

O-194-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2592050
BY
JOHN RENNIE
TO REGISTER THE TRADE MARK



IN CLASS 43

AND

THE OPPOSITION THERETO
UNDER NO 102734
BY
GEORGE V EATERTAINMENT

BACKGROUND

1. On 17 August 2011, John Rennie (hereafter the applicant), applied to register the above trade mark in class 43 of the Nice Classification system, as follows:¹

Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; crèche services.

2. Following publication of the application on 7 October 2011, George V Eentertainment (the opponent) filed notice of opposition against the application.

3. The grounds of opposition were brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4. The opposition is directed at all of the applicant's services in class 43. The opponent relies upon the mark shown below in so far as it is registered for the following services:

MARK DETAILS AND RELEVANT DATES	SERVICES RELIED ON
CTM: 2695005 MARK: BUDDHA-BAR Filing date: 13 May 2002 Registration date: 8 September 2003	Class 43: Restaurant services (food).

5. In its statement of grounds the opponent submits:

"4. The trademark Buddha-Bar is well-known and highly distinctive for services of restaurants and bars, the word "Buddha" being the main of [sic] this trademark. The opposite trademark is named "Sugar Buddha" but the word Buddha is the most important of this trademark, sugar being hard tu [sic] read in the letter "b" of Buddha. The two trademarks are then similar, and the services covered by the opposed trademark are identical to or similar to those covered by the earlier trademark."

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

6. On 9 March 2012, the applicant filed a counter statement. It denies the grounds on which the opposition is based.

7. Four of the opponent's marks are earlier marks, which, in principle, are subject to proof of use because, at the date of publication of the application, they had been registered for five years.² However, at section 5 of its counter statement the applicant has answered "NO" when asked if it requires the opponent to provide proof of use. Therefore I need consider it no further.

8. The opponent filed evidence, neither party filed submissions in lieu of attendance at a hearing. Neither party requested a hearing, both content for a decision to be made from the papers on file.

EVIDENCE

9. The opponent's evidence consists of a witness statement, dated 25 October 2012, in the name of Frank Fortet, General Director of the opponent company. There are five exhibits attached to the witness statement which refer to t-shirts, incense, a snow ball, a silk scarf and chocolates. None of the exhibits and no part of the witness statement refers to the services in class 43 relied upon by the opponent and therefore I do not summarise it here. I refer to submissions included with the evidence as necessary below.

DECISION

10. Section 5(2)(b) of the Act reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

Relevant case law

11. In his decision in *La Chemise Lacoste SA v Baker Street clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel*

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

B.V. [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing act

12. In accordance with the above cited case law, I must determine who the average consumer is and consider the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of goods at issue. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

13. The parties' respective specifications include a number of services. Restaurant, bar and catering services and the booking services for the same will for the most part be provided to members of the general public. The degree of attention paid to such purchases will vary. A consumer visiting a bar on impulse is unlikely to pay as much attention as someone visiting a restaurant for a special occasion, though, in my view neither of these will illicit any more than a reasonable degree of attention.

14. Holiday accommodation and booking is also likely to be directed at members of the general public. I would expect the level of attention being paid to be higher than that for bar and restaurant services since the purchase is likely to be more expensive and less frequent.

15. Temporary accommodation services may be provided to members of the general public or to businesses. The level of attention paid is likely to be higher than that paid for bar and restaurant services but not as high as the attention which will be paid when booking a holiday.

16. Crèche services will be used by members of the general public who are parents/guardians and are likely to be fairly regular services ranging in price from fairly inexpensive, where the crèche is for short term care at, for example a shopping centre, to expensive nursery care. The level of attention paid will be at least reasonable to the extent that the average consumer will want to ensure proper care for their child/children.

17. Retirement home services are expensive, infrequent purchases which will be used by members of the general public for long term care of the elderly. The level of attention paid is likely to be at least reasonable as the average consumer will be seeking care for themselves or a loved one and will have many criteria to consider.

Comparison of services

18. The services to be compared are as follows:

Opponent's services	Applicant's services
Class 43 Restaurant services (food).	Class 43 Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; crèche services.

19. In comparing the services, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

"29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

20. Other factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

- (a) the respective *uses* of the respective goods or services;
- (b) the respective *users* of the respective goods or services;
- (c) the *physical nature* of the goods or acts of service;
- (d) the respective *trade channels* through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

21. I also bear in mind the decision in *El Corte Inglés v OHIM* Case T-420/03, in which the court commented:

"96...goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi [2005] ECR II-685)"

22. I also take note of the case of *Les Éditions Albert René V Office for Harmonisation in the Internal Market (Trade Marks & Designs) (OHIM) T-336/03*, where it was held:

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

23. Additionally, there is the guidance provided in *Avnet Incorporated v Isoact Limited* - [1998] F.S.R. 16 (HC):

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

24. Where appropriate I will, for the purposes of comparison, group related services together in accordance with the decision in *Separode Trade Mark* BL O-399-10 (AP):

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

25. The term ‘restaurant services (food)’ in the opponent’s specification is included within the terms ‘services for providing food and drink; restaurant, bar and catering services’ in the applicant’s specification. In accordance with *Meric* these are identical services.

26. Temporary accommodation, provision of holiday accommodation and booking of holiday accommodation are self evidently accommodation services. Even where the accommodation may include a restaurant, the core meaning of the service is the booking of accommodation. In accordance with the decision in *Avnet*, these services are not the same as restaurant services (food), which provide food to the average consumer within a restaurant. Consequently, I find these services to be dissimilar.

27. The application also includes retirement home services and creche services. The opponent is seeking to rely on restaurant services (food). The fact that residents of retirement homes and children in a crèche may be fed as part of the service is too tenuous a link to provide any meaningful degree of similarity. In the absence of any submissions from the opponent to explain why it considers these services in class 43 of the applicant’s specification to be similar to its own services in class 43; and having considered the nature of the services, their intended purpose, their method of use and whether they are in competition with each other or are complementary, I can find no meaningful areas in which the competing services coincide. As a consequence, retirement home services and crèche services are not, in my view, similar to any of the opponent’s services.

28. Finally, the applicant’s specification includes booking and reservation services for restaurants. A restaurant booking service goes beyond the consumer telephoning a restaurant to make a reservation. Such services are provided by third party companies which may be contacted by the consumer, the booking then being taken by the third party company on behalf of the restaurant. From the point of view of the consumer the end result is the same, the purpose being to make a reservation and dine at the restaurant of their choice. However, the service is a step removed from the restaurant services themselves. Consequently, I find there to be a moderate degree of similarity between these services and the restaurant services (food) relied upon by the opponent.

Comparison of marks

29. The marks to be compared are as follows:

The opponent’s mark	The applicant’s mark
	<p style="text-align: center;">BUDDHA-BAR</p>

30. In making a comparison between the marks, I must consider the respective marks’ visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components³, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

31. I note that with its counter-statement the applicant provided a ‘clearer version [of the] proposed device’. However, in reaching a decision on the similarity of the marks at issue I must consider the mark as it appears on the UK Trade Marks Register, which is the version presented above.

32. The applicant states that its mark is ‘SUGAR BUDDHA’, the word ‘SUGAR’ being included at a ninety degree angle in the left hand side stem of the letter ‘b’. The mark as it appears on the register does not clearly show this to be the case. A degree of texture is evident within the letter ‘b’ and also above the first letter ‘d’, in the bowl of the second letter ‘d’ and above and within the final letter ‘a’. However, I am unable to conclude what this is intended to represent to the average consumer. The mark consists of the word ‘buddha’ presented in gold lower case lettering on a rectangular brown background. The background shape is unlikely to be paid any attention by the average consumer. In my experience it is the type of background which is commonly seen in trade marks. The dominant and distinctive element of the applicant’s mark is the word ‘buddha’ as this is the only discernible element of the mark.

³ *Sabel v Puma AG, para.23*

33. The opponent's mark consists of the words BUDDHA-BAR in plain upper case type. The word 'BAR' in the context of the services in class 43 is not particularly distinctive. The dominant, distinctive element of the mark is the word BUDDHA.

Visual similarities

34. The opponent's mark consists of the words 'BUDDHA-BAR' presented in plain block capitals. The applicant's mark is the word 'buddha' presented in lower case in gold on a brown rectangular background. The word has some element of texture, though, as I have concluded above, this is not clear and is likely to go unnoticed by the average consumer. The mark is not limited to colour and, as such, it is necessary for me to consider it as being "drained of colour" in line with the guidance provided in *Specsavers* [2010] EWHC 2035 (Ch), para 119.

35. Any similarity between the marks rests in the word BUDDHA, which is the first word of the opponent's mark and the only clearly visible word in the application. Consequently, I find there to be a high degree of visual similarity.

Aural similarities

36. Aurally the opponent's mark will be pronounced BUD-DHA-BAR; the applicant's mark will be pronounced BUD-DHA. Consequently, there is a high degree of aural similarity between the marks.

Conceptual similarities

37. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁴ The assessment must be made from the point of view of the average consumer.

38. Buddha is defined as:

*'A title applied to Gautama Siddhartha, a nobleman and religious teacher of N India, regarded by his followers as the most recent rediscoverer of the path to enlightenment: the founder of Buddhism (c.563–c.483 bc).'*⁵

39. The average consumer cannot be assumed to know the meaning of everything. In the *Chorkee* case (BL O-048-08), Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

"36. By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one's own personal experience, knowledge and assumptions are more widespread than they are.

⁴ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

⁵ http://www.credoreference.com/entry/hcengdict/buddha_noun_the_563_483_bc- accessed 8 May 2013

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.”

40. Similarly in this case, I am aware of the identity of Buddha and can establish the fact very quickly, however, in the absence of any evidence from the parties, I am not able to take judicial notice of the fact that the average consumer for, inter alia, restaurant services, would know that. However, I can conclude that the average consumer will consider the word Buddha to relate to a religious figure even if they are not aware of his exact identity or the religion to which he is connected.

41. Whatever the average consumer’s knowledge of the Buddha actually is, it will be the same in respect of both marks. I have already concluded that the additional word ‘bar’ in the opponent’s mark is non-distinctive for the services in class 43. Taking all of these factors into account, I find the marks to possess a very high degree of conceptual similarity.

Distinctive character of the earlier mark

42. 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 used as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber* and *Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As no evidence of use has been filed I can only consider the inherent distinctive character of the earlier mark.

43. The word ‘bar’ in the earlier mark is not distinctive for the particular services in class 43. The word BUDDHA does not serve to describe or allude to the services and is distinctive. In combination I find there to be a normal level of distinctive character.

Likelihood of confusion

44. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled

perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁶ I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to 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.

45. I have found the marks to be visually and aurally highly similar and, conceptually, very highly similar. I have found there to be a normal level of inherent distinctive character in the earlier mark and have found the services to be identical in the case of 'services for providing food and drink' and 'restaurant, bar and catering services' and moderately similar in the case of 'booking and reservation services for restaurants'. I have found the remaining services to be dissimilar. I have identified the average consumer, namely a member of the general public and have concluded that the level of attention paid to the purchase will vary from reasonable in the case of a casual visit to high where the consumer is purchasing retirement home services.

46. In the case of services which I have concluded are dissimilar, I need not go on to consider the likelihood of confusion.⁷ In respect of the remaining services, taking all of these factors into account the similarity of the marks is such that in the context of services which possess a reasonable degree of similarity there will, in my view, be direct confusion (where one mark is mistaken for the other). Even if I am wrong in this, there will be indirect confusion (where the average consumer believes the respective services originate from the same or a linked undertaking).

Conclusion

47. The opposition fails in respect of temporary accommodation, provision of holiday accommodation, booking and reservation services for holiday accommodation, retirement services and crèche services.

48. The opposition succeeds in respect of 'services for providing food and drink, restaurant, bar and catering services' and 'booking and reservation services for restaurants.'

Costs

49. Both the opponent and the applicant have achieved a measure of success. Consequently, the parties should bear their own costs and I decline to make an award.

Dated this 14th day of May 2013

**Ms AI Skilton
For the Registrar,
The Comptroller General**

⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27.

⁷ *The test is a cumulative one, see Vedral SA v OHIM C-106/03*

