

O-562-19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3308271

BY MANNOR LTD

TO REGISTER THE FOLLOWING TRADE MARK:

Royal Caspian

IN CLASS 30

AND

OPPOSITION THERETO UNDER NO. 414173

BY CASPIAN HOLDING FRANCHISE LIMITED

BACKGROUND AND PLEADINGS

1. On 2 May 2018, Mannor Ltd (“the applicant”) filed trade mark application number UK00003308271 for the mark **Royal Caspian**. The application was accepted and published for opposition purposes on 3 August 2018, in respect of goods in class 30.¹

2. Caspian Holding Franchise Limited (“the opponent”) opposes the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon United Kingdom trade mark (“UKTM”) no. UK00002561419, the pertinent details of which are as follows:

Representation: CASPIAN

Filing date: 14 October 2010

Registration date: 13 May 2011

Goods:

Class 30 Flour and preparations made from flour, cereals; bread, pastry, confectionery, sauces, namely mint sauce, tomato sauce, garlic sauce, barbecue sauce, chilli sauce, spices and seasonings; rolls, biscuits, breads, cakes, rice; pizza consisting predominantly of meats, cheese and/or vegetables ; pizza crusts; pizza dough; pasta; prepared pasta meals consisting predominantly of meats, cheese and/or vegetables; pies consisting predominantly of meats; sandwiches consisting predominantly of meats or cheese; desserts; coffee, tea.

Class 32 Non-alcoholic beverages

3. The opponent’s UKTM qualifies, under section 6 of the Act, as an earlier trade mark for the purpose of these proceedings. Given its registration date, it is subject to the proof of use provisions contained in section 6A of the Act. To this extent, the opponent made a statement of use corresponding to the goods on which it relies (those listed at paragraph 2 of this decision).

¹ I will list these goods when I come to the goods comparison

4. The opponent's case under section 5(2)(b) is that the applied-for mark is visually, phonetically and conceptually similar to its earlier mark and is seeking registration for similar goods, resulting in a likelihood of confusion.

5. The applicant filed a counterstatement in which it denies a likelihood of confusion on the basis that there is no similarity between the goods or the marks at issue. The applicant requested the opponent provide proof of use of its UKTM for the goods upon which it relies.

6. Only the opponent filed evidence. Neither party requested a hearing. Only the opponent filed written submissions in lieu of a hearing. The opponent is represented by National Business Register LLP. The applicant represents itself.

EVIDENCE

7. The opponent's evidence consists of a witness statement and six exhibits from Mitchell Willmott of National Business Register LLP, representing the opponent.

Witness statement

8. Mr Willmott's witness statement is dated 18 March 2019, the salient points from which are as follows:

- i. The opponent first began trading as CASPIAN PIZZA in the United Kingdom in 1999;
- ii. The opponent operates 23 restaurants across the United Kingdom, in Coventry, Birmingham, Solihull, Leicester, West Midlands and Burton-on-Trent.

9. Mr Willmott's witness statement goes on to describe what is contained within each exhibit.

Exhibits

10. Exhibit MW1 contains a printout from the opponent's website (www.caspianpizza.com) showing there are restaurants named 'CASPIAN PIZZA' in 23 different locations across the UK. The date on this exhibit is 13 March 2019, presumably the date on which the pages were printed from the website.

11. Exhibit MW1a contains a printout from www.who.is.com confirming the domain name caspianpizza.com was registered on 23 January 2004 to Caspian Pizza Ltd. There is nothing in the witness statement or the exhibits to explain whether this company is the predecessor of the present opponent, or is somehow linked economically.

12. Exhibit MW2 contains three invoices relating to the purchase of pizza boxes, by Caspian Pizza (UK) Ltd. The witness statement explains that the opponent purchases pizza boxes (branded with 'CASPIAN PIZZA') from TREBOX s.n.c. and uses the boxes to sell its pizzas. The invoices are dated 25 March 2016, 19 July 2016 and 3 October 2016. The invoices are mainly in Italian, therefore, I am unable to translate their contents. However, I can see a cost of £12,605.36 on the invoice dated 25 March 2016 and a cost of £14,119.22 on the invoice dated 19 July 2016: no cost is visible on the 3 October 2016 invoice. On all three invoices, the product description includes "P.BOX [...] caspian". "CASPIAN PIZZA (UK) LTD" is visible in the top right-hand corner of all three invoices.

13. Exhibit MW3 contains four invoices relating to the purchase of foodstuffs from Qualitops (UK) Ltd by Caspian Pizza UK Limited. The witness statement explains that the food products are CASPIAN branded and sold by the opponent. The invoices are dated 4 August 2016, 30 September 2016, 18 April 2017 and 5 June 2017 and total £11,071.20. The description of the goods begins "Caspian [...]" and the list of food products includes: turkey ham; beef meatball; plain chicken; BBQ chicken; pepperoni; Chinese chicken; pizza meatballs; and beef spicy.

14. Exhibit MW4 contains a letter dated 6 March 2019 from Ranjit Khamba, Supply Chain Manager of Panesar Foods Ltd. The letter confirms that Panesar Foods Ltd

have been trading with Caspian Pizza (UK) Limited since 19 September 2012 and that the company regularly manufactures Caspian branded pizza sauce, “which is primarily used on their [pizzas]”.

15. Exhibit MW5 contains one invoice, dated 23 May 2017, relating to the purchase of pizza sauce from Panesar Foods by Caspian Pizza, totalling £8,419.00. The product details describe the goods as “pizza sauce”.

16. That concludes my summary of the opponent’s evidence, insofar as I consider it relevant.

DECISION

Proof of use

17. The first issue is whether, or to what extent, the opponent has shown genuine use of its earlier mark. The relevant statutory provisions are as follows:

“6A Raising of relevant grounds in opposition proceedings in case of non-use

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark 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 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 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 European Union 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 Union.

(6) Where an earlier trade mark satisfies the use condition 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.”

18. 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.”

19. The relevant period in the current case, in which the opponent must prove use of its mark (no claim for proper reasons for non-use having been made), in accordance with section 6A of the Act, is 4 August 2013 to 3 August 2018.

20. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. In *Walton International Ltd & Anot v Verweij Fashion BV*,² Arnold J. summarised the case law on genuine use of trade marks:

“114. The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Behher BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 *P Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

² [2018] EWCH 1608 (Ch) (28 June 2018)

(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; Leno at [29]-[30], [56]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34].

(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] and [76]-[77]; 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].”

21. Before assessing the opponent’s evidence of use, I remind myself of the comments of Mr Daniel Alexander QC, sitting as the Appointed Person, in *Awareness Limited v Plymouth City Council*,³ where he 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

³ Case BL O/230/13

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.”

22. I also note Mr Alexander’s comments in *Guccio Gucci SPA v Gerry Weber International AG*.⁴ Although the case concerned revocation proceedings, the principle is the same for proof of use in opposition actions. He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round – or lose it”.

23. The comments of Mr Geoffrey Hobbs QC in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*,⁵ where he sat as the Appointed Person, are also relevant. He 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

⁴ O/424/14

⁵ Case BL O/404/13

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."

24. The difficulty for the opponent is that no evidence has been filed to show any sales of the goods for which it has claimed use, either under the CASPIAN mark, or at all. Nor have turnover figures been provided as evidence of sales. I will refer to each exhibit, in turn, to explain its use (if any) for showing genuine use of the earlier mark.

25. The website printout at exhibit MW1 simply shows that there are 23 restaurants (on the date the pages were printed) named CASPIAN PIZZA. This is not evidence of the mark in use on the goods relied upon by the opponent. In any case, the pages are dated more than seven months after the end of the relevant period. As such, this evidence does not assist the opponent in proving use of its mark during the relevant period.

26. Ownership of a domain name is not equivalent to use of a trade mark. As such, exhibit MW1a does not assist the opponent in proving use of its mark.

27. The invoices at exhibit MW2 are somewhat helpful in that they show repeat orders for large sums of money within the relevant period, suggesting the pizza boxes are being used. However, no evidence of such use has been provided. The purchase of pizza boxes is not evidence of pizzas (or any goods relied upon by the opponent) being sold to consumers under the CASPIAN mark, and I cannot presume the same. Even if I were to come to that conclusion, there are no images of the pizza boxes for me to be satisfied that they do in fact display the earlier mark, either as registered or in a satisfactory variant manner.

28. The invoices at exhibit MW3 show that the opponent has purchased the goods identified, but not that it has then sold them under the CASPIAN mark. In any case, the earlier mark is not registered for any of the goods listed on the invoices, so this does not assist the opponent. Nor does the witness statement explain how these goods are used once purchased, or whether they are simply branded with the CASPIAN mark and sold in the form in which they were purchased.

29. In relation to exhibit MW4, since the opponent has solicited the letter from Panesar Foods for the purpose of these proceedings, rather than getting the third party to file evidence by witness statement, affidavit or statutory declaration, it will be treated as hearsay evidence. In accordance with section 4 of the Civil Evidence Act 1995, I give very little weight to this evidence.

30. Similarly to exhibit MW3, the invoices at exhibit MW5 show that pizza sauce has been purchased within the relevant period but not that the opponent has sold pizza sauce, either under the CASPIAN mark, or at all, or used it in any way.

31. Overall, the exhibits do not build a picture of goods that are available to the public, not just because the evidence is minimal, but because a business that has been trading, according to the witness statement, from 1999 to the present date should quite easily be able to demonstrate that it has sold the goods for which its mark is registered, under that mark, and it has not done so. The evidence filed is insufficiently solid to

show that there has been genuine use of the mark on or in relation to the goods upon which the opponent relies. In addition, the majority of the exhibits make reference to “Caspian Pizza Ltd” or “Caspian Pizza (UK) Ltd”. Section 6A(3)(a) of the Act provides that use of the mark must be “by the proprietor or with his consent”. The opponent in this case is Caspian Holding Franchise Limited. There is no explanation as to the relationship between Caspian Pizza Ltd or Caspian Pizza (UK) Ltd and the opponent.

32. The opponent has failed to establish genuine use of its earlier mark within the relevant period. The opposition fails at the first hurdle. However, in case I am wrong in my finding in relation to genuine use, I go on to consider the opponent’s case under section 5(2)(b).

33. I maintain that exhibit MW2 is not sufficient to constitute genuine use of the earlier mark, however, solely because of the quantity of pizza boxes bought, if I were satisfied that the mark had in fact been used, it would be in relation to the term “pizza consisting predominantly of meats, cheese and/or vegetables” in the opponent’s specification. I will proceed on the basis that the opponent would be able to rely on this specification only for these proceedings.

Section 5(2)(b)

34. Section 5(2)(b) of the Act states that:

“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.”

Relevant law

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

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

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

Comparison of goods

36. The competing goods are shown in the table below:

Earlier mark (following proof of use)	Applied-for mark
Class 30: Pizza consisting predominantly of meats, cheese and/or vegetables.	Class 30: Acanthopanax tea (Ogapicha); Achar pachranga (fruit pickle); Acid drops [confectionery]; Adlay flour for food; Aerated beverages [with coffee, cocoa or chocolate base]; Aerated

	chocolate; Aerated drinks [with coffee, cocoa or chocolate base]; Agave syrup for use as a natural sweetener; Agave syrup [natural sweetener]; Aioli; Alimentary pasta; Alimentary paste [dough]; Alimentary seasonings; Allspice; Almond cake; Almond confectionery; Almond flavorings, other than essential oils; Almond paste; Almond pastries; Almonds covered in chocolate; Angelica; Aniseed; Aniseeds for use as a seasoning; Aperitif biscuits; Apple flavoured tea [other than for medicinal use]; Apple fritters; Apple pies; Apple sauce [condiment]; Apple tarts; Aromatic preparations for cakes; Aromatic preparations for candies; Aromatic preparations for food; Aromatic preparations for ice-creams; Aromatic preparations for making non-medicated infusions; Aromatic preparations for making non-medicated tisanes; Aromatic preparations for pastries; Aromatic teas [other than for medicinal use]; Artichoke sauce; Artificial coffee; Artificial coffee; Artificial coffee and tea; Artificial rice [uncooked]; Artificial tea; Artificial tea [other than for medicinal use]; Asian apricot tea (maesilcha); Asian noodles; Bacon buns; Bagels; Baguettes; Bakery goods; Baking powder; Baking powders; Baking soda; Baking soda [bicarbonate of soda for baking purposes]; Baking
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	<p>soda [bicarbonate of soda for cooking purposes]; Baking spices; Baking-powder; Banana fritters; Baozi [stuffed buns]; Baps; Barbecue sauce; Barley (Crushed -); Barley flakes; Barley flour [for food]; Barley flour for food; Barley for use as a coffee substitute; Barley (Husked -); Barley meal; Barley prepared for human consumption; Barley tea; Barley-leaf tea; Barm cakes; Bars based on wheat; Bars of sweet jellied bean paste (Yohkan); Bases for making milk shakes [flavourings]; Basil, dried; Batter for making crepes; Batter for making pancakes; Batter mixes; Batter mixes for Japanese-style pancakes (Okonomiyaki); Batter mixes for okonomiyaki [Japanese savory pancakes]; Batter mixes for okonomiyaki [Japanese savoury pancakes]; Bavarian creams; Bean jam buns; Bean meal; Bean paste ;Bean-jam filled wafers (monaka); Bean-starch noodles (harusame, uncooked); Bee glue; Beer vinegar; Beverages based on chocolate; Beverages based on coffee; Beverages based on coffee substitutes; Beverages based on tea; Beverages (Chocolate-based -); Beverages (Cocoa-based -); Beverages (Coffee-based -); Beverages consisting principally of chocolate; Beverages consisting principally of</p>
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	cocoa; Beverages consisting principally of coffee.
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37. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*,⁶ 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”.

38. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case⁷ for assessing similarity were:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) 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,

⁶ Case C-39/97

⁷ [1996] R.P.C. 281

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

39. The applicant makes no submissions regarding the goods at issue, other than they are “not similar at all”. The opponent submits the following:

“The goods of the [...] contested application and those covered by the Opponents earlier trade mark are everyday foodstuffs which are commonly used by the relevant consumer.”

40. I see no obvious similarity between the majority of the applied-for goods and the opponent’s goods, save for “bagels; baguettes; bakery goods”. In the absence of any submissions from the parties (in particular, from the opponent), I find the remainder of the applied-for goods dissimilar to the opponent’s goods. I go on now to compare the applicant’s “bagels; baguettes; bakery goods” (I group these goods together for the purpose of assessment in accordance with *Separode Trade Mark*⁸) to the opponent’s “pizza consisting predominantly of meats, cheese and/or vegetables”.

41. Whilst the nature (bread-based foods) and purpose (nourishment) of the goods at issue are similar, and they are consumed in the same way, this is very general similarity that would overlap for the majority of food goods. This does not automatically result in overall similarity between the goods, which are unlikely to share trade channels and are usually found in different locations in physical stores and under different categories online: pizzas are either refrigerated or frozen and usually classed as ready meals; bagels, baguettes and bakery goods are ambient (shelf food) goods that will be categorised as such. However, I bear in mind that baguettes and bagels might include filled baguettes and bagels that will be refrigerated. Consumers are unlikely to choose between the goods, so there is little or no competition, nor are they indispensable for one another to the effect that consumers would think they come from the same or a linked undertaking, so there is no complementarity. If there is any similarity, it is very low.

⁸ BL O/399/10 (AP)

The average consumer and the nature of the purchasing act

42. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.⁹

43. 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*,¹⁰ 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.”

44. The average consumer of the goods at issue (those for which I have found similarity) will be a member of the general public. The goods are relatively inexpensive and are purchased frequently. Overall, no more than a medium degree of care and consideration will be adopted during the purchasing process. The purchase of the goods is likely to be predominantly visual; they will be self-selected from physical stores or websites. However, I do not discount an aural element to the purchase.

Comparison of marks

45. It is clear from *Sabel* 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

⁹ Case C-342/97

¹⁰ [2014] EWHC 439 (Ch)

assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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.”

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

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

Earlier mark	Applied-for mark
CASPIAN	Royal Caspian

48. The parties have made submissions on the similarities and differences of the marks. I have considered them all in reaching my decision and will refer below to some of the arguments raised (although I do not propose to reproduce the submissions in full).

Overall impression

49. The earlier mark consists solely of the word CASPIAN, with no stylisation or figurative elements. The overall impression of the mark rests in the word itself.

50. The applied-for mark consists of the two words Royal Caspian, with no stylisation or figurative elements. Again, the overall impression of the mark rests in the words themselves, with neither word materially dominating the other.

Visual comparison

51. Aside from the upper case versus lower case (which does not create a difference since, notionally, the marks could be used in either), the earlier mark is reproduced identically in the second word of the applied-for mark: CASPIAN. In terms of differences, the applied-for mark contains the additional word “Royal”, in front of “Caspian”. There is no counterpart in the earlier mark. Overall, I find a medium degree of visual similarity between the marks.

Aural comparison

52. Both marks will be articulated in their entirety: the earlier mark as the three-syllable “CAS-PEE-UN” and the applied-for mark as the five-syllable “ROY-UL-CAS-PEE-UN”. Overall, I find a medium degree of aural similarity between the marks.

Conceptual comparison

53. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM*.¹¹ The assessment must be made from the point of view of the average consumer.

¹¹ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

54. Neither party has made submissions regarding the concept of their respective marks.

55. "CASPIAN" is a proper noun that identifies the Caspian Sea.¹² It seems to me unlikely that the average consumer would associate the word used in this context with the goods of either party. It is more likely that consumers will ascribe no direct meaning to the word. They will assume that it has been invented.

56. Looking at the applied-for mark, the addition of the word "ROYAL" does not alter the lack of immediate concept since the two words "ROYAL CASPIAN", used together, have no clear meaning. The marks are, therefore, conceptually neutral.

Distinctive character of the earlier mark

57. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer* 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

¹² www.collinsdictionary.com

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).”

58. It is clear from my previous comments regarding the evidence that the mark cannot benefit from an enhanced distinctive character through use. Accordingly, I have only the inherent distinctiveness of the earlier mark to consider.

59. I have already noted that it is most likely consumers will think that “CASPIAN” is an invented word. Invented words generally have a higher than average level of inherent distinctiveness, and I find that to be the case here. However, even if there are consumers who relate “CASPIAN” to the name of the Sea, my finding remains unchanged since it has no meaning in relation to the goods at issue.

Likelihood of confusion

60. The factors assessed so far have a degree of interdependency (*Canon*); a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel*). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

61. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods and services down to the responsible undertaking being the same or related).

62. The marks have been found to be visually similar to a medium degree, aurally similar to a medium degree and conceptually neutral. The parties’ goods have been found to be similar to only a very low degree.

63. Due to the clear visual and aural differences between the marks at issue (the word “ROYAL” being no less dominant in the applied-for mark than the word “CASPIAN” and having no counterpart in the earlier mark), I am satisfied that direct confusion will not occur. The average consumer will not mistake one mark for the other.

64. In relation to indirect confusion, the lack of similarity at any meaningful level of the goods, coupled with the differences in the marks, and bearing in mind the interdependency principle, satisfies me that the average consumer would not assume that the goods were provided by the same or a related undertaking. I do not consider indirect confusion to be likely.

CONCLUSION

65. The opponent failed to prove use of its earlier mark and the opposition failed at the first hurdle. My fall-back finding under section 5(2)(b) is that there is no likelihood of confusion. The opposition has failed, and the applicant’s mark may continue to registration.

COSTS

66. As the applicant has been successful, it would, ordinarily, be entitled to an award of costs in its favour. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs and, if so, to complete a pro-forma indicating a breakdown of its actual costs. Since the applicant did not respond to that invitation within the timescale allowed (nor has any response been received from the applicant prior to the date of the issuing of this decision), I make no cost award.

24 September 2019

Emily Venables
For the Registrar,
The Comptroller-General