O-528-14

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO 3018419
IN THE NAMES OF JIAQI WANG & JINGYUAN NI
IN RESPECT OF TRADE MARK:

AND

AN APPLICATION FOR A DECLARATION OF THE INVALIDITY THEREOF
UNDER NO 500329 BY TWIST LONDON LIMITED.

BACKGROUND

1.Trade mark No. 3018419 shown above stands registered in the names of Jiaqi Wang and Jingyuan Ni (the proprietors). It was filed on 15 August 2013, completed its registration procedure on 31 January 2014 and is registered for 'Cafe services' in class 43.

2. On 12 March 2014, Twist London Limited (the applicant) filed an application to have this trade mark declared invalid under the provisions of section 47(2)(a) and section 5(2)(b) of the Trade Marks Act 1994 ("the Act") which state:

> "47(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…"

And:

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

3. The applicant relies upon UK trade mark 2574124 for the mark TWIST LONDON in respect of the following services in class 43:

> Services for providing food and drink; restaurant, bar and catering services; services for the organisation and management of the catering at functions; booking and reservation services for restaurants.

4. The mark was filed on 3 March 2011 and completed its registration procedure on 4 November 2011.

5. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "6.-(1) In this Act an "earlier trade mark" means -
>
> (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
>
> (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

6. The applicant's mark is an earlier mark, which is not subject to proof of use because, at the date of the application for invalidity its mark had not been registered for five years.[1] The applicant is entitled to rely on its full specification.

7. On 6 May 2014, the proprietor filed a counter statement in which denies the grounds of invalidation.

8. The applicant filed written submissions in lieu of hearing and neither party elected to be heard.

Section 5(2)(b) case law

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

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

[1] *See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.*

(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.

The average consumer and the nature of the purchasing act

10. 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.* 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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

11. The average consumer for the proprietors' cafe services will be a member of the general public. The applicant's specification includes a wide range of food and drink services which will include those directed at the general public, such as restaurants and bars and small scale catering; as well as those which may be offered to other commercial undertakings such as the provision and management of catering contracts for businesses.

12. With regard to the majority of the services (those offered to members of the general public), they are likely to be selected, for the most part, visually following exposure to street signage, advertising and the internet. However, I do not rule out word of mouth recommendations so aural considerations may also play a part. The level of attention paid is likely to be sufficient to select the correct type of establishment, in my view, no higher than average.

13. The selection of catering services is likely to require a higher level of attention to be paid, which is likely to vary depending on the nature of the service. A wedding reception or

long term business catering contract is likely to be more highly considered than a small lunch for a few people at a conference or meeting. In any event the purchase will require consideration of, inter alia, numbers of attendees and menu selection. It is likely to be a primarily visual one, though I do not rule out an aural element, where recommendations are made or the first contact is made by telephone.

Comparison of services

14. The services to be compared are as follows:

The applicant's services	**The registered proprietors' services**
Class 43 Services for providing food and drink; restaurant, bar and catering services; services for the organisation and management of the catering at functions; booking and reservation services for restaurants.	**Class 43** Cafe services

15. In comparing the services, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM,* Case T-133/05:

> *"29. …goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark."*

16. The proprietors' services are included within the broad term 'services for providing food and drink' in the applicant's specification. Consequently, in accordance with *Meric*, I find the parties' services to be identical.

Comparison of marks

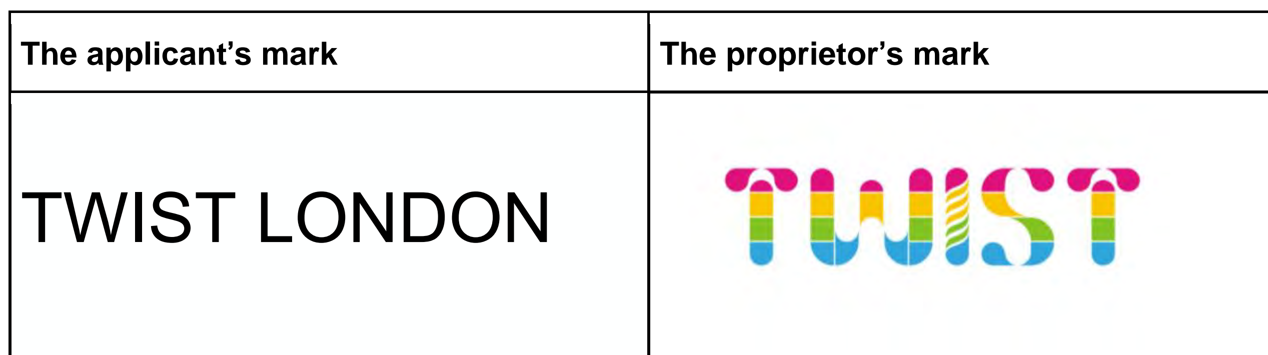
17. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference 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."

18. It would be wrong, therefore, artificially to 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.

19. The marks to be compared are as follows:

The applicant's mark	**The proprietor's mark**
TWIST LONDON	

20. The proprietors submit in their counter-statement that, *"Twist London do not use Twist London in their publicity or marketing but use solely Twist; this is not their registered TM".* The assessment I must make is between both marks as they appear on the trade marks register (shown in the paragraph above) and on a notional basis.

21. The applicant's mark consists of the two words 'TWIST' and 'LONDON' in block capitals with no form of stylisation. The applicant submits that the word 'TWIST' dominates its mark as the word 'LONDON' indicates a geographic connection.

22. The words 'TWIST' and 'LONDON' do not hang together. The overall impression of the mark is dominated by the word the word 'TWIST' which is the first word in the mark, coming before the word 'LONDON', which will be seen simply as indicating the geographic location.

23. The proprietors' mark is the word 'TWIST' in a stylised typeface with a degree of decoration. The letters are presented with stripes of colour, from magenta/pink at the top, followed by a band of yellow and a band of green with the final stripe being blue. None of the stylisation prevents the mark from being read as the word 'TWIST', which is what dominates the overall impression.

Visual similarities

24. The proprietors submit that their mark has a 'unique logo' that has been custom designed whereas the applicant's 'TWIST LONDON' mark uses a 'standard MS office font' freely available to the public.

25. In considering the presentation of the marks at issue I am mindful of the comments in *Sadas*[2], where the Court of First Instance (now the General Court (GC)) assessed the similarity of 'Arthur' (in script) against the application 'ARTHUR ET FÉLICIE', in plain block capital letters. It held:

> "47. At the visual level, given that the figurative elements of the earlier mark are secondary relative to its word element, the comparison of the signs may be carried out on the basis of the word element alone, whilst still adhering to the

[2] *Sadas SA v OHIM, T-346/04*

> principle that an assessment of the likelihood of confusion, with regard to the similarity of the signs, must be based on the overall impression given by them. Accordingly, since the earlier mark Arthur is entirely included in the trade mark sought ARTHUR ET FÉLICIE, the difference linked to the addition of the words 'et' and 'Félicie' at the end of the trade mark sought is not sufficiently large to counter the similarity created by the coincidence of the dominant element of the trade mark applied for, namely the word 'Arthur'. Moreover, since registration of the trade mark ARTHUR ET FÉLICIE was sought as a word mark, nothing prevents its use in different scripts, such as, for example, a form comparable to that used by the earlier mark. As a result, the signs at issue must be considered visually similar."

26. The GC also applied *Sadas* in similar circumstances in *Peek & Cloppenburg v OHIM*[3], where the earlier mark was the plain word mark. It stated,

> "27...the Board of Appeal was wrong to take into account the particular font used by the mark applied for in its comparison of the signs at issue. … since the early mark is a word mark, its proprietor has the right to use it in different scripts, such as, for example, a form comparable to that used by the mark applied for."

27. Accordingly, in this case, normal and fair use of the applicant's mark would include use of the mark in a range of typefaces, including those with a degree of stylisation which may reduce the apparent visual difference between the marks when the applicant's mark is considered in block capitals.

28. With regard to the colours present in the competing trade marks, since neither is limited as to colour, the applicant would be entitled to present elements of its trade mark in the same colours as those present in the proprietors' trade mark. Consequently, the fact that the proprietors' mark is presented in particular colours is not a point that assists them.

29. Taking all of these factors into account, I find the degree of visual similarity to be medium.

Aural similarities

30. Both marks contain the single syllable word TWIST, which is the entirety of the proprietors' mark and the first word of the applicant's mark. The opponent's mark contains the additional word 'LONDON' which follows the word 'TWIST' and adds an additional two syllables to its mark, resulting in a mark somewhat longer than the mark applied for. Both words will be easily understood and pronounced by the average consumer. Taking these factors into account, the marks are aurally similar to a medium degree.

Conceptual similarities

31. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.[4] The assessment must be made from the point of view of the average consumer.

[3] *T-386/07*

32. 'TWIST' is a well known word in the English language and will be easily understood by the average consumer. Whatever meaning the average consumer gives it, it will be the same for both marks. The addition of the word 'LONDON' in the earlier mark simply provides a geographic location to an undertaking identified by the first word 'TWIST'. The marks are conceptually similar to a high degree.

Distinctive character of the earlier mark

33. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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 *WindsurfingChiemsee* 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)."

34. In respect of the distinctive character of the word TWIST, the proprietors submit:

> *"Twist is both a noun and a verb. As such it is common usage and as such has no distinctive character unless it has a specific and unique logo or font. Twist has this but Twist London does not."*

35. No evidence has been filed and I have only the inherent characteristics of the trade mark to consider. The applicant's mark is 'TWIST LONDON'. In respect of its services in class 43 the mark is neither descriptive nor allusive. The geographic element, 'LONDON' serves to indicate the region of origin or current location of the undertaking but does not give any message in respect of the services. I find it to have a medium level of inherent distinctive character.

---

[4] *This is highlighted in numerous judgments of the GC and the CJEU including Ruiz Picasso v OHIM [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.*

Likelihood of confusion

36. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.[5] I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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 vice versa.

37. I have found the marks to have a medium degree of visual and aural similarity and a high degree of conceptual similarity. I have found the earlier mark to have a medium level of inherent distinctive character and have found the proprietor's services to be identical to those of the applicant. I have identified the average consumer, namely a member of the general public (and in some cases a business/professional) and have concluded that the purchase will be primarily visual, though I do not discount an aural element where word of mouth recommendation plays a part in the selection process. The level of attention paid to the purchase of the majority of the services will be no higher than average but is likely to be higher for certain catering services.

38. Taking all of these factors into account, the similarity of the marks are such that in the context of services which are identical there will be, in my view, direct confusion (where one mark is mistaken or the other).

39. In any event, if I am found to be wrong in this, I am mindful of *L.A. Sugar Limited v By Back Beat Inc*[6], in which Mr Iain Purvis Q.C. sitting as the Appointed Person noted 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.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

[5] *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V., paragraph 27*
[6] *Case BL-O/375/10*

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

40. The examples given above represent a non-exhaustive list which serves to provide examples of the ways in which indirect confusion may operate. As I have discussed above, the additional word ‘LONDON’ in the applicant’s earlier mark is simply a geographic indicator. When encountering the respective sides’ marks the average consumer will consider them both to be ‘TWIST’ marks, one of which is based in London, accordingly, they will be seen as linked undertakings.

Conclusion

41. As a consequence of my decision above, the applicant’s request to invalidate the registered proprietor’s trade mark has succeeded under section 5(2)(b) of the Act and, under the provisions of 47(6) of the Act. The registration shall be deemed never to have been made in respect of the proprietor’s registration for cafe services in class 43.

Costs

42. Twist London Limited has been successful and is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. I have taken into account that no hearing has taken place and award costs on the following basis:

Preparing a statement and considering the other side’s statement:	£ 300
Written submissions:	£ 300
Official fee:	£ 200
Total:	**£ 800**

43. I order Jiaqi Wang & Jingyuan Ni to pay Twist London Limited the sum of £800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of December 2014

Ms Al Skilton
For the Registrar,
the Comptroller General