

O-0718-23

**TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3699224
BY CASA TUA HOLDING I LLC
TO REGISTER**

The image shows the handwritten trade mark 'Casa ♥ Tua'. The word 'Casa' is on the left, followed by a heart symbol, and the word 'Tua' is on the right. The handwriting is in a cursive, black ink style.

**AS A TRADE MARK IN CLASS 43
AND
OPPOSITION THERETO (UNDER NO. 430934)
BY
GIUSEPPE MIGGIANO**

BACKGROUND

1) On 22 September 2021, an application was made to register the following trade mark in the UK, in respect of the services shown below:



Class 43: Hotel services; Restaurant services.

The application was filed pursuant to Article 59 of the 'Withdrawal Agreement' between the UK and the European Union and the EU filing date was 04 May 2020. The application also claims a priority date of 04 November 2019 (from France). The application currently stands in the name of Casa Tua Holding I LLC ('the applicant')¹.

2) The application was published in the Trade Marks Journal on 26 November 2021 and notice of opposition was later filed by Giuseppe Miggiano ('the opponent'). The opponent claims that the trade mark application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The following trade mark registration is relied upon:

UKTM No. 3116529

Casa Tua

Class 43: Fast-food restaurants; Delicatessens [restaurants]; Rental of food service equipment; Provision of information relating to restaurants; Rental of food service

¹ As per the Form TM16 filed on 07 September 2022 which recorded a transfer of ownership of the contested application from the original applicant to Casa Tua Holding I LLC (the relevant transfer having taken place on 2 August 2022). The necessary undertakings were filed on behalf of the latter on 03 October 2022 in which it was confirmed that Casa Tua Holding I LLC i) has had sight of all relevant forms and evidence, ii) stands by the statements made in the counterstatement and iii) is aware of, and accepts liability for, costs.

apparatus; Provision of food and drink in restaurants; Restaurants; food takeaway service; Agency services for reservation of restaurants; Providing reviews of restaurants and bars.

Filing date: 6 July 2015

Date of entry in the register: 16 October 2015

3) The trade mark relied upon by the opponent is an ‘earlier’ mark, in accordance with section 6 of the Act. As it had not been registered for five years or more at the priority date of the application, it is not subject to the proof of use conditions as per Section 6A of the Act.

4) The applicant filed a counterstatement stating that the marks are dissimilar. It concedes that there is some overlap between the parties’ services but submits that its ‘hotel services’ are dissimilar to the opponent’s services.

5) The opponent is represented by Withers and Rogers LLP. The applicant is represented by Morgan, Lewis & Bockius UK LLP. Neither party has filed any evidence in these proceedings. The applicant filed written submissions during the evidence rounds². The opponent has filed nothing beyond the notice of opposition. Neither party requested a hearing; only the applicant filed submissions in lieu³. I now make this decision after considering all the papers before me.

DECISION

6) Section 5(2)(b) of the Act states:

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

(a)....

² On 31 January 2023

³ On 22 March 2023

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

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

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Case law

7) 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 on in these proceedings are derived from an EU Directive. Accordingly, it is appropriate, in this decision, to refer to the trade mark case law of EU courts.

8) The leading authorities which guide me are from the Court of Justice of the European Union: *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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

9) All relevant factors relating to the services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment:

“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.”

10) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

(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.

11) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if 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..”

In *Sanco SA v OHIM* Case T-249/11, the General Court found that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services was very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* (BL-0-255-13):

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

12) The services to be compared are:

Opponent's specification	Applicant's specification
<p>Class 43: Fast-food restaurants; Delicatessens [restaurants]; Rental of food service equipment; Provision of information relating to restaurants; Rental of food service apparatus; Provision of food and drink in restaurants; <u>Restaurants</u>; food takeaway service; Agency services for reservation of restaurants; Providing reviews of restaurants and bars. (my emphasis)</p>	<p>Class 43: Hotel services; Restaurant services.</p>

13) The applicant's 'Restaurant services' are self-evidently identical to the opponent's 'Restaurants'.

14) Turning to the applicant's 'Hotel services', it seems to me that the opponent's strongest case lies with its 'Restaurants'. Although the core purpose of the respective services is not the same (the applicant's services being for the primary purpose of providing temporary accommodation and the applicant's being for the purpose of providing food and drink), the respective users will be the same (the general public) and the trade channels may converge. Indeed, it is not uncommon, in my experience, for hotels to have restaurants on their premises which are available for their customers/other members of the public to use. Bearing this in mind, there is also, in my view, a certain degree of complementarity between the respective services because the opponent's 'restaurant services' may be important for the provision of the applicant's 'hotel services' in such a way that the average consumer

believes that the responsibility for both lies with the same undertaking. I find a medium degree of similarity between the applicant's 'hotel services' and the opponent's 'restaurants'.

Average consumer and the purchasing process

15) It is necessary to determine who the average consumer is for the respective services and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

16) The average consumer of restaurant services and hotel services is the general public. Their cost is likely to vary depending on the particular kind of hotel/restaurant in question. Generally speaking, though, I would expect a medium degree of attention to be paid during the purchase. The services are likely to be sought out primarily by eye, such as on the high street or on websites and so I would expect the purchase to be mainly visual. However, I bear in mind that the services may sometimes be the subject of word-of-mouth recommendations or telephone bookings and so aural considerations are also borne in mind.

Comparison of marks



17) 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 CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

18) The marks to be compared are:

Opponent's mark	Applicant's mark
	

19) The earlier mark consists of the words ‘Casa Tua’ with each of those words being underlined. The words are presented in a fairly ordinary kind of font. The overall impression of that mark is dominated by the words themselves with the particular font-style and underlining playing a much lesser role.

20) The contested mark consists of the words ‘Casa Tua’ along with the device of a heart which is positioned in between those two words. The words and device have a hand-written kind of presentation. The overall impression of the mark is dominated by the words. The heart also contributes to the mark’s overall impression but to a

lesser extent than the words. The hand-written presentation makes the least contribution to the overall impression of the mark.

21) Visually, both marks contain the two words 'Casa Tua'. The visual differences arise due to the different font-styles, the underlining in the earlier mark which is absent from the contested mark and the presence of the heart device in the contested mark which is not present in the earlier mark. Despite the latter differences, I find a high degree of visual similarity between the marks overall.

22) Aurally, the only element of both marks that is likely to be articulated is the words 'Casa Tua'. They are aurally identical.

23) Conceptually, the heart device in the applicant's mark brings to mind the concept of love/romance and creates a point of conceptual difference between the marks. I would expect the average consumer to perceive 'Casa Tua' as being a foreign phrase. However, I would not expect the average UK consumer to understand what the phrase means and there is no evidence before me to suggest otherwise. Those words are therefore unlikely to evoke any immediately graspable concept and, as such, are conceptually neutral. However, if I am wrong, and the average consumer does immediately perceive a concept from 'Casa Tua', any such concept would be the same in both marks and, overall, the marks would be conceptually very highly similar (allowing for the point of conceptual difference created by the heart device).

Distinctive character of the earlier mark

24) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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)."

The opponent has filed no evidence and therefore I have only the inherent degree of distinctiveness of the mark to consider. The earlier mark does not appear to me to be obviously descriptive or allusive in relation to the earlier services and there is no evidence before me to suggest otherwise. I find it to have a normal degree of inherent distinctiveness.

Likelihood of confusion

25) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

26) The parties' services are either identical or similar to a medium degree. The marks are visually highly similar and aurally identical. Conceptually, if the words 'Casa Tua' are perceived as meaningless, and therefore neutral, the heart device creates some conceptual difference between the marks overall. However, if I am wrong on that, and 'Casa Tua' does evoke an immediately graspable concept, that concept will be the same and the marks are conceptually very highly similar overall. The earlier mark also has a normal degree of distinctiveness. Taking all of these factors together, I find that an average consumer paying a medium level of attention is likely, through imperfect recollection, to mistake one mark for the other, whether they perceive the marks as being conceptually similar or not. **There is a likelihood of direct confusion.**

27) In case I am wrong about the consumer being directly confused, and the average consumer does recognise that the marks are not the same, I will consider the likelihood of indirect confusion. In this connection, I bear in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., sitting as the Appointed Person, explained that:

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

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)".

It must be borne in mind that the categories above are, of course, not an exhaustive list of all the ways in which indirect confusion can occur. They are merely examples of the way in which it tends to occur.

28) I also keep in mind that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

29) Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

30) In the event that the consumer realises that the marks are not the same (because they notice the different presentations of the words, the presence/absence of the underlining and the presence/absence of the heart device) they are, nevertheless, highly likely to believe that they are simply variant marks used by the

same undertaking in respect of the relevant services. **The opposition under Section 5(2)(b) of the Act succeeds in full.**

COSTS

31) As the opponent has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

Preparing a statement and considering the other side's statement	£200
Official fee (Form TM7)	£100
Total:	£300

32) I order Casa Tua Holding I LLC to pay Giuseppe Miggiano the sum of **£300**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of July 2023

**Beverley Hedley
For the Registrar,
the Comptroller-General**