

O-257-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2452608
IN THE NAME OF JANG HUSSAIN
FOR REGISTRATION OF MANGO HOUSE AS A SERIES OF THREE
MARKS IN CLASS 43**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 95673
IN THE NAME OF CONSOLIDATED ARTISTS B.V.**

Trade Marks Act 1994

**IN THE MATTER OF application No. 2452608
in the name of Jang Hussain
for registration of MANGO HOUSE as a series of three marks in Class 43**

And

**IN THE MATTER OF opposition thereto under No. 95673
in the name of Consolidated Artists B.V.**

BACKGROUND

1. On 16 April 2007, Jang Hussain made an application to register MANGO HOUSE, Mango House and mango house as a series of three trade marks in Class 43 in respect of the following services:

Restaurants Restaurant Services Restaurant Services specialising in Indian Cuisine Restaurant services specialising in Tandoori Cuisine Restaurant services for the provision of fast food Restaurant services incorporating licensed bar facilities.

2. On 19 November 2007, Consolidated Artists B.V. filed notice of opposition to this application, the ground of opposition being in summary:

Under Sections 5(2)(b) because the marks applied for are similar to the opponent's earlier trade mark, and are sought to be registered in respect of services that are identical and/or similar to those covered by that earlier mark, such that there exists a likelihood of confusion on the part of the public.

3. The applicant filed a Counterstatement stating that:

“The goods and services for which the trade mark is intended to be used are restaurant services specialising in Indian cuisine, specialising in Tandoori Cuisine Restaurant Service and for the provision of fast food restaurant services.

The earlier trade mark is not used in association with the aforementioned goods and services.

The very specialised and narrow area of intended use of a similar but not identical mark means that a likelihood of confusion, including a likelihood of association with the earlier trade mark, on the part of the public does not exist.”

4. Neither side filed evidence in these proceedings. The matter came to be heard on 18 June 2008, when the applicant was represented by Mr Phillip Barnett of City Legal. The opponent was represented by Mr Chris Pett of Frank B Dehn & Co.

DECISION

5. The opposition is based on Section 5(2)(b), which 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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

6. An earlier trade mark is defined in Section 6 of the Act as follows:

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

(a) a registered trade mark, international trade mark (UK), 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.”

7. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *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 B.V.* [2000] 45 F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723 *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, and the CFI in *Shaker di L. Laudato & C. Sas v OHIM* Case C-334/05 P. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, but, beyond this, and notwithstanding that the overall impression may be dominated by one or more parts of a composite sign, it is possible that an earlier mark used as part of a composite sign may have an independent distinctive role in that sign without necessarily being the dominant element *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, but it is only when all the other elements of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element. *Shaker di L. Laudato & C. Sas v OHIM*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

8. When looking at the similarity of the mark applied for and the opponent's earlier mark, Mr Pett drew my attention to the Counterstatement in which the applicants refer to the "...intended use of a similar but not identical mark". This admission against interest can be taken into account, and if taken at face value could be extremely

damaging to the applicant's case. They could, however, just have been saying that there is similarity, not that the marks are similar for the purposes of establishing whether there is a likelihood of confusion. So notwithstanding this apparent concession it is appropriate that I consider this question, particularly given that I received submissions on the similarity of the respective marks.

9. As can be seen from the above references, the ECJ in *Sabel BV v Puma AG* stated that the assessment of the similarity of marks must be made by reference to the overall impressions created, bearing in mind their distinctive and dominant components. However, in *Shaker di L. Laudato & C. Sas v OHIM*, the *Limoncello* case, the CFI stated that it was only when all the other elements are negligible that it was permissible to make the comparison on the basis of the dominant element, the following being an extract from their decision:

“41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).”

10. This should be taken in context with paragraph 30 of the *Medion* judgment referred to above in which the ECJ stated:

“30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.”

11. In *Matratzen Concord GmbH, formerly Matratzen Concord AG and the Office for Harmonisation in the Internal Market (Trade Marks & Designs)* case T-6/-01, (referred to in the *Limoncello* case), the Court of First Instance stated the following in its judgment:

"33. Consequently, it must be held that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it."

12. This was referred to by the ECJ under case C-03/03P. In its order the ECJ stated:

"In the context of the application of Article 8(1)(b) of Regulation No 40/94 on the Community trade mark, the assessment of the similarity between two marks does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. That does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components."

13. It is also necessary to take into account the decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58, and *Criminal Clothing Ltd v Aytan's Manufacturing (UK) Ltd*, [2005] EWHC 1303 which indicated that the circumstances in which the relevant goods and the trade marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration, but the matter must be considered by applying an assessment of all relevant factors. This should be balanced by the decision of the CFI in *Devinlec Développement Innovation Leclerc SA v OHIM (Case T- 147/03)* in which it was stated that a conceptual difference between the marks at issue may be such as to counteract to a large extent any visual and aural similarities. However, this requires at least one of the marks to have a clear and specific meaning so that the public is capable of grasping it immediately.

14. Unlike goods, obtaining a service usually occurs after the initial contact with the sign. In this case the sign at issue may be encountered visually from the exterior signage or advertisement, or aurally through personal recommendation. It is also likely that having become aware of the sign the consumer will obtain the services some time later, from personal and often imperfect recollection. So in my view, all three aspects used in the assessment of similarity, that is, visual, aural and conceptual appreciation, are of importance, and arguably, conceptual being of most.

15. The earlier mark relied upon by the opponents consists of the word MANGO, which is the name of an exotic fruit, a fact that I believe will be well known to the consumers of the relevant services. This connection is about as close as the word gets to having any relevance for services connected with the provision of food; it is a mark with a strong distinctive character. No evidence has been filed showing if, how or to what extent the respective marks may have been used. I therefore do not need to consider whether there is any attached reputation that would add to the distinctive character of the earlier mark such that it warranted a greater degree of protection, or whether concurrent use is something to factor into my decision.

16. That the opponent's earlier mark is in a sort of military-style font does not have any bearing on my consideration of whether the respective marks are similar. It is still clearly the word MANGO which is how the relevant consumer will undoubtedly see it. The font used is not particularly unusual and there is no evidence that this is unique to the opponents. It is also the case that in normal and fair use, the applicant's notional rights will extend to use their marks in the same font.

17. The opponents state that their mark MANGO is “entirely contained” within MANGO HOUSE; that is a matter of fact. To the extent that the respective marks have the word MANGO in common there must be similarity. However, even in circumstances such as this where the earlier mark and the first word of the marks applied for are identical, unless diminishes the addition of a second word, distinctive or not must have an impact on the look and sound.

18. The opponents assert that as the first and most distinctive element in the marks applied for, the word MANGO will generally be regarded as of greater significance in any comparison. There is nothing controversial in the statement that it is the beginnings of marks that are, in the main considered to be of most significance, although I would say that is more usually the case when comparing words with the same beginning but different endings. In the mark applied for the word MANGO catches the eye, and is the strongest contributor to the overall visual appreciation of the mark. The word HOUSE in the mark applied for has an effect on its appearance but not to the extent that I would say it crosses the bridge from being similar to dissimilar to the word MANGO alone.

19. Likewise, when taken from an aural standpoint the word MANGO will have the greater impact to the ear such that I would consider the marks to be aurally similar.

20. Being the only element of the earlier mark I do not need to consider whether MANGO is the dominant component; it clearly must be. In the case of the mark applied for, MANGO is followed by the word HOUSE, and I need to determine whether it is appropriate to consider MANGO to be the dominant, distinctive component, and HOUSE as negligible in the contribution it makes to the overall impression of the marks applied for.

21. In support of their contention on the distinctiveness of the elements, the opponents say that HOUSE in relation to restaurant services will have its “normal connotation” although do not say what that connotation is. There is no evidence to assist me, but these are everyday services of which I have some experience. I am aware that “House” is used to indicate a retailer of goods and services, perhaps more usually as “House of...”, but the impression is the same whichever way. I am also aware of instances where “HOUSE” is used in restaurants, for example, in relation to an unbranded wine offered under the description “house red” or “house white”. I would add that although the consumer would recognise HOUSE as denoting a commercial establishment, they would not either consciously or subconsciously add the word to MANGO.

22. Mr Barnett referred me to *Mastercard International Incorporated v Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), in which the Courts found MASTERCARD and CREDITMASTER to have a very low level of similarity; *inter alia*, because they conjured up different ideas, and were, in any event, visually and aurally different. That is not exactly the case here; the marks have a visual and aural similarity.

23. The conclusion I reach is that MANGO is the distinctive and dominant element of the respective marks. Whilst I accept that the word HOUSE does not occupy an independent distinctive role in the applicant’s mark, it cannot be that simply adding the word to another with a strong distinctive character necessarily creates a mark of a

different identity. If that were the case, many marks, no matter how distinctive would be open to acquisition. Adding HOUSE to MANGO does not change the concept away from the idea of fruit. It does not change the distinctive character or contribute in a significant way to the overall impression created by the applicant's mark as was the case in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in the *CARDINAL PLACE* case BL-O-339-04. In my view the marks are visually, aurally and conceptually similar, and on the guidance of the above cases I find the marks to be similar.

24. The applicant seeks registration in respect of restaurants and restaurant services in general, and such services specialising in Indian cuisine, Tandoori cuisine, for the provision of fast food, and those incorporating licensed bar facilities. The opponent's earlier mark also covers restaurant services for food, and bars, so self evidently the services covered are identical and/or similar. In their argument against there being a likelihood of confusion, the applicant states that he intends to use the mark in a "...specialised and narrow area...". That may well be the case, but given that the specification of the earlier mark is not limited in any way, the identity in the services continues to exist even if this "specialism" were to be taken into account.

25. The services covered by the opponent's specifications, and those for which the applicant seeks registration are not out of the ordinary, nor have they been limited in a way so as to make them specialised to the extent that the consumer changes from being consumers in general to being a particular sector of the public. This being the case, I must proceed on the basis that the similarity extends to the services considered notionally capable of being supplied through the same channels of trade, from manufacture to retailer, and also to the same end-consumer.

26. In summary, MANGO is the distinctive and dominant element of the respective marks. The word HOUSE does not occupy an independent distinctive role in the applicant's mark; but neither does it change the distinctive character of MANGO. Adding this with all of the other factors such as the identity in services, channels of trade and consumer, and adopting the global approach advocated, I take the view that whilst use of the marks applied for in respect of the services for which registration is sought, will lead the consumer to believe that the respective services come from the same or some linked undertakings; there is a likelihood of confusion, particularly after taking into account the possibility of imperfect recollection. The opposition under Section 5(2)(b) succeeds.

The opposition having been successful, the opponents are entitled to a contribution towards their costs. I therefore order that the applicant pay the opponents the sum of £1,250 towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of September 2008

**Mike Foley
for the Registrar
the Comptroller-General**