

O-682-18

TRADE MARKS ACT 1994

IN THE MATTER OF:

TRADE MARK APPLICATION Nos. 3238196 & 3238199

BY AT PIZZA LIMITED

**TO REGISTER THE FOLLOWING
TRADE MARKS**



IN CLASSES 25, 30, 32 AND 43

And



IN CLASSES 25, 32 AND 43

AND

OPPOSITION THERETO (Nos. 410402 & 410405)

BY IMAPIZZA LLC

Background and pleadings

1) These consolidated proceedings involve oppositions against the following two trade mark applications, both filed in the name of AT PIZZA LIMITED ('the applicant'). Pertinent details of the applications are as follows:



Number: 3238196 ('196' mark)

Date of filing: 19 June 2017

Publication date: 30 June 2017

Goods/services being opposed:

Class 25: Clothing; footwear; headgear.

Class 30: Flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, yeast, baking powder, salt, mustard; vinegar, condiments, sauces, spices and seasonings; rolls, biscuits, breads, cakes, rice; pizza; pizza sauces; pizza crusts; pizza dough; pasta and prepared pasta entrees; salad dressings.

Class 32: Squashes; carbonated non-alcoholic drinks; mineral and aerated waters; fruit drinks and fruit juices, slush drinks, syrups and other preparations for making beverages.

Class 43: Restaurant services; snack bar services, café services, canteens and fast-food outlets, catering services.



Mark:

Number: 3238199 ('199' mark)

Date of filing: 19 June 2017

Publication date: 30 June 2017

Goods/services being opposed:

Class 25: Clothing; footwear; headgear.

Class 32: Squashes; carbonated non-alcoholic drinks; mineral and aerated waters; fruit drinks and fruit juices, slush drinks, syrups and other preparations for making beverages.

Class 43: Restaurant services; snack bar services, café services, canteens and fast-food outlets, catering services.

2) On 29 September 2017, ImaPizza LLC ('the opponent') opposed the applications. The '199 mark is opposed on the basis of Section 3(1)(a) and (b) of the Trade Marks Act 1994 ('the Act'). The opposition is against all of the applied for goods and services. The opponent claims:

Section 3(1)(a): There is no element of the application which is distinctive, meaning that it is incapable of functioning as an indicator of origin. Therefore, the sign for which registration has been sought is open to objection under Section 3(1) because it does not satisfy the requirements of Section 1(1).

Section 3(1)(b): Under section 3(1)(b) it claims that that the application is devoid of distinctive character for the applied for goods and services. It claims that the 'at' symbol is used on many social networking platforms, where it serves a technical function, namely providing the users of these platforms with direct links to the social networking platforms of others. Further, it is argued that the application has minimal stylisation which is insufficient to warrant registration as it does not provide the sign with distinctive character.

3) The '196 application is opposed on the basis of sections 3(1)(a), (b) and 5(2)(b) of the Act. The section 3(1)(a) claim is on the same basis as outlined above in relation to the '196 application. The section 3(1)(b) and 5(2)(b) objections against the '196 application are as follows:

Section 3(1)(b): The word PIZZA is not distinctive in relation to any of the goods and services for which registration is sought. It is directly descriptive for

all the services in Class and for 'pizza, pizza sauces, pizza crusts, pizza dough' listed in class 30, but it is also not distinctive for the remaining goods in class 30 and the goods in class 25 and 32, all of which are, or might be, sold in or by the restaurants, etc listed in class 43.

4) The section 5(2)(b) claim is against classes 30, 32 and 43 and is on the basis of the following earlier right. It claims that its earlier registration is confusingly similar to the application:

&pizza

Mark:

European Union trade mark ('EUTM') number: 15141872

Filing date: 24 February 2016

Date of entry in register: 26 April 2018

Relied upon goods:

Class 30: Beverages made of tea; Candies; Candy; Coffee; Ice cream desserts; Iced tea; Instant tea; Salad dressings; Tea; Tea bags.

Class 32: Apple juice beverages; Bottled water; Carbonated waters; Fruit drinks and fruit juices; Grape juice; Italian soda; Mineral water; Mixed fruit juice; Non-alcoholic fruit juice beverages; Non-alcoholic sparkling fruit juice beverages; Orange juice; Pineapple juice beverages; Soda water; Soft drinks, namely, sodas; Syrups for making flavoured mineral waters; Tomato juice beverages.

5) The applicant filed a counterstatement denying the claims made. With regard to the defence of its '199 application, the applicant states 'that it is not seeking registration for social media or social networking goods or services, but for clothing, food, drink and catering services. The prevalence or otherwise of the symbol '@' in social media does not prevent its use in a sign to indicate trade origin for such goods and services.' Further, the applicant states that the mark was produced on its behalf by a designer who 'created a design document that sought to demonstrate a very simplified 4 stage process using illustrator of how the '@' was created for the

Applicant starting with a series of circles and manipulating them to develop an '@ sign'.

6) With regard to the '196 application the applicant relies on the same arguments made above in relation to the '199 mark. Further, it argues that 'the combination of the symbol '@' and the word 'pizza' as an indication of trade origin, has a degree of distinctiveness.'

7) In respect of the section 5(2)(b) claim, the applicant denies that there is a likelihood of confusion. It argues that the marks are not sufficiently similar and, save for 'salad dressings', none of the goods or services are identical.

8) Neither side filed evidence in these proceedings. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision.

9) A hearing took place on 3 August 2018, with the opponent represented by Mr Zweck of counsel, instructed by Lawdit Solicitors Limited and the applicant by Mr Norris of counsel, instructed by Creation IP Limited.

DECISION - Section 3(1)(a)

10) Section 3(1)(a) of the Act states:

“3(1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1),

(b),

(c) ...,

(d) ...:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

11) Section 1(1) of the Act states:

“1.—(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

12) Strictly speaking, there is no need for me to decide whether this ground succeeds or fails. As Mr Geoffrey Hobbs Q.C., as The Appointed Person pointed out in *AD2000 Trade Mark*¹, s.3(1)(a) permits registration provided that the mark is ‘capable’ to the limited extent of “*not being incapable*” of distinguishing. Consequently, if I am satisfied that the mark complies with s.3(1)(b) of the Act, the ‘incapable of distinguishing’ objection under section 3(1)(a) is bound to fail. Alternatively, if the ground under section 3(1)(b) succeeds, the outcome under section 3(1)(a) becomes moot. However, for the sake of completeness, I set out here, briefly, why the ground fails, regardless of the ground under section 3(1)(b) of the Act.

13) In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418(Ch), Arnold J said:

“44. ... As I discussed in *JW Spear & Sons Ltd v Zynga Inc* [2012] EWHC 3345 (Ch) at [10]–[27], the case law of the Court of Justice of the European Union establishes that, in order to comply with art.4 , the subject matter of an application or registration must satisfy three conditions. First, it must be a sign. Secondly, that sign must be capable of being represented graphically.

Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

¹ [1997] RPC 168

45. The CJEU explained the third condition in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-1619 as follows:

"80. As a preliminary point, it is appropriate to observe, first, that the purpose of Article 2 of the Directive is to define the types of signs of which a trade mark may consist (Case C-273/00 *Sieckmann* [2002] ECR I-11737, paragraph 43), irrespective of the goods or services for which protection might be sought (see to that effect *Sieckmann*, paragraphs 43 to 55, *Libertel*, paragraphs 22 to 42, and Case C-283/01 *Shield Mark* [2003] ECR I-0000, paragraphs 34 to 41). It provides that a trade mark may consist inter alia of 'words' and 'letters', provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

81. In view of that provision, there is no reason to find that a word like 'Postkantoor' is not, in respect of certain goods or services, capable of fulfilling the essential function of a trade mark, which is to guarantee the identity of the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (see, in particular, Case C-39/97 *Canon* [1998] ECR I5507, paragraph 28, *Merz & Krell*, paragraph 22, and *Libertel*, paragraph 62). Accordingly, an interpretation of Article 2 of the Directive appears not to be useful for the purposes of deciding the present case."

46. The Court went on to say that the question whether POSTKANTOOR (Dutch for POST OFFICE) was precluded from registration in respect of particular goods and services (i.e. those provided by a post office) because it was devoid of distinctive character and/or descriptive in relation to those particular goods and services fell to be assessed under Article 3(1)(b) and (c) of the Directive (Article 7(1)(b) and (c) of the Regulation).

47. It follows that "the goods or services" referred to in Article 4 are not the

particular goods or services listed in the specification, as counsel for the defendants argued. Rather, the question under Article 4 is whether the sign is capable of distinguishing any goods or services.”

14) Article 4 of Regulation 207/2009 of 26 February 2009 on the Community trade mark (codified version) is the equivalent to section 1(1) of the Act, set out above. The applications are not incapable of distinguishing any goods. It follows from this authority that the ground of opposition against each of the applications under section 3(1)(a) must fail.

DECISION - Section 3(1)(b)

15) Having considered the section 3(1)(a) objection against each of the applications, I shall now assess the section 3(1)(b) claim beginning with the ‘199 application. Section 3(1)(b) of the Act states:

“3(1) The following shall not be registered –

(a) ...,

(b) trade marks which are devoid of any distinctive character,

(c) ...,

(d) ...:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

16) The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the

purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).


30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

17) I begin by reminding myself of the mark in question and the goods which are being opposed. The applicant has not filed evidence, or claimed that it has acquired distinctive character by virtue of the use made of it. Therefore, I must assess the inherent distinctive character of the mark.

The '199 mark	Goods and services
	<p><i>Class 25: Clothing; footwear; headgear.</i></p> <p><i>Class 32: Squashes; carbonated non-alcoholic drinks; mineral and aerated waters; fruit drinks and fruit juices, slush drinks, syrups and other preparations for making beverages.</i></p> <p><i>Class 43: Restaurant services; snack bar services, café services, canteens and fast-food outlets, catering services.</i></p>

18) It is not in dispute that since there is no claim to acquired distinctiveness (particularly since there is no evidence filed), the relevant date for the purpose of assessing the opponent's section 3 claims is the date of filing of the application, i.e. 19 June 2017.

Opponent's arguments

19) The opponent makes numerous arguments as to why the application is devoid of any distinctive character and that it should consequently be refused registration. I shall address these in turn.

Social media functional symbol

20) The opponent argues that despite the application being stylised, it would be perceived as an '@' symbol. It states that in recent years it has developed into an essential function tool used in email addresses and social media. In the opponent's skeleton argument it states that the symbol followed by text or a username is referred to as a Twitter handle and is the way of identifying and searching for people, businesses, topics of discussion, etc. It claims that it is also commonly used on other

social media with the same or similar functionality often to join a conversation or to identify someone or something. In view of this purely functional use, the opponent claims that it cannot act as a commercial indication of origin.

21) In support of this argument the opponent refers to UK Trade Mark Manual guidance on top level domain names which states:

“Domain names

General guidance

Generic individual elements of top level domains (gTLDs) such as ‘.com’ or ‘.co.uk’ (whether a prefix or a suffix) are considered to be totally non-distinctive. However, domain names presented in their entirety (e.g. ‘www.ipo.gov.uk’ or ‘ipo.gov.uk’) can be registered as trade marks provided they are distinctive in totality. As a general rule, one should consider whether the remainder of the mark (i.e. the elements other than ‘www’, ‘.com’ or ‘.co.uk’ etc.) is descriptive or non-distinctive. If so, there is likely to be an objection under sections 3(1)(b) and (c). For example, the signs ‘cars.com’ and ‘www.soap.com’ would be unacceptable as they merely describe the provision of cars and soaps via the Internet.”

22) The Manual goes on to state (which was not referred to by the opponent):

“In PHOTOS.COM (C-70/13), the following was stated at paragraph 25:

“However, in paragraphs 24 to 28 of the judgment under appeal, the General Court held as follows:

It is appropriate to examine the word sign PHOTOS.COM as a whole. According to settled case-law, the distinctiveness of trade marks composed of words and a typographical sign, such as that at issue in the present proceedings, may, in part, be assessed by examining each of its terms or elements, taken separately, but must in any event depend on an appraisal of the composite whole. The mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that in

combination they cannot present a distinctive character (see [judgment of 12 December 2007 in Case T- 117/06 DeTeMedien v OHIM (suchen.de)], paragraph 31 and the case-law cited).

The parties agree on the fact that the word mark PHOTOS.COM, considered as a whole, reproduces the characteristic structure of a second-level domain name (“photos”) and a TLD [top level domain] (“com”), separated by a dot. As the Board of Appeal pointed out, that mark has no additional features – in particular, graphic features – because the dot is typically used to separate the second level domain from the TLD.

26 Furthermore, the addition of the element “.com” to the word “photos”, which is descriptive and devoid of distinctive character, does not render the sign distinctive as a whole. As the Board of Appeal pointed out, the distinctive part of a domain name is not the TLD, which is generic, but the second-level domain – which, in the present case, is devoid of distinctive character.

27 Additionally, it is important to note that, even if the registration of a sign as a Community mark is not conditional upon a finding of a certain level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark, the fact remains that – as the Board of Appeal found – there is no additional element to support the conclusion that the combination created by the commonplace and customary components “photos” and “.com” is unusual, fanciful or might have its own meaning, especially in the perception that the relevant public might have of the goods and services concerned (see, to that effect, [DeTeMedien v OHIM], paragraph 32).

28 Accordingly, in the absence of special characteristics peculiar to the sign at issue, the relevant public’s perception of that sign will be no different from its perception of the combination of the two words comprising the sign. It follows that, as the Board of Appeal rightly pointed out, the relevant public will not be able to distinguish the goods and services covered by the trade mark application from goods and services of a different commercial origin. Consequently, the sign is devoid of distinctive character.”

The addition of '.com' or '.co.uk' to words which describe characteristics of the goods or services (as opposed to describing the generic name of the goods themselves), will usually be sufficient to bestow distinctive character upon the mark in totality. For example, even though the phrase 'Twist and Seal' is itself likely to be objectionable for storage jars on the basis of it describing a characteristic of the goods (i.e. storage jars with a 'twist and seal' action), the addition of an URL suffix such as '.com' is likely to give the resulting sign i.e. 'www.twistandseal.com' in its totality a trade mark character."

23) In the applicant's skeleton argument, which was emphasised further at the hearing, it argues that:

'The principle contention of the Opponent...is that the '@' symbol is too ubiquitous on social media to allow it to be commandeered for exclusive use in any category of goods or services by a given party'. Para 20 'However, that is not what the @ Mark does. Leaving aside the issue of stylisation for the moment, it is telling that the Opponent has not illustrated its submissions with examples, because doing so demonstrates that the sign 's', even without stylisation, is not used on social media as a generic indication referring to a certain type of goods, or in such a way that allowing registration of it would amount to registration of a generic symbol incapable of differentiating those goods...the way in which '@' is used in the world is in the context of e-mail addresses, Twitter handles and Facebook handles, which could take the following forms, by way of example:

- (1) Joe.bloggs@domain.com (e-mail address)
- (2) @joebloggs (individual's handle)
- (3) @domain (company's handle)

Para 21 It is evident when considering this usage that the registration of '@' would not have the effect of commandeering the use of the sign for exclusive use in any category of goods. To the contrary, the average consumer would see '@' (pronounced 'at' when spoken) as a very unusual sign when used alone as a sign divorced from an e-mail address or Twitter/Facebook handle, and

the mark would therefore have a high level of distinctive character, even without stylisation.’

24) It must be noted at this point that neither party has filed evidence. The opponent has not filed evidence to support the arguments that it raises, notably not just how the @ symbol is used but the perception of the relevant public. Therefore it is seeking to rely upon my own knowledge and experience, and relying on my taking judicial notice of the use made of the @ symbol. In *Chorkee Ltd v Cherokee Inc.*, Case BL O/048/08, Ms Anna Carboni as the Appointed Person described the limits to which judicial notice can be used in order to find that the average consumer is aware of particular facts. She said:

“While the Applicant contended in its Counterstatement that the earlier marks would be recognised to refer to the Cherokee tribe and that the tribe was well known to the general public, no evidence was submitted to support this. By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are.”

25) In that case she found that although the hearing officer was entitled to take judicial knowledge of the fact that CHEROKEE was the name of a tribe of native Americans, he was not entitled to attribute this knowledge to the average UK consumer of clothing. I accept that the ‘@’ sign is universally recognised as appearing in all emails. It is preceded by the specific name or address of the recipient (this is known as the ‘local-part’), then the ‘@’ symbol followed by the domain which is in effect the ‘mailbox’ which the email would be sent. I also accept that it is used in social media, in particular Twitter. However, I am unclear on what impact this has on the relevant public. I shall address this in more detail later in this decision.

Stylisation

26) The applicant does not appear to dispute that the application would be perceived as the '@' symbol. However, it argues that the application has 'a significant degree of stylisation' which Mr Zweck describes in his skeleton argument as: '1) The overall shape of the 'a' shape and extending circles is peculiar, featuring pronounced 'flat' vertical and horizontal sections in addition to the curved sections, 2) The mark features a distinctive segmented presentation, which might be perceived either as two separate sections or a single section broken up by a white dividing line.'

27) Mr Zweck states that the overall impression of the mark is such that it exhibits sufficient 'surplus' and that it has the 'minimum degree of distinctive character' to cross the threshold of distinctiveness as set out in the *Das Prinzip Der Bequemlichkeit C-64/02P* and *Eurocool Logistik GmbH & Co. KG v OHIM ('EUROCOOL')* [2003] ETMR 4.

28) The opponent argues that 'No party is free to commandeer the '@' symbol as exclusively their own through slight stylisations.' During the hearing Mr Norris compared the stylisation to the 'classic example' of the 'figleaf' of distinctiveness cited by Mr Justice Arnold in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2013] F.S.R. 29 where he held 'Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative figleaf of distinctiveness, and refuse registration of such marks in the first place'.

29) In *Starbucks v BSB*, Arnold J. held that a descriptive word with a minor figurative embellishment was, as a whole, devoid of any distinctive character. He found that:


"116. Taking all of the evidence into account, I conclude that the CTM is precluded from registration by art.7(1)(c) in relation to the services in issue because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the service. The figurative elements of the CTM do not affect this conclusion. In the alternative, if the inclusion of the figurative elements means that the CTM does not consist exclusively of the unregistrable word NOW, I


consider that the CTM is devoid of distinctive character and thus unregistrable by virtue of art.7(1)(b).


117. I would comment that it appears to me that PCCW only succeeded in obtaining registration of the CTM because it included figurative elements. Yet PCCW is seeking to enforce the CTM against signs which do not include the figurative elements or anything like them. That was an entirely foreseeable consequence of permitting registration of the CTM. Trade mark registries should be astute to this consequence of registering descriptive marks under the cover of a figurative figleaf of distinctiveness, and refuse registration of such marks in the first place.”

30) A similar point arose in *Thomas Pink Ltd v Victoria’s Secret UK Ltd*, [2014] EWHC 2631 (Ch), when Birss J. found that the registration of the descriptive word PINK (for clothing) with the letters in the colour pink, and in a unique form of script, and within a rectangular box, did not prevent the mark being *prima facie* unregistrable under s.3(1)(c). In the alternative, the mark was excluded by s.3(1)(b). See also the judgment of the General Court in *Spirig Pharma v EUIPO*, Case T-261/15.



31) The mark in question in the Starbucks case was . In that instance Arnold J. found the sign to be descriptive for the applied for goods and services, mainly telecommunication type goods and services.

32) I am of the view that the application, the subject of this opposition, is distinguishable from the  mark before Arnold J. Firstly, the aforementioned mark was considered descriptive for the services it was applied for, namely telecommunication and broadcasting type services ‘because NOW would be understood by the average consumer as a description of a characteristic of the service, namely the instant, immediate nature of the services.’ In the present case,

the application  is for classes 25 (clothing, footwear, headgear), 32 (various non-alcoholic beverages) and 43 (provision of food and drink type services). These

are not goods or services which the @ sign is used in a technical or functional manner. There is no evidence to support this view and even from my own knowledge and experience I do not consider this to be the case. Secondly, I consider there to be a greater degree of stylisation in the application than the ‘figleaf’ of stylisation used on the ‘NOW’ mark. For these reasons, I find that the present case to be distinguishable from the conclusions drawn by Arnold J., though, of course, I hold firmly in mind the legal principles set out.

German trade mark decision

33) The opponent also seeks to rely upon a decision issued by the German Federal Patent Court to refuse an application to register the mark ‘@’. The application was for various goods in classes 25, 29, 30, 32, 33 and 34. As highlighted in the applicant’s submissions of 4 June 2018, and acknowledged during the hearing by Mr Norris, this decision is not binding on me. Notwithstanding this, the applicant states that the ‘@’ symbol before the German is distinguishable from the mark in question since the former mark is non-stylised whereas the mark I have before me is. For these reasons, I do not find the decision to be of any assistance or persuasive value.

Assessment

34) The distinctive character must be assessed, firstly, by reference to the goods or services which registration is sought. As already stated above, the goods and services in question in this case are clothing, footwear, headgear in class 25, various non-alcoholic beverages in class 32 and the provision of food and drink type services in class 43. The relevant public for these goods and services are the general public who are considered to be reasonably well-informed and reasonably observant and circumspect.

35) The applicant’s main argument is that the @ symbol is widely used and recognised as having a technical function. It states that it is widely used in social media, in particular Twitter, and in view of this it would not denote trade origin. Whilst I am, of course, aware of email and Twitter use of the @ symbol, there is no evidence demonstrating the potential impact on the general public. Use of the ‘@’

symbol without preceding name and followed by the web address would not be viewed as an email address. Notwithstanding this, the application is not for any electronic, telecommunication, broadcasting or social media type goods or services. It has been applied for ‘non-electronic’ goods and services which you would not expect to have a technical function.


36) As I have already stated, I consider the mark’s stylisation to endow it with some distinctive character and it is most certainly more stylised than the ‘NOW’ mark. I am conscious and astute to the consequence of registering descriptive marks (in this case it is claimed to be devoid of distinctive character) under the cover of a figurative ‘figleaf’ of distinctiveness. However, in this instance I do not consider the mark to be descriptive (or in this instance devoid of distinctive character) for the goods and services in question. Therefore, the application is inherently distinctive for the applied for goods and services.

Section 3 conclusion for the ‘199 application

37) Both the section 3(1)(a) and (b) objections fail.

DECISION – section 3(1)(b)

38) I now turn to the opposition against the ‘196 mark and remind myself of the mark and goods which the application covers:

The ‘196 mark	Goods and services
	<p><i>Class 25: Clothing; footwear; headgear.</i></p> <p><i>Class 30: Flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, yeast, baking powder, salt, mustard; vinegar, condiments, sauces, spices and seasonings; rolls, biscuits, breads, cakes, rice; pizza; pizza sauces; pizza crusts; pizza dough; pasta and prepared pasta entrees; salad dressings.</i></p>

	<p><i>Class 32: Squashes; carbonated non-alcoholic drinks; mineral and aerated waters; fruit drinks and fruit juices, slush drinks, syrups and other preparations for making beverages.</i></p> <p><i>Class 43: Restaurant services; snack bar services, café services, canteens and fast-food outlets, catering services.</i></p>
--	--

39) I shall not repeat the section 3(1)(b) case law here (paragraph 16 above refers) but confirm that I shall bear it in mind when determining whether the application is devoid of distinctive character, or not.

40) Since the application includes the word ‘pizza’, which for many of the applied for goods and services is either descriptive of the goods themselves or a characteristic of the services, it is appropriate for me to group them into pizza and non-pizza goods and services. I shall begin with the ‘pizza’ related goods and services. These are:

Class 30: Pizza; pizza sauces; pizza crusts; pizza dough.

Class 43: Restaurant services; snack bar services, café services, canteens and fast-food outlets, catering services.

41) The opponent argues that ‘This mark suffers from the same problems as the ‘199 application but with the added problem that this functions as a Twitter handle for people looking for pizza. This would be a generic search tool for searching for a pizza vendor’. As I have previously stated, I do accept that the ‘@’ symbol is widely used in emails and that it is used on social media, in particular Twitter. I also accept that the ‘@’ symbol is used on Twitter which when followed by another word forms a unit. However, in the absence of evidence, I am unwilling to accept that the average consumer would perceive the symbol, followed by the word pizza, as being a list of pizza vendors. The goods are pizza type foodstuffs and the provision of food and drink, i.e. restaurant, café, fast-food, etc services and not social media, computer software or telecommunication services. Therefore, I do not accept the opponent’s argument, particularly since in the absence of evidence it is asking me to go beyond my own experience and knowledge. This view is supported by the relevant consumer

of the goods and services to be the general public of everyday consumables and users of food and drink outlets rather than technology based goods and services.

42) The opponent argues that the application is not distinctive particularly since one possible characteristic of the application is that it is descriptive. Mr Norris relies upon the *DOUBLEMINT case OHIM v Wm Wrigley Jr Company C-191/01 P*) which established that a descriptive indication does not cease to be objectionable because it also has non-descriptive meanings, or because that there are more usual ways of describing the goods or their characteristics. It is sufficient that the mark could be used as a descriptive indication of the goods/services (or their characteristics) in the future and would be understood as such by relevant consumers. Of course, in the present case the objection is not based on section 3(1)(c)². However, I must not dissect the application and focus on one particular element. I must assess relevant public's perception of the application as a whole, for the goods and services in question.

43) I have already stated that the '@' symbol is used in a social media context. However, I have also stated that in the absence of evidence I am unclear as to the perception that this has on the relevant public. There is also no evidence about the perception of an '@' symbol followed by the word pizza. Moreover, the application is noticeably stylised and the '@' symbol is larger in size than the word and the application is stylised. Whilst it is clear that the word pizza is descriptive for pizza and pizza related goods, I must assess the application as a whole. Taking all of the factors into consideration I find that the application is not devoid of distinctive character and does not fall foul of section 3(1)(b).

44) Since I have found that the application is not devoid of distinctive character and is not objectionable under section 3(1)(b) for goods and services which cover pizza or describe a characteristic of the services offered, it must follow that where the goods are not pizza related it also does not prohibit section 3(1)(b). Although 'pizza' is an easily understood, when applied to goods which are not pizza or are descriptive

² Section 3(1)(c) states '(1) The following shall not be registered – (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services'.

of the goods or services having a characteristic of pizza, then it is distinctive. Further, it is noted that the opponent has not offered any reason why the position should be different in respect of these goods. In fact, in the opponent's skeleton argument it states that 'Had the Applicant used a distinctive name rather than descriptor, then that mark could have been acceptable'.

45) For the reasons set out above, I find that the section 3(1)(b) objection also fails against the 'non-pizza' related goods.

Section 3 conclusions

46) For the reasons set out above, the sections 3(1)(a) and (b) oppositions filed against the '196 and '199 applications have failed.

DECISION – SECTION 5(2)(b)

47) Since the opposition has failed in respect of its section 3 grounds, I will now turn the section 5 objection. This is on the basis of the opponent's earlier

&pizza registration.

48) Section 5(2)(b) of the Act is 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”.

Case law

49) The following principles 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.

The principles

(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 goods and services

50) In the judgment of the Court of Justice of the European Union 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”.

51) 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 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.

52) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur 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”.

Applicant's goods and services	Opponent's
<i>Class 30: Flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, yeast, baking powder, salt, mustard; vinegar, condiments, sauces, spices and seasonings; rolls, biscuits, breads, cakes, rice; pizza; pizza sauces; pizza crusts; pizza dough; pasta and prepared pasta entrees; salad dressings.</i>	<i>Class 30: Beverages made of tea; Candies; Candy; Coffee; Ice cream desserts; Iced tea; Instant tea; Salad dressings; Tea; Tea bags.</i> <i>Class 32: Apple juice beverages; Bottled water; Carbonated waters; Fruit drinks and fruit juices; Grape juice; Italian soda; Mineral water; Mixed fruit juice; Non-alcoholic fruit juice beverages; Non-</i>

<p><i>Class 32: Squashes; carbonated non-alcoholic drinks; mineral and aerated waters; fruit drinks and fruit juices, slush drinks, syrups and other preparations for making beverages.</i></p>	<p><i>alcoholic sparkling fruit juice beverages; Orange juice; Pineapple juice beverages; Soda water; Soft drinks, namely, sodas; Syrups for making flavoured mineral waters; Tomato juice beverages.</i></p>
<p><i>Class 43: Restaurant services; snack bar services, café services, canteens and fast-food outlets, catering services.</i></p>	

Class 30

53) *Salad dressings* are identically included in the respective list of goods.

54) The opponent argues that when applying the *Meric* principle, the applied for *ices* are identical to *ice cream desserts*. I agree, they are identical.

55) I find that the applied for *condiments* and *sauces* are similar to the opponent's *salad dressings*. They are all goods which are used as an accompaniment to other foods. They would be sold in the same area of a supermarket and there is a degree of competition. They are similar to an average degree.

56) The remaining class 30 goods are not similar. These are: *Flour and preparations made from cereals, bread, pastry and confectionery; honey, yeast, baking powder, salt, mustard; vinegar, spices and seasonings; rolls, biscuits, breads, cakes, rice; pizza; pizza sauces; pizza crusts; pizza dough; pasta and prepared pasta entrees.*

Class 32

57) *Fruit drinks, fruit juices and mineral water* are identically included in both lists of goods.

58) The applied for term *carbonated non-alcoholic drinks* is identical to the earlier *carbonated waters*.

59) The applied for *squashes* are non-alcoholic concentrated syrups which are typically added to water to make a fruit flavoured drink. Applying the principle set out in *Meric*, I consider it to be included and therefore identical to *syrups for making flavoured mineral waters*.

60) Applying the principle set out in *Meric* I consider the applicant's *aerated waters* to be identical to the earlier *bottled water*.

61) The applied for *slush drinks* are flavoured drinks consisting of water, chipped ice and some form of syrup fruit flavouring. I consider them to be covered by, and therefore identical to, the earlier *non-alcoholic fruit juice beverages*.

62) The earlier *syrups for making flavoured mineral waters* are identical to the applied for *syrups for making beverages* and highly similar to the *other preparations for making beverages* since they have the same nature, purpose and users.

Class 43

63) During the hearing Mr Norris argued that when customers visit places to eat they are served the foodstuffs covered by the earlier registration and therefore there is similarity.

64) Services are different in nature to goods since they are tangible items whereas services are intangible. They also serve different needs. Further, they differ in purpose and method of use. There is an element of competition between the applicant's drinks in class 32 since a consumer may purchase a beverage as goods as an alternative to visiting premises where the beverage may be purchased and consumed. Further, the respective class 32 goods and applied for services overlap in channels of trade and there is a degree of complementarity. Taking all of these factors into account, I find that the applied for class 43 services to be similar to the opponent's various class 32 drinks to a low degree.

65) At this point it is important to note that following the comparison of goods and services, some goods were found to be not similar. These are:

Flour and preparations made from cereals, bread, pastry and confectionery; honey, yeast, baking powder, salt, mustard; vinegar, spices and seasonings; rolls, biscuits, breads, cakes, rice; pizza; pizza sauces; pizza crusts; pizza dough; pasta and prepared pasta entrees.

66) It is a condition for a finding of a likelihood of confusion there must be some similarity between the goods and services. Since this is not the case in respect of the goods listed above, the opposition fails. It is of particular relevance here since there is no similarity in respect of the applied for pizza related goods which, as will become apparent later, is a factor which must be taken into account when the mark includes the word pizza.

Comparison of marks



67) 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 Court of Justice of the European Union 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.”

68) 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.

69) The respective trade marks are shown below:

Applicant's mark	Opponent's mark
 The applicant's mark consists of a stylized '@' symbol followed by the word 'pizza' in a bold, lowercase, sans-serif font. The '@' symbol is significantly larger than the letters in 'pizza'.	 The opponent's mark consists of an ampersand (&) symbol followed by the word 'pizza' in a bold, lowercase, sans-serif font. The ampersand is slightly larger than the letters in 'pizza'.

70) The opponent's mark consists of the word 'pizza', presented in lowercase and thick font, and preceded by an ampersand (which is slightly larger in font) without an antecedent. The ampersand will instantly be recognised as the symbol meaning 'and', and the word 'pizza' will be attributed its ordinary and natural meaning. I consider the word 'pizza' to play a greater role in the overall impression of the mark with the symbol playing a lesser role in the overall impression.

71) The applicant's mark also consists of the word 'pizza', presented in lowercase, and preceded by an '@' symbol which is slightly larger. For pizza related services the word pizza does not have any distinctive character. However, all of the mark is noticeably stylised with the @ being larger in size. Therefore, I consider the word '@' symbol to play a moderately greater role in the overall impression of the mark with the word playing a lesser role in the overall impression of the mark.

72) Visually, the applicant argues that the average consumer would perceive the respective symbols as being relatively dominant. Both marks begin with a symbol followed by the word pizza. Whilst the applicant's mark is stylised it does not detract from the visual similarity deriving from the only word in each mark being pizza. Taking these factors into consideration, I consider the marks to be visually similar to an above medium degree.

73) From an aural perspective, the applicant's mark is likely to be pronounced as 'at-pizza' and the opponent's mark as 'and-pizza'. Therefore, they differ in the first syllable but share the final two syllables forming the word 'pizza'. The applicant

argues that the 'At' and 'And' are distinct and different sounds which, at most, have a very low level of similarity. As a general rule greater aural emphasis is placed at the beginning of the marks, though there is some similarity by virtue of the word 'pizza' being aurally identical. Taking these factors into account, I consider the respective marks to be aurally similar to a medium degree.

74) In order for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer³. It is clear that the word 'pizza' is capable of immediate grasp. I do not consider the stylisation of the applicant's mark to have any conceptual impact. Whilst both marks are preceded with symbols, they are different symbols that have different meanings. For example, the opponent's mark (&pizza) may be perceived as suggestive of being suitable to consume with pizza. Notwithstanding this, the different potential meanings of the symbols do not alter the concept of each mark or sufficiently alter the concept of each mark so that the word pizza would not be remembered. They are therefore conceptually similar to a medium degree.

Average consumer and the purchasing act

75) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

76) 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

³ See the comments of Anna Carboni, sitting as the Appointed Person in *Chorkee*, BL O/048/08, paragraphs 36 and 37.

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.”

77) The average consumer of the goods and services in question will be a member of the general public. The goods at issue are various food and non-alcoholic drinks. They are likely to be self-selected from the shelves of retail premises such as supermarkets and shops, and their online equivalents. Trade channels will also include restaurants, cafes, etc. where the consumer will be exposed to the marks on menus and bottles. For all of the goods the purchasing act will predominantly be a visual inspection of the goods, though I do not rule out aural recommendations (for example advice from sales assistants and waiters etc).

78) The level of attention paid is likely to vary but the goods are all of the type which are bought frequently and are not particularly expensive. Notwithstanding this, the consumer is likely to take some care to ensure, for example, that the correct type or flavour of product is bought. Therefore, the level of care and attention paid upon purchasing the goods is average.

Distinctive character of earlier mark

79) 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).”

80) The opponent has not filed any evidence. Therefore, it does not claim to have an enhanced level of distinctive character by virtue of the use made of the mark.

81) From an inherent perspective, the earlier mark consists of ‘&pizza’ in thick unremarkable font. The word ‘pizza’ when placed on non-pizza goods is not descriptive and I consider it to have a certain degree of distinctive character. The applicant argues that the only distinctive element of the earlier mark is the ampersand and therefore it is distinctive to a low degree. In my view, the distinctive character of the earlier mark resides in the combination of the & followed by pizza. I consider the mark to be distinctive to a moderate degree.

Likelihood of confusion – global assessment

82) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

83) Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks,

goods and services down to the responsible undertakings being the same or related).

84) At this point it is important to recall that for the pizza and pizza related goods, I have found that there was no similarity with the opponent's goods and therefore there cannot be a likelihood of confusion and the section 5(2)(b) ground fails against those goods. However, I did find some similarity between the applied for class 43 services and the earlier class 32 drinks. Since the applied for services may relate to pizza (i.e. they may only serve or specialise in pizza) I shall deal with this group of services first.

85) I have found the earlier class 32 drinks and the applied for class 43 services to be similar to a low degree. I have also found the average consumer to be the general public who will pay a reasonable degree of care and attention, plus the purchase will primarily follow a visual inspection of the goods and services. I have found the respective marks to be visually similar to an above medium degree. They are also aurally and conceptually similar to a medium degree. In *Whyte & Mackay Ltd v Origin Wine UK Ltd* [2015] EWHC 1271 (Ch) Arnold J. stated that:

“.....if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”

86) The respective marks are a combination of a symbol followed by the word pizza, which for pizza related services is non-distinctive. Taking this into account, and bearing in Mr Norris' comment at the hearing that I should be careful not to dissect the marks, I do not accept that there is a likelihood of direct confusion. I am also of the view that consumers will not believe that there is an economic connection or association between them and so I find that there is no indirect confusion. Should consumers encounter different symbols followed by the non-distinctive/descriptive word 'pizza' they are unlikely to be confused and nor would they believe that they are economically associated.

87) In view of the above the opposition based on section 5(2)(b) of the Act fails against the following services:

Class 43: Restaurant services; snack bar services, café services, canteens and fast-food outlets, catering services.

88) I now turn to the opposition against the non-pizza related goods, these are:

Class 30: Ices; condiments, sauces; salad dressings.

Class 32: Squashes; carbonated non-alcoholic drinks; mineral and aerated waters; fruit drinks and fruit juices, slush drinks, syrups and other preparations for making beverages.

88) Apart from the class 30 condiments and sauces being averagely similar to the opponent's salad dressings, I have found all of the above goods to be identical or highly similar to those covered by the earlier registration.

89) As previously stated, the respective marks are visually similar to an above medium degree and aurally similar to a medium degree. From a conceptual perspective, there is a medium degree of conceptual similarity. During the hearing Mr Norris relied upon there being a likelihood of confusion particularly because the average consumer would be relying upon its imperfect recollection. In my view, bearing in mind that the average consumer is reasonably observant and circumspect, I am of the view that there is a likelihood of direct confusion. I consider that once consumers are faced with the application on goods which are purchased on a frequent basis and then encounter another pizza mark, for non-pizza goods, which is also preceded by a symbol, they are likely to be confused.

90) However, even if I am wrong on my finding of direct confusion, I must also consider indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“..... Indirect confusion, on the other hand, only arises where the consumer has actually recognised 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).”

91) I also note that in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

92) Whilst guarding against finding indirect confusion simply because the marks share a common word, I also find that the average consumer will put the common presence of the word PIZZA (for non-pizza goods) down to the responsible undertakings being the same or being related. During the hearing Mr Zweck argued strongly that there would not be any brand extension or association. I disagree. I find that they will merely assume that the preceding symbol has been changed to act as a sub-brand or brand extension. To come to an opposite view would mean that the average consumer would put the point of similarity down to pure co-incidence which is, in my view, improbable. There is a likelihood of indirect confusion in relation to the identical goods in play.

OUTCOME

93) The opposition under sections 3(1)(a) and (b) have failed. The opposition based on section 5(2)(b) has partially succeeded, and therefore the application shall be refused registration (subject to appeal), in respect of:

Class 30: Ices; condiments, sauces; salad dressings.

Class 32: Squashes; carbonated non-alcoholic drinks; mineral and aerated waters; fruit drinks and fruit juices, slush drinks, syrups and other preparations for making beverages.

94) The opposition has failed against the following goods and services and, therefore, the application shall proceed to registration (subject to appeal), in respect of:

Class 25: Clothing; footwear; headgear.

Class 30: Flour and preparations made from cereals, bread, pastry and confectionery; honey, yeast, baking powder, salt, mustard; vinegar, spices and seasonings; rolls, biscuits, breads, cakes, rice; pizza; pizza sauces; pizza crusts; pizza dough; pasta and prepared pasta entrees.

Class 43: Restaurant services; snack bar services, café services, canteens and fast-food outlets, catering services.

COSTS

95) The applicant has been more successful than the opponent and so it is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £700 as a contribution towards the costs of the proceedings. The award takes into account that it has been partially successful in defending its application.

Preparing counterstatements and considering the other side's statements	£300
Preparing for and attending a hearing (including the written submissions previously filed)	£400
TOTAL	£700

96) I therefore order IMAPIZZA LLC to pay AT PIZZA LIMITED the sum of £700. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 31st day of October 2018

Mark King
For the Registrar,
The Comptroller-General