

O/0379/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 4011563

**BY RAIN GROUP LIMITED
TO REGISTER THE FOLLOWING TRADE MARK:**

Loaf & Co

IN CLASS 35 & 43

AND

THE OPPOSITION THERETO UNDER NUMBER 447560

BY HEKMAT EL ZEIN

BACKGROUND AND PLEADINGS

1. On 6 February 2024, Rain Group Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the contested mark”). The contested mark was published for opposition purposes in the Trade Marks Journal on 1 March 2024 in respect of the following services:

Class 35: Retail services in relation to bakery products; Retail services relating to bakery products.

Class 43: Coffee shop services; Coffee shops; Delicatessens [restaurants]; Cafe services; Take-away restaurant services; Salad bars [restaurant services]; Restaurant services; Restaurant and bar services; Bar and restaurant services; Café services; Restaurants (Self-service -); Self-service restaurants; Catering services for company cafeterias.

2. On 16 May 2024, the applicant’s mark was opposed by Hekmat el Zein (“the opponent”). The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and in respect of the class 43 services for which the contested mark has been applied for.
3. The opponent relies upon the following mark (the “earlier mark”):



Trade mark number 3987478

Filing date 4 December 2023.

Registration date 29 March 2024.

4. The opponent relies upon the following services for which its mark is registered:

Class 43: Restaurant services.

5. In accordance with section 6 of the Act, the mark relied upon by the opponent is an earlier mark. The mark had not been registered for five years at the date of application for the contested mark and so, in accordance with section 6A of the Act, the mark is not subject to proof of use. The opponent may therefore rely upon restaurant services without having to prove that it has used its mark.
6. The applicant has filed a counterstatement denying the claims made.
7. Neither party has legal representation and only the opponent filed written submissions in support of their claim, which will not be summarised, but will be referred to as and where appropriate during this decision. As neither party requested a hearing, this decision is taken following a careful consideration of the papers.

PRELIMINARY ISSUES

8. I have considered all of the information provided by the parties in making this decision. However, some of the information that has been provided/assertions that have been made have no bearing on these proceedings. I will address these in turn and explain why these have no relevance to this matter and my consequential decision.
9. It is noted that the applicant filed an email on 1 August 2024 attaching an image that the applicant referred to as its “logo”. The applicant has not clearly identified why this is relevant to the present case. It appears to be an argument that the opposition should fail as this logo is entirely different to the opponent’s earlier mark. However, the logo provided is not the same as the contested mark that is the subject of this opposition, and I can only consider the mark as applied for against the earlier mark as it appears on the register.
10. The applicant also makes the point in its email that the opponent’s business is a deli and the applicant’s business is not a deli. I must compare the services in the parties’ specifications on the basis of the ‘notional’ coverage of the services listed in the specifications, not the services currently provided. Any differences between the actual goods offered by the parties or the parties’ trading styles will, as a matter of law, have no bearing on the outcome of this opposition, unless

those perceived differences are apparent from the specifications. This is because a trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services if there is a likelihood of confusion, and the level of protection afforded to that mark will be identified in its specifications. Once a trade mark has been registered for five years, section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods and services for which it is registered.

11. It is also noted that the applicant claims that they do not understand why the opponent is objecting to the application of the contested mark on the basis that the applicant is based “in the South West” of the United Kingdom (“the UK”). However, it is important to keep in mind the fact that the protection afforded to a UK Trade Mark covers the whole of the territory of the UK. This argument therefore has no weight, and I shall say no more about it.

DECISION

12. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

Section 5(2)(b)

13. The opponent’s opposition is based upon section 5(2)(b) of the Act which stipulates the following:

“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”.

14. Section 5A of the Act stipulates that “Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Relevant law

15. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*,¹ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (“Canon”),² *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*,³ *Marca Mode CV v Adidas AG & Adidas Benelux BV*,⁴ *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (“OHIM”),⁵ *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,⁶ *Shaker di L. Laudato & C. Sas v OHIM*⁷ and *Bimbo SA v OHIM*⁸:
 - 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 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 services in question;

¹ Case C-251/95

² Case C-39/97

³ Case C-342/97

⁴ Case C425/98

⁵ Case C-3/03

⁶ Case C-120/04

⁷ Case C-334/05P

⁸ Case C-591/12P

- 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 services may be offset by a great degree of similarity between the marks, and vice versa;
- h. there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i. mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- j. the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- k. if the association between the marks creates a risk that the public might believe that the respective services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Services

16. The competing services are as follows:

The opponent's services	The applicant's services
<u>Class 43</u> Restaurant services.	<u>Class 43</u> Coffee shop services; Coffee shops; Delicatessens [restaurants]; Cafe services; Take-away restaurant services; Salad bars [restaurant services]; Restaurant services; Restaurant and bar services; Bar and restaurant services; Café services; Restaurants (Self-service -); Self-service restaurants; Catering services for company cafeterias.

17. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

- (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification⁹.
- (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”

18. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated (at paragraph 23) that, when making the comparison, “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”.

⁹ “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957.

19. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case¹⁰, for assessing similarity were:
- a. The uses of the respective services;
 - b. The users of the respective services;
 - c. The physical nature of the acts of service;
 - d. The respective trade channels through which the 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 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 services in the same or different sectors.
20. The opponent submits that the services identified in the table above in the contested mark are either identical or similar to the services identified above for which the earlier mark is protected. The applicant submits that the services within the relevant marks' specifications are not identical. However, the applicant's position in respect of the similarity between the services is unclear. Specifically, the applicant submits the following:
- "I see similarity in Class 43, but that counts for every restaurant / cafe in the UK. Similarity doesn't [sic] mean identical and the more you [sic] refine the more you can see the difference in every sense. We are also not the same as a McDonalds, yet we share similarities under Class 43.
- I herefor [sic] state that I deny the claim made by the opponent"
21. In any event, despite the lack of clarity, I will undertake a comparison of the services in the ordinary way.

¹⁰ [1996] R.P.C. 281

22. I bear in mind that in *Gérard Meric v OHIM*, the General Court confirmed that even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa)¹¹:

“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.”

23. As per the case of *Separode*,¹² I also bear in mind that it is permissible to group the services together, for the purpose of comparison.

Restaurant services;

24. It is clear that the applicant's restaurant services are identical to the opponent's "restaurant services".

Restaurants (Self-services-); Self-service restaurants; Take-away restaurant services; Delicatessens [restaurants]; Salad bars [restaurant services]

25. These are all types of "restaurant services". For that reason, I find them to be identical in line with the principle of *Meric*.

Bar services

26. I consider that the average consumer would consider bar services to be the preparation and service of drinks (the majority of which will be alcoholic) at a bar establishment. As well as drinks, the purchase and service of food is often a feature of visiting a bar. There is therefore an overlap in the purpose, method of use and users of bar services to that of restaurant services. There is also a

¹¹ Case T-133/05

¹² BL O/399/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person

degree of competition in that customer may opt to purchase a meal at a bar establishment instead of at a traditional restaurant. I therefore consider there to be a medium to high degree of similarity between restaurant and bar services.

Coffee shop services; Coffee shops; Café services; Cafe services

27. I must also compare the opponent's "restaurant services" with the applicant's "coffee shop services", "coffee shops", "cafe services" and "café services", which I will refer to as "coffee shop/café services" for the purposes of this comparison.
28. I consider that the average consumer would regard the core meaning of coffee shop/café services as being an establishment in which an assortment of drinks (a large proportion of which will contain coffee) are served to its customers either on site or by way of a take-away order. However, as well as the purchase of drinks, the purchase of food is often a feature of visiting a coffee shop/café. There is therefore an overlap in the purpose, method of use and users of coffee shop/café services and restaurant services. There is also a degree of competition in that customers may opt to visit a coffee shop/café over a restaurant (and vice versa). Consequently, I consider there to be a medium to high degree of similarity between the respective services.

Catering services for company cafeterias

29. This service has a similar nature, intended purpose and method of use to the opponent's restaurant services in that they both involve preparing and serving food. The users will be businesses providing catering for their staff cafeterias as well as the staff themselves purchasing food and drink during breaks. The services are not complementary and there does not appear to be any meaningful degree of competition. Trade channels may overlap since undertakings offering restaurant services may also offer catering services. As a result, I find that there is a low to medium degree of similarity between catering services for company cafeterias and restaurant services.

The average consumer and the purchasing act:

30. 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 services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

31. 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. held:

“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.”

32. For all of the restaurant, bar and coffee shop/café services, the average consumer is a member of the general public who will purchase the services on a fairly frequent basis. The price of the services is likely to vary considerably. There will be times where the consumer needs to find something to eat or drink very quickly. On other occasions, they will make a more considered choice, taking account of the range of options on the menu, the ingredients used, the cleanliness of the restaurant, reviews, and whether the service caters for any dietary requirements that the consumer has. On balance, then, I find that the level of attention paid when purchasing these services will be somewhere between low and medium.

33. I consider that the average consumer for “catering services for company cafeterias” will be corporate entities who may utilise the services so that any food or beverages purchased can be sold on at their own premises. I am of the view that during the purchasing process the corporate entities will consider the range of options available on the menu, the ingredients used, the cleanliness of the undertaking, other customer reviews, whether the undertaking caters for dietary

requirements and the price of the service. The corporate entities are likely to pay a higher than medium level of attention when purchasing the services on the basis that the contract for these services is likely to be of a significant value and may last for an extended period of time.

34. In respect of both types of consumers, the services may be purchased directly from the hospitality establishments or online via the establishment's website or social media accounts. Online, the average consumer selects the services after viewing information and imagery on a website. In hospitality settings, the services are likely to be purchased aurally (such as verbal orders to staff), though this will occur following a visual inspection of the goods in display cabinets, on menus or price lists. The services will be selected after viewing information on signage at the establishment's premises, in promotional materials, on the internet or after receiving word-of-mouth recommendations. In light of all the above, I find that the purchasing process for both types of average consumers will be primarily visual in nature, though I do not discount an aural component playing a role.

Comparison of marks:

35. 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 *Bimbo*,¹³ 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.”

¹³ *Bimbo SA v OHIM*, Case C-591/12P

36. It would be wrong, therefore, to dissect the trade marks artificially, 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.

37. The marks to be compared are as follows:

The opponent's earlier trade mark	The applicant's contested trade mark
	Loaf & Co

Overall Impression

38. The applicant's mark is a word only mark that consists of the words 'Loaf & Co'. This will be understood as being short for 'loaf and company'. The reference to 'and company' is something that is so common across many businesses in the UK that consumers will attribute it very little weight from a trade mark perspective. As a result, I find that 'loaf' plays the greater role in the overall impression of the mark, with "& Co" playing a lesser role.

39. The opponent's mark also utilises the word "loaf". This is the only word in the mark. There is also a device within the mark that, in my view, could be interpreted as either a slice of bread or the profile of a traditional style loaf of bread. It is my view that this device has a lesser role within the opponent's mark for two reasons. Firstly, I consider that its placement in the centre of the "o" could be fairly easily overlooked by the average consumer. Secondly, the device itself simply reinforces the meaning of the word "loaf", which I consider would be largely interpreted by the average consumer as a quantity of bread baked in one piece. The word loaf dominates the overall impression of the opponent's mark as it is the largest element of the mark.

Visual Comparison

40. Visually, the marks share the word 'loaf'. This sits at the beginning of the applicant's mark and is the dominant element of the earlier mark. For the reasons outlined above, it is the strongest element of the contested mark. The marks differ in the presence of the word '& Co' in the applicant's mark and as a consequence of a device in the opponent's mark which is not present in the applicant's mark. While these differences play lesser roles in their respective marks, they are still points of visual difference. Taking all of this into account and also bearing in mind that consumers tend to focus on beginnings of marks (being where the point of identity lies),¹⁴ I find that the marks are similar to between a medium and high degree.

Aural Comparison

41. Whilst I have found it to have a limited role in the applicant's mark, I find that the words '& Co' will be pronounced. I say this whilst bearing in mind the comments of Mr Phillip Harris, sitting as the Appointed Person, in the case of *Purity Hemp Company Improving Life as Nature Intended*¹⁵ wherein he stated that descriptiveness of an element does not render it aurally invisible. Whilst I do not consider '& Co' to be descriptive, I consider that a similar principle should apply here. As such, both marks will be pronounced in full meaning that the applicant's mark consists of three syllables whereas the opponent's mark consists of one syllable. Both marks will, in my view, be pronounced in their ordinary way but, for the avoidance of doubt, I confirm that I consider '& Co' will be pronounced as 'and co' (as opposed to 'and company'). Both marks share an identical first syllable, but the remaining syllables in the contested mark differ entirely. Bearing in mind what I have said above the level of regard that the average consumer will have for the beginnings of marks, I am of the view that the marks are aurally similar to a medium degree.

¹⁴ El Corte Inglés, SA v OHIM, Cases T-183/02 and T-184/02

¹⁵ Case BL O/115/22

Conceptual Comparison

42. I am of the view that the average consumer will readily understand that ‘loaf’ refers to a quantity of bread baked in one piece. I am also conscious that the opponent has submitted that they sell “bread, loaves, and sandwiches” and the applicant has submitted that it sells “bread, loafs [sic] and baguettes”. Loaf is an ordinary dictionary word which is present in both marks. The applicant’s mark has the additional concept of & Co, meaning “and company”, which is absent from the earlier mark. Balancing the conceptual similarities and differences, I am of the view that the marks are conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

43. 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).

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).”

44. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has not pleaded that its mark has obtained an enhanced level of distinctiveness and neither has it filed any evidence of use. Therefore, I have only the inherent position to consider.
45. As outlined above, I find that the word ‘loaf’ will dominate the distinctiveness of the earlier mark, the bread-shaped device adding little to the distinctiveness of the mark as a whole. Further, whilst I do not consider the meaning of the word “loaf” to be descriptive of the services at issue, I do consider that it will be viewed as being somewhat allusive of those services, it being a word for a type of food served in restaurants. Consequently, in my view, the inherent distinctiveness of ‘loaf’, and therefore, the inherent distinctiveness of the earlier mark as a whole, is somewhere between a low and medium degree.

Likelihood of Confusion

46. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst 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.
47. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). 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 (see *Canon*, C-39/97, para 17). It is necessary for me to keep in

mind the distinctive character of the earlier marks, the average consumer for the services, and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

48. I have determined that the class 43 services in the contested mark's specification are either identical or similar to the earlier mark's restaurant services. I have found that the applicant's bar services and coffee shop/café services have a medium to high degree of similarity to the opponent's restaurant services. I have also found that the applicant's "catering services for company cafeterias" are similar to a low to medium degree to the opponent's services. I have identified that the average consumers for the restaurant, bar and coffee shop/café services are members of the general public at large who will demonstrate a low to medium level of attention during the purchasing process. I have also found that the average consumers for the catering services will be corporate entities who will demonstrate a higher than medium level of attention during the purchasing process. I have identified that the purchasing process for the respective services will be primarily visual in nature, though aural considerations have not been excluded. I have found that the opponent's mark possesses between a low to medium degree of distinctive character for the services for which the mark is protected, and I acknowledge that both marks are visually similar to a medium to high degree, aurally similar to a medium degree and conceptually similar to a medium degree.
49. Taking all of these factors into account together with the principle of imperfect recollection, I consider that the average consumer is likely to mistake the parties' marks for one another. This finding is, in my view, supported by the fact that the marks at issue share identical dominant and distinctive words. Given that the additional elements in the marks have lesser impacts on their overall impressions, I am of the view that consumers will misremember which mark is just "loaf" with the device described above, and which was 'loaf & Co'. I say this because '& Co' is fairly unremarkable from a trade mark perspective so is unlikely to remain in the minds of the consumer, especially when considering imperfect

recollection, and I believe the image of the loaf of bread/slice of bread will be easily overlooked by the average consumer. While I appreciate that the earlier mark has between a low to medium degree of distinctive character, I remind myself that a weaker degree of distinctive character does not preclude a finding of confusion.¹⁶ Consequently, I consider that there exists a likelihood of direct confusion between the marks, even for services for which there is a low to medium degree of similarity and a higher than medium level of attention.

50. In the event that consumers recognise the differences between the marks and those differences are sufficient to avoid direct confusion, then I find that consumers will still consider that the marks originate from the same or economically connected undertakings. I make this finding on the basis that the ‘& Co’ in the contested mark, will be considered by the average consumer to be a logical indicator consistent with a sub-brand or brand extension. Whilst I appreciate that ‘loaf’ has a low to medium degree of distinctive character in respect of the services at issue, I do not consider its shared use to be coincidental. As a result, I am of the view that when consumers are confronted by the marks on identical or similar services, even those of only a low to medium degree of similarity, they will consider that ‘loaf & Co.’ has been created as a sub-brand or brand extension of the earlier mark. It would be logical in the case of a ‘company’ cafeteria catering service to add ‘& Co’ as a brand extension. Consequently, I consider that there exists a likelihood of indirect confusion between the marks.

CONCLUSION

51. The opposition succeeds in full, and the applicant’s mark is hereby, subject to any successful appeal of my decision, refused registration for the class 43 services applied for. The application may proceed to registration for the class 35 services which were unopposed.

¹⁶ L’Oréal SA v OHIM, Case C-235/05 P

COSTS

52. The opponent has been successful and is entitled to a contribution towards its costs. As the opponent is not legally represented, in its letter to the opponent of 28 January 2025, the Tribunal said:

“If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. Please send these by e-mail to tribunalhearings@ipo.gov.uk.

If there is to be a “decision from the papers” this should be provided **on or before 25 February 2025**. If a hearing is taking place you will be advised of the deadline to do so when the Hearing is appointed.

If the proforma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour.”

53. No cost pro forma has been received to date. Since the opponent did not file a cost pro forma by the deadline given in the Tribunal’s letter of 28 January 2025, it is only entitled to the statutory opposition fee of £100.
54. I therefore order Rain Group Limited to pay Hekmat el Zein the sum of £100. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 24th day of April 2025

B HARTLAND

For the Registrar