

o/786/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK3557800
BY FRESH UPS FOODS LIMITED
TO REGISTER THE SERIES OF TRADE MARKS:**

lebaneats

Lebaneats

LebanEats

IN CLASSES 39 & 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 423761
BY Ahmed Mohamed Hussein Sayed**

Background and pleadings

1. On 19 November 2020, FRESH UPS FOODS LIMITED (“the applicant”) applied to register the series of trade marks shown on the cover page of this decision in the UK. The application was published for opposition purposes on 29 January 2021. The applicant seeks registration for the following services:

Class 39: Food delivery services relating to fast food, takeaway food, restaurant food, and catering food.

Class 43: Banqueting services; Bar and restaurant services; Bistro services; Café services; Cafe services; Cafés; Cafeteria services; Cafeterias; Carvery restaurant services; Catering; Catering (Food and drink -); Catering for the provision of food and beverages; Catering for the provision of food and drink; Catering in fast-food cafeterias; Catering of food and drink; Catering of food and drinks; Catering services; Catering services for company cafeterias; Catering services for conference centers; Catering services for educational establishments; Catering services for hospitality suites; Catering services for hospitals; Catering services for nursing homes; Catering services for providing European-style cuisine; Catering services for providing Japanese cuisine; Catering services for providing Spanish cuisine; Catering services for retirement homes; Catering services for schools; Catering services for the provision of food; Catering services for the provision of food and drink; Coffee bar services; Coffee shops; Coffee supply services for offices [provision of beverages]; Contract food services; Cookery advice; Corporate hospitality (provision of food and drink); Fast food restaurants; Fast-food restaurant services; Food and drink catering; Food and drink catering for banquets; Food and drink catering for cocktail parties; Food and drink catering for institutions; Food and drink preparation services; Food preparation; Food preparation for others on an outsourcing basis; Food preparation services; Food service apparatus (Rental of -); Grill restaurants; Hookah bar services; Hookah lounge services; Hospitality services [food and drink]; Hotel restaurant services; Juice bar services; Juice bars; Outside catering; Outside catering services; Preparation and provision of food and drink for immediate consumption;

Preparation of food and beverages; Preparation of food and drink; Preparation of meals; Providing food and beverages; Providing food and drink; Providing food and drink catering services for convention facilities; Providing food and drink catering services for exhibition facilities; Providing food and drink catering services for fair and exhibition facilities; Providing food and drink for guests; Providing food and drink for guests in restaurants; Providing food and drink in bistros; Providing food and drink in Internet cafes; Providing food and drink in restaurants and bars; Providing food to needy persons [charitable services]; Providing information in the nature of recipes for drinks; Providing of food and drink; Providing of food and drink via a mobile truck; Providing restaurant services; Providing reviews of restaurants; Providing reviews of restaurants and bars; Provision of food and beverages; Provision of food and drink; Provision of food and drink in restaurants; Restaurant and bar services; Restaurant information services; Restaurant reservation services; Restaurant services; Restaurant services for the provision of fast food; Restaurant services incorporating licensed bar facilities; Restaurant services provided by hotels; Restaurants; Restaurants (Self-service -); Salad bars; Salad bars [restaurant services]; Self-service cafeteria services; Self-service restaurant services; Self-service restaurants; Services for providing drink; Services for providing food; Services for providing food and drink; Serving food and drink for guests; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Serving food and drinks; Snack bar services; Snack-bar services; Snackbars; Snack-bars; Take away food and drink services; Take away food services; Take-away fast food services; Takeaway food and drink services; Take-away food and drink services; Takeaway food services; Take-away food services; Takeaway services; Take-out restaurant services.

2. The application was opposed by Ahmed Mohamed Hussein Sayed (“the opponent”) on 29 March 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition was initially also based upon sections 5(3) of the Act however, this was removed after no evidence was filed in support of that claim.

3. The opponent relies on the following trade marks:

UK3164709 and EUTM 15872203



UK filing date: 16 May 2016

UK registration date: 16 September 2016

Relying upon all services for which the earlier mark is protected, namely:

Class 39: Delivery and distribution of food and drink prepared for consumption; delivery of food by restaurants; food delivery; food storage services; packaging of food; packing of food; information, advisory and consultancy services all relating to the aforesaid services.

Class 43: Food cooking services; cookery advice; restaurant and catering services; banqueting services; provision of catering services for events, receptions, functions, conferences, banquets and festivals; provision of food and drink for events, receptions, functions, conferences, banquets and festivals; self-service restaurant services; snack services; bar services; cafe services; take away food and drink services; preparation of food and drink; provision of food and drink; preparation of meals or foodstuffs for consumption off the premises; coffee bar services; restaurant reservation services; information, advisory and consultancy services all relating to the aforesaid services.

4. The opponent also relies on the EUTM15872203 which is identical to the earlier UK trade mark and claims priority from it. I will therefore refer to the earlier mark in the singular for the rest of the decision.

5. The opponent claims that the marks are similar aurally, visually and conceptually. It argues that both marks contain the identical element 'LEBANEAT' which is the dominant word element of the earlier registrations with the only difference being the inclusion of the letter 'S' and that there is therefore a strong likelihood of confusion. The opponent also claims that the applicant's services are either identical or highly similar to their own services.

6.. The applicant filed a counterstatement denying the claims made.

7. The applicant is represented by Trade Mark Wizards Limited and the opponent is represented by Womble Bond Dickinson (UK) LLP.

8. Neither party filed evidence nor requested a hearing/provided submissions in lieu. This decision is therefore taken following careful perusal of the papers.

9. Although the UK has left the EU, 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 Act 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.

Preliminary Issues

10. The applicant's counterstatement makes numerous references to the Lebaneats brand and other, earlier marks that the applicant owns. It also claims to have been using "Lebaneats" as the name of a restaurant since 2009, which is before the application date of the earlier mark. The focus of this opposition is purely on the new series of marks under the application number UK3557800. The Registry wrote to the applicant on 21 September 2021 referring them to Tribunal Practice Notice 4/2009 which confirms that there is no mechanism for counterclaims to opposition

proceedings and that defenses to claims under section 5(2) of the Act based on another even earlier mark are wrong in law and that the proper process is to oppose or apply to invalidate the opponent's mark.

11. No such invalidity action has been consolidated with this matter at this time and therefore, I cannot consider the information provided regarding the applicant's earlier mark. I am basing this decision purely on the marks at issue as set out above.

Decision

Section 5(2)(b)

12. Section 5(2)(b) reads as follows:

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

(a)...

(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.”

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of IR 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.”

14. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant’s mark pursuant to section 6 of the Act. The opponent’s mark is not subject to the proof of use requirements pursuant to section 6A of the Act. This is because it had not been registered for more than 5 years at the filing date of the application in issue. The opponent can, therefore, rely upon all of the goods which it has identified.

Section 5(2)(b) case law

15. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Services

16. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

17. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

18. 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.

19. In *Gérard Meric v OHIM* ('Meric'), Case T-133/05, the General Court ("the GC") stated that:

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

20. For the purposes of considering the issue of similarity of services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

21. 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 or services. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the 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”.

22. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings.

| Applicant Services | Opponent Services |
|--|---|
| <p>Class 39: Food delivery services relating to fast food, takeaway food, restaurant food, and catering food.</p> <p>Class 43: Banqueting services; Bar and restaurant services; Bistro services; Café services; Cafe services; Cafés; Cafeteria services; Cafeterias; Carvery restaurant services; Catering; Catering (Food and drink -); Catering for the provision of food and beverages; Catering for the provision of food and drink; Catering in fast-food cafeterias; Catering of food and drink; Catering of food and drinks; Catering services; Catering services for company cafeterias; Catering services for conference centers; Catering services for educational establishments; Catering services for hospitality suites; Catering services for hospitals; Catering services for nursing homes; Catering services for providing European-style cuisine;</p> | <p>Class 39: Delivery and distribution of food and drink prepared for consumption; delivery of food by restaurants; food delivery; food storage services; packaging of food; packing of food; information, advisory and consultancy services all relating to the aforesaid services.</p> <p>Class 43: Food cooking services; cookery advice; restaurant and catering services; banqueting services; provision of catering services for events, receptions, functions, conferences, banquets and festivals; provision of food and drink for events, receptions, functions, conferences, banquets and festivals; self-service restaurant services; snack services; bar services; cafe services; take away food and drink services; preparation of food and drink; provision of food and drink; preparation of meals or foodstuffs for consumption</p> |

Catering services for providing Japanese cuisine; Catering services for providing Spanish cuisine; Catering services for retirement homes; Catering services for schools; Catering services for the provision of food; Catering services for the provision of food and drink; Coffee bar services; Coffee shops; Coffee supply services for offices [provision of beverages]; Contract food services; Cookery advice; Corporate hospitality (provision of food and drink); Fast food restaurants; Fast-food restaurant services; Food and drink catering; Food and drink catering for banquets; Food and drink catering for cocktail parties; Food and drink catering for institutions; Food and drink preparation services; Food preparation; Food preparation for others on an outsourcing basis; Food preparation services; Food service apparatus (Rental of -); Grill restaurants; Hookah bar services; Hookah lounge services; Hospitality services [food and drink]; Hotel restaurant services; Juice bar services; Juice bars; Outside catering; Outside catering services; Preparation and provision of food and drink for immediate consumption; Preparation of food and beverages; Preparation of food and drink; Preparation of meals; Providing food and beverages; Providing food and drink; Providing food and drink catering services for convention facilities; Providing food and drink catering services for exhibition facilities; Providing food and drink catering services for fair and exhibition facilities; Providing food and drink for guests; Providing food and drink for guests in restaurants; Providing food and drink in bistros; Providing food and drink in Internet cafes; Providing food and drink in restaurants and bars; Providing food to needy persons [charitable services]; Providing information in the nature of recipes for drinks; Providing of food and drink; Providing of food and drink via a mobile

off the premises; coffee bar services; restaurant reservation services; information, advisory and consultancy services all relating to the aforesaid services.

| | |
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| truck; Providing restaurant services; Providing reviews of restaurants; Providing reviews of restaurants and bars; Provision of food and beverages; Provision of food and drink; Provision of food and drink in restaurants; Restaurant and bar services; Restaurant information services; Restaurant reservation services; Restaurant services; Restaurant services for the provision of fast food; Restaurant services incorporating licensed bar facilities; Restaurant services provided by hotels; Restaurants; Restaurants (Self-service -); Salad bars; Salad bars [restaurant services]; Self-service cafeteria services; Self-service restaurant services; Self-service restaurants; Services for providing drink; Services for providing food; Services for providing food and drink; Serving food and drink for guests; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Serving food and drinks; Snack bar services; Snack-bar services; Snackbars; Snack-bars; Take away food and drink services; Take away food services; Take-away fast food services; Takeaway food and drink services; Take-away food and drink services; Takeaway food services; Take-away food services; Takeaway services; Take-out restaurant services. | |
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24. The following goods from the applicant's specification have identical terms within the opponent's specification:

Banqueting services; Café Services; Cafe services; Cookery advice; Coffee bar services; Preparation of food and beverages; Preparation of food and drink; Provision of food and drink; Restaurant reservation services; Take away food and drink services; Self-service restaurant services; Self-service restaurants; Takeaway food and drink services; Take-away food and drink services.

25. For the class 39 services of the applicant, I find them to fall within the wider category of the opponent's 'food delivery' and therefore, they are identical under the *Meric* principles.

26. I find that the following applicant services: 'Cafés; Cafeteria services; Cafeterias' are identical to the opponent's 'cafe services' with the wording of the services being presented in a slightly different manner but having the same meaning.

27. I find that the following applicant services: 'Providing of food and drink; Provision of food and beverages' are identical to the opponent's 'provision of food and drink' with the wording of the services being presented in a slightly different manner but having the same meaning.

28. I find that the opponent's 'Bar services' falls within the wider category of the applicant's 'Bar and restaurant services' and therefore these services are identical under the *Meric* principles.

29. For the applicant's 'Bistro services' I find that a bistro is a small, informal restaurant or a bar where food is served.¹ Therefore, I consider that it falls within the opponent's wider category of 'restaurant and catering services' and is therefore identical under the *Meric* principles.

30. Regarding the following applicant services 'Carvery restaurant services; Catering; Catering (Food and drink -); Catering for the provision of food and beverages; Catering for the provision of food and drink; Catering in fast-food cafeterias; Catering of food and drink; Catering of food and drinks; Catering services; Catering services for company cafeterias; Catering services for conference centers; Catering services for educational establishments; Catering services for hospitality suites; Catering services for hospitals; Catering services for nursing homes; Catering services for providing European-style cuisine; Catering services for providing Japanese cuisine; Catering services for providing Spanish cuisine; Catering services for retirement homes; Catering services for schools; Catering services for the provision of food; Catering

¹ <https://www.collinsdictionary.com/dictionary/english/bistro>

services for the provision of food and drink; Fast food restaurants; Fast-food restaurant services; Food and drink catering; Food and drink catering for banquets; Food and drink catering for cocktail parties; Food and drink catering for institutions; Grill restaurants; Hotel restaurant services; Outside catering; Outside catering services; Providing restaurant services; Restaurant services; Restaurants; Restaurants (Self-service -); Restaurant services for the provision of fast food; Restaurant services incorporating licensed bar facilities; Restaurant services provided by hotels; Salad bars; Salad bars [restaurant services]; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars' I find that these services will all fall within the wider category of 'restaurant and catering services' and therefore the services are identical under the *Meric* principles.

31. 'Restaurant and bar services' from the applicant's services is a wider category which encompasses the opponent's 'bar services' and therefore, the services are identical under the *Meric* principles.

32. I find that the following applicant services 'Coffee supply services for offices [provision of beverages]; Corporate hospitality (provision of food and drink); Providing food and beverages; Providing food and drink; Providing food and drink for guests; Providing food and drink for guests in restaurants; Providing food and drink in bistros; Providing food and drink in Internet cafes; Providing food and drink in restaurants and bars; Providing food to needy persons [charitable services]; Providing of food and drink via a mobile truck; Provision of food and drink in restaurants; Services for providing drink; Services for providing food; Services for providing food and drink' fall within the wider category of 'provision of food and drink' and therefore the services are identical under the *Meric* principles.

33. I find that the following applicant services 'Food and drink preparation services; Food preparation; Food preparation for others on an outsourcing basis; Food preparation services' Preparation of meals' fall within the wider category of 'preparation of food and drink' and therefore the services are identical under the *Meric* principles.

34. I consider the applicant's 'Preparation and provision of food and drink for immediate consumption' would fall within the wider category of the opponent's 'restaurant and catering services' as part of restaurant services would be the preparation of food for consumers and then serving or providing it to them. Therefore, I find these services to be identical under the *Merit* principles.

35. For the following applicant services 'Providing food and drink catering services for convention facilities; Providing food and drink catering services for exhibition facilities; Providing food and drink catering services for fair and exhibition facilities;' I find that they fall within the wider category of the opponent's 'provision of catering services for events, receptions, functions, conferences, banquets and festivals' as conventions, exhibitions and fairs would all come under the category of being events or functions. Therefore, these services are identical under the *Merit* principles.

36. In relation to the applicant's 'Self-service cafeteria services;' I find that this falls within the wider category of the opponent's 'self service restaurant services' as a cafeteria is a type of restaurant.² Therefore, the services are identical under the *Merit* principles.

37. I find that the applicant's 'Take away food services; Take-away fast food services; Takeaway food services; Take-away food services; Takeaway services; Take-out restaurant services' all fall within the wider category of the opponent's 'take away food and drink services' and therefore, the services are identical under the *Merit* principles.

38. Considering the applicant's 'Snack bar services; Snack-bar services; Snackbars; Snack-bars' I find that these will fall within the wider category of the opponent's 'snack services' as both will be offering snack type foods and maybe drinks for people to eat between meals or as a treat.

39. Next I will look at the applicant's 'Serving food and drink for guests; Serving food and drinks'. I find that these services will overlap in nature and purpose with the opponent's 'restaurant and catering services' as within a restaurant setting there would

² <https://www.collinsdictionary.com/dictionary/english/cafeteria>

be an expectation for the most part that food will be served to the consumers. This also means there is an overlap of use and there could be an overlap of user as servers might be required for larger events or covering any shortages in employed staff. I therefore find these services to be similar to a high degree.

40. Looking at the applicant's 'Coffee shops' I consider that this is simply a different way of referring to 'Coffee bar services' as found within the opponent's specification and therefore find these services to be identical.

41. Regarding the applicant's 'Hospitality services [food and drink]' I find that these are a wider category that would incorporate most of the opponent's class 43 services but particularly 'restaurant and catering services' and therefore these services are identical under the *Meric* principles.

42. I consider that the applicant's 'Hookah bar services; Hookah lounge services' will have an overlap in nature with the opponent's 'bar services' as they will be a similar bar style but the hookah bars and lounges will obviously feature the addition of the hookahs. The purpose will differ slightly as the main focus of a bar would be for the drinks, usually alcoholic whereas the focus of a hookah bar will be on the hookahs with the drinks being of secondary interest; however, they would both be used as a social gathering place or place of relaxation for people which shows an overlap in use. The users might differ slightly as the hookah bars will more likely be used by those with interests in smoking or using a hookah whereas bars will be for those people wishing to have drinks. I therefore find these services to be similar to a medium degree.

43. I find that 'Contract food services' is a way of providing food and drink but under the terms of a contract and therefore, will fall within the opponent's wider category of 'provision of food and drink' and therefore, the services are identical under the *Meric* principles.

44. Looking at the applicant's 'Food service apparatus (Rental of -)' I believe that there may be an overlap in use with the opponent's 'provision of food and drink for events, receptions, functions, conferences, banquets and festivals' as the food service apparatus could be used during events mentioned when the food is being provided.

The services could be considered as complementary as the apparatus for food service would be expected to be used during the provision of food during events, conferences and banquets etc particularly where there is not an on site kitchen. It would be reasonable for the average consumer to believe that the same undertaking that provides the service for the provision of food would also rent the apparatus in order to carry this out. I consider that the services will differ in that there might be different users - for some the rental of the apparatus will be done by consumers looking to serve their own food and that just require further apparatus to do so for larger events or even on going service whereas the opponent service includes the provision of the food and drink to be served. The trade channels and nature may also differ as the applicant services will be focused on the rental of equipment to those who require it whilst the opponent services are food and drink based. I therefore find these services to be similar to a low degree.

45. 'Juice bar services; Juice bars' are likely to overlap in nature and use with the opponent's 'coffee bar services' as they are both bars where consumers can purchase non alcoholic drinks. They differ in the type of drinks offered although I note that it is possible for coffee bars to sell more than just coffee. The users will be people who are looking for a beverage, but again they differ on the types of drink they are looking to purchase and I also consider that juice bars may have more of a reputation for providing healthier options. I also consider there may be an element of competition between the services as the consumer will choose between them as to where they purchase their beverage. I therefore find these services to be similar to at least a medium degree although not the highest degree.

46. For the applicant's 'Restaurant information services; Providing information in the nature of recipes for drinks; Providing reviews of restaurants; Providing reviews of restaurants and bars' I think that these fall within the wider category of the opponent's 'information, advisory and consultancy services all relating to restaurant and catering services' as all services will involve providing details about restaurants to consumers so that they can make decisions about whether or not to use certain restaurants.

Average consumer and the purchasing act

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

48. 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.”

49. The average consumer for the class 39 services at issue together with the take away/fast food related services in class 43 would be the general public. The cost of fast food and food delivery services is unlikely to be particularly high and therefore, I do not expect the services to be highly considered by the consumer and would likely be a fairly casual purchase. That being said, the consumer might look at pricing, wait time and the food/restaurants that are on offer, with particular focus on any allergens or dietary requirements. I would therefore expect no more than an average degree of attention to be paid when selecting these services. I would think that the services are likely to be sought out by eye either on the high street, on websites or applications or even leaflets and so the purchasing process is likely to be highly visual. I do not discount that there may be times where word of mouth recommendations or telephone orders are used and so aural considerations are also to be borne in mind.

50. For the class 43 services involving restaurant and catering services, bars, banqueting, cafes, coffee and juice shops and food and drink preparation and provision, I consider that the average consumer will likely be the general public although I do not discount that for catering services, there could be a commercial undertaking using these services. I believe the price point can range from very low - the cost of a cup of coffee - up to very expensive - catering for events such as weddings or conventions. As such, consideration by the consumer will range from fairly casual and frequent to much more involved as there will be people who buy their regular cup of coffee or juice or take away sandwich to consumers looking for high quality 3 course meals to be provided at large one-off events. Again, there may be particular focus on any allergens or dietary requirements. I therefore find that there would be between an average and a high degree of attention. I consider that the purchasing process would likely be visual, either in a high street setting or via websites, catalogues and brochures. But I also consider that it is possible that word of mouth recommendations or telephone orders are used and so aural considerations are also to be borne in mind.

51. In relation to the class 43 services for restaurant information, reviews and advisory and consultancy services. I consider that there could be both member of the general public and businesses and professionals that use these services. The service provider will be selected based on reviews, cost and suitability. I believe the cost of these will vary greatly between very low and potentially high. For the member of the public, I believe that no more than an average degree of consideration will be paid as they will likely be the lower end of the cost scale, if not finding the information for free. For professional and business consumers, I consider the costs will be higher and the purchase to be less frequent but perhaps more long term and therefore, the consideration will likely be above average. The selection process will once again likely be predominantly visual with the use of promotional material, websites and brochures.

Comparison of the marks


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

created by the marks, bearing in mind their distinctive and dominant components. The 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.”

53. 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.

54. The respective trade marks are shown below:

| Earlier mark | Contested mark |
|---|--|
|  | <p data-bbox="815 1305 1034 1350">lebaneats</p> <p data-bbox="815 1469 1050 1514">Lebaneats</p> <p data-bbox="815 1637 1054 1682">LebanEats</p> |

55. The earlier mark is a figurative mark which features the word ‘Lebaneat’ in a slightly italic font and light orange colour. The word is in the lower half of the mark and above it, is a device of two hands clasped together in a handshake. The front hand contains

what I assume is the Lebanese flag which consists of red stripes at the top and bottom, the middle is white with a bright green tree in the middle. The back hand is plain white. Both the device and the word are contained within a brown circle background. In considering the mark, I find that the most dominant element is the word 'Lebanean' due to its size and that it spans the width of the mark. Keeping in mind *Migros-Genossenschafts-Bund v EUIPO*, T-68/17 where it was stated that

“...in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements...”³

I therefore find that the word element is also the most distinctive element of the mark.

56. Slightly less dominant is the figurative element of the shaking hands featuring the Lebanese flag but it will still contribute to the overall impression of the mark. The background circle is the least distinctive element of the mark and will have little impact on the consumer.

57. The series of contested marks are single word marks with varying use of capital and lowercase letters and therefore the overall impression lies within the words themselves.

58. In terms of a visual comparison, the contested marks are comprised of nine letters in a standard font. I also bear in mind the following from Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14 found that:

“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks.....A word may therefore be presented in a different

³ Paragraph 52

way (for example a different font, capitals as opposed to small letters, or handwriting as opposed to print) from that which appears in the Register whilst remaining 'identical' to the registered mark."

59. Therefore, the contested marks could be presented in different fonts - such as the font used in the contested mark and with any combination of capitalization, as shown by the series of three marks.

60. The earlier mark features an eight letter word which is entirely reproduced in the contested marks - which have an additional 's' on the end. It also features the hand shake device above the word and the brown circle background. Given this additional material I find the marks are visually similar to no more than a medium degree.

61. Turning to the aural comparison between the marks, I consider that the word element of the earlier marks will likely be pronounced with three syllables as *leh/ban/eat*. For the contested marks, I believe that they will be pronounced again as three syllables as *leh/ban/eats*. The only difference would be the addition of the 's' on the end of the contested marks. Therefore the marks are very highly aurally similar.

62. Conceptually, the contested marks are a made up term however, I believe the average consumer might see that it is a play on the term 'Lebanese' as meaning someone from Lebanon and combining it with 'eats' as a nod to the services on offer being related to food and drink services. The same will apply to the earlier marks with the meaning being reinforced by the Lebanese flag being featured. Therefore, the marks are conceptually identical.

63. I do not discount that there may be some consumers who do not immediately recognise the exact country name of the Lebanon but I believe they will still understand it to be a name of origin for the food from the services.

Distinctive Character of the Earlier Mark

64. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

65. The opponent made no claim and put forward no evidence relating to an enhanced level of distinctiveness of their earlier mark. I will therefore consider the position based solely on its inherent distinctiveness.

66. The mark is comprised of one word which appears to be a portmanteau. It is supported by two hands in a shaking motion, one of which contains the Lebanese flag (although this might not be immediately recognised by the average consumer). The background is a brown circle. The ‘eat’ element can be said to be descriptive of the services that are on offer. I therefore find that the mark is inherently distinctive to an above average degree although not the highest degree.

Likelihood of Confusion

67. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

68. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

69. I have come to the conclusions above that the marks at issue are visually similar to no more than a medium degree; aurally similar to at least a high degree; they are conceptually identical and the average consumer would be paying no more than a medium degree of attention. The services at issue have been found to be between identical or similar to a low degree. The earlier mark is inherently distinctive to an above average (but not the highest) degree.

70. I found the overall impression of the contested marks was in the words themselves and that the most distinctive and dominant component of earlier mark is the word

'Lebaneat'. I believe that consumers will notice the differences between the marks – the additional device element in particular. I therefore find that they will not mistake one mark for another and that direct confusion is unlikely. I will now go on to consider indirect confusion.

71. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

“17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example”).

72. These examples are not exhaustive but provide helpful focus, as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

“This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.”⁴

73. As discussed in the case law above, the average consumer is relying upon the imperfect picture of the marks he has kept in his mind. In the case of indirect confusion, the average consumer has noticed the differences between the marks but still believes them to be linked. I discussed earlier that the dominant and distinctive feature of the earlier mark is ‘Lebaneat’ and the only difference between this and the applicant marks is the addition of the letter ‘S’- in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWCH 1271 (Ch) Arnold J (as he then was) confirmed that the principles established in *Medion v Thomson* extend to a situation where the composite mark contains an element which is similar to the earlier mark. Given the identity between the conceptual meaning of the marks, the applicant marks being entirely recreated within the earlier mark, except for the letter S (which the average consumer may well imperfectly remember) and the earlier mark being inherently distinctive to an above average degree, I believe the average consumer will see the contested marks as simply another way (a word only version) of using the earlier mark. Therefore, I find that indirect confusion is likely to occur, even where the services have only a low degree of similarity.

Conclusion

74. The opposition succeeds in its entirety.

Costs

75. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings are based upon the scale set out in Tribunal Practice Notice (TPN) 2/2016. After due consideration, I believe that an award of costs to the opponent is appropriate as follows:

⁴ Paragraph 12

| | |
|---|-------------|
| Official fee | £200 |
| Preparing the notice of opposition and considering the Counter Statement | £400 |
| TOTAL | £600 |

76. I therefore order FRESH UPS FOODS LIMITED to pay Ahmed Mohamed Hussein Sayed the sum of £600. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 13th day of September 2022

**L Nicholas
For the Registrar**