

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**TRADE MARKS No. 3120192 AND No. 3123434**

**REGISTERED IN THE NAME OF SALIMA VELLANI**

**AND INVALIDITY APPLICATIONS No. 501157 AND No. 501158**

**IN THE NAME OF DIRTYBIRD RESTAURANTS LTD**

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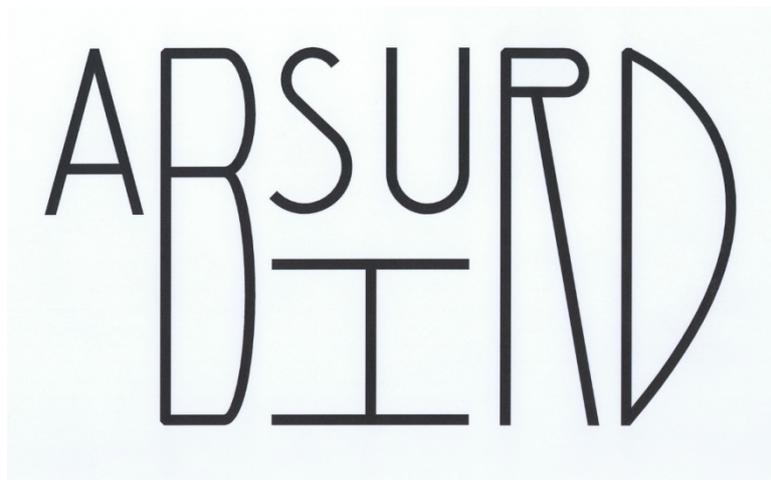
**DECISION**

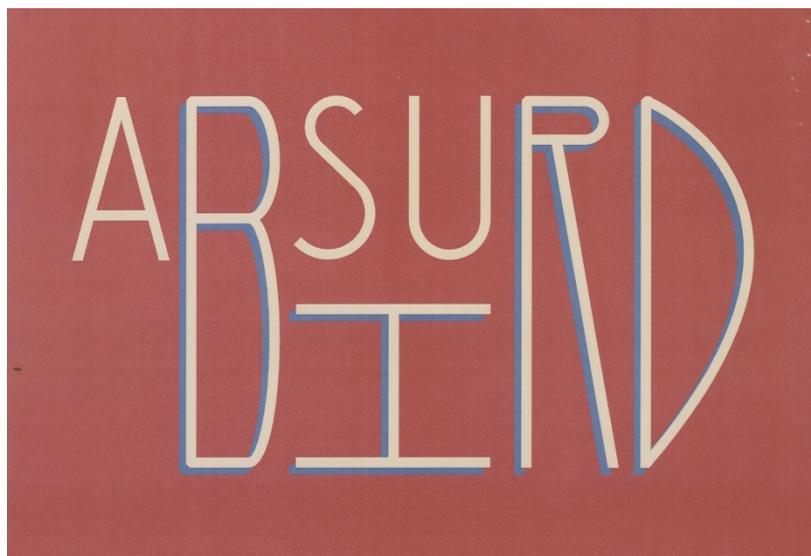
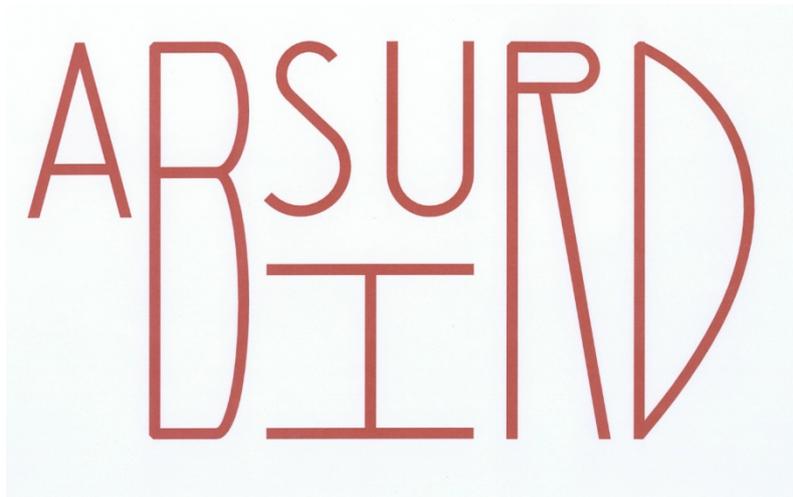
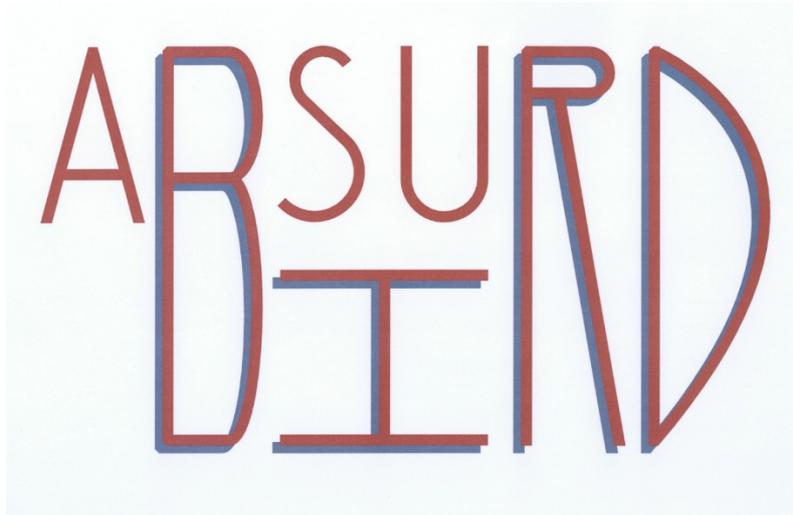
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1. The following trade marks were registered in the name of Salima Vellani ('the Proprietor') in 2015:

Trade Mark No. 3120192

(A series of four marks)





Filing date: 30 July 2015  
Registration date: 16 October 2015  
Class 25: Clothing  
Class 43: Services for providing food and drink;  
bar and catering services

Trade Mark No. 3123434

**Absurd Bird**

Filing date: 21 August 2015  
Registration date: 13 November 2015  
Class 9: Computer games, computer software,  
mobile phone application  
Class 25: Clothing  
Class 28: Games  
Class 43: Services for providing food and drink;  
restaurant, bar and catering services.

2. On 9 March 2016, Dirtybird Restaurants Ltd ('the Applicant) applied under s.47 of the Trade Marks Act 1994 for declarations to the effect that the Proprietor's trade marks were invalidly registered in Class 43 having regard to the earlier rights for which the Applicant claimed protection under ss.5(2)(b) and 5(4)(a) of the Act. Its claim for protection under s.5(2)(b) was based on proprietorship of the earlier trade mark **BIRD** registered under number 3035551 with effect from 19 December 2013 for use in relation to '*restaurant services*' in Class 43. Its claim for protection under

s.5(4)(a) was based on proprietorship of an earlier common law right to prevent misleading and deceptive use of that denomination by others in relation to restaurant services and the provision of food and drink in accordance with the law of passing off.

3. The claims for invalidity were upheld under s.5(2)(b) of the Act for the reasons given in a decision issued by Mr. George Salthouse on behalf of the Registrar of Trade Marks under reference BL O/264/17 on 2 May 2017. The Hearing Officer declined to consider the Applicant's claims for invalidity under s.5(4)(a) because he considered that there was no point in doing so in view of the conclusion he had reached on the claims under s.5(2)(b). He ordered the Proprietor to pay £1,500 to the Applicant as a contribution towards its costs of the Registry proceedings.
4. The Proprietor appealed to an Appointed Person under s.76 of the 1994 Act, contending that the Hearing Officer had erred in his assessment of similarity between the marks in issue and wrongly determined that they could not be used concurrently for services of the kind for which they were respectively registered in Class 43 without giving rise to the existence of a likelihood of confusion. There is no appeal by the Applicant in respect of the Hearing Officer's decision not to rule on the claims it had raised under s.5(4)(a). To the extent that they are not identical, the services in issue are closely related. In essence the question for this Tribunal on appeal is whether it was open to the Hearing Officer to conclude as he did, for the reasons he gave, that the Proprietor's registrations in Class 43 were invalid under s.5(2)(b) by reason of the presence therein of the earlier trade mark **BIRD**.

5. The Hearing Officer's assessment of the distinctiveness of the Applicant's earlier trade mark was as follows:

31. ... The word "BIRD" has, as far as I am aware, no particular meaning for restaurant or catering services as although most restaurants will serve birds as part of their menu, it is unusual to have nothing else other than birds on offer. Even fried chicken outlets offer items to eat other than chicken ... clearly restaurants do not describe chicken dishes as "bird" dishes and also offer other birds such as quail, pheasant, partridge, grouse, pigeon, ostrich, puffin, goose, duck, etc. **Overall [the Applicant's] mark is distinctive to a low to medium degree. Whilst [the Applicant] has shown use of its mark it would appear to be limited to a relatively small area of London and the turnover figures, whilst perfectly respectable are, in the context of the UK market for restaurant/catering services, miniscule. The [Applicant] cannot benefit from enhanced distinctiveness.**

I am satisfied that it was open to the Hearing Officer to conclude that the earlier trade mark **BIRD** possesses a low to medium degree of distinctiveness with a modicum of culinary allusion to 'poultry' in the context of services of the kind for which the mark was protected by registration. I do not accept the Proprietor's submission that the Hearing Officer was obliged to go further on the evidence before him and conclude that the earlier trade mark was distinctive only to 'a very low degree'.

6. The Hearing Officer properly directed himself by reference to para. [34] of the Judgment of the CJEU in Case C-591/12P Bimbo SA v. OHIM EU:C:2014:305 where the Court affirmed 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’.

7. It should be added that the guidance in that paragraph must be read and applied consistently with the guidance set out in paras. [22] to [25], [35] and [36] of the same Judgment:

22. The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole (*OHIM v. Shaker* EU:C:2007:333, paragraph 41).
23. The overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v. Shaker* EU:C:2007:333, paragraphs 41 and 42, and *Nestlé v. OHIM* EU:C:2007:539, paragraphs 42 and 43 and the case-law cited).
24. In this connection, the Court of Justice has stated that it is possible that an earlier mark used by a third party in a composite sign that includes the name of the company of the third party retains an independent distinctive role in the composite sign. Accordingly, in order to establish the likelihood of confusion, it suffices that, on account of the earlier mark still having an independent distinctive role, the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark (Case C-120/04 *Medion* EU:C:2005:594, paragraphs 30 and 36,

and order in Case C-353/09 P *Perfetti Van Melle v. OHIM* EU:C:2011;73, paragraph 36).

25. None the less, a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately (see, to that effect, order in Case C-23/09 P *ecoblue v. OHIM and Banco Bilbao Vizcaya Argentaria* EU:C:2010:35, paragraph 47; *Becker v. Harman International Industries* EU:C:2010:368, paragraphs 37 and 38; and order in *Perfetti Van Melle v. OHIM* EU:C:2011:73, paragraphs 36 and 37).

...

35. The determination of which components of a composite sign contribute to the overall impression made on the target public by that sign is to be undertaken before the global assessment of the likelihood of confusion of the signs at issue. Such an assessment must be based on the overall impression produced by the trade marks at issue, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, as has been stated in paragraph 21 above. Therefore, this does not involve an exception, that must be duly substantiated, to that general rule.
36. Moreover, the individual assessment of each sign, as required by the settled case-law of the Court of Justice, must be made in the light of the particular circumstances of the case and cannot therefore be regarded as being subject to general presumptions. As the Advocate General observed in point 24 of his Opinion, it is clear, in particular, from the case-law subsequent to *Medion* (EU:C:2005:594), that the Court of Justice did not introduce, in that judgment, a derogation from the principles governing the assessment of the likelihood of confusion.

8. On examining the Proprietor's trade marks from the required perspective, it is necessary to recognise that **ABSURD BIRD** is literally, conceptually and conspicuously an **ABSURD** contextualisation of the word **BIRD** and all the more so when graphically represented in the undeniably quirky manner recorded in the registration of trade mark number 3120192.
9. The Hearing Officer's appraisals were in that regard correctly orientated. In para. 28 of his decision, he said this with regard to perception of trade mark number 3123434 by the relevant average consumer: 'When seeing "Absurd bird" they will have an image of a ridiculous or ludicrous bird, but again nothing specific, although they may go to the more extreme avian species. The word "absurd" acts as an adjective to the word "Bird" so that whatever image the word "BIRD" conjures in the consumer's mind is qualified by the term "absurd".' In para. 29 of his decision he said this with regard to the black-and-white version of the signs registered in series under number 3120192: 'Although the mark is quite stylised it still will be viewed by the average consumer as the words "Absurd Bird" written in a highly unusual or even "ridiculous" way. This feeds into the narrative of a ludicrous bird, but again is unspecific'.
10. There is no finding in the Hearing Officer's decision to the effect that the single word **BIRD** is individually dominant or retains an independent distinctive role in the Proprietor's trade marks. That, together with his findings as noted in para. 9 above, points to the conclusion that the verbal elements of the Proprietor's trade marks are likely to be perceived and remembered cohesively as "**ABSURD-BIRD**"

marks rather than segmentally as ‘**ABSURD plus BIRD**’ or ‘**ABSURD / BIRD**’ marks (cf. para. [25] of Bimbo SA).

11. The Proprietor relies on the Hearing Officer’s observation that visually and aurally there is an ‘obvious difference’ between the marks in issue due to the presence of the word **ABSURD** as the first element of her trade marks (para. 28). It is submitted on her behalf that the words **ABSURD** and **BIRD** together have a meaning which differs from that of the word **BIRD** alone in a way which should be taken to establish that the difference between the marks is not only ‘obvious’ from a visual and aural point of view, but also from a conceptual point of view. That appears to me to be correct for the reasons identified in paras. 8 to 10 above.
  
12. The Hearing Officer considered that the marks in issue are similar to a medium degree (paras. 28, 29 and 32). He did not explain how the ‘obvious’ difference between them factored into his application of the principles stated in paras. [22] to [25] and [34] to [36] of the Judgment in Bimbo SA (set out in paras. 6 and 7 above) or those derived from the case law of the CJEU which he noted at sub-paras. (i) to (k) of para. 14 of his decision for the purpose of guiding him in his assessment of the Applicant’s claims for invalidity:
  - (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.

13. The Proprietor's case was (and remains) that the marks in issue are dissimilar or similar only in a way which is not sufficient to give rise to what may properly be regarded as the existence of a likelihood of confusion (paras. 8, 10 and 11 of its Skeleton Argument dated 27 April 2017).
  
14. The Applicant's case was (and remains) that the marks in issue are similar 'because the "Bird" element that is common to all the marks would clearly be perceived as a noun with the same normal English meaning in each case' and 'while the average consumer will recognize that the Proprietor's Marks are different from the Applicant's Mark, he/she will identify the common "Bird" element and, taking account of that element in the context of the Marks as a whole, conclude that "Absurd Bird" is another brand of the owner of the Applicant's mark .... for one or both of the following two reasons: (1) The "Bird" element is sufficiently distinctive (both inherently and as a result of the applicant's use) that the average consumer would assume that no one else but the brand owner would be using it in a trade mark for restaurant services; (2) The average consumer would readily perceive the additional "Absurd" element as an adjective applying to "Bird" resulting in a brand extension. When encountering an "Absurd Bird" restaurant, the average consumer would assume that it was an alternative, zany sister or spin-off to the original BIRD restaurant(s)' (paras. 14 and 19 of its Skeleton Argument dated 27 April 2017).

15. The Hearing Officer stated his conclusion briefly with regard to the existence of a likelihood of confusion in the following terms (para. 34):

In view of all of the above, and allowing for the concept of imperfect recollection, in respect of either of Ms Vellani's marks there is a likelihood of consumers being indirectly confused into believing that the Class 43 services registered under marks 3120192 & 3123434 and provided by Ms Vellani are those of DR or provided by some undertaking linked to it. **The invalidity under section 5(2)(b) in respect of the class 43 services is successful.**

16. His reference to indirect confusion relates back to para. 33 of his decision where he cited, in full, paras. [16] and [17] of the decision of Mr Iain Purvis QC sitting as the Appointed Person in L.A. Sugar Ltd v By Back Beat Inc (BL O/375/10; 26 October 2010). However, the decision under appeal does not explain why (assuming he did) the Hearing Officer expected the relevant average consumer to perceive the Proprietor's trade marks as being in each case 'another brand of the owner of the earlier trade mark', which was the point under discussion in the particular paragraphs he cited from the L.A. Sugar decision.
17. This was a significant omission from his reasoning on a key part of the decision. At the hearing of the appeal, I was asked by the Applicant to infer that the Hearing Officer had accepted the thrust of the argument it advanced at the hearing before him, as summarised in the passages from its Skeleton Argument I have quoted in para. 14 above (Transcript p.53, line 10 to p.54, line 4). That seems likely and I make that inference. However, it does not allay my concern that the Hearing Officer gave no real weight to the effect of his own prior reasoning with regard to the matters

I have referred to in paras. 5 and 8 to 11 above when he came to apply the law to the particular circumstances of the case before him.

18. There is no rule or presumption to the effect that the concurrent use of a trade mark and one of its components for identical or similar goods or services will always or necessarily give rise to the perception that the goods or services concerned come from the same or economically linked undertakings. That might or might not be the case. In order to determine whether it is, the decision taker must give as much or as little significance to the visual, aural and conceptual differences and similarities between the marks in issue as the relevant average consumer would have attached to them at the relevant point in time (which in this case was July/August 2015). It is axiomatic that the relevant average consumer is to be regarded as reasonably well-informed and reasonably observant and circumspect. However, (s)he is not to be regarded as a person who normally engages in extended thought processes for the purpose of pairing and matching trade marks or actively considering how they might be developed or appropriated for use as siblings of other marks. Indirect confusion of the kind described by Mr Iain Purvis QC in paras. [16] and [17] of his decision in L.A. Sugar is a matter of instinctive reaction to precipitating factors rather than the result of detailed analysis, as emphasised by Mr James Mellor QC sitting as the Appointed Person in Duebros Ltd v Heirler Cenovis GmbH (BL O/547/17; 27 October 2017) at para. 81.
19. Why, if the marks in issue in the present case are visually, aurally and conceptually different to a degree which the Hearing Officer was (rightly) prepared to describe

as ‘obvious’, would the relevant average consumer nonetheless be disposed to perceive them as brand variants? It is difficult to why that would be the case in circumstances where: the Hearing Officer has (rightly) decided that the earlier trade mark **BIRD** possesses a low to medium degree of distinctiveness with a modicum of culinary allusion to ‘poultry’ in the context of the services in issue; he has (rightly) made no finding as to dominance or any independent distinctive role attaching to the single word **BIRD** in the Proprietor’s trade marks; he has fleshed out his finding that the marks in issue are similar to a medium degree by (rightly) attributing that to their respective ‘avian’ connotations; and he has (rightly) found that *‘the services are such that the average consumer will pay a low to medium degree of attention to the selection of such services’* (paragraph 16).

20. The latter finding counts against the suggestion that the relevant average consumer would be likely to reflect upon the etymology of the marks in issue with the kind of attention to meaning pre-supposed by reasons (1) and (2) of the Applicant’s argument noted in paragraph 14 above. And on assessment in accordance with the Hearing Officer’s findings I have upheld, the visual, aural and conceptual difference between the marks in issue remains ‘obvious’, hence significant, notwithstanding the ‘avian’ connotations they respectively possess. I do not think it is realistic to characterise the ‘obvious’ difference between the marks **BIRD** and **ABSURD BIRD** as a variation without also characterising it as a variation which is by its nature apt to dispel rather than instil a belief in the existence of a link between them. I consider that it was contrary to the flow of his own findings for the Hearing Officer to regard ‘avian’ connotations as a sufficient basis for envisaging anything more

significant than a possibility of ‘mere association, in the strict sense that the later mark brings the earlier mark to mind’. Association of that kind is beyond the reach of s.5(2)(b): Case C-251/95 Sabel BV v Puma AG EU:C:1997:528 at para. [26]; Case C-425/98 Marca Mode CV v Adidas AG EU:C:2000:339 at para. [41]. The L.A. Sugar decision (in which there was held to be no likelihood of indirect confusion) does not suggest otherwise.

21. I am satisfied that the Hearing Officer ought to have appreciated that his own findings were sufficiently pronounced to displace the concept of indirect confusion as discussed in L.A. Sugar and were for that reason sufficiently pronounced to displace the basis on which he upheld the Applicant’s objections to the validity of the Proprietor’s trade mark registrations under s.5(2)(b).
22. For the reasons I have given, the Proprietor’s appeal is allowed. The Hearing Officer’s decision and order as to costs are set aside. I approach the question of costs in the manner indicated in paras. [12] to [14] of my decision in AMARO GAYO COFFEE Trade Mark (BL O/257/18; 25 April 2018). Having regard to what I consider to be the amount of effort and expenditure that is likely to have been incurred productively in defence of the registrations in issue, I think it would be reasonable to order the Applicant to pay £3,500. to the Proprietor in respect of her costs of the invalidity proceedings at first instance and on appeal. That sum is to be paid within 21 days of the date of this decision.

Geoffrey Hobbs QC

28 June 2018

Ms Ashton Chantrelle instructed by Underwood Solicitors LLP appeared on behalf of the Proprietor.

Mr Chris Aikens instructed by Dolleymores appeared on behalf of the Applicant.

The Registrar took no part in the appeal.