

O-151-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3189818 BY
OTHMANE MELLOUKI**

TO REGISTER:



AS A TRADE MARK

IN CLASS 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000569 BY
OTTO ALBERT TEPASSE**

Background & pleadings

1. On 7 October 2016, Othmane Mellouki (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the services shown in paragraph 12 below.

The application was published for opposition purposes on 28 October 2016.

2. On 30 January 2017, the application was opposed in full by Otto Albert Tepassee (“the opponent”) under the fast track opposition procedure. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon United Kingdom registration no. 3011784 for a series of two trade marks i.e.

OTTO’S and  which have an application date of 27 June 2013, a registration date of 17 January 2014 and which stand registered for the services shown in paragraph 12 below. The opponent states:

“The distinctive and dominant word element of the application is identical to the opponent’s registration. The application only differs by the addition of a pizza logo and the non-distinctive/descriptive words “Pizza, Burgers and Pasta”. The marks are phonetically identical and visually virtually identical. Conceptually, the shared identical word OTTO’S is identical. The services are identical, highly similar or complementary...”

3. The applicant filed a counterstatement in which the basis of the opposition is denied. He states:

“We consider our trademark (based on stylisation) to be significantly different to that of the opponent’s...There is no likelihood of confusion; the opponent has a French restaurant in London whilst our fast food outlet is in Liverpool...”

4. In these proceedings, the opponent is represented by Keltie LLP; following the filing of his counterstatement, the applicant has been represented by McEntegart Legal Limited.

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

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

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

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; both parties filed written submissions which I will refer to, as necessary, below.

DECISION

8. The opposition is based upon section 5(2)(b) of the Act, which reads 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.”

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. The registration upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this earlier trade mark is not subject to proof of use, the opponent is entitled to rely upon all of the services it has identified.

Section 5(2)(b) – case law

11. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of services

12. The competing services are as follows:

The opponent's services	The applicant's services
<p>Class 43 - Services for providing food and drink; restaurants; coffee shops; cafeterias; bistros; brasseries; snack bars, canteens, eating and drinking establishments, bars, wine bars, public houses, taverns, catering services, take-away services relating to food and drink, fast-food outlets, provision of food, of meals and of drinks, arranging and/or booking of meals including reservation services.</p>	<p>Class 43 - Catering (Food and drink -); Catering in fast-food cafeterias; Outside catering services; Pizza parlors; Preparation of food and drink; Providing food and drink for guests in restaurants; Take-away fast food services.</p>

13. I begin by reminding myself that in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution

(HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

14. In his submissions, the applicant reiterates a comment made in his counterstatement. He states:

“4. The opponent claims that he and the applicant’s services are “identical, similar or complementary”. This is not the case. The opponent has a French restaurant in London whilst the Applicant has a pizza and fast food outlet in Liverpool...”

15. That submission proceeds on a basic misunderstanding of the comparison I am required to make. As neither parties’ specifications are limited in any way and as the opponent’s registration is not subject to proof of use, inter alia, the geographical areas in which the competing trade marks may actually be used are irrelevant. What I must do, is compare the words as they appear in the specifications applied for and registered.

16. Although the applicant’s services may be considered to be identical or similar to a number of the services in the opponent’s specification, the most obvious areas of conflict are as follows.

“Catering (food and drink)”, “catering in fast-food cafeterias”, “outside catering services” and “preparation of food and drink” in the application, are all encompassed by (at least) the term “catering services” appearing in the opponent’s specification; the competing services are, as consequence, identical on the principle outlined in *Meric*;

“Providing food and drink for guests in restaurants” and “pizza parlors” would be encompassed by (at least) “restaurants” in the opponent’s specification; the competing services are, once again, identical on the *Meric* principle.

Finally, “take-away fast food services” in the application is simply an alternative way of describing “take-away services relating to food and drink” in the opponent’s specification.

In summary, all of the applicant’s services are identical to those of the opponent.

The average consumer and the nature of the purchasing act

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the services at issue; I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

18. The average consumer of the services at issue is a member of the general public. As such services are most likely to be selected having considered, for example, promotional material (in hard copy and on-line) and signage appearing on the high street, visual considerations will be an important part of the selection process. However, as such services are also, in my experience, likely to be the subject of word-of-mouth recommendations, aural considerations must also be kept in mind. The degree of care the average consumer will display when selecting such services is likely to vary considerably. Contrast, for example, the degree of care likely to be paid when one selects a venue for an impromptu cup of coffee, with the time and effort one might take selecting a restaurant for an important family event.

Comparison of trade marks

19. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

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

21. Although the opponent’s registration consists of a series of two trade marks, in its submissions, the opponent relies only upon the non-stylised version of its trade mark. As a consequence, the trade marks to be compared are as follows:

The opponent’s trade mark	The applicant’s trade mark
OTTO’S	

22. In his submissions, the applicant states:

“1. The opponent claims that the word “Otto” is the distinctive and dominant element of the mark. It is not. The stylisation of the applicant’s mark (the black background, the cut pizza shape within the letter “O” and the joined “TT”s) provides sufficient distinctiveness.

2. The opponent claims that both marks are phonetically identical. They are not. The applicant’s mark relies on a visual presentation. The applicant’s mark includes “pizza, burgers, pasta” which are not referenced at all in the opponent’s mark.”

23. The trade mark upon which the opponent relies consists of five letters presented in upper case. Between the final letter “O” and the letter “S” there appears an apostrophe symbol indicating possession. The trade mark’s overall impression and distinctiveness lies in its totality.

24. The applicant’s trade mark consists of a number of components. The rectangle presented in black merely acts as a background upon which the other contrasting components appear; it has little or no distinctive character. Irrespective of their size, positioning or colour in which they are presented, when considered in the context of the services at issue, the words “PIZZA”, “BURGERS” and “PASTA” are self-evidently descriptive; they will, as a consequence, make little or no contribution to the overall impression the applicant’s trade mark conveys; the vertical white lines which separate these words will either go unnoticed, or if noticed, will make no contribution to the trade mark’s overall impression or distinctiveness.

25. Both parties appear to agree that the device present in the trade mark is intended to represent a pizza, with the applicant describing it as a “cut pizza shape within the letter “O””. Given its size and positioning and as the device is, in my view, somewhat unusual, even in relation to services relating to pizza, it will make a not insignificant contribution to the overall impression the trade mark conveys and its distinctiveness.

26. As to the remaining letters and punctuation symbol which appear in the trade mark and which are presented in yellow, the underlining appearing below the letter “S” is likely to go largely unnoticed; if it is noticed, it will make little or no contribution to the trade mark’s overall impression or distinctiveness. The first occurrence of these letters appears to the right of the device component, are clearly significant within the context of the trade mark as a whole and will make a significant distinctive contribution to the overall impression the trade mark conveys. The second occurrence (which appears below the device component) is much smaller and simply mirrors the first occurrence mentioned above. As to the letters themselves, the applicant refers to the joined “TT”s. While I accept the letters “TT” are joined, that does nothing to prevent them from being seen as two letter “T”s. In short, the letters appearing in the applicant’s trade mark will, in my view, be understood by the average consumer as the letters “O-T-T-O-S”; the fact that the letter “S” is somewhat smaller than the other letters does not affect that conclusion. When considered as a totality, these letters and the apostrophe symbol which accompanies them will, in my view, be understood in exactly the same way as the letters and apostrophe symbol in the opponent’s trade mark.

The visual, aural and conceptual comparison

27. Notwithstanding that the applicant’s trade mark is presented in the colours black, yellow and white, the fact that the competing trade marks either consist exclusively of or contain a component (which makes a significant distinctive contribution to the overall impression the trade marks convey) which the average consumer would construe as the letters and symbol “O-T-T-O’S”, results in at least a medium degree of visual similarity between them.

28. As to the degree of aural similarity, while I note the applicant’s comments reproduced above, they miss the point. It is well-established that when a trade mark consists of a combination of words and figurative elements, it is by the word elements that the trade mark is most likely to be referred. The words “PIZZA”, “BURGERS” and “PASTA” are most unlikely to be articulated when the trade mark is referred to aurally. Having already concluded that the letters and symbol appearing in the competing trade marks will be understood in exactly the same way, the

manner in which these letters are presented in the applicant's trade mark does not affect the aural comparison. The competing trade marks are, in my view, aurally identical i.e. they will both be referred to by the average consumer as the two syllable word "OT-TOS".

29. Finally, the conceptual comparison. The concept conveyed by the opponent's trade mark is of an unspecified something belonging to a man called OTTO. The applicant's trade mark sends the same conceptual message, albeit limited to pizza, burgers and pasta. If not conceptually identical, the competing trade marks are conceptually similar to a high degree.

Distinctive character of the earlier trade mark

30. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

31. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it may have made of its earlier trade mark. In my experience, it is fairly commonplace for establishments providing the services at issue in these proceeding to do so by reference to both male and female forenames. Although OTTO will be understood as a male forename by the average consumer, it is, in my experience, a relatively uncommon forename in this country. Absent use, the opponent's trade mark is possessed of an average degree of inherent distinctive character.

Likelihood of confusion

32. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the competing services are identical;
- the average consumer is a member of the general who will select the services at issue using a combination of visual and aural means and whose level of attention will vary considerably during that process;
- the overall impression and distinctiveness of the opponent's trade mark lies in its totality;
- the overall impression and distinctiveness of the applicant's trade mark lies in a combination of the device component and letters and symbol which will be understood by the average consumer as OTTO'S;
- the competing trade marks are visually similar to at least a medium degree, aurally identical and conceptually similar to at least a high degree;
- the opponent's earlier trade mark is possessed of an average degree of inherent distinctive character.

33. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where

the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks/services down to the responsible undertakings being the same or related.

34. In reaching a conclusion, I will proceed on the basis most favourable to the applicant i.e. the average consumer will pay a high degree of attention to the selection of the services at issue, thus making them less prone to the effects of imperfect recollection. However, even in those circumstances, having reminded myself that, inter alia, identical services are involved and the degree of similarity in the competing trade marks I have identified earlier, there remains, in my view, a likelihood of confusion. Whilst the differences in the competing trade marks are likely to avoid a likelihood of direct confusion from a visual perspective, that would not be the case when aural considerations are taken into account. However, even when considered from a visual perspective, the presence of a component in the applicant's trade mark which the average consumer would construe as OTTO'S and which makes a significant contribution to both the overall impression the trade mark conveys and its distinctiveness will, in my view, lead the average consumer to assume that the undertakings using the competing trade marks are the same or economically linked i.e. there will be indirect confusion.

35. In reaching the above conclusion, I have not overlooked the following comment which appeared in the applicant's submissions:

"5. The opponent claims that there is an inevitable likelihood of confusion. However, the opponent offers no evidence to show that there has been confusion. The applicant has had no experience of any confusion between it and the opponent's restaurant."

36. This submission does not assist the applicant for the reasons explained below. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

"80.the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign

have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

37. The absence of evidence of actual confusion is not particularly surprising if, as the applicant states, the parties are currently operating in different geographical locations.

Overall conclusion

38. The opposition has succeeded and, subject to any successful appeal, the application will be refused.

Costs

39. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. Using that TPN as a guide, I award costs to the opponent on the following basis:

Official fee:	£100
Preparing a statement and considering the applicant's statement:	£ 200
Written submissions:	£ 200
Total:	£500

40. I order Othmane Mellouki to pay to Otto Albert Tepassee the sum of £500. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of March 2017

C J BOWEN
For the Registrar