

O-307-20

TRADE MARKS ACT 1994

IN THE CONSOLIDATED MATTERS OF

APPLICATION NO. 3249954

BY W A ESSEX LIMITED TO REGISTER AS A TRADE MARK (SERIES OF 3):

TACO RIA / Taco Ria / TACO-RIA

IN RESPECT OF SERVICES IN CLASS 43

AND

THE OPPOSITION THERETO UNDER NO. 410706

BY TAQUERIA WORLDWIDE LIMITED

AND

APPLICATIONS FOR INVALIDATION AND REVOCATION BY W A ESSEX LIMITED

(UNDER NOS. CA502573, CA502574, CA502575 AND CA502576)

AGAINST UK REGISTERED TRADE MARKS NO. 2366345 ("TAQUERIA")

AND NO. 2551634 (**TAQUERIA**)

OWNED BY TAQUERIA WORLDWIDE LIMITED

Background and pleadings

1. This decision deals with consolidated proceedings between the parties, where the applicant has challenged, on absolute grounds, the standing of a registered trade mark relied on by the opponent (and a stylised version of the same).

The Opposition

2. On 12 August 2017, W A Essex Limited (“**the Applicant**”) applied to register a series of three word-only marks – “**TACO RIA**”, “**Taco Ria**” and “**TACO-RIA**” - for services in class 43, namely: *restaurant services, restaurant services incorporating licensed bar facilities; restaurants; restaurants (self-service-); take-out restaurant services* (“**the Application**”).
3. The Application was published for opposition purposes on 8 September 2017, and on 6 November 2017, Taqueria Worldwide Limited (“**the Opponent**”) filed a notice of opposition, relying on grounds under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“**the Act**”).
4. **The section 5(2)(b) claim:** The Opponent is the proprietor of UK trade mark No. 2366345 for the word “Taqueria”, registered for services in class 43, namely: *provision of food and drink; temporary accommodation, including restaurant, bar and catering services* (“**the Earlier Mark**”). The Earlier Mark was filed on 22 June 2004 (and registered on 26 November 2004) and is thus an earlier trade mark as defined in section 6(1) of the Act. The Opponent’s stated objection under section 5(2)(b) is that the parties’ marks are visually similar and phonetically and conceptually identical, that the parties’ services are identical, and there is consequently a likelihood of confusion on the part of the public, which includes a likelihood of association with the Earlier Mark.
5. **The section 5(4)(a) claim:** The Opponent claims use of the sign “TAQUERIA” throughout the UK since March 2005 for “restaurant services, the provision of food and drink” and that it has acquired goodwill and reputation in the market, such that use of the applied-for marks would be a misrepresentation leading the public to believe that the services offered by the Applicant are the services of the Opponent, or to mistakenly infer that the businesses are connected or associated, and that the Opponent is likely to suffer damage as a result.
6. **The Applicant’s notice of defence:** The Applicant denied all aspects of the 5(4)(a) claim. In response to the 5(2)(b) claim, the counterstatement admitted that the relevant services

are identical, but denied that the marks are similar or that there is a likelihood of confusion. The Earlier Mark had been registered for more than five years when the Application was published for opposition and the Applicant put the Opponent to proof of use in respect of the services relied on. The Applicant also referred in its counterstatement to its having filed applications to invalidate and revoke the Earlier Mark (as follows).

Applications for invalidation and revocation

7. On 22 April 2019, the Applicant filed challenges not only to the standing of the Earlier Mark, but additionally against a second registration owned by the Opponent (in this context “**the Proprietor**”), namely, UK trade mark registration No. 2551634, which involves a stylised version of the same word as follows: **TAQUERIA** (“**the Stylised Mark**”). The Stylised Mark was filed on 29 June 2010 and entered in the register on 1 October 2010 for ‘*services for providing food and drink; restaurant services; catering services; bar services; temporary accommodation; booking and reservation services for all the aforesaid services*’ in class 43.
8. The Applicant challenges both the Earlier Mark and the Stylised Mark, firstly by **applications for invalidity** brought under **section 47(1)** of the Act, and secondly by way of **applications to revoke** those registrations, relying on the provisions of **section 46(1)(c)** of the Act.
9. The **applications for invalidity** are based on claims that they were registered in breach of sections 3(1)(b), (c) and (d) of the Act, as follows:
 - Under **section 3(1)(b)** the claim is that the mark is devoid of distinctive character because it comprises nothing more than a wholly descriptive term, “taqueria”, which is a dictionary word meaning ‘a Mexican restaurant specialising in tacos’, and that, as such, consumers will be unlikely to perceive it as designating trade origin or distinguishing the services of one undertaking from those of other undertakings.
 - Under **section 3(1)(c)** the claim is that the mark consists exclusively of a sign or indication which may serve, in trade, to designate the kind, intended purpose or other characteristics of the services for which it is registered.
 - Under **section 3(1)(d)** the claim is that the mark consists exclusively of a sign or indication which has become customary in the current language or in the *bona fide* and established practices of the trade. This allegation is again based on the dictionary definition of the word “taqueria”, but also on the claim that “several third parties” in the UK had at the filing

date of the Earlier Mark used the sign in a generic sense to refer to a Mexican restaurant which serves tacos.

10. Whereas the above invalidity claims must be assessed as at the filing dates of the Earlier and Stylised Marks (**the “relevant dates”** - respectively, 22 June 2004 and 29 June 2010), the **applications to revoke** those registrations rely on the provisions of **section 46(1)(c)** of the Act that, in consequence of acts or inactivity of the Proprietor, it has, since registration and by the date of the application for revocation, *become* the common name in the trade for the services for which it is registered. The Applicant again refers to the dictionary meaning of the term “taqueria” and to several third parties in the UK having used and continuing to use it in a generic sense to refer to a Mexican restaurant serving tacos. The Applicant claims that the extent of the generic use of the sign is such that that knowledge can reasonably be imputed to the proprietor and that as such the sign “taqueria” has become generic “as a result of the inactivity of the Proprietor” in not confronting those third party uses.
11. **The Proprietor’s notices of defence:** The Proprietor denies that its marks were invalid when they were filed; it puts the Applicant to strict proof that at each relevant date, either trade mark was devoid of distinctive character and a dictionary word relevant to the UK, or consisted exclusively of a sign or indication that designated a characteristic of the services or which had become customary in the language or in the bona fide and established practices of the trade.
12. The counterstatements also denies the revocation challenges and puts the Applicant to proof of its claims that: the marks have become a common name in the trade for the services and that the word is nothing more than a dictionary term that refers to a Mexican restaurant specialising in tacos; that third parties are using the mark in generic sense; that knowledge of use by third parties can be imputed to the proprietor; that the Proprietor has been inactive in dealing with third party use.

Papers filed, representation, and the hearing

13. Both parties filed evidence, both in chief and in reply, comprised as follows:
 - On 17 September 2019, the Opponent/Proprietor filed evidence in the form of a short witness statement from Christopher Lewis and a longer witness statement from Daniele Benatoff accompanied by exhibits **DB1** to **DB15**.

- On the same date, the Applicant filed evidence in the form of a witness statement from Antony Yerasimou, accompanied by exhibits **AY1** to **AY17**. The Applicant also filed short submissions.
 - On 18 November 2019, the Opponent filed reply evidence in the form of a second witness statement from Mr Benatoff, accompanied by exhibits **DB16** to **DB19**.
 - On the same date, the Applicant filed its reply evidence in the form of a second witness statement from Mr Yerasimou, accompanied by exhibits **AY18** to **AY22**.
14. I have read all the papers filed. Given the extent to which the claims in these proceedings turn on what may be concluded from the evidence filed, I summarise the parties' evidence in some detail below and refer to it, and to any points made in submissions, where I consider it warranted to do so elsewhere in this decision.
15. The Applicant requested an oral hearing, which duly took place by video conference on 12 March 2020. At the hearing, Jamie Muir Wood acted as Counsel for the Applicant, instructed by Trade Mark Wizards Limited; Benet Brandreth QC represented the Opponent, instructed by Dolleymores LLP. Both parties filed skeleton arguments.
16. In line with the approach taken at the hearing, this written decision will first consider the challenges to the standing of the Earlier Mark relied on by the Opponent (and to the Stylised Mark), and in light of my conclusions thereon, will proceed to consider the opposition claims accordingly.

Proof of use

17. Mr Muir Wood accepted in his skeleton argument that the Opponent has (or its predecessors in title have) made use of "TAQUERIA" for restaurant services sufficient to amount to proof of use. Since those services are the closest to the services for which the Applicant sought registration and there is no application to revoke for non-use, the Applicant pursued no further the lack of evidence for services such as '*temporary accommodation*'.
18. I agree that the Opponent's evidence satisfied the proof of use requirements for the section 5(2)(b) claim; my summary of evidence below addresses evidence of use by the Opponent to the extent that it may be relevant to establishing the degree and extent of goodwill for the section 5(4)(a) claim, noting that Mr Muir Wood's acceptance of genuine use was based on a single restaurant in West London.

EVIDENCE SUMMARY

The Opponent's evidence in chief

19. **Witness statement of Christopher Lewis.** Mr Lewis is a partner at Dolleymores, the Opponent's attorneys, but from 2001 – 2004 worked as a trade mark examiner at the UKIPO and gives evidence as to his experience of the types of internet and dictionary searches that would typically have been carried out in relation to trade mark applications. He also states that prior to the publication of a trade mark application in the Trade Marks Journal, a pre-publication copy would have been circulated to all appropriate managers in the UKIPO trade mark examination department, serving as a further check on section 3 conflict.
20. **First Witness statement of Daniele Benatoff (with Exhibits DB1 to DB15).** Mr Benatoff has been Director of the Opponent company since March 2017 and gives facts from his own knowledge and from the records of the Opponent. Mr Benatoff's statement includes the following points:
- Dodie Miller and Fred Taylor, who originally filed the Earlier Mark, began using it in London in 2005, from which time use has been continuous. The mark was assigned to Taqueria Management Ltd in 2010, and the Opponent company bought from Taqueria Management Ltd, all rights in the Earlier Mark and the Stylised Mark and relevant goodwill in the business. **Exhibit DB2** shows a copy of the deed of assignment signed and dated 20 June 2017.
 - Turnover figures since 2011 range from over £900,000 in each of the years 2011 – 2014, to over £1.3 million in 2016 and 2017, and over £2.3 million in 2018. (A 3-month refurbishment in 2017 led to dip in turnover that year.)
 - Use of the mark(s) is shown on menus, its website and on social media (e.g. **Exhibit DB5** shows around 1300 followers on Twitter in 2017). Since March 2014, the Opponent has employed a marketing manager and from 2015 - 2018 has spent over £35,000 annually promoting its services under the marks.
 - **Exhibit DB6** includes a positive review in *The Telegraph* by Matthew Norman (August 2013). Page 73 of the same exhibit includes Taqueria listed by Groupon in September 2014 under the heading "*Mexican Restaurants London – The Top 5*". To in some degree contextualise the profile of the Opponent, I note that that list of five also includes Wahaca (described as the "*hugely successful chain established in 2005 by Thomasina Miers, first Masterchef Winner*"). It also includes Lupita, which arises elsewhere in the evidence, notably **Exhibit DB15** (below). The synopsis of Taqueria at that page refers to it being

the only Mexican restaurant in London making fresh corn tortillas every day using their special tortilla machine – I mention this in connection with an alleged descriptive use raised by the Applicant, which I shall come to.

- **Exhibit DB7** shows Taqueria to have been ranked on TripAdvisor as #2826 out of 19,147 restaurants in London, achieving 4 out of 5 stars, based on 454 reviews and to have had Certificates of Excellence in 2015 and 2017.
- **Exhibit DB9** shows Taqueria to have featured on television (Eat Your Heart Out – on Dave TV – aired in October 2017).
- **Exhibit DB11** shows the UKIPO 2004 examination report for the Earlier Mark – it shows no section 3 objection to registration of the word in relation to the Opponent’s services.
- **Exhibit DB12** is said to show the results of a search on the UKIPO’s web-based search tool for trade marks featuring TAQUERIA registered in Class 43. The only UK registrations for or including TAQUERIA are those of the Opponent, with all other UK applications withdrawn or opposed by the Opponent.
- On becoming aware of a reference to TAQUERIA in the Collins English Dictionary, the Opponent’s trade mark attorneys were instructed to approach the publishing company, Harper Collins, with a request that it identifies TAQUERIA as a trade mark.¹ **Exhibit DB13** shows the publisher’s response on 16 April 2019 as *“although it is included in our British dictionary content (as indicated by “in British” after the entry word), we have labelled the word “US”, meaning we are treating it here as an American, rather than a British, term. Our citations of the word were drawn from US sources, where it has been borrowed from Spanish and is used generically, and this is the meaning that our dictionary covers. Therefore, we will not be making any changes to the dictionary entry.”*
- Mr Benatoff states that the Opponent has been active in protecting its trade marks and has continuously taken action to prevent others from infringing or diluting the distinctive character of its trade marks. **Exhibit DB14** shows annual invoices from 2010 for a commercial watch service to identify applications made to UKIPO for similar marks. **Exhibit DB15** comprises documents, such as legal correspondence, showing the action taken by the Opponent and its predecessors against parties it considered infringing. Eleven instances are identified, some ongoing, but most concluded. Examples include: a request for a change of company name from *Lupitas Taqueria Limited* – the name was changed to Lupe’s Cantina Mexicana Limited; an infringement claim against use of the sign *Corazon Taqueria* – the other party ceased using Taqueria; a threat of opposition

¹ Pursuant to section 99A of the Act

against a UK trade mark application for, and claim of infringement against the use of the sign *Downtown Taqueria* – the application was withdrawn and the infringement claim is ongoing; a notification letter regarding a company name for *Que Padre Taqueria Ltd* (matter ongoing); a request to change a company name and a claim of infringement against the use of the sign *The Little Taqueria* – the other party changed its sign and company name accordingly.

The Opponent's evidence in reply

21. Mr Benatoff filed a second witness statement making points in reply to the Applicant's evidence; I shall refer to such points in the context of my summary of the Applicant's evidence below.

The Applicant's evidence

22. The entirety of the evidence in support of its invalidity and revocation claims is given by Antony Yerasimou, a trade mark attorney acting for the Applicant. Mr Yerasimou's evidence presents the results of a seemingly extensive web trawl conducted in September 2019, (his first Witness Statement), and November 2019, (his second Witness Statement). Mr Yerasimou does not give direct evidence, for example by stating that he knew of the word 'Taqueria' as having the meaning contended for by the Applicant. His evidence goes no further than what can be understood from his exhibits. Nor is there any evidence from any third party, whether trade or consumer, beyond the content of the exhibits.
23. At the hearing Mr Muir Wood presented the evidence in the following seven categories:
- i. Dictionary use
 - ii. Use in names of restaurants (by the Opponent and other entities)
 - iii. Use by restaurants in a descriptive fashion (other than in their names)
 - iv. Use by members of the public
 - v. Use by journalists
 - vi. Use by chefs and on-line recipes
 - vii. Use by predecessor in title to the Opponent

Dictionary use evidence

24. **Exhibit AY1** shows entries in various dictionaries for the word "taqueria", which is defined essentially as '*a Mexican restaurant or stand specializing especially in tacos*'. The

dictionaries cited include: dictionary.com; Cambridge Dictionary; Merriam Webster; Lexico; Collinsdictionary.com; and Wiktionary.

25. Two points are obviously relevant (a) the extent to which the exhibits are drawn from UK dictionaries and (b) that it is not clear at what point in time these dictionary sources first referenced the word. The reply evidence at **Exhibit DB16** shows that some (but not all) of these dictionaries are of US-origin. It is also clear that the examples are largely cast from a US perspective. For example, while the Cambridge dictionary is from a UK university press, it clearly intends to cover both US and UK audiences, as is apparent not only from the distinguishing pronunciations at the top, but perhaps more telling as to the intended audience are the distinctively US-focused examples, such as “*he wires money from his job at a taqueria in Denver to his family in Mexico.*” The Merriam Webster is a US dictionary (**DB16**) with all of its examples squarely American (Los Angeles Times, Houston Chronicle etc). It includes a reference to “first known use” as being 1982, although I presume that to be the first adoption of the word from Spanish into the English language in the US – it is not clear when it first entered even a US dictionary. The Collins dictionary identifies the term as “US”; I have referred to the Proprietor’s engagement with Collins above (**DB13**), where the publishers state that they are not treating the word as a British term. The Collins entry includes an example “You enter the bar through a taqueria stall that sells the best tacos in the city”, which is attributed to *The Times, Sunday Times* (2016). While I understand those to be UK publications, the context is not clear and the reference could be a review referencing a US city. It does, however, show that the term featured in the Collins dictionary from at least 2016.

Descriptive use in names of restaurants (by the Opponent and other entities)
and Use by restaurants in a descriptive fashion (other than in their names)

26. **Exhibits AY2 – AY7** show references to various restaurants in various cities in the UK that include the word “Taqueria” in their names, which the Applicant states are also descriptive uses. Examples include:
- *La Taqueria Ormeau* in Belfast (**Exhibit AY2**), which started as a pop-up in September 2016, with a second restaurant opening in February 2019;
 - *Downtown Taquería* in Bristol in December 2018 (**Exhibit AY3**);
 - *iQUE PADRE! TAQUERIA* (North London) (**Exhibit AY4**), shown to have garnered 32 likes on Instagram by December 2018;

- *Gary's Taqueria* (**Exhibit AY5**), a one-night only facebook event pop-up in October 2018;
- *Escobar – Taqueria and Cocktails* in Inverness (September 2019);
- *Bodega*, in Edinburgh, which the Wayback Machine shows to have described itself in July 2015 as a “Mexican Taqueria”;
- *Overdraft* – craft beer and taqueria (Winchester) April 2018.

Descriptive use by members of the public

27. **Exhibit AY8** shows the results of a 2019 search for “taqueria” on **Tripadvisor**, yielding around 40 results. Some are those restaurants identified above; some include references to the word by reviewers. For example, page 93 shows *Wahaca* (in Covent Garden), and includes a review that describes it as “*as good as any taqueria in Mexico.*” The date of review is not clear. I do note that *Wahaca* is shown to be the subject of 2293 reviews, only 3 which mention the contested word. At page 103 is another review for *Wahaca*, dated April 2019, which refers to “*the flavors are wonderfully brought together.... We tried a good part of their taco selection and found them just as delicious as any good taqueria in Mexico.*” At page 109 reviewer of *Viva Mexico*, in Edinburgh, writes in August 2018 “*I live in California ...– could have been in a taqueria in Jalisco.*”
28. **Exhibit AY16** shows evidence from Twitter referring to taqueria. The high point of that evidence is a reference in November 2012 to Lupita where a Chef Marco Cuervo tweets “*Chef Benjamin so happy on his taqueria*”. Another is in reference to Benito’s Hat, dated March 2015 “*we’re serving hand made tacos at our taqueria*”. However, the filed Twitter evidence is strikingly thin, showing only four tweets mentioning the word: one in 2012, one in 2013, one in 2015 and one in December 2017.

Descriptive use by journalists

29. The evidence includes close to twenty examples of use of the word in various UK website articles, including on *Bighospitality.co.uk* and *Glasgowlive.co.uk*, but also in online versions of more widely known publications such as *The Independent* and *The Evening Standard*. The following from **Exhibit AY11** are illustrative:
- The Guardian* (September 2018) – a recipe by Thomasina Miers refers to *Breddo’s* as “*an extremely good taqueria in Soho*”;
- Bighospitality.co.uk* – an article from February 2018 has the headline “*El Pastor team to launch second London taqueria*” (*Tortilleria El Pastor*);

FT.com – an article from January 2017 has the headline: “*Five of the best: Tacos in London*” sub-headline “*with multiple taquerias opening in capital, tacos are the new burger (or should that be ramen?)*”;

The Guardian (July 2017) – a review of *El Pastor* by Jay Rayner bears the sub-headline “*If you think the food of Mexico is all mushy avocados and soft tortillas, the Borough taqueria will prove you wrong*”.

30. The earliest journalistic reference appears at **Exhibit AY17**, where an article in *Tatler* in March 2015 refers to a “10-week-takeover” in the food hall of Selfridges where “*Benito’s Hat taqueria stand offers overflowing tacos-to-go.*”
31. Some of the articles indicate that those involved have some connection to Mexico or the bordering US. For example, at **Exhibit AY11**: *Wallpaper.com* (January 2017) “*Corazón – London UK*” “*Joining London’s recent taqueria boom, Corazón is the brainchild of Texan native Laura Sheffield*”, and *Chronicle live.co.uk* (Newcastle, December 2016) “*with the knowledge I have from growing up in California, I decided to create a little taqueria*”. Other examples appear to consider it necessary to explain or strongly contextualise the term: thus in **Exhibit AY11** (page 170), an article on restaurant openings from *Independent.co.uk* (September 2016) refers to “*El Pastor business partners spent years in Mexico ... a desire to create a taqueria – a Mexican restaurant specialising in tacos – akin to those in Mexico.*” And similarly, an article from *thedrinksbusiness.com* (11 July 2016) “*Anglo-Spanish brothers behind Barrafina are to open a taco specialist restaurant in Borough Market El Pastor - the new taqueria will be called El Pastor*”

Use by chefs and on-line recipes

32. **Exhibit AY12** shows copies of covers/pages from three recipe books. one called “*Taqueria*” by Australian author Paul Wilson, published in 2016; one called “*Easy Mexican Food Favorites – A Mexican cookbook for Taqueria-Style Home Cooking*” by Jennifer Olvera published in 2017; and the other called “*Taquería Tacos - a taco cookbook to bring the flavors of Mexico home*”, by Leslie Limón published in 2016. Although Mr Yerasimou stated in his evidence that the books are “published in the United Kingdom”, the Opponent’s evidence in reply provided biographies of the authors and details of the publishers (**Exhibit DB18**) that casts significant doubt on that statement. It appears that the latter two are US publications and while the first includes an address for its publisher in Melbourne and in

London, the book is shown to be catalogued in National Library of Australia, but no equivalent reference is made to the British Library.

Use by predecessor in title to the Opponent

33. Mr Muir Wood referred to two exhibits drawn from the website of coolchile.co.uk. **Exhibit DB19** (from the Opponent's evidence in reply) shows The Cool Chile Co as founded by Dodie Miller, who also founded Taqueria (and was therefore predecessor in title to the Opponent). The exhibit refers to her travelling in New Mexico and Mexico before setting up The Cool Chile Co, which import chillies from Mexico to inform UK Mexican cooking. It also shows a page (February 2014) stating that Cool Chile Co founded Taqueria in 2005 and includes a short blurb about that restaurant under the heading "*Taqueria (Mexican restaurant specialising in tacos)*". Mr Muir Wood contended that this is descriptive use of the word. The exhibit (via the web archive resource) shows the site at different points in time; one page references the "Cool Chile Shop at Taqueria" (2005) and that (in 2010) it had a "new monster of a machine and perfect white maize flour to make supple, tasty tortillas". Mr Yerasimou's **Exhibit AY14** also shows (undated) web pages from the website of the Cool Chile Co, where it offers for sale its "*Taqueria Tortillas*" where it refers to "*58 taqueria tortillas to the kilo*" and which it promotes as "*essential for making taqueria style tacos ...*". It was contended that this too is descriptive use of the word by the predecessor in title to the Proprietor/Opponent.

Other evidence

34. From among the other evidence filed on behalf of the Applicant, I note that **Exhibit AY19** is a December 2017 decision by the Opposition Division of the EUIPO, finding against the Opponent. As in the present case, the Opponent relied on its Earlier Mark alleging a



likelihood of confusion, to oppose an EU TM application for , the sub-script of which, on its banner, reads "mucho mas que una taqueria". The decision cited includes the conclusion of the Opposition Division, based on the Collins English Dictionary online that the relevant public (in the UK) "*will understand taqueria as a reference to a restaurant specializing in tacos ... therefore its distinctiveness in relation to the services at stake is reduced.*"

THE LAW ON THE INVALIDITY CLAIMS

35. **Section 47 - Grounds for invalidity of registration**

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

36. Sections 3(1)(b), 3(1)(c) and 3(1)(d) of the 1994 Act state as follows:

Absolute grounds for refusal of registration

3.- (1) The following shall not be registered—

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

Section 3(1)(b) case law

37. Mr Muir Wood referred in his skeleton argument to the summary of the law by Arnold J (as he then was) in relation to the provisions of EU law equivalent of section 3(1)(b) in *Starbucks v. B Sky B²*, from which I note the following points:

- marks which are devoid of any distinctive character are not to be registered;

² *Starbucks (HK) Ltd v. British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch); [2013] F.S.R. 29, at §90
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- the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for these purposes in relation to a specific product or service;
- According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product (goods/services) in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings;
- that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public;
- the examination of trade mark applications must not be minimal, but must be stringent and full, in order to prevent trade marks from being improperly registered and, for reasons of legal certainty and good administration, to ensure that trade marks whose use could be successfully challenged before the courts are not registered.

Section 3(1)(c) case law

38. The principles to be applied under Article 4(1)(c) of the Directive/Article 7(1)(c) of the Regulation, which correspond to the provisions of section 3(1)(c) of the Act, were summarised by the Court of Justice of the European Union (the “CJEU”) in Case C-51/10P *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market* [2011] ECR I-1541 as follows (citations omitted)³:

"33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services ...

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or

³ See Arnold J at paragraphs 66 – 76 in LNDR case: *Frank Industries Pty Ltd v Nike Retail BV* [2018] EWHC 1893 (Ch) (25 July 2018)
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services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration

...

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics".

39. As Floyd LJ confirmed in *JW Spear v Zynga*⁴:

"79. Thus it is the presumed perception of the average consumer which is relevant. It is not of course enough if the connection between the signs and a characteristic of the goods does not dawn immediately on the average consumer. If it requires any thought or explanation it is not "easily recognisable".

82. It is nevertheless the case that signs which are candidate trade marks lie on a continuum between the entirely generic, through the descriptive to the inherently

⁴ [2015] ETMR 27

distinctive. Not every word which alludes to or is suggestive of some aspect of the goods or services is necessarily unregistrable. It is of course trite that it is not an objection to registration that the word has a dictionary meaning, or is an ordinary English word. The objection bites on relationships between the word and the characteristics of the goods or services for which it is sought to be registered which the average consumer will immediately perceive.”

Section 3(1)(d) case law

40. In *Telefon & Buch*⁵, the General Court summarised the law under the equivalent of section 3(1)(d) of the Act at §49 as follows (citations omitted):

“49 Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark.

50 With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question.

51 Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered.

52 Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices

⁵ *Telefon & Buch Verlagsgesellschaft mbH v. OHIM (T-322/03)* EU:T:2006:87
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of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark.”

DECISION ON THE INVALIDITY CLAIMS

41. Although each of the grounds for refusal listed under section 3(1) (b), (c) and (d) is independent of the others and calls for a separate examination, there is a clear overlap between the scope of the respective provisions.⁶ In the present case, Mr Brandreth submitted in his skeleton argument that the basis for the allegations under sections 3(1)(b) and (c) are the same, namely the alleged descriptive meaning of the Earlier Mark, and that although section 3(1)(b) is capable of broader application it is not suggested here that there is any broader relevance. Mr Muir Wood took no issue with that submission; I agree with it and will accordingly focus on the allegation under section 3(1)(c) of the Act.⁷ I also acknowledge, as Mr Brandreth further submitted, that while the allegation under 3(1)(d) is formally of different remit, it takes the matter no further than the allegation of descriptiveness that would, if correct, bite under section 3(1)(c) of the Act.⁸ Mr Muir Wood agreed that the central contention ran in common through the three sub-sections, although he considered the section 3(1)(c) ground as likely to be the Applicant’s strongest case and formed the focus of the invalidity claims at the hearing. Nonetheless, while I consider the claims under sections 3(1)(b) and 3(1)(c) squarely to stand or fall together, and deal with them simultaneously below, I shall go on to give separate formal consideration to the claim under section 3(1)(d).
42. Having in mind the relevant law and legal principles set out above, my task is to decide, whether, on the relevant dates(22 June 2004 and 29 June 2010) the Earlier and Stylised Marks, the word “taqueria” was (or was capable of being) descriptive of any characteristic of the services at issue – particularly *provision of food and drink* and including restaurant services. That assessment is to be based on the perception of the average consumers of the services in the UK, reasonably well-informed and reasonably observant and circumspect.⁹ The average consumer accessing the services for which the Earlier Mark and

⁶ See by analogy the ruling of the CJEU in *Koninklijke KPN Nederland NV v. Benelux-Merkenbureau (C-363/99)* EU:C:2004:86; [2004] E.T.M.R. 57 at §67

⁷ See by analogy the reasoning in *Frank Industries PTY Ltd v Nike Retail BV and others* [2018] EWHC 1893 (Ch) at [65]

⁸ See *Ukelele Orchestra of Great Britain v Erwin Clausen* [2015] ETMR40 at [31]

⁹ For example, see paragraph 24 *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04.

Stylised Mark are registered will be the general public in the UK. The crux of the Applicant's challenge is the allegation that at the relevant date(s), in the UK, average consumers understood the sign TAQUERIA to mean 'a Mexican restaurant that specialises in tacos'. That is a question of fact to be established on the evidence.

43. Although the Stylised Mark is not the word in plain form and despite the requirements in the claims that a challenged trade mark must consist "exclusively" of signs or indications (that are descriptive etc), I do not consider the modest degree of stylisation in the Stylised Mark is sufficient to put it beyond the reach of those grounds, and nor indeed was this a line of argument before me. I note, by way of analogy, the analysis of Richard Arnold QC (sitting as a deputy, as he then was) in *Hormel Foods*¹⁰, where the contested mark consisted of the word "SPAMBUSTER" in stylised form.
44. As I have noted, my assessment of the claims¹¹ based on the allegation that the contested word was descriptive of the services at issue must be directed to the relevant dates. The Applicant has filed no evidence that directly addresses the position in the UK at the relevant dates. I recognise of course that case law¹² is clear that for a trade mark to be excluded from registration is not necessary that the sign composing the mark actually be in use at the time of the application for registration in a way that is descriptive of the goods or services. Rather, it is sufficient that such signs and indications *could* be used for such purposes. However, I agree with Mr Brandreth's submission that that does not exclude all terms from registration on the off chance that they might be used in future. It requires a tribunal to assess the degree of foreseeability about the sign ever being pressed into service as a descriptive indication. I also acknowledge that assessments by the tribunal should take the evidence in the round (as Mr Muir Wood urged that I do). However, there must be a satisfactory explanation as to why the weaving together of the evidence resolves some question of date or country that the exhibits individually do not.
45. The strength of the dictionary evidence is that the definition there presented squarely describes the kind of services in fact provided under the contested marks. However, it is not clear when the definition was first included in any dictionary, let alone a UK dictionary. The single reference to first known use (of 1982) does not really assist on that point.¹³ Not

¹⁰ *Hormel Foods Corp v. Antilles Landscape Investments NV* [2005] EWHC 13 (Ch); [2005] E.T.M.R. 54, particularly §§ 133 – 151.

¹¹ i.e. sections 3(1)(b) and 3(1)(c)

¹² - eg see not only Technopol (cited earlier) but also the CJEU in *OHIM v. Wrigley ("DOUBLEMINT")* [2004] RPC 18 at [32]

¹³ I note that **Exhibit AY22** shows a Google.com search result for the word 'taqueria', identifying it as a US Mexican Spanish noun and that a graph showing its use (where?) over time as peaking in around 2010.

one of the dictionary extracts identifies the term as “UK”; most explicitly identify it as a US term and nothing in the dictionary evidence suggests the word had a known UK meaning at either of the relevant dates. I again agree with Mr Brandreth where he submits that there is an obvious reason as to why the position might be different as between the UK and the USA – the proximity of the latter to Mexico and the influence of Mexican culture.

46. Mr Brandreth referred to *Alcon Inc v OHIM*¹⁴ in acknowledgement that it may be permissible to rely on material from outside the relevant time or area, but only if it allows the inference to be drawn about the relevant period and area; whereas he submitted that in the present case there is no reason given for that nor any that can be derived from the exhibits themselves.¹⁵ Mr Muir Wood argued that we now live in a global world and that English-language dictionaries available online and searchable by members of the public show the meaning in the English language of the word ‘taqueria’ as having the definition set out by the Applicant. That is not in my view sufficient. The matter is to be judged based on the perception of the average UK consumer and I find that the dictionary evidence does not permit a finding on the balance of probabilities that the word had that meaning in the UK in 2004 or 2010 and would have been easily recognisable to the public, such that its meaning would have dawned immediately on the average consumer.
47. I find that the evidence shows that a number of restaurants in cities across the UK have used the word to designate the kind of restaurant services they offer – for example, *Gary’s Taqueria* (October 2018 – **Exhibit AY5**). However, even the earliest such reference is July 2015 (in reference to *Bodega*, **Exhibit AY7**), which is fifteen years after the relevant date for the Earlier Mark and five years beyond that for the Stylised Mark. I do not consider this good evidence on which to invalidate the contested marks.
48. The evidence includes some examples of descriptive use by members of the public, although I accept that the extent to which they are representative of the UK average consumer is not clear. Mr Brandreth submitted that since TripAdvisor sources its reviews from tourists, it is perfectly possible that the reviews are from American tourists. Certainly, some of the comments indicate (from spellings and from overt statements) that some of the reviews are by people who have lived in the US and Mexico. However, this evidence again faces the greater difficulty that even the earliest review is years later than the relevant dates. Likewise, while the evidence demonstrates descriptive use by restaurant reviewers and

¹⁴ Case C-192/03 P at [41]

¹⁵ Contrast the technical language of specialists in the relevant scientific community identified in *Alcon*.

other journalistic coverage, most of it is more than five years after even the later relevant date.

49. Notwithstanding the suggestion that English-language books may be bought here in the UK over the internet, I do not consider the evidence of recipe books involving the word in the US and Australia at all helpful to the Applicant's case. I also found the evidence from the Cool Chile website of no assistance in establishing descriptive use. While the bracketed description of Taqueria (as a Mexican restaurant specialising in tacos) conforms to the definition, it would also be a description of that restaurant whatever it were called. The reference is anyway after the relevant dates and the fact that it provides a description of what Taqueria is, suggests that it would not be apparent to the average consumer. And given the entwined connection of Cool Chile Co with Taqueria, and the distinction it ascribes to its home-made tortillas, I find it entirely plausible that the references to 'taqueria tortillas' are intended to be distinctive use, not descriptive.
50. As to the EUIPO decision in evidence, I note not only **Exhibit DB13** relating to the response from Collins dictionary (the source referenced in the EUIPO decision), but I also agree with Mr Brandreth's position that a decision of a different trade mark office, in December 2017, addressing a different mark and based on unknown evidence and submissions is not probative of the state of affairs in the UK in 2004 or 2010 relevant in the present proceedings.
51. Although I do not give undue weight to the evidence of **Christopher Lewis** based on his experience as a trade mark examiner at the UKIPO, and I note that there is no suggestion that he personally examined the Earlier Mark, I do accept that standard procedural checks would have been in place that might reasonably have been expected to identify objections on absolute grounds. The evidence shows that no relevant objection was raised against the contested marks, from which it may be inferred that the claimed meaning of the word was not one that was easily recognisable to the examiner who did not raise descriptiveness as an issue. I do not find the evidence filed establishes that the marks were descriptive in the UK at the relevant dates or that it was reasonably foreseeable that the marks would become descriptive in such that they were invalidly registered. **The section 47(1) claims based on sections 3(1)(b) and 3(1)(c) of the Act fail.**
52. Whereas the section 3(1)(c) ground entails a degree of potentiality (that a sign *could* designate a characteristic, even if not currently actually used as such), the claim under

section 3(1)(d) presents the Applicant with a greater, or at least different, evidential challenge. At paragraph 30 of her decision in STASH (O/281/04), Professor Ruth Annand, as the Appointed Person, noted her view that “*there are two separate limbs of section 3(1)(d). A mark must be refused registration if, in relation to the goods or services applied for, it has become customary: (a) in the current language; or (b) in the bona fide and established practices of the trade.*” “Customary” is defined in the Oxford English Reference Dictionary, 1995 as: “usual; in accordance with custom”. In the present case, given the extent to which the exhibits post-date the relevant dates, there is nothing in the evidence that could sustain an objection based on the then-current usage in the relevant trade sector.

The section 47(1) claim based on section 3(1)(d) of the Act also fails.

53. Having rejected the claims that the marks were invalid at either of the relevant dates (when they were filed), I move on to the 46(1)(c) ground which involves the contention that the sign had, by 22 April 2019 (the date on which the revocation action was filed), become a common name for the services.

THE LAW PERTAINING TO THE REVOCATION CLAIMS

54. Section 46(1)(c) of the Act provides:

Revocation of registration.

- (1) The registration of a trade mark may be revoked on any of the following grounds—

...

- (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

...

55. The judgment in *Hormel Foods* (cited above), summarised the law under section 46(1)(c) of the Act as follows:

"163. Section 46(1)(c) implements Art.12(2)(a) of the Directive and corresponds to Art.50(1)(b) of the Regulation. It gives rise to two main issues. First, had the defendant's mark become **the** common name in the trade for a service in respect of which it is registered by 25 April 2003 or earlier? Secondly, if so, was this due to acts or inactivity of the defendant?

Common name in the trade

164. In Case C-371/02 *Björnekulla Frukindustrier AB v Procordia Food AB* [2004] E.T.M.R. 69 the Court of Justice held that, in cases where intermediaries participate in the distribution to the consumer or the end user of a product which is the subject of a registered trade mark, the relevant circles whose views fall to be taken into account in determining whether that trade mark has become the common name in the trade for the product in question comprise all consumers and end users and, depending on the features of the market concerned, all those in the trade who deal with product commercially.
165. One important question which arises is whether these provisions require that it be shown that the trade mark has become *the* common name in the trade for the goods or services in question or whether it is sufficient that it has become *the* common name.
- ...
167. The literal wording of s.46(1)(c), Art.12(2)(a) and Art.50(l)(b) suggests that what must be shown is that the trade mark has become the common name and not merely a common name. It is well-established, however, that European legislation is to be interpreted teleologically rather than necessarily in accordance with its literal wording. In my judgment, the purpose of these provisions, which is to enable marks to be removed from the register if they cease to fulfil their essential function of enabling consumers to distinguish the goods or services of one undertaking from those of others, would be defeated if the provisions were interpreted in this way. If a trade mark has become a common name for goods or services for which it is registered, then it can no longer perform this essential function even if there are also other common names for those goods or services.

Acts or inactivity

- ...
171. Here a question which arises is whether it must be shown that the proprietor's inactivity was the sole cause or whether it was sufficient that it was a cause. In my view it is not necessary to show that the proprietor's inactivity was the sole cause, it is sufficient to show that it was a cause. Again I consider that the contrary interpretation would not give effect to the purposes of these provisions."

DECISION ON REVOCATION

56. Mr Muir Wood argued that the term was akin to ‘pizzeria’, and that because the Proprietor had chosen a descriptive sign from Mexican Spanish it is perhaps unsurprising that 15 years later, in an era when foodstuffs are consumed around the world and where people adopt the language of the origins, that the Proprietor has not been able to stop, and could not have stopped, the term becoming generic. In support of the Applicant’s case, Mr Muir Wood highlighted several recent decisions of the EUIPO, where terms were found to have become generic. Mr Muir Wood’s skeleton argument noted in particular the following comments in the Vape Shop decision¹⁶:

“The Cancellation Division considers that when the situation reaches the point where vape shops can be found in Google maps, entities refer to their establishments as vape shops, Google gives results such as ‘best vape shops in Dublin’, the expression is used in studies related to e-cigarettes and the Oxford Dictionary mentions the expression as one of the most common compound names including the word ‘vape’, the EUTM proprietor cannot seriously argue that he could not reasonably be expected to fight against such a sporadic use. The activity to maintain a distinctive character of the contested mark should not have consisted merely of starting infringement procedures with particular businesses using the term ‘vape shop’ in their names, as the EUTM proprietor seems to be implying (and what he in any case did not do), but it should have, more importantly, consisted of informing the many entities responsible for the generic use of the expression (the dictionary, the maps, the website owners etc.), that ‘the vape shop’ is a trade mark and requesting these entities to stop the generic use or include information that it is a trade mark. Moreover, the applicant submitted a very convincing evidence of a very widespread generic use of the word ‘vape’ as such. The EUTM proprietor cannot pretend not to have known about this wide spread generic use. Given that its trade mark is composed of the word ‘vape’ in combination of totally inherently non-distinctive words ‘the’ and ‘shop’, it should have known that its mark would be extremely vulnerable of becoming a common name as a whole once the word ‘vape’ becomes generic. Consequently, the EUTM proprietor should either have objected to generic use of the word ‘vape’ as such, or at least be extra vigilant, once ‘vape’ had started to be widely used, as to the generic use of the expression ‘the vape

¹⁶ cancellation number 18 821 C in respect of European Union trade mark number 11 814 589 for the sign ‘THE VAPE SHOP’ - at page 14

shop' as a whole. The one opposition filed by the EUTM proprietor against another 'vape shop' trade mark cannot be considered to be sufficient activity in protecting the distinctiveness of its trade mark."

57. Mr Brandreth emphasised two points in relation to the revocation claims: firstly, that it requires a significantly higher level of awareness of the word among the public than arises under the 3(1)(c) ground: the word has to be a common term; it is not enough that it could be capable of being so. And secondly, that its status as a common term must be the result of acts or inactivity of the Proprietor.

58. I have in mind the connotation of the word "common" as indicating that the word 'taqueria' has become a generic descriptor, but I also acknowledge its ordinary significance of "occurring or found often; prevalent". Mr Brandreth argued that the evidence filed was the result of an extensive trawl by Mr Yerasimou and that that best evidence showed only "*a few bleed-over examples of descriptive use.*" He submitted that it revealed no sense of scale of use. I bear in mind Arnold J's view expressed at paragraph 166 in *Hormel* that the test is a qualitative one, not quantitative one, such that statistical evidence as to the frequency of use of the word is not key. Nonetheless, I note that the Applicant's evidence at **Exhibit AY8** shows that by 2019, a search for "taqueria" on TripAdvisor yielded 40 results across the UK. Many appear to have been returned in the results on the basis of single use of the word within their reviews. For example, Voodoo Café in Darlington has 330 reviews, only one of which mentions "taqueria" ("*unique selection of drinks with a fascinating array of taqueria*"). Even the "*hugely successful*" Wahaca, with over two thousand reviews of its Covent Garden restaurant shows only 3 mentions. While I understand Mr Muir Wood's point of comparison, the evidence does not in my view warrant equating the word with 'pizzeria'. I am very doubtful that a majority of the UK public would recognise the word "taqueria" as a common name (still less the common name) for the contested services (or a part thereof). I have noted the presentation of just four tweets mentioning the word (**Exhibit AY16**). However, I do not overlook that certainly by 2017 and 2018 there are several articles in the national press that use the word to describe the services of particular restaurants (**Exhibit AY11**). Such articles are of course addressed to the public at large, and whilst arguably those who pay attention to such restaurant reviews may still be a minority of the UK public, I accept that the journalistic usage weighs on the side of the suggestion that the term was moving toward common recognition and generic usage. That said, I have noted that some of the references in press articles overtly provide an explanation of the term. However, even if,

based on the evidence that, by April 2019, various restaurants in towns and cities in the UK referred to themselves as a taqueria, and that national press articles also used the term, I were to conclude that the word had become a common, generic name for the services – the Applicant still faces the challenge of having to establish that the ‘common name’ status is attributable to the inactivity of the Proprietor.

59. Mr Muir Wood acknowledged that the Proprietor’s evidence shows that it had not been inactive in policing its registrations with a view to trying to stop its marks becoming generic.¹⁷ His position was that despite the efforts of the Proprietor it could scarcely hope to have prevented its becoming entirely generic. In my view the word *solus* still operates as a badge of origin for the registered services; the evidenced activities of the Proprietor in defence of the distinctiveness of its registrations (**Exhibit DB15**) are in my view sufficient to defeat the revocation claims in this case and I do not find, as claimed, that knowledge of every evidenced use by third parties can be imputed to the Proprietor. Each case must be determined according to its own facts, and while I have noted the decision of the EUIPO tribunal in the vape shop case, the Proprietor in the present case has gone much further in respect of much more limited usage of the relevant term. **I find that the claims for revocation under section 46(1)(c) fail.**

THE OPPOSITION DECISION

The section 5(2)(b) claim

60. In light of my conclusions in relation to the invalidity and revocation claims, the Opponent remains the proprietor of a valid earlier mark for its claim under section 5(2) of the Act, which states:

Relative grounds for refusal of registration.

- ...
- (2) A trade mark shall not be registered if because—
- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected,
 - or
 - (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,

¹⁷ See para 183 Hormel

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

61. There was no dispute as to the relevant legal principles. Mr Muir Wood referred to the principles to be considered when undertaking the global assessment of the likelihood of confusion as set out by the Court of Appeal in *Specsavers v Asda*¹⁸, from which I note:
- a. the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
 - b. the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
 - c. the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
 - d. the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
 - e. nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
 - f. ...;
 - g. a lesser degree of similarity between the goods or services may be offset by a greater 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. ...; and

¹⁸ *Specsavers International Healthcare Ltd v. Asda Stores Ltd* [2012] EWCA Civ 24; [2012] E.T.M.R. 17 (at §52).
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k. if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the services

62. The Applicant accepted that the services for which registration is sought are identical to the earlier services (or at least some of them).

The average consumer and the purchasing process

63. In *Hearst Holdings Inc*,¹⁹ Birss J explained that “... *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 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 word “average” denotes that the person is typical*”.

64. Both parties agreed that the average consumer for restaurant services will be a **member of the general public**. The restaurant services at issue will likely be selected after sight, for example, of promotional material in hard copy or online and of signage on the high street; visual considerations will thus be an important part of the selection process, although aural considerations are also significant on the basis of oral recommendations. The average consumer will pay **no more than a medium level of attention**.

Comparison of the marks

65. It is clear from the CJEU judgment in *Sabel*²⁰ 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 CJEU stated in *Bimbo*²¹ 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*

¹⁹ *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), at paragraph 60.

²⁰ *Sabel BV v. Puma AG (C-251/95)* [1998] E.T.M.R. 1, at §23 - 25

²¹ *Bimbo SA v. OHIM (C-591/12P)* [2014] E.T.M.R. 41 at 34 - 35

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.

35. *The determination of which components of a composite sign contribute to the overall impression made on the target public by that sign is to be undertaken before the global assessment of the likelihood of confusion of the signs at issue. ...”*

66. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

The contested mark:	TACO RIA
The Earlier Mark:	TAQUERIA

67. The respective marks are both word-only marks. Although the Applicant has applied for a series of marks, Mr Muir Wood was content for the purposes of these proceedings to treat the Applicant’s sign as TACO RIA as shown above - the overall impression lies in those two words. The overall impression of the Earlier Mark inevitably lies in that single word.

Visual similarity

68. Mr Brandreth emphasised that the marks are of similar length and both start and end with identical letters TA and RIA, concluding that they are visually highly similar. Mr Muir Wood submitted that whilst the start and finish of the respective marks are identical, the splitting of the contested sign into two words and the replacement of ‘QUE’ with ‘CO’ generates a marked difference. He submitted that there is at most a medium degree of visual similarity. **I find the marks visually similar to medium degree.**

Aural similarity

69. Both parties seemed to agree that ‘QUE’ in the Earlier Mark would be pronounced as ‘care’, and that thus the Earlier Mark would essentially be pronounced TA – KEH – REE - AH and the contested sign as TA – KO REE - AH. Mr Muir Wood submitted that the pronunciation is different as between the second CO / KEH syllable and that the Earlier Mark will be

pronounced as a single word with four syllables whereas, although the contested sign also has four syllables since it involves two words the space between those two words “will be emphasised”. Mr Muir Wood concluded that the respective marks were aurally similar to a slightly lower degree than their visual similarity. While I acknowledge that pronunciation of the two words that make up the contested mark may involve a very slight aural hiatus, since they share the sounds TAK and REE-AH the audible difference at the second syllable will be very largely lost. **In my view the marks share a very high degree of aural similarity.**

Conceptual similarity

70. Mr Brandreth argued that there is no conceptual message to the Earlier Mark. He acknowledged that in the Applicant’s sign the word TACO is separated and that the word will have descriptive connotations in the context of restaurants. He submitted that this *“creates a small conceptual difference in isolation and an even smaller one in the context of the sign of the Application as a whole.”*
71. Mr Muir Wood argued that the concept behind the Earlier Mark is of a restaurant serving tacos. As to the Applicant’s sign, he too acknowledged the word ‘TACO’ carried a meaning, submitting that it is a word that has become commonplace and will be recognised by the average consumer. However, he submitted that the word ‘RIA’ is the Spanish word for estuary and thereby creates a different concept. His argument was that those among the general public who understand the meaning of the Spanish word ‘RIA’ will see the Applicant’s sign as an odd juxtaposition of two meaningful Spanish words. His submissions recognised, however, that while the average consumer would recognise the word ‘TACO’, she/he may not understand the word ‘RIA’ with the consequence that the full concept would not be understood. In light of those submissions he concluded that “there is accordingly, no or very limited conceptual similarity” between the Earlier Mark and the Applicant’s contested sign.
72. It seems to me that the portion of the general public in the UK having a reliable understanding of the meaning of the Spanish word ‘RIA’ is so small a minority as not to be admitted within my considerations of the notional perspective of the average consumer. I agree with both Counsel that the average consumer (or at least a significant portion of the UK public) will recognise the word TACO and understand it as a form of Mexican food. I also find that the average consumer (or at least a significant portion of the UK public) will attach no conceptual message to the Earlier Mark (“Taqueria”). On that basis Mr Brandreth

is right that **a conceptual difference arises**, albeit that the reference to the Mexican foodstuff 'TACO' may have descriptive connotations in the context of restaurants. However, I have also found that the evidence shows that, in the few years leading up to the date of the Application, the word "taqueria" has been used by some restaurants, in press articles and in some reviews on TripAdvisor, to convey the concept of a restaurant serving tacos (although much of the evidence dates from after the date of the Application i.e. after August 2017). I therefore allow that a significant portion of the UK public (a relevant minority) who make up the notional average consumer may understand that concept. To the extent that the contested sign also references the same food in the context of restaurant services the marks may also be considered to have **some conceptual similarity** (indeed the Applicant's sign sounds rather like a play on the word that is the Earlier Mark).

Distinctiveness of the earlier mark

73. The distinctive character of the earlier mark must be assessed, as, potentially, the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion.²² In *Lloyd Schuhfabrik*, 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-2779, 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)".

²² *Sabel* at [24]

74. It was argued on the part of the Applicant that even if the Earlier Mark were found not to fall foul of section 3(1) or section 46(1)(c) of the Act, it can only have a very low degree of inherent distinctive character, since it has the dictionary meaning a restaurant serving tacos. Mr Muir Wood accepted that if the Earlier Mark remained validly registered, it must have at least a minimum degree of inherent distinctive character but estimated it as no higher than that absolute minimum. For the Opponent, Mr Brandreth argued that the Earlier Mark is inherently distinctive and benefits from “a degree of acquired distinctiveness” thanks to the long-standing use that has been made of it.
75. It seems to me that since matters must be viewed from the perspective of the average consumer²³ and I have found that at least a significant portion of the UK public will attach no conceptual significance to the word “taqueria”, the Earlier Mark will be **inherently distinctive (to at least a medium degree) for those people**. The evidence shows use of the Earlier Mark for well over a decade, but there appears to have been just a single restaurant and the promotional expenditure and turnover, while perhaps respectable do not appear to me on a scale sufficient to have enhanced its distinctiveness. I have also found that there is a relevant portion of the UK public who make up the notional average consumer who may understand the word to refer to a restaurant that specialises in tacos. For those people, whom I consider likely to be a minority, the relationship of the word to the services may reduce its inherent distinctiveness, but I would still estimate the word *solus* to possess **a degree of distinctive character that is more than minimal**.

Likelihood of confusion

76. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph 61 of this decision. Sitting as the Appointed Person in the Eden Chocolat appeal decision²⁴, James Mellor QC, commented helpfully on the assessment process, including: “81.2 ... *the reason why the CJEU has stressed the importance of the ultimate global assessment is, in my view, because it is supposed to emulate what happens in the mind of the average consumer on encountering, for example, the later mark applied for with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.*”

²³ While not squarely on point, I note the findings of Anna Carboni as the Appointed Person at paragraphs 36 – 38 of her decision in Cherokee (BL O/048/08) regarding the public awareness of the meaning of Cherokee.

²⁴ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

77. Such a global assessment is not then a mechanical exercise. I must keep in mind my relevant findings above and the legal principles. The services are identical and I note this may have the capacity to offset a lesser degree of similarity between the marks. I have found that visual considerations will be important in accessing the services and that the marks are visually similar to medium degree. However, I have also noted the significance of aural considerations in the selection of the services based especially on how people pass on restaurant recommendations or make suggestions for where to eat, and I have found the marks to be similar to a very high degree from an aural perspective. The general public will not be paying a special degree of attention (**no more than a medium level**) and **allowing for the effect of imperfect recollection it seems to me that there is a likelihood that the average consumer may mistake one mark for the other – directly confuse the marks**. I have set out my findings on the extents to which the marks may be considered conceptually similar or different and on the degrees to which the Earlier Mark may be considered (inherently) distinctive; I find that none of those permutations disrupts my conclusion on a likelihood of confusion.

Outcome: The opposition succeeds in full and the Application cannot proceed to registration.

The section 5(4)(a) claim

78. Mr Brandreth argued at the hearing that the section 5(4)(a) ground would become relevant only if the challenge to validity of the Earlier Mark had succeeded and that otherwise it does not advance the opposition beyond the section 5(2)(b) position. I agree. For completeness, I would briefly indicate that I consider that a claim under section 5(4)(a) would succeed. The evidence establishes the relevant chain of ownership for the earlier right and the turnover levels are clearly sufficient to have generated the necessary goodwill and to demonstrate that the earlier right is distinctive of that goodwill. (Although not corroborated by supporting documents, Mr Benatoff states his evidence to be drawn from the records to which he has access; since there has been no challenge to it I accept Mr Benatoff's account and give it due weight.) Misrepresentation of course need not be intentional and in my view the closeness of the marks (particularly aurally) is enough to bring about the deception envisaged and a diversion of trade that would inevitably cause damage. Although the claimed goodwill was across the UK, and the business appears based on just one restaurant

in London, I note that it has received attention in the national press and that anyway a local goodwill would be capable of preventing a trade mark registration, which has national effect.

COSTS

79. The Opponent is entitled to a contribution towards its costs in pursuing the opposition and in defending the challenges to the standing of its registrations. In line with the scale published in the annex to Tribunal practice notice (2/2016), I make the following award of costs:

Reimbursement of the official fee for Form TM7 Notice of Opposition:	£200
Preparing a notice of opposition and reviewing the defence and statement:	£300
Preparing Form TM8 (x4) in defence of its contested registrations (noting degree of repetition):	£300
Preparation of evidence and considering and commenting on the other side's evidence:	£1800
Preparing for and attending a hearing:	£900
Total	£3500

80. I order W A Essex Limited to pay Taqueria Worldwide Limited Ltd the sum of £3500 (three thousand five hundred pounds). This sum is to be paid within two months of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of June 2020

Matthew Williams

**Hearing Officer
For the Registrar**