

O/527/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION UK 3392829

BY

MARK LAWRENCE ROBINSON

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 43



AND OPPOSITION THERETO (NO. 600001129)

BY

THE NAKED DELI LTD

Background and Pleadings

1. MARK LAWRENCE ROBINSON (The Applicant) applied to register the trade mark, as displayed on the front cover page, on the 17 April 2019 which was published on the 3 May 2019 for services in class 43 namely *Restaurant and Bar Services*.

2. THE NAKED DELI LTD (The Opponent) opposes the application by way of the Fast Track opposition procedure, under section 5(2)(b) of the Trade Marks Act 1994 (the Act). It relies on its earlier UK registered trade mark as displayed below, numbered UK3315211, filed on the 4 June 2018 and registered on 31 August 2018.



3. Whilst the Opponent's mark is also registered for goods and services in classes 29, 30 and 32 it has limited its opposition, relying on its services in class 43 only.

4. The Opponent claims that there is a likelihood of confusion because the trade marks are similar and are to be registered for services identical with or similar to those for which the earlier mark is protected. The Opponent did not make any additional representations within its statement of grounds regarding the basis of its opposition.

5. Mr Robinson filed a defence and counterstatement denying the claims made submitting that he does "not believe that that there will be any confusion to the general public" as "'deli' and 'RESTAURANT & BAR' are not similar enough for customers not to be able to make a clear distinction between the two establishments."

6. Neither party is represented and neither party filed submissions nor applied for leave to file evidence.¹ The matter has therefore proceeded in accordance with the Fast Track procedure. I have taken note of Mr Robinson's submissions contained within his original TM8 pleadings, which I will refer to, where necessary, in my decision.

Decision

7. The opposition is based on section 5(2)(b) of the Act which states:

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

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

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

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

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

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

....

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and

¹ Rule 20(4) Trade Mark Rules 2008

which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

9. In these proceedings, the Opponent is relying upon its UK trade mark registration, shown above, which qualifies as an earlier mark under section 6 of the Act. As the earlier mark had not been registered for 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. Consequently, the Opponent is entitled to rely upon all its Class 43 services of its registration, as specified, without having to establish genuine use.

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

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, is not sufficient;

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

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

Comparison of the services

11. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc.* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

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

12. The competing services are set out as follows:

The Applicant’s services	The Opponent’s services
Class 43: Restaurant and Bar Services	Class 43: Accommodation booking agency services [time share]; Accommodation bureau services; Accommodation bureau services [hotels, boarding houses]; Accommodation bureaux [hotels, boarding houses]; Accommodation

	<p>bureaux services; Accommodation exchange services [time share]; Accommodation letting agency services [time share]; Accommodation (Rental of temporary -); Accommodation reservation services; Accommodation reservation services [time share]; Accommodation reservations; Accommodation reservations (Temporary -); Accommodation services; Accommodation services for functions; Accommodation services for meetings; Advice concerning cooking recipes; Agency services for booking hotel accommodation; Agency services for reservation of restaurants; Agency services for the reservation of temporary accommodation; Animal boarding; Animals (Boarding for -); Appraisal of hotel accommodation; Arranging and providing temporary accommodation; Arranging holiday accommodation; Arranging hotel accommodation; Arranging of accommodation for holiday makers; Arranging of accommodation for tourists; Arranging of banquets; Arranging of holiday accommodation; Arranging of hotel accommodation; Arranging of meals in hotels; Arranging of temporary accommodation; Arranging of wedding receptions [food and drink]; Arranging of wedding receptions</p>
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	<p>[venues]; Arranging temporary housing accommodations; Banqueting services; Bar and restaurant services; Bar information services; Bar services; Bars; Beer bar services; Beer garden services; Bistro services; Boarding for animals; Boarding for horses; Boarding for pets; Boarding house bookings; Boarding house services; Boarding houses; Boarding kennel services; Booking agency services for holiday accommodation; Booking agency services for hotel accommodation; Booking of accommodation for travellers; Booking of campground accommodation; Booking of hotel accommodation; Booking of hotel rooms for travellers; Booking of restaurant seats; Booking of temporary accommodation; Booking of temporary accommodation via the Internet; Booking services for accommodation; Booking services for holiday accommodation; Booking services for hotels; Brasserie services; Buildings [Rental of transportable -]; Business catering services; Café services; Cafe services; Cafés; Cafeteria services; Cafeterias; Camp services (Holiday -) [lodging]; Campground facilities (Providing -); Canteen services; Canteens; Caravan park facilities (Provision of -); Carry-out restaurants;</p>
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	<p>Carvery restaurant services; Catering; Catering (Food and drink -); Catering for the provision of food and beverages; Catering for the provision of food and drink; Catering in fast-food cafeterias; Catering of food and drink; Catering of food and drinks; Catering services; Catering services for company cafeterias; Catering services for conference centers; Catering services for educational establishments; Catering services for hospitality suites; Catering services for hospitals; Catering services for nursing homes; Catering services for providing European-style cuisine; Catering services for providing Japanese cuisine; Catering services for providing Spanish cuisine; Catering services for retirement homes; Catering services for schools; Catering services for the provision of food; Catering services for the provision of food and drink; Catering services specialised in cutting ham by hand, for fairs, tastings and public events; Catering services specialised in cutting ham by hand, for weddings and private events.</p>
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13. Mr Robinson submits in his statement of grounds that the parties “sell two totally different products and are aimed at different markets” and “The Naked Deli is aimed at those who wish to partake in a healthier style of eating” whereas the Applicant’s

business is a “fine dining establishment” that serves alcohol and includes entertainment.

14. As the proceedings commenced by way of Fast Track neither party filed evidence regarding use of the respective marks and even if that were the case, the assessment of the likelihood of confusion considers all the circumstances in which the mark applied for might be used within the scope of its classification.² Notional and fair use of the earlier mark extends its protection to all of the goods/services covered by the registered specification.³

15. The Applicant seeks registration for “*Restaurant and Bar Services*” in class 43. Although I note that the Opponent relies on other services, its specification includes “*bar and restaurant services*”. The services are therefore identical.

Average Consumer and the Purchasing Process

16. When considering the opposing trade marks, I must bear in mind that the level of attention is likely to vary according to the category of goods and services in question.⁴

17. 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

² *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

³ *Compass Publishing* [2004] RPC 41 at [22] affirmed in *Roger Maier* [2015] EWCA Civ 220 at [78]

⁴ *Lloyd Schuhfabrik Meyer*, C-342/97

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. Neither party has made submissions regarding the average consumer or the purchasing process. I consider the average consumer of the services at issue, to be members of the general public. The purchasing process will be primarily visual with customers selecting the services following the display of its name at the actual venue, via the internet or via advertising material. Aural considerations cannot be discounted, however, due to word-of-mouth recommendations.

19. The level of attention in the purchasing process will depend on the type of food and drink on offer. Consumers, however, are increasingly more alert to the selection of restaurant and bar services as it will involve a discussion regarding which eating establishment to frequent, the nature of the food, and the type of occasion - be it a celebratory or a casual eating experience. Overall, I consider that the selection process will involve a medium degree of attention.⁵

Comparison of the marks

20. 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

⁵ On this issue, see paras 10-16 *Monster Energy Company v Chris Dominey and Christopher Lapham* BL O/061/19

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.”

21. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to consider 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.

22. The Opponent argues that “the logos are different with no similar characteristics except the word Naked” and that the respective marks “are very distinguishable therefore there will be no chance of misidentification during marketing and advertising.”

23. The respective trade marks are shown below:

Applicant's mark	Opponent's Mark
	

24. The Opponent's mark consists of the words THE NAKED DELI presented in a conventional black font, in capitals, together with a figurative element of a bearded man's head. Two lines frame the words, but they do not play a significant role within the mark as a whole. The words THE NAKED DELI form a phrase albeit with an unclear meaning. The word NAKED however within this phrase is the most distinctive element; the words "The" and "Deli" contributing, but less so. The overall impression of the Opponent's mark lies in the words and the figurative device which play roughly an equal role.

25. The Applicant's mark consists of the word NAKED in white, emboldened, capital letters presented on a red rectangular background. The words "RESTAURANT & BAR" are presented underneath the word NAKED, also in white, in considerably smaller font. Given their relative size, positioning and descriptive nature, the words "RESTAURANT & BAR" have little or no impact in the overall impression. The red rectangular box's role is limited as it merely acts as a background upon which the other components are presented. It is the word NAKED which is the dominant element and which makes the greatest contribution to the overall impression of the mark.

Visual comparison

26. The only point of visual comparison between the competing marks is the word NAKED. Both marks consist of this word in combination with other elements. I do not place any great reliance on the colour red used in the Applicant's mark, as a determining factor to distinguish between the respective marks, bearing in mind that notional use of the earlier mark also covers use in any colour.⁶ Balancing the visual similarities and differences, I consider that, overall, the degree of visual similarity

⁶ *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2014] C-252/12

between the two marks is between low and medium with the shared presence of the word NAKED.

Aural Comparison

27. The aural similarities lie in the word NAKED which will be articulated in an identical way in both marks. The remaining verbal elements will be given their ordinary English pronunciation. Due to the size and positioning of the words RESTAURANT & BAR, these may be omitted when articulating the Applicant's mark and therefore if this is the case it will be pronounced as NAKED. The verbal elements of the Opponent's mark will be pronounced as THE NAKED DELI, since no pronunciation will be afforded to the figurative element. If all elements are articulated in both marks they will be aurally similar to a low degree. If only the NAKED element is articulated in the Applicant's mark they will share a medium degree of aural similarity.

Conceptual Comparison

28. Neither party has made submissions or filed evidence regarding the conceptual message of their respective marks. Both marks include the word NAKED which is a dictionary word meaning bare or unclothed. When NAKED is used in relation to the provision of food and drink, it is somewhat allusive of simple, stripped back food, which will apply equally to both marks. The words restaurant, bar and deli are descriptive of the nature of the undertaking providing the services; deli being an abbreviation for delicatessen. The addition of the definitive article "The" in the earlier mark has little distinctive conceptual significance, whilst the presence of the figure will be perceived as a bearded man. Overall, taking into account my findings, I consider that the marks share a reasonably high degree of conceptual similarity.

Distinctive character of the earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, 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).”

30. Registered trade-marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer, others being highly inherently distinctive, such as invented words.

31. The Opponent has not filed any evidence as this is a Fast Track opposition and therefore I am only able to consider the position based on inherent characteristics.

32. The earlier mark comprises of a number of elements. The relevant public is likely to attribute the ordinary dictionary meaning to the word NAKED, namely bare or unclothed. When considered in the context of the relevant services it does have some allusive quality to simple, stripped back food. The mark also includes the words “THE” and “DELI”; the former being the definitive article of little distinctiveness; the latter being purely descriptive of the nature of the establishment providing the services. The device has no apparent link to the services but it is a stylised cartoon picture of a person which contributes to the distinctiveness of the mark. It is the combination of the device and the words as a whole, which gives the mark its distinctive character, but which I place at no higher than a medium level.

Likelihood of Confusion

33. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or related source.

34. 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 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 recognised 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, I conclude that it is another brand of the owner of the earlier mark."

35. A number of factors must also be borne in mind when undertaking the assessment of confusion. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison. In doing so, I must consider 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 that he has retained in his mind.

36. I remind myself that I have found the marks are visually similar to between a low and medium degree. Their aural similarity will either be low if all the verbal elements are articulated or medium if not. I will proceed with my assessment based on the lower degree of aural similarity as this is the most favourable to the Applicant. I have found the marks share a reasonably high degree of conceptual similarity. Overall, I have found the earlier mark as a whole to possess a medium degree of inherent distinctiveness. I have identified the average consumer to be a member of the general public, selecting the services primarily through visual means but with aural considerations not being discounted. I have found that the level of attention paid by the average consumer is medium.

37. In terms of direct confusion, I do not consider it likely that the average consumer will mistake one mark for the other even in relation to identical services. There are sufficient differences between the visual characteristics of the marks to ensure that the average consumer will easily distinguish between them, especially since the services are chosen primarily through visual means.

38. However, I must also consider the possibility of indirect confusion and whether the relevant public believes that there is an economic connection between them or that they are variant marks from the same undertaking as a result of the shared common element NAKED. Whilst a shared common element alone does not necessarily lead to a likelihood of confusion⁷ it is important for me to note the aspects of the other elements within the respective marks and the part they play. I bear in mind not only the level of distinctiveness of the earlier mark as a whole but also the distinctiveness of the common element.

39. 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 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

⁷ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

40. Both marks include additional elements which are descriptive of the type of establishment offering the services; “restaurant and bar” as opposed to “deli”. I acknowledge that the word NAKED in both marks is somewhat allusive, but it is still a distinctive element of the earlier mark and the most distinctive component of the application. Bearing in mind my assessment of the overall impression and the role each element plays in the overall impression, when coming across the respective marks, I find that the average consumer will consider that the same provider has expanded its business. It is a natural extension of a restaurant business to expand into an associated deli business and vice versa and therefore the marks will be seen as variants used by the same undertaking. On this basis, as the respective services are identical, I consider that consumers will conclude that they are provided by the same or economically linked undertaking leading to a likelihood of indirect confusion. It follows that confusion is even more likely where the degree of aural similarity between the marks is medium.

Outcome

41. The opposition under section 5(2)(b) of the Act succeeds in full. Subject to any successful appeal the application is refused for its services in class 43.

Costs

42. As the Opponent has been successful it is entitled to an award of costs. For Fast Track opposition proceedings costs are capped at £500 according to TPN 2/2015. Therefore, I award costs on the following basis:

Preparing a notice of opposition and considering the defence and counterstatement	£200
Official fee	£100
Total	£300

43. I order MARK LAWRENCE ROBINSON to pay THE NAKED DELI LTD the sum of £300. The sum 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 6 September 2019

Leisa Davies

For the Registrar