

BL O/0971/23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION No. 3731845

BY

ATAS CHEF & CONSULTANCY LTD

TO REGISTER THE TRADE MARK:



IN CLASS 43

-AND-

THE OPPOSITION THERETO UNDER No. 429983

BY

CHARLEIGH WHALE

Background and pleadings

1. ATAS CHEF & CONSULTANCY LTD (“**the Applicant**”) applied to register the following trade mark in the UK on 11 December 2021:



2. It was accepted and published in the Trade Marks Journal on 7 January 2022 in respect of the following services:

Class 43

Contract food services; Food preparation services; Takeaway food services; Take away food services; Fast-food restaurant services; Take-away food services; Services for providing food; Food and drink preparation services; Consultancy services relating to food; Hospitality services [food and drink]; Rental of food service apparatus; Takeaway food and drink services; Rental of food service equipment; Take-away fast food services; Take away food and drink services; Food preparation; Take-away food and drink services; Consultancy services relating to food preparation; Services for providing food and drink; Catering services for the provision of food; Fast food restaurants; Services for the preparation of food and drink; Charitable services, namely providing food and drink catering; Restaurant services for the provision of fast food; Services for the provision of food and drink; Restaurants; Restaurant services; Grill restaurants; Tourist restaurants; Self-service restaurants; Carry-out restaurants; Restaurant reservation services.

3. On 7 January 2022, Charleigh Whale (“**the Opponent**”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opposition is

based on the Opponent's trade mark shown below, which is registered in respect of services in Class 43. Details of the registration are as follows:

Representation of the mark:	BARLEY'S
Trade mark registration No.:	3721619
Type of mark:	Word mark
Filing date:	15 November 2021
Registration date:	4 February 2022

Class 43:

Food and drink catering; Catering (Food and drink -); Serving food and drinks; Providing food and drink; Catering of food and drink; Preparation of food and drink; Food and drink preparation services; Hospitality services [food and drink]; Providing of food and drink; Catering of food and drinks; Provision of food and drink; Takeaway food and drink services; Take away food and drink services; Take-away food and drink services; Services for providing food and drink; Food and drink catering for institutions; Serving food and drink for guests; Food and drink catering for banquets; Providing food and drink for guests; Arranging of wedding receptions [food and drink]; Food and drink catering for cocktail parties; Corporate hospitality (provision of food and drink); Services for the preparation of food and drink; Catering for the provision of food and drink; Services for the provision of food and drink; Preparation and provision of food and drink for immediate consumption; Catering services for the provision of food and drink; Providing food and beverages; Preparation of food and beverages; Provision of food and beverages; Providing drink services.

4. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to Section 6 of the Act.¹ However, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely upon all of the services for which its earlier mark

¹ Section 6 of the Act defines the meaning of "earlier trade mark"; in particular, section 6(2) provides that a trade mark whose registration was still pending at the time of filing the opposition, is regarded as an earlier trade mark, providing it subsequently proceeds to registration.

is protected without having to show that the mark has been used in relation to those services.²

5. The Opponent argues that the respective services are identical or similar and that the marks are similar, giving rise to a likelihood of confusion.

6. The Applicant filed a counterstatement denying the claims made.

7. Neither party filed submissions nor evidence during the evidence rounds. No hearing was requested, and neither party elected to file written submissions in lieu of a hearing. I make this decision following a careful consideration of the papers before me.

8. In these proceedings, neither party is professionally represented. Lee Brown acts as the representative for the Opponent and the Applicant acts on its own behalf.

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

Preliminary Issue

10. Whilst no formal evidence has been submitted by the Applicant, the Certificate of Incorporation of ATAS CHEF & CONSULTANCY LTD (the Applicant), dated 11 September 2019, has nonetheless entered into proceedings via the Applicant's Form TM8 'Notice of Defence and Counterstatement' which was verified by a statement of truth.

11. In its counterstatement, the Applicant states that it "*created [its] business on 11 September 2019 and [has] been registered on companies house since [that] date, the owner of Barley applied for [its] trademark years after my business was launched*".

12. The task before me under section 5(2)(b) of the Act is to compare the trade mark application with the Opponent's earlier right and decide whether sufficient similarity

² A trade mark proprietor has a period of five years from the date when their mark is actually put on the Register to put their mark into genuine use.

exists between the marks and the services at hand, such that the average consumer of the services would be confused as to their trade origin. The relevant dates for establishing whether the Opponent's mark is an earlier mark, are the filing dates of the respective marks. The Opponent's mark was filed before the contested mark (i.e. before the Applicant's mark), therefore it is an earlier mark.³ As such, the fact that the company ATAS CHEF & CONSULTANCY LTD was incorporated on 11 September 2019, can have no bearing on the task before me and I shall make no further reference to the Applicant's certificate of incorporation in my decision.

DECISION

Legislation and Case Law

13. Section 5(2)(b) and 5A of the Act are as follows:

"5(2) A trade mark shall not be registered if because-

[...]

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

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

"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."

14. I am guided by the following principles which 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*,

³ Pursuant to section 6 of the Act

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

15. In *Gérard Meric v Office for Harmonisation in the Internal Market*,⁴ (“**Meric**”), the General Court held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa (this principle equally applies to services).

16. When considering whether goods and services are similar, all the relevant factors relating to the goods and services should be taken into account. Those factors include, inter alia: the physical nature of the goods or acts of service; their intended purpose; their method of use / uses; who the users of the goods and services are; the trade channels through which the goods or services reach the market; in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and whether they are in competition with each other (taking into account how those in trade classify goods and services, for instance whether market research companies put them in the same or different sectors); or whether they are complementary to each other.⁵

17. Complementary means “*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*”

⁴ Case T- 133/05

⁵ See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case.

undertaking".⁶ I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity,⁷ and that complementarity can be clearly distinguished from 'use in combination' – the latter being where goods/services are merely used together, whether by choice or convenience (e.g. bread and butter; or wine and wine glasses⁸), this means that they are not essential for each other.

18. When interpreting the terms in a specification I bear in mind:

- (1) that it is *"necessary to focus on the core of what is described [... and that] trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise"*, although *"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 [and services] in question"*,⁹
- (2) where *"the words chosen may be vague or could refer to goods or services in numerous classes [of the Nice classification system], the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services"*,¹⁰
- (3) the following applicable principles of interpretation:

"(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.

⁶ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

⁷ *Kurt Hesse v OHIM*, Case C-50/15 P

⁸ As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL O/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."

⁹ *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12

¹⁰ *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), paragraph 94

(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.*¹¹

19. For the purposes of making a comparison, the services can be grouped together where the same reasoning applies.¹²

20. The competing services are as follows:

Opponent's services	Applied-for services
<p><u>Class 43</u></p> <p>Food and drink catering; Catering (Food and drink -); Serving food and drinks; Providing food and drink; Catering of food and drink; Preparation of food and drink; Food and drink preparation services; Hospitality services [food and drink]; Providing of food and drink; Catering of food and drinks; Provision of food and drink; Takeaway food and drink services; Take away food and drink services; Take-away food and drink services; Services for providing food and drink; Food and drink catering for institutions; Serving food and drink for guests; Food and drink catering for banquets; Providing food and drink for guests; Arranging of wedding receptions [food and drink]; Food and drink catering for cocktail parties; Corporate hospitality (provision of food and drink); Services for the preparation of food and drink; Catering for the provision of food and drink; Services for the provision of food and drink; Preparation and provision of food and drink for</p>	<p><u>Class 43</u></p> <p>Contract food services; Food preparation services; Takeaway food services; Take away food services; Fast-food restaurant services; Take-away food services; Services for providing food; Food and drink preparation services; Consultancy services relating to food; Hospitality services [food and drink]; Rental of food service apparatus; Takeaway food and drink services; Rental of food service equipment; Take-away fast food services; Take away food and drink services; Food preparation; Take-away food and drink services; Consultancy services relating to food preparation; Services for providing food and drink; Catering services for the provision of food; Fast food restaurants; Services for the preparation of food and drink; Charitable services, namely providing food and drink catering; Restaurant services for the provision of fast food; Services for the provision of food and drink; Restaurants; Restaurant services;</p>

¹¹ See *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)

¹² *Separode Trade Mark* BL O/399/10, paragraph 5.

<p>immediate consumption; Catering services for the provision of food and drink; Providing food and beverages; Preparation of food and beverages; Provision of food and beverages; Providing drink services.</p>	<p>Grill restaurants; Tourist restaurants; Self-service restaurants; Carry-out restaurants; Restaurant reservation services.</p>
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Food and drink preparation services

21. “*Food and drink preparation services; Services for the preparation of food and drink*” appear in both parties’ specifications and are therefore **identical**.

22. “*Food preparation services; Food preparation*” in the Applicant’s specification fall within the broader category of “*Food and drink preparation services*” in the Opponent’s specification. They are **identical** on the principle outlined in *Meric*.

Takeaway food and drink services

23. “*Takeaway food and drink services; Take away food and drink services; Take-away food and drink services*” appear in both parties’ specifications and are therefore **identical**.

24. “*Takeaway food services; Take away food services; Take-away food services; Take-away fast food services*” in the Applicant’s specification fall within the broader category of “*Takeaway food and drink services*” in the Opponent’s specification. They are **identical** on the principle outlined in *Meric*.

Restaurant services

25. “*Carry-out restaurants*” in the Applicant’s specification fall within the broader categories of “*Takeaway food and drink services; Services for the provision of food and drink*” in the Opponent’s specification. They are **identical** on the principle outlined in *Meric*.

26. I note that hospitality services for the provision of food and drink encompass those services provided to customers of food and drink establishments such as restaurants,

bars, etc. With that in mind, the following services in the Applicant's specification, namely:

“Restaurants; Restaurant services; Grill restaurants; Tourist restaurants; Self-service restaurants; Fast-food restaurant services; Fast food restaurants; Restaurant services for the provision of fast food”

fall within the following broad categories in the Opponent's specification:

“Hospitality services [food and drink]; Services for the provision of food and drink; Preparation and provision of food and drink for immediate consumption”.

They are therefore **identical** on the principle outlined in *Meric*.

Provision of food and drink / hospitality services

27. *“Services for providing food and drink; Services for the provision of food and drink; Hospitality services [food and drink]”* appear in both parties' specifications and are therefore **identical**.

28. *“Services for providing food; Catering services for the provision of food; Charitable services, namely providing food and drink catering”* in the Applicant's specification fall within the broader categories of *“Food and drink catering; Catering services for the provision of food and drink; Services for providing food and drink”* in the Opponent's specification. They are **identical** on the principle outlined in *Meric*.

29. *“Contract food services”* in the Applicant's specification fall within the broader categories of *“Services for providing food and drink; Hospitality services [food and drink]; Catering services for the provision of food and drink”* in the Opponent's specification. They are **identical** on the principle outlined in *Meric*.

Consultancy services

30. The Applicant's specification contains the following consultancy services:

“Consultancy services relating to food; Consultancy services relating to food preparation”.

31. Whilst I recognise that a customer of catering services and hospitality services for the provision of food are likely to ‘consult’ the food service provider (i.e. seek advice and recommendations) with regard to menu selection; and/or the preparation of the food with regard to food allergies and intolerances etc., this is not what I consider to be the scope of the Applicant’s services. Focusing on the core of what is described, it is my opinion that the ordinary and natural meaning of these terms refer to consultancy services that are likely provided by third parties, such as food consultancy agencies, that offer consultancy services to food businesses with the scope of advising on, for example: food product development and food production processes; the composition of foods such as calorific values, nutritional information and ingredient composition; or assisting food businesses to adopt, implement and maintain appropriate food safety protocols for food preparation and production.

32. Therefore their purpose, nature and method of use differs from any of the Opponent’s services, and they would not be in competition with each other. They also would not have the same user (the user of the Applicant’s services would be a food service provider, whereas the user of the Opponent’s services would be customers of food establishments, such as members of the general public).

33. Given that the users are different, the services are also not complementary. I note that, in accordance with the case-law, goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking. This presupposes that they are intended for the same public. It follows therefore that goods or services cannot be complementary if they are intended for different publics.¹³

34. The Applicant’s consultancy services are therefore **dissimilar** to the Opponent’s Class 43 services.

¹³ See *Commercy AG v OHIM – (easyHotel)*, Case T-316/07, paragraphs 57 – 58 (which was cited by the General Court in *Pucci International v OHIM — El Corte Inglés (Emidio Tucci)*, T-357/09, paragraph 50; and that paragraph of ‘*Emidio Tucci*’ was cited by the General Court in *Compagnie des montres Longines, Francillon SA v OHIM*, Case T-505/12, paragraph 58).

Restaurant reservation services

35. The same reasoning applies, as set out in my paragraphs 32 and 33 above, in respect of the Applicant's "*Restaurant reservation services*", I note that, albeit you can call and reserve a table at a restaurant / food establishment, this is not what I consider to be "restaurant reservation services". These services would likely be provided by third parties, who specialise in, and offer reservation services to restaurants and food service establishments. Therefore, the trade channels, nature, method of use and purpose differs with the Opponent's Class 43 services. The services are neither complementary nor in competition. They are **dissimilar**.

Rental of food service apparatus / equipment

36. Again, the same reasoning applies, as set out in my paragraphs 32 and 33 above, in respect of the Applicant's "*Rental of food service apparatus; Rental of food service equipment*". These are services that would likely be provided to a food service provider i.e. businesses (as opposed to the Opponent's services, which are intended for the customers of food establishments), therefore the users would differ. The trade channels, nature, method of use and purpose also differs with the Opponent's Class 43 services and the services would not be in competition with each other.

37. With regard to complementarity, whilst I recognise that there may be instances where a members of the general public may rent food service apparatus and equipment for an event they are hosting for example, and from that perspective, the user would be the same, I do not consider this to be sufficient for a finding of similarity, since the complementarity is not sufficiently pronounced, and there is no rule that 'complementarity' always and necessarily equals 'similarity'.¹⁴ These services are therefore **dissimilar**.

Conclusions on the services comparison

38. I have found that some of the applied-for services are dissimilar to the Opponent's services, whilst the remainder are identical. Since some similarity between the

¹⁴ See *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, paragraph 22, in which the Appointed Person quoted: *Assembled Investments (Proprietary) Ltd v. OHIM*, T105/05, paragraphs 30 to 35 (which was upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*, C-398/07P, paragraphs 34, 35).

services is required for the purposes of a section 5(2)(b) claim, the opposition must fail in respect of the dissimilar services identified above,¹⁵ namely:

“Consultancy services relating to food; Consultancy services relating to food preparation; Restaurant reservation services; Rental of food service apparatus; Rental of food service equipment”.

I therefore proceed to consider a likelihood of confusion only in relation to the services that are identical.

The average consumer and the nature of the purchasing act

39. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the services in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word “average” merely denotes that the person is typical,¹⁶ which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.¹⁷ It is therefore necessary to determine who the average consumer of the services is, and how the consumer is likely to select those services.

40. The average consumer for the services still in play will be members of the general public i.e. the consumers of food services (e.g. customers of a restaurant), and not a business that is a professional provider of food services. The average consumer therefore encompasses individuals as well as organisations requiring catering for events for example.

41. The services are likely to vary in cost, however, they are on average likely to be used relatively frequently. In selecting the services, the average consumer will take various factors into consideration such as the cost, the type of cuisine offered and the standards of customer service and hygiene. Consequently, the level of attention paid during the selection process will be medium.

¹⁵ See *Waterford Wedgwood plc v OHIM* – C-398/07 P (case of the CJEU); and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49.

¹⁶ *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), paragraph 60

¹⁷ *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

33. The services are likely to be selected visually, following the viewing of signage on the frontage of premises or viewing adverts and menus (and their online equivalents); or orally – bearing in mind the nature of the services, it is likely that the average consumer may select them following oral recommendations, and oral orders would also play some part. The way the marks look and the way they sound must be taken into account, therefore the visual and aural components would play an equal role in the selection process.

Comparison of marks

42. It is clear from *Sabel BV v. Puma AG*,¹⁸ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ('CJEU') stated in *Bimbo SA v OHIM*,¹⁹ 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."

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

¹⁸ Case C-251/95, paragraph 23.

¹⁹ Case C-591/12P, paragraph 34.

44. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
BARLEY'S	 A circular trade mark with a green border. Inside the circle, at the top, is a green tree. Below the tree, the word "BARLEY" is written in large, bold, black, block-capital letters. Underneath "BARLEY", the words "EST 2021" are written in a smaller, green, block-capital font. At the bottom of the circle, the word "LONDON" is written in black, block-capital letters, following the curve of the bottom edge.

Overall impression

45. The earlier trade mark is a word-only mark for the word 'BARLEY'S', the overall impression lies in that word. The apostrophe 'S' would merely be perceived by the average consumer as a possessive 'S'. Accordingly, the apostrophe 'S' represents an ordinary grammatical rule and plays a limited role in the mark.

46. The contested trade mark is a figurative circular trade mark made up of several verbal and non-verbal components. The verbal components consist of the words 'BARLEY', 'EST 2021' and 'LONDON'. The word 'BARLEY' is represented in a bold, black block-capital typeface which runs through the centre of the mark – it is larger than the rest of the wording. Below the word 'BARLEY' is the writing 'EST 2021', represented in a green, block-capital typeface – it is the smallest writing contained within the mark; below this is the place name 'LONDON', represented in a larger (but not as large as the word 'BARLEY'), black block-capital font which is curved at the bottom part of the mark.

47. 'EST' is a commonly understood abbreviation for the word 'established', and 'LONDON' is clearly a geographical location. It is not an uncommon practice throughout a range of industries, not least the hospitality sector, for businesses to display the year they were established and the location from which they originate or were founded. I find that these verbal elements are not distinctive in relation to the services for which protection is sought and accordingly have limited relative weight in

the overall impression of the mark. Indeed, there is a real possibility that the average consumer of the services may fail to perceive the wording 'EST 2021' and 'LONDON' as an intentional part of the brand name, therefore they would be accorded less attention than the word 'BARLEY'.

48. The figurative elements consist of a stylised representation of an olive tree / a tree in green; and a decorative circular, green border in which the tree device and wording is contained. I note that where a mark contains words and figurative elements, the average consumer will refer to the goods and services in question by quoting their name, rather than by describing the figurative elements, particularly where the figurative element has been added for decorative effect and is not intended to be distinctive,²⁰ as such, the word elements will usually be more distinctive.²¹

49. Despite the mark being made up of several components, the stylisation is such that the word 'BARLEY' is the most visually prominent element in the mark. Taking all the foregoing into account, I find that the word 'BARLEY' has an independent distinctive role in the contested mark, and that the overall impression of the mark is dominated by that word – the other elements making up the mark having limited weight relative to the word 'BARLEY'.

Visual comparison

50. I note that a word mark protects the word itself and the comparison must be made on the basis of the word, not any particular presentation of the word. The protection of a word mark is not limited by any features such as capitalisation or the typeface which appears on the Register,²² as such those features do not provide a point of distinction when comparing a word-only mark with a figurative mark, where the figurative mark comprises of words in a stylised font.²³

51. The marks visually coincide in the word 'BARLEY'S' and 'BARLEY' – 'BARLEY' being wholly contained in the earlier mark. I note that generally, although just as a rule

²⁰ *M & K v EUIPO*, T-171/17, paragraph 41.

²¹ Although, that is not to say that there is a general rule of thumb that non-distinctive word elements therefore become distinctive when they are combined with a figurative element, and the assessment should be made on the factors in each case.

²² See the comments of Iain Purvis KC, sitting as the Appointed Person in the following two cases: *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, Case BL O/281/14, paragraph 21; and *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22, paragraph 37.

²³ *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22.

of thumb, the beginnings of words tend to have more visual (and aural) impact than the ends.²⁴ As the words only differ in the apostrophe 'S', which is at the end of the earlier mark, these words are highly similar.

52. Given my earlier comments regarding the overall impression of the contested mark being dominated by the word 'BARLEY', and the limited relative weight of the wording 'EST 2021' and 'LONDON' (I note that the other elements making up the contested mark, although having less weight than the word 'BARLEY', cannot be ignored in a visual comparison), I therefore assess the degree of visual similarity as medium to high.

Aural comparison

53. 'BARLEY'S' / 'BARLEY' are ordinary words and will be pronounced in the ordinary way. The only difference between the pronunciation is the sound attributed to the apostrophe letter 'S' in the earlier mark, however, this does not greatly alter the way it is pronounced such that the degree of aural similarity between these two words is high.

54. The general conformity is to pronounce 'EST' as the full word for which it is an abbreviation i.e. 'established', therefore 'EST 2021' would be pronounced as 'established twenty-twenty-one'. 'LONDON' would be pronounced in the ordinary way. As neither of these elements are present in the earlier mark, they represent a point of difference between the competing marks. That said, given my assessment of the relative weight that wording plays in the overall impression of the contested mark, this difference is not significant, this wording is banal and the consumer is unlikely to pronounce it when referencing the contested mark. Indeed, I consider it likely that the average consumer of the services would merely articulate the word 'BARLEY', for example, the average consumer of a 'restaurant service' is unlikely to refer to that restaurant as 'BARLEY ESTABLISHED TWENTY-TWENTY-ONE LONDON' or 'BARLEY LONDON ESTABLISHED TWENTY-TWENTY-ONE'. As such, the overall degree of aural similarity (based on this consideration) is high.

²⁴ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraph 81

55. However, I acknowledge that whilst that wording is banal, that does not render it negligible or aurally invisible.²⁵ Therefore, in the alternative, I do not overlook that the average consumer may also articulate the word 'LONDON' (on the basis that the consumer may refer to it because it denotes the location of the service provider; and also given its size and greater prominence visually relative to 'EST 2021'). As such, although I consider this less likely, the contested mark may be referred to as 'BARLEY LONDON'. In such circumstances the degree of aural similarity would be at least medium.

Conceptual comparison

56. With regard to the contested mark, the concept of the word 'BARLEY' derives from its ordinary meaning i.e. a cereal plant of the grass family – the grain which derives from that plant also being called 'barley' – being an edible grain, often used in the preparation of malt liquors and spirits. I also do not discount that the average consumer may also perceive it as a person's forename or surname, particularly considering the economic sector to which the services relate, for example, I am aware as a consumer of those services that it is not uncommon for businesses to be named after their owner (so the name of the business would be the name of the owner).

57. The concept conveyed by the other wording in that mark derives from their ordinary meanings i.e. that 'BARLEY' was established in 2021 and is located in London.

58. The tree device does not alter the concept derived from the word 'BARLEY'.

59. The apostrophe 'S' in the earlier mark serves to indicate that 'BARLEY' is a name, this is because the 'S' is possessive. This is even more so, given the economic sector at hand, and the fact that, as I have already mentioned, food establishments can often be named after their proprietors; in addition, I am aware that it is not uncommon for such businesses to use the possessive apostrophe 'S' after the name, to indicate that it is 'their' place. For example, *McDonald's*, *Nando's* etc.

60. That said, I do not discount that the average consumer will still perceive the ordinary meaning of the word barley. For example, people's names can derive from plants/ flowers such as Rose, Violet etc. – notwithstanding they are names, this does

²⁵ *Purity Hemp Company Improving Life as Nature Intended*, Case BL O/115/22.

not detract from the ordinary meaning of those words. The conceptual message of the earlier mark is therefore one of a person's name (the meaning of which also derives from an ordinary word – i.e. barley).

61. Given my earlier comments regarding the overall impression of the contested mark, and my finding that the contested mark is dominated by the word 'BARLEY', I assess the degree of conceptual similarity as high.

Distinctive character of the earlier mark

62. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion may be.²⁶

63. The issue of a trade mark's protection is intimately tied to the scope of the protection to which it is entitled. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

64. The Opponent makes no claim to enhanced distinctiveness through the use made of the earlier mark, and has filed no evidence of use, therefore I only have the inherent distinctiveness of the mark to consider.

65. 'BARLEY'S' makes no descriptive reference to the Opponent's services and will be given its ordinary meaning. Whilst I recognise that barley, in its ordinary, dictionary meaning, is an edible grain that is also used in the preparation of spirits, it does not allude to the Opponent's services. Consequently, it is a normal trade mark possessed of a medium degree of inherent distinctive character.

²⁶ *Sabel v Puma*. Although it is the distinctive character of a component that is similar between the marks that is particularly relevant – see *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraphs 38 and 39.

Conclusions on Likelihood of Confusion

66. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law, taking into account all factors relevant to the circumstances of the case.²⁷ This includes taking into account the distinctive character of the earlier mark, the average consumer of the services and the nature of the purchasing act. I must also have regard to the principle of interdependency i.e. that *“a global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between [the] goods or services. Accordingly a lesser degree of similarity between [the] goods or services may be offset by a greater degree of similarity between the marks, and vice versa.”*²⁸

67. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the services at hand and determining whether they are likely to be confused – bearing in mind the fact that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have kept in mind.²⁹ The global assessment is therefore supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.³⁰ The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.³¹

68. 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 undertaking being the same or related.³²

²⁷ *Sabel BV v Puma AG*, Case C-251/95.

²⁸ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

²⁹ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

³⁰ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

³¹ See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

³² See *Sabel BV v Puma AG* at paragraph 16; and *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, paragraphs 16 – 17.

69. I have found that the services still in play are identical and will be selected by the average consumer, who is a member of the general public, via a visual and aural selection process, with a medium degree of care and attention. The earlier mark has a medium degree of inherent distinctive character, and the overall impression of the contested mark is dominated by the word 'BARLEY'.

70. The words 'BARLEY'S' and 'BARLEY' are visually, aurally and conceptually highly similar. Notwithstanding this, I have found that the respective marks are visually similar to at least a medium degree overall and aurally similar to between a medium and high degree overall, owing to the additional elements that make up the contested mark (although those elements have limited weight relative to the word 'BARLEY'). I also bear in mind the likelihood that the average consumer may refer to the contested mark as just 'BARLEY'.

71. Taking all factors relevant to the circumstances of the case into account, and having regard to the principle of interdependency, I find that there is a likelihood that the average consumer, or a significant proportion thereof, would be directly confused as to the origin of the services. I make this finding notwithstanding the differences between the marks, this is because the similarity between 'BARLEY'S' and 'BARLEY' (the latter forming the dominant element of the contested mark), is so striking that it will lead the average consumer to mistake one mark for the other. This is particularly so given the difference between those words is merely an apostrophe 'S' at the end of the earlier mark, which may be lost to the imperfect recollection of the consumer; and the addition to the contested mark of non-distinctive wording that does not serve to distinguish one undertaking from another.

72. Where the average consumer recognises the differences between the marks, I consider there would nevertheless be a likelihood of indirect confusion, on the basis that the services at hand are identical, and that the average consumer is likely to believe that the differences between the marks are due to marketing considerations or a brand evolution for example, rather than the services originating from different undertakings.

OUTCOME

73. The opposition under section 5(2)(b) of the Act is partially successful. Subject to any appeal, the contested trade mark application shall proceed to registration only in respect of the following services in Class 43:

“Consultancy services relating to food; Consultancy services relating to food preparation; Restaurant reservation services; Rental of food service apparatus; Rental of food service equipment”.

COSTS

74. The Opponent has been partially successful and would ordinarily be entitled to an award of costs. However, as the Opponent had not instructed professional representatives, it was invited by the Tribunal to indicate whether it intended to make a request for an award of costs by returning a completed costs pro-forma setting out accurate estimates of the number of hours spent on a range of given activities relating to the proceedings. It was made clear by letter dated 30 May 2023, that if the pro-forma was not completed and returned, costs, other than official fees arising from the action, may not be awarded.

75. The Opponent did not file a completed costs pro-forma. I therefore only award the Opponent the sum of £100 in respect of the official fee for the filing of the notice of opposition.

76. I therefore order ATAS CHEF & CONSULTANCY LTD to pay Charleigh Whale the sum of **£100**. This sum is to be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 12th day of October 2023

Daniela Ferrari

For the Registrar