

**O-264-17**

**TRADE MARKS ACT 1994**


**IN THE MATTER OF REGISTRATION Nos. 3120192 & 3123434  
STANDING IN THE NAME OF  
SALIMA VELLANI**

**AND**

**IN THE MATTER OF A REQUEST FOR A DECLARATION  
OF INVALIDITY THERETO UNDER Nos.501157 & 501158  
BY DIRTYBIRD RESTAURANTS LIMITED**

## BACKGROUND

1) The following trade marks are registered in the name of Salima Vellani:

Mark	Number	Filing & registration date	Class	Specification
 <p>A series of four marks</p>	3120192	30.07.15 16.10.15	25	Clothing
			43	Services for providing food and drink; bar and catering services.
Absurd Bird	3123434	21.08.15 13.11.15	9	Computer games, computer software, mobile phone application.
			25	Clothing.
			28	Games.
			43	Services for providing food and drink; restaurant, bar and catering services.

2) By applications dated 9 March 2016 Dirtybird Restaurants Limited (hereinafter DR) applied for a declaration of invalidity in respect of this registration. The grounds are, in summary:

a) DR is the registered proprietor of the following trade mark:

Mark	Number	Filing & registration date	Class	Specifications relied upon
BIRD	3035551	19.12.13 05.02.16	43	Restaurant services.

- b) DR contends that the class 43 services are similar to the class 43 services for which the mark in suit is registered. It contends that the marks are highly similar as the opponent's mark appears in the mark in suit, and that the services of the two parties are identical. The mark in suit offends against Section 5(2)(b) of the Trade Marks Act 1994 ("the Act").
- c) DR contends that it has used the mark Bird in respect of "restaurant services; provision of food and drink" since May 2014 and had considerable goodwill in the BIRD mark. DR contends that use of the mark in suit will cause misrepresentation and damage through loss of sales or detriment to the repute and distinctive character of its marks. The mark in suit therefore offends against section 5(4)(a) of the Act.

3) Ms Vellani provided a counterstatement covering both invalidity actions, dated 17 May 2016, in which she claims to have created her brand in Dubai in 2013. It is also claimed that DR only opened its first restaurant in Shoreditch in May 2014, its second in Islington in October 2015 and its third in Camden in November 2015. She denies that DR has any reputation or goodwill in the mark BIRD in regard to the services listed as it is claimed that they only sell fried chicken and doughnuts. She denies that her marks offend against Sections 5(2)(b) and 5(4)(a).

4) Both sides filed evidence. Both sides ask for an award of costs. The matter came to be heard on 2 May 2017 when Mr Aikens of Counsel, instructed by Messrs Dollymores represented DR; Ms Vellani was represented by Ms Chantrielle of Counsel instructed by Messrs Underwood Solicitors LLP.

### **DR's Evidence**

5) DR filed a witness statement, dated 18 August 2016, by Paul Hemmings, a Director of DR, a position he has held since July 2013. He states that the first restaurant in Shoreditch opened on 28 April 2014. He states that in the period 28 April 2014 to 30 July 2015 his company's sales totalled £1,139,280. He states that his company has since March 2014 owned the domain name [www.birdrestaurants.com](http://www.birdrestaurants.com) and has operated a website which he claims shows use of the mark BIRD. However, I note that the exhibit PH2 provided shows a device mark being used as shown below in Annex A. At exhibit PH3 he provides photographs of the

restaurant exterior, interior and items such as napkins which all use the device element shown at annex A, which are undated. Mr Hemmings states that his company served over 75,000 customers in Shoreditch during the period 28 April 2014 to 30 July 2015, and also had a stand at the Lovebox Festival in London in July 2015. The photographs of DR's stand at the festival only shows use of the device at annex A. He states that almost 130,000 people have visited his company's website. At exhibit PH6 he provides numerous copies of pages from the London Evening Standard and Metro which reference his company's restaurants and which are dated prior to 30 July 2015. Mr Hemmings states that DR spent approximately £45,000 prior to 30 July 2015 on advertising, and at exhibit PH8 provides copies of flyers which were distributed. These show use of the device element at annex A. He states that DR has also used social media to promote its brand, has a number of followers on Twitter, Facebook and Instagram (approximately 10,000 in total) and has been mentioned by others on their social media sites. He also points out that Shoreditch is in Hackney which has almost 270,000 inhabitants.

### **Ms Vellani's Evidence**

6) Ms Vellani provided a witness statement, dated 20 October 2016. She states that she created the mark and back story for the brand in 2013, and registered domain names absurd-bird.com and absurd-bird.org in December 2013. She provides numerous details regarding the branding, and photographs showing use post July 2015 which are not relevant to my decision. Also included is "state of the register" evidence which is also of no assistance to my decision.

### **DR's Evidence in reply**

7) DR filed a second witness statement by Paul Hemmings, dated 21 December 2016. At exhibit PH12 he provides a photograph of the entrance to the Absurd Bird restaurant and claims that the colour of the awning is such that the word "ABSURD" is not visible. I note that whilst the word "ABSURD" cannot be seen on the awning, the photograph is in black and white and the angle at which it is taken may also have played a part in obscuring the word. At exhibit PH13 he provides a copy of a Google map which shows the restaurants of the two parties being less than a mile apart.

## **Ms Vellani's Evidence in reply**

8) Ms Vellani provided a witness statement, dated 20 January 2017. She disputes the evidence of DR regarding the awning stating that the photograph shows an awning that was fitted prior to the opening of the restaurant and which was incorrectly designed. She refers to page 7 of exhibit SV6 provided with her earlier evidence which clearly shows the awning in full colour and the logo used is that shown in mark 3120192, and the words ABSURD BIRD can be clearly seen.

9) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## **DECISION**

10) The invalidity is brought under Section 47 of the Trade Marks Act 1994 ("The Act") which reads:

**"47. - (1)** The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

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

(2B) The use conditions are met if –

- (a) within the period of five years ending with the date of the application for the declaration 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) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Union.

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists 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.

(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.”

11) The first ground of invalidity is under Section 5(2)(b) which reads:

“5.-(2) A trade mark shall not be registered if because -

(a) .....

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

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

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

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

13) DR is relying upon its trade mark listed in paragraph 2 above which is clearly an earlier trade mark. As the earlier mark was registered in February 2016 the proof of use requirements do not apply.

14) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and



reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **The average consumer and the nature of the purchasing decision**

15) The invalidity action is only in respect of the class 43 services for which the mark is registered. 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. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

16) I must consider the class 43 services of both parties, which broadly speaking are the provision of food and drink. Such services are going to be purchased by the general public including businesses. Such consumers are likely, in my opinion, to select the services mainly by visual means, initially from an on-line search or advertisement, or the sign outside the facility. Once selected, even if the transaction is carried out on-line some consumers are going to take a degree of care in the selection the quality of the food and drink provided as allergies are quite common these days, also the level of hygiene could have an impact physically upon the consumer. However, I accept that some consumers will pay little attention if they do not have allergies. Whilst the visual issues are likely to be the most important I also must take into account aural issues as it is possible that word of mouth recommendations may play a part in the selection. As I have stated, the nature of the

services are such that the average consumer will pay a **low to medium degree of attention to the selection of such services.**

### **Comparison of services**

17) In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

18) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

19) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“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.”

20) The services of the two parties are:

Ms Vellani's services in Class 43	DR's services in class 43
3120192: Services for providing food and drink; bar and catering services.	Restaurant services
3123434: Services for providing food and drink; restaurant, bar and catering services.	

21) It is accepted by both parties that “Services for providing food and drink; restaurant services” in Ms Vellani’s specification are identical to that of DR’s “Restaurant services”. Ms Vellani contends that “bar and catering services” included in her specification is merely similar to DR’s services but provides no reason to explain this claim. Given that catering services equates to the provision of food it is difficult to see how this does not encompass restaurant services which by definition would include the provision of food. **I therefore find catering services identical to “restaurant services”**. Whilst I accept that the provision of restaurant services does not inevitably include bar services, it is, in my experience, extremely rare for such services not to be offered by a restaurant. **To my mind, “bar services” must be regarded as similar to at least a medium degree to DR’s services.**

### **Comparison of trade marks**


22) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

23) It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. As DR points out the applicant’s mark 3120192 is a series of four marks, and referred me to the comments of the Court of Appeal in *Comic Enterprises v Twentieth Century Fox* [2016] EWCA Civ 455; [2016] Bus LR 849 where Kitchen LJ stated at paragraph 58:

“In order to qualify as a series the trade marks must resemble each other in their material particulars. Any differences between the trade marks must be of a non-distinctive character and must leave the visual, aural and conceptual identity of each of the trade marks substantially the same. These matters must be assessed from the perspective of the average consumer of the goods or services in question.”

24) As a result of the above it is only necessary to consider one of the marks from the series of four and it is most sensible to choose the monochrome version, particularly as in two of the marks in the series the letters “A”, “S” and “U” in the word ABSURD are in a different colour and therefore give prominence to the word “BIRD” which would be detrimental to Ms Vellani. The trade marks to be compared are:

Ms Vellani’s trade marks		DR’s trade mark
3120192 	3123434 Absurd Bird	BIRD

25) DR contends:

“13. There is no material difference between the two Marks in terms of their dominant and distinctive elements. Each consists of the two words ‘Absurd’ and ‘Bird’. There are no non-word device elements in the Device Mark. It is therefore not necessary to distinguish between the two Marks when comparing them with the Applicant’s Mark.

14. The entirety of the Applicant’s Mark is contained within each of the Marks. Visually and aurally, the marks are similar at least to a medium degree. Conceptually, the marks are similar because the ‘Bird’ element that is common to all the marks would clearly be perceived as a noun with the same normal English meaning in each case, namely either (a) a particular class of animal or (b) a person of a specified kind or character, especially a young woman or girlfriend. The ‘Absurd’ element of the Marks would be perceived as an adjective describing a particular characteristic of the ‘Bird’.

15. Overall, therefore, the Marks are similar at least to a medium degree.”

26) Ms Vellani contended that the first element was particularly important and that in the instant case these were different. This is quite correct as in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court (GC) noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar."

27) I am also aware that in *Bristol Global Co Ltd v EUIPO*, T-194/14, the GC held that there was a likelihood of confusion between AEROSTONE (slightly stylised) and STONE if both marks were used by different undertakings in relation to identical goods (land vehicles and automobile tyres). This was despite the fact that the beginnings of the marks were different. The common element – STONE – was sufficient to create the necessary degree of similarity between the marks as wholes for the opposition before the EUIPO to succeed.

28) I shall firstly compare DR's mark to 3123434. Clearly, both are in a similar font, differences in upper and lower case do not form any part of my decision as they are regarded as the same. Visually there is an obvious difference as the word "Absurd" is the first element of Ms Vellani's mark although both marks have the word "Bird" in them. Aurally the same difference is present. Conceptually DR's mark is somewhat vague as the term "bird" covers a vast array of creatures from Sparrows to Flamingo's by way of puffins and ostriches. The average consumer will form an image in their mind of a form of bird when seeing the term. When seeing "Absurd bird" they will have an image of a ridiculous or ludicrous bird, but again nothing specific, although they may go to the more extreme avian species. The word "absurd" acts as an adjective to the word "Bird" so that whatever image the word "BIRD" conjures in the consumer's mind it is qualified by the term "absurd".

**Overall the marks are similar to a medium degree.**

29) I now turn to compare DR's mark to 3120192. The same considerations as outlined in the previous paragraph come into play. This time I do have to take into account the degree of stylisation within 3120192. Although the mark is quite stylised it still will be viewed by the average consumer as the words "Absurd Bird" written in a highly unusual or even "ridiculous" way. This feeds into the narrative of a ludicrous bird, but again is unspecific.

The stylisation is a factor I will take into account although it plays, in my view, a relatively minor role. **Overall, I consider the marks to be similar to a medium degree.**

### **Distinctive character of the earlier trade mark**

30) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

31) DR contends that its mark has been used extensively. However, I note that the mark actually used is not simply the word “BIRD” it is the device element shown at annex A. This includes as part of the letter “R” a device element which would appear to be a bird but the species is highly uncertain. Use of marks which differ from the mark registered has been considered by the Appointed Person in *Nirvana Trade Mark* (BL O/262/06) and by the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12. The question to be asked is whether that sign differs from the registered trade mark in elements which do not



alter the latter's distinctive character. To my mind despite the "get up" I accept that the mark used does not differ in elements which alter the distinctive character of the registered mark. Both the registered mark and the mark used are clearly "Bird" marks. The word "BIRD" has, as far as I am aware no particular meaning for restaurant or catering services as although most restaurants will serve birds as part of their menu, it is unusual to have nothing else other than birds on offer. Even fried chicken outlets offer items to eat other than chicken. Ms Chatrielle contended that the mark "BIRD" is common for restaurants/catering services and sought to rely upon the evidence of Ms Vellani. However, as this was only copies of the IPO/EUIPO registers showing marks with the word "BIRD" having been registered, without any evidence of use of these marks I do not accept this contention. Ms Chantrielle also contended that the word "BIRD" would conjure up an image of chicken, but clearly restaurants do not describe chicken dishes as "bird" dishes and also offer other birds such as quail, pheasant, partridge, grouse, pigeon, ostrich, puffin, goose, duck etc. **Overall DR's mark is inherently distinctive to a low to medium degree. Whilst DR has shown use of its mark it would appear to be limited to a relatively small area of London and the turnover figures, whilst perfectly respectable are, in the context of the UK market for restaurant/catering services, miniscule. The opponent cannot benefit from enhanced distinctiveness.**

### **Likelihood of confusion**

32) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade marks as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the services is a member of the general public including businesses who will select the services by predominantly visual means, although I

do not discount aural considerations and that they are likely to pay a low to medium degree of attention to the selection of such services.

- DR's mark is similar to both of Ms Vellani's marks to a medium degree.
- DR's mark has a low to medium level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- The following services of Ms Vellani's 3120192 mark are identical to DR's services under its mark 3035551: "Services for providing food and drink; catering services". Whilst "Bar services" are similar to a medium degree to DR's "restaurant services".
- The following services of Ms Vellani's mark 3123434 are identical to DR's services under its mark 3035551: "Services for providing food and drink; restaurant, catering services". Whilst "Bar services" are similar to a medium degree to DR's "restaurant services".

33) I must also consider the comments of Mr Iain Purvis Q.C. as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, where he noted that:

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

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(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).”

34) Ms Chantrielle contended that DR’s mark did not have a significant reputation as its use was of the device mark at annex A, which she contended would not be seen as a “bird” mark. Whilst I accept that the mark used has a degree of stylisation, to my mind, the distinctive element is the word “BIRD”. Doubt was also cast of the veracity of the evidence of DR. However, I note that this was not challenged in evidence and no request for cross examination was made. I accept that the evidence cannot be viewed uncritically, but provided that it is not “obviously incredible” then it should be accepted. In view of all of the above, and allowing for the concept of imperfect recollection, in respect of either of Ms Vellani’s marks there is a likelihood of consumers being indirectly confused into believing that the Class 43 services registered under marks 3120192 & 3123434 and provided by Ms Vellani are those of DR or provided by some undertaking linked to it. **The invalidity under section 5(2)(b) in respect of the class 43 services is successful.**

35) The only other ground of invalidity is under section 5(4)(a) and is in relation to the class 43 services for the two marks registered. Given the above finding I decline to consider the ground under section 5(4)(a).

## CONCLUSION

36) The invalidity action has succeeded in respect of all the class 43 services for which the two marks 3123434 and 3120192 were registered. As only the class 43 services were the subject of the invalidity action the marks will remain upon the register for the following goods and services.

**3123434:** Class 9: Computer games, computer software, mobile phone application.

Class 25: Clothing.

Class 28: Games.

**3120192:** Class 25: Clothing.

## COSTS

37) As DR has been successful it is entitled to a contribution towards its costs. Ms Vellani requested that I took into account the conduct of DR in the instant case. It is alleged that procedures were not adhered to and that additional costs were unnecessarily incurred in respect of the evidence of DR regarding the awning outside of Ms Vellani's restaurant. I have made a minor adjustment to the costs awarded to take these actions into account.

Preparing a statement and considering the other side's statement	£300
Expenses	£200
Preparing evidence and considering the other side's	£400
Attending the hearing	£600
TOTAL	£1500

38) I order Salima Vellani to pay Dirtybird Restaurants Limited the sum of £1,500. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 2<sup>ND</sup> day of May 2017**

**G W Salthouse**

**For the Registrar**

**the Comptroller-General**

ANNEX A

