

**O/0172/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3645263**

**BY SHAANTI 11 LTD**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**RNB Brunch**

**IN CLASS 41**

**AND**

**AN OPPOSITION THERETO UNDER NUMBER 428826**

**BY THE BRUNCH CLUB PRESENTS LTD**

## BACKGROUND AND PLEADINGS

1. On 21 May 2021, Shaanti 11 LTD (“the applicant”) applied to register “RNB Brunch” as a trade mark in the UK. The application was published for opposition purposes on 3 September 2021 and registration is sought for services in Class 41.<sup>1</sup>

2. On 3 December 2021, The Brunch Club Presents Ltd (“the opponent”) opposed the application in full, based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon UK trade mark number 3634142, “The Brunch Club”, which has a filing date of 28 April 2021, a registration date of 17 September 2021 and is registered for services in Classes 35, 41 and 43, all of which are relied upon for the purposes of this opposition.<sup>2</sup>

3. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion on the basis that the marks are similar and the services are identical or similar.

4. The opponent further claims that the applicant’s mark is similar to its pre-existing ‘Hip Hop & RnB Bottomless Brunch’ brand that the opponent hosts under its ‘The Brunch Club’ mark. I will stipulate here that the opponent’s ‘Hip Hop & RnB Bottomless Brunch’ brand is not relevant to this decision, the purpose of which is to decide whether there is a likelihood of confusion between the two marks at issue: ‘RNB Brunch’ and ‘The Brunch Club’. Any sub-brands belonging to or used by the opponent, which have not been relied upon as registered trade marks, are not relevant to a section 5(2)(b) opposition.

5. As a result of its earlier filing date, the mark relied upon by the opponent qualifies as an earlier mark for the purpose of section 6(1)(a) of the Act. In accordance with section 6A of the Act, the earlier mark is not subject to proof of use and so the opponent may rely upon all the services for which the mark is registered.

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<sup>1</sup> These will be listed in the services comparison.

<sup>2</sup> These will be listed in the services comparison.

6. The applicant filed a defence and counterstatement denying the ground of opposition on the basis of a lack of similarity between the trade marks; the applicant accepts there is similarity or identity between the respective services in Class 41, but denies similarity between its Class 41 services and the Class 35 and 43 services of the earlier mark.

7. In its counterstatement, the applicant suggests that if the opposition succeeds, it would be in a position to invalidate the earlier mark on the basis of the applicant's prior use of its trade mark "R&B Brunch" – number 3460162. Prior use of a different trade mark is not a defence in opposition proceedings brought under section 5(2)(b); as referred to by the applicant, this issue would be required to be dealt with under separate invalidity proceedings.

8. The applicant is represented by MW Trade Marks Limited; the opponent represents itself. Only the applicant filed evidence in these proceedings. Neither party requested a hearing but both filed written submissions in lieu. The evidence and submissions will be referred to as and where appropriate throughout this decision.

## **EVIDENCE**

9. The applicant filed evidence in the form of the witness statement of Anne Wong dated 19 August 2022 and its corresponding seven appendices (Appendix 1a – Appendix 6). Anne Wong is a Chartered Trade Mark Attorney representing the applicant. The evidence filed goes to the applicant's submission that the word 'brunch' is non-distinctive for, and descriptive of, events and similar services which take place at the time between breakfast and lunch. Some of the appendices, which are either undated or dated in 2022, show examples of numerous events offered by different organisers, the names of which all include the word 'brunch'.<sup>3</sup>

10. In the applicant's written submissions filed with its evidence, it lists trade marks on the Register in the UK which include the word 'brunch' and are registered for services in Class 41. The applicant quite rightly admits that 'state of the Register' evidence is

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<sup>3</sup> Appendices 2 and 3.

not persuasive. The Register is not evidence of how many of such trade marks are used and, even if they were, it cannot be said with any certainty whether consumers are or are not confused by the presence of such marks.<sup>4</sup> I will therefore say no more about this evidence.

11. The applicant's evidence also consists of screenshots of the opponent's website and social media intending to show the opponent's use of the word 'brunch'<sup>5</sup> and of "third party trade marks".<sup>6</sup> The opponent's use of the word 'brunch' is said to support the applicant's submission that the word is descriptive for the services at issue. I will address this during the mark comparison later in this decision. The opponent's use of "third party trade marks" is claimed to be unauthorised use of third party brands.<sup>7</sup> This is not a matter to be determined by this Tribunal in these proceedings and, as such, I will say no more about this evidence.

12. The opponent attempted to file what I consider to be evidence with its written submissions in lieu. Screenshots of searches for 'rnb brunch' online are intended to show that 'RNB' "is a generic term that [the opponent] and other brunch brands are using currently as well as have used in the past".<sup>8</sup> The opponent chose not to file evidence during the evidence rounds and it was not open to it to file evidence at such a late stage in the proceedings without making a request to the Tribunal. Given that the evidence was not filed in the correct format, nor at the appropriate time, I give very little weight to it. Whilst the applicant was not afforded an opportunity to file evidence in reply, it was instead permitted to file further written submissions in lieu, in which it addressed the opponent's evidence. I note the comments contained therein.

## **DECISION**

### **Relevance of EU law**

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<sup>4</sup> See the comments of the General Court in *Zero Industry Srl v OHIM*, Case T-400/06.

<sup>5</sup> Appendix 5.

<sup>6</sup> Appendix 6.

<sup>7</sup> The applicant's written submissions filed during the evidence rounds at paragraph 20.

<sup>8</sup> The opponent's written submissions in lieu.

13. 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 upon 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.

### **Section 5(2)(b)**

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

“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.”

### **Relevant law**

15. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“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.

#### 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 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. The competing services are shown below:

### The opponent's services

Class 35 *Event marketing; Promotion of special events; Arranging and conducting of marketing events; Arranging and conducting of promotional events.*

Class 41 *Entertainment; Entertainment services; Arranging of musical events; Conducting of entertainment events; Conducting of live entertainment events; Production of live entertainment events; Ticketing and event booking services; Arranging and conducting of entertainment events; Corporate hospitality (entertainment); Hospitality services (entertainment); Special event planning; Organisation of musical events; Organisation of cultural events; Conducting of cultural events; Musical events (Arranging of -); Arranging of cultural events; Presentation of live entertainment events; Musical entertainment; Interactive entertainment; Live entertainment; Planning (Party -) [entertainment]; Entertainment party planning; Music entertainment services; Popular entertainment services; Party planning [entertainment]; Entertainment services provided at nightclubs; Music festival services; Organising of festivals; Organisation of festivals; Conducting of performing arts festivals; Festivals (Organisation of -) for cultural purposes; Festivals (Organisation of -) for recreational purposes; Arranging of festivals for entertainment purposes.*

Class 43 *Hospitality services [food and drink]; Corporate hospitality (provision of food and drink).*

The applicant's services

Class 41 *Dance events; Organisation of musical events; Organisation of cultural events; Conducting of cultural events; Organisation of entertainment events; Arranging of musical events; Organization of dancing events; Arranging of cultural events; Conducting of entertainment events; Organising community cultural events; Organising events for entertainment purposes; Organizing cultural and arts events; Organising events for cultural purposes; Production of live entertainment events; Video editing services for events; Ticketing and event booking services; Presentation of live entertainment events; Organisation of entertainment and cultural events; Organization of events for cultural purposes.*

17. In *Gérard Meric v OHIM*, the General Court (“GC”) confirmed that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):<sup>9</sup>

“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.”

18. The applicant has admitted similarity or identity between the parties' services. I will, however, briefly state that either because of their wording or in line with the principle set out in *Merica* (cited above), I consider the entirety of the applicant's specification, save for *video editing services for events*, to be clearly identical to one or more of the opponent's services in Class 41. The production of events is likely to involve video editing and, as such I consider the applicant's *video editing services for*

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<sup>9</sup> Case T-133/05



events to fall within the scope of the opponent's *production of live entertainment events*.

### **The average consumer and the purchasing act**

19. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

20. The average consumer for the parties' services is a member of the general public. The purchase is predominantly visual with consumers seeing either printed advertising material such as posters and flyers or online advertising on websites and social media. Events and entertainment, as well as related services, also rely on word-of-mouth recommendations so there will be an aural element to the selection of the services, though it is of lesser weight. Consumers will consider factors such as the type of event and the associated cost. Overall, I consider a medium degree of attention will be paid to the selection of the parties' services.

### **Comparison of marks**

21. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be

assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant 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.”

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

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

<b>The earlier mark</b>	<b>The applicant's mark</b>
<b>The Brunch Club</b>	<b>RNB Brunch</b>

24. The applicant submits that the word ‘brunch’ is descriptive for the services at issue. I disagree; there is nothing in either party’s specification that denotes the services are related to brunch or offered at that time of the day. Whilst it may have an allusive nature for events which take place between breakfast and lunch, that is not apparent from the list of services and will only be the case in certain circumstances (as in the applicant’s evidence). Consequently, I do not consider the word ‘brunch’ to be less dominant or distinctive than any other element in either mark.

25. The earlier mark contains the three words 'The Brunch Club' which hang together as a unit with neither word dominating. The overall impression of the mark rests in the three words.

26. The applicant's mark consists of the letters 'RNB' followed by a space and the word 'Brunch'. As with the word 'brunch', there is nothing in the specification to suggest that 'RNB' is descriptive. Whilst this element may have a relationship to some of the music-related services, I consider that neither element dominates the mark and the overall impression lies in the mark as a whole.

#### Visual comparison

27. The marks coincide in the common element 'brunch', which is the second word in each mark, creating a point of visual similarity. The earlier mark contains two additional words, either side of the word 'brunch', which have no counterparts in the applicant's mark. Similarly, the letters 'RNB' preceding 'brunch' in the applicant's mark have no counterpart in the earlier mark. I bear in mind that in both marks the word 'brunch' is preceded by a string of three letters. However, the additional elements create visual differences and I consider the overall similarity between the marks to be of a low to medium degree.

#### Aural comparison

28. As with the visual comparison, the common element 'brunch' creates aural similarity. When articulated, however, the common element appears in different positions in the marks – the second of three syllables in the earlier mark and the fourth and final syllable in the applicant's mark. There is aural similarity between the marks, albeit to a low degree.

#### Conceptual comparison

29. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and

the CJEU including *Ruiz Picasso v OHIM*.<sup>10</sup> The assessment must be made from the point of view of the average consumer.

30. The word 'brunch' in both marks will conjure the same meaning to consumers: the time of day between breakfast and lunch or a meal consumed at that time. In the applicant's mark, 'RNB' will most likely be seen as an abbreviation (an alternative to R&B) of 'rhythm and blues', a popular genre of music. The concept immediately grasped by the applicant's mark for the services at issue is, therefore, an 'R&B'-themed event either involving brunch as a meal or occurring at brunch-time.

31. For the earlier mark, 'The Brunch Club' will, to the average consumer, be seen as a reference to either a group of people who eat brunch or meet at the associated time of the day, or to a venue which hosts events involving brunch as a meal or occurring at brunch-time.

32. 'Brunch' creates a conceptual overlap, whereas the other elements of each mark add a slightly different meaning. Overall, the marks are conceptually similar to a medium to high degree.

### **Distinctive character of the earlier mark**

33. In *Lloyd Schuhfabrik Meyer* 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).

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<sup>10</sup> [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

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).”

34. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

35. Since the opponent has filed no evidence of use from which I can make an assessment as to an enhanced distinctive character, I have only the inherent position to consider. The mark consists of the words ‘The Brunch Club’. Whilst the applicant’s evidence is mostly dated in 2022, it reaffirms my view that ‘going for brunch’ has become a popular pastime for the general public, whether it simply involves a meal between breakfast and lunch, or is accompanied by alcohol, music or both. Accordingly, the earlier mark may have an allusive nature in terms of entertainment and events; it suggests that the events it organises involve brunch or are hosted at that time of the day. However, this is not an apparent characteristic of the services from the opponent’s specification and so the mark is not descriptive or devoid of distinctive character and is only allusive if such events actually do take place at, or involve, brunch; if they do not, ‘The Brunch Club’ has no real relevance. However, regardless of the services, ‘brunch’ remains a very common dictionary word. Overall, I consider the mark to have a low to medium degree of inherent distinctive character.

## Likelihood of confusion

36. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel*) from the perspective of the average consumer. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik*). The factors considered above have a degree of interdependency (*Canon*): for example, 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.

37. I have found the marks to be visually similar to a low to medium degree, aurally similar to a low degree and conceptually similar to a medium to high degree. I have found the earlier mark to have a low to medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who, paying a medium degree of attention, selects the services predominantly by visual means, with aural considerations also relevant to the selection. I have found the services to be identical.

38. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Limited v By Back Beat Inc.*, BL O/375/10, where Iain Purvis QC (as he then was), sitting 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 recognised 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’.

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).”

39. I bear in mind that the beginnings of marks tend to have more visual and aural impact than the ends<sup>11</sup> and that the marks begin with entirely different words. I accept that the marks share the common word ‘brunch’ but remind myself of the additional words in both marks. For me to conclude that the marks may be recalled as one another would require me to find that the average consumer would forget the words ‘The’ and ‘Club’ in the earlier mark and forget the element ‘RNB’ in the applicant’s mark. Given that direct confusion involves no process of reasoning, and the additional elements in both marks are not negligible so as to go unnoticed, I find it highly unlikely

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<sup>11</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

that the average consumer would mistake one mark for the other. Even accounting for the identical services, I do not consider there to be a likelihood of direct confusion.

40. I turn now to indirect confusion. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

41. During the course of this decision I have explained that the common element ‘brunch’ results in conceptual similarity between the marks to a medium to high degree, but that the earlier mark has only a low to medium degree of distinctive character and the word ‘brunch’ is a common dictionary word: it is certainly not so distinctive that consumers would assume only a single undertaking uses it. Neither is the word ‘brunch’ combined with purely descriptive words in either mark, which the consumer may see as logical sub-brands or brand extensions. The opponent’s submissions seem to suggest that the applicant’s mark would be seen as an R&B themed event under ‘The Brunch Club’ brand.<sup>12</sup> However, I am cognisant of the fact that in this case, the difference between the marks is not a simple addition/removal of one element; it involves the removal of two elements and the addition of one entirely different element. The protection afforded to the earlier mark is in the words ‘The Brunch Club’; I do not consider that protection to extend to the word ‘brunch’ solus or ‘brunch’ with any additional elements. To my mind, consumers will see the use of ‘brunch’ in two different marks as a coincidence rather than attributing any trade significance to the word. I find that even for identical services there is no likelihood of indirect confusion.

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<sup>12</sup> The opponent’s submissions in lieu dated 22 November 2022.



## **CONCLUSION**

42. The opposition under section 5(2)(b) fails and the application may proceed to registration.

## **COSTS**

43. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £900, calculated as follows:

Preparing a statement and considering the other side's statement	£200
Preparing evidence	£400
Preparing submissions in lieu of a hearing	£300
<b>Total</b>	<b>£900</b>

44. I therefore order The Brunch Club Presents Ltd to pay Shaanti 11 LTD the sum of £900. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

**Dated this 17<sup>th</sup> day of February 2023**

**E FISHER (née VENABLES)**

**For the Registrar**