

O/638/17

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3181758**

**BY SMD CONCEPTS LIMITED**

**TO REGISTER THE TRADE MARK:**

**TIFFINS**

**IN CLASS 43**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 407907**

**BY NAZLI OZKAN AND SASEETHARAN THIAGARAJAH**

## **Background and pleadings**

1. On 23 August 2016, SMD Concepts Limited (“the applicant”) applied to register the trade mark **TIFFINS** for the following services:

Class 43 Services for providing food and drink; restaurant services; bar services; café services; wine bar services; banqueting services; catering services for providing food and drink; advisory services relating to café, restaurant, bar and catering services; advisory and information services relating to the selection, preparation and serving of food and beverages; restaurant services incorporating licensed bar facilities; restaurant reservation services; booking of restaurant places (seats), including online from a computer database or from the Internet.

2. The application was published for opposition purposes on 16 September 2016. It is opposed by Nazli Ozkan and Saseetharan Thiagarajah (“the opponents”). The opposition is based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”), and is directed against all of the services in the application.

3. Under ss. 5(2)(b) and 5(3), the opponents rely upon their UK trade mark registration no. 2550760 for the trade mark **THE TIFFIN TIN**. The mark was applied for on 18 June 2010 and its registration procedure was completed on 5 November 2010. The mark is registered for the following services in class 43, all of which are relied upon:

Class 43 Take-away services; restaurant, cafe, snack bar services; catering services; preparation of meals and food stuffs for consumption off the premises.

4. Given its date of filing, the opponents’ mark qualifies as an earlier mark in accordance with s. 6 of the Act. The opponents state in their Notice of Opposition that the mark has been used in relation to all of the services relied upon. This statement is

made because the earlier mark is subject to the proof of use provisions contained in s. 6A of the Act.

5. The opponents' claims under s. 5(2)(b) can be summarised as:

- The services are identical or highly similar;
- The marks share the common element "TIFFIN", which is a distinctive and dominant element in both marks;
- The marks are highly similar visually, aurally and conceptually;
- The relevant public is likely to believe that the services are provided by the same or economically linked undertakings.

6. Under s. 5(3), the opponents add that:

- Consumers are likely to associate the application with the opponents' mark, thus conferring an unfair advantage on the later mark;
- Any connection made between the marks could lead to detriment to the earlier mark, particularly if the applicant's services are of lower quality;
- An association with the mark applied for could damage the distinctive character of the earlier mark, reducing its value and affecting the purchasing decisions of consumers.

7. Under s. 5(4)(a), the opponents rely on the use since 2004, in London and the surrounding areas, of the sign **THE TIFFIN TIN**. The opponents claim a goodwill associated with that name and claim that the use of the mark applied for would constitute a misrepresentation to the public which is likely to cause damage to the opponents' business.

8. The applicant filed a counterstatement in which it denies the basis of the opposition and in which it requests that the opponents provide evidence that they have used the earlier mark. In particular, I note the applicant's claims that:

- The word "TIFFIN" is not distinctive. In the context of the provision of food and drink, the word is of inherently low distinctiveness;

- “TIFFIN” does not form a dominant element in the opponents’ mark. The mark refers to a specific object and the word “TIN” is the dominant element in the mark;
- There are significant conceptual, aural and visual differences between the marks;
- There are clear differences between the services: they are neither identical nor highly similar;
- The applicant’s activities would not result in detriment to the earlier mark. There is no risk of detriment to the earlier mark’s distinctive character or any potential for a reduction in the mark’s value;
- Use of the application would not constitute a misrepresentation to the public causing damage to the opponents’ business.

9. Both parties have been professionally represented throughout, the opponent by Wildbore & Gibbons LLP and the applicant by Fladgate LLP. Both parties seek an award of costs.

10. Only the opponents 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 all of the papers.

## **Evidence**

### Opponents’ evidence

12. This consists of the witness statement of Nazli Ozkan and ten exhibits. The statement contains a mixture of evidence and submission: I do not summarise the submissions here but I have taken them all into account and will refer to them, as appropriate, later in this decision.

13. Ms Ozkan describes herself as the co-founder and director of “The Tiffin Tin” business. She states that, having opened their first restaurant in Hornsey in 2005,<sup>1</sup> the opponents now own five establishments, all in London, which operate under the name “THE TIFFIN TIN”.<sup>2</sup> Ms Ozkan indicates that the five restaurants operate as separate companies for tax purposes and were converted from partnerships into limited companies in 2015.<sup>3</sup> The impression given by Ms Ozkan’s evidence, in which she indicates that her statement is made “from my own knowledge or obtained from internal records to which I have free and full access”, is that she is a controlling mind of the companies. I also note that she refers to “our business” throughout, whether in relation to the original takeaway or all five establishments. The applicant has not disputed whether the use is by the opponents or with their consent. In the absence of any such challenge, I proceed on the basis that any use shown, if not use by the opponents themselves as the controlling minds of the limited companies, is with the opponents’ consent. I will also adopt Ms Ozkan’s approach and refer to the opponents’ commercial enterprise generally as “the opponents’ business”, unless I indicate otherwise.

14. Ms Ozkan states that “THE TIFFIN TIN branches are primarily take-away restaurants, with some minimal provision for casual eat-in dining and catering services for events. Our business plan includes expansion to dine-in restaurant services within the very near future”.<sup>4</sup> Total turnover is given as £1,912,959 for the financial year ending 31 March 2016, being broken down for each location as follows:

Hornsey	£473,101
West Hampstead	£323,374
Totteridge	£243,844
Tufnell Park	£446,250
Wanstead	£426,390

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<sup>1</sup> §7.

<sup>2</sup> §9 and exhibit NO2

<sup>3</sup> §12.

<sup>4</sup> §10.

15. Ms Ozkan exhibits an invoice for £950 to The Tiffin Tin Hornsey for “social media services” provided between December 2015 and February 2016.<sup>5</sup> There is also a copy of the Tiffin Tin social media strategy document, along with two invoices, dated February and May 2016, for social media marketing consultancy.<sup>6</sup>

16. A number of articles and reviews are exhibited.<sup>7</sup> The most relevant are an article from *The Times* dated 16 November 2013 entitled “Giles Coren’s Top 50 restaurants” in which the author says that he has had “two stellar takeaways” from The Tiffin Tin, and an unattributed article dated May 2011 about multi-cultural London, in which the opponents’ restaurants are mentioned.<sup>8</sup> The remaining reviews at exhibit NO4 are not dated, though I note that one reviewer states that “The Tiffin Tin fed over 250 guest at my wedding in July 2010 [all sic] [...]”. There are also reviews from just-eat.co.uk dated between October 2015 and October 2016, most of which are star-ratings.<sup>9</sup> However, some reviewers refer to, for example, delivery times. As well as the establishment being identified as “The Tiffin Tin” on the web page, the following mark is shown:<sup>10</sup>



17. Exhibit NO7 is a print from hungryhouse.co.uk which is said to be a review of The Tiffin Tin dated 2 July 2013. However, only the title is legible.

18. Exhibit NO6 is a print from timeout.com, dated 1 October 2015, giving details about The Tiffin Tin locations. The premises in postcode area N19 are described as “our largest outlet” where customers can “[expect] exciting, tasty, authentic freshly cooked food delivered to your door”.

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<sup>5</sup> Exhibit NO3, p. 11

<sup>6</sup> Exhibit NO3, pp. 17-18.

<sup>7</sup> Exhibits NO4, NO5, NO7 and NO8

<sup>8</sup> Exhibit NO4.

<sup>9</sup> Exhibit NO5.

<sup>10</sup> pp. 26, 29.

19. Exhibit NO9 consists of three invoices to the Tiffin Tin, for design services (May 2010) and menu leaflets (October 2012 and January 2016). Ms Ozkan states that “[the] invoices are each for 100,000 leaflets which are distributed to customers in the local vicinity of each restaurant”.<sup>11</sup> There is also a copy of “the menu design” which shows the mark as follows:<sup>12</sup>



I note that the menu also states “Party Catering available”.

20. NO10 is a design for a takeaway box featuring the same mark as shown at paragraph 19, above. It is said to be dated 19 July 2010.

21. In addition, there is an article from the *Guardian* which describes what “tiffin” was in the context of the British Raj.<sup>13</sup> I will return to this later.

22. As the applicant did not file any evidence, that concludes my summary of the evidence, insofar as I consider it necessary.

### **Proof of use**

23. The first issue is whether, or to what extent, the opponents have shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A- (1) This section applies where -

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<sup>11</sup> §14(f).

<sup>12</sup> p. 46.

<sup>13</sup> Exhibit NO1.

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.



(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services”.

24. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it”.

25. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch); [2013] F.S.R. 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *Pasticceria e Confetteria Sant Ambroeus Srl v G&D Restaurant Associates Ltd (SANT AMBROEUS Trade Mark)* [2010] R.P.C. 28 at [42] of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV (C-40/01)* [EU:C:2003:145]; [2003] E.T.M.R. 85, *La Mer Technology Inc v Laboratories Goemar SA (C-259/02)* [EU:C:2004:50]; [2004] E.T.M.R. 47 and *Silberquelle GmbH v Maselli-Strickmode GmbH (C-495/07)* [EU:C:2009:10]; [2009] E.T.M.R. 28 (to which I added references to *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-416/04 P)* [EU:C:2006:310]). I also referred at [52] to the judgment of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV (C-*

149/11) *EU:C:2012:816*; [2013] *E.T.M.R.* 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C-141/13 P)* *EU:C:2014:2089* and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd (O/528/15)* [2016] *E.T.M.R.* 8.

218. [...]

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For

example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]”.

26. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public”.

27. He went on to say:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is

sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted”.

28. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the

question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use”.

29. According to section 6A of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the mark applied for. The relevant period is, therefore, 17 September 2011 to 16 September 2016.

30. Although Ms Ozkan states that the opponents’ business began in 2005 with the opening of their first premises, she only gives turnover figures for the financial year 2015-2016 and the majority of the evidence relates to the same period. For what Ms Ozkan admits is essentially a takeaway business, the turnover does not strike me as unreasonably small. In terms of the geographical reach of the use, the vast majority of the exhibited evidence is local to London, though I acknowledge that the *Times* article from 2013 will have had national reach. Although just-eat is a national website, the services are only likely to be provided within a limited radius of the premises, which are in north and east London. Having said that, while the territorial extent of the use is a factor in assessing genuine use, the nature of takeaway services is such that they are usually very local. Ms Ozkan also gives unchallenged evidence that the business has added new premises in different areas of London over time, suggesting a pattern of

expansion. The evidence showing that the opponents have sought to develop a media strategy to attract more custom reinforces my impression that the business continues to develop. Taking the evidence as a whole, I am satisfied that the evidence shows a level of use sufficient to constitute genuine use of the mark.

31. As regards the form in which the mark has been used, in *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under s.46(2) of the Act as follows:

“33. [...] The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period [...].

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all”.

32. There is evidence of the opponents’ business being referred to within the relevant period as “The Tiffin Tin” both in articles and reviews, and on invoices. The images of the mark in use date from both before and during the relevant period. The mark is as follows:



The evidence shows the mark both with and without the words “REAL Indian food for take-home or delivery”. The stylisation is minimal, consisting only of a slightly stylised typeface and a dark background. Where the mark is used in combination with the words “REAL Indian food for take-home or delivery”, those words are likely to be perceived as a non-distinctive strapline and be accorded no trade mark significance. I am of the view that the very slight stylisation in the mark as used does not alter the distinctive character of the registered mark.

33. The next step is to decide whether the opponents’ use entitles them to rely on all of the services identified in the notice of opposition. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned”.

34. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].



iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46".

35. Ms Ozkan describes the opponents' business as "primarily take-away restaurants, with some minimal provision for casual eat-in dining and catering services for events".<sup>14</sup> That accords with my impression of the evidence. Although Ms Ozkan also states that the opponents' plans include "expansion to dine-in restaurant services", there is nothing in the evidence to suggest that the business operated by the opponents is, in reality, a restaurant business. Whilst the evidence shows that the opponents' businesses are occasionally referred to as restaurants (e.g. p. 20), this is in the context of lists of eateries and I do not consider it safe to infer from that alone that the business is what would normally be considered a restaurant. The menus exhibited give the impression of being takeaway leaflets, whilst the customer reviews refer to factors such as delivery times; there are no countervailing references which would suggest a restaurant operation, such as comments about the standard of the service or attentiveness of waiting staff.

36. I note that the menus refer to catering being available and that there is one review in the evidence where the reviewer refers to catering at a wedding. However, this dates from before the relevant period and, the turnover figures not being broken down, there is no way for me to establish whether, or to what extent, catering services were provided in the relevant period, still less whether such use is warranted in the economic sector. Bearing in mind all of the above, I consider that a fair specification, upon which the opponents may rely, is "take-away services; preparation of meals and food stuffs for consumption off the premises".

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

37. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

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

[...]

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<sup>14</sup> §10.

(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”.

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 are:

(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.

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

39. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then decide the manner

in which these 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”.

40. The opponents have not commented directly on the average consumer, although Ms Ozkan states that “the business operating under the name THE TIFFIN TIN has generated significant goodwill and reputation among a significant portion of the UK public, namely consumers of Indian food across North and East London”.<sup>15</sup> The applicant has not made any submissions regarding the average consumer.

41. In my view, the average consumer of the majority of the services at issue is a member of the general public. However, in relation to banqueting and catering services, in addition to the general public, there would be a second group of relevant consumer, namely business users.

42. The purchasing process is likely to be dominated by visual considerations, as the average consumer is likely to select the services at issue following inspection of the premises’ frontage on the high street, on websites and in advertisements, for example in magazines, on flyers or on posters. However, given that word-of-mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services.

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<sup>15</sup> §15.

43. The average consumer's level of attention will vary across the range of services, depending on factors such as the type of food and drink provided, the cost of the service offered and the nature of the establishment/event. However, generally speaking, the member of the general public purchasing the services at issue will do so with an average degree of attention. I consider that the position for banqueting and catering services is slightly different as, for both groups of relevant average consumer, considerable sums may 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 these services will pay a higher than average, though not the highest, degree of attention to the selection of the service.

### **Comparison of services**

44. When making the comparison, all relevant factors relating to the services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment:

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

45. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- 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 inquiry 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.

46. In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

47. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

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

48. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if terms are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

49. In *Separode Trade Mark* BL O-399-10 (AP):

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision”.

50. 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 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”.

51. 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., sitting as the Appointed Person, noted 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”.

#### Services for providing food and drink

52. This is a very broad term and encompasses the opponents’ “take-away services”. The services are identical on the principle outlined in *Meric*. However, I recognise that “services for providing food and drink”, notionally speaking, covers services which are not identical to “take-away services”. However, no fall-back specification has been provided to limit to such services and, in any event, such services would still, in my

view, be similar at least to a low degree, coinciding in both purpose and users, as well as being potentially competitive or complementary.

#### Restaurant services; restaurant services incorporating licensed bar facilities

53. These services share the same intended purpose of providing food and drink, as well as some similarity in nature, with takeaway services. It is common for a restaurant to offer a takeaway service in parallel to its eat-in services, so channels of trade may overlap. Whilst there is some difference in the method of use, there is competition between the services, as a takeaway may be chosen instead of a meal in a restaurant. The services are similar to a reasonably high degree.

#### Café services

54. Like takeaway services, the above services are concerned with the provision of food and drink. Although café services often entail the provision of seating areas for customers, it is also generally possible to purchase food and drink to consume off the premises. There is, therefore, overlap in the intended purpose, nature, users and channels of trade, and there may be competition between the services. They are similar to a reasonably high degree.

#### Bar services; wine bar services

55. The provision of food and drink go hand in hand, with bars serving food and takeaways selling beverages. I acknowledge that the focus is likely to be on drinks and food, respectively. Whilst takeaways do not, as a rule, sell wine, all of the services will provide soft drinks. Accordingly, there is a degree of overlap in the services' intended purpose, and their users are identical. However, there is a difference in the nature of the services and in their method of use, as bars and wine bars do not usually sell either food or drink for consumption off the premises, whilst takeaways do exactly that. There

may be a degree of competition between the services but they are not complementary. They are similar to a fairly low degree.

Banqueting services; catering services for providing food and drink

56. Although the precise nature of the services is not identical to takeaway services, they are all concerned with providing ready-to-consume food and drink. Their channels of trade are not likely to overlap. The users, however, may be the same. I do not think that there is a materially competitive relationship, as one would not ordinarily replace the other, and there is no complementarity. The services are similar to a low degree.

Restaurant reservation services; booking of restaurant places (seats), including online from a computer database or from the Internet

57. Whilst these services involve restaurants, they are otherwise unconnected to the provision of food and drink, their purpose being to enable the booking of restaurant tables, something which takeaway services do not entail. I acknowledge that it is possible to order takeaway meals through third parties but that does not seem to me to be a natural reading of the services provided under “restaurant reservation services”. They are not similar in either nature or purpose to the opponents’ takeaway services. Although their users may overlap, their channels of trade will not and they are neither in competition nor complementary. They are not similar.

Advisory services relating to café, restaurant, bar and catering services; advisory and information services relating to the selection, preparation and serving of food and beverages

58. These services are different from services which provide food and drink per se. Their respective nature, intended purpose and methods of use are all different. In general, the providers of these services are not the providers of the food services themselves and the relevant consumer would not approach the provider of these

advisory services expecting to access the opponents' takeaway services. The fact that the information at issue relates to services which are, themselves, similar to the opponents' services, is not sufficient to find similarity. There is no material similarity.

### **Comparison of trade marks**

59. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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”.

60. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Applicant's mark	Opponents' mark
TIFFINS	THE TIFFIN TIN

61. I have no submissions from the applicant on this point beyond the comments in the pleadings. I note that Ms Ozkan provides in her evidence a 2014 article from the *Guardian* newspaper about the meaning of the word “tiffin”, which states that “tiffin might mean a packed lunchbox or afternoon tea, a savoury snack or a sweet treat”.<sup>16</sup> Ms Ozkan further submits that:

“[...] in India, the word TIFFIN can either refer to a midday meal or the name for a lunchbox. [...] Contrary to the Applicant's arguments, however, this word is not widely recognised or understood among UK consumers, nor used in everyday English language”.

62. The applicant's mark consists of the word “TIFFINS”, presented in capital letters. The overall impression and distinctiveness of the mark lies in its totality.

63. The opponents' mark consists of the words “THE TIFFIN TIN”, also presented in capital letters. The word “THE”, as indefinite article, has less relative weight in the overall impression than the words “TIFFIN” and “TIN”, which play an equal role.

64. In terms of visual similarity, both marks share the word “TIFFIN”, albeit pluralised in the application. There is a clear difference due to the presence of the words “THE” and “TIN” in the earlier mark. I consider that there is a medium degree of visual similarity. As the various elements of each mark will be articulated and pronounced entirely

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<sup>16</sup> NO1, p. 6.

predictably, the same considerations apply to the aural similarity, which is also of a medium level.

65. The position regarding conceptual similarity is more complicated. The applicant submits that the earlier mark “refers very specifically to the receptacles in which “TIFFINS” i.e. light meals are transported”. For her part, Ms Ozkan states that “it is clear to me that the trade marks THE TIFFIN TIN and TIFFINS have a highly similar meaning, with THE TIFFIN TIN referring to the singular item and TIFFINS being the plural version”.<sup>17</sup>

66. The *Oxford Dictionary of English* provides the following definitions of the word “tiffin”:

“1. *dated or Indian* a snack or light meal: *tiffin has been ready for some time* | [*count noun*] : *I made sure they have not forgotten their tiffins* | [*as modifier*] : *a tiffin carrier*.

2. *chiefly British* a cake or dessert made with crushed biscuits, golden syrup, and chocolate, and chilled in a fridge: *the tiffin was a decadent chocolatey treat*”.<sup>18</sup>

67. The *Collins English dictionary* defines “tiffin” as “(in India) a light meal, esp one taken at midday” and “[British, Obsolete] lunch”.

68. There can be no doubt that “tiffin” can mean lunch or a light meal/snack. The difficulty is whether the average UK consumer will know that. The tone of the *Guardian* article in Ms Ozkan’s evidence is explanatory, suggesting that at least the author of the piece considered that the UK reader may not know the word’s meaning. However, that article is the only evidence on the matter and it is not conclusive one way or another. I note in considering the point the comments of Anna Carboni, sitting as the Appointed Person, in *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08. In that case, Ms Carboni

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<sup>17</sup> §4.

<sup>18</sup>[http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m\\_en\\_gb0864100?rskey=wpvbll&result=1](http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en_gb0864100?rskey=wpvbll&result=1) [accessed 24 November 2017].

described the limits to which judicial notice can be used in order to find that the average consumer is aware of particular facts. She said:

“While the Applicant contended in its Counterstatement that the earlier marks would be recognised to refer to the Cherokee tribe and that the tribe was well known to the general public, no evidence was submitted to support this. By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are”.

69. In that case she found that although the hearing officer was entitled to take judicial notice of the fact that CHEROKEE was the name of a tribe of native Americans, he was not entitled to attribute this knowledge to the average UK consumer of clothing.<sup>19</sup>

70. No doubt, some people will be aware of the meaning of tiffin as lunch or a light meal, and some may be aware of its etymology. However, in the absence of any evidence on the point, I am not satisfied that such an assumption may be made across the board about the average consumer of the services at issue. The history of the British Raj is not, to my knowledge, widely taught in schools, nor is it frequently referenced in the news. The indications that the term is “dated” or “obsolete” in the dictionary definitions quoted above support my view that it would be wrong to impute knowledge of the word and its meaning to the average consumer in the UK.

71. In terms of “tiffin” as a type of cake, the parties have not suggested that the average consumer would understand the word in that way. Given that it is in current usage, however, I think it more likely that this meaning would be understood by the average

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<sup>19</sup> See also: *Wunderkind Trade Mark* [2002] R.P.C. 45, in which the registrar’s refusal to attribute knowledge of the German meaning of that word to UK consumers, despite evidence of a small number of uses of that word in UK press articles, was upheld by the High Court.

consumer, though I am not aware that “tiffin” is very commonly available or that it is known to the extent that very well-known cakes, such as Victoria sponge, would be. Nonetheless, I accept that there would be a group of average consumers who would understand the word “tiffin” as meaning a type of cake. That said, I do not consider that it would be safe to conclude that all average consumers would perceive the word in that way. Given my findings that the historical meaning of “tiffin” will not be widely known and that not all average consumers will know that “tiffin” is a cake, it follows that there will be a group of average consumers for whom the word “tiffin” would have no meaning and for whom “tiffin” would be perceived as an invented word.

72. For the sake of completeness, I note that “Tiffin” is also a surname. The parties have not suggested that the average consumer will attribute that meaning to the word. It is not, to my knowledge, a particularly common surname. I do not think it likely that the average consumer will understand the word in this way in either mark.

73. The applicant submits that the mark “refers very specifically to the receptacles in which “TIFFINS” i.e. light meals are transported”. For her part, Ms Ozkan states that “it is clear to me that the trade marks THE TIFFIN TIN and TIFFINS have a highly similar meaning, with THE TIFFIN TIN referring to the singular item and TIFFINS being the plural version”.<sup>20</sup> I agree that “tin” will be interpreted as a receptacle rather than the element: although the word “THE” in the earlier mark is of low distinctiveness, its presence points towards “TIN” meaning a specific object.

74. While there will doubtless be some average consumers who know precisely what a tiffin tin is, there will be significant proportion of average consumers who do not. Among those, consumers who identify “tiffin” as a cake and who do not know exactly what a tiffin tin is are likely, given that storage containers for cake are typically called cake tins, to assume that “THE TIFFIN TIN” is a container for that cake (tiffin). There is for those consumers a degree of conceptual similarity, to the extent that both marks reference the same cake.

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<sup>20</sup> §4.



75. For those consumers who do not know what either tiffin or a tiffin tin is, only the earlier mark will convey any distinct conceptual message, namely that of a tin. The marks, for this category of average consumer, are conceptually different, albeit a non-distinctive difference where one mark has a clear meaning while the other does not.

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

76. 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 goods 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*, 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)”.

77. Invented words usually have the highest degree of distinctive character, while words which are descriptive of the goods normally have the lowest. Distinctiveness can be enhanced through use of the mark. Although the opponents have not made an explicit claim of enhanced distinctiveness, they have filed evidence of use. The turnover figures provided are not negligible but they refer only to one financial year. The evidence also shows a limited geographical reach, in a marketplace which must be vast (though there is no evidence on the point). 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.

78. Turning then to the inherent position, the mark consists of three dictionary words, a combination which is distinctive in relation to the services at issue. I consider that the mark has a medium level of inherent distinctive character.

### **Likelihood of confusion**

79. I have found that “restaurant reservation services; booking of restaurant places (seats), including online from a computer database or from the Internet; advisory services relating to café, restaurant, bar and catering services; advisory and information services relating to the selection, preparation and serving of food and beverages” are not similar to the services upon which the opponents may rely in the earlier mark. If there is no similarity, there can be no confusion.<sup>21</sup> The opposition under s. 5(2)(b) fails in relation to these services.

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<sup>21</sup> *Waterford Wedgwood plc v OHIM* – C-398/07 P

80. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 (*Lloyd Schuhfabrik* at [26]).

81. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

82. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

83. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Purvis, again sitting as the Appointed Person, pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it".

84. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

85. I have found that the services at issue range from identical to similar only to a low degree and that the degree of attention paid to the purchase will vary from average to above average. The earlier mark has a medium level of inherent distinctive character. The marks are visually and aurally similar to a medium degree. The conceptual position will vary, depending on whether the consumer attributes a meaning to the word "tiffin" or not.

86. Considering first the position in relation to those average consumers who perceive the word "TIFFIN" as invented, where the services are similar to a low degree and are

purchased with an above average level of attention, I do not consider that there is a likelihood of direct confusion. The presence of additional elements in the earlier mark is unlikely to be overlooked by the average consumer. However, indirect confusion must also be considered. I have borne in mind that a low level of similarity between the services and the above average level of attention might mitigate against confusion. Nonetheless, in circumstances where the shared element is perceived as an invented word, and the later mark has no other elements to assist in distinguishing it, bar the plural form, I consider that the average consumer will perceive the services provided under the marks as emanating from the same economic undertaking. It follows that the same applies to those services which have a higher degree of similarity and which are selected with less care. There is a likelihood of indirect confusion.

87. Strictly speaking, having found that a significant proportion of average consumers will be confused, there is no need for me to consider the remaining group of average consumers, namely those who identify “tiffin” as a type of cake.<sup>22</sup> The opponents’ case is weaker in this regard. Having carefully considered whether the application will merely bring the earlier mark to mind rather than cause confusion, it is, in my view, likely that there will also be indirect confusion, even in respect of those services which are only similar to a low degree. The presence in both marks of the distinctive element “TIFFIN”, which is qualified rather than altered in the earlier mark by the words “THE” and “TIN”, is sufficient to cause the average consumer to consider that the services are provided by the same or related undertakings. That likelihood is not mitigated, in my view, by the fact that the application is the plural “TIFFINS” form of the word or by the conceptual distinctions between the marks.

88. As the opposition under s. 5(2)(b) has failed in respect of “restaurant reservation services; booking of restaurant places (seats), including online from a computer database or from the Internet; advisory services relating to café, restaurant, bar and catering services; advisory and information services relating to the selection,

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<sup>22</sup> See Floyd J’s comments in *J.W. Spear & Sons Ltd and Others v Zynga Inc* [2015] EWCA Civ 290 at [37] and the comments of Mann J in *SoulCycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch) at [23]-[30].

preparation and serving of food and beverages”, I must consider the remaining grounds, though I do so in respect of these services only.

### **Section 5(4)(a)**

89. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

90. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, HHJ Melissa Clarke sitting as a deputy Judge of the High Court stated that:

“55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL, namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a *substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived

(per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)”.

91. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

#### The relevant date

92. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander Q.C., sitting as the Appointed Person, considered the matter of the relevant date in a passing off case. He said:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour



complained about, and then to assess whether the position would have been any different at the later date when the application was made.”.

93. The contested mark was filed on 23 August 2016. There has been no claim that it has been used prior to that date and there is no evidence to that effect. Consequently, I need only consider the position at the date of application.

### Goodwill

94. I bear in mind the following guidance from the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start”.

95. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off

claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation”.

96. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience”.<sup>23</sup>

97. The opponents’ comments regarding s. 5(4)(a) are brief. They claim that, as a result of their goodwill, “any use of TIFFINS by the Applicant similar goods [sic] would constitute a misrepresentation to the public which is likely to cause damage to the Opponent’s [sic] business”. There is nothing to indicate that the opponents consider that s. 5(4)(a) offers a stronger case than s. 5(2)(b).

98. I indicated at paragraph 13, above, that the evidence does not make it clear how the opponents are linked to the limited companies. However, for reasons of procedural economy, I will assume, without deciding, that there was at the date of application a protectable goodwill in relation to “takeaway services; preparation of meals and food stuffs for consumption off the premises” sold under the sign “THE TIFFIN TIN”, which is

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<sup>23</sup> See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA)

owned by the opponents. That said, the only evidence of turnover is Ms Ozkan's narrative evidence relating to the financial year 2015-2016 and there is, therefore, no way for me to gauge the level of any goodwill before 2015. When coupled with the limited geographical extent of the use, my view is that the goodwill is likely to be at a relatively low level.

### Misrepresentation

99. The relevant test was outlined by Morritt L.J. in *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, where he stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101”.

100. And later in the same judgment:

“477 [...] for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University*

*of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion”.

101. I have already found that the various advisory and booking services in the application are not similar to the services of the earlier mark. Of course, the absence of a common field of activity is not fatal to a claim of passing off but nor is it irrelevant.<sup>24</sup> The parties’ services are provided in distinct fields and it is not, to my knowledge, common practice for the same business to offer both takeaway services and table booking or advisory services. I acknowledge that it is usual for restaurants to accept bookings for tables but the same is not true of takeaway services. Taking all of the above into account, I do not consider that a substantial number of the opponents’ customers or potential customers would have been deceived or misled into believing or assuming that the opponent was responsible for the applied-for services sold under the mark “TIFFINS”. Consequently, use of that mark by the applicant would not have amounted to a misrepresentation to the public. The section 5(4)(a) ground in respect of “restaurant reservation services; booking of restaurant places (seats), including online from a computer database or from the Internet; advisory services relating to café, restaurant, bar and catering services; advisory and information services relating to the selection, preparation and serving of food and beverages” fails accordingly.

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

102. Section 5(3) states:

“(3) A trade mark which-

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<sup>24</sup> *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA) at 714.

(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”.

103. 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, *Addidas-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

104. As is clear from the case law cited above, the earlier mark must be known by “a significant part” of the relevant public in the UK for the services relied upon in order to qualify for protection under this ground. Although the sales figures provided by the opponents are not insignificant, they are restricted to a one-year period and a limited geographical area, i.e. north and east London. As I indicated above, whilst I acknowledge that websites such as [justeat.co.uk](http://justeat.co.uk) are available nationwide, there is nothing in the evidence to suggest that the same can be said of the opponents' services, nor that any advertising was on a national scale. I do not consider that the opponents have shown that their earlier mark benefits from a reputation among a significant part of the relevant public. The opposition under section 5(3) falls at the first hurdle and is dismissed accordingly.

### **Conclusion**

105. The opposition has been successful, save in relation to “restaurant reservation services; booking of restaurant places (seats), including online from a computer database or from the Internet; advisory services relating to café, restaurant, bar and catering services; advisory and information services relating to the selection, preparation and serving of food and beverages”. The application will proceed to registration for these services only; it will be refused for the remaining services.

## **Costs**

106. The parties have achieved a roughly equal measure of success. I direct that they each bear their own costs.

**Dated this 12<sup>th</sup> day of December 2017**

**Heather Harrison**

**For the Registrar**

**The Comptroller-General**