

O-249-18

**TRADE MARKS ACT 1994**

IN THE MATTER OF APPLICATION NO 3182642  
FOR REGISTRATION OF THE TRADE MARK



STANDING IN THE NAME OF MITCH SORBIE

AND

OPPOSITION THERETO UNDER NO 408138  
BY JUST EAT HOLDING LTD

## Background

1. Application no 3182642 seeks registration of the trade mark shown on the front cover of this decision. It stands in the name of Mitch Sorbie (“the applicant”) and has a filing date of 27 August 2016. Following amendments to the specification, the applicant now seeks registration for the following services:

### Class 43

Restaurant services; catering services; services provided by snack bars, cafes, canteens and fast-food outlets; food and take away services; none being provided through an online computer network or by any other electronic or online system and none including the sale, order or delivery of third party food and drink products.

2. Following publication of the application in the *Trade Marks Journal* on 23 September 2016, notice of opposition was filed by Just Eat Holding Ltd (“the opponent”). Its grounds of opposition are brought under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and rely on the following European Union trade marks (“EUTM”):

Mark and grounds	Dates	Specification relied upon
13069638 JUST Section 5(2)(b)	Filing date: 9 July 2014 Date of entry in register: 26 September 2015	Services in class 43
13277173  Section 5(2)(b)	Filing date: 19 September 2014 Date of entry in register: 30 April 2015	Services in class 43
14370555 JUST EAT Sections 5(2)(b) and 5(3)	Filing date: 16 July 2015 Date of entry in register: 20 November 2015	Services in class 43 (under section 5(2)(b))

		Services in classes 35, 38 and 43 (under section 5(3))
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3. The applicant filed a counterstatement essentially denying the grounds of opposition. Both parties filed evidence. Matters came before me for a hearing on 17 April 2017 at which the applicant was represented by Ms Puravee Shah of Murgitroyd & Company. The opponent was represented by Mrs Charlotte Blythe of Counsel instructed by Taylor Wessing LLP.

**The evidence**

4. The opponent’s evidence consists of two witness statements both dated 3 July 2017. The first, accompanied by exhibits JS1-JS16, is by James Sporle, Group General Counsel of the opponent company. The second is by Tom Albertini, a Partner and Trade Mark Attorney with J A Kemp, the opponent’s former professional representatives and is accompanied by exhibits TA1-TA2. The applicant’s evidence consists of a single witness statement dated 14 November 2017 by Mitchell Sorbie along with exhibits MS1-MS7. I will refer to the evidence as necessary in this decision.

**Decision**

**The objection under section 5(2)(b) of the Act**

5. The opponent relies on the three EUTMs set out above. Each is an earlier mark within the meaning of the Act. Under this ground, the opponent relies on each of these marks in relation to the services for which they are registered in class 43.

6. Given the inter-relationship between the date of publication of the application and the date of entry in the register of them, the opponent is not required to show proof of use of its earlier marks. It is therefore entitled to rely on each of the services in class 43 for which they are registered. That said, as Mrs Blythe indicated at the hearing it was the opponent’s strongest case, I intend to proceed on the basis of the opponent’s earlier EUTM 13069638 for the word JUST.

7. Section 5(2)(b) of the Act states:

“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”.

8. In determining whether there is a likelihood of confusion, I take note of the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of the respective services**

9. In considering whether goods are identical, I take note of the decision of *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, where the General Court stated that:

“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 trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

The same is true, by analogy, in respect of services.

10. In its counterstatement, the applicant makes no submissions as to the similarity or otherwise of the respective services. In his witness statement, however, Mr Sorbie makes submissions referring to the natures of the respective parties’ businesses. The earlier trade mark is not subject to proof of its use and, as Ms Shah accepted at the hearing, my comparison has to be carried out on a notional basis taking into account the services as registered by the opponent and as applied for by the applicant and not on the basis of what the parties may or may not actually provide. With this in mind, the services to be compared are as follows:

<b>Opponent’s services as registered</b>	<b>Applicant’s services as applied for</b>
Services for providing food and drink; services for providing food and drink enabling customers to place orders for food and drink online; operation of a website and/or online portal for the ordering of takeaway restaurant and restaurant meals; ordering and booking services for restaurants and takeaway restaurants; restaurant and takeaway restaurant services	Restaurant services; catering services; services provided by snack bars, cafes, canteens and fast-food outlets; food and takeaway services; none being provided through an online computer network or by any other electronic or online system and none including the sale, order or delivery of third party food and drink products

11. Whether provided via e.g. a restaurant or snack bar or catered for at some other location and whether for eating in or taking away each of the applicant's services are for the provision of food and drink and are therefore included within (at least) the opponent's "Services for providing food and drink". These of opponent's services are not subject to any restrictions as to their particular method of supply and thus the limitation in the applicant's specification does not alter my finding that, on the basis of *Merix*, these respective services are identical.

### **The average consumer and the nature of the purchasing process**

12. 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*.

13. 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."

14. In her skeleton argument on behalf of the opponent, Mrs Blythe submits that the services are:

"...everyday, inexpensive services directed at the public at large. As such, the average consumer can be deemed to be an ordinary member of the public who is reasonably well informed, circumspect and observant, and who is likely to display a moderate to low degree of attention to detail."

She goes on to submit:

“...that both visual and aural considerations are likely to play a role in the selection process as customers may choose a restaurant to visit based on word of mouth recommendations, by searching on the Internet or by seeing the restaurant itself.”

15. In her skeleton argument, Ms Shah on behalf of the applicant submits the relevant consumer is “the public at large with an average level of attention”.

16. I agree that the average consumer of the services in question is the general public. Whilst the services of a fast-food takeaway may be chosen with a little less attention than those of, say, a restaurant for a special occasion or family celebration, I agree that the level of attention given to the purchase of the services at issue will be no more than average, even where, as Ms Shah submitted, the consumer has particular dietary requirements. I consider the selection process to be primarily a visual one but agree that aural considerations will also play a part.

### **Comparison of the respective marks**

17. The marks to be compared are as follows:

<b>Earlier mark</b>	<b>Application</b>
<b>JUST</b>	

18. The earlier mark consists of the word JUST in plain block capitals. As a single word, no part of which is highlighted in any way, its distinctiveness rests in its whole. This word also appears in the applicant’s mark. Below it, and in smaller font, are the words PIZZA & PASTA. To the left of the word JUST is a line drawing of a slice of pizza and to the right, another of some pasta wrapped around the tines of a fork.

19. Despite Ms Shah's submissions to the contrary, given its size, position and prominence within the mark, and bearing in mind the descriptive nature of the other words and figurative elements appearing within it, it is the word JUST that is the dominant and distinctive element of the applicant's mark.

20. Of course, I have to compare the marks as wholes. They have some visual similarities in that the word JUST appears in both. There are also some visual differences in that the additional words and figurative elements in the applicant's mark have no equivalent in the earlier mark. When considered as wholes, the marks share a medium degree of visual similarity.

21. Ms Shah submitted that the average consumer would refer to the applicant's mark as JUST PIZZA & PASTA. Mrs Blythe disagreed. In my view, the average consumer is unlikely to articulate the words PIZZA & PASTA (and certainly would not do so in respect of the figurative elements of the mark) and, in these circumstances, the respective marks would be aurally identical. Even if the words PIZZA & PASTA are articulated, they would follow the word JUST and are descriptive and taking into account the general rule that the beginnings of marks tend to have more visual and aural impact than endings (see e.g. *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02), I find the respective marks would share a medium degree of aural similarity.

22. In terms of the conceptual comparison, the applicant submits:

“...the respective marks have different meaning (sic) in the English language”.

In her skeleton argument, Ms Shah refers to the dictionary reference set out in exhibit MS7 to Mr Sorbie's witness statement and submits:

“The word comprising the Opponent's mark, “JUST”, is a common English word, which is defined as, *inter alia*, the following according to the Oxford English Dictionary:

- 1) Based on our behaving according to what is morally right and fair. *‘fighting for a just cause’.*

- 2) (of treatment) deserved or appropriate in the circumstances. *'we all get our just deserts'*.
- 3) (of an opinion or appraisal) well founded; justifiable. *'these simplistic approaches have been the subject of just criticism.'*

The Applicant's mark, according to common rules of English usage, would thus be seen as an expression which means "simply pizza and pasta"

Furthermore, "JUST" is an extremely common word in the English language, being either used as an adjective or an adverb.

In the context of both the Opponent's mark and the Applicant's mark the word "JUST" is used in a sense of "simply"; "only"; or "no more than" as defined by the Oxford English Dictionary. The Applicant's mark refers to specific foodstuffs.

The Opponent's mark, by contrast, according to accepted common usage of the English language, could mean either "right and fair" or "only".

23. For the opponent, Mrs Blythe submitted that the word JUST is an ordinary dictionary word in everyday use in the English language which conveys the meaning of "simply" or "exactly". In her skeleton argument she submits:

"In the context of the specification of both marks covering food provision services, the meaning conveyed is that of simple, straightforward food with no frills or complications. Within the Contested Mark, this meaning is tied specifically to the foods pizza and pasta."

24. I agree that the word JUST is an ordinary dictionary word in everyday use. Whilst I accept the word has a number of meanings which will be well-known to the average consumer, I see no reason why it would be taken as meaning "right and fair" in the context of the services involved. Whatever meaning is accorded to the word JUST in each of the marks is likely to be the same in any event. I consider a significant majority of consumers will see the word in both marks as meaning "only" or "simply"

whether presented alone or with other elements though clearly the applicant's mark defines the specific types of food on offer whereas the opponent's mark does not. The respective marks are conceptually similar to a fairly high degree.

### **The distinctiveness of the earlier mark**

25. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated:

“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).”

26. In his witness statement Mr Sporle gives evidence of the opponent's use of its earlier marks but there is no evidence that goes specifically to use of its earlier mark *JUST solus*. Indeed, he makes clear that in the UK and elsewhere “the principal mark” used has been either *JUST EAT* (word) or *JUST EAT* (stylised form) and the revenue and advertising figures he provides also refer only to these latter marks. Advertising and other promotional material exhibited to his witness statement show

no use of the mark *JUST solus*. The opponent has not shown that the distinctiveness of its mark has been enhanced through its use and indeed, at the hearing, Mrs Blythe confirmed the opponent did not make a claim to any enhanced distinctiveness. That being the case, I have only the mark's inherent distinctiveness to consider.

27. Ms Shah submits that the opponent's mark is one of low distinctiveness. In my view, it is a mark with a lower than average, but not the lowest degree, of inherent distinctive character for the services relied upon.

### **The likelihood of confusion**

28. 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 earlier trade mark as the more distinctive it 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.

29. In her skeleton arguments and repeated at the hearing, Ms Shah stated that there had been no actual instances of confusion between the respective parties' marks and this supported her view that there was no likelihood of confusion. Her submissions were made largely in relation to the opponent's earlier marks which I have not taken into account in reaching my decision. In relation to the opponent's mark which is being considered, the opponent does not claim to have used it but even if it had, I would not have been persuaded by the applicant's submissions. In his witness statement, Mr Sorbie claims to have used his mark from a single shop on the Isle of Man and, given the relevant date, this use would have been for a period of around one month. Whatever the level of trade he might have achieved from that single location and in that very short period, it would have led to an extremely limited

opportunity for real confusion to occur (see *Roger Maier & Anr v ASOS* [2015] EWCA Civ 220).

30. Ms Shah also made submissions based on other marks being on the register which include the word JUST. I was not persuaded by these submissions either. As Mrs Blythe submitted, such “state of the register” does not show what may be happening in the marketplace and the marks referred to are very different in nature to the marks under consideration here.

31. Earlier in this decision I found:

- The respective services to be identical;
- The services are such as will be bought by the general public with a no more than average degree of attention and where the purchasing process is primarily visual but where the aural aspects also have a part to play;
- The respective marks share a medium degree of visual similarity, at least a medium degree of aural similarity and are conceptually similar to a fairly high degree;
- The earlier mark has a lower than average but not the lowest degree of inherent distinctive character which has not been shown to have been enhanced through use.

32. I have to consider both direct and indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr 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”.

33. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

34. At the hearing Mrs Blythe submitted that the opponent’s case was one based primarily on a claim that the respective marks would be indirectly confused, however, for completeness, I should say that I do not consider the respective marks will be subject to direct confusion. Taking all matters into account and in particular the wholly descriptive meaning of the additional elements within the applicant’s mark, I find that the average consumer of the services will be led to conclude that they come from the same or economically linked undertakings, i.e. there will be indirect confusion.

#### **The objection under section 5(3) of the Act**

35. At the hearing, Mrs Blythe submitted that should I find against the applicant in respect of the objection under section 5(2)(b) of the Act, as I have, it would not be necessary to deal with the objection under section 5(3) of the Act. That being the case and in view of my earlier findings, I decline to deal with the objection under this ground.

#### **Summary**

36. The opposition succeeds in full on grounds under section 5(2)(b) of the Act. Subject to any successful appeal against this decision, the application will be refused.

## **Costs**

37. The opponent having succeeded, it is entitled to an award of costs in its favour. Both parties agreed that these would be costs on the usual scale. I make the award on the following basis:

For preparation of a statement and considering the other side's statement:	£200
Fee: (the matter having proceeded on a single 5(2) ground)	£100
For filing evidence and reviewing the other side's evidence:	£300
Preparation for and attendance at the hearing:	£500
<b>Total:</b>	<b>£1100</b>

38. I order Mitch Sorbie to pay Just Eat Holding Ltd the sum of £1100. This sum should 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 24<sup>th</sup> day of April 2018**

**Ann Corbett**  
**For the Registrar,**  
**The Comptroller-General**