

O-075-17

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK REGISTRATION NO 3117388

IN THE NAME OF NOOR MUHAMMAD USMAN NOORI

FOR

THE TRADE MARK



IN CLASS 43

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THEREOF (UNDER
NO. 501057)**

BY

WASEEM GHAS

Background

1) Noor Muhammad Usman Noori ('the proprietor') is the proprietor of the following trade mark registration in respect of *Restaurant Services* in class 43:



2) The trade mark was applied for on 12 July 2015. It was subsequently published in the Trade Marks Journal for opposition purposes on 7 August 2015 and entered on the register on 16 October 2015.

3) Waseem Ghias ('the applicant') claims that the trade mark registration offends under sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 ('the Act') and should therefore be declared invalid. In support of the first two grounds, the applicant relies upon the following five earlier marks:

- UK registration 2628714 for the mark **GRILLER** which has a filing date of 19 July 2012 and was entered in the register on 26 October 2012. The following services are relied upon:

Class 43: Services for providing food and drink; eat-in or take-away restaurants; online services for eat-in or take-away restaurants; fast-food restaurant services; quick-service restaurant services; food and drink preparation services; providing prepared meals; providing drinks; preparation of foodstuffs or meals for consumption on or off the premises; food and drink takeaway services; booking/reservation services for restaurants; self-service restaurants; cafés, cafeterias, canteens, snack bars; catering services; restaurant services; bar services.

- UK registration 2326754 for the mark  which has a filing date of 15 March 2003 and was entered in the register on 24 October 2003 ('the Griller device'). The following services are relied upon:

Class 43: Restaurant, bar and catering services; booking/reservation services for restaurants and holiday accommodation, services for providing food and drink.

- International registration 1096292 for the mark  which designated the EU for protection on 8 August 2011 and protection was subsequently conferred on 26 September 2012. The following services are relied upon:

Class 43: Restaurant, bar and catering services; booking/reservation services for restaurants and holiday accommodation, services for providing food and drink.

- UK registration 3056361 for the mark **Griller Grillo** which has a filing date of 20 May 2014 and was entered in the register on 05 September 2014. The following services are relied upon:

Class 43: Services for providing food and drink; eat-in or take-away restaurants; online services for eat-in or take-away restaurants; fast-food restaurant services; quick-service restaurant services; food and drink preparation services; providing prepared meals; providing drinks; preparation of foodstuffs or meals for consumption on or off the premises; food and drink takeaway services; booking/reservation services for restaurants; self-service restaurants; cafés, cafeterias, canteens, snack bars; catering services; restaurant services; bar services.



- UK registration 2376629 for the mark which has a filing date of 26 October 2004 and was entered in the register on 25 March 2005. The following services are relied upon:

Class 43: Restaurant, bar and catering services, booking/reservation services for restaurants and holiday accommodation, services for providing food and drink.

4) All of the marks set out above are earlier marks in accordance with section 6 of the Act. The marks at the second and fifth bullet points above had been registered for more than five years before the publication date of the applicant's mark and are therefore subject to the proof of use requirements, as per section 6A of the Act. The opponent made a statement of use for all of the services relied upon.

5) Under section 5(4)(a), the applicant relies upon the use of five signs which are the same as the registered marks set out above and, additionally, upon the use, since Sept 2013, of the following unregistered sign in relation to *Restaurant services, fast-food restaurant services*:



It is claimed that the applicant has goodwill associated with those signs such that the use of the proprietor's mark is liable to be prevented under the law of passing off.

6) Under section 3(6), the applicant claims that the proprietor is/was a director of a company which was a former franchisee of his in the United Arab Emirates. He further states that the proprietor was well aware of his use in the UK of the marks

referred to above and of his extensive GRILLER franchise network in the UK at the date of filing of the contested mark. As such, he claims that the making of the application falls short of the standards of acceptable commercial behaviour amounting to an act of bad faith.

7) The proprietor filed a counterstatement denying the grounds of invalidation. In particular, the following points are made:

- The proprietor states he has “incontrovertible evidence” that the contested mark was developed solely by him and that he has been using it for over a year.
- The respective marks are totally different and the word “Griller” is a common English word which means a person who grills food, especially as a cook in a restaurant or an appliance for grilling food.
- The proprietor requests that the applicant provide proof of use for the earlier marks which are subject to the proof of use provisions.

8) The applicant filed evidence in chief. The proprietor filed written submissions. I note that, within those submissions there are also a number of statements of fact and images showing photographs of restaurant frontage and menus. None of this information is accompanied by a statement of truth but I have nevertheless borne it in mind for what it is worth. The applicant responded by filing evidence in reply. Both parties request an award of costs.

9) A hearing took place before me on 22 November 2016 at which the applicant was represented by Mr Chris Pearson, of Counsel and the proprietor by Ms Georgina Messenger, of Counsel, instructed by Elegant Solicitors. At the hearing, I granted leave to the proprietor to file a copy of a license document for the company ‘Grillo The Healthier Option LLC’ as further evidence. Ms Messenger explained that the purpose of the document was to respond to a point made by the applicant in its evidence in reply and to show that the current name of the company on the license is Grillo The Healthier Option LLC, having been changed to that name in April 2014. The said document was filed after the hearing but it is not in evidential form with a

statement of truth. Nevertheless, I have borne it in mind. For reasons which will become apparent, it does not assist the proprietor in any event. The applicant responded to that evidence at the hearing by way of oral submission. However, the day after the hearing, it also filed a number of emails and attachments. These are not in proper evidential form. The proprietor objected to the content of those emails being taken into account as leave to file them had not been requested or granted. I have reviewed the content of the emails and attachments. Insofar as they are in direct response to the proprietor's further evidence I note that they essentially concede to the proprietor's claim that it changed its company name in April 2014. To that extent I have borne them in mind.

Evidence

Applicant's evidence in chief

10) This consists of a witness statement in the name of the applicant with one lengthy exhibit. The evidence runs to more than 500 pages. Much of it relates to the use that the applicant has made of all of the earlier marks relied upon. Rather than summarise the evidence on that issue here, I will refer to it if, and when, it becomes necessary to do so in the decision which follows. I will, however, summarise here the evidence relating to certain pertinent issues, as follows:

i) The development of the applicant's griller franchise in the UK,

- The applicant explains that he has been in the fast food business since 1995 mainly operating fried chicken outlets. In 2002 he started to look at ways of providing healthier options and he thought of providing grilled chicken products and those which have a fried-style taste but are not fried. In 2003 he developed and registered the GRILLER name and GRILLER device which he used above his shop in Essex. In 2005 three franchises also opened; two in Essex and another in London. Thereafter, the GRILLER brand went from strength to strength with a number of further franchises opening from 2007 in London and further afield to places such as Bedford, Luton, Leeds, Milton Keynes, Coventry, Cardiff and Blackburn. A list of all the franchise addresses

is provided at p.23 of exhibit 1. There are 31 in total (the applicant states that 28 of these are still in operation). Trade start dates range from 2003 to 2016. The applicant states that all GRILLER outlets bear the GRILLER mark or GRILLER device on the sign above the shop front. Photographs are provided at p.171-188 of exhibit 1 showing examples of such use.

- The applicant estimates the combined turnover of the franchises to be over £2.5 million.
- In terms of the mark GRILLER GRILLO, the applicant states that he created this mark in 2013. It was first used in that year at the GRILLER head office and at selected GRILLER restaurants and was later rolled out across the GRILLER franchise in 2014. GRILLER GRILLO is said to appear in the main menu boards, in displays in windows and on menus. Examples of use are provided at p.386 – 393 of exhibit 1.
- The applicant explains that it is not possible to provide turnover figures relating solely to the GRILLER GRILLO mark but confirms that it is used to designate a particular section of products and is firmly associated with the GRILLER brand.

ii) The applicant's relationship with the proprietor and other issues pertaining to the claim of bad faith.

- The applicant explains that the proprietor is a former franchisee of his in Dubai. Prior to entering in to the franchise agreement, the proprietor had visited London many times and had often eaten at GRILLER restaurants. It was this that prompted the proprietor to express a desire to start a GRILLER food business in Dubai.
- The applicant provides a copy of a license agreement dated 25 March 2012 between himself and Tooba Restaurants LLC ('Tooba'). He explains that the proprietor is a director and controlling mind of that company. The agreement is for the license of the following trade marks in the United Arab Emirates:



In early 2014 the relationship between the applicant and the directors of Tooba turned sour. The applicant explains that it became clear that the proprietor (along with a co-director) wanted to depart from the GRILLER formula and do their own thing, including changing the GRILLER recipes. The license agreement was terminated on 17 April 2014.

- The applicant states that, shortly after the agreement was terminated in April 2014, the proprietor changed the signage at the GRILLER outlet in Dubai to the contested mark.
- On 12 July 2015 the proprietor filed the application to register the contested mark. The applicant explains that he did not notice this in time to file an opposition against its registration. On 29 October 2015 the applicant wrote to the proprietor warning him of these invalidation proceedings and asking him to sign a letter of undertakings. The letter refers to the goodwill and reputation enjoyed by the GRILLER brand in the UK since 2005 and to the goodwill associated with the name GRILLER GRILLO having been used since 2013. The letter is attached at p.477 – 481 of exhibit 1.
- The applicant states that the proprietor remained defiant and proceeded to launch a Facebook page entitled Grill'o. On 29 November 2015 (one month after the above letter was sent to the proprietor) a post appeared on that page publishing a copy of a trade mark Registration Certificate from the UK Intellectual Property Office. The applicant provides a copy of a screenshot of that post (which was accessed and printed on 02 December 2015) and a close up of the certificate in that post which is reproduced below:

TRADE MARKS
REGISTRY



REGISTRATION
CERTIFICATE

Trade Mark Act 1994 of

Great Britain and Northern Ireland

I certify that the mark shown below has been registered under No. UK00003117388 effective as of the date 12/07/2012 and has been entered in the register on 16/10/2012

Signed this day at my direction



JOHN ALTY
REGISTRAR

Representation of Mark



The mark has been registered in respect of:
Class 43:
Restaurant services.

In the name of GrillO The Healthier Option

Intellectual Property Office is an operating name of the Patent Office

The certificate shows a filing date of 12/07/2012 and registration date of 16/10/2012 for mark no.UK0003117388 (this is the same trade mark number as the contested registration). The name of the proprietor is stated to be 'GrillO The Healthier Option'. The applicant states that this certificate is obviously a forgery since no such mark was ever registered in the name of that proprietor or from the date given in that certificate. The applicant states that this casts bad light back over the whole of the proprietor's dealings with him.

- The applicant states that, at the date of filing of the contested mark, the proprietor knew that he had no right to use the GRILLER branding or anything confusingly similar to any of the marks used by the applicant.

Proprietor's unsworn evidence

11) The pertinent factual information in the proprietor's written submissions can be summarised as follows:

The proprietor states that he has been running a restaurant with the name GRILLO THE HEALTHIER OPTION as a Limited Liability Company in Dubai since 2012 and that the company is duly registered under the Department of Economic Development, Dubai with license no 667534. I note that no copy of the said license is provided.

He further states that the applicant 'intentionally' changed the headings on menus in his Griller restaurant from "Griller Peri Peri" to "Griller Grillo" in 2015 after the contested mark was filed. He asserts that this was done in bad faith to affect his business. Two images of menus are provided in support of this claim; neither are dated.

The proprietor asserts that he has evidence to establish the fact that the contested mark was developed solely by him. He explains that he has been using the mark for over a year (since April 2014) and that it has been registered in more than three countries since then.

A list of 13 trade mark registrations is provided containing the word 'Grill' which is said to show that this word is very common in the restaurant business

Applicant's evidence in reply

12) This consists of a second witness statement in the name of the applicant. The applicant states, inter alia, that the proprietor's claim to have run a restaurant under the name GRILLO THE HEALTHIER OPTION, as a limited liability company in Dubai

under license no 667534 since 2012, is false. In support of this he exhibits a copy of a license showing that license number 667543, issued on 20 March 2012, is for Tooba Restaurants LLC ('Tooba'). Whilst the day and month of the 'print date' of the license is not clear on the faxed copy of the evidence before me, the year '2012' is visible in that date. He refers back to his evidence in chief showing that Tooba is the company to which he granted a license to operate a GRILLER franchise in Dubai and that the proprietor was a director of Tooba.

Proprietor's unsworn evidence filed after the hearing

13) This consists of a copy of license no 667534 showing the name of the company as GRILLO THE HEALTHIER OPTION LLC. The print date of the document is 19 April 2016. Ms Messenger stated that the purpose of the document is to address the point made by the applicant in its evidence in reply and to clarify that the current name of the company under license no 667534 is GRILLO THE HEALTHIER OPTION LLC, having been changed to that name in April 2014. It was conceded that the license had originally been in the name Tooba from 20 March 2012 (as shown on the copy of the license in the applicant's evidence) until that date. The relevant part of the hearing transcript reads:

"MISS MESSENGER: ...The licence was originally in the name of Tooba. It was changed to GRILLO, The Healthier Option LLC in April 2014 when the agreement between our client and the applicant came to an end."

Applicant's emails in response

14) At the hearing, the applicant had submitted that the license document submitted by the proprietor must be a forgery given that it was the applicant's understanding that the name of a company could not be changed on such a license in Dubai. However, in the emails filed the day after the hearing, the applicant now accepts, having sought advice on the matter, that a company name can be changed on payment of a fee. More specifically, it accepts the proprietor's claim that the company name on the license was changed in April 2014 from Tooba to Grillo The Healthier Option LLC.

Section 5(2)(b)

15) Sections 5(2)(b) and 47 of the Act provide:

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

(a)

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

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

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).”

16) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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.

Approach

17) I consider it appropriate to deal first with the assessment of the likelihood of confusion between the proprietor's mark and the applicant's **Griller Grillo** mark. I will only consider the other marks relied upon in the event that the applicant is unsuccessful on that basis.

Comparison of services

18) The proprietor's *Restaurant services* are clearly identical to the applicant's *Services for providing food and drink*.

Average consumer and the purchasing process

19) It is necessary to determine who the average consumer is for the respective goods and 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.”

20) The average consumer for the services at issue is the general public. Their cost is likely to vary depending on the establishment and the kind of food and drink provided. However, I would not expect the services to ever be a highly considered one. Generally speaking, I would expect an average degree of attention to be paid during the purchase. The services are likely to be sought out primarily by eye 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

21) 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 therefore be wrong to artificially 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. The marks to be compared are:

Griller Grillo

v



22) The applicant's mark consists of the words Griller Grillo in a standard font. The two words do not naturally combine to form a unit with a meaning that is different to the two words taken separately; each word retains an independent distinctive role. Ms Messenger submitted that the mark is dominated by the word Griller given that Grillo is no more distinctive than that word, being essentially the word 'grill', and that the average consumer will generally pay more attention to the first word of a mark. In the alternative she argued that neither word is more dominant than the other. My own view accords with the latter argument. Although Griller is at the beginning of the mark, and it is this part of the mark which generally attracts the greater degree of attention, in the instant case, this is tempered to a certain extent by that word sending a strong evocative message of a person or thing that grills (a message which is not particularly distinctive in relation to the relevant services for obvious reasons). Whilst Grillo sends a similar evocative message of something grilled/the act of grilling, the evocation is weaker given what appears to be the invented nature of that word; it has greater distinctiveness than Griller. I find that all of these factors combine to result in the two elements making a roughly equal contribution to the overall impression of the mark.

23) As Ms Messenger submitted¹, the proprietor's mark breaks down into three main elements. The first is the word Grill'o presented in red with flames emanating from the letter 'o'. The second is the chicken device presented in red, white and yellow. The third is the words 'The Healthier Option'. The latter has very little weight in the overall impression given its relative size and positioning to the other elements and the descriptive message that it sends. Both the Grill'o element and the chicken

¹ Paragraph 13 of Ms Messenger's skeleton argument refers.

device are distinctive. Ms Messenger argued that the chicken device is no less dominant than the words in the mark. The chicken device certainly makes an important contribution to the overall impression of the mark. However, in my view, Grill'o has greater visual prominence and it is also the element by which the average consumer is likely to refer to the mark. Grill'o has greater weight than the chicken device in the overall impression.

24) On the point of visual similarity, Ms Messenger drew my attention to the flames emanating from the letter 'o' in the proprietor's mark such as to emphasise that letter and draw the eye through Grill'o instantly to read it as a complete word. This, she submitted, is in contrast to the Grillo element of the applicant's mark where the 'o' is not emphasised in any way. In her submission, the general rule that the consumer will tend to pay more attention to the beginning of a word applies to Grillo in the applicant's mark such that the visual impact of that element is essentially of the word Grill. I agree that Grill'o in the proprietor's mark is likely to be instantly read through as a complete word. Whilst, I also agree that it is a general rule of thumb that the beginnings of words will tend to have the greater impact on the perception, whether that rule applies will depend on the circumstances of the case. In my view, all of the letters of the Grillo element in the applicant's mark, which is a fairly short word, strike the eye with roughly equal force. I find that the presence of Grillo/Grill'o in the respective marks is a clear point of visual similarity notwithstanding the presence/absence of the apostrophe and the flames. The presence of the word Griller at the beginning of the applicant's mark and the chicken device and 'The Healthier Option' in the proprietor's mark are all points of visual difference. On the whole, I find there to be a medium degree of visual similarity.

25) Aurally, Ms Messenger contended that the letter 'o' is likely to be dropped from the second element of the applicant's mark such that the mark, as a whole, may be vocalised as GRILL-ER GRILL or, even, GRILL GRILL. I am not persuaded by this argument. In my view, the mark is likely to be pronounced GRILL-ER GRILL-OH. As regards the proprietor's mark, I agree with Mr Pearson that the average consumer is unlikely to vocalise all of the verbal elements within that mark. It is more likely that only the Grill'o element will be referred to which will be pronounced as GRILL-OH.

The chicken device is also unlikely to be vocalised. I find there to be a medium degree of aural similarity.

26) Conceptually, both elements in the applicant's mark send an evocative message, as identified above (albeit that this message is stronger from the first element than the second). Turning to the proprietor's mark, I do not consider that the descriptive words 'The Healthier Option' are likely to form part of the immediate conceptual hook. Ms Messenger accepted that there is a degree of conceptual similarity between the respective marks owing to the connotation of something grilled/the act of grilling evoked by the Grill'o element of the proprietor's mark. However, she submitted that the presence of the chicken device in the proprietor's mark also creates some conceptual dissimilarity as it conjures up the specific idea of grilled chicken. I accept that the chicken device introduces a degree of conceptual difference. However, I still consider there to be a good degree of conceptual similarity between the marks overall.

Distinctive character of the earlier mark

27) 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).”

28) In the light of the strong evocative message sent by the Griller element and the obvious relevance of that message to the services at issue, it is an element with low distinctiveness. Grillo appears to be an invented word. Although it sends a similar evocative message to the Griller element, that message is weaker. I find that the mark as a whole, and the Grillo element of itself, has an average level of inherent distinctiveness.

29) Turning to the question of whether the mark’s inherent distinctiveness has been elevated through the use made of it, I note that in his evidence, the applicant states that the Griller Grillo mark was first created and used in 2013. He further explains that the mark has been used at his head office and selected GRILLER restaurants since that time and, more widely, across the GRILLER franchise since 2014. He goes on to state that Griller Grillo appears in main menu boards in GRILLER outlets, in displays in GRILLER outlet windows and in GRILLER menus and provides a number of photographs showing examples of that use. There are no turnover figures relating specifically to this mark. Whilst I accept that it has been used by the applicant in the manner shown in the evidence, the duration, geographical extent and nature of that use is insufficient to satisfy me that the distinctiveness of the mark has been materially enhanced.

Likelihood of confusion

30) 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 goods and services may

be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) 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.*).

31) I am not persuaded that the respective marks are likely to be directly confused owing, in particular, to the degree of visual similarity which I pitched at only a medium level; even allowing for imperfect recollection, an average consumer paying an average degree of attention is unlikely to mistake one mark for the other.

I now turn to consider whether there is nevertheless a likelihood of indirect confusion. I have found that, whilst perceiving the whole of the proprietor's mark, Grill'o is nevertheless the element that is likely to have the greatest impact on the average consumer's perception. I also found that, when perceiving the whole of the applicant's mark, the average consumer is likely, at the same time, to perceive the Grillo element as having independent significance; an element which is, of itself, averagely distinctive and has roughly equal weight with the word Griller in the overall impression of the mark. Bearing these factors in mind, together with the identity between the services, I find that, whilst the marks will be perceived as a whole, the respective Grillo and Grill'o aspects within them are likely to indicate to the average consumer that the respective services emanate from the same or linked undertaking(s). In other words, there is a likelihood of indirect confusion. **The ground under section 5(2)(b) succeeds.**

Section 3(6)

32) Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

33) The law in relation to this section of the Act was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C- 529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, *inter alia*, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

34) The applicant's position is that it had been using Griller Grillo since 2013 at its head office in the UK and at selected restaurants on menus, main menu boards and in window displays and that the proprietor was aware of that use. The proprietor denies this. He states (in unsworn form) that the contested mark was developed solely by him in April 2014 when the franchise agreement came to an end in an attempt to distinguish himself from the applicant's GRILLER franchise and marks and that he understood that the applicant began using the Griller Grillo mark after he applied for the contested registration in 2015.

35) The following factors are also relevant:

i) The registration certificate in the applicant's evidence posted on the proprietor's Facebook page in November 2015. That certificate states that the contested mark had been registered from 2012 in the UK in the name of Grillo The Healthier Option. As the applicant has pointed out, no such mark was ever registered at that date under that name. At the hearing, Ms Messenger submitted that the proprietor was not aware of that certificate being displayed or the date change in it and confirmed that it is not on Facebook anymore. She also stated that the post appears "odd" as it looks to have been pasted over a background rather than being a shot of the page. Mr Pearson pointed out that the post is exhibited to the applicant's witness statement which bears a statement of truth and that the address of the post can clearly be seen on the bottom left-hand-side. Accordingly, he submitted, there is nothing to suggest that this is not what it looks like, namely, a real post from the proprietor's Facebook page showing a forged certificate. I agree with Mr Pearson. Although the post emanates from after the relevant date, it indicates to me a willingness by the proprietor to be untruthful in relation to its trade mark rights.

ii) The issue of the name of the proprietor's Limited Liability Company in Dubai under license number 667534. The proprietor had initially claimed that the name of that company had been Grillo The Healthier Option LLC since 2012. The relevance of this is that, if true, it would have indicated that the proprietor had coined the name Grillo prior to the applicant coining its Griller Grillo mark in 2013. However, not only was this claim made in unsworn form, but no copy of the said licence was provided to support this assertion. Moreover, the applicant subsequently showed the proprietor's claim to be false by evidencing a copy of the said license showing the name of the company as Tooba in 2012. It was not until the hearing that Ms Messenger conceded for the proprietor that the license had originally been in the name Tooba since 2012 and was not changed to Grillo The Healthier Option LLC until April 2014. It seems to me that the initial claim made by the proprietor was therefore untruthful or, at the very least, was clearly misleading. Either

way, it is a factor which has also led me to doubt the proprietor's version of events, none of which has been provided in sworn form in any event.

36) I see no reason to doubt the applicant's sworn claim to have used its Griller Grillo mark in the UK since 2013 in the manner shown in its evidence. Whilst it does not appear that the proprietor used that particular mark during his time as a franchisee in Dubai, in all of the circumstances, I consider it more likely than not that he was aware of the applicant's use of it in the UK. I find that, in the light of that knowledge, the application for the contested mark containing the distinctive stylised word Grill'o as the most dominant element, after the relationship between the parties had broken down, was an act of bad faith. **The claim under section 3(6) of the Act succeeds.**

37) Given the conclusions already reached, I do not consider it necessary to assess the other grounds of invalidation.

SUMMARY

38) The application for invalidation succeeds.

COSTS

39) The applicant has been successful and is therefore entitled to an award of costs. As there is no legal representative recorded for the applicant on the case file, at the conclusion of the evidence rounds, he was informed that, if he wished a cost award to be made in his favour, he should complete and return a 'Tribunal Cost Pro Forma' setting out a breakdown of the time he had spent dealing with these matters. In the completed form returned by the applicant, he not only details the time he has spent on the matter but also the amount he has spent on Counsel's fees. Although no receipts have been submitted in support of the claim to have appointed counsel throughout the proceedings, I see no reason to doubt it. This is because the notice of cancellation and all of the applicant's evidence and submissions appear to me to be in keeping with those written in the style of a legal professional rather than a litigant in person. Moreover, I note that Mr Pearson's name and chambers are given at the end of at least some of the documents such as the submissions filed on 6 May 2016

and the accompanying witness statement is headed 'On behalf of the applicant'. Mr Pearson, of course, also represented the applicant at the hearing. Bearing all of this in mind, I consider it appropriate to approach the costs award on the basis of the scale present in Tribunal Practice Notice ('TPN') 4 of 2007 which is applicable to parties with legal representation and which was in force at the time of commencement of these proceedings². However, as stated in that TPN, the approach I must take is to award the applicant a contribution towards his costs rather than full compensation. I will deal with each step of the proceedings in turn:

Official fee

As stated in the TPN, the applicant is entitled to recover the full fee. I therefore award **£200**.

Preparing a statement and considering the other side's statement

The applicant claims that he spent 6 hours on this activity plus Counsel's fees of £750 (excluding VAT) for the preparation of the Form TM26(I). I consider a fair contribution to be **£300**.

Filing evidence and submissions and considering the other side's submissions

The applicant claims 21 hours in respect of this activity and a total of £1791.67 (excluding VAT) in Counsel's fees. In addition there is a claim of 16 hours spent in respect of printing, filing and serving documents and £260 in travelling costs relating to the same. I consider a fair contribution to be **£800**.

Preparing for and attending a hearing

The applicant claims an estimated 4 to 6 hours in respect of this activity and £2000 (excluding VAT) in Counsel's fees, including preparing a skeleton argument and attending the hearing. I consider a fair contribution to be **£1000**.

Total = £ 2300

² See Annex 1.

40) I order Noor Muhammad Usman Noori to pay Waseem Ghias the sum of **£2300**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of February 2017

A handwritten signature in black ink, appearing to be 'B Hedley', with a large, sweeping flourish extending to the right.

Beverley Hedley
For the Registrar,
the Comptroller-General

Annex 1

Scale of costs applicable in proceedings commenced on or after 3 December 2007

Task	Cost
Preparing a statement and considering the other side's statement	From £200 to £600 depending on the nature of the statements, for example their complexity and relevance.
Preparing evidence and considering and commenting on the other side's evidence	From £500 if the evidence is light to £2000 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party had filed a significant amount of unnecessary evidence.
Preparing for and attending a hearing	Up to £1500 per day of hearing, capped at £3000 for the full hearing unless one side has behaved unreasonably. From £300 to £500 for preparation of submissions, depending on their substance, if there is no oral hearing.
Expenses	(a) Official fees arising from the action and paid by the successful party (other than fees for extensions of time). (b) The reasonable travel and accommodation expenses for any witnesses of the successful party required to attend a hearing for cross examination.