

O-583-19

TRADE MARKS ACT 1994

IN THE MATTER OF THE APPLICATION No. 3316199

BY MATHEW WILLIAMS

TO REGISTER AS A UK TRADE MARK:

The Rock & Scallop

FOR SERVICES IN CLASSES 43

AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 413811

BY ALI ZIYAEDDIN AND AHMET ZIYAEDDIN

BACKGROUND AND PLEADINGS

1. Mathew Williams (“**the Applicant**”) filed an application on 7 June 2018 to register the words “The Rock & Scallop” as a UK trade mark in respect of the following services, in Class 43: *Restaurant and bar services; Restaurant services; Restaurant services for the provision of fast food; Restaurant services incorporating licensed bar facilities; Restaurants.*
2. The application was published for opposition purposes in the Trade Marks Journal on 22 June 2018 and is opposed by Ali Ziyaeddin and Ahmet Ziyaeddin (“**the Opponents**”). The opposition is based on three grounds under the Trade Marks Act 1994 (“**the Act**”), namely, **sections 5(2)(b), 5(3) and 5(4)(a)**. The opposition under each ground is directed against all services under the application.
3. For the claims under **sections 5(2)(b) and 5(3)** of the Act, the Opponents rely on their ownership of UK trade mark registration 2549463 (“**the earlier mark**”) as follows:

THE ROCK & SOLE PLAICE
<p>Filing date: 3 June 2010</p> <p>Registered on 1 October 2010, for the following services:</p> <p>Class 43: <i>Restaurant services; café services; catering services for food and drink; preparation and provision of food and drink; preparation of food for take-away.</i></p>

4. The claim under **section 5(2)(b)** is that the earlier mark is similar to the applied-for mark and that the services are identical such that a likelihood of confusion arises.
5. In relation to **section 5(3)**, the statement of grounds includes the following claims:
 - i. uninterrupted use of the earlier mark in the UK in relation to the registered services “since at least 1974”;
 - ii. for at least four decades the Opponents’ business under the mark has been listed in UK restaurant directories and travel guides, and reviewed and mentioned in UK publications;
 - iii. the earlier mark consequently “enjoys a solid and long-term reputation in the UK” in respect of its registered services;

- iv. customers seeing the Applicant's mark "will make a mental connection between the two businesses. For example, they might believe the Opponent has set up a new restaurant under a mark of similar look, sound and meaning to the well-established home brand";
 - v. the Opponents have "invested in promoting and maintaining the good reputation of its business under the mark. In using, without due cause, a mark that is likely to be associated with the Opponent's mark, the Applicant would benefit unfairly from the efforts and investments made by the Opponent in its brand and business and would trade off the back of the Opponent."
 - vi. An association made by customers between the Applicant's mark and the Opponents' mark would be detrimental to the reputation of the earlier mark if the services were of inferior quality to those of the Opponents, or simply did not match customers' expectations placed on the Opponents' mark.
 - vii. The Opponents' mark "has a fanciful and distinctive structure and co-existence in the marketplace with another mark that presents many similarities with its earlier mark and an identical structure to it would dilute the distinctiveness of the Opponent's mark, thereby damaging it."
6. For the **section 5(4)(a)** ground, the statement of grounds makes similar points to 5(i) and (ii) above to claim that through use of the mark "THE ROCK & SOLE PLAICE" "throughout the UK" "since at least 1974", the Opponents have built up "enormous goodwill" in relation to "*restaurant services, café services, preparation of food for take-away*". It claims:
- i. use of the Applicant's mark for its applied-for services would create a misrepresentation in that customers aware of the Opponents' mark would assume a connection between the parties' businesses;
 - ii. this would cause damage to the Opponents' goodwill if, for example, the Applicant's services did not meet customers' expectations of the Opponents' brand, or if business were diverted away from the Opponents in favour of the Applicant due to such misrepresentation. Use of the Applicant's trade mark would also dilute the distinctiveness of the Opponents' mark, thereby damaging the value of the goodwill in the business.

The claim is therefore that the application may not proceed to registration because use of the mark would be liable to have been prevented by the law of passing off.

The Applicant's defence

7. The Applicant submitted a notice of defence in which it requested proof of use and made a very short counterstatement to the effect that the marks are not alike and would not be mistaken for each other. It also stated that the Applicant's restaurant is in the South Wales Valleys and the Opponents' is in Central London.

Papers filed, representation and hearing

8. The Opponents are professionally represented in these proceedings by **Keltie LLP**; they filed evidence during the evidence rounds, which I summarise below. The Applicant is self-represented and filed no evidence or submissions during the evidence rounds, but requested a hearing. An oral hearing was therefore due to take place by video conference on 26 July 2019, but on 22 July 2019 the Applicant informed the registry that he would not be attending the hearing. On 23 July 2019, the Opponents' representatives, who had made arrangements for a barrister to attend, requested that the hearing be cancelled and that a decision be made on the basis of the papers filed.
9. Enclosed with those requests was an open letter, dated 1 July 2019, from the Opponents' representatives to the Applicant; the letter was enclosed in order "to provide a complete picture of the case and bring the Hearing Officer up to date". It stated that irrespective of the outcome of the present opposition proceedings before the tribunal against the *registration* of the applied-for mark, the Opponents reserved their right to commence passing off proceedings if the mark were *used*. Such a passing off claim (to be heard by a court) would be premised on the claimed goodwill in the mark "The Rock and Sole Plaice" for restaurant services and on the claimed misrepresentation and consequent damage. While I note the filing of that open letter, it has no direct bearing on the assessment task and decision before me. However, since the Opponents have raised the matter, it is worth noting that there may be circumstances in which matters that have been decided before the tribunal may be barred under the legal doctrine of estoppel per rem judicatam from being re-assessed in another court of competent jurisdiction.

THE EVIDENCE

10. During the evidence rounds the Opponents filed the following evidence:

- **Witness Statement of Ali Ziyaeddin**, dated 20 December 2018, with Exhibits 1 – 5, 5A, 6, 7A, 7B, 7C, and 8
 - **1st Witness Statement of Amelia Skelding**, dated 20 December 2018, with Exhibits AS1 – AS4
 - **2nd Witness Statement of Amelia Skelding**, dated 21 January 2019, with Exhibit 4A and Exhibit 9
11. **Mr Ziyaeddin’s evidence** includes the following points: since 1980, he has been one of two owners of a company called “The Rock & Sole Plaice”, which operates as a fish and chip shop/restaurant in Endell Street in London. The Opponents’ company started using the mark “The Rock & Sole Plaice” in respect of the services for which their earlier mark is registered in 1974; the underlying restaurant business started its activities in 1871 as one of the very first fish and chip shops. **Exhibit 3** shows a screenshot from the Opponents’ company website www.rockandsoleplaice.com, generated via the “wayback machine” resource and dated November 2002.
12. His evidence shows various media references to the business including on BBC radio (**Exhibit 4**, focusing on the demise of newspaper wrapping) and in online versions of various national newspapers, including *The Sun*, *The Guardian*, and *The Independent*. The articles tend to namecheck the restaurant/take-away in pieces that list, for example, a selection of ‘best chip shops / restaurants / coolest places to eat’. The evidence includes favourable reviews by well-known chefs such as John Torode (*The Mail* online **Exhibit 5**). The dates of the articles range at least from 2002 – 2017. One such (*The Independent*, 22 March 2010, **Exhibit 6**) refers to the restaurant being “on the capital’s tourist trail and serves up to 2000 portions a day, largely to foreigners, including Bill and Hillary Clinton”. **Exhibit 7A** shows that the restaurant garnered over 1600, largely positive, reviews on *TripAdvisor* between 2007 -2015.
13. **Exhibit 8** shows the restaurant referenced in *Lonely Planet* guide as a “no-nonsense chippie dating back to 1871 (but surely without the overwrought cutesy name)”. Other parts of the evidence refer to the punning nature of the restaurant name: **Exhibit 6**, *The Guardian*, 10 February 2002, “a double pun no less”; and again, on 15 January 2012, the restaurant is listed for the pleasure of the punning name, along with 12 others including Frying Nemo, A

Fish Called Rhondda and The Codfather; and at **Exhibit 8** *Visit London* refers to it as a “pun laden chippy”.

14. **Ms Skelding** is employed by the Opponents’ legal representatives and her evidence includes search results for trade marks registered in Class 43 that begin with “The Rock .../ The Rock & ... / The Rock and ...”. The results reveal only two: an EU trade mark (“The Rock and Roll Museum”) and UK trade mark for “The Rock Lounge” (logo). Ms Skelding also states that only two food businesses featured on *TripAdvisor* start with those terms, namely “The Rock and Fountain Inn” and The Rock and Rose Restaurant”, and that the search results revealed no other restaurants in the UK that began with “the rock” followed by a word that refers to a fish or seafood.

Proof of use

15. The Applicant has requested proof of use of the earlier mark. Since the earlier mark had been registered for more than five years when the Applicant applied to register his trade mark, in order to be able to rely on that earlier registered trade mark in opposition proceedings, the Opponents must show genuine use during the relevant five-year period. Section 6A of the Act states that the use conditions are met if:

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

(b) [...]

(4) For these purposes -

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

16. Section 100 of the Act makes it clear that the burden of proof falls on the Opponents to show use of their mark.

17. The case law principles on genuine use were recently summarised by Arnold J in *Walton International*¹. It is unnecessary here to set out the full wording, but I note that the requirement for genuine use of the earlier trade mark will be satisfied if it is shown that:
- i. there has been **actual** use of the trade mark by the proprietor (or authorised third party) in relation to goods or services which are **already marketed** (or about to be marketed);
 - ii. the use is **more than merely token**, that is to say, serving solely to preserve the rights conferred by the registration of the mark;
 - iii. the use is **consistent with the essential function** of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling her/him to distinguish the goods or services from others which have another origin;
 - iv. and that the use is by way of **real commercial exploitation** of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark.
18. In the same case, Arnold J stated that all the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use. He also highlighted that use of the mark need not always be quantitatively significant for it to be deemed genuine; even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services.
19. In addition to the above case law directly concerning proof of use, it is also relevant to note here the case law principles relating to the framing of a fair specification in light of the extent of use that may be established by the evidence. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

1 *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch) - at paragraph 114.

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

20. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law (in the context of partial revocation) as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other

subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

21. I find on the basis of evidence filed and summarised above that the Opponents have clearly made genuine use of the earlier mark in the UK in the last 5 years (indeed for decades more than that) at least in relation to the following of its registered services: *Restaurant services; preparation and provision of food and drink; preparation of food for take-away*. Precisely what constitutes a café in contra-distinction from a restaurant I could not authoritatively state, but since many cafés serve fish and chips, I find that the Opponents may fairly be considered to have shown genuine use in relation to *café services* too. As for *catering services for food and drink*, I understand such services to involve providing food and drink externally, for example at a social event or other gathering; I noted no particular references to the Opponents’ business providing catering services as such and I do not find that the evidence shows genuine use for those services. Therefore, I consider the following to be a fair specification on which the opposition may proceed:

Restaurant services; café services; ~~catering services for food and drink~~; preparation and provision of food and drink; preparation of food for take-away.

22. If I am wrong in my construction of what is meant by catering services, and such services may in fact be considered to include, for example, the sale of take-away fish and chips, which the consumer may take back to whatever social, work or other setting to meet their catering needs, then clearly the evidence shows use in that regard; if so, the Opponents would be able to rely on all services under the earlier mark.

DECISION

The section 5(2)(b) claims

23. 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”.

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

(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 the services

25. The services to be compared are:

The applied-for services
Class 43: <i>Restaurant and bar services; Restaurant services; Restaurant services for the provision of fast food; Restaurant services incorporating licensed bar facilities; Restaurants.</i>
A fair specification of Opponent's services
Class 43: <i>Restaurant services; café services; preparation and provision of food and drink; preparation of food for take-away.</i>

26. Both parties specify “*Restaurant services*”, which are plainly identical. Moreover, in *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the General Court stated that goods can be considered as identical when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (and vice versa).² The same principle similarly applies for services.
27. It is commonplace for restaurants to include a bar that serves alcoholic and non-alcoholic drinks, and I find that the Opponents’ specification of “*Restaurant services*” includes, and therefore may be considered identical to, the following services specified by the Applicant: *Restaurant services for the provision of fast food; Restaurant services incorporating licensed bar facilities; and restaurants*. In any event, taking account of such factors as their shared nature, purpose, method of use, user and trade channels³, there is also self-evidently a very high degree of similarity between the Applicant’s *Restaurant services for the provision of fast food* and the Opponents’ *preparation of food for take-away*, and also between the Applicant’s “*restaurant and bar services*” and the Opponents’ “*preparation and provision of food and drink*”. (In the circumstances, it is clearly not material whether or not “catering services for food and drink” are included within a fair specification.)

The average consumer and the purchasing process

28. In *Hearst Holdings Inc*,⁴ Birss J explained that “... *trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer*

² Case T- 133/05 at paragraph 29 of that judgment.

³ Criteria listed by Jacob J (as he then was) in the *Treat* case [1996] R.P.C. 281

⁴ *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), at paragraph 60.

who is reasonably well informed and reasonably circumspect ... the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical ...”.

29. The average consumer of the services at issue will be a member of the general public at large, who will typically exercise an average, but not necessarily a high degree of care and consideration in selecting a choice of restaurant. The consumer will see the marks used as signage on the physical restaurant, on menus and in advertising for those services in various media, including in print and on the internet. Therefore, I consider the purchase to be a primarily visual one, but aural considerations may also play a part, such as on the basis of word of mouth recommendations, so I also take into account the aural impact of the marks.

Comparison of the marks

30. It is clear from *Sabel* 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 (“the CJEU”) stated in *Bimbo* 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.”*

31. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

The earlier mark:	THE ROCK & SOLE PLAICE
The Applicant’s contested mark:	The Rock & Scallop

32. The overall impression of the earlier mark comes from the collection of its words/text, which forms a unitary phrase, incorporating elements of play on words. The first and third components (namely, the definite article “the”, and an ampersand, signifying the word “and”) are such basic and ubiquitous elements of English text that, of themselves, they generate no significant distinctiveness. Each of the three other words has an equally important role in establishing the punning message of the sign, and the earlier mark taken as whole hangs together as a phrase.
33. The overall impression of the Applicant’s mark comes from the bringing together, via the involvement of the definite article and an ampersand, of the words “rock” and “scallop”. The latter is a longer and less common English word, which makes it more striking than the word “rock”, but both words are distinctive, and since one encounters the word “rock” before “scallop” I consider that both words make an equal contribution to the overall impression.
34. The Opponents submitted that the words “THE ROCK”, shared by the respective marks, are the most distinctive part in both marks, arguing that “the words that follow designate types of fish or seafood, which, in relation to restaurant and connected services are not particularly distinctive”. The Opponents submitted that the marks are therefore “identical in their most distinctive component”. In my view, although a scallop may feature within the menu of offerings by a restaurant it remains distinctive within the Applicant’s mark as I have described above. Likewise, although a restaurant’s menu may offer sole and plaice, the words are distinctive in the Opponents’ mark as part of the whole as I have described above.

Visual similarity

35. In the Form TM7, the Opponents noted visual identity between the marks to the extent that they both begin with “the rock &” and that the next word in each mark begins with the letter “S”. That is self-evidently true, but the visual difference between the following (distinctive) words “SOLE PLAICE” and “SCALLOP” is striking and obvious. **I find the marks may be considered visually similar to (at most) a degree between low and medium.**

Aural similarity

36. I take into account the identical openings, but also note the low distinctiveness of some of those common elements. I take account too of the very different aural impacts created by

the words “SOLE PLAICE” and “SCALLOP” and **I find the marks aurally similar to a low degree.**

Conceptual similarity

37. The Opponents submitted that the degree of similarity arising from the shared identical openings “is further compounded by the conceptual connotation of the marks.” It stated that “both marks start with the words THE ROCK, of identical meaning, and are followed by further words whose meaning designates a type of fish or seafood.” In my view, the average consumer will perceive the marks as quite different from a conceptual perspective.
38. The average consumer will readily perceive the intended punning reference to “rock ’n’ roll” or, else to “rock and soul”, such that the word “rock” will primarily be understood in the context of rock music. Moreover, the average consumer will also perceive the intended play on the word “plaice” to signify the word “place”. Thus, while, in the earlier mark, the fish references are clearly present, they are substantially mutated as concepts to form a “pun-laden” unitary phrase.
39. In contrast, the Applicant’s mark is entirely pun-free. Thus, the word “rock” in the Applicant’s mark is likely to be understood exclusively as a reference to the solid mineral material of the sort found at the seaside (and will not evoke the concept of music) and most among the average consumer will understand “scallop” to refer to a type of shell fish.
40. While I have noted the Opponents’ submissions on this matter, I find that in view of the notable conceptual differences, **the marks may be considered conceptually similar only to very low degree.**

Distinctiveness of the earlier mark

41. The distinctive character of the earlier mark must be assessed, as, potentially, the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion.⁵ However, as pointed out in relevant case law *“it is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark*

⁵ *Sabel* at [24]

*alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”*⁶

42. 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)”.

43. Although the earlier mark contains the names of two types of fish and its services may include, for example, the preparation of fish as food for take-away, the mark, which is a playful unitary phrase, is nonetheless distinctive for that. It is inherently distinctive for its services; moreover, the evidence shows that the mark has been used for several decades in relation to fish and chip restaurant and take-away services, with a good deal of prominence and media coverage. The distinctiveness of the mark has thus been enhanced through use and may be considered highly distinctive overall for the services under its fair specification.

⁶ Kurt Geiger v A-List Corporate Limited, BL O-075-13,. Mr Iain Purvis Q.C. as the Appointed Person

Conclusion as to likelihood of confusion

44. I make a global assessment of likelihood of confusion that takes account of my findings set out in the foregoing sections of this decision and of the various principles from case law outlined in paragraph 23 above.
45. All of the services applied-for are identical or else very highly similar to the services on which the Opponents are able to rely. In selecting the services, members of the general public will typically exercise an average, but not a high degree of care and consideration.
46. I find the pivotal issue in deciding this claim are my findings on the degrees of similarity between the marks. Visual considerations are particularly important in the consumer's selection process and the marks have a low degree of visual similarity. Word of mouth recommendations make aural considerations relevant in the assessment and I find the marks aurally similar to a low degree. I also consider that, viewed overall, there are notable conceptual differences between the marks such that any conceptual similarity is very low.
47. My findings also acknowledge that the earlier mark may be considered highly distinctive for the relevant services. However, even allowing for imperfect recollection, and for the interdependence of factors, such that a lesser degree of similarity between the marks may be offset by a great degree of similarity between the services, I find there is no likelihood that the average consumer, deemed well informed and reasonably circumspect and observant, encountering the respective marks, may wrongly believe that those services are provided by the same or economically-linked undertaking. I bear in mind the guidance of the Appointed Person in the Kurt Geiger decision (cited above) and note that the distinctiveness of the earlier mark lies in the pun, and the absence of a pun in the applied-for mark decreases the likelihood of confusion. It is unlikely that a consumer would think that an undertaking known for a restaurant whose trade mark is based so centrally on a pun would omit to deploy a pun in any connected business; in such circumstances no connection would be assumed. **There is thus no likelihood of confusion – neither direct nor indirect - and the claim under section 5(2)(b) fails.**
48. I move now to consider the other grounds claimed, and I find it sensible to deal first with the ground under section 5(4)(a) of the Act.

The section 5(4)(a) claim

49. Section 5(4)(a) of the Act provides that: "... a trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade." Section 5(4) also states that "A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of 'an earlier right in relation to the trade mark'."
50. The Opponents claim an earlier right in relation to the Applicant's mark arising from use of the unregistered sign "The Rock & Sole Plaice" over several decades such that it has protectable goodwill in relation to the "restaurant services, café services, preparation of food for take-away." In response to Question 1 under Section C of the notice of opposition Form TM7, which deals with this ground, the Opponents were required to state where the earlier right was first used in the UK, and were invited to specify the name of a city/region or to specify "throughout UK" if used nationally. The Opponents stated use "throughout the UK".
51. The criteria for a passing off claim have been well established through UK case law. As set out in the decision by the House of Lords in *Reckitt & Colman Ltd v Borden Inc*⁷, the following three points must be established in order to claim passing off successfully:
- (a) First, the plaintiff must establish a **goodwill** or reputation attached to the goods or services which it supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which its particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiffs goods or services.
 - (b) Second, the plaintiff must demonstrate a **misrepresentation** by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are the goods or services of the plaintiff.
 - (c) Third, the plaintiff must demonstrate that it suffers or that it is likely to suffer **damage** by reason of the erroneous belief engendered by the defendant's misrepresentation that

⁷ [1990] 1 All E.R. 873

the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.

52. On the question of goodwill in this case, there is good evidence that the claimed services have been offered under the sign for several decades, through the long-standing operation of the fish and chip shop business at an address in Covent Garden in London. There is no evidence that the sign has been used in relation to the claimed services beyond that single outlet (although page 11 of **Exhibit 8** did include an article from *The Caterer* in August 2014 where expansion plans to other sites were described, but there is no indication that those plans proceeded to fruition). I am therefore doubtful that its goodwill could be considered national, especially considering the nature of the services. However, its claim to be among the oldest fish and chip shops and the publicity it has attracted through coverage in the various media articles, reviews and guides, certainly show that it draws custom from visitors to London (as well as from Londoners). My primary finding on the point is that while the sign clearly benefits from goodwill in relation to the claimed services, the extent of the goodwill is local to London and the surrounding area. On that basis I proceed to consider the second necessary criterion, namely that there be a misrepresentation.
53. The test for misrepresentation is essentially a question as to whether, if the Applicant were to use its mark, a substantial number of the Opponents' customers or potential customers would be misled into purchasing the Applicant's goods or services in the belief that they are those of Opponents.⁸ In circumstances such as those before me, where goods and services are sold to the general public, the question as to whether such buyers would be likely to be deceived or confused by the use of the trade mark is akin to a "jury question"; as a hearing officer I must use my own common sense and consider whether I would myself be likely to be deceived or confused, while being alert to the danger of allowing my own idiosyncratic knowledge or temperament to influence my decision.⁹

⁸ I note the guidance of Morritt LJ in *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, who quoted *intra alia* from the judgment of Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407.

⁹ Again, see Morritt LJ in the *Neutrogena* case where he quoted Lord Diplock in *GE Trade Mark* [1973] R.P.C. 297 at page 321.

54. Case law has distinguished between ‘mere wondering’ on the part of a consumer as to a trade connection and an actual assumption of such a connection.¹⁰ In *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* Jacob LJ stated that what was needed for passing off would normally be substantial numbers of “assumers” and that the presence of some “mere wonderers” was not sufficient.
55. While the test for likelihood of confusion under trade mark law is not the same as the test for misrepresentation under the law of passing off, it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments. This observation seems in line with the Court of Appeal decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, where Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. He concluded: “... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”
56. Taking account of the various case law principles set out in the preceding paragraphs, and on the basis of the same considerations and analysis around the low levels of similarity between the signs that led me to conclude that there would be no likelihood of confusion on the part of the average consumer, I likewise conclude that use of the mark applied for would not lead to the deception of a substantial number of the Opponents’ customers or potential customers, and thus there would be no real effect on their trade or goodwill.
57. Given the understandable seaside connection between both components of the Applicant’s mark (‘rock’ and ‘scallop’) and the absence of any punning element, I find it unlikely that the mere overlap of “The rock &” between the signs would give rise even to a substantial number of “mere wonderers”, let alone to a substantial number of “assumers”. The evidence from Ms Skelding relating to the low numbers of “the rock”-based signs in the trade mark register or referenced on TripAdvisor has no disruptive effect on my conclusion. Even if I had found

¹⁰ [2007] RPC 5 at 16–17. See too paragraph 54 of the judgment of Mr Iain Purvis QC, as a Recorder of the Court, in *W.S. Foster & Son Limited v Brooks Brothers UK Limited*, [2013] EWPC 18 (PCC).

goodwill to be national that would not change my assessment that there is no misrepresentation. **The claim under section 5(4)(a) fails.**

The section 5(3) claim

58. Section 5(3) of the Act states that a trade mark that is identical or similar to an earlier trade mark shall not be registered to the extent that the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

The relevant case law for section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel Corporation*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure*, Case C-487/07 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

- (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious

likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.
- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.
- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

59. The function and value of a trade mark are not confined to its being an indicator of origin of goods or services (which section 5(2)(b) safeguards); a trade mark can also convey messages, such as a promise or reassurance of quality or a certain image of, for example,

lifestyle or exclusivity ('advertising function').¹¹ Section 5(3) aims at protecting this advertising function and the investment made in creating a certain brand image by granting protection to reputed trade marks, irrespective of the similarity of the goods or services or of a likelihood of confusion, provided that it can be demonstrated that the use of the contested application without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark. Thus, for a claim under section 5(3) of the Act to succeed, requires (i) **identity or similarity** between the contested application and the earlier mark; (ii) evidence that the earlier **registered mark has a reputation** in the relevant territory (in this case, the UK); (iii) that use of the sign applied for must be capable of taking an unfair advantage of, or being detrimental to, the distinctiveness or the repute of the earlier mark; and (iv) that such use must be **without due cause**. These conditions are **cumulative** and failure to satisfy any one of them is sufficient to defeat the claim.

60. Before I address what I consider the central issue in this instance – the similarity or otherwise of the marks – I will first deal with the question of reputation. To show that an earlier mark has acquired a reputation there must be clear and convincing evidence to establish all the facts necessary for a tribunal to conclude safely that the mark is known by a significant part of the public. Reputation cannot be merely assumed and must be evaluated by making an overall assessment of all factors relevant to the case.
61. The CJEU in *General Motors* gives guidance on assessing the existence of a reputation. Paragraph 27 of that judgment requires that I “*take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.*”
62. In *Enterprise Holdings Inc. v Europcar Group UK Ltd*,¹² Arnold J stated that proving a reputation “*is not a particularly onerous requirement.*” However, the evidence before Arnold J in that case showed that the claimant was in fact the market leading car hire company in the UK with a 30% share of the UK market. It was in that context that the judge said that proving a reputation “*is not a particularly onerous requirement.*” He had no reason to turn

¹¹ (judgment of 18/06/2009, C-487/07, L'Oréal, EU:C:2009:378)

¹² [2015] EWHC 17 (Ch)

his mind to situations where the claimant had only a small and/or unquantified share of the relevant market.

63. Nonetheless, I take note of the comments of the General Court in *Farmeco AE Dermokallyntika v OHIM*,¹³ where it stated that a finding that an earlier mark had a reputation “... is not called into question by the applicant’s argument that the turnover figures for sales and the amount spent on promoting the goods covered by the earlier marks ... have not been proved. It should be pointed out that the absence of figures is not, in itself, capable of calling into question the finding as to reputation. First, the list of factors to be taken into consideration in order to ascertain the reputation of an earlier mark only serve as examples, as all the relevant evidence in the case must be taken into consideration and, second, the other detailed and verifiable evidence produced by the opposing party is already sufficient in itself to prove the reputation of its mark ...”.
64. Mr Ziyaeddin states in his evidence that the Opponents have spent an average of between £12,000 and £18,000 annually on advertising and promoting; those are not strikingly large sums, and nor is that expenditure is not specified or documented. However, the evidence does show that for well over a decade there has been actual promotion of the mark, via, for example reviews and profiles. No figures are provided on market share, but the mark appears to have been used only in connection with a single (though popular) food outlet. Its use has therefore been very restricted in geographical terms and its market share inevitably very limited. Overall, I am doubtful that the earlier mark satisfies the criteria for the required level of reputation to sustain a claim under section 5(3), in which case the claim on that ground would necessarily fail. However, in case I am wrong in that assessment, I proceed now to consider another of the central criteria – the requirement for a link to be made in the mind of the relevant public.
65. According to case law¹⁴, the types of injury or damage under section 5(3) may be the consequence of a lesser degree of similarity between the earlier and the later mark than may be required for a likelihood of confusion. The level of similarity required under section 5(3) must be sufficient for the relevant section of the public to make a connection between the respective marks. I must make a global assessment as to whether or not, a significant

¹³ Case T-131/09 at paragraph 59

¹⁴ See by analogy paragraph 72 of the ruling of CJEU in *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P.

part of the relevant public (which will include the general public) would make a link between the earlier mark and the Applicant's later mark, taking account all relevant factors, especially: the degree of similarity between the respective marks and between the goods/services; the extent of the overlap between the relevant consumers for those goods/services; and the strength of the earlier mark's reputation and distinctiveness for the goods and services registered.

66. My previous findings have included that the marks may be considered visually similar to (at most) a degree between low and medium, aurally similar to a low degree and conceptually similar only to very low degree. Those assessments apply equally in relation to section 5(3). I find that despite there being identical services at issue, the mere overlap of "The rock &" between the signs is not sufficient to give rise to the required mental link on the part of the relevant section of the public. While the earlier mark is distinctive for the relevant services, any reputation that it may enjoy will be associated with its "fanciful structure" (as the Opponent described it in its statement of grounds). The absence from the Applicant's mark of any punning element and the understandable seaside connection between both components of the Applicant's mark ('rock' and 'scallop') will avoid any link being made to the earlier mark. Since I find that no link will arise, **the section 5(3) claim must also fail**, and, in the circumstances, it is unnecessary to consider the claimed bases of damage.

OUTCOME

- 67. The opposition has failed across all three of its claimed grounds under sections 5(2)(b), section 5(3) and 5(4)(a) and the application can proceed in relation to all of its services.**

COSTS

68. This opposition has failed in its entirety and, in such circumstances, an applicant would generally be entitled to a contribution towards its costs of defending its application. In a letter dated 2 April 2019, which notified parties at the end of the evidence rounds that the matter was ready for a decision, the registry informed the Applicant that if it intended to request costs it would have to complete and return the provided pro-forma, with copy to the other side. The letter set out the need to include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed. It stated that the Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum

level of compensation for litigants in person in Court proceedings at £19.00 an hour. The letter also explained that if the proforma were not completed and returned, no costs would be awarded. The Applicant does not appear to have filed a completed costs proforma and **I therefore make no award of costs in this case.**

Dated this 02nd day of October 2019

**Matthew Williams
For the Registrar**
