

O-217-18

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NOS. 3137077 & 3135664
BY KUNALINGAM KUNATHEESWARAN
TO REGISTER



AND

Metro's Fried Chicken

AS TRADE MARKS
IN CLASS 43
AND OPPOSITION THERETO (UNDER NOS. 406145 & 406147)
BY
ASSOCIATED NEWSPAPERS LIMITED

Background & Pleadings

1. Kunalingam Kunatheeswaran ('the applicant') applied to register the word only mark **Metro's Fried Chicken** on 11 November 2015. This was published on 27 November 2015. The applicant also applied for the stylised word mark  on 20 November 2015, which was published on 4 December 2015.

2. The above trade marks have been applied for in class 43 for the same services, namely, *Fast food restaurant services*.

3. Associated Newspapers Limited ('the opponent') opposes both marks under Section 5(2)(b)¹ of the Trade Marks Act 1994 (the Act) on the basis of three earlier UK trade marks for services in class 42 as set out below.

UK TM 2233378 metro.co.uk metro.com (series of 2) Filing date: 22 May 2000 Registration date: 17 March 2017	Class 42: Restaurant services
UK TM 2192465 METRO LONDON Filing date: 22 March 1999 Registration date: 17 March 2017	Class 42: Cookery services
UK TM 2232683 METRO MOMENT Filing date: 17 May 2000 Registration date: 17 March 2017	Class 42: Restaurant services

¹ The opposition initially also relied upon sections 5(3), 5(4)(a) and further earlier trade marks. Having failed to file evidence to support the additional grounds, they were subsequently withdrawn in the opponent's submissions of 7 February 2018.

4. The opponent's trade marks are earlier marks, in accordance with section 6 of the Act and, as they have not been registered for five years or more before the publication date of the applicant's mark, they are not subject to the proof of use requirements, as per section 6A of the Act.

5. The applicant filed a counterstatement denying the grounds of opposition.

6. The applicant is represented by HGF Limited in these proceedings and the opponent by Haseltine Lake LLP.

7. Neither party requested to be heard. Only the opponent filed written submissions in lieu. I make this decision on the basis of the material before me.

Section 5(2)(b)

8. Section 5(2)(b) of the Act is 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. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 the services

10. The services to be compared are:

Opponent's services	Applicant's services
Restaurant services Cookery services	Fast food restaurant services

11. With regard to the comparison of services, in *Canon*, the CJEU stated at paragraph 23 of its judgment that:

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

12. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

13. In relation to the assessment of the respective specifications, I note that in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

14. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and*

Another, [2000] F.S.R. 267, Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

15. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) (*‘Meric’*), the General Court (*‘GC’*) held:

“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 *Vedial 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).”

16. I note that the opponent has *restaurant services* at large in the specifications for two of its earlier marks, namely 2233378 and 2232683, and the applicant has *fast food restaurant services*. As fast food restaurants are a type of restaurant, the services are considered identical on the *Meric* principle.

17. With regard to the opponent’s services for no. 2192465, namely *cooking services*, it submits that

“...these are services provided by a cook or a chef in the preparation of food. Such services might, therefore, be provided for a function or event by a chef who may also work in a restaurant. Also, while restaurant services will not only cover the cooking/ preparation of food, the latter is nonetheless an

essential aspect of the services. For these reasons, therefore, the services “cookery services” and “restaurant services” are similar.”

18. I agree with the opponent’s submission that *cookery services* can involve the preparation of food in the context of a function or event. Using the *Treat* factors outlined above in paragraph 12, the users of the contested services could be the same in that they could be customers looking for food to be prepared for them. The physical nature of the services is shared in the respect that one aspect of restaurant services involves the cooking and preparation of foods. Both the contested services may reach the market through the same trade channels such as advertising on the Internet or in business directories in addition to the traditional shop front on the high street. Taking all these factors into account, I find that these contested services are similar to a medium degree.

Average consumer and the purchasing process

19. I must consider who the average consumers are for the services and how those services are purchased. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

20. 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.”

21. The average consumers for the contested services would be members of the general public. There will be a varying level of attention paid depending on the particular requirements. For example the purchase of a fast food meal is likely to be less considered as these are generally cheaper and a more common casual purchase whereas the selection of a restaurant say for a celebratory event will be a more considered process depending on the event, cost and venue.

22. With regard to the purchasing process, selection of food provision is primarily a visual act. Consumers are likely to read advertising material, menus and the like or search the internet to find a suitable restaurant or they will see the frontage of a restaurant premises. However, I also consider there could be an aural element if restaurants are recommended by word of mouth or if advice is sought regarding allergens, vegetarian or vegan options for example.

Comparison of marks

23. The marks to be compared are:

Opponent's marks	Applicant's marks
metro.co.uk metro.com METRO LONDON METRO MOMENT	 Metro's Fried Chicken

24. 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 Court of Justice of the European Union 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.”

25. 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.

26. The opponent's mark no. 2233378 consists of a series of two marks, **metro.co.uk** and **metro.com** presented in plain font. The overall impression of the marks and their distinctiveness rests solely on this presentation.

27. The opponent's mark no. 2192465 consist of two words, **METRO LONDON**, in plain block capitals. The overall impression of this mark is based solely on these words. However as LONDON is a well-known geographical location, and it is likely to be seen as the place where the services are provided or originated, it carries less weight than the word METRO.

28. The opponent's mark no. 2232683 consist of two words, **METRO MOMENT**, in plain block capitals. The overall impression of this mark is based solely on these words. There is nothing about this presentation which suggests that one word would have more weight than the other. The two elements make an equal contribution to the overall impression of the opponent's mark.

29. The applicant's mark no. 3137077 consists of a single word, **Metro's**, depicted in white and in a manuscript style of font, on a red square background. The overall impression of the mark and its distinctiveness rests on the word and the presentation.

30. The applicant's mark no. 3135664, consists of three words **Metro's Fried Chicken** in title case. The overall impression of the mark is based solely on these words. However given that the services are for fast food restaurants, the words **Fried Chicken** are likely to be seen as a descriptor of the type of fast food provided.

31. In a visual comparison, all of the marks share the common element **METRO**. The applicant's marks have an additional element in the '**S** ending which usually denotes a possessive form of the word and the mark no. 3135664 has the words **Fried Chicken**. As previously stated, these words will be seen as a descriptor of the fast food provided. With regard to the opponent's additional elements, **.co.uk** and **.com** are well known as internet domain suffixes and are themselves regarded as non-distinctive elements, whereas **London** and **Moment** are distinctive visual elements. Overall I find there is a medium degree of visual similarity.

32. In an aural comparison, the common element **METRO** will be pronounced in the same way for each mark. The other additional elements are also likely to be vocalised. I find there is a medium degree of aural similarity.

33. For the conceptual comparison, the opponent submits that,

“...whatever significance is applied to the word METRO by the average consumer will be applied equally to the earlier trade marks and the opposed marks. The descriptive words or non-distinctive matter that appears in conjunction with the word METRO in the trade marks has its own concept, but this does not alter the conceptual impact – if any- of the word METRO on the average consumer.”

34. I agree with the opponent that whatever message is brought to mind by the common element **METRO**, it will be same for each of the marks. The applicant's marks will be seen as the possessive form of the word **METRO** and the opponent's mark no. 2233378 (series of two marks) will be seen as domain names for **METRO**. Turning to the two remaining opponent's marks no. 2192465 will bring to mind a location, London, having some connection with **METRO**. With regard to the **London** element of the mark, it is most likely that the average consumer will see it just as the

geographical location and will attach no further conceptual significance to it. It is not uncommon for geographical place names to feature in trade marks and consumers are used to seeing it. Earlier right no. 2232683 will bring to mind a measure of time, a **Moment**, having some connection with **METRO** but has no other conceptual significance. Taking these factors into account, I find there is a high degree of conceptual similarity.

Distinctiveness of the earlier marks

35. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

36. I have no evidence before me with regard to use of the earlier marks so I can only consider their inherent distinctiveness. The common element in all three earlier marks, **METRO**, is an ordinary dictionary word with no meaning in relation to the services at issue. Of the other elements, **.co.uk** and **.com** are non-distinctive and neither **London** nor **Moment** describe the services for which the marks are registered. Overall I find each of the earlier rights to be inherently distinctive to an average degree.

Likelihood of confusion

37. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 9:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

38. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’. Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

39. So far I have found that some of the contested services are identical and some are similar to a medium degree and that they are primarily purchased visually by the general public who will be paying a varying level of attention during the purchasing process. With regard to the comparison of the marks, I have found that they are visually and aurally similar to a medium degree. For the conceptual comparison, I found the marks were conceptually identical for the shared element **METRO**. With regard to the additional elements, the words **fried chicken** and **.co.uk.com** are respectively descriptive and non-distinctive, the word London will simply denote the geographical location and **METRO MOMENT** is not considered to amount to more than the sum of its constituent parts.

40. Based on the marks and the services before me and taking into account the assessments I have made, and the comments made by Mr Purvis outlined above, I find that the distinctive character of the earlier marks lies in the word **METRO** and it is this element which is shared by the applicant’s marks. The possessive form of the word **METRO** in the applicant’s non-possessive form makes no significant conceptual difference in comparison with the opponent’s marks. I find that there a likelihood of confusion between the applicant’s marks and the earlier marks.

Conclusion – Opposition 406145

41. The opposition succeeds under section 5(2)(b) and, subject to any successful appeal against this decision, the application is refused.

Conclusion – Opposition 406147

42. The opposition succeeds under section 5(2)(b) and, subject to any successful appeal against this decision, the application is refused.

Costs

43. As the opponent has been successful, it is entitled to a contribution towards the costs incurred in these proceedings. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4/2007 (which was in force when the opposition was filed). Bearing in mind the guidance given in TPN 4/2007, I award costs as follows:

£200 Official fees for filing two Notices of Opposition

£400 Preparing the two Notices of Opposition

£200 Preparing submissions

£800 Total

44. Although official fees of £200 were paid on each opposition case on the basis that additional grounds were pleaded, these additional grounds were subsequently withdrawn by the opponent and the cases proceeded on the basis of Section 5(2) only. Therefore the official fees have been reduced accordingly.

45. I order Kunalingam Kunatheeswaran to pay Associated Newspapers Limited the sum of £800. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of April 2018

June Ralph

For the Registrar,

The Comptroller General

