

O/1063/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003711860

BY TOUM AND TAHINI LTD

IN CLASS 43

AND OPPOSITION THERETO UNDER NO. 600002061

BY TAREK FARAH

AND

IN THE MATTER OF REGISTRATION NO. UK00003635174

IN THE NAME OF TAREK FARAH

IN CLASSES 39 AND 43

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 505112

BY TOUM AND TAHINI LTD

Background and Pleadings

OPPOSITION

1. On 19 October 2021, Toum and Tahini Ltd (“the applicant”) applied to register the series of four trade marks shown below:

UK00003711860 (Series of 4) (“the application”)

Toum & Tahini

Toum & Tahini



2. The application was made in respect of the following services in class 43:

Food preparation; Contract food services; Fast food restaurants; Food preparation services; Restaurants; Restaurant services; Grill restaurants; Delicatessens [restaurants]; Tourist restaurants; Restaurant information services; Reservation of restaurants; Ramen restaurant services; Carvery restaurant services; Providing restaurant services; Self-service restaurants; Carry-out restaurants; Restaurant reservation services; Washoku restaurant services; Mobile restaurant services; Japanese restaurant services; Spanish

restaurant services; Tempura restaurant services; Hotel restaurant services; Restaurants (Self-service -); Sushi restaurant services; Take-out restaurant services; Self-service restaurant services; Fast-food restaurant services; Bar and restaurant services; Providing reviews of restaurants; Salad bars [restaurant services]; Booking of restaurant seats; Restaurant and bar services; Providing information about restaurant services; Udon and soba restaurant services; Restaurant services provided by hotels; Restaurant services incorporating licensed bar facilities; Providing reviews of restaurants and bars; Provision of information relating to restaurants; Agency services for reservation of restaurants; Travel agency services for booking restaurants; Provision of food and drink in restaurants; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Making reservations and bookings for restaurants and meals; Reservation and booking services for restaurants and meals; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Restaurant services for the provision of fast food.

3. The application was examined and accepted and subsequently published for opposition purposes on 05 November 2021.

4. On 07 December 2021, Tarek Farah (“the opponent/proprietor”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) using the fast-track procedure, relying upon the earlier mark set out below:

UK00003635174 (“the earlier mark”)

Toum

Filing date: 30 April 2021

Registration date: 24 September 2021

5. The opponent/proprietor relies on following services for which the mark is registered, namely:

Class 39: *Food delivery; Packing of food; Delivery of food; Packaging of food.*

Class 43: *Restaurants; Restaurant services; Delicatessens [restaurants]; Fast food restaurants; Providing restaurant services; Carry-out restaurants; Take-out restaurant services; Fast-food restaurant services; Bar and restaurant services; Restaurant and bar services; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Food preparation.*

6. The opponent/proprietor claims that there is a likelihood of confusion because the marks are similar, and the services are identical or similar.

7. The applicant filed a defence and counterstatement denying the claims made. In particular, the applicant states that the earlier mark has no inherent distinctiveness and cannot function as a trade mark due to it being directly descriptive of the kind of food to be packaged, delivered, and/or consumed.

INVALIDATION ACTION

8. On 13 July 2022, the applicant filed an application for invalidation against the opponent/proprietor's earlier mark, pursuant to Sections 3(1)(b) and 3(1)(c) of the Act.

9. In its statement of grounds, the applicant addresses the grounds under Section 3(1)(b) and (c) together. It states:

"The word toum is defined as a garlic condiment common in the Levant, similar to aioli, made with garlic, salt, olive or vegetable oil, lemon juice, and sometimes mint.

It is established case law that the inherent distinctiveness of a trade mark must be assessed, firstly, in relation to the goods or services of the application and, secondly, in relation to the perception of the average consumer (Case T-345/99 TRUSTEDLINK).

The average consumer of the class 39 services of the Registration would be a person requiring the delivery and packaging of food, either a food business looking to outsource this requirement or a consumer requiring food to be delivered to them.

The average consumer of the class 43 services of the Registration would be a person requiring food.

Toum is the name given to a specific food dish, one that can be packaged and delivered, either for and on behalf of a business or a direct consumer having ordered the food, and one that can be served as part of a meal, either incorporated into the prepared dish or provided as a separate condiment.

Consequently, the word Toum cannot function as a trade mark due to its being directly descriptive of the kind of food to be packaged, delivered, and/or consumed.

The word TOUM is devoid of any distinctive character in relation to the services of the Registration.

The word TOUM consists exclusively of a sign or indication which may serve, in trade, to designate the kind of services of the Registration, namely the packaging, delivery, and/or consumption of toum.

The Registration must be invalidated in its entirety under Sections 3(1)(b) & (c) Trade Marks Act 1994 by virtue of Section 47(1) Trade Marks Act 1994”.

10. The opponent/proprietor filed a counterstatement denying the claims. It states:

“The applicant is put to proof of its "definition" and whether the average consumer in the UK would be aware of this interpretation.

It is denied that there is any "food dish" capable of delivery that would be described as TOUM.

An understanding of Arabic is not common amongst the relevant consumers. At best the sign TOUM is a transliteration of the Arabic توم which may also be transliterated as THUM.

Even if the average consumer were to identify the sign as a menu item (which is not admitted) it is denied that there would be any ground of invalidity under Section (3) (b) and (c) as a menu item is not descriptive of the services for which the mark is registered. At best any descriptiveness would be indirect and it is clear that the name of a condiment – even were it well known to the average consumer- could be distinctive as the name of a restaurant or delivery service”

11. The opposition and the invalidation proceedings were consolidated on 19 October 2022. As a result, the fast-track opposition was converted to a standard opposition.

12. Both parties filed evidence in chief, with the opponent/proprietor also filing evidence in reply.

13. Both parties are represented; the opponent/proprietor by Filemot Technology Law Ltd and the applicant by Wilson Gunn. A hearing took place before me on 27 September 2023, by video conference. The applicant was represented by Mr Tim Rose of Wilson Gunn. The opponent/proprietor was represented by Ms Barbara Cookson of Filemot Technology Law Ltd.

EU Law

14. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on 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 on trade mark matters.

EVIDENCE

15. The opponent/proprietor filed evidence in the form of a witness statement of Tarek Farah (i.e. the opponent/proprietor himself) dated 16 December 2022, accompanied by one exhibit marked TF1.

16. The applicant's evidence consists of two witness statements by Laila Chamsi-Pasha. The first was filed as evidence in chief, it is dated 16 December 2022 and is accompanied by 4 exhibits marked 1-4, whereas the second was filed in reply to the opponent/proprietor's evidence, it is dated 16 February 2023 and is accompanied by one exhibit marked 1. Ms Chamsi-Pasha is a director of the applicant's company, a position which she has held since 16 March 2021.

17. Given the potential impact of the invalidation action on the opposition proceedings, I will begin by assessing this claim first.

THE INVALIDATION

18. In invalidation proceedings, Section 3 of the Act has application because of the provisions of Section 47 which reads:

“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).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”.

19. The relevant parts of Section 3(1) of the Act read as follows:

“3.— Absolute grounds for refusal of registration

(1) The following shall not be registered—

(a) [...]

(b) trade marks which are devoid of any distinctive character.

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) [...]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”.

20. The relevant date under Section 3(1)(b) and (c) is the filing date of the opponent/proprietor’s mark which, in this case, is 30 April 2021.

21. I bear in mind that the grounds under Section 3(1)(b) and (c) are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of Section 3(1)(c) but still be objectionable under Section 3(1)(b) of the Act: *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, at paragraph 25. In reality however, since the applicant's case under Section 3(1)(b) is that the opponent/proprietor's mark is descriptive then, if its Section 3(1)(c) claim succeeds or fails the same outcome will apply to its claim under Section 3(1)(b).

Section 3(1)(c)

22. I begin with the applicant's claim under Section 3(1)(c) which prevents the registration of marks which are descriptive of the goods and services or a characteristic of them. The case-law under Section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by analogy, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph

30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland*

[2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the

goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

23. I also bear in mind that descriptiveness must be assessed through the perception of the relevant parties, including those in the trade. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the Court of Justice of the European Union ("CJEU") held that:

"24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its

registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPNNederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

24. In *Exalation v OHIM*, Case T-85/08, the General Court (“GC”) confirmed that, at least where technical terms are concerned, it is appropriate to take account of meanings known to those in the trade. The court stated that:

“38. In paragraph 18 of the contested decision, the Board of Appeal stated that the applicant had not submitted any substantiated evidence to invalidate the examiner’s observations to the effect that the element ‘lycopin’ (lycopene) designated a carotenoid with antioxidant properties.

39. For the first time at the hearing, the applicant challenged the Board of Appeal’s assessment that the term ‘lycopin’ is descriptive. The Court observes that the applicant has not given any details to support its claims and there is thus no need to consider whether such an argument may be raised at this stage in the proceedings. In particular, the applicant has put forward no argument capable of calling into question the meaning attributed to the term ‘lycopin’ by the Board of Appeal. In those circumstances, the Court must find that the applicant has not succeeded in challenging the meaning attributed to the element ‘lycopin’ by the examiner and by the Board of Appeal.

40. First, that technical term designates a food supplement necessarily known by some of the relevant public, in particular professionals dealing with dietetic, pharmaceutical and veterinary preparations.

41. Secondly, the Board of Appeal established in the contested decision that the meaning of the term ‘lycopin’ was easily accessible to consumers of all the goods

covered by the application for registration. The meaning of the term 'lycopin' does in fact appear in dictionaries and on web sites. It is probable therefore that the substance designated by that term is also known by some of the consumers of all the goods listed in paragraph 3 above.

42. Thirdly, consumers of pharmaceutical, veterinary, dietetic and sanitary preparations for medical use who are not aware of the meaning of the term 'lycopin' will often tend to seek advice from the informed section of the relevant public, namely doctors, pharmacists, dieticians and other traders in the goods concerned. Thus, by means of the advice received from those who prescribe it or through information from various media, the less well-informed section of the relevant public is likely to become aware of the meaning of the term 'lycopin'.

43. The relevant public must therefore be regarded as being aware of the meaning of the term 'lycopin', or at least it is reasonable to envisage that the relevant public will become aware of it in the future (see paragraphs 25 and 26 above)."

25. Finally, as the applicant's objection is based on the mark 'Toum' being a transliteration into Latin characters of an Arabic word describing a garlic dip, I bear in mind the case-law relating to the distinctiveness of words in foreign languages. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, in the context of the assessment of distinctiveness for the purposes of registration, the CJEU held that the distinctive character of a trade mark must be assessed from the perspective of the relevant public in the territory in which registration is sought. The same must apply to the assessment of the distinctive character of trade marks for the purposes of assessing whether there is a likelihood of confusion between them: see *Matratzen Concord AG v OHIM*, Case T-6/01.

26. In *Pooja Sweets & Savouries Ltd V Pooja Sweets Limited*, BL O-195-15, Ms Anna Carboni, as the Appointed Person, held that where goods are targeted at the general public, the mere fact that they might be of greater interest to a particular sub-set of the relevant public did not justify narrowing the assessment of distinctiveness to just that sub-set of the relevant public. See also, to similar effect, the judgment of the GC in

Aranynektar v OHIM, Case T-503/15. However, in *Loutfi v AMJ Meatproducts NV and Another*, Case C-147/14, the CJEU held that:

“Article 9(1)(b) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that, in order to assess the likelihood of confusion that may exist between a Community trade mark and a sign which cover identical or similar goods and which both contain a dominant Arabic word in Latin and Arabic script, those words being visually similar, in circumstances where the relevant public for the Community trade mark and for the sign at issue has a basic knowledge of written Arabic, the meaning and pronunciation of those words must be taken into account.”

27. I now turn to the evidence.

28. In support of the claim that the word ‘toum’ describes a garlic sauce, Ms Chamsi-Pasha produces a number of internet definitions from the following webpages:¹

1. <https://feelgoodfoodie.net/recipe/lebanese-garlic-sauce/>. It shows an article titled “*Lebanese Garlic Sauce (Toum)*” dated 27 April 2020 which states: “*This Garlic Sauce (Toum) is a popular condiment in Lebanese restaurants served often with chicken; made with only 4 ingredients: garlic, oil, lemon and salt*”;
2. <https://www.themediterraneanandish.com/toum-garlic-sauce-recipe/>. It shows an article titled “*Whipped Toum (4-Ingredient Garlic Sauce)*” dated 14 September 2020 which states: “*Toum is a bold and creamy Middle Eastern garlic sauce made of garlic, oil, lemon juice, and a pinch of salt with just a little bit of water*” and “*By the way, toum is pronounced TOOM, and in Arabic, it simply means garlic! I first learned about toum sauce from my mother-in-law Dina who used to own a Mediterranean restaurant in grand Rapids, Michigan*”;
3. <https://www.alphafoodie.com/lebanese-garlic-sauce/>. It shows an article titled “*How To Make Lebanese Garlic Sauce (Toum)*” dated 11 February 2021 which

¹ Exhibit 1

states: *“This Lebanese garlic sauce (Toum) is thick, creamy, absolutely packed with garlic flavor, and ready to eat with everything! Plus, this toum recipe is naturally gluten-free and vegan, and similar to garlic aioli!”*;

4. <https://zaatarandzaytoun.com/lebanese-garlic-sauce-toum/>. It shows an article titled *“LEBANESE GARLIC SAUCE RECIPE (TOUM)”* dated 2021 which states: *“Lebanese garlic sauce or ‘toum’ as we call it, should be creamy, fluffy and zingy at the same time”*. The article appears to be written by a *“Lebanon born - London based foodie”*;
5. <https://littlespicejar.com/lebanese-garlic-sauce-toum/>. It shows an article titled *“Lebanese Garlic Sauce (Toum)”* dated 03 April 2022 which states: *“Toum is a Lebanese garlic sauce made with just 4 simple ingredients! It’s easy to make because the sauce comes together in a food processor and lasts for months in the fridge!”*. The writer of the article appears to be based in Texas, USA;
6. <https://www.mamaslebanesekitchen.com/dips/lebanese-garlicdip/>. It shows an article titled *“Toum: The Recipe for the World’s Strongest Lebanese Garlic Sauce”* dated 13 June 2022 which states *“Toum, a Lebanese garlic source that is a staple of Lebanese cuisine [...]. Lebanese Garlic Sauce, Toum, Aioli: Background & Terminology - In Lebanon they call it “Toom” or “Toum” which literally means garlic. Our Egyptian siblings call it “Tooma”... Our Greek cousins have a similar version which they call “skordalia” and in Spain it’s referred to as “Aioli”. In the US it is generally referred to as garlic sauce, however the fact of the matter is that it’s closer to being a thick and fluffy paste than a sauce. [...]*;
7. <https://www.serious-eats.com/traditional-toum>. It shows an article titled *“Traditional Toum (Lebanese Garlic Sauce) Recipe”* dated 15 September 2022 which states: *“A bold, creamy garlic sauce and dip, Lebanese toum is easy to make at home with the help of a food processor and a little good technique”*;
8. <https://www.wise-geek.com/what-is-toum.htm>. It shows an article titled *“What Is Toum?”* dated 12 November 2022 which states: *“Toum is a traditional creamy garlic dipping sauce from Lebanon”*;

29. In support of the claim that 'Toum' is readily available to the average English consumer, Ms Chamsi-Pasha produces copies of webpages (undated) from the UK supermarkets Tesco and Morrison showing a product described as 'MEZEAST Garlic Toum Sauce' available for sale.² Both supermarkets use the same product description as "Garlic sauce. MEZEAST Garlic Toum Sauce, a traditional Lebanese sauce with a raw garlic kick Pungent garlic paste combined with lemon juice for an exciting taste [...]". However, the word 'toum' does not appear on the product itself which uses the words "MEZEAST Garlic Sauce" only, as shown below:



30. The evidence also includes:

- an example of 'toum' listed on a menu (undated) which is said to be from the restaurant Ottolenghi in London. The word 'toum' appears as part of the dish "*Chicken shawarma skewer, pickled cucumbers, toum, herb salad, pita*";³
- an example of 'toum' listed on a menu, including as a standalone item capable of being ordered separately.⁴ The photographs are said to have been taken no later than 14 June 2022. The menu is that of Shatta & Toum, a Middle Eastern kitchen offering food at Arcade Foodhall in London. It states: "*Shatta & Toum is named after the two condiments always found on the table in the*

² Exhibit 2

³ Exhibit 3

⁴ Exhibit 4

Middle East: shatta, a fiery chilli sauce directly translated as 'spicy' and toum, a garlic sauce."

Assessment

31. The applicant's case is that the trade mark 'Toum' is descriptive and/or non-distinctive because it describes "*food served, packaged or delivered*".

32. Although some the evidence is undated or is dated after the relevant date of 30 April 2021 and appears to target US (rather than UK) consumers – as the articles appear to be from websites that are '.com' domains rather than '.co.uk domains' - there is sufficient evidential support for 'toum' being the name of a garlic condiment similar to aioli.

33. The evidence also refers to 'toum' being a traditional Lebanese sauce, although, in its statement of grounds the applicant refers, more generally, to 'toum' being defined as a garlic condiment common in the Levant - which, I understand, indicates the countries and islands of the eastern Mediterranean. The applicant did not provide the dictionary definition it relied upon, but its statement that 'toum' is a garlic condiment common in the Levant appears to be consistent with the current Cambridge online dictionary which defines 'toum' "*a sauce from the eastern Mediterranean, made from garlic, lemon juice, and oil*". Further, consistently with the dictionary definition of the word, the evidence relating to the restaurant called 'Shatta and Toum' refers to 'toum' being popular in a wider geographical area than Lebanon, namely in the Middle East. I will therefore proceed on the basis that the evidence - which is consistent with the dictionary definition - is sufficient to establish that at least a section of the UK relevant public will have an understanding of what 'toum' is.

34. The question of whether the opponent/proprietor's mark is sufficiently descriptive that it should fall foul of Section 3(1)(b) is to be approached by considering the perception of the average consumer of the services covered by the registration which, in this case, comprises *Food delivery; Packing of food; Delivery of food; Packaging of food* (in class 39) and various restaurant and food preparation services (in class 43). This is, for the class 43 services, an English-speaking person who may be interested

in eating at a restaurant, including in circumstances where the restaurant providing the services offers 'toum' as an item on their menu. The aim of the contested class 39 services is to facilitate food delivery logistics; the average consumer of these services would be a UK business from the food industry requiring delivery of restaurant food, takeaway and groceries.

35. Section 3(1)(c) prevents the following from being registered as trade marks:

“trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service”.

36. For the section to bite I must be satisfied that the average consumer would at the relevant date have immediately perceived, without thought or explanation, that the word 'toum' designated a characteristic of the services, which the applicant identifies as the kind of food to be packaged, delivered, and/or consumed.⁵

37. I accept that use of the word 'toum' in relation to the sale of 'toum' would be descriptive of the goods, and that it would not be possible to register 'toum' as a trade mark for toum or garlic sauces in class 30. However, it seems to me that different considerations apply in relation to restaurant and food delivery services. At the hearing Mr Rose made the point that the consumer that eats at the restaurant will easily know where to reacquire toum if they ever wanted to, that being the name of the restaurant. This seems to confuse the primary purpose of restaurant services with that of retail services. Consumers who eat at restaurants purchase a dining experience and do not decide to book a restaurant in order to purchase a condiment or an ingredient – to do that they would go to a shop, not a restaurant.

38. The answer to the question as to whether the offering of a type of food is a “characteristic” of the services, depends on whether the food describes an attribute of

⁵ See *Burgerista Operations GmbH v Burgista Bros Ltd and Ors* [2018] citing *JW Spear & Sons Ltd v Zynga Inc* [2015] EWCA Civ 290

the services. This is because to be merely descriptive, a term must convey an immediate idea of a characteristic of the relevant goods or services in such a way that the relevant public who knows what the goods and services are will understand the mark to convey information about them.

39. The fact that an item of food might be listed on the menu of a restaurant does not make it descriptive of restaurant services because restaurant services prepare and serve a variety of foods. This is unless the name of the food indicates a characteristic of the services in the sense that it describes the main type of food which a restaurant serves (i.e. its speciality) even though other items are available. For example, 'steaks' would be descriptive of a restaurant specialising in (or selling mainly) stakes, 'burgers' would be descriptive of a restaurant specialising in (or selling mainly) burgers, and 'sandwiches' would be descriptive of a sandwich bar that sells primarily sandwiches. At the hearing, Mr Rose referred to the example of a potato van serving delicious baked potatoes with a renowned homemade coleslaw filling not being able to register the word coleslaw as a trade mark. Significantly, Mr Rose's example refers to a "renowned" homemade coleslaw filling and to a potato van selling baked potatoes with a coleslaw filling as a speciality, which is exactly the point I am making; however, the opponent/proprietor's services are very broad and cover the provision of any type of food.

40. This takes me to the next point. In this case, the word 'toum' is a term that refers to a garlic condiment originating from the Middle East. It seems to me that whilst 'toum' might feature in restaurant menus, either as part of a dish or separately, it is only a condiment and/or ingredient and not a generic term for a food group which could represent the speciality of a restaurant. As such, I cannot see how it can immediately inform consumers of a characteristic of the opponent/proprietor's restaurant services.

41. I accept that, as Mr Rose submitted at the hearing, the trade mark 'Toum' used in relation to restaurant services may be suggestive of the geographical origin or style of the food served at the restaurant, for example Lebanese or Middle East food. This is how the opponent/proprietor appears to intend to use the trade mark 'Toum', namely in relation to a restaurant offering Lebanese rotisserie which traditionally serves 'toum' as an accompaniment to chicken dishes. In this connection, the opponent/proprietor

filed evidence showing that the trade mark 'Toum' was chosen to convey the concept that the business would serve *"healthy free-range Lebanese style roast chicken and side mezzes in a casual buzzy setting"*.⁶ Likewise, the applicant appears to use the contested mark 'TOUM & TAHINI' in relation to the provision of Middle East street food with the evidence showing that one of the foods offered under the trade mark is "fatteh", *"a traditional Levantine dish of spice pulled chicken"*, which, again, makes 'toum' likely to be understood by the average consumer as alluding to (or evoking) the geographical origin and/or style of the food served.⁷

42. Consequently, whilst 'toum' might be the name of a garlic sauce, it does not describe a characteristic of restaurant services serving 'toum' as a condiment. The most that can be said is that 'Toum' alludes to a style of food or cuisine (or its geographical origin), since the relevant public would, at most, associate the trade mark 'toum' with the style or geographical origin of the restaurant providing the services, i.e. namely Lebanese or from Middle East. However, the relevant public would not understand that 'Toum' immediately describes a characteristic of the restaurant services, even in circumstances where 'toum' features on the menu; a word which would be more likely to describe characteristics such as the geographical origin of the restaurant or the type of food served at the restaurant would be, for example, 'Lebanese rotisserie', not 'toum'. Furthermore, given that 'toum' is only a condiment (rather than a dish), the average consumer will not understand that 'toum' is the specialty of the restaurant or the main food served in the restaurant. The mark is therefore too vague for there to be a sufficiently direct or specific link with the registered services in class 43.

43. Turning to the services in class 39, the applicant's case is even weaker. This is because food delivery and packaging services do not discriminate between food items according to their nature. In other words, providers of food delivery and packaging services offer delivery and packaging of food in general, not according to the type of food the business user requires them to deliver and package. Further, by contrast to

⁶ TF1

⁷ Exhibit 1 to second witness statement of Ms Chamsi-Pasha

restaurants, food delivery and packaging services do not normally have a thematic focus.

44. In those circumstances, I reject the applicant's claim that at the relevant date the mark 'Toum' was descriptive of the services insofar as it describes food served, packaged or delivered. The word 'Toum' does not describe an intrinsic characteristic of the opponent/proprietor's services, rather at best it is loosely allusive of the style or geographical origin of the food served at the restaurant providing the services, which is described as Lebanese or from Middle East. The connection between the word 'Toum' and its suggestive/allusive meaning is not sufficiently direct to the services at issue, and I do not consider that consumers will immediately perceive that the word 'Toum' describes a characteristic of any of the opponent/proprietor's services; to do so would require a degree of mental effort on the part of the consumers which is not consistent with an immediate perception. The objection under Section 3(1)(c) fails.

45. I now turn to the Section 3(1)(b) objection.

Section 3(1)(b)

46. Section 3(1)(b) prevents the registration of a mark which is devoid of distinctive character.

47. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and Section 3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

"29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

48. I have already found that the opponent/proprietor's mark is not descriptive, and I accept that this does not of itself mean that the mark cannot be objectionable under

Section 3(1)(b). However, descriptiveness is the only claim that the applicant has made under this ground, as to why the mark is devoid of distinctive character.

49. It is clear from the case-law that for a mark to possess distinctive character it must serve to identify the goods/services in issue as originating from a particular undertaking. I can see no reason why the mark not being descriptive of the services at issue could be said to be incapable of identifying those services as originating from a particular undertaking. The invalidation based upon Section 3(1)(b) also fails.

50. In light of these findings the opponent/proprietor may rely upon its earlier mark for the purposes of its opposition under Section 5(2)(b).

OPPOSITION

Section 5(2)(b)

51. Section 5(2)(b) of the Act is as follows:

“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”.

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

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

53. By virtue of its earlier filing date, the trade mark upon which the opponent/proprietor relies qualifies as an earlier trade mark pursuant to Section 6 of the Act. As the earlier mark had not completed its registration process more than five years before the date of the application in question, it is not subject to proof of use pursuant to Section 6A of the Act.

54. 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

55. At paragraph 15 of its counterstatement, the applicant states:

“It is not disputed that the services of the Application are identical with the class 43 services of the Registration and may be perceived as being similar to the class 39 services of the Registration”.

56. Given the applicant's admission, I will proceed on the basis that the services are identical.

Average consumer

57. As the case law above indicates, it is necessary for me to determine who the average consumer is for the 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. (as he then was) 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."

58. The average consumer of the parties' restaurant (or restaurant-related) services is a member of the general public.

59. The purchasing process will be primarily visual with customers selecting the services following the display of the trade mark at the actual venue, via the internet or via advertising material. Aural considerations cannot be discounted, however, due to word-of-mouth recommendations.

60. The level of attention in the purchasing process will depend on the type of food and drink on offer, and on the type of occasion, i.e. celebratory or casual eating experience. Overall, I consider that the selection process will involve a medium degree of attention.



Comparison of marks

61. 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.”

62. 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.

63. The respective marks are shown below:

The applicant's marks	The proprietor/opponent's mark
<p data-bbox="301 416 512 450">Toum & Tahini</p> <p data-bbox="301 521 663 573">Toum & Tahini</p>  	<p data-bbox="906 416 987 450">Toum</p>

Overall impression

The opponent/proprietor's mark

64. The opponent/proprietor's mark is a word mark consisting of the word 'Toum', presented in title case, and therefore, the overall impression lies in that word.

The applicant's marks

65. The applicant's marks are the two words 'Toum' and 'Tahini' connected by an ampersand. The first mark of the series is a word-only mark. The second mark of the series is presented in a slightly stylised font, in brown. The last two marks of the series are presented against rectangular backgrounds, in beige letters against a brown

background (in the third mark in the series) and in brown letters against a beige background (in the fourth mark in the series).

66. The applicant argues that the word 'Toum' has a low level of inherent distinctiveness relying on the fact that the applicant has provided evidence of third-party use of 'Toum' as a trade mark. The applicant also states that the element 'Toum' and 'Tahini' are co-dominant, a claim which in some way conflicts with the claim that 'toum' has a low level of distinctiveness.

67. Aside from the evidence relating to the applicant and the opponent/proprietor's use of the marks at issue in these proceedings, the only evidence (dated after the relevant date) of use of the word 'toum' as a trade mark is that of a business called 'Shatta & Toum'. This is far from showing that, at the relevant date, the restaurant market was saturated with trade marks incorporating the word 'Toum', a fact that might have affected the distinctiveness of 'Toum' as a trade mark. Hence, I reject the applicant's submission on the point.

68. It also appears to be common ground between the parties that 'toum' and 'tahini' are both food products and the opponent/proprietor filed evidence demonstrating that tahini is a paste or spread made from ground sesame seeds which is used as an ingredient in manufactured products such as houmous and is available for sale in the UK.

69. In my view, the overall impression of the applicant's mark is contained in the complete phrase, though the words 'Toum' and 'Tahini' are more distinctive than the ampersand, which nevertheless plays a role. Neither word is more dominant or distinctive than the other. That is obviously based on the assumption that both words will be equally perceived as invented words or as the names of food products. Indeed, if one word is perceived as invented and the other one is understood as the name of a food product, that would affect the distinctiveness of the words with the one perceived as invented having the greater weight in the overall impression.

Visual and aural similarity

70. Visually and aurally, the word 'Toum' is found identically at the beginning of the applicant's marks. The applicant's marks contain an ampersand and a further word which are not replicated in the opponent/proprietor's mark. The stylisation of the words in the applicant's marks is minimal, and the rectangular backgrounds are banal, so their impact is, if not negligible, very small. I consider the marks to be visually and aurally similar to a medium degree.

Conceptual similarity

71. Next, I turn to the conceptual comparison of the marks.

72. Conceptually, both the words 'toum' and 'tahini' appear in online dictionaries, the word 'tahini' being defined as "*a paste made from sesame seeds originating in the Middle East, often used as an ingredient of hummus and other dips*".⁸ Whilst there is evidence of both products being available for sale in the UK, they are the names of foods originating from the Middle East and there is no evidence that they are the staple diet of the UK average consumer or that they are known by a significant proportion of the UK average consumers. The fact that both parties accepted that 'toum' and 'tahini' are food products, does not mean that it is established that the average consumer's perception of the words will be that of the names of food products - and the opponent denied that average consumer will have that knowledge. Consequently, I will allow for multiple scenarios according to whether the average consumer is aware of the meaning of the words.

73. On that basis, I consider that (a) the earlier mark will be perceived either as an invented word (by those who do not know what 'Toum' means) or will be assigned its ordinary dictionary definition of a garlic sauce originating from the Middle East (by those who know what 'Toum' means) (b) the same applies to the words 'toum' and 'tahini' in the contested marks. Accordingly, I find that for those consumers who know what 'toum' and 'tahini' means, the marks are conceptually similar to a medium degree

⁸ Collins online dictionary

insofar as they coincide in the concept conveyed by the word 'toum'. Whereas for those consumers who do not know what 'toum' and 'tahini' means, a conceptual comparison is not possible. Finally for those consumers who know the meaning of 'tahini' but not that of 'toum', the marks are conceptually different.

Distinctive character of earlier mark

74. 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).”

75. Registered trade marks possess various 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. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

76. The opponent/proprietor make no claim to enhanced distinctiveness through the use made of the earlier mark, therefore I only have the inherent distinctiveness of the mark to consider. Depending on whether the word 'toum' will be perceived as invented or as having the meaning of a garlic sauce from the Middle East, the mark will be distinctive to a high or medium degree respectively.

77. Further, whilst I have previously commented on the mark 'toum' being potentially allusive of restaurant services providing Middle Eastern food, the opponent/proprietor's mark is registered for restaurant services at large and can be used in relation to restaurants which do not provide Middle Eastern food. Hence, even if the average consumer is aware of the meaning of the word 'toum', the mark is distinctive to a medium degree.

Likelihood of confusion

78. 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 marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, 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 marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

79. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

80. Earlier in this decision, I concluded that:

- The parties' services are identical;
- The average consumer is a member of the general public who will select the services by predominantly visual means, although not discounting aural considerations and will, on average, pay a medium degree of attention to the selection of such services;
- The competing marks are visually and aurally similar to a medium degree. Conceptually, the marks are, at best, similar to a medium degree. Alternatively, the marks are conceptually different, or a conceptual comparison is not possible;
- The earlier mark is inherently distinctive to a medium degree (if the average consumer knows the meaning of the word 'toum') or a high degree (if the average consumer perceives the word 'toum' as invented).

81. The applicant's case on the likelihood of confusion is as follows:

“Consequently, the Later Mark, as a whole, is distinguishable from the Earlier Mark because TOUM is not the dominant element of the Later Mark. Instead, TOUM is codominant with TAHINI so that TOUM & TAHINI is distinguishable from just TOUM. The juxtaposition of TOUM and TAHINI allows the Later Mark to have a greater level of inherent distinctiveness to the Earlier Mark to the effect that TOUM & TAHINI will not give rise to a likelihood of confusion with TOUM, which will be considered to be a direct reference to a food product rather than a trade mark. The perception of the Later Mark (by being a juxtaposition of two food products) will reinforce this perception of the Earlier Mark”.

82. It seems to me what the applicant is saying is that if the average consumer who happened to be familiar with the origin and the meaning of the word 'toum' (and 'tahini') were to encounter the competing marks used in relation to two different restaurants both offering 'toum' as part of their Lebanese or Middle East menu, the average consumer would appreciate the allusive connotation of the words 'toum' and would not

be surprised in finding that the word was chosen by different traders to evoke the same idea of food originating from Lebanon or the Middle East.

83. However, as this is an opposition, I cannot limit my consideration to the actual (or intended) use of the contested mark by the applicant; rather, I must consider all possible (notional) uses of both the contested mark and the opponent/proprietor's mark in relation to the services covered by the application and the earlier mark respectively, including in relation to restaurant services offering food other than from Lebanese or Middle East cuisine - in this connection, I note that the applicant's specification includes terms like Spanish, tempura, Japanese and sushi restaurants which are a quite a culinary leap from Middle Eastern cuisine.

84. Further, when considering use of the competing marks in relation to restaurant services offering food other than from Lebanese or Middle East cuisine, it is even more unlikely that the average consumer would understand the word 'toum' and 'tahini' as the names of two condiments because they are not part of the staple diet of the UK consumers.

85. In such circumstances, taking into account (i) the high degree of distinctiveness of the shared element 'toum' which will be perceived independently in the applicant's mark (by what I consider to be a significant part of the relevant public) as an invented word or as a word of foreign origin whose meaning is unknown, and (ii) the identity of the services, it is likely that the average consumer would directly mistake the marks or that, having noticed the presence of the word ' tahini' in the applicant's mark, he/she will perceive the applicant's mark as another chain of restaurants originating from the proprietor of the earlier mark, or an undertaking economically connected to it.

86. There is a likelihood of confusion.

87. The opposition under Section 5(2)(b) is successful.

OVERALL OUTCOMES

88. The applicant's application to invalidate the opponent/proprietor's mark UK00003635174 has failed. Subject to any appeal against my decision, the opponent/proprietor's mark UK00003635174 will remain registered in the UK.

89. The opponent/proprietor's opposition against the applicant's mark UK00003711860 has succeeded. Subject to any appeal against my decision, the applicant's mark UK00003711860 will be refused.

COSTS

90. The opponent/proprietor has been successful and is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. I note that the opponent/proprietor was required to defend an invalidation action which did not succeed, and I have taken these costs into account in the overall assessment. I award costs on the following basis:

Preparing an opposition and defence/counterstatement and considering the other side's pleadings:	£500
Preparing evidence and considering the applicant's evidence:	£500
Attending a hearing:	£700
Official fees:	£100
Total:	£1,800

91. I therefore order Toum and Tahini Ltd to pay Tarek Farah the sum of £1,800. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 8th day of November 2023

Teresa Perks
For the Registrar