

O-368-20

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NOS. 3272402, 3272401 AND 3272397
REGISTERED IN THE NAME OF IMAPIZZA LLC AND IN RESPECT OF THE
FOLLOWING MARKS**

andpizza/Andpizza

&pizza

&PIZZA

IN CLASSES 30, 32 AND 43

**AND IN THE MATTER OF AN APPLICATIONS FOR INVALIDATION NO. 502315,
502316 AND 502317 BY AT PIZZA LIMITED**

BACKGROUND AND PLEADINGS

1) ImaPizza LLC (“the proprietor”) is the proprietor of the following three registered trade marks:

(i) 3272402
andpizza/Andpizza (Series of two marks)

Filing date: 22 November 2017

Registration date: 23 February 2018

(ii) 3272401



Filing date: 22 November 2017

Registration date: 23 February 2018

(iii) 3272397

&PIZZA

Filing date: 22 November 2017

Registration date: 23 February 2018

2) All three registrations include an identical list of goods and services in classes 30, 32 and 43.

3) On 29 October 2018, At Pizza Limited (“the applicant”) applied to invalidate the registrations. The invalidations are based upon section 5(2)(b), section 5(4)(a), section 3(1)(b) and section 3(1)(c) of the Trade Marks Act 1994 (“the Act”). In respect of the first ground, the applicant relies on the following two registrations:

UK Mark No. 3238196



Filing date: 19 June 2017

Date of entry in register: 25 January 2019

UK Mark No. 3238199



Filing date: 19 June 2017

Date of entry in register: 29 December 2018

4) These registrations are both in respect of the following identical list of goods and services:

Class 25: *Clothing; footwear; headgear.*

Class 30: *Flour and preparations made from cereals, bread, pastry and confectionery; honey, yeast, baking powder, salt, mustard; vinegar, spices and seasonings; rolls, biscuits, breads, cakes, rice; pizza; pizza sauces; pizza crusts; pizza dough; pasta and prepared pasta entrees.*

Class 43: *Restaurant services; snack bar services, café services, canteens and fast-food outlets, catering services.*

5) The registration dates of the earlier marks are less than five years before the application for invalidation was made. The significance of this is that the proof of use provisions set out in section 47(2) and section 47(2A) of the Act do not apply to the earlier marks and the applicant is entitled to rely upon the complete list of goods and services.

6) It's pleadings in respect of the section 5(2)(b) grounds are that the respective marks are visually, aurally and conceptually highly similar and there exists a high level of similarity, if not identity, between the respective goods and services. As a consequence, it is submitted that there exists a likelihood of confusion, such that the average consumer will believe that the respective goods and services originate from the applicant.

7) In respect of the ground based upon section 5(4)(a), the applicant relies on its goodwill attaching to the signs "atpizza", "@pizza", "@" as well as the following two stylised signs:



that are claimed to have been first used on 12 September 2017 in Edinburgh in respect of an identical list of goods and services as listed in its registered marks. It asserts that the proprietor's registrations are liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting unregistered trade marks or other signs use in the course of trade. It asserts that, at the relevant date, it was the owner of substantial goodwill and/or reputation in the UK as represented by its marks.

8) It also claims that the registrations are caught by the provisions of section 3(1)(b) and section 3(1)(c) because, when taken as a whole, the marks will inform the consumer that the goods are pizzas and the services are, for example, a pizza restaurant. It concludes that because of this the marks convey direct information to the consumer of the kind, intended purpose and subject matter and that they are devoid of any distinctive character.

9) The proprietor filed counterstatements denying most of the claims made. It accepts that there is similarity between some of the parties' Class 30 and Class 32 goods and Class 43 services.

10) The parties both filed evidence and the applicant also provided written submissions. I will refer to the evidence to the extent that I consider it necessary and I will keep the submissions in mind. A hearing was held before me on 4 June 2020 where the applicant was represented by Kyra Nezami of counsel, instructed by Lawdit Solicitors Limited and the proprietor was represented by Andrew Norris of counsel, instructed by J A Kemp LLP.

The applicant's evidence

11) This takes the form of a witness statement by Rupert James Tennant Lyle, founder and director of the applicant, together with the single Exhibit RL1. I will refer to this later to the extent that I consider it necessary

The proprietor's evidence

12) This is in the form of the witness statement of Deborah Morris of Eccora Limited, a specialist intellectual property investigations company. The purpose of Ms Morris' evidence is to introduce a commercial investigation undertaken by Eccora Limited into the use of the marks AT PIZZA/@PIZZA between 12 September 2017 and 22 November 2017. This is provided at Exhibit DM1. No point was taken regarding this evidence and I will not refer to it further.

DECISION

13) The invalidation action is based upon section 5(2)(b), section 5(4)(a), section 3(1)(b) and section 3(1)(c). These are all relevant in invalidation because of section 47, the relevant parts of which read:

“**47.** - (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.

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

14) In its written submissions of 29 April 2019, the applicant narrowed the scope of goods and services that it claimed should be invalidated. At the hearing, Ms Nezami also provided a reduced list of goods and services that were being challenged. This was similar, but not identical, to the list of goods and services provided in the written submissions. Ms Nezami clarified that the applications to invalidate are now restricted to the list of goods and services that she provided, namely:

Class 30: *Bakery desserts; Candies; Candy; Cheese sauce; Cooking sauces; Garlic-based sauces; ...; Pasta sauce; Pesto sauce; Pizza; Pizza dough; Pizza sauce; Ready-made sauces; ...; Spaghetti sauce; ...; Tomato sauce; bread, pastry and confectionary; preparations made from cereals.*

Class 43: *Restaurant and bar services; restaurant, bar and catering services; restaurant and bar services, namely, providing food and beverages for consumption on and off the premises; take-out restaurant services; pizzeria services; café services; pop up restaurant services; mobile restaurant services; take-away services; the provision of food and drinks*

Section 5(2)(b)

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

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

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

Comparison of goods and services

16) In comparing the respective specifications, all the relevant factors should be taken into account. In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon*, (Case C-39/97), the Court stated at paragraph 23:

“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”.

17) 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.

18) In addition, I also keep in mind the guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, when it stated that:

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

19) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

Class 30

20) As Ms Nezami submitted at the hearing, all of the following goods (in the table below, taken from Ms Nezami’s skeleton argument) are identical to goods of the applicant either because the identical term appears in the respective specifications or because the goods of one term are included in a broader term of the other party. This was accepted by Mr Norris:

Proprietor's contested goods	Applicant's goods
Class 30: "Bakery desserts; ... Candies; Candy;... bread, pastry and confectionary"	Class 30: "bread, pastry and confectionary; ... biscuits, breads, cakes"
Class 30: "Pizza; Pizza dough; Pizza sauce"	Class 30: "pizza; pizza sauces; ... pizza dough"
Class 30: "preparations made from cereals"	Class 30: "Flour and preparations made from cereals"

21) Ms Nezami submitted that the remaining goods, namely *Cheese sauce; Cooking sauces; Garlic-based sauces; Pasta sauce; Pesto sauce; Ready-made sauces; Spaghetti sauce; Tomato sauce* are similar to the applicant's *pizza; pizza sauces; pizza crusts; pizza dough; pasta and prepared pasta entrees* are similar to a high degree.

22) Mr Norris accepted that there was similarity but disputed the precise level. The proprietor's goods are all sauces for use in cooking, consequently, they are the same in nature, purpose and methods of use as the applicant's *pizza sauces*. As an average consumer of grocery products such as these, I am aware that a trader may provide, for example, a range of sauces for use in making meals that are perceived as having an Italian influence such as pizza, pasta and spaghetti-based meals. Further, such products are often placed on the same or adjacent shop shelves. Therefore, the average consumer is familiar with such goods having the same trade channels. They are not used in respect of the same meals and consequently they are not in competition, nor are they complementary in the sense expressed in *Boston Scientific*. Taking all of this into account, I conclude that these respective goods share at least a medium level of similarity.

Class 43

23) Similarly to Class 30, Ms Nezami submitted that the following services are identical or similar and Mr Norris accepted this. Again, I use an extract from the table in Ms Nezami's skeleton:

The proprietor's contested services	Applicant's services
Class 43: "Restaurant ...; restaurant, [...] and catering services; restaurant ..., namely, providing food and beverages for consumption on and off the premises; take-out restaurant services; pizzeria services; café services; pop up restaurant services; mobile restaurant services; take-away services; the provision of food and drinks."	Class 43: "Restaurant services; snack bar services, café services, canteens and fast-food outlets, catering services."

24) Ms Nezami submitted that the proprietor's *bar services* are similar to a high degree to all of the applicant's Class 43 services because restaurants and snack bars will also often offer bar services. Once again, Mr Norris accepted that these services are similar, however, he disputed the level of similarity. I disagree with Ms Nezami's conclusion but recognise the possibility for the providers of such services to be linked in the minds of the consumer and I find that *bar services* share at least a medium level of similarity to the applicant's services.

Comparison of marks

25) It is clear from *Sabel BV v. Puma AG*, Case C-251/95 (particularly paragraph 23), Case C-251/95, 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 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."

26) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take account of 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.

27) At the hearing, Ms Nezami accepted that the applicant’s case in respect of earlier mark number 3238199 @ was no better than its case in respect of earlier mark number 3238196 @PIZZA. In light of this I will only undertake a comparison between the earlier mark number 3238196 @PIZZA and the proprietor’s marks. Therefore, the respective marks are:

Applicant’s mark	Proprietor’s marks
	<p data-bbox="879 929 1150 965">Andpizza/andpizza</p> 

28) The applicant’s mark consists of an “@” symbol and the word “pizza” in lower case. Both these elements are presented in a text that features a double line. The “@” symbol is in a slightly larger font. The word “pizza” has no distinctive character in respect to pizza related goods and services offered from a pizza restaurant or otherwise related to the provision of pizza. The “@” element appears at the beginning of the mark, but because the “pizza” element (despite being in a slightly smaller font) makes up a greater proportion of the mark, I find that the two elements share a roughly equal role in the overall impression created by the mark.

29) In respect of the proprietor’s **&pizza** mark, the word “pizza” is presented in lowercase with the “&” symbol appearing taller at the start of the mark. Whilst the “&” symbol will be readily understood as meaning “and”, it is shorter than the five-letter

word itself. Taking all of this together, the two elements share a roughly equal role in the overall impression created by the mark.

30) In respect of the “&PIZZA” word mark, the “&” symbol does not stand out in the same way because it is presented in the same size of the capital letters in the word “PIZZA”. This has the effect of tilting the word “PIZZA” towards being the dominant element of the mark. The word “PIZZA” has no distinctive character in respect of pizza related goods and services. The “&” element is also, more generally, non-distinctive and the distinctive character of the mark resides in its totality.

31) The proprietor’s “Andpizza”/”andpizza” series marks consist of two readily understood words conjoined. The words “And”/”and” and “pizza” retain their identity in the mark. As with the applicant’s mark, the word “pizza” has no distinctive character in respect of pizza related goods and services. The word “And” has a slightly larger visual presence than the “&” symbol in the proprietor’s other marks because it has three characters rather than one. I conclude that two parts of the mark play an approximately equal role within the mark.

32) The fact that the two elements are conjoined does not dilute the individual impact on the two elements upon the marks.

&PIZZA and &pizza

33) Ms Nezami submitted that the comparison of these two marks to the earlier mark is essentially the same. Despite finding the balance of dominance between the elements of the two marks being slightly different, I agree. Therefore, I will undertake just the one comparison. The comparison of the proprietor’s stylised mark and the applicant’s mark was undertaken by Mr King in his decision O-682-18 at paragraphs 72 – 74. I am not bound by his findings, but I have read them and find no reason to depart from his findings that I record below.

34) In respect of visual similarity:

“72) ... Both marks begin with a symbol followed by the word pizza. Whilst the applicant’s mark is stylised it does not detract from the visual similarity deriving from the only word in each mark being pizza. Taking these factors into consideration, I consider the marks to be visually similar to an above medium degree.”

35) I note that in respect of the proprietor’s **&pizza** mark, the font used reflects the same shapes as present in the font used in the applicant’s mark, however, the double line characteristic used in the applicant’s mark visually detracts from this and taking this into account, I accept Mr King’s analysis and I reject Ms Nezami submission that the marks are visually highly similar.

36) In respect of aural similarity:

“73) From an aural perspective, the applicant’s mark is likely to be pronounced as ‘atpizza’ and the opponent’s mark as ‘and-pizza’. Therefore, they differ in the first syllable but share the final two syllables forming the word ‘pizza’. ... As a general rule greater aural emphasis is placed at the beginning of the marks, though there is some similarity by virtue of the word ‘pizza’ being aurally identical. Taking these factors into account, I consider the respective marks to be aurally similar to a medium degree.”

37) I take note of Ms Nezami submission that the marks both start with the same letter, have the same number of syllables and, as a whole, sound highly similar but I disagree with her conclusions for the reason explained by Mr King. I concur with Mr King that they share a medium degree of aural similarity.

38) In respect of conceptual similarity:

“74) In order for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. It is clear that the word ‘pizza’ is capable of immediate grasp. I do not consider the stylisation of the applicant’s mark to have any conceptual impact. Whilst both marks are preceded with

symbols, they are different symbols that have different meanings. For example, the opponent's mark (&pizza) may be perceived as suggestive of being suitable to consume with pizza. Notwithstanding this, the different potential meanings of the symbols do not alter the concept of each mark or sufficiently alter the concept of each mark so that the word pizza would not be remembered. They are therefore conceptually similar to a medium degree."

39) Ms Nezami submitted that in respect of both marks the concept is of pizza and that this is not altered by the "@" symbol in the applicant's mark. In respect of the proprietor's mark, it was submitted that the presence of the "&" symbol may suggest something related to pizza. These submissions appear to align substantially with Mr King's comments. I conclude that they share a medium degree of conceptual similarity.

Andpizza/andpizza

40) Ms Nezami conceded that this mark is less similar to the applicant's mark than the other two marks in issue. I agree. The proprietor's mark consists of the two words "And"/"and" and "pizza" conjoined and with the first letter capitalised. The word "And"/"and" shares no visual similarity to the "@" symbol and I conclude that the respective marks share less than a medium level of visual similarity.

41) In respect of aural and conceptual similarity, the finding detailed above are essentially undisturbed and I find that they also share a medium degree of aural and conceptual similarity.

Average consumer and the purchasing act

42) 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*.

43) 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.”

44) Ms Nezami submitted that the level of care and attention paid by the average consumer during the purchasing process is below average because they are commonly purchased goods and services, they are normally inexpensive and are the subject of repeat purchases.

45) All the respective goods are ordinary food and drink, or grocery items and the services all relate to the provision of food and drink. The average consumer for all these goods and services is likely to be predominantly the general public. I agree with Ms Nezami that such goods and services are commonly purchased where the level of care and attention is not particularly high and that their cost is not normally particularly high. The purchasing act is predominantly visual in nature with the products being selected from the shelf in a shop, the online equivalent, or upon viewing the front of the premises in the case of the services. However, I do not rule out that aural considerations may play a part in circumstances such as when the goods are selected in a restaurant or café setting. However, even in those circumstances, the consumer normally has an opportunity to see the product on display or appearing in a menu. Taking all of this together, I conclude that the level of care and attention paid during the purchasing act is likely to be average rather than below average as Ms Nezami submitted.

Distinctive character of the earlier trade marks

46) 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).”

47) In respect of the earlier marks' inherent distinctive character, I have already noted that the word “pizza” has no distinctive character in respect of pizza related goods and services. I acknowledge that where the mark is used on other goods and services the word “pizza” may have no, or less, obvious meaning and in such circumstances it's contribution to the distinctive character of the mark, as a whole, will be greater. The “@” symbol does not have a particularly strong distinctive character, but when combined with the word “pizza” and with both words presented in a double line-type font, I conclude that it is endowed with a moderate degree of inherent distinctive character.

48) Ms Nezami's submitted that the mark benefits from an enhanced distinctive character because of the use made of it. This claim was roundly criticised by Mr Norris who pointed out that the applicant's activities prior to the relevant date were restricted to 9 weeks of social media posts. At the relevant date, the applicant had no customers in the UK and its restaurant in Edinburgh had yet to open. Consequently, the use of its mark could not have been to the extent that it would have resulted in enhancing its distinctive character. I agree with Mr Norris and dismiss the claim the distinctive character has been enhanced through its use.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

49) The following principles are obtained from the decisions of the CJEU 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 ("Medion"), *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P ("Bimbo"):

(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.

50) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of

confusion (*Sabel BV v. Puma AG*, paragraph 22). These factors must be assessed from the viewpoint of the average consumer who rarely has the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related).

51) Ms Nezami accepted that I was not bound by the previous registry decision involving the parties, however, she submitted that it was still relevant and that it was reasonable to expect that this current decision is consistent with it. In particular, Ms Nezami submitted that the comparison of marks analysis should be the same and noted that the hearing officer in the earlier decision found that the respective marks shared an “above medium degree of similarity”.

52) I have found that:

- The proprietor’s “&pizza” and **&pizza** marks share an above medium degree of visual similarity and that aurally and conceptually, they share a medium degree of similarity;
- In respect of the proprietor’s “Andpizza”/“andpizza”, they share less than a medium degree of visual similarity and a medium degree of aural and conceptual similarity;
- In respect of the applicant’s mark and the proprietor’s “Andpizza”/“andpizza” and **&pizza** marks the two elements present in these marks share a roughly equal role in the overall impression created by the mark;
- In respect to the proprietor’s “&Pizza” mark, the get-up tilts the word “pizza” towards being the dominant element of the mark. The “&” symbol is generally non-distinctive, and the distinctive character resides in the combination of elements;
- Many of the respective Class 30 goods are identical. Those that are not share at least a medium level of similarity;

- The majority of the respective Class 43 services are identical. The exception (bar services) shares a high degree of similarity;
- The average consumer is predominantly the general public.
- The level of care and attention during the purchasing act is average;
- The purchasing act is predominantly visual in nature, but I do not rule out that aural considerations may play a part;
- The opponent's mark has a moderate degree of inherent distinctive character and that this has not been enhanced through use.

53) Ms Norris relied upon the guidance of Arnold J (as he then was) in *Whyte and Mackay*¹ where it was stated that:

“...if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”

54) Mr Norris contended that this guidance applies here. Ms Nezami submitted that the current case it's not on all fours with *Whyte and Mackay*. In discussing the *Bimbo* judgment of the CJEU, Arnold J referred to the *Medion v Thomson* principle that, in order to establish a likelihood of confusion, it suffices that, on account of the earlier mark still having an independent distinctive role within the later mark, the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark. Having done so, Arnold J went on to say:

“20. ... this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).”

¹ *Whyte and Mackay Limited v Origin Wine UK Limited/Dolce Co Invest Inc*, [2015] EWHC 1271 (Ch)

55) Keeping this guidance in mind, when considering the proprietor's "&PIZZA" mark and its **&pizza** mark, the only common element in the respective marks is the word "PIZZA"/"pizza". I keep in mind that the respective marks include symbols at the start of the mark that is used to denote, albeit different, short, common English words. I have found that the word "pizza" has no distinctive character in respect to pizza related goods and services offered from a pizza restaurant or otherwise related to the provision of pizza. In respect of such goods and services, that I have found to be identical or similar to at least a medium degree, the word "pizza" is not possessed with any "distinctive significance independently of the whole" and applying Arnold J's guidance, I find that the ground of invalidation fails in respect of the following goods and services:

Class 30: ... *Pizza; Pizza dough; Pizza sauce; Ready-made sauces* [that can include pizza sauce]; ...; ...; *Tomato sauce* [that may be pizza sauce]; *preparations made from cereals* [pizza bases are normally made of flour being a cereal based preparation].

Class 43: *Restaurant and bar services* [as acknowledged earlier, bar services may be provided by a pizzeria/pizza restaurant]; *restaurant, bar and catering services; restaurant and bar services, namely, providing food and beverages for consumption on and off the premises; take-out restaurant services; pizzeria services; café services* [Cafes may specialise in the provision of pizzas]; *pop up restaurant services; mobile restaurant services; take-away services; the provision of food and drinks*

56) The similarity in the letter shapes of the respective fonts when considering the proprietor's **&pizza** mark is insufficient to disturb this finding.

57) In respect of the remaining goods, namely *Bakery desserts; ...; Candies; Candy; Cheese sauce; ...; Cooking sauces; Garlic-based sauces; ...; Pasta sauce; Pesto sauce; ... Spaghetti sauce; ... bread, pastry and confectionary* in Class 30, I have found that they share at least a medium level of similarity to the applicant's goods. In respect of these goods, the word "pizza" has distinctive character and consequently,

when keeping imperfect recollection in mind, in respect of goods that are not obviously pizza related, I find that there is a likelihood of confusion.

58) In respect of the proprietor's "Andpizza"/"andpizza" series marks, I have found that it shares a less than a medium degree of visual similarity because the "&" symbol has been replaced by the word "and". This changes the visual impact of the mark and is sufficient, even in circumstances where the respective marks are used for identical non-pizza related goods or services, for there to be no likelihood of confusion.

59) Ms Nezami contended that there is both direct and indirect confusion the latter being relied upon in the alternative. She submitted that indirect confusion result because the average consumer will perceive "Andpizza"/"andpizza" as no more than a brand extension of the "@pizza" mark. Ms Nezami referred to a claimed example where such indirect confusion has occurred, namely, at page 49 of Mr Lyle's exhibit. This consists of a print dated 23 April 2019 of an undated social media post where the writer asks the question "Hey @andpizza did you know there is an @atpizzauk! Are y'all the same company or what?". Mr Norris pointed out that the language used by the writer suggested that they are American and that it is not possible to ascertain that it a UK consumer that is confused. This is a valid criticism. Further, the writer refers to "atpizzauk" and it is not clear whether he/she was actually exposed to the applicant's "@pizza" stylised mark being relied upon in these proceedings. Consequently, I find that this evidence does not support Ms Nezami's claim to indirect confusion.

60) I find that there is no indirect confusion because it is unlikely that the consumer would expect the word "pizza" preceded by the word "And"/"and" would have any connection with "@pizza". The differences are such that one mark would not bring the other to mind. I dismiss Ms Nezami's submission.

61) In summary, the applicant's grounds of invalidation based upon section 5(2)(b) partially succeeds in respect of the proprietor's "&PIZZA" and **&pizza** marks, as set

out in paragraphs 53 and 55. It fails in its entirety in respect of the proprietor's "Andpizza"/"andpizza" series marks.

Section 5(4)(a)

62) 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) [.....]

63) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

64) In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar summarised the position regarding the relevant date for the purposes of section 5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has

used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

65) In the current case, the contested registrations were all filed on the 22 November 2017. No claim has been made by the proprietor to an earlier date and, consequently, I only need to consider the position as of the filing date of the three contested registrations.

66) The applicant must, therefore, demonstrate that it has the requisite goodwill at the relevant date. Its @Pizza restaurant did not officially open until a few days after the relevant date, however, it claims that it has goodwill because, at the relevant date:

- It had 5,000 followers on Instagram²;
- Its first Facebook post was on 20 September 2017 and had between 500 and 1000 followers at the relevant date³;
- One of its videos on Facebook had had over 30,000 views⁴, and;
- It had featured in four food and drink magazines⁵;
- There is a claim that the posts heavily feature the applicant’s marks but most of the occurrences are of its stylised “@” symbol or “atpizza”.

67) This evidence was roundly criticised by Mr Norris because:

- It does not reflect an existing business (with goodwill) launching a new business;
- There is not a single order nor customer before the relevant date, the doors of the applicant’s restaurant were not opened before the relevant date.

² Mr Lyle’s witness statement, para 15(a) and Exhibit RL1

³ Ditto, para 15(b) and page 5 of Exhibit RL1

⁴ Ditto, para

⁵ Mr Lyle’s witness statement, para 15 and 35

68) Mr Norris submitted that there are only two cases⁶ where such pre-launch publicity appears to have been considered sufficient and in both cases the plaintiffs had long established businesses and goodwill.

69) I also keep in mind the recent comments of Thomas Mitcheson QC in *RECUP trade mark*, BL O-304-20. He referred to the following comments of Lord Neuberger in the Starbucks case⁷:

“As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough, as the cases cited at [21]–[26] and [32]–[36] above establish. **The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction**, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere.”

70) Mr Mitcheson reviewed this requirement in the context of other leading cases and concluded that “a successful claimant ... needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon”⁸. The applicant’s restaurant was not open at the relevant date and, therefore, cannot point to any customers or sales at the relevant date. Rather, it relies upon pre-launch social media. Taking account that the applicant has now pre-existing goodwill, this social media activity is insufficient to demonstrate the “significant goodwill” required.

71) The applicant has failed to demonstrate that it has the requisite goodwill and, therefore, its case based upon section 5(4)(a) of the Act fails in respect of all three applications for invalidation. Consequently, it is not necessary that I consider the issues of misrepresentation and damage.

⁶ *Allen v Brown Watson* [1965] RPC 191 and *BBC v Talbot* [1981] FSR 228

⁷ *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc*, [2015] FSR 29 at [52]

⁸ See para 34 of *RECUP*

Section 3 grounds

72) I keep in mind that sections 3(1)(b) and (c) are independent and have differing general interests. In *SAT.1 Satelliten Fernsehen GmbH v OHIM*, Case C-329/02 P, the CJEU stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

Section 3(1)(c)

73) Section 3(1)(c) states:

“3(1) The following shall not be registered –

(a) [...]

(b) [...],

(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) [...]

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.”

74) The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“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 (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

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 (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P)

[2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

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 services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

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 (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

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 (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). 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 (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that

that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

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 (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

75) I also keep in mind that:

- combining words does not necessarily provide them with a distinctive character under section 3(1)(c)⁹;
- Descriptive word and minor embellishments can be caught by section 3(1)(c)¹⁰.

76) Ms Nezami submitted that the average consumer would immediately understand all three of the proprietor's marks as being descriptive of the characteristics of pizza

⁹ *Campina Melkunie BV and Benelux-Merkenbureau*, Case C-265/00, [39] – [41]

¹⁰ See for example *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2013] F.S.R. 29, [116], [117] and *Thomas Pink Ltd v Victoria's Secret UK Ltd*, [2014] EWHC 2631 (Ch)

and pizza related goods and services namely Pizza; pizza dough; pizza sauce in Class 30 and all of the Class 43 services. Ms Nezami elaborated this argument by explaining that the marks are descriptive of “something AND PIZZA”. As I have already found (when considering conceptual similarity under the section 5(2)(b) grounds), the mark may be suggestive. However, section 3(1)(c) does not place a bar on suggestive marks and I dismiss Ms Nezami’s submission.

77) Mr Norris submitted that the marks, as a whole, do not describe a characteristic of the goods and services with the “&” and “and” elements not describing a characteristic of the goods and services. He further submitted that the shunting together of the two elements creates a nonsense message. In addition, he points to the “unusual font” of the proprietor’s **&pizza** mark. Whilst I am unconvinced by the final submission; the font does not appear particularly unusual to me, I am with Mr Norris in respect of his other submissions. The addition of the word “And”/“and” or the “&” symbol appearing before the word “pizza” in all three marks creates a sign that strikes the consumer as being somewhat unusual, if suggestive, and lacking any direct link to designating a characteristic of the goods and services.

78) Taking all of the above into account, I find that the grounds based upon section 3(1)(c) fail against all three registrations.

Section 3(1)(b)

79) This part of the Act reads:

3(1) The following shall not be registered –

(a) [...]

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

[...]

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.

80) The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... 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 the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. 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 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 (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that 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 (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se,

three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

81) Ms Nezami submitted that the proprietor's "&PIZZA" mark is devoid of distinctive character because it is presented in a "simple and standard font" and that this is no more than a "figurative fig leaf of distinctiveness" and that this extends to non-pizza related goods because the average consumer would not perceive the marks as identifying the goods as originating from any particular undertaking but would, instead, make the connection between the product being sold and pizza.

82) Mr Norris relied upon "the well-established proposition" that a minimum degree of distinctive character is sufficient¹¹, arguing that the word "And"/"and" and the symbol "&" are easily sufficient to render the marks not devoid of distinctive character. He pointed to the fact that the marks comprise a symbol or word shunted together with the word "pizza" and that this creates a nonsense message.

83) I accept that the proprietor's marks may be suggestive of being suitable to consume with pizza (as per Mr King's decision at [74]) but, when used alone, they are all capable of distinguishing the goods and services of one trader from another. Section 3(1)(b) does not apply to marks that are merely suggestive. I am persuaded by Mr Norris' submissions and I agree that the combination of the word "And"/"and"

¹¹ Mr Norris referred to the General Court's judgment in *Eurocool*, Case T-34/00

or the symbol “&” and the word “pizza” is sufficient to render the marks distinctive whether for pizza related goods and services or whether for non-pizza related goods.

84) In conclusion, the grounds based upon section 3(1)(b) fail in their entirety.

Summary

85) The applications for a declaration of invalidity of 3272401 **&pizza** and 3272397 “&PIZZA” has been partially successful in respect of the grounds based upon section 5(2)(b). These two invalidations succeed in respect of the following list of goods and services:

Class 30: *Bakery desserts; ...; Candies; Candy; Cheese sauce; ...; Cooking sauces; Garlic-based sauces; ...; Pasta sauce; Pesto sauce; ... Spaghetti sauce; ... bread, pastry and confectionary*

86) These two applications for declarations of invalidity fail in respect of:

Class 30: *... Pizza; Pizza dough; Pizza sauce; Ready-made sauces; ...; Tomato sauce; preparations made from cereals.*

Class 43: *Restaurant and bar services; restaurant, bar and catering services; restaurant and bar services, namely, providing food and beverages for consumption on and off the premises; take-out restaurant services; pizzeria services; café services; pop up restaurant services; mobile restaurant services; take-away services; the provision of food and drinks*

87) The application for the declaration of invalidity of 3272402 “Andpizza”/“andpizza” fails in its entirety.

Costs

88) The proprietor has been successful in defending one of its registrations completely. In respect of the other two applications, the outcome was approximately even. In respect of these latter two applications, the parties should bear their own costs. In respect to the first application, the proprietor is entitled to a contribution towards its costs. As the application consisted of one third of the consolidated cases, I reduce the award to one third.

89) At the hearing Mr Norris submitted that I should take into account the broad range of goods and services relied upon by the applicant and the range of marks relied upon but were ultimately not pursued or dropped late in the day. He urged me to consider off scale costs in respect of these issues. In addition, the unformalised strikeout request that was included in the applicant's submissions of April 2019 required the proprietor to obtain legal advice which cost time and money. This strike out request was not pursued and again, Mr Norris submitted that costs off the scale were appropriate in respect to this. I do not agree.

90) Firstly, in respect of the strike out request, this was never formally raised by the applicant and no preliminary view was sought or issued by the Registry. In the circumstances any legal advice sought by the proprietor was premature and unnecessary.

91) In respect of the original scope of the proceedings and the dropping of issues late in the day, no evidence or submissions were filed by the proprietor that addresses the original breadth of the applications and, therefore, it is not clear what financial burden (if any) that was placed upon the proprietor by reducing the scope of the applications. The restriction of the scope of goods and services under attack were clarified by Ms Nezami at the hearing, but this posed no difficulty to Mr Norris. Accordingly, I decline to award off-scale costs in respect of this.

92) I award costs to the proprietor as follows:

Considering statements and preparing counterstatements:	£150
Considering evidence and preparing own evidence:	£250
Preparing and attending hearing:	£250
TOTAL	£650

93) I, therefore, order At Pizza Limited to pay ImaPizza LLC the sum of £650. The above sum should be paid within 2 months of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 28th day of July 2020

Mark Bryant
For the Registrar
The Comptroller-General