document containing information about the opponent's history between 1980 and 2011. It is in French and no translation has been provided.

15. Exhibit MQ3 consists of information about the opponent's restaurants. The exhibit is all in French and is not dated, save for the printing date of 23 February 2015. Mr Queré states that the opponent owns 328 restaurants in France, Spain, Luxembourg and Switzerland. These are listed in the exhibit, which shows that the vast majority of the restaurants are in France. The mark is visible in the form shown at paragraph 13, above, and in white on a plain red background.

16. Exhibits MQ4 and MQ4a contain financial information about the opponent's company, in French at MQ4 and in English translation at MQ4a. The first document is taken from the opponent's website.<sup>1</sup> It bears a printing date of 23 February 2015. The document shows increasing revenue between 1998 and 2011, with pre-tax turnover in 1998 of €113 million, increasing to €534.2 million in 2011. It indicates that the opponent's market share is 44%.<sup>2</sup> There is also an extract from the company accounts for the financial year ending 31 December 2008 which shows net income of €22,892 million in 2007 and €19,856 million in 2008.<sup>3</sup> At pp. 48-49 (the original is at pp. 32-33), there is a press release dated 18 February 2011 which states that the opponent's pre-tax turnover was €551 million in 2010. The most recent financial information is at pp. 50-54, which is the financial statements as at 31 December 2013. This shows net income of €11,430 million in 2012 and €11,285 million in 2013.

17. Exhibit MQ5 consists of survey evidence regarding the perception of the brand in the marketplace, in French and then in translation at MQ5a. In proceedings before the Registry, leave must be sought before survey evidence is permitted, as set out in Tribunal Practice Notice 2/2012. No leave has been sought or granted in the instant proceedings. Even if it had been, the survey is dated July 2006 and cannot cast any light on the market conditions in October 2015.

18. Exhibit MQ6 consists of press articles about the opponent, covering a range of topics from acquisition of new restaurants (p. 98) and new restaurant openings (p. 118) to the opponent's renovation plans (p. 135). Some of these articles are in English; the majority are provided in both French and English versions. Almost all of the articles are from French-language publications (e.g. *L'expansion* (pp. 92-93), *La tribune* (pp. 102-103)) whose distribution in the UK is not made clear. Not all of the articles are dated. Those which do have dates are dated between 1998 and 2010.

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<sup>1</sup> pp. 39-41 (corresponding to pp. 26-27).

<sup>2</sup> p. 39 (p. 26).

<sup>3</sup> p. 44 (p. 29)

19. Exhibit MQ7 shows results for the term “buffalo” from the search engine www.google.fr on 23 February 2015.

20. The opponent’s trade mark portfolio is exhibited at MQ8. Given that only one mark is relied upon in these proceedings, it is unclear how this evidence assists the opponent.

21. Exhibit MQ9 gives details of one of the opponent’s French trade mark registrations. Mr Queré says that it shows “the registration of my Company’s rooftop as a trade mark”.<sup>4</sup> That trade mark is not involved in the instant proceedings.

22. Exhibits MQ10 to MQ13 consist of trade mark decisions issued by the EUIPO, while at MQ14 there is a UK IPO decision. I have read them but none is binding upon me; indeed, as those cases are different on the facts, the decisions are of little or no persuasive value.

23. Mr Queré states that exhibit MQ15 contains brochures offered by the opponent. None is dated, except for at p. 255, where a voucher is said to be valid from December 2002 to April 2003. The copies are in grey scale and the mark appears throughout as shown below:



24. Exhibit MQ16 is said to show information regarding a smart phone game application. The document is in French and there is no translation. It is not dated, though I note that Mr Queré refers to the application being ranked “in the top 30 of the AppStore downloads in 2011”.<sup>5</sup> The territory to which this applies is not clear. The mark is shown on each page as above (paragraph 23) but in red.

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<sup>4</sup> Paragraph 19.

<sup>5</sup> Paragraph 27.

25. Exhibit MQ17 contains three copies of the opponent's newsletter, all dated October 2014. The mark is visible in the form shown at paragraph 13, above. The documents are in French and are not translated but are said to show social events run by the opponent. They appear to relate to a number of different restaurants, presumably in France.

26. Exhibit MQ18 is also in French and not translated. It is said to show the opponent's non-profit activities. The first and third articles are dated 2011 (p. 283; p. 290); the date of the second article is not clear. The mark is visible at p. 283 and p. 290, in red, in the form shown at paragraph 23, above.

27. Exhibit MQ19 consists of a table showing the opponent's marketing expenditure, in French, and in translation at MQ19a. The evidence shows the outlay between 2008 and 30 April 2010. The expenditure over the three years exceeded €12.6 million. It is not clear where the opponent's marketing efforts were directed.

#### *Applicant's evidence*

28. This consists of the affidavit of Haytham David, president of the applicant. Much of the affidavit consists of submissions, to which I will return shortly. The affidavit contains images of the applicant's restaurants, which are not particularly clear.

29. Exhibit HD1 consists of images of what is said to be the current menu used by the applicant's franchises (the affidavit is dated 22 August 2016). The image is not particularly clear but the mark applied for appears to be on the cover.

30. Exhibit HD2 is said to show search results for the term "BUFFALO" taken from google.co.uk.<sup>6</sup> The exhibit is illegible.

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<sup>6</sup> Paragraph 9.

31. There are further internet search results shown at exhibit HD3, apparently for the term “Buffalo Wings”. Again, the exhibit itself is not legible.

32. Exhibit HD4 is an article from Wikipedia entitled “Buffalo wing”. The article is not legible.

33. As the opponent did not file evidence in reply, that concludes my summary of the evidence.

### **Preliminary issue**

34. In his evidence, Mr David makes a number of submissions regarding the applicant’s use of the mark applied for and, in particular, the different styles adopted by the parties, both in terms of the food offered and in the décor of their restaurants. These points will, as a matter of law, have no bearing on the outcome of this opposition. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, my assessment must take into account only the applied-for mark (and its specification) and any potential conflict with the earlier trade mark. This means that any differences between the goods and services provided by the parties, or their trading styles, are not relevant unless those differences are apparent from the applied-for and registered marks (and their specifications).

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

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

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



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

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

36. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6. (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

37. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3, above, which qualifies as an earlier trade mark under the above provisions. As the opponent’s earlier mark had not been registered for five years or more at the publication date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services it has identified.

38. 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.

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

### **Comparison of goods and services**

39. The applicant seeks to register its mark for the following services:

Class 43      Restaurant services; café, bar and other establishments for providing food and drink; restaurant, bar, catering, food and drink preparation and service.

40. The opponent's specification includes in class 43 the very wide term "services for providing food and drink". The services must be considered identical, given that the

services applied for fall within the ambit of the opponent's broader term. This principle was set out by the General Court ("GC") in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05:

"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".

41. Given that the opponent's position would not be improved were I to consider its other goods and services, I do not intend to do so.

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

42. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

43. The average consumer of the services at issue is likely to be comprised mainly of members of the general public. In addition, in respect of catering services I consider that there is a second group of relevant consumer, namely business users. The purchasing process for all of the services, for both groups of average consumer, will be primarily visual: restaurant and café services, for example, are likely to be selected following inspection of the premises' frontage on the high street, a website or advertisements in magazines or on posters, while the average consumer is likely to select catering services after consulting websites and magazines. Oral recommendations may play a role for all of the services at issue, so the aural similarity between the marks must also be given some, albeit relatively less, weight.

44. The average consumer's level of attention will vary, depending on factors such as the type of food and drink provided, the cost of the service offered and the nature of the establishment or event. However, with the exception of catering services, the member of the general public purchasing the services at issue will do so with an average degree of attention. The position for catering services is slightly different as, for both groups of average consumer, considerable sums are likely to be laid out and the quality and efficiency of the service are likely to be of particular concern. As a result, I consider that the average consumer purchasing catering services will pay a higher than average, though not the highest, degree of attention to the selection of the service.



### **Comparison of trade marks**

45. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

It would be wrong, therefore, artificially to 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 marks.

46. The trade marks to be compared are as follows:

| Opponent’s trade mark   | Applicant’s trade mark   |
|---|--|
|  |  |

47. In its notice of opposition, the opponent submits that:

“6. Both marks contain the prominent BUFFALO element. The WINGS AND RINGS elements in the Application are liable to be considered descriptive of

the products being offered in the Applicant's services. The images which feature in both marks also serve to reinforce the BUFFALO element.

7. The BUFFALO word is therefore the dominant and distinctive element contained within the both the [sic] Application and the Registration. It is these elements which play strongest in the mind of the average consumer.

8. As a result of these similarities the marks must be considered visually and phonetically similar. Conceptually, as both refer to Buffalo, a well known animal, they are also similar”.

48. The applicant, in its counterstatement, argues that the word “BUFFALO” does not dominate the mark applied for. It states:

“7 [...] It is submitted that the representation of the head of the Buffalo is central to the Trade Mark of the Applicant and is the feature that the general restaurant visiting public would identify as the badge of origin. The general restaurant visiting public would expect to be able to purchase an American style chicken product (BUFFALO WINGS) from such restaurants”.

49. The opponent's mark consists of the words “BUFFALO GRILL” in capital letters, placed one above the other. The typeface has some stylisation and the top edge of the word “BUFFALO” is slightly curved. In addition, on either side of the word “BUFFALO” is the representation of a horn, mainly horizontal in shape but turned upwards at the outermost edge. The opponent's mark is in red and is subject to a colour claim for “red”. A colour claim is not a limitation of rights. The distinction between a colour claim and a limitation was explained in *Comic Enterprise Ltd v Twentieth Century Fox Film Corporation*,<sup>7</sup> where it was stated that:

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<sup>7</sup> [2014] EWHC 185 (Ch), [57]-[62].

“61. As Jacob LJ held in *Phones4U* at [60] to [70], the effect of a limitation is that it is simply not an infringement of this mark to use the same words or devices in other colours. This is not merely a factor that goes into the assessment of a likelihood of confusion but is a limit on the rights of the trade mark proprietor even before one gets to that assessment. In the case of a claim, if the colours used by the alleged infringer are different from those claimed then it is a question of comparing the two signs in their different colours and assessing the likelihood of confusion”,

and (quoting guidance from the Registrar) that:

“62 [...] A colour claim is not a limitation of rights under s.13 of the Trade Marks Act 1994. Rather it is a description of the mark simply confirming that the colours shown are intended to form part of the subject matter of the trade mark (as opposed to incidental of colour as used to happen from time to time when applications were filed on paper)”.

50. The word “GRILL” has little distinctiveness in relation to the opponent’s services. “BUFFALO” is likely to suggest the type of meat on offer in the opponent’s restaurants but it is not descriptive of the services and is more distinctive than “GRILL”. I am of the view that the words “BUFFALO GRILL” will be perceived as a unit and that they have the greatest impact in the overall impression. The “BUFFALO” element is reinforced by the device of the horns which appear at either side of the word. The device therefore has a lesser, though not negligible, impact in the overall impression.

51. The applicant’s mark has a number of elements. There is a stylised representation of the head of a buffalo or bison at the centre of the mark, which is surrounded by a black circle. In the top half of the circle, in capital letters and in white, are the words “BUFFALO WINGS”. In the bottom half of the circle are an ampersand and the word “RINGS” in capital letters. These are also in white but in a slightly larger typeface. As the two verbal elements readily make a phrase, reading “BUFFALO WINGS & RINGS”,



that is how the average consumer is likely to perceive them. Around the whole is another, thinner black circle. In respect of the applicant's services, the words "BUFFALO WINGS" are suggestive but I consider that the words "BUFFALO WINGS & RINGS" and the image of a bison's head each play a roughly equal part in the overall impression. Weaker roles are played by the thick black circle which serves as background for the words and by the thin circular border.

52. Visually, there is some similarity because both marks contain the word "BUFFALO". That is where the similarity ends. There are significant differences in the verbal elements, since the opponent's mark features the word "GRILL" and the applicant's mark includes the words "WINGS & RINGS", neither of which has a counterpart in the other party's mark. Both marks have a device element, namely horns in the earlier mark and a bison's head in the application, which is not present in the other mark. The applicant's mark also has the two circles as background and border, which distinguish it from the opponent's mark. Overall, I consider that there is a low degree of visual similarity.

53. Aurally, the devices in the parties' marks will not be verbalised. The opponent's mark will be pronounced entirely conventionally as "BUFFALO GRILL". The ampersand in the applicant's mark will be articulated, so that the mark is pronounced "BUFFALO WINGS AND RINGS". The applicant's mark will thus be articulated as four words, in contrast to the two words of the earlier mark. I bear in mind that the marks share the same first word and that there is thus some degree of aural similarity. However, there is no aural similarity between the remaining words in the marks. The marks at issue are aurally similar to a medium degree.

54. Regarding the conceptual similarity between the marks, the opponent claims that "as both [marks] refer to Buffalo, a well known animal, they are also similar".<sup>8</sup> On the applicant's behalf, Mr David submits in his witness statement that "one of the most likely connotations of "Buffalo Wings" in the minds of the United Kingdom consumers is likely

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<sup>8</sup> Statement of grounds, paragraph 8.

the prepared chicken recipe called “Buffalo Wings” which originated in Buffalo, New York”.<sup>9</sup> Exhibit HD4, which is said to support this statement, is illegible and consequently adds no support for this statement.

55. I accept that the word “BUFFALO” in the opponent’s mark may conjure the image specifically of a buffalo. I also accept that some restaurants, the opponent’s included,<sup>10</sup> may offer buffalo meat but there is no evidence to show that it is commonplace. Some average consumers may, therefore, consider that the word “BUFFALO” alludes to bovine meat more generally rather than buffalo meat in particular. I indicated above that “GRILL” has little distinctiveness and is likely to be understood as a reference to the way in which the food is prepared. The device of the horns reinforces the message conveyed by the word “BUFFALO”.

56. I have no evidence from the parties to assist me in determining how the average consumer will perceive the applicant’s mark. It is possible that the average consumer will identify “BUFFALO WINGS” as a food product made of chicken wings. This is particularly the case given the services at issue and that “wings” are a common chicken product. I do not think it likely that the average consumer will know that Buffalo wings originate from a town called “Buffalo” in the state of New York, although I accept that some average consumers may surmise that that is so. However, it is also possible that some average consumers will neither know nor assume that Buffalo wings are a particular type of chicken product. In such a scenario, the words “BUFFALO WINGS” may create the somewhat fanciful image of a buffalo with wings, although I think this the less likely perception. The “& RINGS” element of the mark is less clear. However, taken in context, the average consumer is likely to perceive it as relating to a food item, such as onion rings, particularly if “BUFFALO WINGS” is understood as a reference to chicken products. If not, the word “RINGS” may be perceived literally as circular bands although, again, I consider this interpretation less likely. The device in the applicant’s mark is, however, clearly a buffalo or bison’s head.

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<sup>9</sup> Paragraph 13.

<sup>10</sup> MQ1, p. 9.

57. For the average consumer who perceives “BUFFALO WINGS” as meaning chicken wings, irrespective of the meaning attributed to “& RINGS”, both word elements have conceptual messages different from those in the earlier mark. Where the average consumer also perceives “BUFFALO” in the opponent’s mark as a reference specifically to buffalo, there is a medium degree of conceptual similarity. For those who perceive the word “BUFFALO” in the opponent’s mark as alluding to bovine meat more generally, there is likely to be a lesser degree of conceptual similarity, although I consider that it would still be of a medium degree. I accept that the average consumer may not know for a fact that buffalo and cattle are part of the same bovine family. However, I think it likely that most average consumers would speculate that that is the case given, among other things, the physical resemblance between the animals, and would make an association between buffalo and bovine animals.

58. Where the average consumer does not recognise “BUFFALO WINGS” as a reference to a type of chicken product, I do not consider that the position is materially altered. Although there will be conceptual similarity between the word “BUFFALO” in each mark, reinforced by the image of a buffalo head in the applicant’s mark, I consider that the introduction of the different concepts of wings of buffalo and rings in the application will result, overall, in a medium degree of conceptual similarity.

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

59. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd*

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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)”.

60. 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 services, to those with high inherent distinctive character, such as invented words which have no allusive qualities (KODAK is the paradigm example). I indicated at paragraph 50 that I consider the wording and device of the opponent’s mark to be suggestive of the food sold in its establishments. However, the arrangement of the elements adds to its distinctiveness and I consider that, overall, the earlier mark has an average degree of inherent distinctive character.

61. The opponent submits that its mark enjoys an enhanced level of distinctiveness due to the use that has been made of it. For the purposes of this assessment, the relevant market to which I must have regard is the UK market.<sup>11</sup> While the evidence shows impressive turnover and that the mark has been used prominently in relation to the opponent's services on the continent, there is no evidence at all of use in the UK. Moreover, there is no evidence of any efforts to promote the mark and the opponent's services in the UK. On the basis of the evidence filed, I am unable to determine that the earlier mark has an enhanced distinctive character in relation to the services at issue.

### **Likelihood of confusion**

62. 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, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also bear in mind the average consumer for the services, the nature of the purchasing process and 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 he has retained in his mind.

63. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related. In terms of the former, although both marks contain the word "BUFFALO", the word does not play an independent distinctive role in either mark and will not be relied upon by the average consumer as an indication of trade origin: it is the differing overall

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<sup>11</sup> On the irrelevance of a reputation in continental Europe when assessing enhanced distinctiveness for the purposes of section 5(2), see the comments of Iain Purvis, QC, sitting as the Appointed Person, in *China Construction Bank Corporation v Groupement des cartes bancaires* (BL O/281/14) at [30]-[34].

impressions created by the marks which will signal the origin of the services. I consider that the other elements of the marks, particularly the striking device and presentational elements, will be recalled or remembered by the consumer even, taking the position most favourable to the opponent, when the average consumer pays no more than an average degree of attention to the purchase. As I have indicated, the selection of the services is likely to be primarily visual, so the visual differences are of particular weight. Although there is some similarity between the marks, the greatest degree of similarity is aural and conceptual, while the visual similarity is only of a low degree. Taking all of the competing factors into account, I am satisfied that, even considering the effects of imperfect recollection, there will be neither direct nor indirect confusion. There is no likelihood of confusion.

### **Section 5(3)**

64. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

65. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

### *Reputation*

66. The opponent has demonstrated that it enjoyed a 44% share of the market and that its turnover was in excess of €500 million in 2011.<sup>12</sup> It does not explicitly state that this was in France, though given the locations of the majority of its restaurants that seems likely. I accept that the figures provided are from some years before the relevant date

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<sup>12</sup> MQ4a, p. 39.



and that the latest turnover figures (for 2012 and 2013) are lower.<sup>13</sup> However, the scale of the opponent's presence in the French market in 2011, combined with what are significant turnover figures over a period of years, is such that, despite decreasing revenue, the mark is still likely to have been known by a significant part of the relevant public at the relevant date. I find that the opponent has established that the earlier mark had a reputation at the relevant date amongst a substantial proportion of the relevant public in France. The reputation was in relation to services for providing food and drink. There is no evidence that the opponent has used the earlier mark in relation to the goods upon which it relies and, consequently, I find that the earlier mark has no reputation in relation to the goods for which it is registered.

67. As the earlier mark is an EUTM, the comments of the CJEU in *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07, at [27]-[29], are relevant in determining whether the earlier mark had a qualifying reputation. The court held that a reputation in a single member state may be sufficient to constitute the required reputation in "a substantial part of the territory of the Community". I find that the reputation of the earlier mark established in France at the relevant date also qualified as a reputation in the EU.

#### *Link*

68. In *Iron & Smith kft v Unilever NV*, Case Case C-125/14, the CJEU was asked to clarify whether it was possible for a CTM (now EUTM) with a reputation in one Member State to be infringed under provisions of the Community Trade Mark Regulation (now the European Union Trade Mark Regulation), which are broadly equivalent to s.5(3) of the Act, even in circumstances where it did not have a reputation in the Member State where infringement was alleged. The court said:

"If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the

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<sup>13</sup> MQ4a, p. 53.

relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of that provision or, failing that, a serious risk that such injury may occur in the future”.

69. I do not consider that the opponent has shown that its mark would be known to a commercially significant part of the relevant public in the UK. Indeed, there is no evidence at all that there have been any efforts to offer, advertise or otherwise promote the opponent’s services under the mark in the UK. Quite apart from the absence of evidence relating specifically to the UK, most of the evidence that has been provided has been translated from originals in French. Given that the UK public is notoriously monolingual, it is highly unlikely that any of the material exhibited was either intended for or used in relation to the UK market. I find that the relevant public will not make any link between the earlier mark and the mark applied for. In the absence of a finding that the requisite link has been established, it is not necessary for me to consider the issue of detriment. The opposition under section 5(3) fails.

## **Conclusion**

70. The opposition has failed. Subject to appeal, the application will proceed to registration.

## **Costs**

71. As the applicant has been successful, it is entitled to a contribution towards its costs. Both parties filed evidence but the applicant’s evidence did not assist me in

making my decision and I make no award in respect of it. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:


Considering the Notice of Opposition and  
filing a counterstatement: £200

Considering the other party’s evidence: £250

**Total: £450**

72. I order Buffalo Grill to pay BWR International LLC the sum of **£450**. This sum is to 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 16<sup>th</sup> day of December 2016**



**Heather Harrison  
For the Registrar  
The Comptroller-General**

## Annex

### Specification for EUTM 11602075

Class 29 Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs; Milk and milk products; Edible oils and fats; Preserved garlic; Ajvar [preserved peppers]; Albumen for culinary purposes; Alginates for culinary purposes; Weed extracts for food; Fermented vegetable foods [kimchi]; Aloe vera prepared for human consumption; Ground almonds; Anchovy; Peanuts, processed; Potato fritters; Butter; Buttercream; Peanut butter; Cocoa butter; Coconut butter; White of eggs; Milk beverages, milk predominating; Black pudding; Broth; Broth, broth concentrates; Prawns, not live; Caviar; Mushrooms, preserved; Charcuterie; Low-fat potato chips; Sauerkraut; Silkworm chrysalis, for human consumption; Coconut oil; Rape oil for food; Cranberry sauce [compote]; Apple purée; Broth concentrates; Fruit jams; Jams; Frozen fruits; Fruits, tinned [canned (Am.)]; Vegetables, tinned [canned (Am.)]; Fish, tinned [canned (Am.)]; Meat, tinned [canned (Am.)]; Shellfish, not live; Gherkins; Whipped cream; Cream [dairy products]; Shrimps, not live; Croquettes; Crustaceans, not live; Dates; Crayfish, not live; Fruit-based snack food; Fish meal for human consumption; Milk ferments for culinary purposes; Beans, preserved; Fish fillets; Potato flakes; Liver; Cheese; Fruit, preserved; Fruit preserved in alcohol; Stewed fruits; Fruit jellies; Gelatine; Jellies for food; Game, not live; Ginger jam; Soya beans, preserved, for food; Processed sunflower seeds; Processed seeds; Coconut fat; Edible fats; Fatty substances for the manufacture of edible fats; Herrings; Sea cucumbers (not live); Lobsters, not live; Hummus [chickpea paste]; Edible oils; Oysters, not live; Isinglass for food; Ham; Yolk of eggs; Vegetable soup preparations; Vegetable juices for cooking; Kefir [milk beverage]; Kumys [kumyss] [milk beverage]; Milk; Albumin milk; Curd; Non-alcoholic egg nog; Soya milk [milk substitute];

Milk products; Spiny lobsters, not live; Bacon; Lecithin for culinary purposes; Vegetables, preserved; Vegetables, cooked; Vegetables, dried; Lentils, preserved; Linseed oil for culinary use; Corn oil; Margarine; Marmalade; Fat-containing mixtures for bread slices; Foods prepared from fish; Milk shakes; Animal marrow for food; Mussels, not live; Vegetable mousses; Fish mousses; Edible birds' nests; Coconut, desiccated; Palm kernel oil for food; Nuts, prepared; Eggs; Snail eggs for consumption; Processed fish spawn; Powdered eggs; Onions, preserved; Olive oil for food; Olives, preserved; Bone oil, edible; Palm oil for food; Clams [not live]; Liver pâté; Pectin for culinary purposes; Whey; Piccalilli; Pickles; Peas, preserved; Fish, not live; Fish, preserved; Salted fish; Pollen prepared as foodstuff; Potato chips; Tinned vegetables; Soups; Rennet; Fruit pulp; Tomato purée; Raisins; Lard for food; Fruit salads; Vegetable salads; Salted meats; Sardines; Sausages; Sausages in batter; Salmon; Sesame oil; Suet for food; Tahini [sesame seed paste]; Tuna fish; Tofu; Tomato juice for cooking; Sunflower oil for food; Fruit chips; Tripe; Truffles, preserved; Toasted laver; Meat; Meat, preserved; Pork; Meat extracts; Meat jellies; Poultry, not live; Yogurt; Fruit peel.

Class 30 Coffee, tea, cocoa and artificial coffee; Rice; Tapioca and sago; Flour and preparations made from cereals; Bread, pastry and confectionery; Ices; Sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces (condiments); Spices; Ice; Seaweed [condiment]; Powders for ice cream; Almond confectionery; Starch for food; Star aniseed; Aniseed; Peanut confectionery; Flavorings, other than essential oils; Flavorings, other than essential oils, for cakes; Aromatic preparations for food; Seasonings; Meat tenderisers, for household purposes; Oat-based food; Crushed oats; Oatmeal; Husked oats; Unleavened bread; High-protein cereal bars; Stick liquorice [confectionery]; Baking soda [bicarbonate of soda for cooking purposes]; Beer vinegar; Rusks; Cookies; Cookies; Cocoa-based beverages; Coffee-based beverages; Chocolate-based

beverages; Tea-based beverages; Flavourings (vegetable), other than essential oils, for beverages; Sweetmeats [candy]; Gruel, with a milk base, for food; Hominy; Buns; Cocoa; Cocoa products; Coffee; Coffee flavourings; Chicory [coffee substitute]; Unroasted coffee; Rice pie; Cinnamon [spice]; Capers; Caramels [candy]; Curry [spice]; Celery salt; Buns; Breadcrumbs; Cheeseburgers [sandwiches]; Chicory [coffee substitute]; Chocolate; Chow-chow [condiment]; Chutneys [condiments]; Cloves [spice]; Condiments; Corn flakes; Fruit coulis [sauces]; Couscous [semolina]; Crackers; Custard; Cream of tartar for culinary purposes; Cream of tartar for cookery; Preparations for stiffening whipped cream; Ice cream; Pancakes; Turmeric for food; Sea water for cooking; Natural sweeteners; Cereal-based snack food; Rice-based snack food; Thickening agents for cooking foodstuffs; Spices; Essences for foodstuffs, except etheric essences and essential oils; Malt extract for food; Meal; Ferments for pastes; Bean meal; Wheat flour; Oat flakes; Chips [cereal products]; Fondants [confectionery]; Cakes; Waffles; Royal jelly; Wheat germ for human consumption; Ginger [spice]; Glazing preparations for ham; Cake frosting [icing]; Ice; Ice, natural or artificial; Edible ices; Glucose for culinary purposes; Gluten additives for culinary purposes; Gluten prepared as foodstuff; Chewing gum; Groats for human food; Halvah; Garden herbs, preserved [seasonings]; Infusions, not medicinal; Meat gravies; Ketchup [sauce]; Cocoa beverages with milk; Coffee beverages with milk; Chocolate beverages with milk; Leaven; Yeast; Binding agents for ice cream; Sausage binding materials; Linseed for human consumption; Macaroni; Macaroons [pastry]; Maize flour; Corn, roasted; Popcorn; Corn, milled; Malt biscuits; Malt for human consumption; Maltose; Marinades; Marzipan; Mayonnaise; Molasses for food; Peppermint sweets; Mint for confectionery; Farinaceous foods; Honey; Milling products; Chocolate mousses; Mousse desserts (confectionery); Mustard; Mustard meal; Muesli; Nutmegs; Noodles; Prepared meals based on noodles; Crushed barley; Barley meal; Husked barley; Bread; Gingerbread; Lozenges

[confectionery]; Almond paste; Soya bean paste [condiment]; Pastry; Meat pies; Pasta; Fruit jellies [confectionery]; Pasties; Pastries; Pesto [sauce]; Petit-beurre biscuits; Petits fours [cakes]; Bread rolls; Peppers [seasonings]; Pizzas; Pepper; Potato flour for food; Puddings; Baking powder; Cake powder; Pralines; Bee glue; Allspice; Quiches; Ravioli; Liquorice [confectionery]; Relish [condiment]; Rice; Spring rolls; Saffron [seasoning]; Sago; Sandwiches; Soya sauce; Tomato sauce; Dressings for salad; Sauces [condiments]; Cooking salt; Salt for preserving foodstuffs; Semolina; Hominy grits; Golden syrup; Soya flour; Sorbets [ices]; Spaghetti; Artificial coffee; Sugar; Candy; Confectionery; Confectionery for decorating Christmas trees; Sushi; Tabbouleh; Tacos; Tapioca; Tapioca flour for food; Tarts; Tea; Iced tea; Tortillas; Pies; Vanilla [flavoring] [flavouring]; Vanillin [vanilla substitute]; Vermicelli [noodles]; Vinegar; Frozen yogurt [confectionery ices].

Class 43 Services for providing food and drink; Temporary accommodation; Accommodation bureaux [hotels, boarding houses]; Bars; Cafés; Cafeterias; Holiday camp services (lodging); Canteens; Day-nurseries [crèches]; Hotel services; Rental of cooking apparatus; Rental of chairs, tables, table linen, glassware; Rental of transportable buildings; Rental of drinking water dispensers; Rental of temporary accommodation; Rental of meeting rooms; Rental of tents; Retirement homes; Tourist homes; Providing campground facilities; Motel services; Boarding houses; Boarding for animals; Hotel reservations; Temporary accommodation reservations; Boarding house bookings; Snack-bars; Self-service restaurants; Restaurants; Catering; Bar services, Cafés, Cafeterias, Hotels, Snack bars, Self-service restaurants, Food and drink catering.