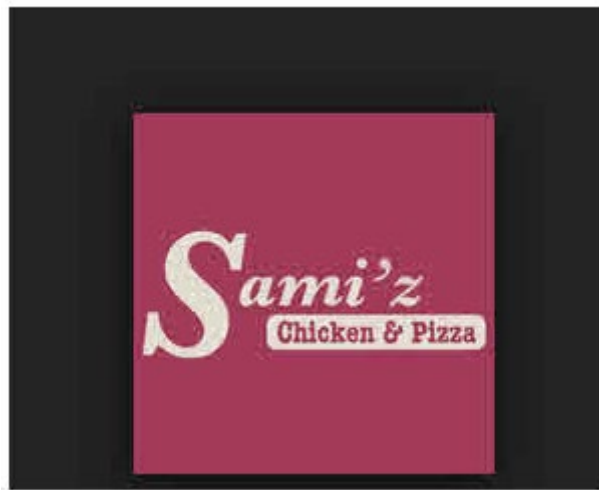


O/358/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3418523
AND THE REQUEST BY MOHTASIM PAL
TO REGISTER THE TRADE MARK



IN CLASS 43

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 419041
BY SAM'S CHICKEN LIMITED



Background and pleadings

1. On 2 August 2019, Mohtasim Pal (“the Applicant”) applied to register the figurative mark shown on the front page of this decision, in Class 43 for “*take away food services*”. The application was published for opposition purposes in the Trade Marks Journal on 11 October 2019.
2. It is opposed by Sam’s Chicken Limited (“the Opponent”) which relies on the following trade marks, which I will refer to as Marks A, B and C in this decision:

Mark A (series of 4 marks):

Representation	Details
1. 	Figurative mark UK registration No. 2510175
2. 	Application filed on 3 March 2009 Entered in the register on 31 July 2009
3. 	Class 43: Provision of food and drink; restaurant services and catering services
4. 	

Mark B (series of 2 marks):

Representation	Details
1. 	Figurative mark UK registration No. 3010945
2. 	Application filed on 21 June 2013 Entered in the register on 27 September 2013 Class 43: Services for providing food and drink; provision of food and drink; restaurant services; take away services; catering services.

Mark C:

Representation	Details
	Figurative mark EU trade mark registration No. 15715105 Application filed on 2 August 2016 Entered in the register on 5 December 2016 Class 43: Services for providing food and drink; provision of food and drink; restaurant services; take away services; catering services; restaurant services incorporating licensed bar facilities.

3. The Opponent opposes the trade mark application in full, on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), which concerns similar trade marks and identical/similar goods, resulting in a likelihood of confusion.

4. An “earlier trade mark” is defined in section 6(1) of the Act as:

“(a) a registered trade mark, international trade mark (UK), a European Union 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”

5. Each of the trade marks relied upon by the Opponent has a filing date that predates that of the Applicant’s trade mark. The Opponent’s Mark C is an EU trade mark (“EUTM”). Although the UK has left the EU and the Transition Period has now expired, such EUTMs remain relevant in these proceedings in light of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice (2/2020) on “*End of Transition Period - impact on tribunal proceedings*” provides guidance in relation to tribunal proceedings such as those in the present case, which were launched before the end of the Transition Period. For “tribunal proceedings launched before IP Completion Day (i.e. before 11pm on 31 December 2020)”, the guidance states that “*the transitional provisions provide that these proceedings should continue to be dealt with under the Act as it existed before IP Completion Day (i.e. the old law continues to apply).*” It adds that: “*Users should note the following:*

- *EUTMs and IR(EU)s will continue to constitute earlier trade marks for the purpose of these proceedings. This applies to both registered and pending marks, although, in the case of the latter, this is subject to the earlier mark subsequently being registered or protected.*
- *it will not be possible to substitute in, or add, comparable marks or re-filed EUTM/IR(EU)s into these proceedings.”¹*

6. Under section 6A of the Act, a proprietor has a period of five years following registration in which to use its trade mark. Marks A and B had been registered for more than five years before the date the Applicant applied for the contested mark.

¹EU trade mark No. 15715105 is now protected in the UK under comparable trade mark No. UK00915715105.

These marks are therefore subject to section 6A, meaning that they must have been put to genuine use in the UK by the proprietor, or with his consent in relation to the goods and services for which they are registered. The Opponent has duly provided a statement of use of its marks in relation to all its registered goods and services under Marks A and B.

7. In an opposition, the applicant may require the opponent to provide evidence to substantiate the opponent's statement of use. In its notice of defence and counterstatement (Form TM8), the Applicant ticked the box requiring the Opponent to provide such proof of use. However, the Applicant did not, as is required by the form, indicate which of the Opponent's registrations the request applied to. As this information was not provided in Form TM8, nor following requests from the Tribunal, this case proceeds on the basis that the Applicant did not request proof of use of Marks A and B.
8. Mark C had not been registered for five years before the date the Applicant applied for the contested mark and is therefore not subject to the proof of use requirement.
9. In conclusion, the Opponent can rely on all the goods and services in Marks A, B and C, without having to provide evidence as to how it has used its marks.
10. In its statement of grounds, the Opponent submits that the dominant and distinctive element in the Opponent's registrations is the word "Sam's", which is highly similar to "Sami'z", which is the dominant and distinctive element in the Applicant's mark. The Opponent argues that all its services in Class 43 are either identical or similar to *take away food services* in the Applicant's mark. The Opponent concludes that due to the similarity between the marks and the services, there is a likelihood of confusion on the part of the relevant public.
11. On 15 December 2020, the Opponent filed submissions restating, and building upon the arguments in its statement of grounds. The submissions related, for instance, to the average consumer and purchasing act for take away services, the distinctive character of the earlier marks, and a comparison of the marks. I have

read and considered all the submissions and will return to these in my decision, as appropriate.

12. In its defence and counterstatement, the Applicant admitted that there is some similarity between its mark and the Opponent's earlier marks but denied that there would be confusion on the part of the public. The Applicant listed the differences between the respective marks, referring to the spelling, colour, font and background of the marks. No further written submissions have been provided by the Applicant.

13. In these proceedings, the Opponent is represented by Boulton Wade Tennant LLP, the Applicant represents itself.

14. In respect of the UK's departure from the EU, it should be noted that section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the Transition Period. The provisions of the Trade Marks Act 1994 relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

DECISION

15. Section 5(2)(b) of the Act states:

“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”.

16. The following principles are gleaned from the decisions of the CJEU 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 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 might 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

17. In considering the extent to which there may be similarity between the services, I take account of the guidance from relevant case law. Thus, in Canon the Court of Justice of the European Union (“the CJEU”) stated that:

“In assessing the similarity of the goods or services concerned, ... 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”.*²

18. The relevant factors identified by Jacob J. (as he then was) in the Treat³ case 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.

19. I also bear in mind that terms used to specify services should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.⁴

20. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the General Court of the European Union 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).⁵

² Case C-39/97, at paragraph 23.

³ *British Sugar PLC v James Robertson & Sons Ltd.*, 1996 R.P.C. 281.

⁴ See, for example, Lord Justice Arnold at paragraph 47 of *Sky v Skykick* [2020] EWHC 990 (Ch).

⁵ *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, case T-133/05 at paragraph 29. See Case T-388/00 *Institut für Lernsysteme v OHIM — Educational Services (ELS)* at paragraph 53 for this principle applied to services.

21. The Opponent relies on all its Class 43 services from its three earlier registrations:

Mark A	Provision of food and drink; restaurant services and catering services.
Mark B	Services for providing food and drink; provision of food and drink; restaurant services; take away services; catering services.
Mark C	Services for providing food and drink; provision of food and drink; restaurant services; take away services; catering services; restaurant services incorporating licensed bar facilities.

22. The Applicant's services are "*take away food services*" in Class 43. Marks B and C include "*take away services*", which are plainly identical to the Applicant's services. Mark A includes "*provision of food and drink*" and "*restaurant services*" which encompass the Applicant's "*take away food services*". The services in Mark A are therefore identical to the services in the Applicant's mark under the *Gérard Meric* principle.

23. In conclusion, I find the services in the Applicant's mark to be identical to the services under each of the Opponent's earlier marks. I note that in its submissions, the Opponent has compared each of its individual services to "*take away food services*" in the Applicant's mark. As I have found identical services within the Opponent's earlier marks, it is not necessary for me to continue to compare the Applicant's services to the remaining services relied upon by the Opponent.

Average consumer and the purchasing act

24. It is necessary to determine who is the average consumer for the respective services and how the consumer is likely to select them.

25. In *Hearst Holdings Inc*⁶, Birss J. explained that:

⁶ *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.

“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 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 ...”

26. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*⁷.

27. The Opponent submits that the average consumer of the services is the general public who will pay an average degree of attention. The Opponent also submits that in respect of low cost food, the level of attention paid may even be low for the services. In terms of the purchasing process, the Opponent submits that the services *“are likely to be selected orally, say by discussion amongst a group of diners, or chosen from a menu or leaflet. Therefore, the way the marks look and sound are more important than their meaning.”*

28. I agree with the Opponent that the average consumer of the services is the general public. Restaurant and takeaway services are a reasonably frequent purchase, although this will vary for different people. The level of cost will also vary, but overall the level of expenditure is fairly low. In respect of the level of attention paid by the average consumer, I consider this to be medium for the services, even for low cost food. When selecting food services, such as a restaurant or takeaway, in addition to considering the type of food offered by the service provider, the average consumer will also pay attention to factors including dietary requirements, food hygiene ratings and recommendations from friends, family, colleagues etc. Consumers of the services will in many cases consider this as a treat and will also want to take care in selecting the services to ensure a good experience and pleasurable meal. I therefore disagree with the Opponent's statement that a low

⁷ Case C-342/97.

level of attention would be paid by the average consumer of the services and find the level of attention paid to be medium.

29. In terms of the purchasing act, takeaway services will often be selected from a range of leaflets or menus provided by service providers; or a list of local takeaways on a website or search engine. Restaurant services will also frequently be selected from a list of local restaurants on a website or search engine. In settings outside of the home or office etc., takeaway and restaurant services will usually be selected from a range of establishments on a high street, in a shopping centre, airport or other location with a high level of footfall. In these cases, the mark will be visible on signage outside the establishment and likely inside as well, where it will appear on menus and perhaps on staff apparel. I find the purchase of the services to be predominantly visual, however, aural considerations are also relevant, on the basis of word of mouth recommendations.

Comparison of marks

30. It is clear from *Sabel BV v. Puma AG*⁸ (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*,⁹ 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.”

⁸ Case C-251/95.

⁹ Case C-591/12P.

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

32. The Opponent relies on three earlier registrations, two of which consist of a series of marks. All the Opponent’s marks consist of the word “Sam’s”, in the same font and on top of a device of overlapping letter “S” shapes. In each mark the device has a contrasting colour or shade to the word “Sam’s” (yellow device with red word; light grey device with dark grey/black word). Marks A and C feature a by-line consisting of descriptive words for the services (“CHICKEN & PIZZA”; “PIZZA & CHICKEN”; “CHICKEN”). Mark C features a brown background.

33. Due to the similarities between the Opponent’s marks I will begin my comparison with the mark that I consider shares the most corresponding features with the Applicant’s mark. I have therefore selected Mark A, representation 1. Following my analysis of Mark A, representation 1, I will briefly consider the Opponent’s other marks.

34. The respective trade marks are shown below:

Earlier trade mark	
Contested trade mark	

35. A number of elements contribute to the overall impression of the Opponent’s earlier trade mark: (i) the large, central word “Sam’s”; (ii) a background row of overlapping letter “S” shapes; (iii) the smaller words “CHICKEN & PIZZA” written beneath.

36. I find the dominant and most element of the Opponent's mark to be the word "Sam's", although the font, colours and "S" background device elements contribute to the overall impression and serve to focus attention on the word "Sam's". As to element (iii), the average consumer will understand "CHICKEN & PIZZA" as designating that the service provider offers these types of foods; that element is thus non-distinctive.

37. A number of elements contribute to the overall impression of the Applicant's mark: (i) the word "Sami'z", where (ii) the first letter "S" is much larger than the other letters, (iii) the non-distinctive words "Chicken & Pizza", (iv) the presentation of words in the centre of a dark red square, which itself is positioned in the lower part of a black rectangle. I find the word "Sami'z" to be distinctive and dominant in the Applicant's mark.

Visual similarity

38. The Opponent highlights certain similarities between the marks and concludes that there is an *"average or strong visual similarity between the marks"*.

39. I acknowledge that visually, the marks both feature, as the dominant and distinctive element, a word that starts with a letter "S" which is larger than the following letters. These words have the same opening three letters "Sam" and there is an apostrophe, followed by one further letter at the end of the words. I acknowledge too that in both marks that same words "Chicken & Pizza", with an ampersand in place of the word "and", are positioned below and to the right of the dominant word. Both marks feature the colour red, although the tone of red in the Opponent's mark appears to be a letterbox red; whereas in the Applicant's mark, it is a dark shade of red, almost burgundy.

40. The marks differ in that the Opponent's mark consists of three letters before the apostrophe, whereas the Applicant's mark consists of four letters before the apostrophe. In the Opponent's mark, there is a letter "s" after the apostrophe, whereas in the Applicant's mark, there is a letter "z" after the apostrophe. I do not agree with the Opponent that the first letter "S" in the Applicant's mark is *"slightly*

larger” than the following letters, as I find it to be significantly larger, reaching below the line of the following letters. This compares to the letter “S” in the Opponent’s mark, which appears as a capital letter, with the same relative proportions as the following letters in the word “Sam’s”. Other visual differences between the marks concern the letter “S” background device in the Opponent’s mark, which is not present in the Applicant’s mark. Another difference is the dark-red square and black rectangle in the Applicant’s mark, which are not present in the Opponent’s mark.

41. Overall, the colour schemes and figurative elements in the marks are different. While both marks feature a by-line, consisting of the same words, these are descriptive words in relation to the services at issue (and generate no material visual similarity) and the positioning of the by-line, below and aligned to the right, is typical. I accept that both marks start with the same three letters, however, the words differ in overall length, in terms of the letter appearing after the apostrophe and in respect of the large letter “S” in the Applicant’s mark. In conclusion, I find the marks to be visually similar to a low degree.

Aural similarity

42. The Opponent submits that there is an “*average phonetic similarity between the marks*”. While accepting that there are two syllables in the Applicant’s mark, compared to one in the Opponent’s marks, the Opponent states that the Applicant’s mark “*could be heard as ‘Sammy’s’ rather than ‘Sami’z*”.

43. I consider that the Opponent’s mark will be spoken as “Sam’s”; the Applicant’s mark will be spoken as “Sam” “eez”. I accept that the apostrophe “z” in the Applicant’s mark provides a very similar sound to the apostrophe “s” in the Opponent’s mark. “Pizza & Chicken” will be spoken in exactly the same way, but as these are descriptive elements within the marks, they generate little or no material similarity.

44. Overall, there is an overlap in the first syllable of the distinctive and dominant element in the respective marks, “Sam”. However, the marks differ aurally, with the

distinctive and dominant element of the Opponent's mark consisting of one syllable; as compared to the two syllables in the Applicant's mark. In respect of the Opponent's submission on the similarity of "Sammy's" and "Sami's", although "Sam" "eez" does sound like "Sammy's", the Opponent's mark is "Sam's" and not "Sammy's".

45. I find the marks to be aurally similar to a degree that is somewhere between low and medium.

Conceptual similarity

46. The Opponent submits that there is an *"average or strong conceptual similarity between the marks"*. The Opponent concludes this based on both marks being *"perceptible as names"* and with part of the distinctive and dominant component of the Opponent's mark "Sam" being wholly contained within the Applicant's mark. The Opponent also contends that conceptual similarity arises from the apostrophes in both marks, which indicate possession.

47. Conceptually, I consider the marks to align in that their dominant and distinctive elements consist of a name, with an apostrophe and further letter that signifies possession. However, they are different names, with one being a well-known and commonly found first name in the UK, often short for "Samuel", or "Samantha" and the other being a name that is not particularly common in the UK.

48. There is conceptual identity between the by-line "Pizza & Chicken", so consumers will understand that both service providers offer these types of foods. However, little or no significance can be accorded to this, as this element of the marks is descriptive of the services.

49. Overall, I find the marks to be conceptually similar to a low degree, with a notably conceptual difference as to the named origin of the services provided.

Opponent's remaining marks

Mark A:

50. Mark A consists of a series of four marks, the first of which has been the subject of my comparison above. Mark A, representation 2 is the same as representation 1, but with the "S" background device being light grey and the word "Sam's" being dark grey/black. The difference in colour does not alter my conclusions reached for Mark A, representation 1 and I find Mark A, representation 2 to be visually and conceptually similar to the Applicant's mark to a low degree, and aurally similar to a degree that is somewhere between low and medium.

51. Mark A, representations 3 and 4 have the by-line "PIZZA & CHICKEN", as opposed to "CHICKEN & PIZZA" in representations 1 and 2. Representation 3 has the same red and yellow colour scheme as representation 1; representation 4 has the same grey and black colour scheme as representation 2. The difference in the by-line in representations 3 and 4 does little to alter the visual, aural and conceptual identities of the marks, as this is descriptive of the services. If anything, the different by-line results in a marginally lower degree of similarity as the order of words in the by-line differs to that in the Applicant's mark.

52. I find Mark A, representations 3 and 4 to be visually and conceptually similar to the Applicant's mark to a low degree, and aurally similar to a degree that is somewhere between low and medium.

Mark B:

53. Mark B consists of a series of two marks which feature the same word "Sam's", in an identical font and appearing on top of the same "S" background device as in Mark A. Mark B, representation 1 shares the same colour scheme as representations 2 and 4 in Mark A. Mark B, representation 2 shares the same colour scheme as Mark A, representations 1 and 3.

54. The difference in Mark B is that the mark representations do not include a descriptive by-line. The lack of a by-line in Mark B does little to alter my conclusions

on visual, aural and conceptual similarity between the Applicant's and Opponent's marks. If anything, there is a marginally lower degree of similarity than I found in respect of Mark A, representation 1 due to the lack of by-lines informing the consumer of the services on offer.

55. I find Mark B, representations 1 and 2 to be visually and conceptually similar to the Applicant's mark to a low degree, and aurally similar to a degree that is somewhere between low and medium.

Mark C:

56. Mark C features the same word "Sam's", in an identical font and appearing on top of the same "S" background device as in Marks A and B. The colour scheme of Mark C is red and yellow, as in Mark A, representations 1 and 3 and Mark B, representation 2. Mark C features a by-line which appears in the same position as those in Mark A, however the text in this by-line is "CHICKEN" alone. There is a brown background in Mark C, that does not feature in Marks A and B.

57. Comparing Mark C to the Applicant's mark, my conclusions on visual, aural and conceptual similarity are the same as for Mark A, representation 1. If anything, there is marginally lower similarity than I found in Mark A, representation 1 as the by-line in Mark C is shorter and does not correspond to that in the Applicant's mark. Also, the colour brown does not feature in the Applicant's mark.

58. I find Mark C to be visually and conceptually similar to the Applicant's mark to a low degree, and aurally similar to a degree that is somewhere between low and medium.

Distinctive character of the earlier trade marks

59. The distinctive character of the earlier mark must be assessed, as the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion (*Sabel* at [24]). In *Lloyd Schuhfabrik*¹⁰, 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...”

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...”

60. I agree with the Opponent’s view that “Sam’s” is the dominant and distinctive element of its earlier marks.

61. The Opponent submits that as the word “Sam’s” has no meaning in relation to the services, the distinctive character of the earlier marks must be considered to be high. While it is correct that the word “Sam’s” does not describe a characteristic of the services for which it is registered, I take judicial notice that service providers in the UK, including those providing food services, frequently use a personal name as a trade mark for their business. Consumers will be accustomed to seeing names used in this way, with “Sam” being a fairly common name in the UK. I therefore find the Opponent’s earlier marks to be inherently distinctive to no more than an average degree.

¹⁰ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

Likelihood of confusion

62. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and I now come to make a global assessment of these factors. In making this global assessment, I take stock of my findings in the foregoing sections of this decision and the authorities and principles that I have set out, in particular, at paragraph 16 above.

63. There are two types of confusion that I may find. The first type is direct confusion which occurs where the consumer mistakes one mark for another. The second type is indirect confusion, where the consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that the goods or services derive from the same, or a related economic undertaking.¹¹

64. In this decision I have found the services in the Applicant's and Opponent's marks to be identical and I keep in mind the interdependency principle which holds that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the services.¹² I note that the word element "Sam" appears in both marks and forms part of the distinctive and dominant element of the respective marks and I recall in this respect the general rule that the beginnings of a word tend to have more visual and aural impact than the ends.¹³ I note that I have found a medium degree of aural similarity and that I have found aural considerations to be relevant in the purchase of the services.

65. On the other hand, I note my finding that the marks are visually and conceptually similar to a low degree. Although the marks both consist of names, the names are clearly different, with one being fairly common in the UK and the other being a name found much less frequently. I keep in mind my finding that the distinctive character of the Opponent's marks is average (no more than that), with the average consumer being accustomed to first names being used as trade marks to distinguish between the providers of these types of services.

¹¹ L.A. Sugar Limited v Back Beat Inc, BL O/375/10

¹² Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc, Case C-39/97

¹³ El Corte Inglés, SA v OHIM, Cases T-183/02 and T-184/02

66. In terms of visual similarity, I have found the marks to have a different overall impression created by their figurative elements, including colours, letters and the “S” background device. I have found the services to be a predominantly visual purchase, meaning that the average consumer – who is deemed to be reasonably well informed and reasonably circumspect and observant – will see the figurative get-up of the marks, including on signage and leaflets and so is likely to perceive the visual differences that I have identified. Also, I have found the level of attention that the general public will pay when engaging the services to be medium, meaning that the average consumer is less likely to confuse the marks.

67. Taking a global assessment of my findings, I conclude that there is no likelihood of confusion between the Applicant’s and Opponent’s marks. A key point in reaching this conclusion is that the distinctive and dominant elements in the marks are names that are different and will be recognised as such by the average consumer, who is used to seeing names used as trade marks by service providers. This point, coupled with the clear differences in get-up between the marks means that the average consumer would not directly confuse the marks, by mistaking one for the other; nor would they believe the services to derive from the same, or a related undertaking, resulting in indirect confusion.

68. I have also considered the likelihood of confusion should my assessment of the level of attention be incorrect, and a low degree of attention is paid for the services. I find that, even paying a low degree of attention, the average consumer would neither directly nor indirectly confuse the marks for the same reasons as stated above, essentially, that the marks are composed of different names with different figurative features.

Conclusion

69. The opposition has failed and subject to any appeal, the application by Mohtasim Pal may proceed to registration for the applied for services in Class 43.

Costs

70. The Applicant has been successful. As the Applicant is representing itself, the Tribunal invited it to complete and return a proforma indicating the time spent on various activities associated with the proceedings. The Applicant did not return the form. I therefore make no award on costs.

Dated this 12th day of May 2021

Charlotte Champion

**For the Registrar
The Comptroller-General**