

O-750-18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 3304937

BY DENIZ ASH

TO REGISTER THE SERIES OF FOUR TRADE MARKS

**Okka coffee bar
Okka cafe eatery
Okka coffee and burger bar
Okka restaurant**

IN CLASS 43

AND

IN THE MATTER OF OPPOSITION

THERE TO UNDER No. 600000896 BY

OKA RESTAURANTS LIMITED

BACKGROUND

1) On 19 April 2018, Deniz Ash (hereinafter the applicant) applied to register the trade marks shown on the front cover in respect of the following services in class 43:

Café services; Cafe services; Cafés; Cafeteria services; Cafeterias; Catering of food and drink; Catering of food and drinks; Catering services; Catering services for company cafeterias; Bar and restaurant services; Bistro services; Booking of restaurant seats; Brasserie services; Reservation and booking services for restaurants and meals; Reservation of restaurants; Restaurant reservation services; Restaurant services; Restaurant services for the provision of fast food; Restaurant services incorporating licensed bar facilities; Restaurants; Restaurants (Self-service -).

2) The application was examined and accepted, and subsequently published for opposition purposes on 25 May 2018 in Trade Marks Journal No.2018/021.

3) On 27 June 2018 Oka Restaurants Ltd (hereinafter the opponent) filed a notice of opposition, subsequently amended. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
	3133429	27.10.15 22.01.16	43	Restaurants.

4) The grounds of opposition are in summary: the opponent contends that the marks applied for and its mark are similar and that all the services applied for are identical and/or similar. As such it contends that the application offends against Section 5(2)(b) of the Act.

5) On 4 September 2018 the applicant filed a counterstatement, which basically denied all the grounds pleaded. The applicant states that it only does Mediterranean dishes. Neither party filed

evidence; both parties seek an award of costs in their favour. Neither side wished to be heard nor provided written submissions.

DECISION

6) The only ground of opposition is under section 5(2)(b) which reads:

“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.”

7) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

8) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier filed trade mark. The interplay between the date of the instant marks being published (25 May 2018) and the opponent’s mark being registered (22 January 2016) means that the proof of use requirements do not bite.

9) When considering the issue under section 5(2)(b) I take into account the following principles which 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:

(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.

The average consumer and the nature of the purchasing process

10) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade.

11) The services of both parties are broadly speaking café / bar / restaurant services. The consumers for such services would be the general UK public including businesses. These types of services will typically be offered for sale at an outlet such as a café / bar / restaurant or hotel, in brochures and on the internet. The initial selection is therefore primarily visual, although personal recommendations, bring aural considerations into play.

12) Clearly, the average consumer's level of attention will vary considerably depending on the whether they are simply seeking a cup of coffee or planning to celebrate an occasion. However, to my mind even when just seeking a beverage to quench their thirst the average consumer will pay attention to considerations such as whether the establishment is clean, if its advertised prices seem reasonable and whether it offers the type of beverages/cuisine they are seeking. **Overall the average**

consumer for these types of services is likely to pay an average degree of attention to the selection of such services.

Comparison of services

13) In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU stated at paragraph 23 of its judgement:

“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”.

14) Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

15) In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

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

16) In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) OHIM*) case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T110/01 *Vedial V OHIM France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

17) The specifications of both sides are reproduced below for ease of reference:

Opponent's services in class 43	Applicant's services in class 43
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Restaurants	Café services; Cafe services; Cafés; Cafeteria services; Cafeterias; Catering of food and drink; Catering of food and drinks; Catering services; Catering services for company cafeterias; Bar and restaurant services; Bistro services; Booking of restaurant seats; Brasserie services; Reservation and booking services for restaurants and meals; Reservation of restaurants; Restaurant reservation services; Restaurant services; Restaurant services for the provision of fast food; Restaurant services incorporating licensed bar facilities; Restaurants; Restaurants (Self-service -).
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18) Clearly, the opponent’s specification of “restaurants” encompasses the following terms in the applicant’s specification “Restaurant services; Booking of restaurant seats; Reservation and booking services for restaurants and meals; Reservation of restaurants; Restaurant reservation services; Restaurant services; Restaurant services for the provision of fast food; Restaurant services incorporating licensed bar facilities; Restaurants; Restaurants (Self-service -)”. As such all these services must be regarded as identical.

19) To the best of my knowledge, the word Bistro means a small, informal restaurant or a bar where food is served; a brasserie is a small and usually cheap restaurant or bar; a Cafeteria is a restaurant in which customers serve themselves from a counter and pay before eating; a café is a place where you can buy drinks, simple meals, and snacks; whilst Catering is the business of providing a food service in a hotel, hospital, pub or event venue. As neither side has commented I must draw my own view. To my mind, the following services of the applicant are all identical to the opponent’s restaurant services “Café services; Cafe services; Cafés; Cafeteria services; Cafeterias; Bistro services; Brasserie services; Catering of food and drink; Catering of food and drinks; Catering services; Catering services for company cafeterias”.

20) Similarly, I believe that a reasonable definition of “bar services” is that they are usually found in a pub or club and refers to the provision of alcoholic beverages such as beer, wine and spirits. It is well known that most pubs and clubs also sell snacks and various food items with many have a restaurant within them. Similarly, most restaurants also offer alcoholic beverages. As such “bar services” must be considered identical or at least highly similar to the opponent’s specification.

Comparison of trade marks

21) 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 them, 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.”

22) The marks of the two parties are as follows:

Applicant's marks	Opponent's mark
<p>Okka coffee bar</p> <p>Okka cafe eatery</p> <p>Okka coffee and burger bar</p> <p>Okka restaurant</p>	

23) It is clear that all four of the applicant's marks have as their first element the word "okka". This is then followed by a variety of words, all of which are descriptive of the type of services offered. The distinctive and dominant element of all four of the applicant's marks is the word "OKKA" which would appear to be a made up word. The opponent's mark has at its start the word "OKA" with a device of a mountain alongside. Underneath are the words "pan Asian and sushi" which is clearly descriptive of

the type of meals on offer, further underneath are the words “restaurant and takeaway” which are again descriptive of the services on offer. The distinctive and dominant element of the opponent’s mark is the word “OKA” with the device element forming an independent element. Clearly, there is a considerable degree of similarity in the dominant elements, as well as considerable difference in the descriptive aspects. Visually and aurally there are similarities as I believe that “OKKA” and “OKA” would be pronounced in an identical fashion; as well as differences once the first element is dealt with. Neither mark has any conceptual meaning. **Overall, the marks are similar to a medium degree.**

Distinctive character of the earlier trade mark

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 *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).”

25) The word “OKA” has no meaning for any of the services for which it is registered, nor does the mountain device. The other aspects of the mark are all descriptive of the services for which it is

registered. The mark is clearly inherently distinctive to an average to high degree in respect of all its services. No evidence of use was filed so the opponent's mark cannot enjoy enhanced distinctiveness through use. **I find that the opponent's mark has an average to high degree of inherent distinctiveness but cannot benefit from enhanced distinctiveness through use in respect of its services.**

Likelihood of confusion

26) In determining whether there is a likelihood of confusion, 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 services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact 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 he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public, who will select the services by predominantly visual means, although not discounting aural considerations, and that they will pay an average degree of attention to the selection of such services.
- the opponent's mark has an average to high degree of inherent distinctiveness, but cannot benefit from an enhanced distinctiveness through use in respect of its class 43 services.
- The marks are similar to a medium degree.
- The services of the two parties are identical or at least highly similar

27) Taking all of the above into account there is a likelihood of consumers being confused into believing that services applied for under the marks in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) in respect of all the services applied for succeeds.**

CONCLUSION

28) The opposition under Section 5(2)(b) was completely successful.

COSTS

29) As the opponent has been successful it is entitled to a contribution towards its costs.

Expenses	£200
Preparing a statement and considering the other side's statement	£200
TOTAL	£400

30) I order Deniz Ash to pay Oka Restaurants Ltd the sum of £400. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of November 2018

George W Salthouse
For the Registrar,
the Comptroller-General