

**O-397-20**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO 3391329  
BY CHICKS N CHIPS LIMITED  
TO REGISTER**



**AS A TRADE MARK  
IN CLASS 43  
AND OPPOSITION THERETO (UNDER NO. 416547)  
BY  
ENTOURAGE B.V.**

## Background and pleadings

1. CHICKS N CHIPS LIMITED (“the applicant”) applied to register the trade mark set out on the title page on 11 April 2019. The trade mark was published on 19 April 2019 in class 43 for the following services:

*Services for providing food and drink; restaurant services; takeaway services; all the aforesaid services relating to Halal produce.*

2. On 10 June 2019, Entourage B.V. (“the opponent”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) on the basis of its earlier EU trade mark no.17243841. The details of the earlier mark are set out below. The opponent claims that the respective marks contain “virtually identical terms” and are for identical or highly similar services.

EU TM No. 17243841	Class 43 services relied on:
<b>CHICKS &amp; CHIP SHOP</b>  Filing date: 26 September 2017 Registration date: 13 February 2018	Services for providing food and drink; Temporary accommodation; Temporary accommodation; Bars; Restaurants; Hospitality services and services provided in, or with regard to, restaurants, catering and other sites and facilities which procure beverages and food prepared for consumption; Hospitality services at discotheques or nightclubs.

3. The opponent’s trade mark is an earlier mark, in accordance with section 6 of the Act, and as it has not been registered for five years or more before the filing date of the applicant’s mark, it is not subject to the proof of use requirements, as per section 6A of the Act.

4. The applicant filed a counterstatement in which it denied the ground of opposition.

5. The applicant is unrepresented in these proceedings whereas the opponent is represented by Novagraaf UK.

6. Only the opponent filed evidence and written submissions which will not be summarised but will be referred to as and where appropriate during this decision. Neither party requested a hearing and so I make this decision from the material before me.

### **Preliminary issue**

7. In its counterstatement the applicant made reference to its own operation in the UK and the opponent operating in Amsterdam as a means of distinguishing the respective trade marks. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“80. ....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

8. The issue raised by the applicant that the marks are used in different territories of the EU is not a valid reason in and of itself to find against the opponent. I would point out that holding an EU registered trade mark entitles the proprietor to rights in all EU member states including the UK. The decision I make here examines all the relevant factors set out in case law to determine whether there is likelihood of confusion.

## **Section 5(2)(b)**

9. 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”.

10. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## Comparison of the services

11. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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”.

12. The following case law is also applicable in relation to the contested services in these proceedings when in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 für 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”.

13. The services to be compared are set out below:

Opponent's class 43 services	Applicant's class 43 services
<i>Services for providing food and drink; Temporary accommodation; Temporary accommodation; Bars; Restaurants; Hospitality services and services provided in, or with regard to, restaurants, catering and other sites and facilities which procure beverages and food prepared for consumption;</i>	<i>Services for providing food and drink; restaurant services; takeaway services; all the aforesaid services relating to Halal produce.</i>

<i>Hospitality services at discotheques or nightclubs</i>	
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14. Both specifications contain the identical terms *Services for providing food and drink; Restaurants*. The applicant submits in its counterstatement that its services are distinguished because they are limited to being Halal produce. I do not find that the limitation distinguishes the services as the breadth of the terms *Services for providing food and drink* and *Restaurants* in the opponent's specification are such that they will cover all services in relation to food and drink products including Halal produce.

15. I find that the applicant's remaining term *takeaway services* will be covered by the breadth of the term *Services for providing food and drink* in the opponent's specification and is considered identical on the *Meric* principle.

#### **Average consumer and the purchasing process**

16. I next consider who the average consumers are for the services and how those services are purchased. 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*.

17. 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.”

18. The average consumers for the contested services are the general public. Buying a fast food style takeaway meal is relatively inexpensive and is not an especially considered purchase. Whereas choosing a restaurant to eat in may be more considered as it is likely to be more of an occasion and generally more expensive. Either way in my view the average consumer will pay at least a medium degree of attention during the purchasing process.

19. With regard to the purchasing process, selection of food and drink services is primarily a visual act. Consumers are likely to see the frontage of a restaurant or takeaway premises, or they will possibly read advertising material, menus etc or search online to find a suitable outlet. However, I also consider there could be an aural element if takeaway meals are ordered over the telephone or if advice is sought beforehand regarding allergens, vegetarian or Halal options for example.

### **Comparison of the marks**

20. 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 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.”

21. 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.

22. The marks to be compared are:

Opponent's mark	Applicant's mark
<p><b>CHICKS &amp; CHIP SHOP</b></p>	

23. The opponent's mark is a word mark including an ampersand character. Its overall impression resides solely in these words although I find that the word **Shop** carries less weight within the mark as a whole as it is descriptive of a retail outlet.

24. The opponent's mark is a composite arrangement consisting of a long rectangular red background in which the device of a stylised chicken's head is positioned before the words **Chicks 'n' Chips** with the word **HALAL** following in a smaller font. This whole element is positioned above a smaller red rectangle which contains the same stylised chicken's head device placed above the words **Chicks 'n' Chips**. The mark is not limited to colour and I do not consider the red background to be particularly significant. It is simply a means to contrast the lettering in white. The chicken's head has a visual impact although the device does reinforce the meaning of the word **Chicks** in the phrase **Chicks 'n' Chips** which follow it. The word **Halal** will be seen as descriptive given the food services covered in the specification and therefore carries little weight in the overall impression of the mark. It is the remaining two elements, that is the chicken's head device and the words **Chicks 'n' Chips** which have equal weight in forming the overall impression of the mark.

25. In a visual comparison, the respective marks share the word **Chicks** and the word **Chip**. The applicant's mark has an additional letter **s** to make **Chips** into a plural and the same words are repeated in the lower rectangle. As an additional point of visual difference, the linking element between the shared words is an

ampersand in the opponent's mark and a letter **n** with inverted commas placed either side of that letter in the applicant's mark, although both are recognised substitutes for the word **and**. The opponent's mark also lacks the device found in the other mark. There are additional words in the respective marks, namely **Shop** in the earlier mark and **Halal** in the applicant's mark but as stated above, I do not consider that either of those elements has distinctive character. I do not think that the average consumer will pay much attention to them. Taking these factors in account, I find there is a medium degree of visual similarity.

26. In an aural comparison, the applicant's device element will not play a part, so I need only to consider the respective word elements. As stated above the marks contain the words **Chicks** and **Chip** which are pronounced identically in both cases. The applicant's **Chip** word element is plural so has an additional letter **s** giving an additional 's' sound to the pronunciation. Taking the applicant's mark as a whole, I think it is unlikely that an average consumer will repeat the same words twice even though they appear twice. The ampersand symbol in the opponent's mark will be verbalised as the word **and**. The letter **n** with inverted commas in the applicant's mark is commonly used in place of the word **and**, so it will likely be verbalised in the same way, although I take into account that some consumers may just pronounce it as the letter **n**. The points of aural difference are the word **shop** in the opponent's mark and **Halal** in the applicant's mark. Given the descriptive nature of these words and the likelihood that the average consumer will pay less attention to these elements, I find that overall the marks have a high degree of aural similarity.

27. In my view in undertaking a conceptual comparison, the average consumer will regard the shared word **Chicks** as meaning chickens especially as the following word is **Chip/Chips**, the whole being a well-known fast food combination. The applicant's device of a chicken's head reinforces the chicken concept in both sections of the mark. The opponent submitted by way of evidence three images of different fast food chicken outlets obtained online. The images contain various depictions of shop fronts which showed a stylised chicken's head device with the name of the outlet. The opponent contends that consumers regard such images as commonplace and simply indicative that the fast food outlet sells chicken meals. I agree with this contention. With regard to the remaining elements of the marks, the

average consumer will regard the word **shop** as merely the premises from which the chicken and chips meal is purchased, and the word **Halal** as indicating that the chicken has been properly prepared according to Islamic ritual. It is unlikely that a consumer will attach any further significance to those two elements. Overall I find that the conceptual similarity of the marks is identical.

### **Distinctiveness of the earlier mark**

28. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

29. I have no evidence of use before me so I can only consider the inherent distinctiveness of the earlier mark. The mark consists of the words **Chicks & Chip**

**Shop** and is registered for food related services. There is a strong allusion between the mark and the services. Although the word **Chicks** is a less common shortening of the word Chickens, nevertheless I find the mark to have only an average degree of inherent distinctiveness for the provision of food from a shop premises.

### **Likelihood of confusion**

30. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer and the nature of the purchasing process for the contested services. In doing so, I must be aware that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

31. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related.

32. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., sitting 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.”

33. So far in this decision I have found that the respective services are identical. I have also found that consumers will be paying at least a medium degree of attention during a mainly visual purchasing process although I did not rule out an aural component for telephone ordering or enquiries. The earlier mark was found to have average inherent distinctiveness. Finally I found the respective marks to be visually similar to a medium degree, aurally similar to a high degree and conceptually identical.

34. The competing marks both contain the identical word elements **Chicks** and **Chip** (repeated twice in the applicant’s mark) as well as a similar linking element meaning **and**, namely the ampersand and ‘n’. The pluralisation of the word **chips** in the applicant’s mark makes no significant visual, aural or conceptual difference in comparison with the earlier mark. The word differences between the marks, namely the words **shop** and **Halal**, I found were descriptive elements. Although the chicken’s head device is visually impactful, I found that such devices are commonplace for the services and as such they do not outweigh the identity of the words. The average consumer rarely has the chance to make a direct comparison of the marks and must instead rely on the imperfect picture of them that they have kept in their mind. Taking into account that both marks contain the identical element **Chicks** and **Chip/Chips** as well as a very similar grammatical structure, i.e. both words linked by a recognised substitute for the word **and**, I find there is a likelihood of direct confusion.

35. In case I am wrong in my finding of likelihood of direct confusion, I will consider whether there is any indirect confusion. Taking the guidance given in *L.A. Sugar*, I find that if the average consumer takes account of the common elements, namely **Chicks** and **Chip/chips** then they would likely see the device and the word **Halal** as being a plausible brand extension and are likely to believe that both marks are

connected to the same economic undertaking. I find there is a likelihood of indirect confusion.

### **Conclusion**

36. The opposition brought under section 5(2)(b) of the Act has succeeded. Subject to any appeal against this decision, the application will be refused.

### **Costs**

37. As the opponent has been successful, it is entitled to a contribution towards its costs incurred in these proceedings. Awards of costs are set out in Tribunal Practice Notice 2/2016. Using that guidance, I make the following award:

£100 Official fee for filing the Notice of Opposition

£200 Preparing the Notice of Opposition and considering the other side's statement

£600 Preparing evidence and written submissions

**£900 Total**

38. I order CHICKS N CHIPS LIMITED to pay Entourage B.V. the sum of £900. This sum is to be paid within two months of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 11th day of August 2020**

**June Ralph**

**For the Registrar,**

**The Comptroller General**