

BL O-184-20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3374053

BY R7 RESTAURANTS LTD

TO REGISTER:

SUPERMAX

AS A TRADE MARK IN CLASS 43

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 416330

BY SUPERMAC'S (HOLDINGS) LTD

BACKGROUND & PLEADINGS

1. On 8 February 2019, R7 Restaurants Ltd (“the applicant”) applied to register **SUPERMAX** as a trade mark for the services shown in paragraph 14 below. The application was published for opposition purposes on 15 February 2019.

2. On 15 May 2019, the application was opposed in full by Supermac’s (Holdings) Ltd (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). In its Notice of opposition, the opponent indicates that it relies upon all the services (which are the same in both specifications and shown in paragraph 14 below) in the following European Union Trade Mark (“EUTM”) applications:

(1) no. 15442023 for the trade mark **SUPERMAC’S** which was applied for on 17 May 2016 and is yet to achieve registration.

(2) no. 16583379 for the trade mark shown below:

The logo for Supermac's is written in a red, cursive script. The word 'Supermac's' is written in a fluid, handwritten style with a red underline beneath the letters 'mac's'.

“Mark details

Colours Claimed/Indication:

Red.”

This trade mark was applied for on 10 April 2017 and is yet to achieve registration.

3. In its Notice of opposition, the opponent stated:

“The trade marks are highly visually, aurally and conceptually similar. The services in the opposed application are identical or highly similar to those covered by the earlier application...”

4. The applicant filed a counterstatement in which it stated:

“Opposition states the trademark is visually and conceptually similar which is not the case with a very different logo for example and wording is different though aurally is similar.

The services are deemed identical by the opposition. Our service and activity is that of a late-night cocktail bar and private hire venue. The opposition's service is a fast-food restaurant which is not of similar nature.

In addition, given the significant difference in geographical location (as well as difference of service) we believe it very unlikely this would cause consumer confusion.”

5. In these proceedings, the opponent is represented by Carpmaels & Ransford LLP; the applicant represents itself. No evidence has been filed. While neither party requested a hearing, the opponent elected to file written submissions in lieu of attendance. I shall keep these written submissions in mind, referring to them to the extent I consider it necessary.

DECISION

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

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

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

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

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

7. An earlier trade mark is defined in section 6 of the Act, which states:

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

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

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

8. The trade marks being relied upon by the opponent have filing dates earlier than that of the application for registration. However, as section 6(2) of the Act makes clear, they will only qualify as “earlier trade marks” if and when they achieve registration. In such circumstances, the tribunal has for many years suspended proceedings to await the outcome of the application(s) being relied upon (Tribunal Practice Notice (“TPN”) 3 of 2004 refers). It is not clear why that approach was not adopted in these proceedings. However as it was not, I will revert to the tribunal’s previous practice and, if the opponent is successful, this decision will be an interim one. As the trade marks being relied upon are still applications, the proof of use provisions are not relevant.

Case law

9. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha*

v Metro-Goldwyn-Mayer Inc, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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.

My approach to the comparison

The applicant's counterstatement

10. In its counterstatement, the applicant refers to what it regards as the differences in what appear to be the actual areas of trade of interest to the parties and the differing geographical areas in which they operate. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the trade mark applied for might be used if it were registered.

11. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

12. While I understand the applicant’s submissions, as the opponent submits, they proceed on a misunderstanding of the comparison I am required to make. As neither party’s specification is limited in any way, the fact that the parties may operate in different geographical areas is not a factor I can take into account. Nor is it a relevant consideration that at present the parties are trading in what the applicant regards as discrete parts of the market. Rather what I must do, is compare the competing specifications and trade marks on the basis of notional and fair use.

The trade marks being relied upon by the opponent

13. The opponent is relying upon the two trade mark applications shown in paragraph 2 above, the specifications for which are identical. Although trade mark no. (2) is presented in a cursive script in the colour red and is partially underlined, the script is not unusual, the colour and underlining add very little and it is still readily discernible as the word “Supermac’s”. Consequently, it matters not upon which trade mark I conduct the comparison. If the opponent succeeds upon the basis of the first trade mark it relies upon i.e. SUPERMAC’S it will also succeed in relation to its second trade mark. This is important because as I mentioned earlier, the opponent is relying upon two pending trade marks, only one of which may achieve registration.

Comparison of services

14. The competing services are as follows:

Opponent's services	Applicant's services
<p>Class 43 - Services for providing food and drink; restaurant services; fast-food restaurant services; canteens; self-service restaurant services; takeaway services; snack-bars.</p>	<p>Class 43 - Bar and restaurant services; Bar services; Bars; Booking of restaurant seats; Café services; Cafe services; Cafés; Cafeterias; Carry-out restaurants; Catering; Catering (Food and drink -); Catering for the provision of food and beverages; Catering for the provision of food and drink; Catering of food and drink; Catering of food and drinks; Cocktail lounge services; Cocktail lounges; Coffee bar services; Coffee shops; Consultancy services in the field of food and drink catering; Food and drink catering; Food and drink catering for cocktail parties; Hospitality services [food and drink]; Lounge services (Cocktail -); Night club services [provision of food]; Pizza parlors; Preparation of food and drink; Provision of food and drink; Provision of food and drink in restaurants; Pubs; Rental of rooms; Rental of rooms for social functions; Restaurant and bar services; Restaurants; Services for providing food and drink; Serving food and drink for guests; Serving of alcoholic beverages; Wine bar services; Wine bars.</p>

15. In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

"... 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."

18. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

19. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

20. 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”.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

22. In its submissions, the opponent states:

“The class 43 services covered by the Contested Application are identical to the services covered by the Earlier Rights. All of the services in the Contested Application are a subset of “*services for providing food and drink*” in the Earlier Rights. The remaining services covered by the Earlier Rights, for example, “*fast-food restaurant services*”, are highly similar to the services in the Contested Application, such as “*restaurant and bar services*”. As such, the Opponent’s services and the Applicant’s services are identical.”

23. The opponent’s specification includes the broad terms “services for providing food and drink” and “restaurant services”. Having applied the above case law and in particular the guidance in *Avnet*, when considered together these terms are, in my view, either literally identical (because the same words are used), are synonymous, or are to be regarded as identical on the inclusion principles outlined in *Meric*, to the vast majority of the terms in the application. Although that may not apply to “booking of restaurant seats”, “rental of rooms” and “rental of rooms for social functions”, given the obvious overlap in, at least, the users, intended purpose and complementary nature of these services to those of the opponent, they are, in my view, similar to at least a medium degree.

24. The exception is the “consultancy services in the field of food and drink catering”. It appears to me that the average consumer of such services is much more likely to be business users who are either already involved in or wish to become involved in the catering business as opposed to the general public who are the average consumer of the remainder of the services at issue (see below). The nature of the service and its intended purpose are also likely to differ from those of the opponent, there appears to be no competitive relationship involved and the types of undertakings supplying such services are also likely to differ. That leaves complementarity to be considered. To be regarded as complementary in a trade mark sense, there needs to be a “close connection between [the services], 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 [services] lies with the same undertaking”. Absent evidence or submissions to assist me, there is, as far as I can tell, no meaningful degree of complementarity between the applicant’s named services and those of the opponent.

25. Considered overall, there is, in my view, no meaningful degree of similarity between the applicant’s named services and those of the opponent. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

26. As a consequence, the opposition to the applicant’s “consultancy services in the field of food and drink catering” fails and is dismissed accordingly.

The average consumer and the nature of the purchasing act

27. As the case law above indicates, it is necessary for me to determine who the average consumer is for those services I have found to be identical/similar. I must then determine the manner in which such 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.”

28. The average consumer of the services at issue is a member of the general public. My own experience as an average consumer (which I do not regard as atypical), informs me that such services are most likely to be selected having considered, for example, promotional material and reviews (in hard copy and on-line) and on signage appearing on the high street; as a consequence, visual considerations will be an important part of and are likely to dominate the selection process. However, as such services are also, in my experience, very likely to be the subject of word-of-mouth recommendations, aural considerations will be a not-insignificant feature of the process. The degree of care the average consumer will display when selecting such services is likely to vary. Contrast, for example, the low degree of care likely to be taken when one selects a venue for an impromptu snack, with the fairly high degree of attention one is likely to take when selecting a restaurant for an important family event. I shall return to this point when I consider the likelihood of confusion.

Comparison of trade marks

29. 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 them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

30. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
SUPERMAC'S	SUPERMAX

31. The opponent's trade mark consists of the word SUPERMAC'S presented in block capital letters. As no part of the trade mark is highlighted or emphasised in any way, the overall impression it conveys and its distinctiveness lie in the trade mark as a whole. It will not, however, escape the average consumer's attention that it contains the laudatory word "SUPER". The same considerations apply to the applicant's trade mark, albeit with the average consumer noticing it ends with the abbreviation for maximum i.e. "MAX" (which also has laudatory connotations).

Visual similarity

32. The competing trade marks consist of eight and nine letters respectively. The first seven letters are identical. They differ to the extent that the applicant's trade mark ends with a letter "X" whereas the opponent's trade mark ends with the letters "C-S" with an apostrophe symbol appearing between those letters. Weighing the similarities and differences including the positioning of the latter, results in what I regard as a high degree of visual similarity.

Aural similarity

33. In its counterstatement, the applicant admits the competing trade marks are aurally similar. I would go further. In my view the competing trade marks are aurally identical.

Conceptual similarity

34. The laudatory word "SUPER" appears in both trade marks and will send the same conceptual message. Other than containing an additional laudatory reference i.e. "MAX", beyond that, I am not convinced that either trade mark will evoke any concrete conceptual image in the mind of the average consumer.

Distinctive character of the earlier trade mark

35. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

36. As the opponent has filed no evidence of any use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. Although the opponent's trade mark includes the laudatory word "SUPER" when considered as a totality, there is nothing to suggest it is either descriptive of or non-distinctive for the services for which it seeks registration. It is, as a consequence, possessed of a medium degree of inherent distinctive character.

Likelihood of confusion

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

38. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and services down to the responsible undertakings being the same or related.

39. Earlier in this decision I concluded that:

- the remaining services in the application are to be regarded as at least similar to a medium degree and, for the most part, identical to those of the opponent;

- the average consumer is a member of the general public who will select such services using a combination of visual and aural means whilst paying varying degrees of attention during that process;
- the competing trade marks are visually similar to a high degree, aurally identical and conceptually similar in that they both evoke the concept of superiority;
- the opponent's earlier trade mark is possessed of a medium degree of inherent distinctive character.

40. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of words tend to have more visual and aural impact than the ends.

The court stated:

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

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

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

41. I shall consider the matter from the position most favourable to the applicant i.e. that the average consumer will pay a high degree of attention during the purchasing process, thus making him/her less prone to the effects of imperfect recollection. However, even proceeding on that basis, the degree of similarity and identity in the competing services combined with the high degree of visual similarity and aural identity, results in a likelihood of direct confusion. That conclusion is even more pronounced should the average consumer pay a less than high degree of attention when selecting the services at issue.

Overall conclusion

42. Subject to any successful appeal, the application will be refused in relation to all the services for which registration has been sought, with the exception of "consultancy services in the field of food and drink catering" which will be allowed to proceed to registration.

What happens now?

43. Subject to successful registration in respect of relevant services the opponent will partially succeed on the basis of one or other of its trade marks. Consequently a final decision cannot be given in relation to these proceedings until one or other of the two trade marks being relied upon is finally determined.

44. I direct that Carpmaels & Ransford LLP advise the tribunal and the applicant within one month of the final determination of one or other of the EUTM applications of the outcomes of the application(s). On receipt of this information a supplementary

decision will be issued giving a full determination of the opposition proceedings and making an award of costs.

Dated this 19th day of March 2020

C J BOWEN

For the Registrar