BL O/0827/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003646064
BY HYVA KALA LTD
TO REGISTER THE TRADE MARK:

YOU ME

IN CLASS 43

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600001991
BY YANNIS MANSARI

BACKGROUND AND PLEADINGS

1. On 24 May 2021, Hyva Kala Ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 24 September 2021. The applicant seeks registration for the following services:

Class 43 Services for providing food and drink; provision of food and drink in restaurants; catering for the provision of food and drink; hotels; pubs; bars; lounge services (cocktail); café; sushi bars; wine bars; wine bar services; wine tasting services (provision of beverages); catering for the provision of food and beverages; preparation of food and drink; services for the preparation of food and drink; provision of information relating to the preparation of food and drink; temporary accommodation; restaurant services; restaurant information services; restaurant reservation services; carvery restaurant services; mobile restaurant services; fast food restaurant services; self-service restaurant services; restaurant services incorporating licensed bar facilities; restaurant services for the provision of fast food; takeaway services; take-out restaurant services.

2. The application was opposed by Yannis Mansari ("the opponent") on 1 November 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following trade mark:

ME YOU

UK registration no. UK00003453828
Filing date 23 December 2019.
Registration date 9 August 2020.
Relying upon all of the services for which the mark is registered, namely:

Class 43 FAST FOOD RESTAURANT.

3. The applicant filed a counterstatement denying the claims made.

4. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

> "(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

5. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought to file any evidence in respect of these proceedings.

6. Rule 62 (5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

7. The opponent is unrepresented and the applicant is represented by Trade Mark Wizards Limited. A hearing was neither requested nor considered necessary, and neither party filed evidence or submissions in lieu of a hearing.

8. 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. This is why this decision continues to make reference to the trade mark case law of EU courts.

DECISION

9. Section 5(2)(b) reads as follows:

> "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."

10. The earlier mark had not completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at s.6A of the Act do not apply. The opponent may rely on all of the services it has identified without demonstrating that it has used the mark.

Section 5(2)(b) case law

11. 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:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

12. The competing services are as follows:

Opponent's services	**Applicant's services**
Class 43 FAST FOOD RESTAURANT.	Class 43 Services for providing food and drink; provision of food and drink in restaurants; catering for the provision of food and drink; hotels; pubs; bars; lounge services (cocktail); café; sushi bars; wine bars; wine bar services; wine tasting services (provision of beverages); catering for the provision of food and beverages; preparation of food and drink; services for the preparation of food and drink; provision of information relating to the preparation of food and drink; temporary accommodation; restaurant services; restaurant information services; restaurant reservation services; carvery restaurant services; mobile restaurant services; fast food restaurant services; self-service restaurant services; restaurant services incorporating licensed bar facilities; restaurant services for the provision of fast food; takeaway services; take-out restaurant services.

13. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

14. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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

15. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM),* Case T-133/05, the General Court ("GC") 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 für Lernsysterne

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."

16. 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."

17. I bear in mind the following applicable principles of interpretation from *Sky v Skykick* [2020] EWHC 990 (Ch), paragraph 56 (wherein Lord Justice Arnold, in the course of his judgment, set out a summary of the correct approach to interpreting broad and/or vague terms):

> "(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.
>
> (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.
>
> (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

Restaurant services for the provision of fast food; fast food restaurant services.

18. I consider that the opponent's "FAST FOOD RESTAURANT" services are self-evidently identical to the applicant's above services.

Services for providing food and drink; provision of food and drink in restaurants; catering for the provision of food and drink; catering for the provision of food and beverages; preparation of food and drink; services for the preparation of food and drink; restaurant services.

19. I consider that the opponent's "FAST FOOD RESTAURANT" services falls within the applicant's above broader terms. They are identical on the principle outlined in *Meric*.

Carvery restaurant services; self-service restaurant services; restaurant services incorporating licensed bar facilities.

20. I consider that the opponent's "FAST FOOD RESTAURANT" services are similar to the applicant's above services. All of the services are types of restaurant services, and therefore overlap in nature, method of use, purpose and user. I also consider that there may be an overlap in trade channels. The services are not complementary, however, they may be, to some-extent, in competition, as the user will chose between the different establishments to dine at. I therefore consider that they are similar to a high degree.

Takeaway services; take-out restaurant services.

21. I consider that the average consumer will understand that the opponent's term "FAST FOOD RESTAURANT", refers to an establishment where the user can "eat in", as well as, or instead of, taking the food away for consumption off of the premises. The applicant's services are takeaway services, which may, or may not, involve fast food. I bear in mind that I must not interpret terms used for services widely, and

therefore, the parties' terms are not the same. However, I find that there is a significant overlap in terms of users, purpose and nature of service. For those "FAST FOOD RESTAURANT" services, which also provide takeaway services, there will be an overlap in trade channels. I also consider that the services may be in competition. It is my view that the services similar to between a medium and high degree.

Mobile restaurant services

22. I consider that the opponent's "FAST FOOD RESTAURANT" services are similar to the applicant's above mobile restaurant services, which would also include mobile fast-food restaurants. The services would overlap in trade channels, user and purpose as the same undertaking would provide the user with fast-food, either on its premises or via its mobile restaurant. However, the services differ in method of use, as the applicant's restaurant services are mobile, and thus the food is consumed solely off the premises. The services are not complementary but they will be in competition. Consequently, the services are similar to between a medium and high degree.

Pubs; café.

23. The applicant's above services provide the user with seating to consume their food within the premises, and therefore overlap in nature and method of use with the opponent's "FAST FOOD RESTAURANT" services. I consider that similar foods would be sold at all of these establishments, such as burgers and chips etc. However, the trade channels will clearly differ, as the services would be provided by different undertakings. The services are not complementary; however, they will be in competition. Consequently, the services are similar to at least a medium degree.

Sushi bars.

24. I consider that the opponent's "FAST FOOD RESTAURANT" services are similar to the applicant's above services. They overlap in nature and method of use, as all of the users are provided with seating to consume their food within the premises. However, they will differ in purpose, as the applicant's services provide sushi, whereas the opponent's services provide fast-foods. Therefore, the trade channels will clearly

differ. The services are not complementary, but they could be, to some extent, in competition. I therefore consider that the services are similar to no more than a medium degree.

Bars; lounge services (cocktail); wine bars; wine bar services; wine tasting services (provision of beverages).

25. The applicant's above services provide the user with seating to consume alcoholic beverages, including wine. I consider that the opponent's "FAST FOOD RESTAURANT" services would also provide the user with beverages, however, it is unlikely that they will be alcoholic. The opponent's services predominantly provides fast-food to its customers, and does not offer any type of bar-related services. Therefore the parties' services differ in nature, purpose and method of use. The services would not overlap in trade channels, as different undertakings would provide wine and bar services to fast-food restaurants. I do not consider that the services are complementary nor in competition. There may be an overlap in user, however, this is not enough on its own to establish similarity. The services are, therefore, dissimilar.

Provision of information relating to the preparation of food and drink; restaurant information services.

26. I consider that the applicant's above services provide the individual with information to enable them to choose between a variety of restaurants. Therefore, this service differs in nature, method of use and purpose with the opponent's "FAST FOOD RESTAURANT" services, which provides the consumer with seating to dine in and consume food and beverages. The same undertaking would not provide both services, and therefore they differ in trade channels. The services are neither complementary nor in competition. I note that there could be an overlap in user, however, this is not enough on its own to establish similarity. The services are, therefore, dissimilar.

Restaurant reservation services.

27. I consider that the same reasoning applies in paragraph 26 above in respect of the applicant's reservation services. I note that albeit you can call and reserve a table at

a restaurant, that this is, not what I consider to be “restaurant reservation services”. These services would be provided by third parties, which solely offer reservation services for a variety of restaurants. Therefore, the trade channels, nature, method of use and purpose differs with the opponent’s “FAST FOOD RESTAURANT” services. The services are neither complementary nor in competition. They are dissimilar.

Temporary accommodation.

28. The applicant’s services provide accommodation on a temporary basis, which could range from to an overnight stay at a hotel, but could also apply to the rental of an apartment whilst the occupant is engaged on a work placement away from their usual residence. These services, therefore, clearly do not overlap in nature, purpose, method of use or trade channels with the opponent’s “FAST FOOD RESTAURANT” services. They are neither in competition nor complementary. I note that there could be an overlap in user, however, this is not enough on its own to establish similarity. The services are, therefore, dissimilar.

Hotels.

29. I note that hotels also have facilities to serve its customers with food, however, its primary purpose is to provide the user with temporary accommodation, and therefore the same comparison applies in paragraph 28 above. The services are dissimilar.

30. It is a prerequisite of section 5(2)(b) that the services be identical or at least similar. The opposition will, therefore, fail in respect of the services that I have found to be dissimilar.[1] The opposition under section 5(2)(b) fails for the following services:

Class 43 Bars; lounge services (cocktail); wine bars; wine bar services; wine tasting services (provision of beverages); provision of information relating to the preparation of food and drink; temporary accommodation; restaurant information services; restaurant reservation services.

[1] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

The average consumer and the nature of the purchasing act

31. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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."

32. The average consumer for the services will be members of the general public. The services are likely to vary in cost and frequency of purchase. However, the average consumer will take various factors into consideration such as the cost, the type of cuisine offered and customer service standards. Consequently, the level of attention paid during the purchasing process will be medium.

33. The services are likely to be purchased following perusal of signage on premises frontage or perusal of adverts and menus online. Therefore, visual considerations are likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase of the services through word-of-mouth recommendations.

Comparison of the trade marks

34. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to

analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade 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."

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

36. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
ME YOU	**YOU ME**

37. The opponent's mark consists of the words ME YOU. The overall impression of the mark lies in the combination of these elements.

38. The applicant's mark consists of the words YOU ME. The overall impression of the mark lies in the combination of these elements.

39. The applicant submits that the marks are visually, aurally and conceptually dissimilar. However, I simply cannot agree with this assertion. Visually, both marks

consist of the words “ME” and “YOU”, but inverted. Therefore, they are visually similar to a high degree.

40. Aurally, the opponent’s mark will be pronounced as ME-YOU, and the applicant’s mark will be pronounced as YOU-ME. Consequently, the marks are aurally similar to a high degree.

41. Conceptually, albeit the words are inverted, I consider that the marks evoke the same meaning, as they consist of two ordinary dictionary words, which would be known to the average consumer. The marks are conceptually identical.

Distinctive character of the earlier trade mark

42. 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 C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, 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 promotion of 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)."

43. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

44. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

45. As highlighted above, the opponent's mark consists of the two ordinary dictionary words "ME YOU". The mark is neither descriptive nor allusive of the services. Therefore, I consider that the mark is inherently distinctive to no more than a medium degree.

Likelihood of confusion

46. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

47. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually and aurally similar to a high degree.
- I have found the marks to be conceptually identical.
- I have found the opponent's mark to be inherently distinctive to no more than a medium degree.
- I have identified the average consumer to be members of the general public who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the services.
- I have found the parties' services to be identical to similar to a medium degree.

49. Taking all of the factors listed in paragraphs 47 and 48 into account, bearing in mind that the marks are inverted versions of each other (YOU ME vs ME YOU), and the principle of imperfect recollection, I consider that the marks are likely to be mistakenly recalled or misremembered as each other. This is particularly the case given the high degree of visual similarity between the marks and the predominantly visual purchasing process. Even where aural considerations play a greater role, the higher aural similarity between the marks will have the same result. I also consider that in the absence of a conceptual hook between the marks, the average consumer will conceptualise them in the exact same way. This results in a likelihood of direct confusion, even where there is a medium degree of similarity between the services.

CONCLUSION

50. The opposition is partially successful in respect of the following services, for which the application is refused:

Class 43 Services for providing food and drink; provision of food and drink in restaurants; catering for the provision of food and drink; pubs; café; sushi bars; catering for the provision of food and beverages; preparation of

food and drink; services for the preparation of food and drink; restaurant services; carvery restaurant services; mobile restaurant services; fast food restaurant services; self-service restaurant services; restaurant services incorporating licensed bar facilities; restaurant services for the provision of fast food; takeaway services; take-out restaurant services.

51. The application can proceed to registration in respect of the following services, for which the opposition has been unsuccessful:

Class 43 Bars; lounge services (cocktail); wine bars; wine bar services; wine tasting services (provision of beverages); provision of information relating to the preparation of food and drink; temporary accommodation; restaurant information services; restaurant reservation services.

COSTS

52. Award of costs in fast track proceedings are governed by TPN 2/2015. The opponent has been successful and would normally be entitled to a contribution towards their costs. However, as the opponent is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the opponent and invited them to indicate whether they intended to make a request for an award of costs. The opponent was informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities associated with the proceedings. They were informed that "if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded".

53. The opponent did not file a completed Pro Forma. That being the case I award the opponent the sum of £100 in respect of the official fee only.

54. I therefore order Hyva Kala Ltd to pay Yannis Mansari the sum of **£100**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 31st day of August 2023

L FAYTER

For the Registrar