

**O/361/18**

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 179 814: GRINDHOUSE  
BY NEW LONDON IP LIMITED

AND

IN THE MATTER OF OPPOSITION THERETO BY GRIND & CO LTD  
UNDER OPPOSITION NO. 407980

## Background and pleadings

1. New London IP Limited (the applicant) applied to register the trade mark GRINDHOUSE under No 3 179 814 in the UK on 11<sup>th</sup> August 2016 (the relevant date). It was accepted and published in the Trade Marks Journal on 2<sup>nd</sup> September 2016 in respect of the following services:

Class 35:

*Promoting festivals and events; promoting food and drink festivals; retail services connected with the sale of audio recordings, video recordings, compact discs, DVD's, photographic and cinematographic films prepared for exhibition, music, sounds, images, text, signals, software, information, data and code provided by telecommunications networks by online delivery or by way of the internet, computer software, non-printed publications, identity and/or membership cards, printed matter, printed publications, books, magazines, recipe cards, flyers, photographs, prints, posters, stationery, albums, badges, calendars, diaries, personal organisers, book markers, pencils, pens, markers, postcards, greeting cards, fact sheets, notepads and notebooks, scrapbooks, food, drink, meat, poultry, game, fish and seafood, preserved, frozen, dried and cooked fruits and vegetables and food products prepared therefrom, salads, fruit salads, soup and soup preparations, preserved garden herbs, nuts, spreads, dips, crisps, snack foods, jellies, jams, eggs, milk and dairy products, cheese and cheese products, edible oils and fats, preserves, pickles, prepared meals, nutrition food bars, coffee, tea, cocoa, beverages made therefrom, prepared meals, flour and preparations made from cereals, bread, pies, rolls, biscuits, cakes, pastry and confectionery, ices, honey, treacle, mustard, vinegar, sauces, salad dressings, salt, pepper, mustard, condiments, essences, marinades, spices, chocolate, chocolates, non-medicated confectionery, nut confectionery, ice cream, frozen confections, snack foods in this class, muesli and muesli bars, breakfast cereals, nutrition food bars, puddings and desserts, water, mineral water, sparkling water, and other non-alcoholic drinks, soft drinks, fruit drinks*

*and fruit juices, liquid and powdered beverage mixes, flavouring syrups for making beverages, beer, ale, lager, stout and porter, low-alcoholic and de-alcoholised beverages, alcoholic beverages, wines, spirits and liqueurs, cider, perry, furniture, mirrors, picture frames, household or kitchen utensils and containers, combs and sponges, brushes (except paintbrushes), brush-making materials, articles for cleaning purposes, steelwool, unworked or semi-worked glass (except glass used in building), glassware, porcelain and earthenware, jewellery, clothing, footwear, headgear, textiles and bags.*

Class 41:

*Organisation of festivals; organising and managing festivals and events; organising and managing food and drink festivals; live cookery demonstrations; providing entertainment; organising of food and drink events; ticket and event booking services; information, consultancy and advisory services relating to the aforesaid services.*

Class 43:

*Services for providing food and drink; temporary accommodation; restaurant, cafe, cafeteria, snack bar, pub, guesthouse, hotel, bar, canteen, carvery, lodging and coffee house services; take-away services; catering services; contract food services; preparation of carry out foods and beverages; preparation of food and drink; provision of facilities for the consumption of food and of beverages; charitable services, namely providing food and drink catering; delicatessens [restaurants]; food cooking and food preparation services; night club services [provision of food]; tasting services (provision of beverages); information and advisory services, all relating to the aforesaid services.*

2. Grind & Co Ltd (the opponent) oppose the trade mark on the basis of Section 5(2) (b) and 5(3) of the Trade Marks Act 1994 (the Act). This is on the basis of the following earlier UK trade marks:

- a) 3 054 830 GRIND. Registered for the following goods and services:
- Class 29: *Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces, eggs, milk and milk products; edible oils and fats.*
  - Class 30: *Coffee, tea, cocoa, sugar, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.*
  - Class 32: *Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages.*
  - Class 33: *Alcoholic beverages (except beers); none being liqueurs.*
  - Class 41: *Production and distribution services in the field of sound and/or visual recordings and entertainment; music publishing services; artist management, recording studio services; production of masters of sound and/or visual recordings; remastering of sound and/or visual recordings; enhancement of sound and/or visual recordings; information services relating to the mixing, enhancement and recordal of sound and/or images; nightclub and discotheque services; dj and compere services; dance club services; hosting of musical events; production, distribution and publishing of music; production of television and radio programs; distribution of television and radio programs for others; providing online entertainment, namely providing sound and video recordings in the field of music and music based entertainment; entertainment services, namely providing online non-downloadable prerecorded musical sound and video recordings via a global computer network; fan clubs; entertainment in the nature of live concerts and performances by dj's, musical artists and groups; entertainment services, namely personal appearances by dj's, musical groups, musical artists and celebrities; organising, arranging, managing and staging musical events, shows, concerts, festivals, gigs and live band performances; arranging of competitions for entertainment purposes; organization of entertainment competitions; organisation of fan clubs; operating websites on the Internet in connection with entertainment and competitions; advisory and information services relating to all the aforesaid.*

- Class 43: *Services for providing food and drink; restaurant, bar and catering services.*

b) 3059018 Picadilly Grind. Registered for the following goods and services:

- Class 30: *Coffee, tea, cocoa, sugar, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.*
- Class 32: *Minerals and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages.*
- Class 43: *Services for providing food and drink; restaurant, bar and catering services.*

c) 3 060 182 Holborn Grind and 3 060 183 London Grind. Registered for the following goods and services:

- Class 30: *Coffee, tea, cocoa, sugar, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.*
- Class 32: *Minerals and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages.*
- Class 33: *Alcoholic beverages (except beers); none being liqueurs.*
- Class 43: *Services for providing food and drink; restaurant, bar and catering services.*

d) 3 100 332 (series of two) **GRIND GRIND** . Registered for the following goods and services:

- Class 29: *Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces, eggs, milk and milk products; edible oils and fats.*

- *Class 30: Coffee, tea, cocoa, sugar, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.*
- *Class 32: Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages.*
- *Class 33: Alcoholic beverages (except beers); none being liqueurs.*
- *Class 41: Production and distribution services in the field of sound and/or visual recordings and entertainment; music publishing services; recording studio services; production of masters of sound and/or visual recordings; remastering of sound and/or visual recordings; enhancement of sound and/or visual recordings; information services relating to the mixing, enhancement and recordal of sound and/or images; nightclub and discotheque services; dj and compere services; dance club services; hosting of musical events; production, distribution and publishing of music; production of television and radio programs; distribution of television and radio programs for others; providing online entertainment, namely providing sound and video recordings in the field of music and music based entertainment; entertainment services, namely providing online non-downloadable prerecorded musical sound and video recordings via a global computer network; fan clubs; entertainment in the nature of live concerts and performances by dj's, musical artists and groups; entertainment services, namely personal appearances by dj's, musical groups, musical artists and celebrities; organising, arranging, managing and staging musical events, shows, concerts, festivals, gigs and live band performances; arranging of competitions for entertainment purposes; organization of entertainment competitions; organisation of fan clubs; operating websites on the Internet in connection with entertainment and competitions; advisory and information services relating to all the aforesaid.*
- *Class 43: Services for providing food and drink; restaurant, bar and catering services.*

3. The opponent argues that the respective services are identical or similar and that the marks are similar. Under Section 5(3), the same trade marks as those listed above are relied upon. The opponent argues that its earlier trade marks enjoy a reputation in respect of all the goods and services registered and that the application will create a connection in the minds of the consumers that the services are either connected or emanate from the same or economically linked undertakings. This may divert business away from the opponent as the respective parties' services overlap. The strong brand identity cultivated by the opponent will also be diluted and cause it irreparable damage.
4. The opponent also claims that it has a family of trade marks, centred around "GRIND". Use of a similar trade mark by the applicant will inevitably lead to a link between the goods and services of the opponent and those of the applicant. The distinctive character of its earlier trade marks will be eroded and will no longer act as a guarantee of origin for the opponent's goods and services.
5. The opponent also opposes on the basis of Section 5(4)(a) of the Act. In this respect, the following signs are relied upon: GRIND, PICCADILLY GRIND, HOLBORN GRIND, LONDON GRIND, SOHO GRIND, CLERKENWELL GRIND, EXMOUTH MARKET GRIND, COVENT GARDEN GRIND, WHITECHAPEL GRIND, ROYAL EXCHANGE GRIND, HOXTON GRIND, SHOREDITCH GRIND/Shoreditch Grind and **GRIND GRIND** . According to the opponent, the signs have been used since 2011 in the UK (specifically in and around London) in respect of: *coffee and beverages; bar, restaurant and catering services; hosting of music events, renting and providing space for entertainment and events.*
6. The applicant filed a counterstatement denying the claims made. Specifically, it argues that conceptually, GRIND evokes the stage of coffee preparation in which roasted coffee beans are made into small pieces of powder. By contrast, GRINDHOUSE calls to mind a type of building or home. Further,

GRIND is low in distinctiveness given the conceptual connection to the relevant goods and services.

7. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
8. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

## **Evidence**

### **Opponent's Evidence**

9. The applicant did not request that the opponent provide proof of use. However, the opponent relies upon Section 5(3) and Section 5(4)(a) as well as a family of marks argument. The summary that follows focusses upon information directly relevant to these grounds and arguments.
10. The opponent's evidence is a witness statement, dated 2<sup>nd</sup> June 2017, from Mr David Abrahamovitch (Mr A), the CEO and Founder of the GRIND brand and Director of the opponent company.
11. He explains:
  - GRIND is a group of six café bars and three restaurants across London. The brand has been in existence since 2011. It sells numerous goods and provides a number of services. Exhibit DA1 contains further details. It is noted that it sells coffee (as in, packets to purchase), it provides café/restaurant services and also has its own coffee roastery. Further, it has diversified to providing music recording services and particular events such as (music) album launches, festivals etc.

- GRIND establishments are “trendy” and frequented by a number of celebrities.
- Photographs of each of the respective GRIND establishments are provided in the evidence, as are sample menus. All were opened prior to the relevant date in these proceedings.
- The opponent employs around 200 people and the group sales turnover for the last four years is as follows: 2016 – £5.8 million; 2015 – 3.7 million; 2014 – 1.8 million; 2013 - £813,000. The forecast for 2017 is £9 million. Advertising expenditure is also provided: 2016 - £92,641; 2015 - £124,348; 2014 - £64,534; 2013 - £39,731.
- The GRIND brand has developed a significant profile in the press. Examples in the evidence include articles in the Evening Standard and Time Out. It is noted from the Evening Standard article that the opponent’s brand is ambitious with a notable turnover.
- The GRIND brand has been nominated for a number of industry awards and in 2016 were selected as one of the Bloomberg’s Business Innovators. The judges recognised the innovation of the GRIND mobile ordering and payment App which allows customers to order and pay for a coffee whilst walking towards the nearest GRIND shop.
- There are over 6,000 customers using the GRIND loyalty card (a free coffee or cocktail for every ten purchased).
- As regards the applicant, the opponent approached them in April 2016 with a view to their involvement as an investor in the GRIND brand. This offer was declined. Four months later, the applicant applied for GRINDHOUSE, for essentially, according to Mr A, the same goods and services as though of the opponent. The evidence includes an email exchange between Mr A and Henry Dimpleby of the applicants, wherein Mr Dimpleby accepts that the businesses could be competitive.

### **Applicant’s evidence**

12. This is a witness statement, dated 26<sup>th</sup> September 2017, from Mr Jonathan Downey, a Director of the applicant company. He explains that the applicant

plans to use the trade mark in respect of a premium burger restaurant, with emphasis on providing high quality and diverse grinds of meat. Mr Downey believes that this premise will be a unique and differentiating feature for the applicant and that GRINDHOUSE was deliberately chosen to allude to this. My Downey considers this to be easily distinguishable from the opponent's use of grind, which, according to Mr Downey, is clearly allusive of coffee beans.

13. Mr Downey goes on to claim that he believes that GRINDHOUSE will also be understood as the name used to describe a genre of film known as "exploitation films" and the type of theatres which showed such films. Exhibit JD1 are Wikipedia extracts which appear to support Mr Downey's assertion. Exhibit JD2 refers to a film called GRINDHOUSE released in 2007 by Quentin Tarrantino and also to an article which appeared in Rolling Stone Magazine entitled "25 Best Modern Exploitation Movies".

14. Exhibit JD3 contains details of third parties using GRIND. Mr Downey is therefore of the view that in the light of this use, it is unclear as to how the respective trade marks in these proceedings can be confusingly similar.

### **Opponent's evidence in reply**

15. This is a second witness statement, dated 14<sup>th</sup> November 2017. Mr A raises doubts as to whether the mainstream public will understand the term GRINDHOUSE. Rather, he considers it niche.

16. Mr A also takes issue with the third party use described by Mr Downey and points out that in respect of two of the incidences of use, the opponent actually has opposed or is in the process of, opposing the offending trade marks.

## DECISION

### 17. Section 5(2)(b)

Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

## Comparison of goods and services

18. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

20. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

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

21. This decision will initially focus upon earlier trade mark No 3 054 830 GRIND and I shall return to consider the remaining trade marks if necessary. This trade mark is registered for the following goods and services:

- Class 29: *Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces, eggs, milk and milk products; edible oils and fats.*
- Class 30: *Coffee, tea, cocoa, sugar, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.*

- Class 32: *Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages.*
- Class 33: *Alcoholic beverages (except beers); none being liqueurs.*
- Class 41: *Production and distribution services in the field of sound and/or visual recordings and entertainment; music publishing services; artist management, recording studio services; production of masters of sound and/or visual recordings; remastering of sound and/or visual recordings; enhancement of sound and/or visual recordings; information services relating to the mixing, enhancement and recordal of sound and/or images; nightclub and discotheque services; dj and compere services; dance club services; hosting of musical events; production, distribution and publishing of music; production of television and radio programs; distribution of television and radio programs for others; providing online entertainment, namely providing sound and video recordings in the field of music and music based entertainment; entertainment services, namely providing online non-downloadable prerecorded musical sound and video recordings via a global computer network; fan clubs; entertainment in the nature of live concerts and performances by dj's, musical artists and groups; entertainment services, namely personal appearances by dj's, musical groups, musical artists and celebrities; organising, arranging, managing and staging musical events, shows, concerts, festivals, gigs and live band performances; arranging of competitions for entertainment purposes; organization of entertainment competitions; organisation of fan clubs; operating websites on the Internet in connection with entertainment and competitions; advisory and information services relating to all the aforesaid.*
- Class 43: *Services for providing food and drink; restaurant, bar and catering services.*

## 22. The later services are:

### Class 35:

*Promoting festivals and events; promoting food and drink festivals; retail services connected with the sale of audio recordings, video recordings, compact discs, DVD's, photographic and cinematographic films prepared for exhibition, music, sounds, images, text, signals, software, information, data and code provided by telecommunications networks by online delivery or by way of the internet, computer software, non-printed publications, identity and/or membership cards, printed matter, printed publications, books, magazines, recipe cards, flyers, photographs, prints, posters, stationery, albums, badges, calendars, diaries, personal organisers, book markers, pencils, pens, markers, postcards, greeting cards, fact sheets, notepads and notebooks, scrapbooks, food, drink, meat, poultry, game, fish and seafood, preserved, frozen, dried and cooked fruits and vegetables and food products prepared therefrom, salads, fruit salads, soup and soup preparations, preserved garden herbs, nuts, spreads, dips, crisps, snack foods, jellies, jams, eggs, milk and dairy products, cheese and cheese products, edible oils and fats, preserves, pickles, prepared meals, nutrition food bars, coffee, tea, cocoa, beverages made therefrom, prepared meals, flour and preparations made from cereals, bread, pies, rolls, biscuits, cakes, pastry and confectionery, ices, honey, treacle, mustard, vinegar, sauces, salad dressings, salt, pepper, mustard, condiments, essences, marinades, spices, chocolate, chocolates, non-medicated confectionery, nut confectionery, ice cream, frozen confections, snack foods in this class, muesli and muesli bars, breakfast cereals, nutrition food bars, puddings and desserts, water, mineral water, sparkling water, and other non-alcoholic drinks, soft drinks, fruit drinks and fruit juices, liquid and powdered beverage mixes, flavouring syrups for making beverages, beer, ale, lager, stout and porter, low-alcoholic and de-alcoholised beverages, alcoholic beverages, wines, spirits and liqueurs, cider, perry, furniture, mirrors, picture frames, household or kitchen utensils and containers, combs and sponges, brushes (except paintbrushes), brush-making materials, articles for cleaning purposes, steelwool, unworked or*

*semi-worked glass (except glass used in building), glassware, porcelain and earthenware, jewellery, clothing, footwear, headgear, textiles and bags.*

Class 41:

*Organisation of festivals; organising and managing festivals and events; organising and managing food and drink festivals; live cookery demonstrations; providing entertainment; organising of food and drink events; ticket and event booking services; information, consultancy and advisory services relating to the aforesaid services.*

Class 43:

*Services for providing food and drink; temporary accommodation; restaurant, cafe, cafeteria, snack bar, pub, guesthouse, hotel, bar, canteen, carvery, lodging and coffee house services; take-away services; catering services; contract food services; preparation of carry out foods and beverages; preparation of food and drink; provision of facilities for the consumption of food and of beverages; charitable services, namely providing food and drink catering; delicatessens [restaurants]; food cooking and food preparation services; night club services [provision of food]; tasting services (provision of beverages); information and advisory services, all relating to the aforesaid services.*

### Comparison of services in Class 35:

23. It is noted that the applied for specification in Class 35 includes retail services for a wide range of foodstuffs, many of which are included within the specification of the earlier trade mark. In this regard, I take into account the following guidance:

In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and

method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

24. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*<sup>1</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>2</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>3</sup>, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently

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<sup>1</sup> Case C-411/13P

<sup>2</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>3</sup> Case C-398/07P

pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

25. In *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, the General Court held that a registration for 'retail services', which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made between those services and the goods covered by the later mark. It was not therefore possible to determine that the respective services and goods were similar.

26. Bearing in mind the above, it is considered that the earlier goods which are specifically listed in the earlier trade mark, such as coffee and mustard (illustrative example, there are others to which the same analysis applies) are similar to a medium degree to the later services in so far as they relate to the retail of the same, specific goods.

27. There is a group of food items, for which the later trade mark retails that are included within wider food terms in the earlier trade mark. For example, soups are included in prepared meals. As such it is considered that the retail of soups on the one hand and prepared meals (as goods) on the other are

similar, to a low degree. The same conclusion also applies to the following later terms: (retail of) muesli and muesli bars, breakfast cereals (included within preparations made from cereals); spreads and dips (included within edible oils and fats); cheese and cheese products (included within milk products); preserves (included within jams); chocolate, chocolates, non-medicated confectionery, nut confectionery (included within confectionery); ice cream, frozen confections (included within ices); pickles (included within preserved, dried and cooked fruits and vegetables); marinades, essences (included within sauces (condiments and spices)); wines, spirits, cider, perry, stout, porter, (included within alcoholic beverages); de-alcoholised beverages, soft drinks (included within non-alcoholic drinks); low-alcoholic beverages (included within alcoholic beverages); lager, ale (included within beers); puddings and desserts (can be included in milk products, pastry and confectionery, dependent upon exact composition).

28. The later trade mark also includes the retail of “food” and “drink” at large. Bearing in mind the wide range of food and drink items included in the earlier trade marks, the relationship between the goods and the retailer of such goods is one where the similarity is more than low. This is because they are likely to share distribution channels and there is a complementary relationship. The degree of similarity is pitched as being medium.
29. The earlier goods specification does not specifically identify some of the contested retailed foodstuffs. Specifically: preserved garden herbs, salads, nuts, fruit salads, soup preparations, crisps, snack foods in this class, snack foods, nutrition food bars, biscuits, cakes, liqueurs. However, it is considered that a retailer of a wide range of food and drink (as is the case here) is likely to be linked with other specific food items. Distribution channels (at least) would coincide. In view of this, I consider there to be a low degree of similarity.
30. The remaining applied for retail services are in respect of a number of additional items, none of which appear in the earlier trade marks, such as the retail of *clothing, footwear, headgear, bags, jewellery, non-printed*

*publications, printed matter, printed publications, books, magazines, photographs, prints, posters, stationery, albums<sup>4</sup>, badges, calendars, book markers, pencils, pens, markers, postcards, fact sheets, notepads and notebooks, scrapbooks.* The earlier services include services such as entertainment in the nature of live concerts and organising, arranging, managing and staging musical events. Such events often include the selling of merchandise (commonly t shirts, prints and the like) in respect of the particular artist or musician on the bill. However, this does not render the services intrinsically similar. They differ in nature and purpose. The end user may coincide but only in the most general of terms. They are not complementary. I also take into account the following: In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

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

31. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of

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<sup>4</sup> Albums is considered to mean, in the context here, items such as photo albums (proper to Class 16).

activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

32. Bearing in mind the aforesaid, they are considered to be not similar.

33. The later retail services also include items such as those *connected with the sale of audio recordings, video recordings, compact discs, DVD's, photographic and cinematographic films prepared for exhibition, music, sounds, images, text, signals, software, information, data and code provided by telecommunications networks by online delivery or by way of the internet, computer software*. The earlier services include *providing online entertainment, namely providing sound and video recordings in the field of music and music based entertainment; entertainment services, namely providing online non-downloadable prerecorded musical sound and video recordings via a global computer network*. It is considered that these respective services can simply provide an alternative medium to one another (but with the consumer ultimately receiving the same content) or will otherwise be in direct competition. They can also have the same end users. They are considered similar to a medium degree.

34. I now turn to the following later services: *retail services connected with the sale of furniture, mirrors, picture frames, household or kitchen utensils and containers, combs and sponges, brushes (except paintbrushes), brush-making materials, articles for cleaning purposes, steelwool, unworked or semi-worked glass (except glass used in building), glassware, porcelain and earthenware and textiles*. I cannot see that these terms have anything in common with any of the earlier goods and services. They are considered to be not similar.

35. The later service *promoting festivals and events* has features in common with the later term *organising, arranging, managing and staging musical events, shows, concerts, festivals, gigs and live band performances*. Organising and arranging are broad terms can involve activities of a promotional nature. They may also be targeted at the same end user. They are considered to be

similar, to a medium degree. Likewise the earlier term includes all types of festivals. This can include the food and drink festivals of the later term and so the same analysis applies here. This term is also similar to a medium degree.

36. The remaining terms left over in Class 35 are: *retail services connected with the sale of identity and/or membership cards, flyers, recipe cards, diaries, personal organisers, greeting cards*. With the exception of *identity and/or membership cards, flyers* it is considered that these terms have nothing common with any of the earlier terms. They are not similar. In respect of the retail of *identity and/or membership cards*, the earlier services include *fan clubs; organisation of fan clubs* and of course hosting a wide range of events as already described. Any of these services is likely to include the sale of membership cards as an intrinsic activity. There is similarity, to a low to medium degree. It is unclear as to exactly what is meant by the term *retail services connected with the sale of flyers*. Flyers are promotional documents (usually one page) which raise awareness or otherwise advertise an event, service, product, special offer etc. They are typically made to order (from printers) so that they include the relevant information about what they are trying to promote. They are usually given out or otherwise distributed free of charge, so the retail of them is an odd term. In the absence of any evidence or submissions from the parties on this point, I conclude that there is no similarity between this later term and any of the earlier terms.

#### Comparison of services in Class 41:

37. The earlier services are: *organising, arranging, managing and staging musical events, shows, concerts, festivals, gigs and live band performances*. The following later services are self evidently identical: *organisation of festivals; organising and managing festivals and events; organising and managing food and drink festivals; live cookery demonstrations; providing entertainment; organising of food and drink events; ticket and event booking services*.

38. The later services: *information, consultancy and advisory services relating to the aforesaid services* are also identical.

### Comparison of services in Class 43:

*Services for providing food and drink; temporary accommodation; restaurant, cafe, cafeteria, snack bar, pub, guesthouse, hotel, bar, canteen, carvery, lodging and coffee house services; take-away services; catering services; contract food services; preparation of carry out foods and beverages; preparation of food and drink; provision of facilities for the consumption of food and of beverages; charitable services, namely providing food and drink catering; delicatessens [restaurants]; food cooking and food preparation services; night club services [provision of food]; tasting services (provision of beverages); information and advisory services, all relating to the aforesaid services.*

39. With the exception of *temporary accommodation, hotel, guesthouse, lodging services*, the later services are all concerned with the provision of food and drink (or information and advisory services relating thereto). This is true, irrespective of the exact nature of the provision (take away, catering service, restaurant etc). The earlier term is *services for providing food and drink* which is clearly broad and clearly includes the later services to the extent specified above. They are identical. The same applies to the information and advisory services.

40. This leaves: *temporary accommodation, hotel, guesthouse, lodging services* in the later specification. It is common for services providing accommodation to also provide food and drink and vice versa. They go hand in hand. They are considered to be similar to a medium degree. The same applies to the information and advisory services.

41. The overall outcome of the above is therefore: the following services are considered to be identical and/or similar:

Class 35:

*Promoting festivals and events; promoting food and drink festivals; retail services connected with the sale of audio recordings, video recordings, compact discs, DVD's, photographic and cinematographic films prepared for exhibition, music, sounds, images, text, signals, software, information, data and code provided by telecommunications networks by online delivery or by way of the internet, computer software, identity and/or membership cards, food, drink, meat, poultry, game, fish and seafood, preserved, frozen, dried and cooked fruits and vegetables and food products prepared therefrom, salads, fruit salads, soup and soup preparations, preserved garden herbs, nuts, spreads, dips, crisps, snack foods, jellies, jams, eggs, milk and dairy products, cheese and cheese products, edible oils and fats, preserves, pickles, prepared meals, nutrition food bars, coffee, tea, cocoa, beverages made therefrom, prepared meals, flour and preparations made from cereals, bread, pies, rolls, biscuits, cakes, pastry and confectionery, ices, honey, treacle, mustard, vinegar, sauces, salad dressings, salt, pepper, mustard, condiments, essences, marinades, spices, chocolate, chocolates, non-medicated confectionery, nut confectionery, ice cream, frozen confections, snack foods in this class, muesli and muesli bars, breakfast cereals, nutrition food bars, puddings and desserts, water, mineral water, sparkling water, and other non-alcoholic drinks, soft drinks, fruit drinks and fruit juices, liquid and powdered beverage mixes, flavouring syrups for making beverages, beer, ale, lager, stout and porter, low-alcoholic and de-alcoholised beverages, alcoholic beverages, wines, spirits and liqueurs, cider, perry.*

Class 41:

*Organisation of festivals; organising and managing festivals and events; organising and managing food and drink festivals; live cookery demonstrations; providing entertainment; organising of food and drink events; ticket and event booking services; information, consultancy and advisory services relating to the aforesaid services.*

Class 43:

*Services for providing food and drink; temporary accommodation; restaurant, cafe, cafeteria, snack bar, pub, guesthouse, hotel, bar, canteen, carvery, lodging and coffee house services; take-away services; catering services; contract food services; preparation of carry out foods and beverages; preparation of food and drink; provision of facilities for the consumption of food and of beverages; charitable services, namely providing food and drink catering; delicatessens [restaurants]; food cooking and food preparation services; night club services [provision of food]; tasting services (provision of beverages); information and advisory services, all relating to the aforesaid services.*

42. The remaining services are not similar.

## **Comparison of marks**

43. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

44. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

45. The respective trade marks are shown below:

GRIND	GRINDHOUSE
Earlier trade mark	Later trade mark

46. Neither trade mark is comprised of complex features. The later trade mark is GRIND and HOUSE conjoined, both of which are instantly understandable words that are likely to be appreciated instantly. However, neither is more dominant or distinctive over the other and so the mark as a whole must be considered. Visually, the marks are similar to the extent that each contain GRIND and differ in respect of HOUSE which appears in the later trade mark and which has no counterpart in the earlier trade mark. They are considered visually similar to a medium degree.

47. The situation is similar aurally, the earlier trade mark will coincide entirely with the first syllable of the later trade mark. But differ in respect of the second syllable HOUSE which has no counterpart in the earlier trade mark. They are similar to a medium degree.

48. Conceptually, GRIND primarily means to crush a substance until it becomes a fine powder. Though other potential meanings are not ignored, it is considered that this meaning will be the one that is readily apparent to the consumer. The later trade mark will be understood, according to the applicant as the name used to describe a genre of film known as “exploitation films” and the type of theatres which showed such films. The applicant has filed evidence in this regard, which has been described above. This evidence is very limited in scope. However, I accept that some of the UK general public will understand GRINDHOUSE as meaning that as has already been described. I am not persuaded that this meaning will be widely known and instantly appreciated upon seeing GRINDHOUSE. As such, this evidence does not help the applicant demonstrate that the trade marks are conceptually different.

49. As such, I must assess the impact of the addition HOUSE in the later trade mark and whether or not it has the effect of creating a conceptual gap. I have considered this point carefully but conclude that HOUSE does not alter the meaning when combined with GRIND to create an instantly appreciable differing idea. Rather, it conjures up the idea of a physical building where the activity of grinding can take place. I conclude that there is conceptual similarity between the trade marks. This is pitched as being medium.

## **Average consumer and the purchasing act**

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

51. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,*

[2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

52. The average consumer of these goods and services will be the public at large and also businesses in respect of services such as those offering promotional services. The purchasing act will vary, from predominantly visual in the case of consumer items but also include word of mouth in respect of, for example, music festivals. The latter will also take account of areas of personal interest. Both visual and aural considerations are therefore important. As regards the level of attention one would expect to be displayed, again, this will vary from fairly low in respect of inexpensive consumables purchased frequently, to fairly high in respect of, for example tickets to a music festival or the acquisition of a promotional service which can be expensive and purchased infrequently and so, carefully. Both extremes need to be factored into the final assessment.

## **Distinctive character of the earlier trade mark**

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an

overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

54. It is noted that the opponent does not claim it enjoys an enhanced distinctive character as a result of use made of the earlier trade mark (though it does claim reputation under Section 5(3) which I will return to further below). Prima facie, GRIND is an ordinary dictionary word with the meaning as already described above. The applicant argues it is weak in distinctive character, particularly in respect of coffee shops. However, the goods and services on the basis of which the trade mark is registered are far broader than this. It is entirely meaningless for the vast majority of the goods and services for which it is registered. As such, it has at least an average degree of distinctive character.

55. The exception to this is in respect of goods such as coffee and coffee shops (included within *services for providing food and drink*). However, even in respect of such goods and services, it is considered that GRIND is not the apt term and even though it is relatively weaker in this context than the other

goods and services, it retains a degree of distinctive character. This is considered to be lower than average.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

56. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### *The principles*

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks

bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Similarity of goods and services is a necessary condition for Section 5(2)(b) to apply. For those contested services found to be not similar, the opposition inevitably fails.

57. Many of the services have been found to be identical or similar to varying degrees. The marks have been found to be similar to a medium degree. The earlier trade mark has, in the main, at least an average degree of distinctive character. This weighs in the opponent's favour. The exception to this is in respect of goods such as coffee and services such as coffee houses. However, even then, I bear in mind that the case law tells me that an earlier trade mark being relatively weak in distinctive character does not preclude a finding of a likelihood of confusion<sup>5</sup>. The range of attention displayed during the purchasing act will vary dependent upon the goods and/or services in question and will never be very low. However, even in such a scenario, it is accepted that HOUSE will not go unnoticed in the later trade mark and is likely to be sufficient to avoid one trade mark being mistaken for the other. However, the following is also taken into account:

58. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

59. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion

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<sup>5</sup> *L'Oréal SA v OHIM*, Case C-235/05 P

should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

60. Here, the earlier trade mark is GRIND and the later trade mark is GRINDHOUSE. The addition of HOUSE does not have the effect of creating a conceptual gap between the marks. Rather, it merely reinforces GRIND by providing a physical place for it to occur. It is GRIND that will provide the conceptual hook in the mind of consumers, to the extent that I am persuaded that GRINDHOUSE will be seen as another brand of the owner of GRIND. As such, it is considered that indirect confusion between the respective trade marks is likely. This is considered to be the case, irrespective of the degree of similarity of the later services to those registered in the earlier trade mark.

61. The opposition under Section 5(2)(b) therefore succeeds in respect of the goods and services found to be identical and/or similar.

62. In respect of the remaining earlier trade marks relied upon under Section 5(2)(b), it is considered that they do not put the opponent in any better position as the remaining contested services are still dissimilar. They will therefore not be considered under Section 5(2)(b).

## **Final Remarks – Confusion: Families of trade marks**

63. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the Court of Justice of the European Union stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing

common characteristics which make it possible for them to be regarded as part of a 'family' or 'series' of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

64. The opponent claims that the following trade marks are a family:

**GRIND GRIND** , Picadilly GRIND, Holborn GRIND and London GRIND. I notionally accept that use of these trade marks is borne out by the evidence. However, I cannot see how a family of marks argument improves the opponent's position over and above that they enjoy as a result of GRIND alone. As such, and bearing in mind the above findings, I dismiss the argument.

65. The opposition under Section 5(2)(b) has not succeeded in its entirety. As such, I will go on to consider the remaining grounds.

### **Section 5(3) – Reputation**

66. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

67. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L’Oreal v Bellure*).

## **REPUTATION – THRESHOLD**

68. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

69. The evidence filed by the opponent in support of its claim under Section 5(3) has already been described above. The following is of note:

- a) The opponent's chain of shops is limited geographically. All six are in London.
- b) Further, though there is press coverage, this is also limited geographically.
- c) There are turnover figures provided but there is no context of the relevant market as a whole. It is therefore impossible to gauge market share.

70. The evidence does not demonstrate that the opponent's earlier trade marks are known by a substantial number of the general public for the reasons given above. It is not enough persuade me that the opponent enjoys a reputation in any of the earlier trade marks.

71. The ground of opposition under Section 5(3) therefore fails.

## Section 5(4)(a) – Passing Off

72. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

73. The opponent bases this ground of opposition upon a number of earlier signs encompassing GRIND, PICCADILLY GRIND, HOLBORN GRIND, LONDON GRIND, SOHO GRIND, CLERKENWELL GRIND, EXMOUTH MARKET GRIND, COVENT GARDEN GRIND, WHITECHAPEL GRIND, ROYAL EXCHANGE GRIND, HOXTON GRIND, SHOREDITCH GRIND/Shoreditch Grind and **GRIND GRIND** . As already described above, according to the opponent, the signs have been used since 2011 in the UK (specifically in and around London) in respect of: *coffee and beverages; bar, restaurant and catering services; hosting of music events, renting and providing space for entertainment and events.*

74. It is considered that these additional signs do not improve the opponent’s position. This is because even though the scope of the earlier sign’s is increased in terms of number, as regards materiality, nothing has changed. Further, there is said to be goodwill in respect of goods and services for which similarity has already been found under Section 5(2)(b). In respect of the

services of the application which survived the 5(2)(b) ground, it is difficult to see how the opponent can succeed here.

75. This ground of opposition therefore also fails.

## **OUTCOME**

76. The opposition is partially successful and so the application is refused in respect of the following services:

Class 35:

*Promoting festivals and events; promoting food and drink festivals; retail services connected with the sale of audio recordings, video recordings, compact discs, DVD's, photographic and cinematographic films prepared for exhibition, music, sounds, images, text, signals, software, information, data and code provided by telecommunications networks by online delivery or by way of the internet, computer software, identity and/or membership cards, food, drink, meat, poultry, game, fish and seafood, preserved, frozen, dried and cooked fruits and vegetables and food products prepared therefrom, salads, fruit salads, soup and soup preparations, preserved garden herbs, nuts, spreads, dips, crisps, snack foods, jellies, jams, eggs, milk and dairy products, cheese and cheese products, edible oils and fats, preserves, pickles, prepared meals, nutrition food bars, coffee, tea, cocoa, beverages made therefrom, prepared meals, flour and preparations made from cereals, bread, pies, rolls, biscuits, cakes, pastry and confectionery, ices, honey, treacle, mustard, vinegar, sauces, salad dressings, salt, pepper, mustard, condiments, essences, marinades, spices, chocolate, chocolates, non-medicated confectionery, nut confectionery, ice cream, frozen confections, snack foods in this class, muesli and muesli bars, breakfast cereals, nutrition food bars, puddings and desserts, water, mineral water, sparkling water, and other non-alcoholic drinks, soft drinks, fruit drinks and fruit juices, liquid and powdered beverage mixes, flavouring syrups for making beverages, beer, ale, lager, stout and porter, low-alcoholic and de-alcoholised beverages, alcoholic beverages, wines, spirits and liqueurs, cider, perry.*

Class 41:

*Organisation of festivals; organising and managing festivals and events; organising and managing food and drink festivals; live cookery demonstrations; providing entertainment; organising of food and drink events; ticket and event booking services; information, consultancy and advisory services relating to the aforesaid services.*

Class 43:

*Services for providing food and drink; temporary accommodation; restaurant, cafe, cafeteria, snack bar, pub, guesthouse, hotel, bar, canteen, carvery, lodging and coffee house services; take-away services; catering services; contract food services; preparation of carry out foods and beverages; preparation of food and drink; provision of facilities for the consumption of food and of beverages; charitable services, namely providing food and drink catering; delicatessens [restaurants]; food cooking and food preparation services; night club services [provision of food]; tasting services (provision of beverages); information and advisory services, all relating to the aforesaid services.*

77. The following services can proceed to registration:

Class 35:

*Retail services connected with the sale of non-printed publications, printed matter, printed publications, books, magazines, recipe cards, flyers, photographs, prints, posters, stationery, albums, badges, calendars, diaries, personal organisers, book markers, pencils, pens, markers, postcards, greeting cards, fact sheets, notepads and notebooks, scrapbooks, furniture, mirrors, picture frames, household or kitchen utensils and containers, combs and sponges, brushes (except paintbrushes), brush-making materials, articles for cleaning purposes, steelwool, unworked or semi-worked glass (except glass used in building), glassware, porcelain and earthenware, jewellery, clothing, footwear, headgear, textiles and bags.*

## **COSTS**

78. It is clear that the opponent has been overwhelmingly successful. As such it is entitled to a contribution towards its costs, less a small proportion whereby the applicant succeeded. In the circumstances I award the opponent the sum of £1600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of opposition plus statutory fee - £500

Preparing and filing evidence - £750

Considering evidence - £350

TOTAL - £1600

79. I therefore order New London IP Limited to pay Grind & Co Ltd the sum of £1600. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 14<sup>th</sup> day of June 2018**

**Louise White**

**For the Registrar**