O/289/20

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3349937 BY SARAFERAZ AHMED SHARIF

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 600001058 BY THE JUNGLE RESTAURANT LIMITED

DECISION

Introduction

1. This is an appeal against a decision of Mr C J Bowen, acting on behalf of the Registrar of Trade Marks, dated 27 August 2019 (O-497-19) in which he upheld Opposition No. 600001058 in its entirety on the basis of section 5(2)(b) of the Trade Marks Act 1994; and ordered Saraferaz Ahmed Sharif to pay Jungle Restaurant Limited £100 as a contribution towards its costs of the proceedings.

2. On 31 October 2018, Saraferaz Ahmed Sharif ("***the Applicant***") applied to register the trade mark shown below

with respect to restaurant services in class 43. The application was published for opposition purposes on 16 November 2018.

3. On 7 February 2019, the application was opposed in full under the fast track opposition procedure by The Jungle Restaurant Ltd ("***the Opponent***"). The opposition was based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ("***the 1994 Act***").

4. For these purposes the Opponent relied upon United Kingdom trade mark registration No. 3212773 for the trade mark **the jungle restaurant** with respect to, *inter* alia, '*Take-out restaurant services; Restaurants; Serving food and drink in restaurants and bars; Salad bars [restaurant services]; Takeaway services*' in class 43. The said

trade mark was filed on 14 February 2017 and registered on 19 May 2017.

5. The Applicant filed a Counterstatement which stated as follows:

> The Applicant's response is that the mark and goods of the Opponent are not similar to the mark and goods of the Applicant and the application of opposition should be denied.
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> The Opponent relies on s 5(1) - identical mark
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> Main points are as follows:
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> Wording - The Opponents mark is a word mark only.
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> The Applicants mark is wording together with a logo. The wording is different, the colour of the wording is different, the style of font is different and overall wording would not confuse the average consumer when compared to the Opponents.
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> Logo - The Opponents mark does not have a logo.
> The Applicants logo contains a graphic design contained in a circle with fire together with the wording steakhouse stencilled in a stylistic design at the bottom of the circle. The average consumer would not confuse the logo with the Opponents registered mark.
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> The Opponent relies on s 5(2)(a) - identical mark
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> The Applicants registered mark is not identical to the Opponents mark. The Applicants mark is different visually when compared with the Opponents mark. The Applicants mark is different conceptually and phonetically. The marks are not identical and would not create comparisons in the mind of the public. There would not be confusion as to the origin of the Applicants mark when compared to the Opponents mark.
>
> The Opponent relies on s 5(2)(b) - similar mark
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> The Applicants registered mark is not similar to the Opponents mark. The Applicants mark is different visually when compared with the Opponents mark. The font, level of stylisation, colour and overall impression of the mark is unique. The Applicants mark is different conceptually and phonetically. The marks are not similar and would not create comparisons in the mind of the public. There would not be confusion as to the origin of the Applicants mark when compared to the Opponents mark."

6. In accordance with the fast track procedure by an official letter dated 8 May 2019, the parties were allowed until 22 May 2019 to seek leave to file evidence or request a

hearing and until 5 June 2019 to provide written submissions. No application to file evidence was made. A hearing was neither requested nor considered necessary. Neither party elected to file written submissions.

The Hearing Officer's Decision

7. The Hearing Officer first considered the Grounds of Opposition under section 5(1) and 5(2)(a) of the 1994 Act and rejected them both on the basis that the marks in issue were not identical.

8. The Hearing Officer then turned to the objection under section 5(2)(b) of the 1994 Act. Having set out the principles of law applicable to his assessment the Hearing Officer went on to find that:

   (1) The average consumer of the services in issue were members of the general public whose degree of care when selecting restaurant services is likely to vary (paragraph [18] of the Decision);

   (2) There was a moderate degree of visual similarity between the marks in issue (paragraph [24] of the Decision);

   (3) There was a medium degree of aural similarity between the marks in issue (paragraph [25] of the Decision);

   (4) There was a high degree of conceptual similarity between the marks in issue (paragraph [26] of the Decision); and

   (5) That the Opponent's trade mark possessed only a very low degree of inherent distinctive character (paragraph [28] of the Decision).

9. On the basis of these findings the Hearing Officer went on to consider the likelihood of confusion. In his decision the Hearing Officer identified the relevant law with regard to a finding of a likelihood of direct and indirect confusion (see paragraphs [30] to [35] and [37] to [38]). Having found that there was no likelihood of direct confusion (paragraph [36] of the Decision), the Hearing Officer went on to consider the likelihood of indirect confusion and to reach his conclusion with regard to the ground of opposition under section 5(2)(b) of the 1994 Act as follows:

> 39. I remind myself again that the earlier trade mark being relied upon has a very low degree of inherent distinctive character. However, notwithstanding that and the presence of, inter alia, the monogram in the applicant's trade mark, in my view, were the identical services at issue to be provided under trade marks which consist of or contain the words "the jungle restaurant"/"JUNGLE GRILL", even an average consumer

> paying a high degree of attention during the selection process is likely to assume they emanate from the same or commercially linked undertakings i.e. there is likely to be indirect confusion. For those average consumers paying a lower degree of attention during the selection process and who are, as a consequence, even more susceptible to the effects of imperfect recollection, the likelihood of indirect confusion is, in my view, even greater. As a finding of indirect confusion is sufficient for the opposition based upon section 5(2)(b) of the Act to succeed, the application will be refused.

The appeal

10. On 23 September 2019, the Applicant filed an appeal against the Hearing Officer's Decision pursuant to section 76 of the 1994 Act.

11. The Statement of Grounds filed on behalf of the Applicant were not in conventional form. Although unsigned the Statement of Grounds took the form of a 'witness statement' from the Applicant.

12. In a number of contexts the Statement of Grounds referred to 'evidence' with regards to the *actual* trading activities of the two parties (such material not having been put before the Hearing Officer); it also referred to sections 1(1) and 11(2) of the 1994 Act and to principles that arise in the context of a passing off claim.

13. In paragraph 10 of the Statement of Grounds the Applicant stated '*The application of the opposition should be denied as the applicant's request incorporates more than a mere word mark but also a logo which the opponent does not have*' and noted in paragraph 15 that '*the visual similarity only related to the use of the word jungle in the aural sense*'.

14. In the section entitled 'Concluding Remarks' it was stated as follows:

> 16. Both trademarks are evidently different and the applicant's trade mark has a distinctive and unique character. Notwithstanding, the presence of a monogram with the JG and the different service provider with the mere similarity of being in the food industry is not substantive of being identical. The applicant's trade mark would clearly differentiate itself from the simplistic The Jungle Restaurant in comparison to The Jungle Grill (JG) Steakhouse.
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> 17. The appeal on the basis set out above should be successful.

15. No Respondent's Notice was served.

16. At the hearing of the appeal the Applicant was represented by of Mr Raja Haroon Rashid of Counsel instructed solely for the purposes of the hearing of the appeal on the basis of direct access. The Respondent did not appear.

Standard of review

17. An appeal against decisions taken by the Registrar is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. See Reef Trade Mark [2003] RPC 5; and Actavis Group PTC v. ICOS Corporation [2019] UKSC 1671 at [78] to [81].

18. Moreover, where the decision below involves the making of a value judgment the decision maker on appeal must be especially cautious about interfering with that judgment on appeal: see most recently Actavis (above) at [80]:

> 80. What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge's conclusions of primary fact but with the correctness of the judge's evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible: *Assicurazioni Generali SpA v Arab Insurance Group (Practice Note)* [2002] EWCA Civ 1642; [2003] 1 WLR 577, paras 14-17 per Clarke LJ, a statement which the House of Lords approved in *Datec Electronic Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23; [2007] 1 WLR 1325, para 46 per Lord Mance.

19. It is necessary to bear these principles in mind on this appeal.

Decision

Preliminary issue

20. At the start of the hearing Counsel for the Applicant raised a preliminary issue. Mr Rashid informed me at the hearing that on 21 January 2020 the Opponent (a registered

company) had been dissolved. On that basis it was initially submitted that the Opposition should be deemed withdrawn and/or that the Appeal should be allowed. At the hearing Counsel accepted that all the assets of the dissolved company are and were deemed to be bona vacantia. Such assets would include the trade mark which formed the basis of the Opposition.

21. Counsel ultimately accepted at the hearing that in order to set aside the decision of the Registrar, absent any consent, he would need to succeed on the present appeal.

22. It seems to me that Counsel was entirely correct in his ultimate position and to proceed in the way that he did. It is not disputed that at the date that the Opposition proceedings were commenced the proprietor of the earlier mark was Jungle Restaurant Limited i.e. the Opponent. That is to say the opposition proceedings were properly constituted within the relevant time limits as required by the 1994 Act and the Trade Marks Rules 2008. It seems self-evident that such proceedings (including any appeals) should be allowed to continue (c.f. P harmedica GmbH's Inte r nat ional Trade Mark Application [2000] RPC 536. This is all the more the case given that there is no suggestion that the property right upon which the Opposition proceedings is based has ceased to exist but has rather been transferred to a different proprietor by operation of law and in circumstances where there is a public and private interest in the outcome of opposition proceedings.

23. The hearing of the substantive appeal therefore proceeded before me.

Substantive appeal

(1) 'Application' to rely on 'evidence' on appeal

24. In so far as the Statement of Grounds of Appeal contained evidence, I do not take it into account on this appeal. The reason for this is twofold. Firstly, at no stage in the appeal proceedings was an application for the additional evidence to be admitted on appeal made. Secondly, even if it could be said that the Statement of Grounds of Appeal was in effect an application for the admission of evidence into the proceedings, I am not prepared to exercise my discretion to allow that application.

25. The general principles to be applied in respect of the admissibility of fresh evidence in trade mark appeals, sought to be introduced for the first time on appeal were summarised by Henry Carr J in Consolidated Developments Ltd v. Cooper [2019] FSR 2. In that Judgment at paragraph [33] it was made clear that the *Ladd v Marshall* factors are basic to the exercise of the discretion. Those principles were set out in the same Judgment at paragraph [20] as follows:

> 20. However, there may be exceptions to this general principle. In *Ladd v Marshall* [1954] 1 W.L.R. 1489 at p.1491 Denning LJ set out a three-part test for admission of fresh evidence on appeal. In particular:

> (i) it must be shown that the evidence could not have been obtained with reasonable diligence for use at the trial;
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> (ii) the evidence must be such that, if given, it would probably have an important influence on the result of the case, though it need not be decisive; and
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> (iii) the evidence must be such as is presumably to be believed, or in other words, it must be apparently credible, though it need not be incontrovertible.

26. In the present case there is nothing to suggest that the 'evidence' that the Applicant seeks to have admitted could not have been obtained for use in the proceedings below. It also does not appear that any attempt was made at any stage for this evidence or indeed any evidence to be admitted to the opposition. This is despite the fact that the by an official letter dated 8 May 2019, the parties were allowed until 22 May 2019 to seek leave to file evidence. That this is the position points firmly against the admission of the evidence on appeal.

27. Secondly, the 'evidence' which the Applicant seeks to rely upon for the purposes of the appeal is entirely irrelevant to any issues that are before me.

28. The 'evidence' which the Applicant seeks to introduce relates to the actual trading activities of the two parties to this appeal and in particular: (1) that the services provided under the mark by the Applicant '*include the provision of halal which provide Fresh (sic), grilled, healthy food including: steaks, gourmet burgers, peri-peri chicken and meats . . . includes dine-in and dine-out options*'; and (2) that the Opponent actually trades under the name 'Rainforest Café'.

29. It is a well-established rule that in globally assessing whether there is a conflict under section 5(2)(b) of the 1994 Act the exercise is an objective one irrespective of the actual marketing habits of the parties ((see, for example, Case T-414/05 <u>NHL Enterprises BV v. OHIM</u> [2009] ECR II-0056, paragraph [71] and the cases cited therein).

30. The question that was therefore before the Hearing Officer was the question of conflict under section 5(2)(b) of the 1994 Act which required *inter alia* a comparison between the mark ***as applied for*** with the earlier mark ***as registered***; and the services contained within the specification of the mark ***as applied for*** and the earlier mark ***as registered***. As set out above the services for which the mark was applied for was ***<u>restaurant services</u>*** and the services upon which the Opponent relied for the purposes of the Opposition were '*Take-out restaurant services; Restaurants; Serving food and drink in restaurants and bars; Salad bars [restaurant services]; Takeaway services*' all in class 43. The Applicant's services, were quite correctly found by the Hearing Officer, to be identical to the Opponent's services (see paragraph [12] of the Decision).

31. Finally, I would also observe that there was no signature or statement of truth on the Statement of Grounds and therefore there is a question as to whether such material can properly be regarded as evidence at all. However, for the purposes of the exercise of my discretion I have not taken this point into account.

32. In the circumstances, in so far as the Statement of Grounds seeks to rely upon 'evidence' those Grounds are rejected.

(2) Other Grounds

33. As noted above, the Statement of Grounds sought to rely upon sections 1(1) and section 11(2) of the 1994 Act as well as the law of passing off. The decision made by the Hearing Officer was on the basis of section 5(2)(b) of the 1994 Act.

34. At no stage was any point raised by the parties or the Hearing Officer and/or any objection raised before the Hearing Officer on the basis of section 1(1) of the 1994 Act or indeed any absolute grounds of opposition; nor was there any objection raised on the basis of section 5(4)(a) of the 1994 Act which may include consideration of the law of passing off. Section 11(2) of the 1994 Act is concerned with defences to a claim for infringement and is not relevant to anything that the Hearing Officer had to decide under section 5(2)(b) of the 1994 Act.

35. In the circumstances in so far as the Statement of Grounds sought to rely on this appeal upon sections 1(1) and section 11(2) of the 1994 Act and/or the law of passing off they are misconceived and are dismissed.

36. Neither in the Statement of Grounds of Appeal nor in the submissions before me was any error by the Hearing Officer as to the legal principles applicable to his assessment under section 5(2)(b) identified. That seems to me to be the correct position.

37. What it appears the Applicant seeks to say is that the Hearing Officer incorrectly applied the legal principles to the issues that were before him. The difficulty in the present appeal is that this was asserted both in the Statement of Grounds and in the submissions before me almost entirely without reference to the findings actually made by the Hearing Officer.

38. In so far as particular criticisms were made of the Hearing Officer's they seemed to be:

    (1) That the Hearing Officer failed to take into account that the trade make application consisted of *'more than a mere word mark but also a logo which the [Opponent's mark] does not have*'; and

    (2) That the Hearing Officer failed to take into account the fact that the visual and aural similarity between the marks in issue was only in the word 'jungle'

and that had he given sufficient weight to these factors he would not have found that there was a likelihood of confusion.

39. With regard to the first criticism it is clear that the Hearing Officer was fully aware and considered the issue on the basis that the Applicant's mark consisted of both words and figurative elements. He made it clear that he needed to be careful not to artificially dissect the marks (paragraph [20] of the Decision] before going on to analyse the marks at issue at paragraphs [21] to [23] of his Decision. With regard to the Applicant's mark it is clear from the content of paragraphs [22] and [23] that the Hearing Officer had firmly in mind that the mark was made up of both figurative (or logo) and word elements. I have not been pointed to any particular criticism of these paragraphs and it seems to me that it was open to the Hearing Officer to make the findings that he did in those paragraphs.

40. With regard to the second criticism. First the Hearing Officer did find at paragraph [24] of the Decision that (emphasis added) '*the competing trade marks **only** coincide in relation to the words "jungle"/"JUNGLE"*'. In the same paragraph the Hearing Officer went on to state that his assessment of visual similarity was made on that basis together with the similarities and differences between the marks that he had previously identified in paragraphs [21] to [23] of the Decision.

41. With regard to the aural similarity the Hearing Officer considered that the average consumer would predictably verbalise the Opponent's mark as "the jun-gle res-tau-rant" and considered that the average consumer would be overwhelmingly likely to pronounce the Applicant's mark as "JUN-GLE GRILL" and made his assessment accordingly. He went on to make further findings in case he was wrong in that on the basis that the average as "JUN-GLE J R GRILL" or "JUN-GLE GRILL J G") (or either of those accompanied by the words "STEAK HOUSE"). The Hearing Officer went on to note that in each of the examples described the word "JUNGLE" would be articulated first. There is no suggestion from this assessment at paragraph [25] of the Decision that the Hearing Officer was not aware that the word "JUNGLE" was the only common word in the aural comparison (particularly given his finding in paragraph [24] of the Decision). There is no other criticism of the Hearing Officer's analysis of aural similarity in this paragraph of his Decision.

42. At the hearing of the appeal it was also submitted on behalf of the Applicant that the Hearing Officer should have place more weight on the presence of the words "STEAK HOUSE" in the Applicant's mark. However, the Hearing Officer clearly considered the words "STEAK HOUSE" in his analysis: see paragraphs [23] and [24] of the Decision. Moreover, no submissions were put forward as to why the Hearing Officer was incorrect to find as he did in paragraph [23] of his Decision that the words "STEAK HOUSE" were descriptive and would be regarded by the average consumer of the relevant services as ubiquitous. Nor was any suggestion made that the Hearing Officer was not entitled to find as he did in paragraph [23] of his Decision that '*the unit created by the combination of the words "JUNGLE" and "GRILL" and the monogram consisting of the letters "J" and "G" which are likely to make the most*

important contributions to the overall impression the applicant's trade mark conveys and it is these components which lend the trade mark the majority of its distinctive character.'. Given these findings it seems to me that there is no merit in the criticism made at the hearing with regard to the weight given by the Hearing Officer to the presences of the words "STEAK HOUSE" in the Applicant's mark.

43. At the hearing before me the submissions, which were made in broad and generalised terms, were largely directed to the conclusion that there was a likelihood of indirect confusion in paragraph [39] of the Decision. Insofar as the conclusion in this paragraph was criticised in the course of submissions:

(1) The findings that had been made earlier in the decision (in particular at paragraphs [21] to [26]); and summarised at paragraph [29] of the Decision were, at least initially, ignored. Those findings were, for the reasons set out above, findings that it was open to the Hearing Officer to make;

(2) Failed to take into account as the Hearing Officer had correctly directed himself at paragraph [35] of the Decision that the case law made it clear: (i) that it was not permissible to conclude that the Opponent's trade mark had no distinctive character; and (ii) that the fact that the Opponent's trade mark had only weak distinctive character did not preclude a finding of confusion.

(3) Failed to take into account that the Hearing Officer had found that there was no direct confusion and had made findings in support of that conclusion (see paragraph [36] of the Decision); and

(4) Failed to take into account the case law set out in paragraphs [37] and [38] of the Decision which the Hearing Officer clearly had in mind and in particular the guidance that merely because the two trade marks share a common element does not give rise to a finding of indirect confusion.

44. Having regard to: (1) the findings made earlier in the Decision which were either unchallenged or findings that I have found, for the reasons set out above, were findings that it was open to the Hearing Officer to make; (2) the fact that no other specific points or criticisms were identified on behalf of the Applicant in the Statement of Grounds with regard to the specific findings in paragraph [39] of the Decision save for the conclusion that there was a likelihood of confusion was wrong; and (3) the points set out in paragraph 43(2) to 44(4) above I have come to the view that the Applicant has not identified any error of principle or material error in the Hearing Officer's Decision.

45. In all the circumstances, it seems to me that the conclusion that the Hearing Officer reached in paragraph [39] of the Decision was one that it was open to him to reach.

Conclusion

46. For the reasons set out above, it does not seem to me that there is any error of principle or material error in the Hearing Officer's decision. It was in my view open to the Hearing Officer to make the decision that he did for the reasons that he gave. In the result the appeal fails.

47. Therefore, the appeal is dismissed.

48. In the usual course a successful party is entitled to a contribution towards its costs. The Opponent has played no part whatsoever in the conduct of this appeal. In the circumstances, it seems to me that I should make no order as to costs on this appeal.

EMMA HIMSWORTH QC
Appointed Person

21 May 2020