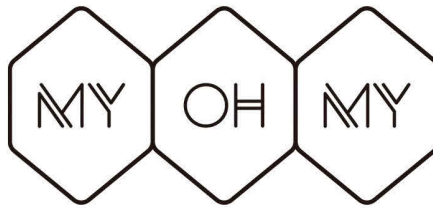


BL O-210-20

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3364532
BY GLOBAL HOTELS & RESORTS GROUP LTD**

TO REGISTER:



AS A TRADE MARK IN CLASS 43

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 416693
BY LEAF TEA HOLDINGS LTD**

BACKGROUND & PLEADINGS

1. On 3 January 2019, Global Hotels & Resorts Group Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the services in class 43 shown in paragraph 9 below. The application was published for opposition purposes on 22 March 2019.

2. On 21 June 2019, the application was opposed in full by Leaf Tea Holdings Limited (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). In its Notice of opposition, the opponent indicates that it relies upon the services in class 43 (shown in paragraph 9 below) in the following United Kingdom trade mark registration:

No. 3033640 for the trade mark shown below, which was applied for on 5 December 2013 and entered in the register on 25 July 2014:

OH ME OH MY

3. In its Notice of opposition, the opponent stated:

“The opposed mark comprises of three two letter elements: 'MY OH MY'. The mark of the Opponent comprises of four two letter elements: 'OH ME OH MY'. The look and feel of both marks is similar, with the last two elements being identical in both words and position. Furthermore, the elements 'MY' and 'ME' which are positioned identically, constitute the same pronoun, such that the only substantial difference between the marks is the omission of the “OH” at the beginning of the opponent’s (sic) mark. Clearly, the class 43 services offered under each mark are identical.”

4. The applicant filed a counterstatement in which the basis of the opposition is denied.

5. In these proceedings, the opponent is represented by Equipped (4) IP Limited and the applicant by Taylor Wessing LLP. No evidence has been filed. While neither party requested a hearing, both elected to file written submissions in lieu of attendance. I shall keep these written submissions in mind, referring to them to the extent I consider it necessary.

DECISION

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

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

(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.”

7. The trade mark being relied upon by the opponent qualifies as an earlier trade mark under the provisions of section 6 of the Act. 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. As a consequence, the opponent can rely upon all the services claimed without having to demonstrate that its trade mark has been used in relation to such services.

Case law

8. 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.

Comparison of services

9. The competing services are as follows:

Opponent's services	Applicant's services
Class 43 - Services for providing food and drink; restaurant, bar and catering services.	Class 43 - Restaurant, bar and catering services, cafes, cafeterias and snack bars; food bars; drinks bars; cocktail lounges; provision of food and drink; information, consultancy and advisory services relating to the aforesaid

10. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

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

- (a) The respective 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 whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

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

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

13. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

14. The phrase “restaurant, bar and catering services” in the application also appears in the opponent’s specification and is literally identical. In addition, as the phrase “provision of food and drink” in the application is simply an alternative way of describing the opponent’s “services for providing food and drink” they too are identical. As the applicant’s: “cafes, cafeterias and snack bars”, “food bars”, “drinks bars” and “cocktail lounges” are all encompassed by the phrase “services for providing food and drink” in the opponent’s specification, such services are to be regarded as identical on the inclusion principle outlined in *Merici*. If not encompassed by the broad terms in the opponent’s specification, given the obvious similarity in the users, intended purpose and complementary nature, the applicant’s “information, consultancy and advisory services relating to the aforesaid” are similar to the opponent’s services to a high degree.

The average consumer and the nature of the purchasing act

15. As the case law above indicates, it is necessary for me to determine who the average consumer is for 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.”

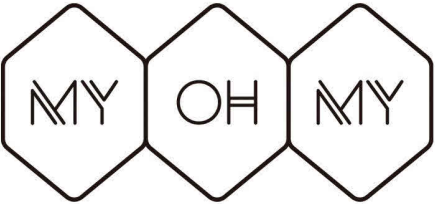
16. The average consumer of the services at issue is a member of the general public. My own experience as an average consumer (which I do not regard as atypical), informs me that such services are most likely to be selected having considered, for example, promotional material and reviews (in hard copy and on-line) and on signage appearing on the high street; as a consequence, visual considerations will be an important part of and are likely to dominate 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

17. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

Opponent's trade mark	Applicant's trade mark
OH ME OH MY	

19. The opponent's trade mark consists of the four words shown above presented in upper case in a very slightly stylised typeface. The words form a unit which creates a

phrase with which I am satisfied the average consumer will be very familiar. It is in that unit the overall impression and distinctiveness lie. The applicant's trade mark consists of three linked hexagonal devices and the words "MY", "OH" and "MY" presented in a stylised font. Although the devices and stylisation will contribute to the overall impression the applicant's trade mark conveys and its distinctiveness, it is the words which, despite their stylisation, will be understood by the average consumer as creating the unit "MY OH MY", that will have the highest relative weight in the overall impression conveyed and will make by far the greatest contribution to the trade mark's distinctive character. I will bear those conclusions in mind in approaching the comparison which follows.

Visual similarity

20. The opponent's trade mark consists of four words and eight letters, whereas the applicant's trade mark consists of three words and six letters. The opponent's trade mark begins with the word/letters "OH" whereas the applicant's trade mark begins with the word/letters "MY". The second words/letters in the competing trade marks differ i.e. "ME"/"OH". The last two words/four letters are identical i.e. "OH-MY". In addition to the stylised manner in which the letters in the applicant's trade mark are presented, it also contains the three hexagonal devices. Although the devices and stylisation in the applicant's trade mark are points of difference, the fact that the word components of the competing trade marks begin "OH ME" and "MY OH", together with the fact that the last two words are identical i.e. "OH MY", results in what I consider to be a fairly high degree of visual similarity between them.

Aural similarity

21. It is well established that when a trade mark consists of a combination of words and figurative components, it is by the word components that the trade mark is most likely to be referred to. That is the case here. As all of the words in the respective trade marks will be known to the average consumer, the manner in which they will be articulated is predictable i.e. the applicant's trade mark as the three-syllable combination "MY-O-MY" and the opponent's trade mark as the four-syllable

combination “O-ME-O-MY.” The competing trade marks have a similar rhythm and are aurally similar to a fairly high degree.

Conceptual similarity

22. As I mentioned above, the word components in both trade marks create a unit forming a phrase with which, I am satisfied, the average consumer will be very familiar i.e. either may be used if one wishes to express surprise or pleasure. As neither the devices nor stylisation present in the applicant’s trade mark do anything to modify the meaning the applicant’s trade mark conveys, the competing trade marks are, if not conceptually identical, conceptually similar to a high degree.

Distinctive character of the earlier trade mark

23. 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.

24. As the opponent has filed no evidence of any use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. Although consisting of a well-known phrase, there is nothing to suggest it is either descriptive of or non-distinctive for the services upon which the opponent relies. Absent use, it enjoys a medium degree of inherent distinctive character.

Likelihood of confusion

25. 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.

26. 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.

27. Earlier in this decision I concluded that:

- the competing services are either identical or similar to a high degree;
- the average consumer is a member of the general public who will select such services using a combination of visual and aural means whilst paying varying degrees of attention during that process;
- the competing trade marks are visually and aurally similar to a fairly high degree and conceptually similar to at least a high degree;
- the opponent's earlier trade mark is possessed of a medium degree of inherent distinctive character.

28. I shall consider the matter from the position most favourable to the applicant i.e. that the average consumer will pay a high degree of attention during the purchasing process, thus making him/her less prone to the effects of imperfect recollection. However, even proceeding on that basis, the degree of similarity and identity in the competing services combined with the fairly high degree of visual and aural similarity and the at least high degree of conceptual similarity, results in a likelihood of direct confusion. That conclusion is even more pronounced should the average consumer pay a less than high degree of attention when selecting the services at issue.

Overall conclusion

29. Subject to any successful appeal, the application will be refused in relation to all of the services for which registration has been sought.

Costs

30. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the above guidance and making no award to the opponent in respect of its written submissions which added nothing, I award costs to the opponent on the following basis:

Filing the Notice of opposition and reviewing the counterstatement:	£200
Official fee:	£100
Total:	£300

31. I order Global Hotels & Resorts Group Ltd to pay to Leaf Tea Holdings Limited the sum of **£300**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of April 2020

C J BOWEN

For the Registrar