

O-374-10

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 956717 IN THE
NAME OF EMME SEI S.P.A.**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 71797 BY BUFFALO GRILL**

BACKGROUND

1. On 29 January 2008, EMME SEI S.P.A. ("Emme") requested protection in the United Kingdom of the international registration (IR) of the following trade mark:



"The trademark is made up by a stylized rectangular head of cow with typical horns and the fancy words "Fratelli la Bufala" and "Pizzaioli emigranti" placed between two stylized suns."

2. The United Kingdom Trade Marks Registry ("TMR") considered that the request satisfied the requirements for protection and particulars of the IR were published in Trade Marks Journal No. 6738 on 6 June 2008 for the following services in class 43:

Catering services and all services in connection with the management and operation of restaurants, pizzerias, fast-food restaurants, snack bars.

3. On 5 September 2008, Buffalo Grill ("Buffalo") filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act). Buffalo indicate that their opposition is based upon the following trade mark:

Trade Mark	No.	Application Date	Registration Date	Services in class 42
	CTM 190082	01.04.1996	19.05.1999	Restaurants

4. In the Statement of Grounds accompanying their opposition Buffalo said:

“The opponent’s trade mark is a stylised mark BUFFALO GRILL and contains horns and the words “buffalo grill”. The mark opposed is a stylised mark also featuring a set of horns and the words FRATELLI LA BUFALA PIZZAIOLI EMIGRANTI. The dominant element of this mark is the set of horns and the words FRATELLI LA BUFALA. PIZZAIOLI EMIGRANTI is depicted in smaller writing and is a less dominant element of the mark. These two trade marks are confusingly similar due to both containing horn elements and the similar words “buffalo” and “bufala”.

5. On 9 December 2008, Emme filed a counterstatement. As this contains the only comments I have from them on the merits of the opposition it is reproduced below in full. Having admitted the existence of Buffalo’s registration but not its validity (I note that in boxes 5 and 6 of their counterstatement Buffalo ask Emme to provide proof of the use they have made of their trade mark), Emme go on to say:

“2. The applicant denies that it’s applied for mark is similar to the opponent’s mark. The applicant’s mark is a complex mark made up of several elements each distinctive in its own right. The words in the applied for mark FRATELLI LA BUFALA bear no resemblance at all to the words BUFFALO GRILL in the opponent’s mark. The average person in the UK would not know the meaning of La Bufala and would simply recognise an Italian or Spanish connotation. The arrangement of the separate elements in the applied for mark create a composite mark which would never be confused with the opponent’s mark.

In the opponent’s mark the horns are highly stylised and bold and determine the overall shape of the mark which is equally dominated by the words BUFFALO GRILL. In the applied for mark there is a stylised head of a cow with horns on which the words LA BUFALA have been placed. These are surrounded by other words which all combine to create a mark which, when considered as a whole, gives a completely different impression.

The services, while identical, are of a kind which render confusion between the respective marks unlikely. No one seeing or knowing the Buffalo Grill restaurant would venture into the LA BUFALA restaurant by mistake thinking it was a BUFFALO GRILL restaurant. Nor would anyone book a table at La Bufala believing in to be a Buffalo Grill.”

6. Only Buffalo filed evidence. While neither party asked to be heard or filed written submissions in lieu of attendance at a hearing, during the evidence rounds Buffalo filed a witness statement, dated 21 October 2009, from Clare Lorimer who is a partner in the firm of Phillips & Leigh (their professional representatives in these proceedings) which contained legal arguments. Consisting of arguments rather than evidence it is not necessary or appropriate for me to summarise these submissions here; I will however

refer to them as necessary below. After a careful consideration of all the material before me, I give this decision.

Buffalo's evidence

7. This consists of two witness statements. The first, dated 19 October 2009, is from Jean-François Sautereau who is the Président du Directoire of Buffalo. Mr Sautereau explains that he has been employed by Buffalo for one year; he confirms he has full access to Buffalo's records and is authorised to make his statement on their behalf. The second witness statement, dated 6 January 2010, is from Amanda Conrad a translator at Amanda Conrad Translations; Ms Conrad states that she is conversant with the French, Spanish and English languages. The purpose of her statement is to translate into English extracts from exhibits 1 to 4 to the statement of Mr Sautereau.

8. Mr Sautereau explains that Buffalo Grill is a French restaurant chain which began in 1980 when their first restaurant opened in Avrainville in the Essonne region of France; he states that "the restaurant is a steak house well known in the European market". He goes on to say that today (i.e. October 2009 the date of his statement), the chain has restaurants in France, Spain, Belgium, Switzerland and Luxembourg with over 320 restaurants employing over 6,000 employees and serving up to 32 million diners per year. He provides a list of key dates in the opponent's development. Briefly, these are as follows:

1980: First restaurant opens in Avrainville;

1984: Second restaurant opens in La Ville-du-Bois and Annecy;

1990: 39 restaurants including 11 franchises;

1994 100th restaurant opens in Mulhouse;

1995: 131 restaurants including 38 franchises;

1997: First international restaurant opens in Spain;

End 2000: 217 franchises, 71 restaurants in France and 9 branches abroad in Spain, Belgium and Switzerland;

2005: 284 restaurants including 109 franchises;

2008: More than 300 restaurants and 20 openings planned.

9. Attached to Mr Sautereau's statement are four exhibits; these are as follows:

Exhibit 1 consists of pages downloaded from the website www.totocam.com/buffalogrill.htm on 8 June 2009 which Mr Sautereau describes

as “a list of French Buffalo Grill restaurants...”. The translated version of this exhibit indicates that the restaurants (of which some 290 are listed under the name BUFFALO GRILL) appear under the heading “List of restaurants specialising in far-west style BUFFALO GRILL grilled meat”; the final translated page appears to indicate that this was the position on 2 March (presumably of 2009).

Exhibit 2 is described as “a promotional article regarding Buffalo Grill in Spain”. The pages (which may date from 2004 and which I note contains Buffalo’s registered trade mark), describes the history of Buffalo’s restaurants and provides details on, inter alia, the nature of the dining experience and the associated costs.

Exhibit 3 is described as “a selection of advertisements for Buffalo Grill published in Spain.” Only 1 of the 3 pages provided has been translated. The first page which is dated 29 August (but no year is discernable) contains the trade mark the subject of Buffalo’s registration, as does page 2 (which shows images of food). The final page which has been translated and which also bears the registered trade mark, contains a list of Buffalo’s restaurants in Spain, the address of their head office and a money saving coupon.

Exhibit 4 is described as “a selection of advertisements for Buffalo Grill published in Belgium”. Once again of the seven pages that have been provided only 1 has been translated. While only one of the pages can be positively dated (from 2006), all of the pages contain Buffalo’s registered trade mark, and the single page which has been translated relates to a restaurant service.

Exhibit 5 is described as “a selection of menus from Buffalo Grill in Spain.” While this exhibit has not been translated and does not carry a date, one is able to discern that it is a menu in the Spanish language, on the front page of which Buffalo’s registered trade mark can be seen.

Exhibit 6 is described as “a selection of invoices issued to Buffalo Grill in Spain.” While I am able to discern some information from these invoices, I note, for example, that invoices 1/8, 2/8 and 3/8 are made out to BUFFALO GRILL ESPAÑA S.A. and BUFFALLO GRILL (Majadahonda) respectively and are dated 13 April and 17 March 2009 respectively, as no translation into English has been provided they are of very little assistance.

10. That concludes my summary of the evidence provided to the extent I consider it necessary/possible.

DECISION

11. The opposition is based solely upon section 5(2)(b) of the Act which reads as follows:

“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.”

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

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

13. In these proceedings Buffalo are relying on the registered trade mark shown in paragraph 3 above, which has an application date of 1 April 1996 which is prior to Emme’s request for protection of 29 January 2008; as such, it qualifies as an earlier trade mark under the above provisions. Emme’s request for protection was published for opposition purposes on 6 June 2008 and Buffalo’s earlier trade mark was registered on 19 May 1999. As a result, Buffalo’s earlier trade mark is subject to The Trade Marks (Proof of Use, etc) Regulations 2004. As I noted in paragraph 5 above, in their counterstatement Emme ask Buffalo to provide evidence of the use they have made of their earlier trade mark. The relevant sections of the Proof of Use Regulations read as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Proof of use

14. In reaching a conclusion on this point, I must apply the same factors as I would if I

were determining an application for revocation based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of publication of Emme's request for protection i.e. 7 June 2003 to 6 June 2008. The leading authorities on the principles to be applied when determining whether there has been genuine use of a trade mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following principles:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

15. In addition, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian*

Cruise Lines Ltd [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

16. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way

because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

17. Finally, the comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration.

Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or subcategories.”

18. As is so often the case in proceedings such as this, Buffalo’s evidence of use of their earlier trade mark is far from perfect. For example, I have not been given any indication of turnover (by country) achieved under the trade mark or amounts spent (by country) on making the trade mark known to the average consumer. In addition, the vast majority of the exhibits provided are undated and (curiously) not all of the exhibits provided have been translated into English. In addition, I have not been provided with any exhibits showing use of the registered trade mark in France.

19. However, what I do have is unchallenged evidence from Mr Sautereau which indicates that Buffalo opened their first restaurant in France in 1980, and that by 1995 they had 131 restaurants in France of which 38 were franchises; by 2009 the number of restaurants in France had increased to approximately 290. In addition, I am told that in 1997 Buffalo opened their first international restaurant in Madrid and that by the end of 2000 they had (in addition to their restaurants in France) 9 branches abroad in, inter alia, Spain and Belgium. I also have exhibits which show that Buffalo have used their earlier trade mark in Spain and Belgium in the form in which it stands registered. I note that in his witness statement Mr Sautereau says:

“[Buffalo] have been using the mark in Europe since 1980 starting with use in France, with subsequent use in Luxembourg, Belgium, Spain and Switzerland.”

20. In *PAGO International GmbH v Tirol Milch registrierte Genossenschaft mbH* Case C-302/07 the European Court of Justice (ECJ) considered the requirements for establishing a reputation in respect of a Community trade mark. They said:

“30 The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

21. It would be anomalous if reputation in one member state were enough to satisfy the requirement of Article 9(1)(c) but use in one (or in these proceedings possibly four member state(s)) could not satisfy the use requirement. In considering whether genuine use is established it is necessary to consider, within the context of the European Union as a whole, the sector of the industry in which Buffalo operates and the nature of their services, whether their use is warranted in the marketplace and if their use creates and preserves an outlet for their services in the marketplace. Use might be

of a scale that could be considered warranted in a single jurisdiction but not the European Union as a whole; something that is reflected in Article 108(2)(a) of Council Regulation 40/94 of December 20, 1993 which is based on the premise that use of a trade mark may be sufficient to maintain registration in one jurisdiction but not the European Union as a whole:

“(a) where the rights of the proprietor of the Community trade mark have been revoked on the grounds of non-use, unless in the Member State for which conversion is requested the Community trade mark has been put to use which would be considered to be genuine use under the laws of that Member State”.

22. In my view Buffalo’s evidence demonstrates that their use of their earlier trade mark has been neither token nor internal. In the absence of any challenge from Emme to Buffalo’s evidence, I have come to the conclusion that notwithstanding the deficiencies I have highlighted above, when considered as a totality Buffalo’s evidence is sufficient for me to conclude that the use that they have made of their earlier trade mark in France, Spain and Belgium constitutes genuine use in relation to the restaurant services they provide under their registered trade mark. As their earlier trade mark stands registered in respect of “restaurants”, their specification as registered reflects, in my view, their actual use of their trade mark. In those circumstances there is no need for me to consider the issue of what constitutes a fair specification.

Section 5(2)(b) – case law

23. The ECJ has provided guidance in a number of judgments germane to this issue. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

(e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;

(i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(j) further, 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; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;

(k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

The average consumer and the nature of the purchasing decision

24. 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.

25. Buffalo's earlier trade mark is registered in respect of restaurant services; these are services which target the general public. Emme's application includes the phrase "catering services" (which would include restaurant services) and which again are

services directed at the public at large. However, Emme's specification also contains the phrase:

"all services in connection with the management and operation of restaurants, pizzerias, fast food restaurants and snack bars."

26. This appears to me to be a very wide claim which may in fact have been intended to refer to services proper to other classes, and for which the average consumer may be, for example, a person or business requiring advice on the setting up and running of a restaurant. In those circumstances the average consumer may be somewhat different to the average consumer for the type of restaurant services provided by Buffalo. However, insofar as the services are limited to those proper to class 43, there are clearly all restaurant/catering related and I intend to proceed on the basis that the average consumer for both parties' services will be the same i.e. the general public.

27. As to how restaurant/catering services will be selected by the average consumer, Buffalo's evidence and my own experience suggest that visual considerations (having encountered the trade mark on, for example, signage in the high street, in advertisements in magazines, on posters and on the Internet) are most likely to dominate the selection process. That said, I accept that caterers and restaurants are often recommended by word of mouth; consequently, oral/aural considerations will also play a part in the selection process. The level of attention paid to the selection of, for example, a restaurant by the average consumer is likely, in my experience, to vary depending on the nature of the occasion for which the restaurant is being selected and is likely to range from minimal to reasonably high. While some or all of the following considerations may play a part in the selection of restaurants in some circumstances e.g. the style of restaurant (Italian, French, Indian, Vegetarian), the restaurant's size, location, opening hours and the cost of the items on the menu, I doubt that the average consumer would display the same degree of care selecting a venue to have an impromptu cup of coffee (although even here I accept that the average consumer may display a degree of brand loyalty). As the cost and importance of their selection increases, so will the degree of care displayed by the average consumer when selecting the services.

Comparison of services

28. In her witness statement on behalf of Buffalo Ms Lorimer says:



"The services for which the application opposed has been applied for fall into class 43. Those services are entirely contained with the specification of the earlier mark, which covers identical services. For the purposes of assessment of confusion, the services can be deemed to be identical."

29. I noted in paragraph 5 above that in their counterstatement Emme accepted that the services contained in Buffalo's earlier trade mark (as registered) were identical to those contained in their request for protection. As I have concluded following my assessment

of Buffalo's evidence that its specification should for the purposes of comparison remain as registered, I intend to proceed on the basis that the respective services are identical.

Comparison of trade marks

30. For the sake of convenience, the trade marks to be compared are as follows:

Emme's trade mark	Buffalo's trade mark
	

31. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind I must, as the case law dictates, then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant elements

32. Ms Lorimer says in relation to Emme's request for protection:

"The dominant element of this mark is the set of horns and the words FRATELLI LA BUFALA. PIZZAIOLI EMIGRANTI is depicted in much smaller writing and is a less dominant element of the mark."

And (albeit in relation to the visual similarity between the trade marks):

"We submit that the wording "pizzaioli emigranti" is less distinctive, as represented in smaller text, and would not add appropriate distinctiveness to the mark to overcome the confusion in the mind of the average consumer."

33. In their counterstatement Emme said:

"The applicant's mark is a complex mark made up of several elements each distinctive in its own right... The average person in the UK would not know the

meaning of La Bufala and would simply recognise an Italian or Spanish connotation. The arrangement of the separate elements in the applied for mark create a composite mark which would never be confused with the opponent's mark."

And:

"In the opponent's mark the horns are highly stylised and bold and determine the shape of the mark which is equally dominated by the words BUFFALO GRILL."

34. As far as I am aware, all of the elements which comprise Emme's trade mark i.e. the device elements (which Emme describe as a stylised rectangular head of a cow with typical horns and two stylised suns) and the words "fratelli la bufala" and "pizzaioli emigranti" are individually and collectively distinctive in relation to the services for which they have requested protection. That said, I agree with Buffalo that given their size and positioning the device element which incorporates the device of horns and the words "fratelli la bufala" are the dominant elements of Emme's trade mark.

35. Buffalo's trade mark also consists of a number of elements. Insofar as the words BUFFALO GRILL are concerned, I am aware that Buffalo meat now appears on the menus of a number of restaurants and that the word grill is commonly used to refer to a restaurant that serves grilled food. In those circumstances, the words BUFFALO GRILL appearing in Buffalo's trade mark may be construed by the average consumer as a reference to an establishment specialising in buffalo meat, with the device of what Emme describe as "highly stylised" horns likely to support that assumption. However, the presentation of Buffalo's trade mark in which the words BUFFALO GRILL appear as a central element linking the stylised device of horns appearing on either side of the words is, I think, somewhat unusual. In my view, both elements i.e. the stylised device of horns and the words BUFFALO GRILL are equally dominant and contribute equally to the trade mark's overall distinctive character.

Visual similarity

36. Ms Lorimer says:

"We submit that when viewed by the eye the mark opposed and the earlier registration are confusingly similar, both sharing the common prominent feature of a set of horns and the words BUFFALO and BUFALA. Both marks have been arranged such that the elements they contain form the shape of the head of a bull."

37. Both trade marks contain devices of horns (which although represented differently are, in my view, still reasonably similar) and either a device or words placed where one might expect to find the head of a horn bearing animal. In addition, the respective trade marks contain either the word BUFFALO or bufala, which again, in my view, share a reasonable degree of visual similarity. When considered overall, the distinctive and

dominant elements of the respective trade marks are, in my view, visually similar to a reasonable degree.

Aural similarity

38. Ms Lorimer says:

“When spoken we submit that both of the marks have a common element, BUFFALO/BUFALA. The mark opposed is likely to be verbalised as “Fratelli la Bufala”, whilst the earlier right as “Buffalo Grill.” The words Buffalo/Bufala which are the dominant elements of the two marks are aurally very similar. The words have the identical primary portion “buffal-“, varying only in the last vowel “-o” or “a”.

39. As both trade marks contain word elements, I agree that it is unlikely that the average consumer would resort to referring to the trade marks by reference to the device elements appearing in them. In my view it is much more likely that the average consumer will refer to both trade marks by the word elements present in each. I also agree that both trade marks will be referred to in the manner Ms Lorimer suggests (I very much doubt given the presence of these distinctive and dominant elements that the average consumer would refer to Emme’s trade mark by the words pizzaioli emigranti). Notwithstanding these conclusions there is, in my view, only a very low degree of aural similarity between the words BUFFALO GRILL and fratelli la bufala.

Conceptual similarity

40. Ms Lorimer says:

“We submit that the mark opposed and the earlier registration are conceptually confusingly similar as the prominent feature of both of the marks concerned is a set of horns and elements arranged to represent the shape of the head of a bull. Both marks contain the very similar words “Buffalo” and “Bufala”. Both marks have been designed to lead the mind of the viewer to cattle and related produce.”

41. I agree with Ms Lorimer that the presence of the distinctive and dominant device element in Emme’s trade mark and the presentation of the elements in Buffalo’s trade mark are likely to create a similar conceptual image in the mind of the average consumer i.e. the head of a horned animal. I am less convinced that when considered in isolation the average consumer would make any conceptual link between the words BUFFALO and bufala appearing in the respective trade marks. However, when considered as part of Emme’s trade mark (in particular the device of horns), I am inclined to agree that the visual similarities between the English word Buffalo (and what I assume is its Italian counterpart bufala) may trigger similar conceptual images in the mind of the average consumer.

Distinctive character of Buffalo's earlier trade mark

42. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In my assessment of the distinctive and dominant elements of Buffalo's trade mark I came to the conclusion that while the words and device both carry descriptive overtones, the manner in which the various elements were arranged was somewhat unusual and lent the mark as a whole a degree of distinctive character; that was of course a prima facie assessment. However, as indicated above Buffalo have used their trade mark extensively since it was first adopted in 1980, and although the evidence of use provided by them has many failings, I have little doubt that their use in the hundreds of restaurants mentioned above will have built on their trade mark's inherent distinctive character. In short, I am satisfied that when considered at the date at which Emme requested protection i.e. 29 January 2008, Buffalo's trade mark is likely to have achieved a high level of acquired distinctive character.

Likelihood of confusion

43. 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 Buffalo'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 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.

44. Earlier in this decision I concluded that: (i) the services at issue were identical, (ii) the average consumer for such services was the public at large, (iii) while the average consumer is most likely to select the services by visual means, given the nature of the services at issue aural considerations will also feature in the selection process, and (iv) that the degree of care taken when selecting the services is likely to vary from minimal to reasonably high. When comparing the distinctive and dominant elements of the respective trade marks, I concluded that there was a reasonable degree of visual similarity, a very low degree of aural similarity and that the respective trade marks were

likely to trigger similar conceptual images in the mind of the average consumer. Finally, I concluded that Buffalo's trade mark was as a result of its use since 1980 likely to be possessed of a high level of acquired distinctive character.

45. I must now apply the global approach advocated to my findings to determine whether direct confusion (where one trade mark is mistaken for the other) or indirect confusion (where the services would be assumed to come from economically linked undertakings) is likely to occur. Having done so, and bearing in mind the traits of the average consumer when selecting the services at issue, I have come to the conclusion that the reasonable degree of visual similarity between the respective trade marks and the similar conceptual images the respective trade marks are likely to trigger in the mind of the average consumer, together with the identity in the services and the high level of acquired distinctiveness Buffalo's trade mark is likely to possess are, when considered as a totality, likely to combine to create a likelihood of confusion. In reaching this conclusion the differences in the respective trade marks are, I think, likely to avoid direct confusion. More likely, in my view, is that the similar visual and conceptual imagery shared by the respective trade marks will combine to lead the average consumer to assume that Emme's trade mark is a variation of Buffalo's trade mark such that the parties share an economic link.

46. In summary, the opposition has been successful and Emme's request to extend their IR will be refused.

Costs

47. As Buffalo have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Buffalo on the following basis:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Evidence:	£500
Total:	£900

48. I order EMME SEI S.P.A. to pay to Buffalo Grill the sum of £900. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26 day of October 2010

**C J BOWEN
For the Registrar
The Comptroller-General**