

O/0516/25

TRADE MARKS ACT 1994

**IN THE MATTER OF
UK REGISTRATION NO. 3237018
IN THE NAME OF
SOUL GROUP LTD
IN RESPECT OF THE FOLLOWING TRADE MARK:**

Soul Deli

IN CLASSES 16, 35 & 43

AND

**AN APPLICATION FOR DECLARATION OF INVALIDITY
THERE TO UNDER NO. 504098
BY
SOUL HOLDINGS INC.**

Background & Pleadings

1. The trade mark (“**contested mark**”) shown on the front page of this decision stands registered in the name of SOUL GROUP LTD¹ (“**the registered proprietor**”). The mark was applied for on 13 June 2017 in the United Kingdom and completed its registration procedure on 22 September 2017 for the following goods and services:

Class 16: Food wrappers.

Class 35: Retail services in connection with the sale of food and drink.

Class 43: Food and drink catering for cocktail parties; Food and drink catering for banquets; Food and drink catering for institutions; Food and drink catering; restaurants; café; coffee shop.

2. On 1 September 2021, Soul Holdings Inc. (“**the applicant**”) filed an application to have this trade mark declared invalid under the provisions of Section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”)², which are relevant in invalidation proceedings under Section 47 of the Act. The applicant relies upon its UK trade mark registrations for the following marks:

Trade Mark no.	UK00003209807 ('807)
Trade Mark	SOUL FOODS
Services for which the mark is registered	Class 35
Filing date	31 January 2017
Date of entry in register	16 June 2017

¹ Following the filing of form TM16, I note that the Registry confirmed by way of official letter dated 13 March 2023 the transfer of the ownership of the registered mark from “NSK Foods Ltd” to “SOUL GROUP LTD”.

² 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.

Priority details	Priority date: 30 January 2017 Priority country: Canada TM from which priority claimed: 1820415
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Trade Mark no.	UK00003209809 ('809)
Trade Mark	SOUL COFFEE HOUSE
Services for which the mark is registered	Classes 35 & 43
Filing date	31 January 2017
Date of entry in register	26 May 2017
Priority details	Priority date: 30 January 2017 Priority country: Canada TM from which priority claimed: 1820416

Trade Mark no.	UK00003209805 ('805)
Trade Mark	SOUL RESTAURANTS
Services for which the mark is registered	Classes 35 & 43
Filing date	31 January 2017
Date of entry in register	28 April 2017
Priority details	Priority date: 30 January 2017 Priority country: Canada TM from which priority claimed: 1820417

3. In its statement of grounds, the applicant claims that the competing goods and services are similar and/or identical, and the marks as a whole are highly similar with the common and distinctive element being identical.
4. The registered proprietor filed a notice of defence³ denying the applicant's claims. It also asserted that the earlier mark '805 has no more than a very low degree of distinctiveness and the phrase "soul food" is descriptive of a

³ I note that initially the registered proprietor failed to submit a counterstatement within the required time limit, leading to the automatic admission of the invalidation claims. Consequently, on 13 December 2021, the Registry issued a decision declaring the registration invalid. However, on 10 January 2022, the registered proprietor filed a form TM29, requesting the Registry to set aside the decision, while providing reasons. On 13 January 2022, the Registry issued a preliminary view to accept the registered proprietor's form TM29 allowing the opportunity to defend against the invalidation action.

type of cuisine, and the earlier marks '807 and '809 should have never been registered.

Papers Filed and Representation

5. The registered proprietor's evidence consists of a witness statement dated 10 December 2022 from Ms Angelee Sidar. Her evidence is accompanied by three exhibits (Exhibit AS1 – AS3), mainly focusing on the use of the words "SOUL" and "SOUL FOOD" in relation to food-based goods and services. The registered proprietor also filed written submissions on 11 December 2022.
6. The applicant filed written submissions in lieu of a hearing.
7. I have taken the evidence and submissions into account in reaching my decision and will refer to them below, where necessary.
8. Although a hearing date was initially listed, it was subsequently vacated at the request of the parties, who sought a stay to engage in negotiations aimed at resolving the dispute. The parties agreed that should they fail to reach a settlement by the end of the stayed period, a decision could be made on the papers. Following a number of stays, the parties did not arrive at a settlement. Consequently, this decision is taken following a careful consideration of the papers.
9. In these proceedings, the registered proprietor is unrepresented⁴ and the applicant is represented by Blake Morgan LLP.

Preliminary Remark

10. The registered proprietor's evidence contains various materials, such as screenshots from the Companies House records, social media posts, and

⁴ I note that Elkington and Fife LLP informed the Tribunal that they stopped acting for the registered proprietor with a letter dated 24 April 2024.

Google Maps results, which ostensibly demonstrate the use of the name “SOUL FOOD” by various third-party traders. However, I should highlight that I must determine the matter based on the trade marks before me, and any comparison between third party logos or trade marks that other traders use on their social media platforms or within Companies House records is of no relevance in these proceedings.

Decision

11. Section 47 of the Act states that:

“[...]

(2) Subject to subsections (2A) and (2G), 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, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

12. The invalidation application is based specifically on Section 5(2)(b) of the Act which states that:

“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.”

13. Under Section 6(1) of the Act, the applicant’s trade marks clearly qualify as earlier trade marks. Further, as protection of the earlier marks was completed less than five years before the registration date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.
14. The principles considered in this application for invalidity stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the Goods and Services

15. When making the comparison, all relevant factors relating to the goods or services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. In assessing the similarity of the goods or services concerned [...], 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 complementary.”

16. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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.”

17. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] 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.”

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

19. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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.”

20. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it

were, the core of the possible meanings attributable to the rather general phrase.”

21. The competing goods and services to be compared are shown in the following table:

Applicant's Services	Registered Proprietor's Goods & Services
<u>Earlier Mark '807</u> Class 35: Management of franchised restaurants; business management of franchised restaurants. <u>Earlier Mark '809</u> Class 35: Management of franchised restaurants; business management of franchised restaurants. Class 43: Café restaurants; cafés; restaurant services. <u>Earlier Mark '805</u> Class 35: Management of franchised restaurants; business management of franchised restaurants. Class 43: Café restaurants; cafés; restaurant services.	Class 16: Food wrappers. Class 35: Retail services in connection with the sale of food and drink. Class 43: Food and drink catering for cocktail parties; Food and drink catering for banquets; Food and drink catering for institutions; Food and drink catering; restaurants; café; coffee shop.

22. The applicant submits the following:

“23 The Proprietor's class 43 services, namely "Food and drink catering for cocktail parties; Food and drink catering for banquets; Food and drink catering for institutions; Food and drink catering; restaurants; cafe; coffee shop" are identical to the Applicant's class 43 services.

24 The Proprietor's class 35 services namely "Retail services in connection with the sale of food and drink" are highly similar to the Cancellation Applicant's class 35 services and identical to the class 43 services, both comprising of services for the management of

franchised restaurants and encompassing retail services in connection with the sale of food and drink.

25 The Proprietor's class 16 goods, namely "food wrappers" are similar to the Applicant's class 43 services by way of association, as branded food wrappers are part of the products served within a cafe."

23. The registered proprietor submitted that:

"22. The proprietor submits that paragraphs 7, 8, 9 and 10 of the applicant's statement of grounds contains either no analysis or an insufficient analysis of the respective goods and services.

23. Specifically, the proprietor submits that the applicant's assertion that its class 35 "management of franchised restaurants..." is identical or highly similar to any of the proprietor's goods and services is not credible. It is unclear how class 35 "retail services" are identical or similar to class 35 "management" services.

24. It is also unclear how paper food wrappers in class 16 are identical or similar to the applicant's services.

25. The proprietor accepts that the respective class 43 services are identical or similar where they are not identical. [...]"

24. In light of the above, I note that the registered proprietor admits that Class 43 services are identical or similar, without specifying any competing terms that it considers dissimilar. Thus, even for those terms where identity or similarity has not been denied, I will need to assess the degree of similarity between the services.

25. I agree with the registered proprietor that the applicant's submissions lack specificity, and it is unclear how the competing goods and services in relation to Classes 16 and 35 are similar or identical. Therefore, I will need to undertake an assessment based on the notional use of the competing goods and services.

26. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.⁵

Preferred approach

27. While all the earlier specifications list the same terms under Class 35, only the earlier marks '809 and '805 include services from Class 43. As a result, I will carry out a single assessment for the competing specifications, differentiating them only when necessary.

Class 16

Food wrappers

28. The contested goods are used to wrap and protect food for storage. Although the opponent claims similarity between the contested goods and Class 43 services, it provides no specific submissions as to the points of similarity. In the absence of particularised submissions or evidence, there is no obvious similarity between the contested goods and the applicant's specification. Even though the competing goods and services may share the same users (the general public), and they relate to food in the very widest sense, these are not sufficient factors by themselves to find similarity. They differ in nature, purpose, method of use, and trade channels, and they are not complementary or in competition. Thus, I consider them to be dissimilar.

⁵ *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Class 35

Retail services in connection with the sale of food and drink

29. The opponent claims that the contested services are highly similar to its Class 35 services and identical to its Class 43 services. I disagree. The earlier services under Class 35, namely “*Management of franchised restaurants; business management of franchised restaurants*” are provided in order to improve the performance of restaurants, for example, by overseeing the operations of the establishment, whereas the retail services offered by the registered proprietor are in relation to direct sale of food and drink products to consumers. In the absence of particular submissions and/or evidence, I am not ready to accept that there is an overlap between retail services relating to the distribution of foodstuffs and drinks, and services relating to the business management of franchised restaurants. Therefore, the competing services do not share nature, purpose, users, trade channels or method of use. Also, they are not in competition with each other, and they are not complementary. I find that the competing services are dissimilar.
30. Although the opponent claims that the earlier terms in Class 43 will encompass the contested retail services, I disagree. Even though the competing services pertain to the provision of food and drinks, their delivery is different. This is because the contested services are typically offered to the consumers in retail settings such as grocery stores, supermarkets, and specialty food shops, as opposed to the earlier services which are provided in establishments like cafes and restaurants. In this regard, I find that the competing services differ in nature and method of use, and they are not complementary. That said, I consider that there is a degree of competition, as consumers might choose between the earlier services that offer food and drinks ready for on-site consumption and the contested services for home consumption. In addition, there may be some overlap in trade channels; for instance, prepackaged foods and canned or bottled drinks can be found in both retail outlets and cafés/restaurants.

Further, the competing goods share the same users. I, thus, find them to be similar to between a low to medium degree.

Class 43

Restaurants; café; coffee shop

31. The contested terms are self-evidently identical to the opponent's "*Café restaurants; cafés; restaurant services*".

Food and drink catering for cocktail parties; Food and drink catering for banquets; Food and drink catering for institutions; Food and drink catering

32. The contested services have a similar nature and intended purpose to the opponent's "*restaurant services*", as both involve the preparation and serving of food. Trade channels may overlap since undertakings offering restaurant services may also offer catering for events. The services also share the same users. There may be a degree of competition between them, as a consumer seeking food or drinks for an event might choose a restaurant instead of catering provided at another venue, or vice versa. Consequently, I find that there is between a medium and high degree of similarity between the respective services.
33. For completeness, I will conduct a separate assessment between the earlier mark '807's terms in Class 35 and the contested terms in Class 43 services. I note that the earlier services "*Management of franchised restaurants; business management of franchised restaurants*" concern the provision of management in the field of restaurant franchising, whereas the contested services "*Food and drink catering for cocktail parties; Food and drink catering for banquets; Food and drink catering for institutions; Food and drink catering; restaurants; café; coffee shop*" concern the provision of food and drinks in various settings. Therefore, the inherent nature, purpose, and the users (owners of restaurants v the general public) of the services differ. I also note that there is no competition or complementarity

between the services. Considering the above, I find the competing terms to be dissimilar.

Conclusion on goods and services comparison

34. As some degree of similarity between the respective goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition reliant upon the 5(2)(b) ground aimed against those goods and services I have found to be dissimilar must fail.⁶

Earlier mark '807

35. The likelihood of confusion does not arise in relation to the contested Class 16 goods and Class 35 and 43 services which are dissimilar to the earlier Class 35 services. **The invalidation action cannot succeed against dissimilar goods and services and, therefore, is dismissed.**

Earlier marks '809 and '805

36. The likelihood of confusion does not arise in relation to the contested Class 16 goods which are dissimilar to the earlier marks' services. **The invalidation action cannot succeed against dissimilar goods and services and, therefore, is dismissed insofar as it concerns the following terms:**

Class 16: Food wrappers.

Average Consumer and the Purchasing Act

37. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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

⁶ Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

“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.”

38. The services which I have found to be identical or similar are available to the members of the general public, without excluding businesses. The associated cost is likely to vary considerably, such as budget to high-end restaurants and catering services. The services will be selected after viewing information on signage on the high street, in promotional materials, on the internet or after receiving word-of-mouth recommendations. When purchasing the services, the average consumer is likely to consider the range of food and drink on offer, dietary requirements and reviews. In my view, the average consumer is likely to demonstrate a medium level of attention during the purchasing process.

Comparison of Trade Marks

39. 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.”

40. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

41. The marks to be compared are:

Earlier Marks	Contested Mark
<u>Earlier Mark ‘809</u> SOUL COFFEE HOUSE <u>Earlier Mark ‘805</u> SOUL RESTAURANTS	Soul Deli

Overall Impression

42. The earlier marks are both word marks. Registration of a word mark protects the word itself.⁷ The marks’ overall impression lies in the words, with the first word element “SOUL”, dominating the overall impression. The

⁷ *LA Superquímica v EUIPO*, T-24/17, para 39. See also *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

subsequent words “COFFEE HOUSE” and “RESTAURANTS” are descriptive of the Class 43 services.

43. Similarly, the overall impression of the contested mark lies in the words, namely “Soul Deli”. Again, in this case, the overall impression lies in the words, with the first word element “Soul” being more dominant and the word element “Deli” being descriptive of the Class 43 services.

Visual comparison

Earlier word mark ‘809 and contested mark

44. Visually, the earlier mark “SOUL COFFEE HOUSE” is three words as opposed to the contested mark, “Soul Deli”, which is two. I bear in mind that the beginnings of words tend to have more impact than the ends.⁸ The marks in this instance share the common word element “SOUL” appearing at the beginning. Nevertheless, they differ in the rest of the word elements, where the words “COFFEE HOUSE” in the earlier mark are twelve letters long against four letters (“Deli”) in the contested mark. Considering all the factors, including the overall impression, I find that the degree of visual similarity is medium.

Earlier word mark ‘805 and contested mark

45. Again, in this instance, the marks consist of two word elements sharing the same first word element “SOUL”. However, they differ in the second word element, namely “RESTAURANTS”/“Deli”, with the former being eleven letters and the latter four. Consequently, I find that the marks are similar to a medium degree.

⁸ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

Aural comparison

Earlier word mark '809 and contested mark

46. In this instance, the competing marks will aurally share the same first word element, "SOHL-". However, the marks will differ in articulating the rest of the word elements "CO-FFEE-HOWSS" and "DEL-EE". I find that the degree of aural similarity is medium.

Earlier word mark '805 and contested mark

47. Similarly here, the first word element "SOHL-" will be articulated identically. However, the rest of the word elements will differ in their pronunciation, namely "RESS-TUH-RAHNT" and "DEL-EE". I find the marks to be aurally similar to a medium degree.

Conceptual comparison

48. The registered proprietor submits the following:

"8. As mentioned in the witness statement of Angelee Sidar, the proprietor's understanding is that the words "SOUL" and "SOUL FOOD" are generally non-distinctive and descriptive terms for food-based goods and services. It is widely known that these are historical terms directly describing a type of cuisine, i.e., an ethnic cuisine traditionally prepared and eaten by African Americans, which originates in the Southern United States and has done so since the 1960s, as well as a genre of music. [...]

16. Conceptually, the proprietor submits that the marks SOUL FOODS, SOUL RESTAURANTS and Soul Deli either share only a very low degree of conceptual similarity, or none whatsoever, in view of the non-distinctive component SOUL.

17. Regarding the applicant's specific mark SOUL COFFEE HOUSE, the proprietor submits that there is no degree of conceptual similarity

to the proprietor's mark Soul Deli whatsoever, given that the respective marks, as a whole, convey a dissimilar message.

18. Specifically, the dictionary definition of the word "Deli" is "a delicatessen" and "food typically sold at a delicatessen, as cold cuts, salads, and pickles", as shown in Annex 1 attached to these submissions. The words "COFFEE HOUSE" can be defined as "a public place that specializes in serving coffee and other refreshments", as shown in Annex 1 attached to these submissions.

19. When considered as whole, there is clearly no degree of conceptual similarity between the marks Soul Deli and SOUL COFFEE HOUSE, or at most it is only at a very low degree."

49. The applicant submits the following:

"11. The Submissions on behalf of the Proprietor assert that the words "SOUL" and "SOUL FOODS" are non-distinctive and descriptive terms to describe an ethnic cuisine and genre of music. However, in the context of the Applicant's Marks, this is not the case. The Applicant uses the word SOUL in relation to franchised restaurants and cafes. The use of SOUL in relation to an ethnic cuisine and music genre is therefore not relevant as it is not descriptive of any of the services provided by the Applicant."

50. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

51. The registered proprietor has adduced evidence, positing that the terms "SOUL" and "SOUL FOOD" are descriptive in nature, denoting either an ethnic cuisine originating from the United States predominantly associated with African American culture, or as a reference to a music genre. I note

that the majority of the evidence is revolving around the former interpretation, with various materials being screenshots from .com websites, which indicates they do not target the UK audience. Although I consider that some UK consumers, particularly those of African American descent, may be familiar with this connotation, in the absence of corroborating evidence, I am not prepared to conclude that a significant proportion of UK consumers will immediately grasp this concept. In this context, it is my view that a significant proportion of the average consumers in the UK will interpret the shared element “SOUL”, which is a commonplace and dictionary word and carries multiple meanings, primarily as referring to the spiritual part of a being. Therefore, the common element in the competing marks is conceptually identical.

52. For the same reason, there will not be a significant proportion of UK consumers that will perceive the applicant’s marks, as forming a unit extracting a concept from the marks as a whole. On the contrary, the average consumer will readily understand the commonplace words “COFFEE HOUSE” and “RESTAURANTS” in the two earlier marks ‘809 and ‘805, which will be seen merely as having descriptive qualities of the Class 43 services.
53. The contested mark also contains the word “Deli”. I concur with the registered proprietor’s definition, and I consider that the average consumer will conceptualise the word ‘deli’ as a shop selling ready-to-eat food products. Therefore, it follows that the average consumer will likely treat the word “Deli” as descriptive of the Class 43 services offered by the registered proprietor. For completeness, I do not consider that the average consumer will conceptualise the mark as a whole giving rise to a new meaning.
54. Taking into account all of the above, I find that the competing marks are conceptually similar to between a medium and high degree.

Distinctive Character of the Earlier Trade Marks

55. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).”

56. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
57. The registered proprietor submitted the following:

“10. The proprietor also notes as per the witness statement of Angelee Sidar and Exhibit AS2, that the word SOUL, most likely because of its descriptive connection with food and a genre of music, is widely used by various third-party traders in the restaurant and food industry. This is clear from the extracts of websites and company information demonstrating that the word SOUL is commonly used in the UK by several third-party traders in connection with food-based services.. [...]

34. The proprietor submits that the shared word SOUL is clearly non-distinctive and descriptive in relation to the applicant's services and the remaining elements of the respective marks are descriptive, ie., “FOODS”, “RESTAURANTS”, “COFFEE HOUSE” and “DELI”. The proprietor therefore reiterates that, when assessing whether there exists a likelihood of confusion or association, the degree of distinctive character is a crucial factor, and no likelihood of confusion or association should be found where the earlier marks are non-distinctive and/or where the only shared element is of very low distinctiveness.”

58. I disagree with the registered proprietor's submissions. As outlined earlier in this decision, it is irrelevant to the current assessment whether the word “SOUL” is commonly used in the trade by third party traders. Also, the evidence provided by the registered proprietor is insufficient to support the argument that a significant proportion of consumers will associate the word “SOUL” with an ethnic cuisine that conveys specific descriptive qualities.
59. Even though the applicant claims enhanced distinctiveness, it has not shown use of its marks and thus cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the applicant's marks to consider. I also bear in mind that only the common element between the respective marks should be considered to evaluate the relevant distinctiveness; this is because *“if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to*

*be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.*⁹ The word element “SOUL”, which is the only element that the competing marks have in common, is a commonplace dictionary word having no suggestive or descriptive relevance to the registered services. Therefore, it will afford a medium degree of distinctiveness. As advanced earlier in this decision, the rest of the word elements in the earlier marks, namely “COFFEE HOUSE” and “RESTAURANTS”, have descriptive qualities in relation to the services for which the marks are registered. Consequently, I find that the level of inherent distinctiveness of the marks as a whole will be between a low and medium degree.

Likelihood of Confusion

60. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.¹⁰ It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.¹¹
61. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that

⁹ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13.

¹⁰ See *Canon Kabushiki Kaisha*, paragraph 17.

¹¹ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

the later mark is another brand of the owner of the earlier mark or a related undertaking.

62. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis QC (as he then was), sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

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).

(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)."

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.¹²

63. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson*. He stated:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

¹² See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER)."

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

64. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

65. Earlier in this decision I have concluded that:

- the services at issue range from identical to various degrees of similarity;
- the average consumer will be members of the general public, without excluding businesses. The selection process is predominantly visual without discounting aural considerations. The members of the general public will likely demonstrate a medium level of attention during the purchasing process;
- the earlier marks '809 and '805 and the contested mark are visually and aurally similar to a medium degree, and conceptually similar to between a medium and high degree;
- the earlier marks are inherently distinctive to between a low and medium degree.

66. Taking into account the above factors, I am persuaded that there is no likelihood of direct confusion even for those services that I have found to be identical. Notwithstanding the principle of imperfect recollection, I find that when the marks are considered as a whole, the average consumer would not overlook the difference between the words "COFFEE HOUSE", "RESTAURANTS" and "DELI" in the competing marks. Given that direct confusion involves no process of reasoning, and the divergent word elements in the marks will not go unnoticed, the average consumer will not mistake the applicant's marks for the registered proprietor's.

67. Turning to indirect confusion, the average consumer will identify the differences in the marks emanating from the words "COFFEE HOUSE", "RESTAURANTS" and "DELI", but they will assume that the respective marks originate from the same or economically linked undertakings. This is because the average consumer will likely attribute trade mark significance to the commonly shared word element "SOUL", playing an independent distinctive role within the marks, and treat it as the 'house' brand. As delineated above, it is my view that the word elements in the marks do not form a unit. Thus, when encountering the earlier marks, the

average consumer will consider that the word elements “COFFEE HOUSE” and “RESTAURANTS” will be descriptive of the services. In this case, the common word element “SOUL”, particularly considering its position at the beginning of the marks, creates the conceptual hook between the competing marks that will lead the consumers to perceive the descriptive word element “DELI” in the contested mark as a brand extension or variation of the earlier marks, or vice versa. Consequently, I find there to be a likelihood of indirect confusion between the marks where the average consumer would assume a commercial association between the parties.

68. The above findings extend to the competing services which I found to be similar at any degree.

Outcome

69. Part of the application for invalidation has been successful. Subject to any successful appeal against this decision, **under Section 47(6) of the Act, the registration is deemed never to have been made for the following services:**

Class 43: Food and drink catering for cocktail parties; Food and drink catering for banquets; Food and drink catering for institutions; Food and drink catering; restaurants; café; coffee shop.

Class 35: Retail services in connection with the sale of food and drink.

70. Part of the application for invalidation has been unsuccessful. Subject to any successful appeal against this decision, **the registered trade mark will remain registered for the following goods:**

Class 16: Food wrappers.

Costs

71. The applicant has enjoyed a greater degree of success and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I award costs as follows:

Official fee	£200
Preparing a statement and considering the counterstatement	£250
Preparing submissions and considering and commenting on the other side's evidence and submissions	£250
Total	£700

72. I, therefore, order SOUL GROUP LTD to pay to Soul Holdings Inc. the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 11th day of June 2025

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General