

O/0138/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3586584
IN THE NAME OF A.G. PARFETT & SONS LIMITED
IN RESPECT OF THE TRADE MARK

ZACK'S SNACKS

IN CLASSES 29 & 30





AND

THE OPPOSITION THERETO UNDER NO. 425173
IN THE NAME OF ZAKS (UK) LIMITED

AND

IN THE MATTER OF REGISTRATION NOS. 2613480, 2613481, 2613483 &
2463238

IN THE NAME OF ZAKS (UK) LIMITED
IN RESPECT OF THE TRADE MARKS

ZAKS,  &  (SERIES OF TWO),  &  (SERIES OF TWO)
& ZAKS

IN CLASSES 6, 25, 29, 30, 32, 33, 35 & 43

AND

THE APPLICATION FOR REVOCATION THEREOF UNDER NOS. CA000504324,
CA000504325, CA000504326 & CA000504327
BY A.G. PARFETT & SONS LIMITED

Background and pleadings

1. A.G. PARFETT & SONS LIMITED (“AG”) applied to register the trade mark application no. 3586584 for the mark ZACK’S SNACKS in the UK on 28 January 2021. It was accepted and published in the Trade Marks Journal on 26 March 2021 in respect of the following goods:

Class 29: Potato crisps; potato-based snack foods; legume-based snacks; milk-based snacks; cheese-based snack foods; nut-based snack foods; meat-based snack foods; vegetable-based snack foods; soy-based snack foods.



Class 30: Flour-based savoury snacks; cereal-based crisps and savoury snacks; popcorn; flavoured popcorn; tortilla chips; preparations made from cereals.


2. ZAKS (UK) Limited (“Zaks”) filed an opposition against the trade mark on the basis of sections 3(1)(c), 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. The remaining grounds of opposition¹ are based on the earlier marks/signs set out in the table below.





Grounds	Trade mark/territory	Filing date/ registration date/in use since date	Goods/services relied upon
5(1), 5(2)(a) & 5(2)(b) & 5(3)	ZAKS reg. no. 2613480/UK	8 March 2012/15 June 2012	Under section 5(1), 5(2)(a) & 5(2)(b) Class 29: Meat and meat products; hamburgers; fish and fish products; poultry and game; fresh and pre-prepared meals and snacks

¹ The opposition based on section 3(1)(c) has been struck out of proceedings as explained under the heading ‘Case Management Conference’ below.

	<p>(“the first earlier/contested registration”)</p>		<p>containing the aforementioned goods; preserved, frozen, dried and cooked fruits and vegetables; salads; milk and milk products including milkshakes; milk based desserts.</p> <p>Class 30: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; prepared meals, snacks and desserts containing the aforementioned goods; prepared meals containing principally pasta; ice cream and desserts.</p> <p>Class 43: Restaurant services incorporating licensed bar facilities; restaurant services for the provision of fast food; restaurant services specialising in American cuisine; café, snack bar and take away food services.</p> <p>Under section 5(3)</p> <p>All goods and services as registered, set out in Annex A to this decision.</p>
<p>5(2)(b) & 5(3)</p>	<p>  (series of two) reg no. 2613481/UK</p>	<p>8 March 2012/15 June 2012</p>	<p>Under section 5(2)(b)</p> <p>Class 29: Meat and meat products; hamburgers; fish and fish products; poultry and game; fresh and pre-prepared meals and snacks containing the aforementioned goods;</p>

	<p>(“the second earlier/contested registration”)</p>		<p>preserved, frozen, dried and cooked fruits and vegetables; salads; milk and milk products including milkshakes; milk based desserts.</p> <p>Class 30: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; prepared meals, snacks and desserts containing the aforementioned goods; prepared meals containing principally pasta; ice cream and desserts.</p> <p>Class 43: Restaurant services incorporating licensed bar facilities; restaurant services for the provision of fast food; restaurant services specialising in American cuisine; café, snack bar and take away food services.</p> <p>Under section 5(3)</p> <p>All goods and services as registered, set out in Annex A to this decision.</p>
<p>5(2)(b) & 5(3)</p>	 <p>(series of two)</p>	<p>8 March 2012/15 June 2012</p>	<p>Under section 5(2)(b)</p> <p>Class 29: Meat and meat products; hamburgers; fish and fish products; poultry and game; fresh and pre-prepared meals and snacks containing the aforementioned goods; preserved, frozen, dried and cooked</p>

	<p>reg no. 2613483/UK</p> <p>("the third earlier/contested registration")</p>		<p>fruits and vegetables; salads; milk and milk products including milkshakes; milk based desserts.</p> <p>Class 30: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; prepared meals, snacks and desserts containing the aforementioned goods; prepared meals containing principally pasta; ice cream and desserts.</p> <p>Class 43: Restaurant services incorporating licensed bar facilities; restaurant services for the provision of fast food; restaurant services specialising in American cuisine; café, snack bar and take away food services.</p> <p>Under section 5(3)</p> <p>All goods and services as registered, set out in Annex A to this decision.</p>
5(2)(b) & 5(3)	<p>ZAKS reg no. 2463238 /UK</p> <p>("the fourth earlier/contested registration")</p>	<p>6 August 2007/11 January 2008</p>	<p>Class 43: Restaurant, bar and cafe services; takeaway services.</p>

5(4)(a)	ZAKS	In use since 1976 in Norwich and in use since 1978 in Great Yarmouth	All goods and services as set out at Annex A
5(4)(a)	 	In use since 1976 in Norwich and in use since 1978 in Great Yarmouth	All goods and services as set out at Annex A
5(4)(a)	 	In use in Norwich and Poringland since 2005	All goods and services as set out at Annex A

4. Zaks submits that the respective goods and services are identical and that the mark in the first earlier registration is identical to that applied for, and that as such the application contravenes section 5(1) of the Act. Zaks also argues that the first earlier registration is identical or similar to the mark applied for and that the goods are similar or identical, and that as such there will be a likelihood of confusion under sections 5(2)(a) and 5(2)(b). In respect of the marks in the second, third and fourth earlier registrations above, Zaks argues that the marks are similar to the applied-for mark and are filed in respect of similar or identical goods, and as such there exists a likelihood of confusion under section 5(2)(b) of the Act.

5. Zaks also argues that the application contravenes section 5(3) of the Act, on the basis that Zaks holds a substantial reputation for the marks within the first to fourth earlier registrations in the table above, and that the use of the applied for mark for the

goods filed would cause consumers to believe there is an economic connection between the marks.

6. Finally, in respect of section 5(4)(a), Zaks argues that it holds goodwill for the signs set out in the fifth, sixth and seventh boxes above, and that the use of the signs will confuse or deceive the consumer, resulting in financial damage, loss of investment and loss of opportunities for national expansion for Zaks.

7. AG filed a counterstatement denying the claims made, requesting proof of use be provided in respect of Zaks' four registered marks, requesting proof of Zaks' reputation under section 5(3) in addition to all elements of its 5(4)(a) claim.

8. On 9 November 2021, AG filed the four TM26(N) forms seeking to revoke Zaks' first to fourth contested registrations outlined in the table above. All of the applications for revocation are based on section 46(1)(a) of the Act only. AG seeks to revoke the first, second and third contested registrations in the table above from 16 June 2017. AG seeks to revoke the fourth earlier registration from 12 January 2013. AG seeks to revoke the earlier marks in respect of all of the goods and services for which they are registered. In respect of the first, second and third earlier registrations, the goods and services are set out at Annex A. In respect of the fourth contested mark these comprise the services set out within the table above.

9. Zaks filed a counterstatement in all four of the revocation actions, stating that it has made continuous use of the mark in respect of the relevant goods and services within the relevant periods, that that by virtue of the continued use of its marks in the five-year period prior to the applications for revocation, these should also be dismissed under section 46(3) of the Act.

10. Following the filing of the TM8s and counterstatements, all five sets of proceedings were consolidated.

11. Only Zaks filed evidence in these proceedings. This has been fully considered and will be referred to where appropriate throughout this decision.

12. Only AG filed written submissions which will not be summarised but will be referred to where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

13. AG is represented in these proceedings by Harrison IP Limited. Zaks is represented by Michael Flynn of Flynn IP.

14. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Case Management Conference

15. A case management conference (“CMC”) took place before me on 6 July 2022 with both parties in attendance. This addressed AG’s request for the opposition based on section 3(1)(c) of the Act to be struck out, alongside Zaks’ request for an extension of time to file its evidence and Zaks’ objection to the consolidation of proceedings. The outcome of this CMC was that the proceedings would remain consolidated, an extension of time to file evidence would be granted to Zaks, and that the opposition based on section 3(1)(c) of the Act would be struck out on the basis that it held no real prospect of success. The full reasoning for these decisions is set out in my letter dated 12 July 2022. As Zaks had not received notice that the possible strike out of section 3(1)(c) was to be discussed at the CMC and had therefore not come to the CMC fully prepared to deal with this, the decision on its strike out was issued as a preliminary view, with the parties afforded a further period of time to make written submissions or request to make further aural submissions on this matter. No further submissions were made and this preliminary view became final. As a result, section 3(1)(c) of the Act is no longer in play within these proceedings.

Evidence

16. Whilst I do not intend to complete a full summary of the evidence at this stage, I will set out the statements and exhibits filed. Zaks filed its evidence in the form of two witness statements and a number of corresponding exhibits, providing information on the history of the Zaks business and the use of the marks to date.

17. The first witness statement filed is in the name of Ian Hacon, Managing Director of ZAKS (UK) Limited. The statement is dated 16 June 2022 and introduces 10 exhibits, namely Exhibit IH1 to Exhibit IH10.

18. The second witness statement is filed in the name of Christopher Carr, Chief Operations Director of ZAKS (UK) Limited. This statement is also dated 16 June 2022, and it introduces 15 exhibits, namely Exhibit CC1 to Exhibit CC15.

Revocation nos. 504324, 504325, 504326 & 504327

19. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

20. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“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 Bundervsvereinigung 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 Beheer 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].

(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. Section 100 of the Act states that:

“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.”

22. The burden is therefore on Zaks to show it has made use of its contested registrations in respect of the registered goods and services, in the relevant territory of the UK and within the relevant time periods. The relevant periods within which Zaks must show genuine use of its contested marks are from 16 June 2012 to 15 June 2017 in respect of the first, second and third earlier registrations and from 12 January 2008 to 11 January 2013 in respect of the fourth earlier registration. However, in accordance with section 46(3) of the Act, the marks should not be revoked if use has commenced or resumed after the expiry of the five-year period and before the application for revocation was made.

Variant use

23. Before I consider whether Zaks has shown sufficient use in relation to its marks, I will first consider the marks shown within the evidence, and if I consider this to be use of the marks as registered, or to be an acceptable variant of the same.

24. The first and fourth contested registrations are the single word ZAKS. As these marks have been registered as word marks, they may be used in a range of standard fonts, colours and cases. In *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, Mr Philip Johnson, as the Appointed Person, found that the use of the mark shown below qualified as use of the registered word-only mark DREAMS. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.

dreams

25. Where the evidence shows use of the word 'Zaks' or ZAKS in plain or coloured writing, for example within menus in the relevant periods, this is clearly acceptable use of the mark as registered. Further I consider that use of ZAKS in fonts such as those shown in the evidence on menus and elsewhere as below, constitutes fair use of the word marks:





26. Whilst I note that in the above cases the word elements are used in combination with other elements, in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.


33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.


34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

27. I find use of the marks as above constitutes use of an acceptable variant of the word ZAKS, which continues to act as an indication of origin within the above marks. For the same reasons, I also find this use to constitute use of an acceptable variant of

the earlier series of marks  within the second contested registration. Further, I note that the mark ZAKS is also used in conjunction with a location in some instances (such as 'Zaks Poringland') and again, I find this use to be acceptable in line with the principles set out in *Colloseum*.

28. In respect of the marks within the third contested registration, namely  /

, I note these are used in the evidence on menus dating up until 2015 and on some staff uniforms since 2005,² in addition to being displayed on menus posted to social media accounts in 2016.³ Where these marks are used as registered, including where the black and white mark is used in colour, this will be acceptable use

² See paragraph 19 of the witness statement of Mr Hacon in which he states the uniforms have either had this mark or one of the other marks since 2005, but no exact date range is given for each.

³ See Exhibit IH6 to and paragraph 19 of the witness statement of Mr Hacon.

of the same. However, I consider whether I find use of the other ZAKS marks shown in the evidence to constitute an acceptable variant of the third contested registration. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II

etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

29. The two marks in the third contested registration each include two elements, those being the word ZAKS and the background of a US flag print in the shape of what appears to be the USA. It is my view that both of these elements hold some distinctive character inherently, although level held within the US country/flag device is relatively low. I note the comments at paragraph 15 of *Lactalis* above, and I consider that alterations to this element or the omission of the same will not simply constitute alterations or omissions to a non-distinctive element. However, I keep in mind that changes in the device element of a mark are less likely to have an impact on the distinctive character of the marks overall. I consider the other similar marks used such



as and whilst the addition of the descriptive words (“since 1976” and “AUTHENTIC AMERICAN DISHES”) in this variation do not alter the distinctive character of the mark, after careful consideration I do find in this instance that the complete omission of the country shaped US flag within this mark (and the other marks shown in the evidence) does alter the same. I therefore find it is only where this mark is shown as registered (or in the case of the black and white mark, use of this mark as



registered and in colour) that constitutes acceptable use of the series marks



/ and I will keep this in mind when considering the evidence below.

Use of the marks

30. When conducting my assessment of the use shown, I bear in mind that not all instances of use will be sufficient to show find genuine use of a mark has been made in the UK. In *Memory Opticians Ltd's Application*, BL O/528/15, Professor Ruth Annand, as the Appointed Person, upheld the Hearing Officer's decision to revoke the protection of the mark STRADA on the grounds that it had not been put to genuine use within the requisite 5-year period. There had in fact been sales of goods bearing the mark, but these were very low in volume (circa 40 pairs of spectacles per year) and all the sales were local from 3 branches of an optician. There was no advertising of goods under the mark, although the evidence indicated that they were only displayed in-store on occasions. The mark was said to have been applied to the goods via a sticker applied to the arms of a dummy lens. This level of use was held to be insufficient to create or maintain market under the mark. Consequently, it was not genuine use.

31. Having considered the sum of the evidence, I note immediately that this is not without its flaws. Firstly, I note I have not been provided with any turnover figures or unit sales in respect of the goods and services registered under the contested marks. Further, I have not been provided with any details relating to spend on advertising or promotion of the marks. Without these figures, it is difficult to determine the full extent of the use of the marks made. However, I also note there is no set rule on what must be filed in evidence in order to prove use of an earlier mark or marks, and it is the picture created by the evidence as a whole that is key.

32. Within their statements, Mr Carr and Mr Hacon both identically state:

“4. [Zaks] is engaged in the business of supplying goods and services in relation to provision of food and drink; restaurant; café and bar, fast-food, snack and takeaway services; business management and franchise services; merchandising and related matters in the United Kingdom, particularly through their chain of restaurants and online retail outlet”

Use in respect of the services registered in class 43

33. The main bulk of the use of the marks shown within the evidence provided is in respect of restaurant services, and more specifically, the provision of American style diners. At Exhibit IH1 to the witness statement of Mr Hacon, an extract from a webpage labelled 'Our Story' is provided. The address of the website is given as <https://www.zaks.uk.com/our-story> and within his witness statement, Mr Hacon describes this as “the published backstory of the ZAKS business and brand legacy”.⁴ This page is undated but explains that Zaks has been part of people’s lives in Norwich and Norfolk since 1976, and that it began in May 1976 with burgers served from a caravan. It explains the first restaurant opened its doors in 1978 in Great Yarmouth, followed in 1979 by Zaks on Mousehold Heath and Zaks Waterside in 1988, both in Norwich. Zaks Poringland was opened in 2005 and Zaks Thetford was opened in 2015, but subsequently closed in 2019. It explains that Ian Hacon and Chris Carr became joint owners of the business in 2020. Zaks is described as an “authentic American dining experience” which offers burgers in over 20 different ways, in addition to a range of American dishes including baby back ribs and southern fried chicken. The logo below is shown at the bottom of the extract provided:



34. Mr Hacon explains:⁵

“At least two venues have been in substantially continuous use since before 2008 and a further venue was operational from 2014 to 2019, representing a further use of the marks for qualifying services within the period of alleged non-use.”

⁴ See paragraph 10 of the witness statement of Mr Hacon

⁵ See paragraph 19 of the witness statement of Mr Hacon

35. Mr Carr explains that the number of employees hired by the restaurant during 2018 was 144 and in 2019 this number was 148, however, employee numbers for the relevant periods are not given.⁶

36. Exhibit IH5 provides images of menus available in the restaurants during various time periods from 2004 to date. The menu dated between 2007-2010 reminds customers not to forget Zak's takeaway menu. Menus that have been dated in the exhibits as being from 2004 up to 2015 display the logo below:



37. A 'Drinks and Desserts' menu is provided dated 2010 – 2015 listing a range of beers, wines and cocktails, and a main menu displaying meal options is also provide from this time. The images of menus dated as being between 2015 – 2019 also provide a list of meals and drinks including beers, cocktails and wines. A take-away menu from this time period is also provided, offering burgers, wings, hotdogs and sides. The main logo displayed on these menus is as below:



38. The 2019 to 'current' menus provided at the time the exhibit was filed also display the logo above.

39. Also provided is evidence of what appears to be primarily local press attention about the restaurants, including a number of articles and extracts from the Eastern Daily Press.⁷ These include an extract relating to a competition run in the Eastern

⁶ See paragraph 30 of the witness statement of Mr Carr

⁷ See Exhibit IH2, CC7, CC8, CC12 and CC13

Daily Press website in November 2010 providing the chance to win family panto tickets and a meal at Zaks, an article from 2012 providing details of a classic car cavalcade due to set off from Zaks diner in Poringland to raise awareness of an East Anglian charity, two articles from 2016 commenting on the 40th anniversary of Zaks, and an article published on 16 November 2020 providing information on Zak's plan to launch two mobile caravans and a pop-up diner in the following spring around Norfolk. One of the articles from 2016 refers to the 'iconic Norwich diner' and the second talks of the queues to purchase a burger for the one-off anniversary price of 50p or 56p, as it would have been in 1976. Tweets showing images of the long queues to purchase the same from a van are also provided, dated from the same period in June 2016.⁸ Sales from the burger van itself appears to have been a one-off event in 2016, and no further information regarding whether the two mobile caravans due to launch in spring 2021 were opened at this time is provided.

40. An article from www.thecaterer.com providing details of a fourth venue opening is provided dated 22 April 2014⁹ and two articles from the Norfolk Chamber business community website dated from 15 July 2016¹⁰ and 25 January 2019¹¹ promote charity quiz events taking place at a Zaks restaurant. An article from the Norfolk Live community news website dated 26 December 2021¹² provides information on the closing of the Zaks restaurant in Thetford, explaining:

“Although Zak's still operates in Norwich, the Thetford branch was forced to close in June 2019 with the owner citing tough economic conditions as the reason.

The American restaurant branch first opened in May 2015 and throughout its four years of service, developed a great reputation within the local community. Zak's currently operate three restaurants in and around Norwich.”

⁸ See Exhibit CC13

⁹ Exhibit CC4

¹⁰ See Exhibit CC9

¹¹ See Exhibit CC6

¹² See Exhibit CC14

41. An extract is provided from the Evening News website dated 15 December 2021 stating:¹³

“A burger restaurant that has been a city favourite for more than 40 years has been named one of the best in the UK. Zaks at Mousehold Heath has been listed as one of the UK's top 100 restaurants in 2021 by users of the OpenTable reservation website and app.

To determine the list, the company analysed more than 960,000 reviews from restaurants across the UK - all submitted by verified OpenTable diners.

Zaks is the only restaurant in the county to make the list and it has also been named the best value spot across Norfolk and Suffolk.”

42. Whilst I consider there was one instance of the mobile caravan selling burgers at a promotional price in 2016 to celebrate Zak's anniversary, it is my view that the evidence relating to Zaks providing snack bars within the relevant time frame is very limited at best, and it is not sufficient to show genuine use of the mark in respect of these services within the same. Further, I do not consider the article from November 2020 discussing the proposed plans for further vans in spring 2021 is sufficient to show that use has suitably commenced or resumed in respect of these services in accordance with section 46(3) of the Act. I also do not consider the evidence to show use within the relevant timeframe or thereafter in respect of bar or café services per se.

43. The bulk of the evidence shows the use of the mark is in relation to restaurants which serve alcohol. It is clear from the evidence that there was a minimum of two Norfolk based restaurants consistently selling food and drink including alcohol under variations of the 'Zaks' marks throughout both relevant time periods of 16 June 2012 to 15 June 2017 and 12 January 2008 to 11 January 2013. Further, it appears that up to four restaurants were operating for part of the later time period, with the fourth opening in May 2015 and later closing after the relevant period in 2019.

¹³ See Exhibit Exhibit CC15

44. Whilst limited and mostly local, the press issued makes reference to the longstanding use of the Zaks marks for restaurants around Norfolk, and I note the reference from 2016 within the later use period to the restaurants being 'iconic', and a further reference to from 2021 referencing the restaurants being a 'city favourite' for over 40 years. Whilst I consider the evidence provided could be substantially enhanced, I nonetheless find that the picture created by the sum of the evidence is that all of the earlier marks (or acceptable variants of the same) were used within the applicable relevant time periods in relation to services falling within class 43 as registered. I do not consider the use shown to be token, and whilst I bear in mind the findings made in *Memory Opticians*, it is my view that whilst localised to a limited number of venues within the area of Norfolk/Norwich, the evidence, including the commentary press evidence is in this case is sufficient to show that the use made has been for the purpose of creating and preserving a share of the market for the services.

45. I consider this to be genuine use of the following class 43 services as registered under the earlier marks:

Under earlier marks 2613480, 2613481 & 2613483

Class 43: Restaurant services incorporating licensed bar facilities; restaurant services for the provision of fast food; restaurant services specialising in American cuisine; take away food services.


Under earlier mark 2463238

Class 43: Restaurant services; takeaway services.

46. I do not consider the evidence to be sufficient to show genuine use of the three registrations 2613480, 2613481 & 2613483 in respect of *café* or *snack bar services* as registered, or to show genuine use of the registration 2463238 in respect of *bar and café services*.

47. For completeness, I remind myself at this stage that I found the updated version



of the logo found on the menus dating from 2015 – 2019, namely  does not constitute an acceptable variant of the third registration for the series of two marks



. This means at some stage in 2015 and up until the end of the later relevant period on 15 June 2017, there may well have been no or limited use of these registered marks. However, I note this mark featured on menus provided dated between at least 2013 – 2015 within the relevant time period and was featured on images of menus that were uploaded to social media pages in 2016, and I still consider genuine use to have been made within the relevant period in respect of this third registration.

Use in respect of the goods in class 29 to class 33

48. The evidence shows that Zaks has offered various meals and drinks including alcoholic beverages within its restaurants within the relevant period, that being 16 June 2012 to 15 June 2017 for the goods registered under the first three contested marks. Within its final written submissions, AG argues as follows:

“62. The provision of food and drink to customers, who order from a menu, is clearly within the remit of class 43. Party A has submitted no evidence of the marks applied to classes 29, 30, 32 and 33 goods themselves, in this exhibit or elsewhere.”

49. In *Aegon UK Property Fund Limited v The Light Aparthotel LLP*, BL O/472/11, Mr Daniel Alexander Q.C. (as he then was) as the Appointed Person stated that:

“17. unless it is obvious, the proprietor must prove that the use was in relation to the particular goods or services for which the registration is sought to be maintained.

18. In *Céline SARL v. Céline SA*, Case C-17/06 (*Céline*), the Court of Justice gave guidance as to the meaning of “use in relation to” goods for the purpose of the infringement provisions in Article 5(1) of the Directive. Considering a situation where the mark is not physically affixed to the goods, the court said at [23]:

“...even where the sign is not affixed, there is use “in relation to goods or services” within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party.”

50. In *Euromarket Designs Inc. v Peters* [2001] F.S.R. Jacob J. (as he then was) stated that:

“56. That is not all on the question of non-use. If one looks at the advertisements they are essentially for the shops. True it is that some of the goods mentioned in the advertisements fall within the specification, but I doubt whether the reader would regard the use of the shop name as really being “in relation” to the goods. I think this is an issue worthy of trial in itself. The argument is that there is an insufficient nexus between “Crate & Barrel” and the goods; that only a trade mark obsessed lawyer would contend that the use of “Crate & Barrel” was in relation to the goods shown in the advertisement.

57. In this connection it should be borne in mind that the Directive does not include an all-bracing definition of “use”, still less of “use in relation to goods”. There is a list of what may *inter alia* be specified as infringement (Article 5(3), corresponding to section 10(4)) and a different list of what may, *inter alia*, constitute use of a trade mark for the purpose of defeating a non-use attack (Article 10(2), equivalent to section 46(2)). It may well be that the concept of “use in relation to goods” is different for different purposes. Much may turn on the public conception of the use. For instance, if you buy Kodak film in Boots and it is put into a bag labelled “Boots”, only a trade mark lawyer might say that Boots is being used as a trade mark for film. Mere physical proximity

between sign and goods may not make the use of the sign “in relation to” the goods. Perception matters too. That is yet another reason why, in this case, the fact that some goods were sent from the Crate & Barrel United States shops to the United Kingdom in Crate & Barrel packaging is at least arguably not use of the mark in relation to the goods inside the packaging. And all the more so if, as I expect, the actual goods bear their own trade mark. The perception as to the effect of use in this sort of ambiguous case may well call for evidence.”

51. When discussing the above case, along with a second case¹⁴ within *Aegon UK* referenced above, Mr Daniel Alexander Q.C. (as he then was) stated:

24. Both these cases demonstrate that in considering whether use is in relation to given goods or services, the tribunal may take into account a number of factors, including whether the goods were in fact obtained from the proprietor, the presence or absence of other branding on the goods, how the goods were sold and so on. An approach which entitles the tribunal to make an overall assessment of this aspect of use is similar to that of *Ansul*, which requires regard to all the facts and circumstances in evaluating whether use was genuine.

25. The effect of these authorities, both at EU and at national level, is therefore that this aspect of the non-use provisions requires the tribunal to consider whether, having regard to all the facts and circumstances, the mark been used to identify to the average consumer the proprietor as the origin of, including, having responsibility for, the particular goods or services in question.”

52. In *Cactus SA v OHIM*, Case T-24/13, EU:T:2015:494, the General Court held that the owner of what was then a CTM (now an EUTM) who used the mark only as the name of a shop had used the mark “in relation to” the natural plants, flowers and grains sold in the shop (as well as in relation to retail services for those goods). This is because it had demonstrated that the public would link the (otherwise unbranded)

¹⁴ Premier Brands UK Ltd. v Typhoon Europe Ltd & Anor [2000] EWHC 1557 (Ch) [2000] FSR 767

goods to the mark used for the shop and regard the user of that mark as being responsible for the quality of the goods. The court stated that:

“69 Accordingly, in view of the context of the present case, as described in paragraphs 66 to 68 above, and, in particular, the applicant’s specific expertise in the plants and flowers sector, which it publicises, it must be considered that the documents submitted by the applicant which show the earlier marks establish to the requisite standard that there is a link between those marks and plants, flowers and seeds which bear no mark. Those documents show that the applicant offers for sale or sells those goods with the earlier marks as the only indication of a trade mark, with the result that those marks are the only signs that provide an indication of the commercial origin of the goods in question.

70 That conclusion is not affected by the consideration referred to by the Board of Appeal and OHIM that, in the light of the registration of the earlier marks in relation to retail services in Class 35, the earlier marks must be regarded as designating the applicant’s stores which retail plants, flowers and seeds, not those goods themselves. Although the earlier marks are also registered to designate retail services in respect of the sale of plants, flowers and seeds, as is apparent from paragraphs 31 to 39 above, that does not mean, given the context of the present case described in paragraphs 66 to 68 above, that those same marks may not also designate plants, flowers and seeds which bear no mark and which are offered for sale in shops operated by the applicant.

71 In those circumstances, it must be concluded that the Board of Appeal erred in deciding that the applicant had not proved genuine use of the earlier marks in relation to ‘natural flowers and plants, grains’ in Class 31.”

53. With the above case law in mind, I consider firstly the goods registered under the first, second and third registrations in classes 29 & 30. These are as follows:

Class 29: Meat and meat products; hamburgers; fish and fish products; poultry and game; fresh and pre-prepared meals and snacks containing the aforementioned goods; preserved, frozen, dried and cooked fruits and vegetables; salads; milk and milk products including milkshakes; milk based desserts.

Class 30: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; prepared meals, snacks and desserts containing the aforementioned goods; prepared meals containing principally pasta; ice cream and desserts.

54. In the absence of evidence on the contrary, I accept AG's submission that there is no (significant) evidence that contested marks have been applied to the goods themselves, although I note for completeness there appears in one image of



hamburger (in a bun) wrapped in paper bearing the logo provided at Exhibit IH5, and another image of what look like chicken wings presented on top of paper bearing this logo at Exhibit IH7. However, I consider that at least the vast majority of the goods provided will bear no mark when offered in Zaks restaurants, and I note they are displayed in this way in several additional images provided at Exhibits IH5, IH6 and IH7. This is therefore not as straightforward as if the goods themselves had been shown to bear the trade marks, nor is it akin to the case of Kodak film offered in a Boots store for example. Therefore, in addition to whether Zaks is shown to offer the actual goods as registered within its restaurants, I consider whether the public will perceive Zaks to be the origin of (including, having responsibility for) the particular unbranded goods offered.

55. It is clear from the evidence that a key focus of Zaks is the provision of 'burgers' within its restaurants. In my view, the term 'hamburger' may ordinarily describe both a patty wedged inside two halves of a bun, or it may be used to describe the patty alone. I note in this instance, Zaks has registered hamburgers falling within class 29 of the

Nice classification system, in addition to *bread, prepared meals and snacks containing the aforementioned goods* in class 30. According to the guidance on the UK IPO website, I note that whilst 'hamburgers' are listed within class 29, 'hamburgers contained in buns' are true to class 30, and these goods will fall within Zak's class 30 term *bread, prepared meals and snacks containing the aforementioned goods*. Whilst I note burgers in buns are provided more commonly by Zaks, I also note that Zaks also offered on its menus from 2015-2019 a 'hamburger steak' and a 'skinny minny' both of which comprise hamburgers without the bun.

56. It is my view that these are goods that may generally be purchased by the consumer from either a restaurant or fast-food establishment of some description, or from a supermarket or butchers. When considering the link the public will make between these goods and the Zaks marks, I note the article from www.thecaterer.com discussing the launch of the fourth Zaks restaurant in 2014 states:¹⁵

David added: "We'll be sourcing the famous Zaks burger from the company's existing supplier in Norwich, guaranteeing the continuity of quality Zaks customers have come to know and love. However, we are also absolutely committed to building our own local supplier network ensuring the freshness of all the dishes we plan to serve and will be seeking the advice of Zaks' suppliers to make sure this happens."

57. An article from the Blue Sky Leisure website from 7 November 2013 discussing expansion plans for the restaurants states (emphasis added):¹⁶

"Zaks diners capture the taste of America through the food, experience and the environment by researching and replicating current trends in the United States. It imports ingredients and products for authenticity but also recognises the value in supporting local suppliers, which is why its meat and other fresh produce are all from neighbourhood producers. **The Zaks burger is famous in its locality and is part of their provenance made to their own size, shape and recipe from 100% local beef with no additives.**

Ian adds: "We are keen to replicate our local supplier network across each of our franchise regions. In order to do this we will be enlisting the help of our current

¹⁵ See Exhibit CC4

¹⁶ See Exhibit CC1

providers to assist us in finding suppliers of an equal quality in the different neighbourhoods. **We will however continue to produce our famous burgers in Norwich using our original recipe.**”

58. Whilst I accept that the use of the word ‘famous’ in these contexts does not make this a fact, the messaging surrounding the restaurants makes it clear that these are ‘Zaks’ (100% beef) burgers, for which they are responsible. In addition, these are clearly displayed on the menus within the relevant timeframe, both with and without the addition of a bun, and I note that those in a bun are referred to on the same as ‘Zaks famous burgers’. Considering the above, it is my view that the consumer will believe that Zaks is responsible for the goods and will consider the hamburgers (with and without bun) served in Zaks restaurant are goods sold under the Zaks marks, all three of which are used within the relevant timeframe.

59. Whilst there is less focus on the other goods within surrounding evidence, it is clear that milkshakes were also offered as a prominent part of the Zaks menu within the relevant time period. These are not listed under other brands on the menus, and on the menus from between 2015-2019 they are described in places as ‘Zaks shakes’ or ‘our shakes’. Further, I also note that salads, fish products (such as salmon fillets), cooked vegetables (such as mushrooms and corn on the cob), and other fresh meals and snacks containing meat and meat products, fish and fish products and poultry were offered as choices on the menus. It is my view that the consumer will link the contested marks with these unbranded goods offered and believe Zaks to be ultimately responsible for the same, and as such I consider there to be use of the marks, which feature in the press and on the menus, in relation to these goods.

60. It is not clear that *fresh and pre-prepared meals and snacks containing game* have been offered under the marks within the relevant time period, nor is it clear that *pre-prepared meals and snacks containing meat and meat products, fish and fish products and poultry* were offered, which I considered to comprise ready to eat goods prepared at an earlier stage that the consumer may pick up on the go without waiting for the preparation of the same. Further, it is not clear that *milk-based desserts* of the kind that fall within class 29 are offered within the restaurants.

61. The remaining goods in class 29 are as below:

Preserved, frozen, dried and cooked fruits; frozen and dried vegetables; milk.

62. Whilst some of these goods will undoubtedly be used in the meals offered by Zaks, I do not find that they offered these items as goods per se under the Zaks marks. I do not consider the evidence shows Zaks offers these goods within their establishments.

63. Similarly, I note the following goods class 30 may be used as ingredients or as part of meals sold within Zaks restaurants, however, I do not consider the evidence shows there has been use of the following goods per se:

rice; tapioca and sago; flour and preparations made from cereals; pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, spices.

64. In respect of the goods *Coffee, tea, cocoa and artificial coffee* in class 30 I note the evidence provides an image of a coffee menu bearing the mark below, next to what appear to be a cappuccino and two lattes:¹⁷



65. and although I note the image is undated, Mr Hacon explains in his statement these were posted to Zaks social media accounts in mid-2016. I also note the menus dated 2010 – 2015 and 2015-2019 both make reference to coffee, tea and hot chocolate available for purchase. These are not listed under any other brand on the menu, and it is my view the consumer would consider Zaks to be ultimately responsible for these goods, under the three earlier marks.

¹⁷ See Exhibit IH6

66. However, it is not clear is the extent to which *artificial coffee* is offered under the marks. Further, whilst it is clear Zaks offers prepared meals, snacks and desserts, it is not clear from the evidence which of these constitute *prepared meals, snacks and desserts containing the aforementioned goods*, those being *coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, spices* or *prepared desserts containing bread, sauces (condiments)* keeping in mind they must also fall within the remit of goods in class 30. I have been given no indication or direction from the parties as to what may be considered to fall within this term within the evidence and submissions, and I do not consider the evidence to be sufficient to find use in relation to the same.

67. I note the menu dated between 2010 – 2015 contains a pasta section, and the menu dated between 2015 – 2020 includes pasta dishes such as ‘mac and cheese bites’. Unlike ‘*pre-prepared meals*’ which I consider to be meals prepared prior to their order, I consider that ‘*prepared meals*’ simply means meals which are prepared for consumption, be they freshly prepared or pre-prepared and ready to go. I find there to have been use of the marks throughout the relevant time period in relation to *prepared meals containing principally pasta*. In addition, I find both *ice cream* and *desserts* are featured consistently on the menus, in addition to *sauces (condiments)* and these are not listed under any other brand names. I also find garlic bread features on the menus within the relevant timeframe, which I consider falls within the category of *bread* as registered. It is my view Zaks will be considered as responsible for these goods under its marks.

68. As mentioned previously, I find that Zak has shown use of its marks in relation to goods falling within the category of *bread, prepared meals and snacks containing the aforementioned goods* by way of its hamburgers, and I also consider that it has shown use of goods such as the hotdogs and garlic bread which will also fall within this category. Further, I find that Zaks offers a large range of meals and snacks falling within class 30 containing sauces and condiments, and I therefore consider that it has also shown use for multiple goods falling within the category of *sauces (condiments), prepared meals and snacks containing the aforementioned goods* within its

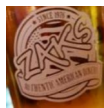
specification. I find Zaks would again be considered to be the party responsible for these goods.

69. The first three contested marks also cover the following goods in class 32:

Class 32: Non-alcoholic beverages; fruit juices; water; beer.

70. I consider that *beer* is also featured on the menus provided within the relevant timeframe. However, I note that they are offered under their own trade marks (for example, under Budwiser and Yardbird). It is my view that the provision of these branded goods within the Zaks establishments is more akin to the Boots/Kodak example set out in *Euromarket Designs*. Whilst these goods are being served within the restaurants, they clearly originate from a source outside of Zaks and the consumer will be aware of the same. I do not find this shows use of the earlier marks in relation to the goods '*beer*'.

71. For completeness, I note there is an undated photograph of a pint of beer said to have been taken for social media provided within the evidence.¹⁸ The image of a pint



of beer shows the logo on the glass, and the images are said to have been posted to the social media account @zaksnorwich in 2016. Within his statement, Mr Hacon states this contains a Pilsner beer which was ultimately launched by the party in 2018.¹⁹ However, this does not appear to feature on the menus provided, and there is no additional evidence surrounding the launch or success of this product. Overall, I do not consider that the evidence is sufficient to find there has been use in relation to 'beer' under any of Zaks marks within the relevant time period.

72. In addition to the above, I note the majority of the soft drinks provided as shown on the menus are also listed under third party trade marks. Whilst I note that 'mineral water' and a 'selection of fruit juices' are listed on the menus without reference to another mark as such, there is no supporting evidence to show that these whether

¹⁸ See exhibit IH6 and Exhibit IH7

¹⁹ See paragraph 19 of the witness statement of Ian Hacon

goods will be provided bearing the Zaks marks, whether they will be provided to consumers bearing a third party mark, or whether they will be unbranded. Unlike food products, it is common for mineral water and fruit juice to be served in a restaurant in branded bottles, and without further evidence, it is not clear that it will be the consumers perception that these are goods offered under the 'Zaks' marks. I do not find the evidence sufficient to show that there has been use of any of the earlier marks in relation to these goods within the relevant time period.

73. However, I note the reference to the 'Zaks Mocktails' on the menus dated 2010 – 2015 and 2015 – 2019. I consider that these goods are generally mixed in house and it is my view that the consumer will believe Zaks to ultimately be responsible for the same under its marks. These goods feature consistently on the menus provided within the relevant timeframe, and I consider there to have been use of the marks in respect of these 'mocktails' which will fall within the broader category of *non-alcoholic beverages* as registered.

74. The following goods are registered in class 33 under the first three contested marks:

Class 33: Alcoholic beverages except beer.

75. Goods including wine and cider are also provided on the Zaks menus under third party marks, and for the reasons previously set out in relation to beer, I do not consider there to have been use of the marks in respect of these goods. However, I do consider the cocktails offered on the menus will have been prepared by Zaks, and will have been served throughout the relevant timeframe, featuring on the menus between 2010-2015 - 2019. It is my view that origin of these prepared drinks will be Zaks, and they will be considered responsible for the same, and I consider there to have been use made in relation to cocktails within this category.

76. I now consider the extent to which the use discussed above constitutes genuine use of the contested marks in relation to the goods. As I have discussed previously, I consider that Zaks has made genuine use of the marks in respect of the restaurant services in class 43 within the relevant time period. I consider that throughout this time,

it has also made use of its marks in relation to the goods which I have mentioned above, by offering these on its menus within its establishments. Whilst again, the evidence filed could be considerably improved, it is my view that whilst localised to the area of Norfolk, the use made in respect of the goods has been for the purpose of creating and preserving a share of the market for the same, and I consider there to have been genuine use of the mark in relation to goods falling within the following categories in class 29, 30, 32 & 33:

Class 29: Meat and meat products; hamburgers; fish and fish products; poultry; fresh meals and snacks containing meat and meat products, fish and fish products and poultry; cooked vegetables; salads; milk products including milkshakes.

Class 30: Coffee, tea, cocoa; bread, sauces (condiments) and prepared meals and snacks containing the aforementioned goods; prepared meals containing principally pasta; ice cream and desserts.

Class 32: Non-alcoholic beverages

Class 33: Alcoholic beverages except beer

77. However, I do not consider Zaks to have made genuine use of its marks in relation to the remaining goods in classes 29, 30, and 32 within the relevant timeframe nor do I consider that the evidence shows use was commenced or resumed in accordance with 46(3) of the Act in respect of the same.

Use in respect of goods in class 6

78. Zaks' first three contested registrations all cover the following goods in class 6:

Class 6: Key rings of common metal

79. Again, the relevant period for showing use of its three earlier marks covering these goods is between 16 June 2012 to 15 June 2017. The evidence provides an undated



image of a key ring displaying the ZAKS logo featuring the US flag device.²⁰ Mr Hacon states that these have been available as part of a welcome pack to all staff members and subsequently, since 2016, to all online purchasers.²¹ Where these are offered to staff members as part of a welcome pack to staff members I do not consider this to be use for the purpose of creating or maintaining a share of the market for these goods. Further, whilst I note that these were available to “all online purchasers” since 2016, the extent to which these goods were purchased (if at all) either within the relevant time periods or subsequent to the same is not clear and there is no additional evidence concerning the sales or advertisement of these goods. I also note for completeness that the keyring provided in the image appears to be for the most part made of plastic, and so it is also unclear if the product in the image constitutes the goods as registered, those being key rings *of common metal*. In any case, I find the evidence provided in respect of these goods to be very limited and based on the same I cannot find that any of the earlier marks covering the class 6 goods have genuinely been used within the relevant time period or that the use has genuinely resumed thereafter in accordance with section 46(3) of the Act in respect of these goods.

Use in respect of goods in class 25

80. Zaks’ first three contested registrations all cover the following goods in class 25:

Class 25: Clothing, namely t-shirts, shirts, sweatshirts, polo shirts, sport shirts, jackets and caps.

81. As above, the relevant period for showing use of its three contested marks covering these goods is between 16 June 2012 to 15 June 2017. I note that the evidence provides images of various items of clothing and accessories including hats,

t shirts, bags, jackets and sweatshirts bearing the signs  and .²² I note that some of these goods are accompanied by prices listed in GBP, and the goods are said on the exhibit to be from an online store with the address

²⁰ See Exhibit IH3

²¹ See paragraph 19 of the witness statement of Mr Ian Hacon

²² See Exhibit IH4

<https://merch.zaks.uk.com>. It is obvious from the sum of the evidence that this is not Zaks' main source of revenue, and, whilst this is not determinative, there is again no information provided regarding how many, if any, of these goods have been sold. Whilst I note Mr Hacon's statement that these goods have been available to visitors of the restaurant and to online purchasers since 2016,²³ information concerning the consistency and the extent of any actual sales that have taken place has not been provided. Whilst I also note Mr Hacon's statement that clothing items have been used to make up the Zaks uniform since 2005,²⁴ I do not consider that providing clothing goods with a 'Zaks' logo to staff for uniforms constitutes a genuine attempt to create a share of the market for the goods. From the evidence provided, I cannot find that there has been genuine use of any of the earlier marks registered in respect of the class 25 goods as registered within the relevant periods, or that the use has resumed thereafter in accordance with section 46(3) of the Act.

Use of the marks in relation to services in class 35

82. Zaks' first three contested registrations all cover the following services in class 35:

Class 35: Business administration and management services; business administration and management support services provided to owners of franchised businesses; business services including the management and running of a franchise network; advertising and promotional services; business advisory services relating to the franchising of restaurant services; retail services in connection with the sale of food.

83. I note firstly that there is no evidence provided showing that Zaks are offering *retail services in connection with the sale of food* under any of their earlier marks. I find no use or genuine use in respect of the same within the relevant time period, and I do not find that the use in relation to these services has resumed thereafter in accordance with section 46(3) of the Act.

²³ See paragraph 19 of the witness statement of Mr Hacon


²⁴ See paragraph 19 of the witness statement of Mr Hacon

84. Next, I consider the evidence provided relating to the franchising of the business, and to what extent this may show use of the marks in relation to the remaining class 35 services. Within his witness statement, Mr Hacon explains:

“Significant investment was made into the development of the franchise aspect of the business model and business support infrastructure (namely “ZAKS Academy”) were put in place. Building a franchise network is a major component of the future expansion of the ZAKS business.”

85. Exhibit IH9 includes an undated flyer promoting a franchise package offered by



Zaks under the mark . Exhibit CC1 comprises a screen shot of a press announcement dated 7 November 2013 on the webpage of Blue Sky Leisure, the former trading name of the owner of the ZAKS business,²⁵ regarding the launch of a franchise scheme under the ZAKS brand. Details are provided as below:

“Having invested heavily in the franchising opportunity to date, the Zaks team will make sure its franchisees are dedicated to the brand by enlisting them on an intensive tailored training course. The Zaks Academy will take place at the Zaks head office near Norwich and will last for several weeks covering business management, marketing, stock control and management and one-to-one training with members of the Zaks team.

The key to success in any franchise is support and in this respect we have abundance. If we are going to introduce a new member to the ‘Zaks family’, it has to be right for us and for them, which is why we’ve chosen a very hands-on approach for selecting our candidates.

The Zaks package will comprise of the following:

- 10 year renewable licence
- Guidance with site location
- Advice on design and fit out
- A panel of high quality suppliers
- Comprehensive start up training

²⁵ See paragraph 1 of the witness statement of Mr Carr

- Co-ordinated launch campaign
- Point of sale material
- Dedicated web page
- Access to regular on-going training
- Business management support
- Access to the full range of Zaks documentation
- Full set of operational manuals

The company behind the authentic American restaurant, Blue Sky Leisure, revealed details of its new Zaks franchise at an American themed event on July 4.”

86. Exhibit CC2 and Exhibit CC3 provide further articles from a webpage entitled ‘Big Hospitality’ and from ‘www.thecaterer.com’ both dated from July 2013 and discussing Zaks plans for an additional 30 franchised restaurants to open in the next five years.

87. Whilst it is clear that in 2013 there were considerable plans to franchise the business and to provide support and training to others in respect of the same, it is not clear from the evidence the extent to which these plans took off. It is not clear that these services have been offered to any extent within the relevant timeframe. Whilst I note that there is a reference to the plans to open a franchise restaurant in an article dating from April 2014, which was due to be run under the franchise management team led by Chris Carr, who also runs the other restaurants,²⁶ it is not clear if/when this opened and to what extent the class 35 services were offered to this franchise. Whilst I note references to a fourth venue opening in Thetford in 2015 and closing again in 2019, it is not clear this was the franchised restaurant referred to in this article (or if it was a franchise at all), to which these services were to be offered. Whilst I consider Mr Hacon’s statement that Zaks has invested heavily in the franchise aspect of the business, I also note Mr Hacon’s reference to building a franchise network being a major component of ‘future plans’, and I note there is no real information provided regarding the extent to which the services in class 35 have been offered to date.

88. Considering the sum of the evidence I do not consider it to have been shown that the use of the marks is sufficient to create or maintain market in relation to the remaining class 35 services. For completeness, I add here that there is also no evidence to show that Zaks offered advertising or promotional services to third parties

²⁶ See Exhibit CC4

under its marks. I therefore cannot find that the evidence shows genuine use of the marks in relation to the services in class 35.

Fair specification

89. With consideration to the use shown of the marks as outlined above, I must now identify what a fair specification should look like considering the categories of goods and services currently registered and the genuine use established.

90. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

91. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

92. The fourth contested mark, namely registration number 2463238 stands registered only in relation to the class 43 services, and genuine use has been found in respect of the services falling into the categories below:

Restaurant services; takeaway services.

93. It is my view that the consumer would find the above to be a fair specification of the services offered under this mark, and I consider it may remain registered in respect of these goods.

94. Genuine use has been found under the three marks 2613480, 2613481 & 2613483 in respect of goods falling within the following categories in class 29:

meat and meat products; hamburgers; fish and fish products; poultry; fresh meals and snacks containing meat and meat products, fish and fish products and poultry; cooked vegetables; salads; milk products including milkshakes.

95. With consideration to the case law, I note it would not be appropriate to reduce the protection under the marks to only the specific categories of goods for which use has been made. However, I consider that *meat and meat products, fish and fish products* and *poultry* provide broad protection, covering everything from raw goods containing meat, fish and poultry to cooked meals such as the type served by Zaks. I consider the consumer's perception of a fair description of the goods, and it is my view that they would find the term *fresh meals and snacks containing meat and meat products, fish and fish products and poultry* in addition to the *hamburgers* as already included within the specification provides adequate and fair protection in this respect.

96. I also consider the category of milk products may be broken up into various subcategories and provides unnecessarily broad protection considering the goods for which the use of the mark has been shown. I consider this may cover a vast range of dairy products. In the circumstance, it is my view that the consumer would fairly describe the goods offered as *milkshakes* and would consider that this provides fair protection under the marks.

97. I consider the remaining goods in class 29, namely *cooked vegetables* and *salads* and it is my view the consumer would find this to be a fair description of the goods provided.

98. It is therefore my view that the following constitutes a fair specification in relation to the goods in class 29:

Class 29: Hamburgers; fresh meals and snacks containing meat and meat products, fish and fish products and poultry; cooked vegetables; salads; milkshakes.

99. Genuine use has been found in respect of the goods falling within the following categories in class 30:

Class 30: Coffee, tea, cocoa; bread, sauces (condiments) and prepared meals and snacks containing the aforementioned goods; prepared meals containing principally pasta; ice cream and desserts.

100. It is my view that *coffee, tea, cocoa; bread; prepared meals containing principally pasta* and *ice cream* are sufficiently narrow and the consumer would consider this to be a fair description of the goods offered under the marks.

101. In respect of the *prepared meals and snacks containing bread* whilst I note these may cover a number of different meals, I consider that Zaks offers a range of meals under these categories including hotdogs, a range of burgers, sandwiches and items such as garlic bread. I find that the consumer would consider this to be a fair description of the goods. I therefore find this to constitute a fair specification for the same. Further, in respect of the category *prepared meals and snacks containing sauces (condiments)* I consider this to also include a number of goods falling within this term such as the nachos provided by Zaks within the relevant timeframe, in addition to the hotdogs, burgers as above, and I consider the wording as it stands to be fair specification for this range of goods.

102. Similarly, I note Zaks offers a range of *sauces (condiments)* and *desserts* under its marks, and whilst it is possible to break these categories down into further subcategories, I find the consumer would view these terms as a fair description of the goods offered, considering the range provided.

103. In respect of class 32, I found genuine use in respect of goods which fell within the category of *non-alcoholic beverages*. However, I find this term to be broad, and I consider that use of the marks has been shown primarily in relation to non-alcoholic cocktails. When describing the goods offered under the mark in this class, I consider the consumer would fairly describe these as *non-alcoholic cocktails*, and I find this to be a fair specification for the goods offered in this class. A similar logic may be applied

in respect of the goods for which genuine use has been found in class 33, which I consider includes 'cocktails' within the category of *alcoholic beverages excluding beer*. It is my view that *cocktails* would be a fair description of the goods offered under the mark in this class.

104. In respect of the services in class 43, it is my view that services listed in the specification would all be considered by the consumer to fairly describe the services offered under the marks, namely:

Class 43: Restaurant services incorporating licensed bar facilities; restaurant services for the provision of fast food; restaurant services specialising in American cuisine; take away food services.

Outcome of the revocation

105. I find Zaks may maintain its protection for the following goods and services under its marks:

Contested marks no. 2613480, 2613481 & 2613483

Class 29: Hamburgers; fresh meals and snacks containing meat and meat products, fish and fish products and poultry; cooked vegetables; salads; milkshakes.

Class 30: Coffee, tea, cocoa; bread, sauces (condiments) and prepared meals and snacks containing the aforementioned goods; prepared meals containing principally pasta; ice cream and desserts.

Class 32: Non-alcoholic cocktails

Class 33: Cocktails

Class 43: Restaurant services incorporating licensed bar facilities; restaurant services for the provision of fast food; restaurant services specialising in American cuisine; take away food services.

Contested mark no. 2463238

Class 43: Restaurant services; takeaway services

106. The first, second and third contested registrations (nos. 2613480, 2613481 & 2613483) will therefore be revoked in respect of the remaining goods and services as of 16 June 2017, and the fourth contested registration (no. 2463238) will be revoked in respect of the remaining services as of 12 January 2013.

Opposition no. 425173

Proof of use of the earlier marks


107. In respect of the opposition based on sections 5(1), 5(2)(a), 5(2)(b) and 5(3) of the Act, AG has requested that Zaks prove use of all four of its earlier registrations in relation to the goods and services relied upon. The evidential requirements and the case law for genuine use are set out above. However, the relevant period for Zaks to prove use of all its earlier marks within this opposition is the five year period 29 January 2016 - 28 January 2021. This overlaps by approximately 1.5 years with the use period considered above in the revocations. In relation again to the services in class 43, I remind myself that Mr Hacon explains:²⁷

“At least two venues have been in substantially continuous use since before 2008 and a further venue was operational from 2014 to 2019, representing a further use of the marks for qualifying services within the period of alleged non-use.”

²⁷ See paragraph 19 of the witness statement of Mr Hacon


108. I also consider Mr Carr’s reference to the number of employees hired by the restaurant during 2018 being 144 and that in 2019 this number was 148.²⁸ These staffing figures fall within the relevant time period to be considered within this opposition. In addition, I consider that the publications relating to the restaurants at exhibits CC6, CC8, CC9, CC12 and CC13 all provide press relating to the restaurants from throughout this relevant time period. Further, I note the menus dated from 2015 – 2019 display the goods mentioned within the revocation matter above for sale under



the mark  , and I note that a further menu displaying this mark is also provided for the period between 2019-2020. Whilst it is difficult to determine the exact dishes provided on this due to the quality of the exhibit, it is clear that meals consisting of meat, fish and poultry products are offered, in addition to milkshakes and ice creams. A take away menu is also provided for this period.


109. Considering the sum of the evidence, and for the reasoning set out previously under the revocation matter addressed above, it is my view that Zaks has made genuine use of its two earlier marks ZAKS (the first and fourth earlier registrations)



and its earlier marks  (the second earlier registration) in respect of the goods and services for which they remain registered following the revocation action above, to the extent that they have been pleaded.

110. However, following its removal from the menus after 2015, I find of use in relation



to the two series marks  to be very limited for the period of 29 January 2016 - 28 January 2021. I acknowledge the images of meals next to menus displaying this mark in respect of which Mr Hacon states:

“These images and the social media accounts to which they were posted remain accessible since their first appearance online mid-2016.”

²⁸ See paragraph

111. Further, I also acknowledge the image of Mr Hacon and Mr Carr featured in a publication posted within the article published on 16 November 2016 at Exhibit IH2 showing use of the mark on the t-shirts they are wearing as below:



112. However, the impression given by the sum of the evidence is that the use of these marks within the relevant period for proving use is minimal. Overall, I do not find the



limited use made of the series of marks as shown in the evidence to be sufficient to create or maintain a share of the market under the same within this period, and as such I find no genuine use of these marks within the relevant period for the purpose of the opposition proceedings.

Section 5(1) & Section 5(2)(a)

Legislation

113. Section 5(1) of the Act reads as follows:

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

114. Section 5(2)(a) of the Act is as below:

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

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

...

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

115. Section 5A of the Act is as follows:

“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.”

116. Section 5A applies in respect of all sections of the Act relied upon within this opposition.

117. Zaks’ opposition based on section 5(1) and 5(2)(a) of the Act relies upon its earlier mark ZAKS with registration no. 2613480 only.

118. Both of these grounds rely on the earlier mark being identical to the contested mark. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

119. In *Reed Executive plc v Reed Business Information Ltd*, Court of Appeal [2004] RPC 767, Jacob L.J. found that ‘Reed’ was not identical to ‘Reed Business Information’ even for information services. He stated that:

“40. It was over “Reed Business Information” that battle was joined. The composite is not the same as, for example, use of the word “Reed” in the

sentence: “Get business information from Reed”. In the latter case the only “trade-marky” bit would be “Reed”. In the former, the name as a whole is “Reed Business Information”. The use of capital letters is of some visual significance – it conveys to the average user that “Business Information” is part of the name. If the added words had been wholly and specifically descriptive – really adding nothing at all (eg “Palmolive Soap” compared to “Palmolive”) the position might have been different. But “Business Information” is not so descriptive – it is too general for that.”

120. The marks to be compared in this instance are as below:

Earlier mark	Contested mark
ZAKS	ZACK’S SNACKS

121. In this instance, it is clear that the contested mark does not simply reproduce the earlier mark without any modification or addition. I do not consider the additional ‘C’ and the apostrophe in the contested mark to be so insignificant that they may go unnoticed by the average consumer, and in addition to this, there is the addition of the word SNACKS in the contested mark. Whilst I consider the word SNACKS is descriptive, its use following an ‘S’ in the word ‘ZACK’S’ makes it clear that it forms part of the mark, depicting ‘snacks’ belonging to or deriving from Zack. As it cannot be said that the marks are identical, the opposition must fail under both section 5(1) and 5(2)(a) of the Act.

Section 5(2)(b)

122. Section 5(2)(b) of the Act is 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”.

The Principles

123. 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.

My Approach

124. Considering the earlier marks relied upon within this opposition, it is my view that the first earlier registration, namely the word mark ZAKS under registration no. 2613480, presents Zaks with its best case. It provides equal protection in respect of the goods and services relied upon to the second earlier registration and broader relevant protection to the fourth earlier registration. Further, as it is registered as a word mark, its protection is not limited by a particular stylisation, and it may be presented in an identical manner stylistically to the contested mark, which is also

registered as a word mark. Further, the use shown in the evidence is considered to be use of an acceptable variant of this mark. I will therefore begin by considering the opposition based on this earlier mark, and only return to consider the position under the other earlier marks if it becomes necessary to do so.

Comparison of goods and services

125. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, 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”.

126. 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.

127. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

128. 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 stated that goods may be considered "complementary" where:

"...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".

129. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“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”.

130. With this in mind, the goods and services for comparison are as follows:

Earlier goods	Contested goods
<p><i>Class 29: Hamburgers; fresh meals and snacks containing meat and meat products, fish and fish products and poultry; cooked vegetables; salads; milkshakes.</i></p> <p><i>Class 30: Coffee, tea, cocoa; bread, sauces (condiments) and prepared meals and snacks containing the aforementioned goods; prepared meals containing principally pasta; ice cream and desserts.</i></p> <p><i>Class 43: Restaurant services incorporating licensed bar facilities; restaurant services for the provision of fast food; restaurant services specialising in American cuisine; take away food services.</i></p>	<p><i>Class 29: Potato crisps; potato-based snack foods; legume-based snacks; milk-based snacks; cheese-based snack foods; nut-based snack foods; meat-based snack foods; vegetable-based snack foods; soy-based snack foods.</i></p> <p><i>Class 30: Flour-based savoury snacks; cereal-based crisps and savoury snacks; popcorn; flavoured popcorn; tortilla chips; preparations made from cereals.</i></p>

Class 29

131. The earlier goods *fresh snacks containing meat and meat products* are included within the contested term *meat-based snack foods* and these goods are therefore identical in line with the principles outlined in *Meric*.

132. I consider that the contested goods *potato crisps* and *potato-based snack foods* will both technically comprise vegetables that have been cooked and they may therefore fall within the meaning of the earlier goods *cooked vegetables*. The same is true for the contested *vegetable-based snack foods*. On this basis, the goods are identical in line with the principles set out in *Meric*.

133. However, if it is considered that finding *potato crisps* and *potato-based snack foods* fall within the category of *cooked vegetables* will stretch the ordinary and natural meaning of the term, I nonetheless find that the category of cooked vegetables will include items such as vegetable crisps and other cooked vegetable snacks. Whilst the nature of these goods will differ with potato crisps (if my earlier findings that these fall within the category of cooked vegetables is wrong), I consider they may both be offered salted within a bag, and trade channels may be shared and they may be placed next to each other in stores. They will share an intended purpose in that they will all be for consumption as a savoury snack to satisfy hunger. There will be competition between the goods on the basis that they all may be chosen as alternative convenient salty savoury snack foods. Users will be shared to the extent that they will all be offered to the general public. Overall, if there is no identity, I find *potato crisps* to be similar to the earlier goods *cooked vegetables* to at least a medium degree.

134. Further, I find *potato-based snack foods*, will include potato crisps, in addition to other goods such as fries and potato wedges, where again there will be a range of vegetable-based alternatives included within the category of *cooked vegetables* such as vegetable-based fries. It is my view that if there is no identity between the goods, the above reasoning will also apply to this category of goods and they will be similar to at least a medium degree.

135. I consider *legume-based snacks*, *soy-based snack foods* and *nut-based snack foods* to include snacking goods such as those made from chickpeas, beans and

lentils, and nuts. These may be cooked and served hot for example in respect of goods such as falafel or may be packaged for snacking such as in the case of roasted chickpeas, beans or nuts. I find these to be of a similar nature to the earlier *cooked vegetables* as all of these categories include plant-based snacking foods. I consider that the purpose of the goods, for eating to satisfy hunger, will be shared. Due to the similarities in the nature, the goods may share trade channels to an extent. They may all be served at restaurants and cafes for example, and they may be placed near each other in stores. Users will be shared to the extent that the goods will all be purchased by the general public, and there may be a degree of competition between the goods with the consumer choosing from cooked vegetables or legume-based, soy-based or nut-based items to snack on. Overall, I find these goods to be similar to at least a medium degree.

136. Alternatively, I also find that on the basis that legumes and soy are often used as meat replacements, being an alternative source of protein used to create vegetarian and vegan options, I find there may also be a level of competition between *legume-based snacks* and *soy-based snack foods* and *fresh snacks containing meat and meat products*, particularly where the former are sold in the form of meat alternatives. I find these goods may share users and trade channels, and whilst they are unlikely to be placed directly next to each other in stores they will share the intended purpose of being consumed as a protein-based snack to satiate hunger. I consider *legume-based snacks* and *soy-based snack foods* to also be similar to the earlier *fresh snacks containing meat and meat products* to a medium degree.

137. Next, I consider the contested terms *milk-based snacks* and *cheese-based snack foods*. I consider that the earlier *fresh [...] snacks containing meat and meat products, fish and fish products and poultry* will cover a range of snacks and lighter or smaller portioned foods made of meat and meat products. Whilst the nature of the contested goods will differ to these earlier goods in the sense that the earlier snack foods will be meat or fish based, the goods may all be hot or cold fresh savoury snack items. I consider that the purpose of the goods, for eating as a snack to satisfy hunger, will be shared. Whilst the difference in nature means the goods are unlikely to be placed directly next to each other in supermarkets for example, they may share trade channels to an extent. They may all be served at restaurants and cafes for example,

and they may be placed near each other in stores on the basis they may all include fresh (hot or cold) snack foods. Users will be shared to the extent that the goods will all be purchased by the general public, and there will be a degree of competition between the goods, with the consumer choosing from a meat-based snack or a milk- or cheese-based snack food, although this may be at a lower level than above where the goods may be formed to create a direct alternative to a meat product. The goods will not be complementary. Overall, I consider there to be at least a low degree of similarity between the goods.

Class 30

138. I find the contested *flour-based savoury snacks* and *cereal-based [...] savoury snacks*, to be fairly broad categories of savoury snacks. The earlier goods include *prepared [...] snacks containing bread*, which in my view will also cover a range of savoury snacks which contain bread, including those which may be flour based or cereal based. As such these goods may be considered identical in accordance with the principles outlined in Meric. However, if I am wrong, I consider that both the earlier goods and the contested goods will cover hot and cold savoury snacks. If they are not considered to be identical then I note the nature will differ to an extent, however, I consider there will be an overlap in that they all cover goods that may all be primarily or partially carbohydrate based, and I note they will both share the purpose of being eaten as a savoury snack to satisfy hunger. Again, there may be an overlap in trade channels, and they may all be served at restaurants and cafes for example, and they may be placed near each other in stores on the basis they may all include fresh (hot or cold) snack foods. Users will be shared to the extent that the goods will all be purchased by the general public, and there will be a level of competition between the goods, with the consumer choosing between them to satisfy their desire for a carbohydrate-based savoury snack item. The goods will not be complementary. Overall, if I am wrong to find identity between the goods, I consider these to be similar to at least a medium degree.

139. In respect of *tortilla chips* I note these will include both salted pre-packaged versions as well as fresh versions of the same. I consider that the earlier goods include *prepared [...] snacks containing sauces (condiments)* which will cover goods such as

prepared nachos containing sauces within this class. I note these will be of a very similar nature to the tortilla chips on the basis that they will contain the same (albeit covered in sauces). They will also share a purpose of being for consumption as a savoury snack. I note *tortilla chips* may be served warm within a restaurant or snack bar environment alongside prepared snacks (such as nachos) containing sauces, and there will be a level of competition between these goods, with the consumer choosing between these goods within such a setting. Users and trade channels will be shared. I therefore find a high degree of similarity between the same. For completeness, I note I also find there to be similarity with the earlier cooked vegetables, which I have found to include goods such as cooked vegetable crisps. Whilst the nature of these goods will differ, I consider they may both be offered salted within a bag, trade channels may be shared and they may be placed next to each other in stores. They will share an intended purpose in that they will all be for consumption as a savoury snack to satisfy hunger. There will be competition between the goods on the basis that they all may be chosen as alternative convenient salty savoury snack foods. Users will be shared to the extent that they will all be offered to the general public, and I consider these goods to be similar to at least a medium degree.

140. Whilst I note that technically, corn is a vegetable and as such 'popcorn' is a cooked vegetable, considering these goods fall within class 30 I do not find they will fall within the meaning of term *cooked vegetables* as included within class 29. As such, I find no identity between these goods. However, I do find *flavoured popcorn*, *popcorn* and *cereal crisps* may again be sold salted and pre-packaged in the same aisles of the supermarket as goods such as vegetable crisps as included within the earlier goods category of *cooked vegetables*. Purpose and users overlap and the goods are in competition. I again find these goods to be similar to the earlier goods to at least a medium degree.

141. I consider that the contested *preparations made from cereals* will include *cereal crisps* and so the above reasoning will apply to these goods, which I find will be similar to the earlier goods to at least a medium degree.

142. Whilst I found it to be appropriate to compare the contested goods with the earlier goods as above, for completeness I also consider in this instance the comparison

between the earlier services in class 43 and the contested goods in classes 29 and 30 in case a higher level of similarity may be found elsewhere. The earlier services include various restaurant services for the provision of food, in addition to take away services. It is my view that this will include services for the provision of food in the broad snack categories included in both the contested classes 29 and 30 as below:

Class 29: Potato-based snack foods; legume-based snacks; milk-based snacks; cheese-based snack foods; nut-based snack foods; vegetable-based snack foods; soy-based snack foods.

Class 30: Flour-based savoury snacks; cereal-based [...] savoury snacks; preparations made from cereals.

143. The nature of the contested goods above and the contested services is very different, as is the method of use. However, I consider that there is a level of complementarity between the goods and services on the basis that the above goods are important or essential for the running of restaurant or take away services for the provision of those goods, and the consumer is likely to believe the goods and services may be offered by the same undertakings. The user and the intended purpose will be shared to the extent that the goods and services will both be aimed at the general public for the purpose of satisfying hunger. There will also be a level of competition between the goods and services, with the consumer choosing to either purchase the contested goods or choosing to engage the earlier services to prepare and serve that same snack. Considering all of these factors, I find the earlier services to be similar to the contested goods to a medium degree.

144. I now consider the remaining goods namely *potato crisps* in class 29 and *cereal-based crisps; tortilla chips; popcorn* and *flavoured popcorn* in class 30 and their similarity with the earlier services in class 43. As expressed above, it is my view that tortilla chips are often served warm in a restaurant (or take away) environment, and as such the above factors apply. I consider these to be similar to the earlier restaurant services to a medium degree. However, I do not consider that *potato crisps* or *cereal-based crisps; popcorn* and *flavoured popcorn* will commonly be offered in a restaurant or take away setting. I do not consider these goods and services to share trade

channels, and I do not consider them to be complementary on the basis they are not important or essential for one another. I note there may be a very broad overlap in intended purpose on the basis that they are both for the purpose of satisfying hunger. However, it seems less likely that the consumer will choose between, for example, purchasing a bag of crisps or popcorn or sitting down to eat at a restaurant or engaging a takeaway service, and I find any level of competition between these goods and services is likely to be small. Overall considering all of these factors, I find the level of similarity between these goods and the earlier services to sit at best at a very low level.

Comparison of the marks

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

158. It would be wrong, therefore, to dissect the trade marks artificially, 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.

159. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
ZAKS	ZACK'S SNACKS

160. The earlier mark comprises the single word ZAKS. It is within this element that the overall impression of the mark resides.

161. The contested mark comprises the two words ZACK'S SNACKS. The word ZACK'S is placed at the beginning of the mark and appears to be the most dominant and distinctive element of the same. However, whilst the descriptiveness of SNACKS in the context of the goods means its weight is somewhat diminished, I do not consider it to be negligible, and I note the two elements hang together to indicate that the 'snacks' derive from or belong to 'Zack'. The overall impression resides in the mark as a whole.

Visual comparison

162. Visually, the marks coincide through the use of the 4 letters Z-A-K-S. These appear in the initial word of the contested mark and comprise the only element of the earlier mark. Whilst the letters are in a similar order, with both these words starting ZA and ending KS, there is an additional C between these two elements in the contested mark, as well as an apostrophe between the K and S. The contested mark also contains the additional word SNACKS. The visual similarities between the marks lie in the initial element, including in the initial two letters of the same, giving them a greater visual impact.²⁹ Overall, I consider the marks to be visually similar to a medium degree.

Aural comparison

163. Aurally, the initial word in each of the marks will be pronounced identically as the plural or possessive version of the known single syllable English name Zack, namely as 'Zacks'. The contested mark also includes the second single syllable word SNACKS which will be known to the consumer and pronounced using its normal pronunciation. This has no counterpart in the earlier mark. Considering the initial single syllable word

²⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

will be pronounced identically in each mark and keeping in mind the differences created aurally by the addition of an extra the single syllable word in the contested mark, it is my view that the marks are aurally similar to a medium degree.

Conceptual comparison

164. The words ZAKS/ZACK'S will both be recognised simply as either the plural or possessive version of (essentially) the same male first name.

160. However, I note the contested mark also contains the word SNACKS. *Collins* dictionary defines snack in the following terms:³⁰

1. COUNTABLE NOUN

*A **snack** is a simple meal that is quick to cook and to eat.*

2. COUNTABLE NOUN

*A **snack** is something such as a chocolate bar that you eat between meals.*

165. I find that the inclusion of the word SNACKS in the contested mark creates a point of conceptual difference between the marks, however, I note this concept is weak on the basis that it is generally descriptive in the context of the goods.

Average consumer and the purchasing act

166. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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*, Case C-342/97.

³⁰ <https://www.collinsdictionary.com/dictionary/english/snack> [accessed 17 January 2023]

167. 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.”

168. The average consumer of the goods and services will primarily comprise members of the general public, although I note there will be a group of professional consumers, such as those purchasing the goods to stock stores, or using the services for the running of events for example. The general public will purchase the goods fairly frequently and often at a low price point, although they will consider factors such as the flavour and nutritional content of the same. Overall, I consider the level of attention paid by the general public to the goods to fall between low and medium. The level of attention paid by the general public in respect of the services offered is likely to sit slightly higher than the everyday food goods, at a medium level. The general public is generally likely to engage the services less frequently and will consider factors such as the type of cuisine offered, the price point, reviews, and location of the same. Due to the increased responsibility faced by professional consumers purchasing the goods to stock stores or engaging the services, the level of attention paid by this group of consumers is likely to be generally higher, falling at medium or above.

169. The goods will primarily be purchased visually, and the general public will purchase the goods either in physical or online retail stores or in cafes or restaurants. Where the goods are purchased by the professional consumer, this is likely to be via physical or online wholesale stores or catalogues. Where the services are engaged by the general public visual considerations are also likely to be key, with visual advertisements and websites playing a part in the process. However, I consider that assistance from retail staff and waiting staff may play a part in the purchasing process

of the goods, as may word of mouth recommendations in respect of the services. I also consider that professional consumers may place orders over the phone. As such I cannot completely discount the aural comparison.

Distinctive character of the earlier trade mark

170. 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).”

171. Earlier in this decision I found the earlier mark will be considered as the plural or possessive use of the male first name ‘Zak’. I do not consider the use of a first name in respect of goods and services to be particularly distinctive inherently, however, I also note the mark is not allusive nor is it descriptive of the goods or services. I consider the earlier mark to hold a medium level of inherent distinctiveness.

172. When considering if the distinctiveness of an earlier mark has been enhanced through the use made of the same, it is the perception of the UK consumer at the relevant date, namely the filing date of the contested application, that is key. In this instance, that falls on 28 January 2021. Whilst I note Zaks has filed evidence showing the genuine use of its earlier mark prior to this date, I note this evidence as a whole is fairly limited, as is the level of use shown within the same.

173. I consider the high points of the evidence show that the mark has been in use since the late 1970s, with a maximum of four restaurant establishments open in the Norfolk/Norwich only area at any one time. I also note the small amount of primarily but not solely local press attention dating prior to the date the application was filed, and the reference to the establishment as the 'iconic Norwich diner' in 2016 within the same. Whilst the article confirming its place in the top 100 restaurants from OpenTable reviews in Evening News website is dated after the relevant date, I note this makes reference to Zaks as a 'city favourite for over 40 years'. I also note the reference to the number of employees hired by the restaurant during 2018 being 144 and 148 in 2019. However, I have not been provided with any turnover figures for the restaurants, nor have I been provided with details of spend on advertisement or promotion of the goods and services under the marks. I have not been provided with details of the size of the market for the goods and services, but this is likely to very large.

174. Considering the sum of the evidence, despite the fairly longstanding use of the mark in the local area of Norwich, it seems the overall operation run by Zaks is relatively small and I do not consider the evidence is sufficient to show the distinctiveness of the earlier mark has been enhanced above its inherent level.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

175. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 123 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctive character of the earlier mark may be inherent, but that it may also be increased through use, and that the distinctiveness of the common elements is key.³¹ I must keep in mind that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods and services are obtained will have a bearing on how likely the consumer is to be confused.

176. There are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.³²

177. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

178. I found the marks to be both visually and aurally similar to a medium degree. I found the marks to contain a point of conceptual difference through the use of SNACKS in the contested mark. However, I place little weight on this difference due

³¹ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

³² *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

to weak concept conveyed through the use of the word 'snacks' in relation to food goods and services, which is likely to be of little assistance to the consumer when distinguishing between the marks. I found the earlier mark to be inherently distinctive to a medium level, and I did not find its distinctiveness to have been enhanced further through its use. I found the consumers will primarily comprise the general public who will pay a low to medium level of attention in relation to the goods and a medium level of attention in respect of the services, but that there will also be a group of professional consumers who will pay a higher level of attention to both, that being medium or above. I found the goods and services to range from identical to similar to a very low degree, but that all of the contested goods were similar to some of the earlier goods or services to at least a low degree.

179. I bear in mind that ZAKS/ZACK'S is the most dominant and distinctive element in both marks, and whilst SNACKS is not negligible, it is on its own descriptive of the goods for which it has been filed. I also consider that the dominant and distinctive element of each of the marks will be considered as alternative spellings for the same male first name, and whilst it is this element that is most likely to stick in the mind of the consumer, I consider the exact choice of spelling is likely to be misremembered. Considering these factors, in addition to all of the factors outlined in the paragraph above, it is my view that there is a likelihood of direct confusion between the marks in respect of all of the goods for which the level of similarity with the earlier goods or services is at least low, which in this instance applies to all of the contested goods.

180. I have also considered if I find there to be a likelihood of indirect confusion in this instance. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C. (as he then was) provided the following examples of circumstances within which a likelihood of indirect confusion may occur:

"17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This

may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

181. Whilst it is my view that this situation does not neatly fall within category (b) above, I consider this to be close to the current situation. It is my view that again, the exact spelling of ZAKS/ZACK'S is likely to be misremembered by the consumer, and it is followed in this instance by an entirely descriptive term. Whilst I note my comment within the overall impression of the mark that the elements hang together and indicate to the consumer that the goods under the mark are 'snacks' deriving from or belonging to 'Zack', I do not find this precludes a likelihood of indirect confusion. Sitting as the Appointed Person in *BARKERS BREW Trade Mark, O-476-14*, Ruth Annand stated:

"24. To my mind the issue was not so much Medion but rather one of general principle: the overall impression the Applicant's mark would have on the pet-owning public in the particular circumstances of this opposition.

25. The Hearing Officer seems, however, to have determined that because in his view BARKERS BREW "hung together", and BREW was not purely descriptive of pet food, BARKERS had no independent significance in the Applicant's mark, and that was sufficient to preclude likelihood of confusion (or a link) with the Opponent's mark, even though BAKERS was highly distinctive and identical goods were involved.

26. On the contrary, the CJEU makes clear in *Bimbo* that “hanging together” is not the determinative criteria in assessing a composite mark: the decisive question being whether the composite mark forms a unit having a different meaning as compared to its components taken separately (*Bimbo*, para. 25).

27. Mr. Malynicz referred me to 2 earlier decisions of Mr. Geoffrey Hobbs Q.C. sitting as the Appointed Person in *CARDINAL PLACE* Trade Mark, BL O/339/043 and *CANTO* Trade Mark, BL O/021/064 , as similarly expressing the same point that marks must be compared as wholes, considering the blend of meaning given by the composite mark against the single term.

28. In my judgment, the Opponent was justified in complaining that the Hearing Officer did not consider the overall blend of meaning and significance of *BARKERS BREW* to the pet-owning public in the context of pet food, and thus made an error of law.”

182. I therefore consider the overall blend of meaning and significance of the contested mark to the relevant consumer when compared with the earlier mark *ZAKS*, keeping in mind the factors previously set out. With this in mind, it is my view that should the consumer notice the addition/omission of the word *SNACKS* (having misremembered the spelling of *ZAKS*, which I find highly likely) and are therefore not directly confused between the marks, it would be entirely logical for the consumer to consider this descriptive element to indicate a sub-brand of the goods offered under the earlier mark, to be used in relation to certain or specific snack items, where there is at least a low level of similarity between the goods and services. I therefore find a likelihood of indirect confusion in respect of the marks in relation to all of the contested goods.

183. For the reasons above, the opposition based on section 5(2)(b) of the Act succeeds in full. It is not necessary for me to consider the opposition under this ground based on the additional earlier marks relied upon.

Section 5(3)

184. Although the opposition based on section 5(2)(b) has succeeded in full, for completeness I will briefly address the additional grounds of opposition relied upon. The marks relied upon under section 5(3) of the Act are set out within the table at the outset of this decision.

185. Section 5(3) of the Act states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

186. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

187. An invalidation based on section 5(3) of the Act can only be successful via the establishment of several individual elements, the cumulation of which must satisfy all elements of the claim. To be successful on this ground, the cancellation applicant must prove it holds a reputation for the earlier marks relied in respect of the goods or services relied upon amongst a significant portion of the public. It must also establish that the earlier marks are similar to the contested mark. If it is found both that the marks are similar and that the earlier mark holds a qualifying reputation it must then be shown that this reputation, combined with the similarity between the marks will result in the relevant public establishing a link between the marks. A link may be found on the basis that the later mark brings the earlier mark to mind. Importantly, if all three of these elements have been established, it must then be shown that the link made by the public will result in, or will be likely to result in, one of the pleaded types of damage. The relevant date for consideration under section 5(3) of the Act is the application date of the contested mark, that being 28 January 2021.

Reputation

188. In *General Motors*, the CJEU gave the following guidance for the assessment of a trade mark's reputation:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it”.

189. I have summarised the high points of Zaks’ evidence earlier in this decision when considering the distinctiveness of this mark. I note again the longstanding use of the marks since the late 1970’s, the use in multiple establishments within the Norfolk/Norwich area, the number of employees and the modest press attention received by the establishments. However, I note the use shown is confined to single region of the UK, and I note the lack of turnover figures and details of advertising and promotional spend mean the full extent of the use and share of the market held by Zaks at or prior to the relevant date is not clear. I consider that the press attention has been limited, and overall I find the evidence falls short of showing Zaks held a reputation under any of its earlier marks relied upon at the relevant date.

190. As an opposition based on section 5(3) of the Act is dependent on the establishment of a reputation under the marks relied upon, the opposition based on this ground must fail.

Section 5(4)(a)

191. The opposition filed under section 5(4)(a) of the Act relies upon the five earlier signs set out in the table in at the outset of this decision. Again, I consider in this instance that Zak's reliance upon the earlier sign ZAKS puts it in the strongest position under this ground, and as such I will approach my analysis based on its reliance upon this mark only at this stage.

192. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

193. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

General principles of Section 5(4)(a)

194. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

195. In respect of section 5(4)(a), the application date (or the priority date if applicable) is considered to be the relevant date for establishing if there is goodwill held by a business under an earlier sign. However, where there is use of the contested mark prior to that date, the opponent must establish that it held goodwill at the date the conduct complained of commenced.³³ In this instance, I have not been provided with any evidence showing that AG has used its mark prior to the application date. I therefore consider the application date of 28 January 2021 to be the relevant date in this instance.

³³ See *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11.

Goodwill

196. Goodwill is described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 233 as below:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

197. Goodwill which is protectable under the law of passing off must be more than trivial,³⁴ and both national and local goodwill may be sufficient to prevent an applicant from acquiring a national trade mark within the UK.³⁵

198. The evidence in this case has already been summarised in detail, however, I consider again shows the longstanding use of the sign ZAKS in the Norfolk/Norwich area dating back to the late 70's in respect of food provision services, with its first restaurant opening under the mark in 1978. I consider that the use of the mark appears to have been fairly consistent since that date, in respect of restaurant services and the provision of the food goods provided at the establishments, and I note the mainly local and occasional national press. It is my view that there will be a moderate level of goodwill held by Zaks local to the Norfolk area as distinguished by the mark relied upon, in respect of the same goods and services for which Zaks has shown use under its mark prior to the relevant date, as below:

Class 29: Hamburgers; fresh meals and snacks containing meat and meat products, fish and fish products and poultry; cooked vegetables; salads; milkshakes.

³⁴ Hart v Relentless Records [2002] EWHC 1984 (Ch).

³⁵ *Caspian Pizza Ltd v Shah* [2017] EWCA (Civ) 1874

Class 30: Coffee, tea, cocoa; bread, sauces (condiments) and prepared meals and snacks containing the aforementioned goods; prepared meals containing principally pasta; ice cream and desserts.

Class 32: Non-alcoholic cocktails

Class 33: Cocktails

Class 43: Restaurant services incorporating licensed bar facilities; restaurant services for the provision of fast food; restaurant services specialising in American cuisine; take away food services.

Misrepresentation

199. In this instance, I have found there to be goodwill distinguished by an identical sign in respect of identical (and additional) goods and services to those relied upon within the opposition based on section 5(2)(b) of the Act. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

200. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems

doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

201. In this instance, I do not consider there will be a different outcome under this ground to that found under section 5(2)(b) of the Act, and I find the contested mark will result in a misrepresentation that it is at least economically connected with the business under the sign relied upon. Whilst I remind myself that the goodwill will be localised, and as such any misrepresentation is likely to be limited to consumers within the Norfolk area, the application filed is for a national right covering this area and as such this makes no material impact on my findings.

Damage

202. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff’s business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff’s goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff’s reputation and goodwill may be damaged without any corresponding gain to the defendant. In the Lego case, for example, a customer who was dissatisfied with the defendant’s plastic irrigation equipment might be dissuaded from buying one of the plaintiff’s plastic toy construction kits for his children if Page 47 of 61 he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

203. In this instance, I consider that the misrepresentation that AG's goods derive from Zaks has the potential to result, within the local area, in a misdirection of sales and the potential for damage to Zak's goodwill.

204. The opposition based on section 5(4)(a) of the Act succeeds in full.

Final remarks

205. The opposition has been successful, and subject to any successful appeal the applications will be refused in full.

COSTS

206. Within the revocation proceedings both parties have achieved a relatively equal level of success, and as such I make no cost award in respect of this element of the proceedings.

207. In respect of the opposition proceedings, Zaks has been entirely successful and is entitled to a contribution towards its costs. In the circumstances I award Zaks the sum of £1350 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee:	£200
Preparing and filing the TM7 and considering the TM8 and counterstatement:	£350
Preparing and filing evidence:	£800
Total:	£1350

208. I therefore order A.G. PARFETT & SONS LIMITED to pay ZAKS (UK) Limited the sum of £1350. The above sum should be paid within twenty-one days of the expiry of

the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 8th day of February 2023

**Rosie Le Breton
For the Registrar**

Annex A

Class 6: Key rings of common metal.

Class 25: Clothing, namely t-shirts, shirts, sweatshirts, polo shirts, sport shirts, jackets and caps.

Class 29: Meat and meat products; hamburgers; fish and fish products; poultry and game; fresh and pre-prepared meals and snacks containing the aforementioned goods; preserved, frozen, dried and cooked fruits and vegetables; salads; milk and milk products including milkshakes; milk based desserts.

Class 30: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; prepared meals, snacks and desserts containing the aforementioned goods; prepared meals containing principally pasta; ice cream and desserts.

Class 32: Non-alcoholic beverages; fruit juices; water; beer.

Class 33: Alcoholic beverages except beer.

Class 35: Business administration and management services; business administration and management support services provided to owners of franchised businesses; business services including the management and running of a franchise network; advertising and promotional services; business advisory services relating to the franchising of restaurant services; retail services in connection with the sale of food.

Class 43: Restaurant services incorporating licensed bar facilities; restaurant services for the provision of fast food; restaurant services specialising in American cuisine; café, snack bar and take away food services.