

O-810-18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3250126
BY CABLE LOGIC EUROPE LTD TO
REGISTER AS A TRADE MARK:



AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 410891 BY WAGAMAMA LIMITED

Background and pleadings

1. On 14 August 2017, Cable Logic Europe Ltd (“the applicant”) applied to register the trade mark shown below (“the contested mark”):



Registration is sought in respect of the following goods:

Class 29 Prepared meals; instant meals; snack foods; preparations and ingredients therefor; soups; prepared, preserved, dried, cooked and/or frozen fruits and vegetables; reduced fat content dairy products; potato crisps and potato chips; all consisting wholly or principally of noodles. Made out of rice and wheat.

2. The application was published for opposition purposes on 25 August 2017. The application is opposed by Wagamama Limited (“the opponent”) on the basis of ss. 5(2)(b), 5(3), 5(4)(a) and 56(1) of the Trade Marks Act 1994 (“the Act”). The opposition is, under all grounds, directed against all of the goods in the application.

3. Under ss. 5(2)(b) and 5(3), the opponent relies upon the following trade marks:

(i) European Union trade mark (“EUTM”) number 810010 **WAGAMAMA**

Filing date: 30 April 1998; date of entry in register: 18 July 2000

Seniority date: 25 June 1992 (UK trade mark no. 1504919)

Registered for various goods and services in classes 29 to 33 and 42; the opponent relies upon various services in class 42, set out at paragraph 22, below.

(ii) EUTM 3102233 **WAGAMAMA**

Filing date: 20 March 2003; date of entry in register: 18 April 2005

Registered for various services in classes 35, 38 and 43; the opponent relies upon services in classes 35 and 43, set out at paragraph 22, below.

(iii) EUTM 4718334:

**wagamama**

Filing date: 1 November 2005; date of entry in register: 14 November 2006

Registered in class 43, the opponent relies upon all of the services of the registration (set out in full at paragraph 22, below).

4. Under s. 5(2)(b), the opponent claims that the marks are visually and orally similar or almost identical. It claims that the respective goods and services are similar. As a consequence, it claims that there is a likelihood of confusion.

5. Under s. 5(3), the opponent claims that its marks have a reputation in the UK such that use of the contested mark would cause the relevant public to believe that there is an economic connection between the applicant and the opponent, where no such connection exists. It claims that the applicant would gain an unfair advantage, benefiting from the investment in promotion and marketing of the opponent's brand without incurring its own marketing expenses. The opponent further claims that the reputation of its marks may be damaged if there were any negative publicity related to the sale of the goods in the applied-for specification and those goods were associated with the opponent. Lastly under this ground, the opponent claims that the distinctive character of the earlier marks would be damaged through the use of the contested mark and that the

economic behaviour of the relevant consumer could be altered, with the goods of the contested mark chosen instead of the services of the opponent.

6. Under s. 5(4)(a), the opponent claims that the sign **WAGAMAMA** has been used throughout the UK since 1992 in respect of all of the services in classes 35 and 43 covered by its registered trade marks and relied upon for this opposition (set out at paragraph 22). It claims that the opponent has acquired a substantial goodwill and that use of the contested mark at the relevant date would have constituted a misrepresentation to the public, with resulting damage to the opponent's goodwill.

7. The opponent further claims that the above trade marks are entitled to protection as well-known marks under article 6*bis* of the Paris Convention and that the marks qualify as earlier trade marks under s. 6(1)(c) of the Act. However, as all of the marks identified in the notice of opposition qualify as earlier trade marks on the normal basis (i.e. under s. 6(1)(a)), the opponent is entitled to whatever protection is appropriate under s. 5 of the Act, whether or not the marks qualify as earlier marks by virtue of the Paris Convention. This claim therefore appears to be duplicative and unnecessary. I note that in its submissions the opponent suggests its claim under this ground extends to s. 5(4). However, the provisions of ss. 6(1)(c) and 56(1) apply to earlier trade marks, not earlier rights, whilst s. 5(4) does not provide protection for registered trade marks. Moreover, the opponent does not make clear which rights it relies upon under s. 5(4) or whether it bases its claim upon s. 5(4)(a) or s. 5(4)(b). Consequently, I will not consider the claim under the Paris Convention other than for the marks identified in the notice of opposition.

8. The applicant filed a counterstatement in which it denies all of the grounds of opposition. It makes the following comments (reproduced as written):

“Our trade mark WAKAYAMA – PREMIUM NOODLES was formed after Wakayama, a physical geographical location found within Kansai prefecture, Japan., noted for ramen noodles where our products are sourced.

Our trade mark WAKAYAMA – PREMIUM NOODLES along with the image of Samurai warrior mixing a large pot. has to go together and not broken down in words wakayama only. Custom Fonts are clear and individual in design.

AURAL impression - Pronounced clearly by a reasonable person, WAKAYAMA does not sound the same as Wagamama. Due to lack of aural similarities between the two names cited, there is no likelihood of confusion here.

VISUAL impression - Our logo is very distinctive and highly original. There is no resemblance whatsoever, therefore unlikely to attract any confusion with general public.

Our products will be primarily, noodles in a pot and selected condiments for public consumption”.

9. Given their dates of filing, the trade marks relied upon by the opponent qualify as earlier marks in accordance with s. 6 of the Act. As the trade marks had been registered for more than five years at the date of publication of the contested mark, they are, in principle, subject to the proof of use provisions contained in s. 6A. However, in its counterstatement the applicant indicated that it did not require the opponent to provide evidence of use. Accordingly, the opponent may rely upon all of the goods and services it has identified without showing that it has used the earlier marks.

10. Only the opponent filed evidence. It also filed written submissions during the evidence rounds, which I will bear in mind. Neither party requested a hearing and neither filed written submissions in lieu. This decision is, therefore, taken after careful consideration of all of the papers. The applicant is not professionally represented. The opponent has been represented throughout by Charles Russell Speechlys LLP.

Evidence

11. This consists of the witness statement of Jane Holbrook, with five exhibits. Ms Holbrook is the Chief Executive Officer of the opponent company. I have read all of Ms Holbrook's evidence. The key points which emerge are detailed below.

12. The opponent's chain of restaurants serves "Japanese inspired cuisine, offering both take away and eat in service".¹ Its first UK restaurant opened in 1992 and its first restaurant outside London in 2000.² The opponent regards itself as "a category of one within the UK branded restaurant market, as the only pan-Asian restaurant operator of scale".³

13. As at April 2017, the opponent operated 124 restaurants throughout the UK.⁴ Ms Holbrook gives the following figures for turnover generated in the UK:⁵

April 2017	£257,774,000
April 2016	£223,693,000
April 2015	£188,115,000
April 2014	£159,233,000
April 2013	£141,170,000
April 2012	£124,392,000

14. I note that there is a slight, unexplained, discrepancy with the documentary evidence, which gives turnover in the UK as £255.2 million for the financial year 2017, up from £220.0 million the previous year.⁶ Average weekly turnover in the UK was £30,600 in 2014 and in 2015 £32,600.⁷

¹ Holbrook, §3.

² Exhibit JH1, p. 12.

³ JH1, p. 8.

⁴ JH1, p. 2.

⁵ Holbrook, §14.

⁶ JH1, p. 5.

⁷ JH1, p. 12.

15. UK advertising and promotion spend is given as follows:

April 2018	£3,392,093 (predicted)
April 2017	£3,264,730
April 2016	£2,789,223
April 2015	£2,399,632
April 2014	£1,598,496

16. Images of the frontages of the opponent's restaurants, which show the word "wagamama" are provided at JH3. It is possible that EUTM 4718334 is shown at p. 3 but the image is poor. None of the images is dated.

17. Six press articles are exhibited in which the opponent features.⁸ Only two are dated before the filing date of the contested mark and are from the Peterborough *Evening Telegraph* (August 2016) and the *Coventry Telegraph* (February 2015). I note that the first article refers to "Pan Asian sensation Wagamama", "wagamama's famed ramen" and "the iconic Wagamama canteen-style benches".⁹ The second article refers to Wagamama as "top of the food chain since cooking up a storm with its first restaurant over 20 years ago" and "[famous] for its fried noodles and Japanese curry dishes".¹⁰ I note the following comments in the remaining articles (dated after the application date): that Wagamama "cut its reputation in the 1990s by becoming the country's most popular go-to noodle bar (it remains a household name today)" (*Yorkshire Evening Post*, December 2017); that an *Observer* article (November 2017) refers to the opponent revolutionising "the way Britons eat, what we eat and the spaces we eat in" and "the pared-back décor", and quotes a 'trend forecaster' as saying that "Wagamama felt very high-tech when it debuted"; and that "Wagamama has become somewhat of a British institution in recent years. It's a shopping mall and high street staple, bristling with ramen bowls and teppanyaki" (*Mirror*, September 2017).¹¹ There are references to,

⁸ JH4.

⁹ p. 9.

¹⁰ p. 10.

¹¹ pp. 3-8.

variously, Japanese/Japanese-inspired or pan-Asian food being provided by the opponent.

18. Details of the opponent's success in various industry awards are provided at JH5. Most are of limited or no assistance. However, I note that Wagamama's success is put down, in part, to its inexpensive offering (pp. 3-4, September 2008), that it is described as a "fast-casual noodle chain" (p. 7, September 2012) and "[famed] for challenging what we ate, how we sat side-by-side and promoting a new casual dining code" (p. 26, also p. 29, both 2016). The comment is made that "[having] once been seen as one of the most innovative and cool restaurants on the UK high street, by late 2013 Wagamama's star had dimmed" p. 14, 2015).

19. That concludes my summary of the evidence, insofar as I consider it necessary.

Section 5(2)(b)

20. Section 5(2)(b) of the Act reads as follows:

"5. – [...]

(2) A trade mark shall not be registered if because – [...]

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

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

21. 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:

(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.

Comparison of goods and services

22. The goods and services to be compared are:

Earlier specifications	Contested specification
EUTM 810010 <u>Class 42</u> : ¹² Providing of food and drink; cafes and cafeteria services; canteen services; catering services; restaurant and self-service restaurant services; snack bars.	<u>Class 29</u> : Prepared meals; instant meals; snack foods; preparations and ingredients therefor; soups; prepared, preserved, dried, cooked and/or frozen fruits and vegetables; reduced fat content dairy products; potato crisps and potato chips; all consisting wholly or principally of

¹² Now proper to class 43, at the date of application these services were correctly classified in class 42.

<p>EUTM 3102233</p> <p><u>Class 35:</u> The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from an Internet website specialising in marketing of food, drinks, general merchandise and restaurant services; retail services; providing information about the provision of food and drink via electronic networks and the Internet, and through publication of print media.</p> <p><u>Class 43:</u> Providing information about the sale of merchandise via electronic networks and the Internet, and through publication of print media.</p> <p>EUTM 4718334</p> <p><u>Class 43:</u> Providing food and drink; providing of food and drink by means of on-line ordering; food and drink takeaway services; cafes and cafeteria services; canteen services; catering services, restaurants and self-service restaurant services, snack bars; services for providing food and drink; providing information about the provision of food and drink.</p>	<p>noodles. Made out of rice and wheat.</p>
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23. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

24. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

25. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

26. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

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

27. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes”,

whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

28. It is permissible for goods and services to be grouped together for the comparison, where essentially the same considerations apply: *Separode Trade Mark* BL O/399/10.

Class 29 v class 35

29. In *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, the GC held that a registration for ‘retail services’, which did not identify the kinds of goods covered by the services, was too vague to permit a proper comparison to be made between those services and the goods covered by the later mark. It was not therefore possible to determine that the respective services and goods were similar. This decision makes it clear that the opponent’s “retail services” is too vague to permit a proper comparison and there is, therefore, no similarity.

30. The earlier term “the bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from an Internet website specialising in marketing of food, drinks, general merchandise and restaurant services” does not explicitly identify the goods for sale. However, it seems reasonable to infer that a website specialising in marketing food and drink will sell food and drink. I proceed on that basis. As it is this term which is of most relevance to the contested foodstuffs, it would not assist the opponent were I to consider whether the term is too vague in relation to the other goods and services and I do not intend to do so.

31. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods and distributed through the same trade channels, and therefore similar to a degree.

32. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut”.

33. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*,¹³ and *Assembled Investments (Proprietary) Ltd v OHIM*,¹⁴ upheld on appeal in *Waterford Wedgewood Plc v Assembled Investments (Proprietary) Ltd*,¹⁵ Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

34. All of the goods in the contested registration are foods or drinks. They are complementary to the opponent's "bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from an Internet website specialising in marketing of food and drinks", as they are indispensable to the retail of food and drink and the consumer may perceive them as emanating from

¹³ Case C-411/13P

¹⁴ Case T-105/05, at paragraphs [30] to [35] of the judgment.

¹⁵ Case C-398/07P

the same trade source. They will also share channels of trade. Although differing in nature, purpose and method of use, overall they are similar to a medium degree.

Class 29 v class 43

35. I will begin by comparing the applicant's goods with the term "providing food and drink", contained in EUTMs 810010 and 4718334. This term encompasses all of the other services for providing food and drink in those marks' specifications and therefore puts the opponent in the strongest position. Although the limitations to the contested specification, namely "all consisting wholly or principally of noodles. Made out of rice and wheat", apply in principle to all of the preceding terms, it is not clear how a product defined as a potato chip, for example, could be made of noodles and/or rice and wheat. Therefore, where the limitations cannot reasonably be said to apply to the goods, I will disregard them.

Prepared meals; instant meals; snack foods; soups; prepared, cooked and/or frozen fruits and vegetables; potato chips; all consisting wholly or principally of noodles. Made out of rice and wheat.

36. These terms all consist of or include prepared dishes or snack foods which could be served as part of the opponent's services for providing food and drink. The goods and services differ in nature, purpose and method of use, as is always the case with goods on the one hand and services on the other. The users are the same, though that is at a very high level of generality and is not determinative on its own. However, not only are the above goods important or essential for the opponent's services but these goods may also be perceived by the average consumer as coming from the same undertaking as the services, particularly as the average consumer is likely to have been exposed to other restaurant chains' foodstuffs for sale in supermarkets. The goods are complementary. Channels of trade may overlap and the goods and services may be in competition, as a ready meal could be purchased instead of the opponent's services being used. There is a medium degree of similarity.

Preparations and ingredients for prepared meals, instant meals, snack foods; preserved and dried fruits and vegetables; potato crisps; reduced fat content dairy products; all consisting wholly or principally of noodles. Made out of rice and wheat.

37. The purpose, nature and method of use of these goods are all different from those of the opponent's services. These goods are not finished dishes which would ordinarily be in competition with the opponent's services. Whilst I accept that crisps and yoghurt (covered by reduced fat content dairy products) may be consumed as snacks, I do not consider that there is any real complementarity, as it would, in the UK, be unusual for the responsibility for such goods to lie with the providers of the opponent's services. The average consumer is, therefore, unlikely to assume any such connection between the respective undertakings. In the absence of any evidence on the point, I conclude that there is no similarity between these goods and the opponent's services.

38. I have considered the remaining terms in the earlier specifications and can see no services which would put the opponent in a stronger position. There is no material similarity between these goods and services. At best, they overlap only in users, a superficial point of similarity; the nature, purpose, method of use and channels of trade all differ, and there is neither competition nor complementarity between the respective goods and services.

The average consumer and the nature of the purchasing act

39. It is necessary for me to determine both who the average consumer is for the respective parties' goods and services and the manner in which these goods and 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”.

40. The average consumer will be a member of the general public. Selection of both the goods and services is likely to be primarily visual, following viewing of the goods on the shelves of retail premises, primarily supermarkets, or their online equivalents, or following inspection of the premises’ frontage on the high street, a website or advertisements, in print or online. However, I do not discount that there may be an aural component to the selection of both the goods and the services. The level of attention paid is likely to vary but the consumer is likely to take some care to ensure, for example, that the flavour of product or type of cuisine, or the type of venue, is suitable for their requirements and taste. They are all likely to be purchased with a medium degree of attention.

Comparison of trade marks


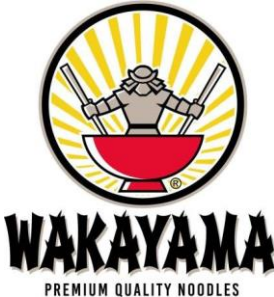
41. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

42. 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”.

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

44. The trade marks to be compared are as follows:

Earlier trade marks (all)	Contested trade mark
<p>(i) WAGAMAMA</p> <p>(ii) </p>	

45. The opponent submits that the device in the contested mark should be discounted for the purposes of the comparison, as it “simply describes a feature of the products”.¹⁶ It submits that the marks are aurally almost identical, and that, neither having a meaning, the marks are conceptually similar.¹⁷ Overall, it claims that the marks are highly similar.¹⁸

¹⁶ Submissions, §12.

¹⁷ Submissions, §14-15.

¹⁸ Submissions, §16.

46. The contested mark has several elements. The first is a device which shows a bowl, in red, with a highlight in white at the left. There is an image of an armoured figure, which seems to be standing behind (or possibly in) the bowl. The figure is holding, in each outstretched arm, a staff. The impression is of chopsticks. The background of the device is yellow and white stripes, radiating from a point behind the figure. The registered trade mark sign ® is at the bottom right of the bowl. The whole is enclosed in a black circle, itself surrounded by a thin gold circle. Underneath the device in a stylised typeface, is the word “WAKAYAMA”, in black capitals. At the bottom of the mark, in plain black capitals, are the words “PREMIUM QUALITY NOODLES”.

47. In terms of the overall impression, both the device and the word “WAKAYAMA” play an important role. I do not accept the opponent’s contention that the device is purely descriptive. In my view, the device is sufficiently stylised to be a distinctive element of the mark. Its size and position mean that its role is roughly equal to that of “WAKAYAMA”. A weaker role is played by the stylisation of the lettering, whilst “PREMIUM QUALITY NOODLES” and the ® sign will not be given any distinctive significance.

48. I will take the comparisons with the earlier marks in turn, beginning with the word marks.

(i) WAGAMAMA

49. These earlier marks consist of the single word “WAGAMAMA”, presented in capital letters. The distinctiveness and overall impression of the marks rest in that word.

50. Visually, there is a significant difference between the earlier and contested marks, due to the relatively large device in the latter. There is some similarity between the verbal elements because of the common sequence of letters “WA-A-AMA”, though the third and fifth letters “G” and “M” in the earlier marks are absent in favour of “K” and “Y” in the later mark. Overall, there is a medium degree of visual similarity.

51. The marks are most similar aurally, because the device and ® symbol will not be articulated, nor are the words “PREMIUM QUALITY NOODLES” likely to be spoken. The marks are, therefore, each four syllables long. The first and last syllables are identical, whilst the second and third syllables differ in the consonant sound (“GA...MA”; “KA...YA”) but share the same vowel sound. The marks are aurally similar to a high degree.

52. Conceptually, and notwithstanding the applicant’s submissions regarding the meaning of “WAKAYAMA” as a geographical location, I do not consider that the average UK consumer will attribute any concept to the word in the contested mark: there is no evidence to support such a view. The device sends no clear conceptual message. The earlier marks have no meaning which would be known to the average UK consumer. As neither mark has a meaning, they are conceptually neutral.

(ii) 

53. The above mark consists of the word “wagamama”, presented in lower case, in a bold but otherwise unremarkable black typeface. Above the first letter “m” is a small star, also in black. The overall impression is dominated by the word “wagamama”, though the star device plays a small role.

54. The visual similarities and differences outlined above are also applicable to this comparison. There is, however, an additional difference because of the star device in the earlier mark. Bearing in mind the relative weight of the different components, these marks are visually similar to a medium degree.

55. From an aural perspective, as the star device will not be articulated, the comparison above applies. These marks are aurally similar to a high degree.

56. The conceptual position is also as set out above, as the star is likely to be seen as decorative. The marks are conceptually neutral.

Distinctive character of the earlier trade mark

57. The distinctive character of the earlier marks must be assessed, as the more distinctive the earlier marks, either inherently or through use, the greater the likelihood of confusion (*Sabel* at [24]). In *Lloyd Schuhfabrik*, 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-2779, 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)”.

58. The word “WAGAMAMA”/“wagamama” will be perceived by the average consumer in the UK as invented. All of the earlier marks are inherently distinctive to a high degree.

The evidence shows that “WAGAMAMA” has been used for restaurant services for many years, that significant advertising investment has been made and that notable annual turnover is generated under the mark. Whilst there are no figures for market share, I am satisfied that the EUTM 810010 benefits from enhanced distinctiveness for restaurant services. There is no evidence that the mark has been used for cafes and cafeteria services, canteen services, catering services or snack bars. As regards EUTM 3102233, there is no evidence at all, bar one assertion in Ms Holbrook’s statement, showing use of the mark for the services relied upon in classes 35 and 43. There is also very little evidence regarding the use which has been made of EUTM 4718334. Ms Holbrook states that the marks have all been used since their filing dates but refers only to “the WAGAMAMA name” or “the WAGAMAMA brand” in her statement. The poor reproduction of the exhibits means that I cannot be certain that any of the documentary evidence shows the figurative mark. In any event, there is no information about the way in which, or the extent to which, the figurative mark has been used. Neither EUTM 3102233 nor EUTM 4718334 enjoys enhanced distinctiveness.

Likelihood of confusion

59. When determining whether there is a likelihood of confusion, a global assessment of the competing factors must be made (*Sabel* at [22]). I must consider the various factors from the perspective of the average consumer and decide whether they are likely to be confused. The factors considered above have a degree of interdependency (*Canon* at [17]), so, for example, a high degree of similarity between the marks may be offset by a lower degree of similarity between the goods, and vice versa. Confusion can be direct (where 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 down to the responsible undertakings being the same or related). In making my assessment, I must keep in mind 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 (*Lloyd Schuhfabrik* at [26]).

60. The difference between direct and indirect confusion was explained In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

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

61. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting 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 another mark to mind. This is mere association not indirect confusion.

62. I will begin by considering the position in relation to EUTM 3102233. The mark is highly distinctive, though this has not been enhanced through use. All of the contested goods are similar to a medium degree to the earlier mark’s services in class 35 (paragraphs 30 to 34, above). They will be selected with a medium level of attention through primarily visual means. It follows that the level of visual similarity between the marks will have a greater bearing on my decision than the level of aural similarity. In my view, the device in the application is sufficiently prominent and distinctive to avoid direct confusion. However, I must consider whether it is likely that the average consumer will

imperfectly recollect the verbal elements (“WAGAMAMA”/“WAKAYAMA”) and conclude that the contested mark is a variant mark being used by the opponent. In short, I find that this is likely. The similarities between these elements are such that, particularly when the highly distinctive nature of the earlier mark is taken into account, and notwithstanding the differing consonants, the average consumer is likely to misremember the words “WAGAMAMA”/“WAKAYAMA” and be indirectly confused. There is a likelihood of confusion in respect of all the contested goods.

63. For the avoidance of doubt, I also consider that there is a likelihood of confusion in respect of the other marks relied upon, where the goods and services are similar. My comments, above, regarding the potential for “WAGAMAMA” and “WAKAYAMA” to be confused are equally applicable to the comparison between the application and EUTM 810010. I do not consider that the star device in EUTM 4718334 will have a sufficient impact on the consumer to avoid essentially the same process of confusion through the imperfect recollection of the words “WAGAMAMA”/“WAKAYAMA”. Where there is no similarity of goods and services, there can be no confusion and the opposition based upon EUTMs 810010 and 4718334 would have been dismissed where the goods and services are dissimilar.¹⁹

Other grounds

64. Given my findings above, the opponent’s position would not be materially improved if I were to consider the remaining grounds. I do not consider it necessary to do so.

Conclusion

65. The opposition has succeeded in full. The application will be refused.

¹⁹ See, for example, *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU).

Costs

66. The opponent has been successful and is entitled to an award of costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Tribunal Practice Notice (“TPN”) 2/2016. The applicant did not file evidence and the opponent’s evidence was light, which is reflected in the award below. I award costs to the opponent on the following basis:

Official fee	£200
Preparing the notice of opposition and considering the counterstatement:	£200
Filing evidence and submissions:	£600
Total:	£1,000

67. I order Cable Logic Europe Ltd to pay Wagamama Limited the sum of **£1,000**. This sum is 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 19th day of December 2018

**Heather Harrison
For the Registrar**