

O-123-11

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2491413 IN THE NAME OF TARIQ
MEHMOOD KHAN IN RESPECT OF THE FOLLOWING TRADE MARK IN
CLASS 43:**



**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 83595 BY SBT1 LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF registration no. 2491413
in the name of Tariq Mehmood Khan
in respect of the following trade mark in Class 43:**



and


**the application for a declaration of invalidity
thereto under no. 83595 by SBT1 Limited**

BACKGROUND

1) Tariq Mehmood Khan is the proprietor of the above mark (“the registration”). He applied for the registration on 30 June 2008 and the registration procedure was completed on 23 January 2009. The registration covers the following services in Class 43:

Fast food and non-stop restaurant services.

2) On 5 October 2009, SBT1 Limited (“SBT1”) of Springfield House, Springfield Court, Summerfield Road, Bolton, BL3 2NT applied for the registration to be declared invalid. The single ground of the application is that SBT1 is the proprietor of an earlier mark, the relevant details being:

Relevant details	Specification of services
2367430B  Filing date: 5 July 2004 Registration date: 15 February 2008	<i>Services for providing food and drink; all included in Class 43.</i>

3) SABT1 say that both marks operate in the same market and that the respective services are identical, that the respective marks contain the same colour scheme of red, white and blue, and the word and device elements are also similar. It further claims that the word PAK in Mr Khan's mark is given "diminished significance". Therefore, there exists a substantial likelihood of confusion under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and should be invalidated under Section 47(2).

4) Mr Khan subsequently filed a counterstatement denying the SABT1's claims.

5) Both sides filed evidence in these proceedings and both sides ask for an award of costs. The matter came to be heard on 24 March 2011 when the applicant for invalidation was represented by Chris Morris for Burges Salmon and the proprietor represented by Mark Sorenti.

Applicant's Evidence

6) This takes the form of four witness statements. The first of these is from a former franchisee and the second and third from two current franchisees of "Dixy Chicken" establishments in Birmingham. These all refer to instances of confusion on behalf of "Dixy Chicken" customers in respect of "Dixy Chicken" establishments and other establishments elsewhere in the city. Khaled Rustame recalls that customers would comment on the difference between the food served in his establishment and the food served at the "Pak Dixi Chicken" establishment. He states that he experienced such confusion, on average, once a week. Zahid Malik and Abid Hussain both report receiving complaints from customers about his establishment based on their knowledge of "Pak Dixi Chicken" establishments.

7) The fourth witness statement is by Christopher David Morris, trade mark attorney at Burges Salmon LLP, SABT1's representative in these proceedings. In response to Mr Khan's comment, in his counterstatement, that the colour scheme red, white and blue alludes to the "stars and stripes" flag of the USA, he provides at Exhibit CDM1, a print out from the website www.flags.net, a world flags database, illustrating that at least thirty national flags are composed of the colours red, white and blue.

Registered Proprietor's Evidence

8) This takes the form of two witness statements. The first of these is by Mr Khan. He states that he has been using the mark PAK DIXI CHICKEN as the name of his restaurant in Birmingham since November 2004 and it has been used continuously since. He says that he is not aware of any instances of confusion. He also asserts that the words "Dixi Chicken" serve to indicate the style of food on offer.

9) Mr Khan also includes a number of submissions that I will keep in mind, but not detail here.

10) The second witness statement is by Mr Sorenti, the agent instructed to act on behalf of Mr Khan. He states that the words DIXI and DIXY that appear in the respective marks are both variants of the common geographical and descriptive word DIXIE. As such, the words will be understood as describing food from, or in the style of, the Southern United States. To support this, at Exhibit MS1, he provides an extract from the user-authored online encyclopaedia, Wikipedia, that states that “‘Dixie’ is usually defined as the 11 Southern states that seceded to form the Confederate States of America. ... This definition is strongly correlated with history and, in the minds of many Southerners, remains the traditional South.” This was obtained on 13 April 2010.

11) Mr Sorenti states that “Dixie Chicken” generally refers to a fried chicken recipe popular in the Southern United States. Examples of recipes for this, from a number of websites, are provided at Exhibit MS2. The first of these is from www.backwoodshome.com and is an article, dated 13 April 2010, entitled “Southern cooking that doesn’t just whistle Dixie”. The article includes a fried chicken recipe called “Nanny B’s Benne Bake”. The second extract is from www.Amazon.co.uk and advertises a book entitled “The Dixie Cook-Book”. There is no indication when the book was published but the print of the web page was obtained on 13 April 2010. The third extract is from an Australian website and refers to a recipe by a person called Dixie Elliott.

Applicant’s Evidence-in-Reply

12) This is in the form of two further witness statements. The first of these is by Shakeel Arshad, a director of SABT1. His statement is in response to Mr Khan’s statement that “there are many restaurants, unconnected with my business, in the Birmingham area with names incorporating the words ‘Dixi Chicken’ or similar versions of these words”. At Exhibit SA1, Mr Arshad provides the results of an online search for “Dixi Chicken”, “Dixy Chicken” and “Dixie Chicken” in Birmingham” on www.yell.com. Six businesses are listed. One is listed as “Dixy Chicken”, but to the best of Mr Arshad’s knowledge, it is now trading as “Crunchy Fried Chicken”. The remaining five businesses listed are all franchisees of SABT1.

13) There is also a further witness statement from Mr Morris. He states that “The Dixie Cook-Book” is freely available online and at Exhibit CDM1 he provides a copy of the poultry chapter. He draws attention to the fact that the book contains a range of chicken recipes, but none for “Dixie Chicken”. Mr Morris also provides a critique of the registered proprietor’s evidence. I do not intend to detail these submissions here, but I will keep them in mind.

DECISION

14) The case has proceeded to final determination on the basis of Section 5(2) (b) of the Act, with such grounds being relevant in invalidation proceedings in view of the provisions of Section 47(2) of the Act. The relevant parts of Section 47 of the Act read as follows:

“47. - (1) ...

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) ...”

15) Section 5(2)(b) reads:

“(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.”

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

17) Of potential relevance to a ground of invalidation under Section 5(2) are the provisions that relate to proof of use. Section 47(2A) and Section 47(2B) details the circumstances where these provisions apply:

“(2A)* But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(b) it has not been so used, but there are proper reasons for non-use.”

18) SABT1 relies upon one earlier mark that is registered and therefore qualifies as an earlier mark as defined by Section 6 of the Act. This earlier mark completed its registration procedure on 15 February 2008. This is within five years of the date of the application for the declaration and, as such, is not subject to the proof of use provisions.

19) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its

components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

Comparison of goods

20) I am mindful that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the registration or when the goods designated by the registration are included in a more general category designated by the earlier mark (the General Court (“GC”), in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*, at paragraph 29). Whilst this guidance was in respect of goods, it applies equally to services.

21) It is self evident that Mr Khan’s list of services are covered by the broader term listed in SABT1’s specification and, applying the guidance in *Merici*, it is obvious that the respective lists of services are identical. This was conceded by Mr Sorenti at the hearing.

The average consumer and the nature of the purchasing act

22) As matters must be judged through the eyes of the average consumer (*Sabel BV v.Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the services at issue. I have already identified that the respective services are identical and it follows that the respective average consumer will also be the same. The average consumer of *fast food and non-stop restaurant services* is the general public. Visual considerations are an important part of the purchasing act who will encounter the marks on, for example, signage in the high street, in advertisements in magazines, or on posters. However, as restaurants may be recommended by word of mouth, aural considerations also play a part in the selection process.

23) Fast food and non-stop restaurants are generally at the lower end of the cost spectrum and consequently, the level of care and attention during the purchasing process will generally be on the low side.

Comparison of marks

24) For ease of reference, the respective marks are:

SABT1's mark	Mr Khan's mark
	

25) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23).

26) From a visual perspective the respective marks share a number of similarities. Firstly, they both use similar bold shades of the colours blue and red with white also being used in both. Both also contain a device of a chicken's head and include the word CHICKEN. Both also prominently feature the word DIXY or DIXI. Whilst these words differ by virtue of their last letter, they share the same first three letters D, I and X. There are a number of differences between the marks. Firstly, SABT1's mark forms a substantially oval shape, whereas Mr Khan's mark is predominantly in the form of an elongated rectangle with a nearly square repeat of the mark appearing to the right of the main body of the mark. There is also a narrow strip appearing below the main body of the mark that appears to contain a representation of food items.

27) Mr Khan's mark also contains the word PAK that appears on the left hand edge of the mark running down vertically. At the hearing, Mr Morris argued that as this word is offset and is smaller in size when compared to the word DIXI, it is visually less important. I concur with this argument. The word PAK is of such a size that it is considerably less dominant in the mark than the word DIXI. The effect of this is that, visually, it has very little impact upon the consumer.

28) Taking all of the above points into account, I conclude that the similarities between the respective marks are such as to outweigh the differences. This results in the respective marks sharing a reasonably high level of visual similarity.

29) Aurally, the marks contain the words DIXY/DIXIE respectively that are both pronounced as the same two syllables DIX-EE. Both marks also contain the word CHICKEN. Mr Khan's mark also contains the word PAK and, at the hearing, Mr Sorenti argued that this word would be expressed by the consumer. However, I am not persuaded by this. As I have already noted, the word PAK has a significantly less prominent position in the mark than the other word elements.

The impact of this is that this mark is likely to be pronounced without reference to PAK. It will therefore be said as DIX-EE-CHIK-EN. This is aurally identical to SBT1's mark. If I am wrong in respect to the word PAK and it will, in fact be pronounced at the start of the mark, the marks are still such that they will share a high degree of aural similarity.

30) From a conceptual perspective, I detected no dissent between the parties that the word CHICKEN, present in both marks, is descriptive. How the average consumer will perceive such a descriptive word has been commented upon by the General Court (GC) in *CM Capital Markets Holding, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-563/08*:

“39. ... Owing to their weak, or even very weak, distinctive character, descriptive elements of a trade mark are not generally regarded by the public as being dominant in the overall impression conveyed by that mark, That does not mean, however, that the descriptive elements of a mark are necessarily negligible in the overall impression conveyed by that mark. It is necessary, in particular, to examine whether other elements of the mark are likely to dominate, by themselves, the relevant public's recollection of that mark

45 ..., as regards the word element of the earlier marks, it must be observed that although ... the expression 'capital markets', which is descriptive of the services covered by the earlier marks, is not generally likely to dominate the overall impression conveyed by the earlier marks, it is nevertheless a relevant element for the purposes of a comparison of the signs at issue because, inter alia, it is as prominent, visually, as the graphic element.”

31) It is clear from this guidance that while the word CHICKEN is not the dominant and distinctive element of either mark, it cannot be said that it is negligible. Applying the above guidance, I must consider it as a relevant element of the marks even though it is not the dominant distinctive element.

32) I note Mr Khan's argument that the word DIXIE or variants of that word is descriptive of the Southern United States. I am aware that Wikipedia is a user-authored site and therefore the origin or veracity of the information it contains must be considered in this context. Nevertheless, the point at issue is supported by the Oxford online dictionary¹ and I accept that the word DIXIE refers to the Southern States of the United States. There is, however, no evidence that the average consumer will understand the term in such a way. In this respect, I am

¹ "Dixie". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 21 March 2011 <<http://oxforddictionaries.com/definition/Dixie?rskey=M0v5sa&result=1>>.

mindful of the comments of Ms Anna Carboni, sitting as the Appointed Person, in *Chorkee v. Cherokee* (BL O-048-08):

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.

38. I therefore agree with the Opponent that the Hearing Officer was wrong to find that the earlier trade marks would give rise to the concept of the native American tribe by the same name in the mind of the average consumer and that he should not have relied on his own knowledge and experience to do so.

...

52. It will be clear from my review of the Hearing Officer's assessment of conceptual similarity that I do not agree that it is appropriate to assume that the relevant average consumer would think of the Cherokee Nation tribe when faced with the earlier trade marks. I stated at the hearing that I had expected to find some reference to Cherokee Jeeps, my own assumption being that many people would think of these vehicles in response to seeing the name CHEROKEE on clothing. Mr Groom rightly was not receptive to that suggestion. Like the Hearing Officer's assumption of the average consumer's awareness of the Cherokee Nation tribe, my assumption of their awareness of the Cherokee Jeep was not a fact of which I could take judicial notice in the absence of evidence."

33) Similarly to the considerations of Ms Carboni, I am not satisfied that the average consumer of *fast food and non-stop restaurant services* in the UK will be aware of the descriptive meaning of the word DIXIE. It appears to be a colloquial term used by Americans to identify part of America. The UK consumer may possibly understand the word as being some allusion to America without knowing

its precise meaning, but I would not put recognition of the word as any higher than that. Of course, an additional factor in the current case is that the respective marks both use (different) misspellings of the word. My finding is not disturbed when considering the two earlier decisions by fellow hearing officers in respect of DIXY FRIED CHICKEN (BL O/144/03) and DIXYLAND CHICKEN & RIBS (BL O/331/02) that were referred to me at the hearing. In summary, I reject the argument that the variants of the word DIXIE will only serve a descriptive purpose within the respective marks.

34) Evidence is also provided on behalf of Mr Khan to illustrate that the term DIXIE CHICKEN generally refers to a fried chicken recipe. The evidence fails to establish this. The first Internet extract merely mentions DIXIE as part of the phrase “whistle dixie” in its title, but it is not linked to a fried chicken recipe. The phrase is American, meaning to engage in unrealistic fantasies². The second extract relates to a book called “The Dixie Cook-Book” but once again, there is no link to fried chicken recipes being identified by the word DIXIE. The final extract appears to be totally irrelevant as it relates to a recipe by a person named Dixie Elliott. Therefore, there is no evidence before me to demonstrate that the term DIXIE CHICKEN is used to refer to a fried chicken recipe popular in the Southern United States.

35) Both marks also contain the stylized device of a chicken’s head that reinforces the meaning of the word CHICKEN in the respective marks. Finally, I acknowledge the presence of the word PAK in Mr Khan’s mark and that, if this is noticed by the consumer, it will not attract any obvious conceptual identity. There is no evidence before me that this word has any meaning.

36) Taking all of the above points into account, the term DIXI/DIXY CHICKEN is no more than a loose allusion to an American style chicken, but that this allusion is common to both marks. When considering the marks as a whole, I conclude that the respective marks share a high level of conceptual similarity.

37) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the trade marks must, therefore, be assessed by reference to the overall impressions created, bearing in mind their distinctive and dominant components. Consequently, I must not engage in an artificial dissection of the marks, although I need to take account of any distinctive and dominant components. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but rarely has the chance to make

² “Dixie”. Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 21 March 2011 <http://oxforddictionaries.com/view/entry/m_en_gb0234710>.

direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind.

38) In this case, in both marks the distinctive and dominant component is the word DIXI or DIXY. As I have discussed above, the UK consumer will perceive this word as an allusion to something American but no more than this.

39) Mr Sorenti referred me to the decision of the General Court in *Vitakraft-Werke Wuhrmann v OHIM – Johnson’s Veterinary Products (VITACOAT)* Case T-277/04 to support his contention that where the shared element of the respective marks is lacking distinctiveness then it is of diminished importance. I note this case and accept the principle, however, I am also mindful of the guidance provided by the CJEU in Case C-235/05 P, *L’Oréal SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Revlon (Switzerland) SA*

“45 The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

40) Therefore, where the shared element is of low distinctive character, this does not allow me to ignore that element in my considerations.

41) In SABT1’s mark the word DIXY is placed centrally within the mark, with all the remaining elements being subservient to this word. The device of a chicken’s head is relatively small and appears only above the letter “Y”, the word CHICKEN is smaller and appears under the word DIXY. Of course it is also descriptive. The colours and oval shapes merely serve as a border and background to the other elements, even if the colours may serve to support an allusion to America (and the “star” device that appears in the mark in place of the dot above the letter “i” in the word DIXY may further support this). In Mr Khan’s mark, whilst the word DIXI does not share quite such a prominent position as the equivalent word in SABT1’s mark, it nevertheless appears twice, with the first occurrence on the left of the mark being singularly the most dominant element of the mark as a whole.

Smaller but more centrally placed is the device of a chicken's head (wearing a peaked hat). The word CHICKEN appears on the right of the mark and the background colours are, once again, red, white and blue. These elements are all repeated in the smaller square to the right of the mark. The word PAK appears in smaller text running from top to bottom on the far left of the main body of the mark and also in small letters to the top left of the word DIXI in the square to the right.

42) The CJEU has commented in *Shaker* that it is only permissible to make the comparison of marks on the basis of the dominant element only when all other components are negligible. In respect of both marks, the devices of chicken's heads are not negligible and neither is the word CHICKEN or the bold red, white and blue colours. Further, whilst I have noted earlier that the word PAK is less dominant than the DIXI element of Mr Khan's mark, it is nonetheless, not negligible. It is obvious from these findings that I must consider the respective marks in their entireties but that the word DIXI/DIXY is the dominant, distinctive element (even if its level of distinctiveness is low).

43) I must factor in all of the above when considering the level of similarity of the marks in their entireties. The dominant and distinctive part of the respective marks is the word DIXI or DIXY. They also share a reasonably high level of visual similarity and a high level of aural and conceptual similarity and these combine to create a reasonably high level of similarity overall.

Distinctive character of the earlier trade mark

44) I have to consider whether SABT1's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. The mark contains the words DIXIE CHICKEN. As I have noted above, this may have some allusive quality in that the consumer may make some undefined link to chicken and the United States. As such, these words do not enjoy a particularly high level of inherent distinctive character. The stylized device of a chicken's head merely reinforces the descriptive meaning of the word CHICKEN. Mr Khan argues that the colours red, white and blue allude to the USA. There is no evidence before me to support this, but I do not see this as significantly altering the already lowish level of inherent distinctive character.

45) Whilst it is clear from the evidence that SABT1 has been using its mark to identify a number of fast food restaurants in the Birmingham area there is a lack of detail regarding the scale of the business identified by the mark or its market share. The inference, however, is that it is a localized business with no significant share of the UK fast food restaurant market. Such a level of use is insufficient for me to conclude that the distinctive character of SABT1's mark has been enhanced through use.

Likelihood of confusion

46) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

47) Whilst the point that the average consumer will not consider a descriptive element of a compound mark as its distinctive and dominant element has been established by the General Court (GC) in Case T-129/01 *Alejandro v OHIM – Anheuser-Busch (BUDMEN)* [2003] ECR II-2251. Nevertheless, I am also mindful of the comments of the GC in *CM Capital Markets Holding, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-563/08, where it was recognised that such elements are not necessarily negligible in the overall impression conveyed by the mark. Taking account of this guidance, the word CHICKEN in both parties' marks cannot be said to be negligible and I must consider it as a relevant element of the marks.

48) Further, I am also mindful of the GC's comments in *Usinor SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-189/05:

“70 Nevertheless, although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion (*Canon*, paragraph 24), it is only one factor among others involved in that assessment. Thus, even in a case involving an earlier mark of weak distinctive character, on the one hand, and a trade mark sought to be registered which is not a complete reproduction of it, on the other, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (Case T 112/03 *L'Oréal v OHIM – Revlon (FLEXI AIR)* [2005] ECR II 949, paragraph 61), particularly where the mark sought to be registered includes elements which are even less distinctive than the element that is common to the marks at issue (see, to that effect, order of 27 April 2006 in Case C 235/05 P *L'Oréal v OHIM*, not published in the ECR, paragraph 45). Since likelihood of confusion is the specific prerequisite for protection of the earlier mark, that protection applies irrespective of whether the earlier mark has only weak distinctiveness (Case T 147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II 11, paragraph 110). The fact that the earlier mark has weak distinctive character does not therefore mean that the similarity of the marks at issue may be disregarded; otherwise there would be a failure to comply with the obligation under Article 8(1)(b) of Regulation No 40/94 to make a global assessment of the likelihood of confusion (see, to that effect, Case C 171/06 P *TIME ART v Devinlec and OHIM* [2007] ECR I 00 00, paragraph 41).”

49) Applying this guidance to the facts of the current case, it is clear to me that whilst the words DIXY or DIXI may allude to the United States, this does not mean I can disregard this similarity when considering likelihood of confusion.

50) At the hearing, Mr Sorenti also argued that consumers could differentiate establishments by the different layout of the restaurants and different staff uniforms. I am not persuaded by this. Fast food and non-stop restaurants often have similar layouts and ambience and even where there is a different layout, this is unlikely to alert the consumer that the restaurants are operated by different entities. Further, the level of attention paid to staff uniforms is not such as to alert consumers to the existence of different operators. I, therefore, dismiss this argument.

51) I have found that the respective services are identical and that visual considerations play an important part of the purchasing act. However, I do not ignore aural considerations. I have also found that the level of consideration, on the part of consumer, during the purchasing act is on the low side. In respect of the marks themselves, I have found that they a reasonably high level of similarity overall. I also found that the earlier mark has a lowish level of distinctive character.

52) Taking all of the above into account, and on the balance of probability, I find that despite the low level of distinctive character of the shared elements of the respective marks, when bearing in mind imperfect recollection, the average consumer will confuse the marks or, at the very least, assume that the services provided under the respective marks originate from the same or linked undertakings.

53) In light of these findings, the application for invalidation of Mr Khan's registration is successful in its entirety.

COSTS

54) The application for invalidation having been successful, SABB1 is entitled to a contribution towards its costs. I take account of the fact that both parties filed evidence, but that this was on the light side, and that a hearing has taken place. I award costs on the following basis:

Filing application of invalidation and considering statement in reply	£500
Preparing evidence and considering other sides evidence	£600
Preparing for, and attending hearing	£600
TOTAL	£1700

55) I order Tariq Mehmood Khan to pay SABB Limited the sum of £1700. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 06 day of April 2011

**Mark Bryant
For the Registrar,
the Comptroller-General**