

O/226/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003368409 BY  
AMEER SAAIL KHAN  
TO REGISTER THE FOLLOWING TRADE MARK:



AS A TRADE MARK IN CLASS 43

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 416714 BY  
ZAFAR IQBAL

## BACKGROUND AND PLEADINGS

1. On 20 January 2019, Ameer Saail Khan (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 22 March 2019 and registration is sought for the following services:

Class 43: Fast-food restaurant services.

2. On 24 June 2019, the application was opposed by Zafar Iqbal (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade marks:

HOWDY STEAK HOUSE

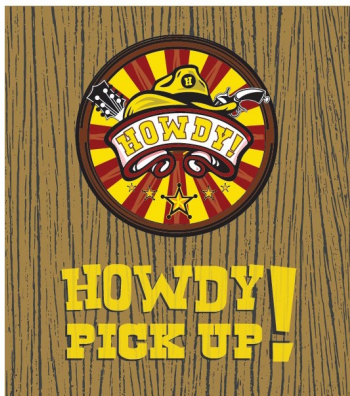
UK registration no. 3298498

Filing date 21 March 2018; registration date 3 August 2018

Relying on all services namely:

Class 43: Provision of food and drink; restaurant, café and bar services; catering services; sandwich and snack bar services; preparation and serving of food and beverages; information and advisory services to all the aforesaid services.

(“the first earlier mark”);



UK registration no. 3201093

Filing date 8 December 2016; registration date 14 April 2017

Relying on all services namely:

Class 43: Ice cream parlors; services for providing food and drink; takeaway services; information in relation to all the aforesaid services.

("the second earlier mark")

and;

HOWDY GELATO

UK registration no. 3165881

Filing date 22 May 2016; registration date 19 August 2016

Relying on all services namely:

Class 43: Ice cream parlors; services for providing food and drink; takeaway services; information in relation to all the aforesaid services.

("the third earlier mark")

3. The opponent submits that there is a likelihood of confusion on the part of the average consumer given that there is a high visual, aural and conceptual similarity between the applicant's mark and the first, second and third earlier marks (collectively referred to as "the earlier marks").
4. The applicant filed a counterstatement denying the claims made.
5. The opponent is represented by Bailey Walsh & Co LLP and the applicant is unrepresented. Neither party has filed evidence. No hearing was requested and both parties have filed written submissions in lieu of a hearing. I have taken the written submissions into consideration and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

## PRELIMINARY ISSUE

6. In his written submissions, the applicant makes reference to the proviso contained within section 3 of the Act and seeks to rely on the fact that the applied for mark has “acquired a distinctive character as a result of the use made of it before the date of application for registration.” The applicant refers to Annex B, which is a photograph of a certificate of registration of the applicant’s mark with the Pakistani Intellectual Property Organisation dated 6 November 2012. For reasons that I will now explain, the applicant’s point regarding the alleged previously acquired distinctive character as a result of the use of the applicant’s mark has no bearing on the outcome of this opposition.
7. The proviso referred to by the applicant applies where an objection under section 3(b), (c) or (d) of the Act is raised. That is, where an objection based upon one or more of these grounds is successfully raised, the objection may still be overcome if the applicant for registration can demonstrate that its mark has acquired enhanced distinctive character through use. As the opposition in this case is not based upon any of these grounds, this proviso is not relevant.
8. In any event, for the avoidance of doubt, the fact that the applicant claims to have used its mark prior to the opponent’s marks being applied for/registered, is not a defence in law to the opposition under section 5(2)(b) of the Act. Tribunal Practice Notice 4/2009 explains this as follows:

*“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark.*

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s

mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

9. Section 72 of the Act provides that registration shall be taken as prima facie evidence of the validity of a registered trade mark. The earlier marks must therefore be regarded as validly registered and, in these circumstances, the law requires priority to be determined according to the filing dates of the applications for registration. This means that, in these proceedings, the opponent's marks have priority given their earlier filing dates. The applicant has not sought to invalidate the earlier marks based on his claim to earlier use of his mark so these submissions from the applicant are not relevant to these proceedings.

10. In any event, the document referred to by the applicant (described as Annex B) simply shows that his mark has been registered in Pakistan. This does not, therefore, demonstrate use of the mark.

## **DECISION**

### **Section 5(2)(b): legislation and case law**

11. Section 5(2)(b) of the Act reads as follows:

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

(a) ...

(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 or association with the earlier trade mark.”

12. Section 5A of the Act states as follows:

“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.”

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

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

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

14. The earlier marks upon which the opponent relies qualify as earlier trade marks under the above provisions. As the opponent’s marks had not completed their registration process more than 5 years before the date of the application in issue, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the services for which the marks are registered.

15. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (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.*

- (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 services**

16. The second earlier mark's and the third earlier mark's specifications for services are identical (as set out in paragraph 2 above). The same comparison between the applicant's mark can therefore be applied for both the second earlier mark and the third earlier mark.

17. The competing services are as follows:

<b>The earlier marks' services</b>	<b>The applicant's services</b>
<u>Class 43</u> <i>The first earlier mark</i> Provision of food and drink; restaurant, café and bar services; catering services; sandwich and snack bar services;	<u>Class 43</u> Fast-food restaurant services.



<p>preparation and serving of food and beverages; information and advisory services to all the aforesaid services.</p> <p><i>The second and third earlier marks:</i> Ice cream parlors; services for providing food and drink; takeaway services; information in relation to all the aforesaid services.</p>	
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18. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. 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 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”.

19. 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.

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

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

*The first earlier mark and the applicant’s mark*

21. “Fast-food restaurant services” contained within the applicant’s specification are either self-evidently or *Merici* identical to “restaurant, café and bar services” contained within the first earlier mark’s specification.

*The second and third earlier marks and the applicant’s mark*

22. “Fast-food restaurant services” contained within the applicant’s specification are either self-evidently or *Merici* identical to “services for providing food and drink” contained within the second and third earlier marks’ specifications.

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

23. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then decide the manner in which these services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

24. The opponent submits that the average consumer of the services will be “an ordinary adult person who occasionally or frequently uses restaurants or fast food outlets.” I have no submissions from the applicant on this point. I consider that the average consumer for the services at issue will be a member of the general public.

25. Purchases of restaurant services can range significantly in price (from Michelin starred restaurants to fast food outlets) and frequency. However, even where the costs are fairly low and purchases relatively frequent, such as in the case of the applicant's fast food restaurants, a number of factors will still be taken into consideration (such as type of food or drink offered, dietary requirements and hygiene rating). I therefore consider that a medium degree of attention will be paid during the purchasing process.

26. The services are likely to be purchased following inspection of the premises' frontage, the website of the service provider or advertisements. Visual considerations are, therefore, likely to dominate the selection process. However, I

do not discount that there will also be an aural component to the purchase of the services, given that word-of-mouth recommendations may also play a part.

### **Comparison of trade marks**

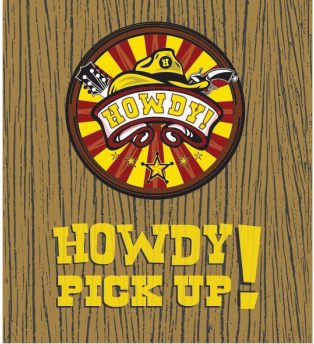

27. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed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

28. 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.”

29. 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 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.

30. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p data-bbox="316 309 676 398">HOWDY STEAK HOUSE (the first earlier mark)</p>  <p data-bbox="316 846 676 880">(the second earlier mark)</p> <p data-bbox="336 958 655 1048">HOWDY GELATO (the third earlier mark)</p>	

31. In its Notice of Opposition, the opponent stated the following in respect of the comparison between the applicant's mark and the earlier marks:

“the mark applied for contains the word HOWDY as the dominant element. The mark relied upon also contains the word HOWDY as the dominant element. Therefore there exists a high visual aural and conceptual similarity between the marks.”

32. In its counterstatement, the applicant stated that:

“the mark applied for and relied upon is a distinctive mark than the opponent's trade marks [...]. Therefore, there exists no visual, aural and conceptual similarity between the applicant's and the opponent's trade marks.”

33. In his written submissions, the applicant has stated that:

“The Applicant’s trade mark contains a single word descriptive element and a figurative element which makes up the composite trade mark. However, each of the opponent’s trade mark contains a descriptive element, which comprises of more than one word and each word is equally dominant as the one claimed by the opponent which makes it unlikely for the average consumer of the goods or services in question [...] not to see, read, hear and understand the trade mark as a whole, make a comparison and distinction from trade mark of other undertaking(s).”

### Overall Impression

#### *The applicant’s mark*

34. The applicant’s mark is a composite mark comprised of a device and a word element. The mark contains the word “HOWDY!” in a yellow, stylised font on a red background. The word has a black, dropped shadow which is visible on the red background. The device element of the mark is a cartoon cowboy. The cowboy is presented on a circular wheel element with alternative coloured sections of red and yellow. The eye is naturally drawn to the elements of the mark that can be read. However, given the device’s size and positioning at the start of the mark, the word HOWDY! and the cowboy device play a roughly equal role in the overall impression of the mark.

#### *The first earlier mark*

35. The first earlier mark is a word only mark consisting of the word HOWDY, followed by the words STEAK and HOUSE. The word HOWDY is an informal greeting that is neither descriptive nor allusive of the services offered under the mark. The words STEAK HOUSE will be considered together by the average consumer to be a type of restaurant service associated with serving steaks. I have taken the applicant’s submissions regarding the equal dominance of the words contained within the first earlier mark into account, however, given that STEAK HOUSE will be seen as descriptive of the type of service offered under the mark it will be attributed little trade mark significance by the average consumer. The word HOWDY plays a

greater role in the overall impression of the first earlier mark because the words STEAK HOUSE are descriptive of the services offered.

*The second earlier mark*

36. The second earlier mark is a composite mark made up of device and word elements. The mark contains a device element of a wheel made up of alternating yellow and red segments. Within the wheel device, is the word HOWDY! presented in a yellow, stylised font on a red and white scroll device, a black cowboy hat with the letter H displayed on the front of it, a black and white revolver pistol, a black and white guitar head and five yellow stars. All of these features combine to form one larger 'wheel' device element.

37. Below the wheel device are the words HOWDY PICK UP. The word HOWDY will be viewed as an informal greeting, that is neither descriptive nor allusive of the services in issue. The words PICK UP may be seen to be descriptive to the type of service offered, in that they may be take away services. The words all appear in a yellow stylised font. The word HOWDY is slightly larger and placed above the words PICK UP. To the right of the words HOWDY and UP sits the larger exclamation point that covers both lines of the word element of the mark.

38. All elements of the mark sit on a vertical rectangular brown and black background. The background is designed to look like the grain of cut wood. The word HOWDY and the wheel device play the greater role in the overall impression of the second earlier mark. I have taken the applicant's submissions regarding the equal dominance of the words contained within the first earlier mark into account, however, given that the words PICK UP are descriptive in nature they play a lesser role in the second earlier mark. The background also plays a lesser role due to its nature as a background to the other elements.

*The third earlier mark*

39. The third earlier mark is a word only mark consisting of the word HOWDY, followed by the word GELATO. The word HOWDY is an informal greeting that is neither

descriptive nor allusive of the services offered under the mark. Gelato is a type of Italian ice cream<sup>1</sup>. The word gelato is an Italian word that literally translates to 'frozen'<sup>2</sup>. I am of the view that it is likely that a significant proportion of average consumer in the UK will make the link between the word GELATO and frozen desserts and/or ice cream. I have taken the applicant's submissions regarding the equal dominance of the words contained within the first earlier mark into account, however, given that the word GELATO within the third earlier mark may be descriptive of the type of services offered under the mark, it will be attributed little trade mark significance by the average consumer. Therefore, the word HOWDY plays a greater role in the overall impression of the third earlier mark.

40. If I am wrong in my finding that a significant proportion of the average consumer would make a link between GELATO and frozen desserts and/or ice cream then it will be considered to be either a made-up word or a foreign language word, which conveys no particular meaning to the UK average consumer. I, therefore, find that the words HOWDY and GELATO play an equal role in the overall impression of the third earlier mark.

### Visual Comparison

#### *The first earlier mark and the applicant's mark*

41. Visually, the marks coincide in that they share the word HOWDY. However, in other respects the marks are different. The words STEAK and HOUSE, present in the first earlier mark, are absent in the applicant's mark. The cowboy device element, the exclamation mark and the stylisation of the word HOWDY! present in the applicant's mark, are absent in the first earlier mark. However, I note that the first earlier mark is a word only mark and can be used in any standard typeface and registration in black and white will cover the use of the mark in different colours. It is established case law that the beginnings of marks tend to have more impact than

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<sup>1</sup> <https://www.collinsdictionary.com/dictionary/english/gelato>

<sup>2</sup> Ibid.



the ends (see *El Corte Inglés, SA v OHIM* Cases T-183/02 and T-184/02). Overall, I consider the marks to be visually similar to a medium degree.

*The second earlier mark and the applicant's mark*

42. Visually, the marks coincide in that they share the word HOWDY. The colour of the word HOWDY in both marks is yellow and the stylisation of the word HOWDY across the marks is highly similar, if not identical. The marks coincide in the use of a wheel device that features prominently in both. The wheel devices in the marks utilise a very similar colour scheme, being red and yellow. The wheel devices differ in that the device in the applicant's mark contains a cartoon cowboy whereas the device in the second earlier mark does not and the device in the second earlier mark contains additional elements (such as the guitar head and pistol) which are not present in the applicant's mark. It does, however, include a cowboy hat to give the elements visual similarities.

43. There are additional differences between the marks in that the applicant's mark does not contain the wood effect background or the words PICK UP! The arrangement of the words within the marks also differ. However, these are offset by the significant similarities of the marks as outlined above. I consider the marks to be similar to between a medium and high degree.

*The third earlier mark and the applicant's mark*

44. Visually, the marks coincide in that they share the word HOWDY. However, in other respects the marks are different. The word GELATO, present in the third earlier mark, is absent in the applicant's mark. The cowboy device element, the exclamation mark and the stylisation of the word HOWDY! present in the applicant's mark, are absent in the third earlier mark. However, I note that the third earlier mark is a word only mark and can be used in any standard typeface and registration in black and white will cover the use of the mark in different colours. It is established case law that the beginnings of marks tend to have more impact than the ends (see *El Corte Inglés, SA v OHIM* Cases T-183/02 and T-184/02). Overall, I consider the marks to be visually similar to a medium degree.

## Aural Comparison

### *The first earlier mark and the applicant's mark*

45. Aurally, the first earlier mark consists of four syllables that will be pronounced HOW-DEE-STAYK-HOWSS. The applicant's mark consists of two syllables that will be pronounced HOW-DEE. The figurative elements of the applicant's mark will not be pronounced. The marks share the first two syllables, being HOW-DEE. The similarities include the entirety of the aural element of the applicant's mark. The marks differ aurally with the inclusion of the last two syllables of the first earlier mark, being STAYK-HOWSS. Taking account of these similarities and differences, I conclude that the first earlier mark and the applicant's mark are similar to between a medium and high degree.

### *The second earlier mark and the applicant's mark*

46. Aurally, the second earlier mark consists of four syllables that will be pronounced HOW-DEE-PIK-UPP. The device elements of the mark will not be pronounced. As above, the applicant's mark consists of two syllables that will be pronounced HOW-DEE. The figurative elements of the applicant's mark will not be pronounced. The similarities include the entirety of the aural element of the applicant's mark. The marks differ aurally with the inclusion of the last two syllables of the second earlier mark, being PIK-UPP. Taking account of these similarities and differences, I conclude that the second earlier mark and the applicant's mark are similar to between a medium and high degree.

47. I note that the wheel device element of the mark contains the word 'Howdy'. For the avoidance of doubt, in my view as noted above, this will not be pronounced. This is because it forms part of the device element and is repeated in the text element beneath it. However, if I am wrong in this finding, I consider the marks to be aurally similar to a medium degree.

*The third earlier mark and the applicant's mark*

48. Aurally, the third earlier mark consists of five syllables that will be pronounced HOW-DEE-JEL-ATT-OHH. The applicant's mark consists of two syllables that will be pronounced HOW-DEE. The figurative elements of the applicant's mark will not be pronounced. The marks share the first two syllables, being HOW-DEE. The similarities include the entirety of the aural element of the applicant's mark. The marks differ aurally with the inclusion of the last three syllables of the third earlier mark, being JEL-ATT-OH. Taking account of these similarities and differences, I conclude that the third earlier mark and the applicant's mark are similar to between a medium and high degree.

Conceptual Comparison

49. Given the fact the word HOWDY is found within both the applicant's mark and the earlier marks, I will first make a finding on the conceptual meaning of that word that will apply to all conceptual comparisons between the marks. The word HOWDY is an informal greeting that is mainly used in the United States of America<sup>3</sup>. It is commonly associated with the American Wild West by way of films, television shows and cartoons of the western/cowboy genre. I find that a significant proportion of average consumers in the UK would connect the word HOWDY with the American Wild West and more specifically, cowboys.

*The first earlier mark and the applicant's mark*

50. The word HOWDY is present in both marks and the conceptual meaning of this is set out above. The first earlier mark contains the words STEAK HOUSE that are descriptive of the nature of the services being provided. It is my view that the applicant's device of the cartoon cowboy reinforces the conceptual message of the word HOWDY, that is contained within both marks i.e. a link with the American Wild West and cowboys. Given that the only conceptual differences between the marks

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<sup>3</sup> <https://www.collinsdictionary.com/dictionary/english/howdy>

are words descriptive of the nature of services, I consider that the first earlier mark and the applicant's mark are conceptually similar to a high degree.

*The second earlier mark and the applicant's mark*

51. In respect of the second earlier mark, the opponent submitted that "conceptually the marks are highly similar, comprising the cowboy greeting "Howdy". The cowboy device of the mark applied for, as well as the colourway gives a virtually identical conceptual impression to the HOWDY! PICK UP registration."

52. The word HOWDY is present in both marks and the conceptual meaning of this is set out above. The marks share additional elements that link them to the American wild west and/or cowboys. The applicant's mark features a cowboy device and the second earlier mark also features a device with references to cowboys such as a cowboy hat and revolver pistol.

53. The words PICK UP within the second earlier mark can be seen to be descriptive of the services for which the mark is registered. The average consumer will likely link the words PICK UP within the second earlier mark to a takeaway service and would therefore consider them to be descriptive of the services protected. Given the conceptual similarities between the marks, I am of the view that the second earlier mark and the applicant's mark are conceptually highly similar.

*The third earlier mark and the applicant's mark*

54. The word HOWDY is present in both marks and the conceptual meaning of this is set out above. The third earlier mark contains the word GELATO that I have found to be descriptive of the nature of the services being provided. It is my view that the applicant's cowboy device reinforces the conceptual meaning conveyed by the word HOWDY, that is contained within both marks i.e. a link with the American Wild West and cowboys. Given that the only conceptual differences between the marks are words descriptive of the nature of services, I consider that the third earlier mark and the applicant's mark are conceptually similar to a high degree.

55. If I am wrong in my finding that GELATO will be considered by a significant proportion of the average consumer to mean frozen desserts and/or ice cream, it will instead be viewed as a foreign language word or a made-up word with no particular meaning. If that is the case, I find that the third earlier mark and the applicant's mark are conceptually similar to a medium degree.

### **Distinctive character of the earlier marks**

56. 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).”

57. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive

character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

58. The opponent has not pleaded that his marks have acquired enhanced distinctive character through use, nor has he filed any evidence to support such a claim. I have, therefore, only the inherent position to consider.

*The first earlier mark*

59. I must assess the inherent distinctiveness of the first earlier mark as a whole. The meaning of the word HOWDY has been outlined above. It is an ordinary dictionary word which is neither descriptive nor allusive of the services for which the mark is registered and will therefore have a medium degree of inherent distinctiveness. The words STEAK HOUSE will be given their ordinary meaning and are likely to be seen as descriptive of the services for which the mark is registered. It will not, therefore, contribute to the distinctiveness of the mark as a whole. I consider the first earlier mark to have a medium degree of inherent distinctive character overall.

*The second earlier mark*

60. I must make an assessment of the inherent distinctiveness of the second earlier mark as a whole. As noted above, I consider the word HOWDY itself to be inherently distinctive to a medium degree. The words PICK UP may have a descriptive element to them in that they may be seen to reference a take-away service. The device elements are neither descriptive nor allusive of the services for which the mark is registered and contribute to the distinctiveness of the mark as a whole. I consider the second earlier mark to have between a medium and high degree of inherent distinctive character

*The third earlier mark*

61. I must assess the inherent distinctiveness of the third earlier mark as a whole. The word HOWDY is inherently distinctive to a medium degree, as set out above. I have found that a significant proportion of average consumers will link the word GELATO

to ice cream and/or other frozen desserts. The word GELATO is, therefore, descriptive of the type of services for which the mark is registered and does not, therefore, contribute to the distinctiveness of the mark as a whole. I consider the third earlier mark to have a medium degree of inherent distinctive character.

62. Alternatively, If I am wrong in my above finding that a significant proportion of the average consumer would make the link from GELATO to ice cream and/or other frozen desserts, it will be considered a foreign language word or a made-up word with no particular meaning. I, therefore, consider the third earlier mark to have between a medium and high degree of inherent distinctive character.

### **Likelihood of confusion**

63. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade marks, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

64. In assessing likelihood of confusion, I am going to focus on the third earlier mark on the basis that the average consumer would consider the word GELATO to be a foreign language word or a made-up word with no particular meaning. Although my primary finding is that the average consumer would understand the meaning of this word, this position represents the lowest degree of similarity with the applicant's

mark and is, therefore, the applicant's best case. It follows that if I find likelihood of confusion in respect of this mark, there will also be a likelihood of confusion between the applicant's mark and the first and second earlier marks (and the third earlier mark for those consumers who understand the meaning of the word 'gelato') because they share a higher degree of similarity with the applicant's mark.

### Direct confusion

65. I have found the third earlier mark and the applicant's mark to be visually and aurally similar to between a medium degree and conceptually similar to a medium degree. I have found that the third earlier mark is inherently distinctive to a higher than medium degree. However, I also note that it is the distinctiveness of the common element which is key.<sup>4</sup> I have found the common word 'Howdy' to be inherently distinctive to a medium degree. I have found the services of the applicant's mark to be identical to the earlier marks' specifications. I have found that the average consumer for the services at issue to be the general public who will select the services primarily by visual means (although I do not discount an aural component). I have found that the average consumer will pay a medium degree of attention in selecting the services at issue. I have taken these factors into account in my assessment of the likelihood of confusion between the marks.

66. Notwithstanding the principle of imperfect recollection, taking all of the above factors into account, I do not consider that the marks will be mistakenly recalled or misremembered as each other. In particular, it is my view that the prominent device elements of the applicant's mark will not be forgotten. The average consumer will distinguish between the marks, especially since the services are chosen primarily through visual means. Consequently, I do not consider there to be a likelihood of direct confusion between the third earlier mark and the applicant's mark, even where they are used on identical services.

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<sup>4</sup> *Kurt Geiger v A-List Corporate Limited*, BL O-075-13



## Indirect Confusion

67. I now turn to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

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

68. I must now consider the possibility of indirect confusion and whether average consumers would believe that there is an economic connection between the marks or that they are variant marks from the same undertaking as a result of the shared common elements of the marks. In my view, even if the differences between the marks are identified by the average consumer, taking all of the above factors into account, the presence of the word HOWDY in both the marks will lead the average consumer to view them as alternative marks used by the same or economically linked undertakings. I therefore consider there to be a likelihood of indirect confusion.

## **FINAL REMARKS**

69. As I have found a likelihood of confusion in respect of the third earlier mark where the meaning of the word ‘gelato’ is not recognised, it follows that there will also be a likelihood of confusion in respect of the first and second earlier marks (and the

third earlier mark for those consumers who recognise the meaning of the word 'gelato'), because they share a greater degree of similarity with the applicant's mark.

## **CONCLUSION**

70. The opposition succeeds in its entirety and the application is refused.

## **COSTS**

71. As the opponent has been successful, he is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£650** as contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the applicant's statement:	£250
Preparing written submissions in lieu:	£300
Official fee:	£100
<b>Total:</b>	<b>£650</b>

72. I therefore order Ameer Saail Khan to pay Zafar Iqbal the sum of £650. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 9<sup>th</sup> day of April 2020**

**A COOPER**

**For the Registrar**