

O-497-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3349937 BY
SARFERAZ AHMED SHARIF
TO REGISTER:**



AS A TRADE MARK IN CLASS 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600001058 BY
THE JUNGLE RESTAURANT LTD**

Background & pleadings

1. On 31 October 2018, Sarferaz Ahmed Sharif (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the services shown in paragraph 11 below. The application was published for opposition purposes on 16 November 2018.

2. On 7 February 2019, the application was opposed in full under the fast track opposition procedure by The Jungle Restaurant Ltd (“the opponent”). The opposition is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying upon United Kingdom trade mark registration no. 3212773 for the trade mark **the jungle restaurant**, which has an application date of 14 February 2017 and registration date of 19 May 2017. The opponent relies upon all the services in class 43 of its registration (also shown in paragraph 11 below). The opponent states:

“The logo, font and name is similar and could cause confusion to customers, investors and prospective partners. We are a high end brand and depending on the quality of their product may devalue our standing with customers and potential investors.”

3. The applicant filed a counterstatement. As these are the only comments I have from him, they are reproduced below in full:

“The Applicant's response is that the mark and goods of the Opponent are not similar to the mark and goods of the Applicant and the application of opposition should be denied.

The Opponent relies on s 5(1) - identical mark

Main points are as follows:

Wording - The Opponents mark is a word mark only.

The Applicants mark is wording together with a logo. The wording is different, the colour of the wording is different, the style of font is different and overall wording would not confuse the average consumer when compared to the Opponents.

Logo - The Opponents mark does not have a logo.

The Applicants logo contains a graphic design contained in a circle with fire together with the wording steakhouse stencilled in a stylistic design at the bottom of the circle. The average consumer would not confuse the logo with the Opponents registered mark.

The Opponent relies on s 5(2)(a) - identical mark

The Applicants registered mark is not identical to the Opponents mark. The Applicants mark is different visually when compared with the Opponents mark. The Applicants mark is different conceptually and phonetically. The marks are not identical and would not create comparisons in the mind of the public. There would not be confusion as to the origin of the Applicants mark when compared to the Opponents mark.

The Opponent relies on s 5(2)(b) - similar mark

The Applicants registered mark is not similar to the Opponents mark. The Applicants mark is different visually when compared with the Opponents mark. The font, level of stylisation, colour and overall impression of the mark is unique. The Applicants mark is different conceptually and phonetically. The marks are not similar and would not create comparisons in the mind of the public. There would not be confusion as to the origin of the Applicants mark when compared to the Opponents mark.”

4. In these proceedings, the opponent is represented by Mr Leo Ihenacho and the applicant by HSK Solicitors LLP.

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

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

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

7. In an official letter dated 8 May 2019, the parties were allowed until 22 May 2019 to seek leave to file evidence or request a hearing and until 5 June 2019 to provide written submissions. A hearing was neither requested nor considered necessary. Neither party elected to file written submissions.

DECISION

8. The opposition is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Act, which read as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

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

(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.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

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

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

10. The registration upon which the opponent relies 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 the application was filed, it is not subject to the proof of use provisions contained in section 6A of the Act. The opponent is, as a consequence, entitled to rely upon it in relation to all of the services indicated without having to prove that genuine use has been made of it.

Comparison of services


11. The competing services are as follows:

The opponent's services (relied upon)	The applicant's services
Take-out restaurant services; Restaurants; Serving food and drink in restaurants and bars; Salad bars [restaurant services]; Takeaway services.	Restaurant services

12. As the opponent's specification includes the word "Restaurants", the services for which the applicant seeks registration are, self-evidently, identical to those of the opponent.

The objections based upon sections 5(1) and 5(2)(a) of the Act

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

The opponent's trade mark	The applicant's trade mark
the jungle restaurant	

14. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ("CJEU") held:

"54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where,

viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

15. The applicant’s trade mark contains, inter alia, a figurative component which appears between the words “JUNGLE” and “GRILL” which has no counterpart in the opponent’s trade mark. Given the size and positioning of this component within the applicant’s trade mark, I have no hesitation concluding that it will be noticed by the average consumer and, as a consequence, the oppositions based upon section 5(1) and 5(2)(a) of the Act fail and are dismissed accordingly.

Section 5(2)(b) – case law

16. 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 process

17. As the case law above indicates, it is necessary for me to determine who the average consumer is of the services at issue; I must then determine the manner in which such 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.”

18. The average consumer of the services at issue is a member of the general public. My own experience as an average consumer (which I do not regard as being atypical), informs me that restaurant services are most likely to be selected having considered, for example, promotional material and reviews (in hard copy and on-line) and on signage appearing on the high street; as a consequence, 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 process. The degree of care the average consumer will display when selecting such services is likely to vary. Contrast, for example, the low degree of care likely to be taken when one selects a venue for an impromptu snack, with the fairly high degree of attention one is likely to take when selecting a restaurant for an important family event. I shall return to this point when I consider the likelihood of confusion.

Comparison of trade marks under section 5(2)(b) of the Act

19. The trade marks to be compared are shown in paragraph 13 above. 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*:

“.....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.

21. The opponent’s trade mark consists of the words “the jungle restaurant” presented in lower case letters. All of these words will be well known to the average consumer. The word “the” is clearly non-distinctive. The words “jungle restaurant” form a unit which will dominate the overall impression the trade mark conveys and it is in this unit any distinctiveness resides.

22. Once again, all of the words in the applicant’s trade mark will be well known to the average consumer. The words “JUNGLE” and “GRILL” are presented in upper case letters in the colour brown. Like the words “jungle restaurant” in the opponent’s trade mark, these words form a unit. Positioned between these two words is a

circular device. This circular device is presented in brown with a white background and brown inner lines. It contains a two letter monogram consisting of the letters “J” and “G” (presumably to mirror the first letters of the words which appear either side of it). These letters are presented in the colours brown, green and white. At the top and bottom of the circular device there appears devices of flames and the words “STEAK HOUSE” respectively, both presented in the same colour orange. Before the letter “S” (of “STEAK”) and after the letter “E” (of “HOUSE”) there appears two circular devices presented in the same colour orange. Finally, above and below the words “JUNGLE GRILL” there appears horizontal lines presented in the same green colour to be found in the monogram.

23. The green horizontal lines and the orange circular devices are likely to have very little if any distinctive character. That, together with their size and positioning within the context of the trade mark as a whole, results in them having very little weight in the overall impression the applicant’s trade mark conveys. Given the services for which registration is sought, the words “STEAK HOUSE” and “GRILL” are descriptive and the devices of flames will, I am satisfied, be regarded by the average consumer to be ubiquitous. Rather, it is the unit created by the combination of the words “JUNGLE” and “GRILL” and the monogram consisting of the letters “J” and “G” which are likely to make the most important contributions to the overall impression the applicant’s trade mark conveys and it is these components which lend the trade mark the majority of its distinctive character.

Visual similarity

24. The competing trade marks only coincide in relation to the words “jungle”/“JUNGLE”. Weighing the similarities and differences in light of my previous conclusions, results in what I regard as a moderate (i.e. between low and medium) degree of visual similarity between the competing trade marks.

Aural similarity

25. As I mentioned earlier, the words in the competing trade marks will be well known to the average consumer. The manner in which the opponent’s trade mark

will be verbalised is predictable i.e. as the six syllable combination “the jun-gle res-tau-rant.” As for the applicant’s trade mark, it is well established that when a trade mark consists of a combination of words and figurative components it is by the word(s) that the trade mark is most likely to be referred to. As I see no reason why the average consumer would articulate either the letters “J”, “G” or the words “STEAK HOUSE”, in my view, the average consumer is overwhelmingly likely to refer to the applicant’s trade mark as “JUN-GLE GRILL”, resulting in a fairly high degree of aural similarity between the competing trade marks. However, even if I am wrong, and the average consumer refers to the applicant’s trade mark as “JUN-GLE J G GRILL” or “JUN-GLE GRILL J G” (or either of those combinations accompanied by the words “STEAK HOUSE”), as the word “JUNGLE” will be articulated first in all the examples I have described, it still results in what I regard as a medium degree of aural similarity.

Conceptual similarity

26. In its counterstatement, the applicant states that its trade mark is conceptually different to that of the opponent. It does not, however, explain why it considers that to be the case. I am satisfied that by the filing date of both the application for registration (October 2018) and the opponent’s earlier trade mark (February 2017), the concept of themed restaurants would have been fairly well known to the average consumer. That being the case and as both trade marks are likely to convey the concept of a jungle themed eating establishment, they are conceptually similar to a high degree.

Distinctive character of the earlier trade mark

27. 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.

28. As the opponent has filed no evidence of any use it may have made of the trade mark upon it relies, I have only its inherent characteristics to consider. I have already commented upon what, inter alia, I consider will be the conceptual message the opponent's trade mark is likely to convey to the average consumer. Approached on that basis, the opponent's trade mark is, in my view, possessed of a very low degree of inherent distinctive character.

Likelihood of confusion

29. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is 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 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 opponent's trade mark is not identical to that of the applicant;
- the competing services are identical;
- the average consumer is a member of the general public who will select the services at issue using a combination of visual and aural considerations, paying a varying degree of attention during that process;

- the competing trade marks are visually similar to a moderate degree, aurally similar to at least a medium degree and conceptually similar to a high degree;
- the opponent's earlier trade mark is possessed of a very low degree of inherent distinctive character.

30. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. 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 stated:

"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."

31. 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.

32. 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 services down to the responsible undertakings being the same or related.

33. In *Formula One Licensing BV v OHIM*, Case C-196/11P, the CJEU found:

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

34. In *L’Oréal SA v OHIM*, Case C-235/05 P, the CJEU found:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight

difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

35. As the above case law makes clear: (i) it is not permissible for me to conclude that the opponent’s earlier trade mark has no distinctive character, and (ii) the fact that the opponent’s trade mark has only a weak distinctive character does not preclude a likelihood of confusion. I shall bear those principles in mind in reaching a conclusion.

36. As normal and fair use of the opponent’s trade mark would include it being presented in, for example, the colours brown and orange, the fact that the applicant’s trade mark is presented in a number of colours does not assist it. Having reminded myself that identical services are in play, given what I consider to be, in particular, the significant visual differences between the competing trade marks, I think it is unlikely that the applicant’s trade mark will be mistaken for that of the opponent. In my view, there is unlikely to be direct confusion.

37. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained:

“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”.”

38. 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 trade marks share a common element. In this connection, he pointed out that it is not sufficient that a trade mark merely calls to mind another trade mark. This is mere association not indirect confusion.

39. I remind myself again that the earlier trade mark being relied upon has a very low degree of inherent distinctive character. However, notwithstanding that and the presence of, inter alia, the monogram in the applicant's trade mark, in my view, were the identical services at issue to be provided under trade marks which consist of or contain the words "the jungle restaurant"/"JUNGLE GRILL", even an average consumer paying a high degree of attention during the selection process is likely to assume they emanate from the same or commercially linked undertakings i.e. there is likely to be indirect confusion. For those average consumers paying a lower degree of attention during the selection process and who are, as a consequence, even more susceptible to the effects of imperfect recollection, the likelihood of indirect confusion is, in my view, even greater. As a finding of indirect confusion is sufficient for the opposition based upon section 5(2)(b) of the Act to succeed, the application will be refused.

Conclusion

40. The opposition based upon section 5(2)(b) of the Act has succeeded and, subject to any successful appeal, the application will be refused.

Costs

41. As the opponent has been successful, it is entitled to an award of costs. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice ("TPN") 2 of 2015. In an official letter to the opponent dated 8 May 2019, the tribunal stated:

“If you intend to make a request for an award of costs you must complete and return the attached pro-forma within 28 days of the date of this letter, that is on or before **5 June 2019**, and send a copy to the other party.

If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded...”

42. As the opponent did not respond to that invitation either by the deadline set or by the date of the issuing of this decision, the only costs it is entitled to is in respect of the official fee for filing its opposition. I therefore order Sarferaz Ahmed Sharif to pay to The Jungle Restaurant Ltd the sum of £100. 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 27th day of August 2019

C J BOWEN
For the Registrar