

O-397-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3159857 BY
CASPIAN EALING LTD
TO REGISTER:**



AS A SERIES OF THREE TRADE MARKS IN CLASSES 29, 30 & 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 407750 BY CASPIAN HOLDING FRANCHISE LIMITED**

BACKGROUND & PLEADINGS

1. On 16 April 2016, Caspian Ealing Ltd (“the applicant”) applied to register the series of three trade marks shown on the cover page of this decision (larger versions of which can be found in the Annex to this decision), for the goods and services shown in paragraph 15 below. The application was published for opposition purposes on 29 July 2016.

2. On 27 October 2016, the application was opposed in full by Caspian Holding Franchise Limited (“the opponent”). Following amendment on two occasions, the opposition is now based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying solely upon the following United Kingdom trade mark registration:

No. 3141100 for the trade mark: **Caspian pizza** which was applied for on 17 December 2015 and entered in the register on 18 March 2016. The opponent relies upon all of the services for which the trade mark is registered, details of which can be found in paragraph 15 below.

3. The applicant filed a counterstatement (subsequently amended on two occasions) in which the basis of the opposition is denied. The applicant states:

“3. The term “Caspian” is a term commonly used by many Iranian/Persian restaurants within the United Kingdom as part of their respective names. The term is widely used by these restaurants to describe the nature, type and geographical origin of the cuisine and associated beverages and services which they provide, namely Iranian/Persian cuisine (including associated beverages) and restaurant services. The term is thus also descriptive of cuisine and restaurant services provided by members of the Iranian community. Both the Applicant and the Opponent are aware of the descriptive nature of the term in question. By reason of its descriptive nature as described above, the term “Caspian” per se is also devoid of distinctive character when used in relation to

cuisine, beverages, and restaurant services of Iranian/Persian origin and/or nationality and/or type. The Opponent therefore has no exclusive right to the use of the term “Caspian” in respect of such food, beverages and restaurant services. The Applicant is able to submit evidence to support these contentions.”

4. In these proceedings, the opponent is represented by National Business Register LLP (“NBR”). Having filed the original and amended counterstatements on the applicant’s behalf, in an e-mail dated 28 May 2017, Decisis Limited advised the tribunal that it no longer represented the applicant. From that point on, the applicant represented itself. Only the opponent filed evidence. Although neither party asked to be heard, the opponent filed written submission in lieu of a hearing. I will refer to those submissions, as necessary, later in this decision.

DECISION

5. The opposition is now based upon section 5(2)(b) of the Act which 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.”

6. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), 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.”

7. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this earlier trade mark had not been registered for more than five years at the date when the application was published, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all the services for which its earlier trade mark is registered and upon which it relies.

The opponent’s evidence

8. This consists of a witness statement from the opponent’s professional representative, Mitchell Willmott, of NBR. Mr Willmott explains that the purpose of his statement is to provide:

“2...evidence in support of the opponent’s contention that the class 43 services covered by [its earlier trade mark] are considered similar to the goods covered by the opposed application in classes 29 and 30.

3. It is common practice for restaurants and other establishments that provide food and drink to also sell their own range of foodstuffs to be taken away and consumed and prepared at home.”

9. Mr Willmott's statement is accompanied by six exhibits. These are as follows:

MW1 – consists of web pages downloaded on 27 January 2017. Page 2, from eat17.co.uk, indicates that Eat 17 is a restaurant located in Walthamstow, East London whilst pages 3-5, from tesco.com and sainsburys.co.uk, indicate that those retailers sell “Eat 17 Bacon Jam” and “Eat 17 Chorizo Jam”;

MW2 – contains the results of a Google image search for “nandos restaurants uk” which were downloaded on 17 February 2017. Pages 7 and 8 contain a range of images, a number of which show the façade of restaurants bearing, inter alia, the word “Nando’s”. Pages 9-11 are from tesco.com and sainsburys.co.uk and were downloaded on 27 January 2017. They indicate that those retailers sell a range of “Nando’s” branded products such as sauces, rubs and marinades;

MW3 - contains the results of a Google image search for “pizza express restaurants uk” which were downloaded on 17 February 2017. Page 13 contains a range of images, a number of which show the façade of restaurants bearing the words “PIZZA EXPRESS”. Pages 14-22 are from tesco.com, sainsburys.co.uk and morrisons.com and were downloaded on 27 January 2017. They indicate that those retailers sell a number of “PIZZA EXPRESS” branded products such as pizza, prosciutto ham, dough balls and salad dressing;

MW4 – contains the results of a Google image search for “gourmet burger kitchen restaurants uk” which were downloaded on 17 February 2017. Pages 24 and 25 contain a range of images, a number of which show the façade of restaurants bearing the words “gourmet burger kitchen”. Page 26 consists of an article dated 20 July 2010 from bighospitality.co.uk which indicates that “Gourmet Burger Kitchen (GBK) branded burgers are to be sold in supermarkets for the first time later this month.” The article also states

“Nando’s, Pizza Express and Wagamama also have branded products for sale in retail outlets.”

MW4.1 – page 28 consists of an article dated 30 April 2015 from thegrocer.co.uk entitled “Gourmet Burger Kitchen gets saucy retail line in Tesco”. It explains that GBK “has launched a range of sauces and relishes for the grocery channel”. Pages 29 and 30 consist of extracts downloaded on 27 January 2017 from waitrose.com and tesco.com referring to “Gourmet Burger Kitchen 2 Aberdeen Angus beef burgers” and “Gourmet Burger Kitchen House Relish” respectively;

MW5 - pages 32 and 33 consist of an article dated 10 July 2012 from bighospitality.co.uk entitled “Increasing number of restaurants launching products into supermarkets”.

10. To the extent that I consider it necessary, that concludes my review of the evidence filed in these proceedings.

Section 5(2)(b) – case law

11. The following principles are gleaned from the decisions of the courts of the European Union 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 greater 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.

The average consumer and the nature of the purchasing act

12. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services; I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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.”

13. The average consumer of the goods and services at issue in these proceedings is a member of the general public. Insofar as the applicant's goods are concerned, these are fairly frequent, low cost purchases which are most likely to be selected with only a moderate degree of care from, for example, the shelves of a brick and mortar retail outlet such as a supermarket or from the equivalent pages of a website. While visual considerations are likely to dominate the selection process, aural considerations in the form of, for example, word-of-mouth recommendations or requests to sales assistants may play a part, albeit, in my view, to a much lesser extent.

14. As to the services at issue, my own experience informs me that such services are most likely to be selected having considered, for example, promotional material (in hard copy and on-line) and signage appearing on the high street; once again visual considerations will be an important part of the selection process. However, as such services are also, in my experience, very likely to be the subject of word-of-mouth recommendations, aural considerations will be a not-insignificant feature of the selection process. The degree of care the average consumer will display when selecting the services at issue is likely to vary. Contrast, for example, the low degree of care likely to be taken when one selects a venue for an impromptu cup of coffee, with the fairly high degree of attention one is likely to take when selecting a restaurant for an important family event.

Comparison of goods and services

15. The competing goods and services are as follows:

The opponent's services	The applicant's goods and services
<p>Class 43 - Services for providing food and drink; restaurant, bar and catering services; takeaway services; information in relation to all the aforesaid services.</p>	<p>Class 29 - Burgers.</p> <p>Class 30 - Sandwiches; Sandwiches containing chicken; Sandwiches containing hamburgers; Sandwiches containing salad.</p>

	Class 43- Fast food restaurant services; Juice bars.
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In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This enquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal*

Market (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-O-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the GC stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

The applicant’s goods in classes 29 and 30

16. The applicant seeks registration for burgers in class 29 and sandwiches (with various fillings) in class 30. When comparing goods with services (the earlier trade mark is only registered for services), there is, of course, a difference between the nature of a good and the nature of a service, which affects the comparison insofar as method of use is concerned. As the case law explains, goods and services can, however be complementary, share channels of trade and can be in competition with one another. This is particularly relevant when one is considering services which provide, inter alia, food, with food products which have been prepared. Takeaway services are specifically mentioned in the opponent’s specification. A takeaway service is complementary to the takeaway, which is a prepared meal. The supply of the goods is essential to the supply of the services; the purpose of both the takeaway and the service is similar i.e. to satiate hunger; the channels of trade will be the same, and the users will be the same. In relation to restaurant services in the opponent’s specification, the average consumer has a choice whether to visit an establishment where they can eat, or they can buy a prepared meal and take it home: the users are the same, the goods and services have a similar purpose, but in this scenario the goods and services are in competition. In my view, there is at least a medium degree of similarity between the opponent’s services I have identified and the applicant’s goods in classes 29 and 30.

17. In addition, the opponent has provided evidence to demonstrate that it is not uncommon for those providing restaurant services also to be engaged in a trade in relation to a range of food products associated with that service. Although the majority of the opponent's evidence is from after the relevant date in these proceedings i.e. 16 April 2016, the articles provided in exhibits MW4 (dated 20 July 2010), MW4-1 (dated 30 April 2015) and MW5 (dated 10 July 2012) are all from prior to the relevant date and exhibit MW5 in particular speaks to the "increasing number of restaurants launching products into supermarkets." That article is from well before the relevant date and its sentiment reflects what, in my own experience, would have been the position at the relevant date in April 2016. As the case law explains, the purpose of examining whether there is a complementary relationship between goods and services is to establish whether the relevant public are liable to believe that the responsibility for the goods/services lies with the same or an economically linked undertaking. In view of the evidence provided and my own experience as an average consumer of the goods and services at issue, I am satisfied that such a complementary relationship existed at the relevant date and the applicant's goods and the opponent's restaurant services are, as a consequence, similar to at least a medium degree.

The services in class 43

18. The opponent's specification includes the phrase "restaurant, bar and catering services" which is broad enough to include all of the services in the applicant's specification in this class. The competing services are identical on the principles outlined in *Meric*.


Comparison of trade marks

19. 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 them, 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.”

20. 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 they create. The trade marks to be compared are:

Opponent’s trade mark	Applicant’s trade marks
Caspian pizza	

21. The opponent’s trade mark consists of the word “Caspian” presented in title case followed by the word “pizza” presented in lower case. When considered in the context of the services for which it is registered, the word “pizza” has no distinctive character and any contribution it makes to the overall impression the trade mark conveys will be very

limited. In those circumstances, it is the first word i.e. “Caspian” that will dominate the overall impression the opponent’s trade mark conveys; I will return to the distinctiveness of this word below.

22. The applicant has applied for a series of three trade marks. The first two trade marks in the series are presented in the same yellow and turquoise colour scheme against a white background. Constructed from four semi-circles forming a nearly circular logo, at the top of the first trade mark there appear the words “BURGER” and “STEAK” and in the second trade mark there appears the word “LOUNGE”; in both trade marks these words are presented in block capital letters in the colour turquoise. To the left and right of these words (and between the words “STEAK” and “BURGER”), there appear small circular devices presented in the colour yellow and a small circular device reminiscent of a curl of hair. The next and by far the largest component in both trade marks is the word “caspián”; it is presented in a stylised but unremarkable font in the colour turquoise in primarily lower case letters but in which the letter “S” is somewhat larger than the letters accompanying it. Below this word appears a device presented in the colour yellow which acts as an underlining but which given its irregular top line, I take to be intended to represent a stylised representation of water. Below this device in both trade marks there appear the following components all presented in the colour turquoise: “EST. 2011”, devices of five stars and the words “SANDWICH BAR”, to the left and right of which appear the same small circular devices presented in the colour yellow.

23. The third trade mark in the series contains many of the same components presented in the same format, colour and position, i.e. the small circular devices presented in yellow which appear at the top and bottom of the trade mark, the circular device reminiscent of a curl of hair, the word “caspián”, the stylised/underlining representation of water, “EST. 2011” and devices of five stars. It differs to the extent that the components are presented against a black background and the word “LOUNGE” appears at the top and bottom of the trade mark.

24. Irrespective of their size, positioning or colour in which they are presented, when considered in the context of the goods and services for which registration is sought, many of the components in the applicant's trade marks are either descriptive or non-distinctive and will, either individually or collectively, make little or no contribution to the overall impression the trade mark conveys. Into this category I place the following: the logo formed by the four semi-circles forming a nearly circular logo, the words "BURGER", "STEAK", "SANDWICH BAR", "LOUNGE", "EST. 2011" (which simply indicates the date when the average consumer will assume the applicant was established), the device of five stars (which are inherently non-distinctive for services relating to, inter alia, the provision of food and drink) and the device of what I described above as an underlining. As a consequence of those conclusions, I agree with the opponent that it is the word "caspien" which will dominate the overall impression the applicant's trade marks convey. As above, I will return to the distinctiveness of this word later in this decision.

The visual, aural and conceptual comparison

25. Approached on the basis of the conclusions I have reached above i.e. that the word "Caspian"/"caspien" is the dominant component of both parties' trade marks and notwithstanding the other components in the competing trade marks, it results in a fairly high degree of visual similarity between them. In my view, the applicant's trade mark is most likely to be referred to aurally as "caspien". Even if the opponent's trade mark is referred to as "Caspian pizza" (which given the non-distinctive nature of the word "pizza" is debatable), as the word "Caspian" would be articulated first, it would still result in a high degree of aural similarity between the competing trade marks.

26. Finally, the conceptual comparison. To some extent this aspect of the comparison overlaps with the assessment of the distinctive character of the opponent's earlier trade mark (which I will return to below). In this respect, in its counterstatement (paragraph 3 above refers), the applicant commented upon the distinctiveness of the word "Caspian" to the effect that, inter alia, it describes Iranian/Persian cuisine and services provided by

members of the Iranian community. Although the applicant indicated that it was “able to submit evidence to support these contentions”, in the event it provided no such evidence. In its submissions filed in lieu of hearing, the opponent stated:

“4...Although the term CASPIAN could make reference to the Caspian Sea it does not have any reputation for services relating to the provision of food and drink, restaurant, bar and catering services, takeaway services...Subsequently, the term CASPIAN in relation to the services covered by the earlier mark possesses a normal to high degree of distinctiveness.”

27. In determining what conceptual message (if any) the competing trade marks are likely to convey to the average consumer, I should start by saying that, in my view, the other components in the parties’ trade marks will do nothing to modify any meaning which is likely to be conveyed to the average consumer by the dominant element of all the trade marks under consideration i.e. the word “Caspian”. In approaching the matter, I have consulted collinsdictionary.com. In BL-O-431-12, the Appointed Person, Mr Geoffrey Hobbs Q.C., commented upon the use of dictionaries in judicial proceedings. In reaching a conclusion on the distinctiveness of the word KILLER, I note that in that decision Mr Hobbs stated:

“29. With regard to point (2), the Hearing Officer rightly recognised that dictionaries and works of reference may indicate how a word or expression can be used or understood without also providing any indication as to how likely or unlikely it is to be understood in any of the ways indicated when used commercially in the context and manner envisaged by the trade mark application and the earlier trade mark registration he was considering. However, that did not require him to proceed upon the basis that dictionaries and works of reference could only be considered if the information they provided was verified by evidence. He should have accepted that it was open to him to take account of the information they provided for what it might be thought to be worth in relation to the matters in issue before him.

...

36. The question is not whether a trade mark tribunal can take account of the contents of dictionaries and works of reference (it can) but whether upon doing so it can be satisfied that they provide information which is pertinent to the assessment it is required to make. The weight to be given to pertinent references is a matter which falls to be considered and evaluated in the context of the evidence as a whole.”

28. As Mr Hobbs points out, it is permissible for me to take into account the contents of dictionaries and works of reference if I am satisfied that in doing so the information they provide is pertinent. Collinsdictionary.com defines “Caspian” as “of or relating to the Caspian Sea” and “Caspian Sea” as “a salt lake between SE Europe and Asia: the largest inland sea in the world; fed mainly by the River Volga. Area: 394 299 sq km (152 239 sq miles)”. However, as Mr Hobbs also pointed out, “dictionaries and works of reference may indicate how a word or expression can be used or understood without also providing any indication as to how likely or unlikely it is to be understood in any of the ways indicated when used commercially in the context and manner envisaged by the trade mark application and the earlier trade mark registration...”.

29. Not only do I have no evidence as to how familiar the average consumer may be with the word “Caspian” but as the applicant did not provide the evidence it alluded to in its counterstatement, I am not in a position to judge how the word would be understood when used commercially in the context of the goods and services at issue in these proceedings. If the average consumer construes the word “Caspian” as a reference to the Caspian Sea and as the other components in the parties’ trade marks do nothing to alter that meaning, the competing trade marks are conceptually identical. If, however, the word “Caspian” sends no conceptual message, the competing trade marks are, insofar as it is relevant, conceptually neutral.

Distinctive character of the earlier trade mark

30. 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.

31. Although the opponent filed evidence, it did not include evidence of any use it may have made of its earlier trade mark. In those circumstances, I have only the trade mark's inherent distinctiveness to consider. Given my earlier conclusion regarding the word "pizza", any distinctiveness the opponent's trade mark possesses is more likely than not to stem from its dominant element i.e. the word "Caspian". I have already commented on the meaning of this word in the context of the parties' submissions when I dealt with the conceptual comparison. Even if I proceed on the basis that the average consumer is aware of the word and its meaning in relation to the Caspian Sea (which, in my view, would be a step too far), in the absence of the type of evidence mentioned in the counterstatement, there is nothing to indicate how the average consumer will construe the word when used in a commercial context. That being the case, I intend to proceed on the basis that the earlier trade mark is possessed of an average (i.e. neither high nor low) degree of inherent distinctive character.

Likelihood of confusion

32. 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 goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and 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. Earlier in this decision I concluded that:

- the average consumer of the goods and services at issue is a member of the general public;
- while the selection process for the goods and services will be predominantly visual, aural considerations will also play their part (particularly in relation to the selection of the services);
- the average consumer will pay a moderate degree of attention to the selection of the goods and a variable degree of attention to the selection of the services;
- the applicant's goods in classes 29 and 30 are similar to the opponent's services to at least a medium degree;
- the competing services in class 43 are identical;
- the word "Caspian"/"caspien" dominates the overall impression both parties' trade marks convey and it is in this word the distinctiveness of the competing trade marks lies;
- the competing trade marks are visually similar to a fairly high degree and aurally similar to a high degree;
- the competing trade marks are either conceptually identical or conceptually neutral;

- the opponent's earlier trade mark is possessed of an average degree of inherent distinctive character.

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

34. In reaching a conclusion on the likelihood of confusion, I begin by reminding myself that the competing goods and services in these proceedings are either identical or similar to at least a medium degree. The level of attention paid by the average consumer during the selection process is also an important consideration; the more considered the purchase the less likely the average consumer will be prone to the effects of imperfect recollection and vice versa. In this regard, I have concluded the average consumer will pay only a moderate degree of attention to the selection of the goods and a variable degree of attention to the selection of the services. However, even if I had concluded that (i) the average consumer would pay a high degree of attention to the selection of all the goods and services at issue and (ii) the conceptual position was neutral, I have no hesitation concluding that the fairly high degree of visual similarity and the at least high degree of aural similarity between the trade marks at issue, will lead to direct confusion. However, even if I am wrong in that regard, the fact that the overall impression and distinctiveness of all the trade marks at issue will be dominated by the word "Caspian"/caspian" (and as the other components in the competing trade marks are descriptive/non-distinctive) will lead, at the very least, to a likelihood of indirect confusion.

Overall conclusion

35. The opposition has succeeded and, subject to any successful appeal, the application will be refused.

Costs

36. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Using the TPN mentioned as a guide, but making no award to the opponent in respect of the preparation of its Notice of Opposition/review of the applicant’s defence (to reflect the fact that its Notice of opposition was amended on two occasions which in turn meant that whilst still professionally represented the applicant incurred additional costs amending its counterstatement on two occasions), I award costs to the opponent on the following basis:

Preparing evidence:	£500
Written submissions:	£200
Official fee:	£100
Total:	£800

37. I order Caspian Ealing Ltd to pay to Caspian Holding Franchise Limited the sum of £800. 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 22nd day of August 2017

C J BOWEN
For the Registrar

ANNEX

