

O-364-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2538378
BY XEN IOANNOU TO REGISTER THE TRADE MARK**

LAHORE EXPRESS

IN CLASSES 29, 30, 32, 33, 39 AND 43

**AND IN THE MATTER OF OPPOSITION
THERETO UNDER NO 100608
BY ALI ASGHAR**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2538378
By Xen Ioannou to register the trade mark**

Lahore Express

and

IN THE MATTER OF opposition thereto under No 100608 by Ali Asghar

BACKGROUND AND PLEADINGS

1. On 8th February 2010, Xen Ioannou of 6 Duke Street, London, W1U 3EN applied to register the above mark in classes 29, 30, 32, 33, 39 and 43 in respect of the following goods and services:

Class 29:

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps.

Class 30:

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.

Class 32:

Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines.

Class 33:

Alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails.

Class 39:


Transport; packaging and storage of goods; travel arrangement; distribution of electricity; travel information; provision of car parking facilities.

Class 43:

Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation;

booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.

2. The application was allocated number 2538378 and was published in the Trade Marks Journal on 12th March 2010 and on 14th June 2010 Mr Ali Asghar of 348 Great Horton Road, Bradford, West Yorkshire BD7 1QJ lodged an opposition against the goods and services specified above.
3. Mr Asghar has opposed on the sole basis of section 5(2)(b) of The Trade Marks Act ('the Act'), citing the following earlier mark:

| Mark. Filing and registration dates | Goods and services relied upon under section 5(2)(b) |
|---|--|
| <p>2486501</p>  <p>(Series of two)</p> <p>1st May 2008</p> <p>16th January 2009</p> | <p>Class 29:</p> <p>Fresh foods for human consumption; ready meals; pre-prepared meals, pre-packed meals; instant meals; individual ready meals; ready to serve meals; chilled ready meals; cooked meals; foodstuffs in the form of prepared meals; frozen cooked meals; frozen prepared meals; prepared meals for consumption on or off the premises; desserts; chilled desserts; frozen desserts; prepared desserts; snack food; snack food products; delicatessen foods.</p> <p>Class 43:</p> <p>Provision of foods and drink; dining, catering and restaurant services; bar services; coffee shop services; café services; delicatessen services; cooking services; restaurant services and provision of fast foods; self service restaurants; takeaway services; snack bar services; arranging of meals; services rendered by restaurants, cafeterias, cafes, snack bars, sandwich bars, canteens, coffee bars, coffee shops and tea rooms.</p> |

4. Mr Asghar says the respective marks are similar and the respective goods and services either identical or similar. As regards this latter claim in relation to the goods and services, I felt this had been too vaguely pleaded, and in

consequence I asked Mr Asghar and his attorneys to say exactly what goods and services they considered to be identical or similar. It is their later, particularised claim that I shall take into account in my decision.

5. Mr Asghar says the dominant part of Mr Ioannou's mark is the word 'Lahore' which is identical to his own mark. The word 'Express' would denote only the nature of the goods themselves. As a consequence, there is a likelihood of confusion.
6. Mr Ioannou, who is unrepresented, filed a counterstatement denying that there is a likelihood of confusion. He provides some background on the Pakistani city of Lahore, derived from WIKIPEDIA. This says it is the capital of the Pakistani province of Punjab, which, in mid -2006, had a population of 10 million and was ranked by THE GUARDIAN as the second best tourist destination in Pakistan. Lahoris are known for their love of food and many tourists are attracted to the food streets in the historic locales of Gawalmandi, Anarkali and Badshahi. New restaurants are constantly opening, says the information taken from WIKIPEDIA.
7. Mr Ioannou says any similarity between the respective marks is based solely on the identity of the city of Lahore. Lahore should not be available to be used by one sole company. The word 'American' in 'AMERICAN EXPRESS' does not mean that no other company can use the word 'American'. He says there are various other existing trade marks using the name 'Lahore' already. In his letter of 22nd September 2009 he specifies three such establishments: LAHORE KARAHI in Tooting, THE ORIGINAL LAHORE KEBAB HOUSE in St John's Wood and LAHORE GRILL in the Edgware Road. Mr Ioannou says 'Lahore Express' is a brand name in its entirety and 'Lahore' is not, accordingly, a dominant element.
8. He says, further, that the 'concept' for 'Lahore Express' restaurants is to deliver high class Punjabi cuisine, providing quality and authentic foods, derived from the city of Lahore. A photograph is provided showing the inside of a restaurant beneath the trade mark 'lahore express' in lower case, and accompanied by a series of three multi- hexagonal shapes of differing sizes. In contrast, he says the opponent's 'concept' is to 'offer a unique combination of eastern and western flavours within their café bar. This information is taken, but not exhibited as formal evidence, from the opponent's website at www.lahorecafebar.co.uk.
9. Due to these different concepts, types of service (the opponents offering a four storey dining space and Mr Ioannou offering fast, authentic food), different clientele, (Mr Ioannou's clients coming from areas of high foot flow and busy environments), the 'Lahore Express' concept would not obstruct or prejudice the opponent's business, as claimed by Mr Asghar.

10. No formal evidence was filed by either party and no hearing was requested and so I give my decision based upon a careful reading of the papers.

DECISION

Section 5(2)(b)

11. The opposition is founded upon Section 5(2) (b) of the Act which 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.”

12. Mr Asghar’s mark was filed on 1st May 2008 and registered on 16th January 2009. It is therefore an earlier mark in accordance with Section 6 of the Act. Moreover, given its date of registration is within 5 years of the publication of the application, it is not subject to proof of use requirements.

13. 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] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 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;

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

Preliminary comment

14. As one of the parties is unrepresented, it is important to explain and stress at the outset that, in an opposition, I am required to consider a *notional* question

as to the likelihood of confusion. That is to say, what matters to me are the marks applied for and the goods and services for which they are either already protected, or in respect of which they seek protection (ie the respective specifications). It is largely irrelevant then, what the *actual* goods and services offered by the parties may be¹.

15. Mr Ioannou has supplied material from his own and Mr Asghar's web sites or other sources and this ought properly to have been put in evidence by him in accordance with rule 64 of The Trade Marks Rules 2008. But even if it had, it would not have made any difference to the outcome because, as I have said, I am engaged in a notional assessment rather than assessing the position in actuality. The particular nature of the goods themselves, (by which I mean in this case, that one person sells 'authentic Punjabi cuisine' and the other a 'fusion of eastern and western' flavours), the particular settings in which these products are sold (by which I mean, one person operates a restaurant and the other a café bar), the type of service and the different clientele are all not relevant in my assessment.
16. The approach taken, as set out above by the case law, is one which makes an assessment of the various factors affecting the evaluation of likelihood of confusion and these include:- identifying who the average consumers would be, comparing the respective marks and assessing their similarity and also comparing the respective specifications. I must also make an evaluation of the distinctive character of the earlier mark. All these factors are then brought together in a final evaluation of likelihood of confusion.

The average consumer and nature of the purchase

17. The average consumer for both parties' goods and services, with the possible exception of Mr Ioannou's 'transport, package and storage services' in class 39 which may be provided on a business to business basis, will be the

¹ There are a number of legal authorities on the question both of the required *notional* assessment of goods and services, and that the particular ways in which goods and services are marketed is irrelevant. See, firstly, eg *Origins Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280 at page 284, which although referring specifically to section 10 of the Act, nevertheless applies also to the likelihood of confusion test I am required to undertake in this case.

Secondly, see, eg, Case C-171/06P *T.I.M.E Art v OHIM and Devinlec Developpement Innovation Leclerc*, where the Court of Justice of the European Union says:

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

general public. There is, thus, an overlap as far as the identities of the respective groups of average consumers are concerned.

18. In the main, and as far as the food and food related services are concerned, these are everyday purchases.
19. The goods and services involved will not engage the average consumer in a purchase requiring a high attention to detail or circumspection, in contrast say, to the purchase of a car or high value jewellery item. Most of the food products involved will be accessed by visual selection, in places such as supermarkets and other retail outlets. Having said that, I also recognise that, again for 'delicatessen products' these may be asked for rather than visually selected.
20. I have not ignored that certain of Mr Ioannou's services are not food related, or rather, do not have the service of food, drink or accommodation as their primary purpose, such as retirement home services and crèche services. To my mind these services stand apart, and whilst they may be accessed by the general public, the process of their selection and people to whom they are directed may be more refined than the provision of food and drink.
21. These observations will be factored into my assessment of likelihood of confusion below.

Comparison of the goods and services

22. In assessing the similarity of the goods and services, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the Judgment:

'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 and their method of use and whether they are in competition with each other or are complementary.'

23. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.
24. It is important to recognise that even though the factual evidence on similarity may be non-existent, I nevertheless have the statements of case, and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC, sitting as

the Appointed Person, said in *Raleigh International trade mark* [2001] R.P.C. 11, at para 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary.

25. I should finally mention that in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 (“*Avnet*”), Jacob J cautioned against giving too wide a construction to specifications for services covering a vast range of activities and that they should be confined to the substance, as it were, of the core of possible meanings attributable to the rather general phrase.

26. The relevant goods and services to be compared are:

| Mr Ioannou’s goods and services | Mr Asghar’s goods and services |
|--|---|
| <p>Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps.</p> <p>Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.</p> <p>Class 32: Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines.</p> <p>Class 33: Alcoholic wines; spirits and liqueurs;</p> | <p>Class 29: Fresh foods for human consumption; ready meals; pre-prepared meals, pre-packed meals; instant meals; individual ready meals; ready to serve meals; chilled ready meals; cooked meals; foodstuffs in the form of prepared meals; frozen cooked meals; frozen prepared meals; prepared meals for consumption on or off the premises; desserts; chilled desserts; frozen desserts; prepared desserts; snack food; snack food products; delicatessen foods.</p> |

| | |
|--|---|
| <p>alcopops; alcoholic cocktails.</p> <p>Class 39:</p> <p>Transport; packaging and storage of goods; travel arrangement; distribution of electricity; travel information; provision of car parking facilities.</p> <p>Class 43:</p> <p>Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.</p> | <p>Class 43:</p> <p>Provision of foods and drink; dining, catering and restaurant services; bar services; coffee shop services; café services; delicatessen services; cooking services; restaurant services and provision of fast foods; self service restaurants; takeaway services; snack bar services; arranging of meals; services rendered by restaurants, cafeterias, cafes, snack bars, sandwich bars, canteens, coffee bars, coffee shops and tea rooms.</p> |
|--|---|

Class 29

27. The following in Mr Ioannou’s specification are self- evidently identical to ‘fresh food for human consumption’ :- ‘meat, fish poultry and game’ and ‘eggs and milk’. ‘Milk products’ is plainly broader than just ‘milk’, but in the light of the perishable nature of milk and the fact that milk based products are generally sold in close proximity to milk itself in the supermarket, I consider that ‘milk products’ are highly similar to ‘fresh food for human consumption’.
28. ‘Jellies’ and ‘compotes’ in Mr Ioannou’s specification are identical to ‘desserts’ in Mr Asghar’s specification. This is because ‘jelly’ and ‘compote’ are specific examples of what is commonly referred to, and consumed as, a dessert.
29. ‘Prepared meals’ and ‘soups’ (which can be sold as ‘ready meals’) in Mr Ioannou’s specification are identical to, “ready meals; pre-prepared meals, pre-packed meals; instant meals; individual ready meals; ready to serve meals; chilled ready meals; cooked meals; foodstuffs in the form of prepared meals; frozen cooked meals; frozen prepared meals; prepared meals for consumption on or off the premises” all in Mr Asghar’s specification.

30. 'Potato crisps' in Mr Ioannou's specification are identical to 'snack food' and 'snack food products'. This is because 'potato crisps' are commonly understood to be, or a specific example of, convenience or 'snack foods'.
31. As far as 'preserved, dried and cooked fruits and vegetables' are concerned, these are, by definition, not 'fresh foods' (which could include, eg fresh fruit) but have been processed in some way. This means they may be in a different area of a large supermarket from fresh produce. That said, in their actual nature, they are nonetheless fruit and vegetables and as such, their respective channels of trade may be the same. Taking all factors into account I find that these products are similar to a high degree to Mr Asghar's goods.
32. That leaves:- 'jams', 'meat extracts', and 'edible oils and fats'. My understanding is that 'meat extract' is akin to a broth, such as, eg BOVRIL. I do not consider any of these items to be similar to Mr Asghar's specification. In the case of meat extracts, and edible oils and fats, they are primarily in liquid form and would not be considered fresh foods. None of these products constitute *meals*, in and of themselves, and may be found in areas of, eg a large supermarket, apart from (ie, not in close proximity to) Mr Asghar's food products. Finally, 'jams' are likewise, housed in a separate and discrete area of a supermarket and are not of themselves, fresh food, desserts or whole meals. Although it may be argued that 'jams' can complement desserts, there are other factors, such as the discrete area of the supermarket in which they can be found, their other uses apart from complements to desserts and channels of trade, all of which, in my view, render them not similar to Mr Asghar's goods.

Class 30

33. The difference between class 29 and class 30 is that class 29 comprises in the main, foods of animal origin and class 30 foods of plant origin.² Of itself, however, the fact goods may appear in different classes does not preclude a finding of similarity in an assessment of likelihood of confusion.³
34. The claim by Mr Asghar is that: "sugar, rice, tapioca, sago, flour and preparations made from cereals, bread, pastry and confectionery, honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices, sandwiches; prepared meals; pizzas, pies and pasta dishes" are all identical to his own goods in class 29. Whereas, "coffee, tea, cocoa, artificial coffee, ice and ices" are all similar to his goods in class 29.

² See the list of Class Headings with explanatory notes published by WIPO in the Ninth Edition of The Nice Agreement on classification of goods and services.

³ See, eg para 36 and following of Case BL O-004-11, *Tao Asian Bistro*, a decision of the Appointed Person.

35. Mr Asghar's products in class 29 are in the form, broadly speaking, of fresh food, entire meals and desserts. Class 29 comprises goods, in the main, of animal origin. Mr Ioannou's goods are, by virtue of their selection in class 30 not necessarily of animal origin but of plant origin. That said, 'ices', 'tapioca' and 'sago' could all comprise a dessert; 'prepared meals' are also specified by Mr Asghar, but in a different class; 'pasta dishes' may conceivably comprise 'ready meals' and 'sandwiches, pizzas and pies' may comprise 'fresh food', or alternatively be regarded as specific examples of 'prepared or ready meals', also covered by Mr Asghar in his class 29 specification. As regards these items I have listed above, as I have said before, the fact such products are specified in a different class cannot preclude a finding of similarity. On that basis, I find that: 'ices', 'tapioca', 'sago' 'prepared meals', 'pasta dishes', 'sandwiches', 'pies' and 'pizzas' are all highly similar to their respective pairings in class 29 I have identified above.
36. The remaining goods would not be considered 'fresh food', do not comprise entire meals and are not desserts per se. Condiments and sauces, even fresh ones for example, are simply used to flavour food, and moreover are sold in a separate and discrete area from other food products in a supermarket and have different channels of trade. Likewise, sugar, rice, flour and preparations made from cereals, bread, pastry and confectionery, honey, treacle, yeast, ice and baking powder. On that basis, I find all of these not to be similar to any of Mr Asghar's class 29 products.
37. Finally, in this class, I must deal with the claim that "coffee, tea, cocoa and artificial coffee" are similar to goods in Mr Asghar's specification in class 29. These goods are to be drunk, not eaten and again, are in a discrete area of the supermarket, generally apart from food items. Their respective channels of trade and manufacturers are also different. On that basis, I find these goods are not similar to any of Mr Asghar's products.

Class 32

38. The claim by Mr Asghar is that all the goods appearing in Mr Ioannou's specification are similar to his goods in class 29.
39. The goods in Mr Ioannou's specification are self-evidently for drinking rather than eating, or otherwise to be used in the manufacture of drinks. As well as being different in nature and intended purpose, they can be found in discrete, distinct areas of a supermarket, apart from food products, and the manufacturers and channels of trade may also be different. On that basis, I find that these goods are not similar to Mr Asghar's class 29 specification.

Class 33

40. The claim is, again, that the goods in this class are similar to Mr Asghar's class 29 specification. For the same reasons given above in relation to class 32 I do not accept this claim and find, accordingly, that the goods are not similar to Mr Asghar's goods.

Class 39

41. The claim by Mr Asghar is that the services in this class are similar to the services in his own class 43. Mr Asghar's services have, as their primary purpose, the provision of food and drink in a variety of settings and circumstances. Applying the *Avnet* 'core meaning' principle, the nature and intended purpose of the services in Mr Ioannou's specification are all different. It must be assumed in this respect that the services listed by Mr Ioannou are offered, for example, to other businesses or the public, and not as *mere adjuncts* to a restaurant or other food and drink establishment. Food establishments do not, as a rule, offer transport, packaging, travel arrangement, electricity or car parking services. On that basis, I find that the services in Mr Ioannou's specification are not similar to those of Mr Asghar's class 43 specification.

Class 43

42. The claim by Mr Asghar is that, 'Services for the provision of food and drink, restaurant, bar and catering services' in Mr Ioannou's specification are all identical to his own identical or similarly named services in this class. This is self-evident and I agree.

43. He also claims that, 'temporary accommodation, provision of holiday accommodation' are all similar to his own services in this class. Taking into account the *Avnet* core meaning principle, any consideration of services has to be restricted to "substance, as it were, of the core of possible meanings attributable to the rather general phrase". Whilst the providers of temporary and holiday accommodation may, for example, provide food and drink on their premises, in substance they provide accommodation; that is their 'core service'. Having said that, the service of food and drink inevitably complements the primary accommodation service and is indispensable to it. Moreover, it cannot be ignored that many hotels and other places providing accommodation are known also for their restaurants and café services, which may or may not be open just to residents. Taking all factors into account, I find these services are similar to a moderate degree to Mr Asghar's services.

44. It could be said, perhaps, that 'booking and reservation services for restaurants' must be similar to restaurants themselves. In my view, however,

a normal restaurant which you would phone to book a reservation is not, in fact, strictly speaking, offering booking and reservation services as they would be understood. It would not, for example, take bookings on behalf of other restaurants and so, insofar as it inevitably takes its own bookings, these are only part and parcel, and incidental to, its primary restaurant service. Such a booking and reservation service, properly speaking and understood, would be along the lines, eg, of a 'portal' or 'directory', similar to something being offered by, eg, a travel agency, through which the consumer can access the (or any) particular or affiliated restaurant they wish and make a booking. Such a service, whilst it may be said to be complementary to the restaurant itself, is not in its nature and intended purpose, similar. Along with the differences in nature and intended purpose, the channels of trade may also be different. On that basis I find that 'booking and reservation services for restaurants are not similar to Mr Asghar's services.

45. Such differences in nature and intended purpose are true, especially, of 'retirement home services' and 'crèche services', both of which clearly have a discrete, unique function and intended purpose. The undertakings offering these services, whilst inevitably serving food and drink, do not hold themselves out as cafés or restaurants. On that basis, I find these services are also not similar to those of Mr Asghar's class 43 specification.

46. It would help at this point if I summarise my findings in a table.

| Class 29 (Mr Ioannou's goods) | Mr Asghar's goods |
|---|---|
| Meat, fish, poultry and game, eggs, milk | Identical to: Fresh foods for human consumption |
| Prepared meals, soups | Identical to: Ready meals; pre-prepared meals, pre-packed meals; instant meals; individual ready meals; ready to serve meals; chilled ready meals; cooked meals; foodstuffs in the form of prepared meals; frozen cooked meals; frozen prepared meals; prepared meals for consumption on or off the premises |
| Potato crisps | Identical to: Snack food; snack food products |
| Jellies, compotes | Identical to: Desserts |
| Milk products; preserved, dried and cooked fruits and vegetables; | Highly similar to: Fresh food for human consumption |

| | |
|---|--|
| Jams, meat extracts, edible oils and fats; | Not similar |
| Class 30 | |
| Ices, tapioca, sago | Highly similar to: Desserts in class 29 |
| Prepared meals | Highly similar to: Prepared meals in class 29 |
| Pasta dishes | Highly similar to: Ready meals in class 29 |
| Sandwiches, pies and pizzas | Highly similar to: Fresh food for human consumption or prepared or ready meals in class 29 |
| Coffee, tea, cocoa, sugar, rice, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice | Not similar |
| Class 32 | |
| Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines. | Not similar |
| Class 33 | |
| Alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails. | Not similar |
| Class 39 | |
| Transport; packaging and storage of goods; travel arrangement; distribution of electricity; travel information; provision of car parking facilities. | Not similar |
| Class 43 | |
| Services for providing food and drink, restaurant, bar and catering services. | Identical to: Provision of foods and drink; dining, catering and restaurant services; bar services. |
| Temporary accommodation, provision of holiday accommodation. | Similar to a moderate degree: Provision of foods and drink; dining, catering and restaurant services; bar |


| | |
|--|--------------------|
| | services. |
| Booking and reservation services for restaurants and holiday accommodation, retirement home services, crèche services. | Not similar |

Comparison of marks

47. The case law makes it clear I must undertake a full comparison, taking account of visual, phonetic and conceptual similarities and dissimilarities, from the perspective of the average consumer. Marks need to be considered in their totalities and taking account of overall impression (see authorities (c), (e) and (f) above in para 13), giving recognition to distinctive and dominant elements.

Visual comparison

48. The respective marks for comparison are as below:

| Mr Ioannou's mark | Mr Asghar's mark |
|-------------------|--|
| Lahore Express |  |

49. As can be seen, the applicant's mark comprises the words 'Lahore Express' in normal title script. The opponent's mark comprises a series of two; the first being in grey scale and the second in colour, the colours being blue and orange. Both marks of Mr Asghar's series contain the recognisable six letter word 'lahore' in lower case script. The colour mark has a large blue background against which the l, a, h, and o letters of the word 'lahore' are set, and a much smaller orange square device immediately to the right of the larger square. The word 'lahore' is in orange. Both parties' marks share the common verbal element 'Lahore'. Taking the similarities and dissimilarities into account I find that the respective marks are visually similar to a more than moderate degree.

Phonetic comparison

50. The applicant's mark will be pronounced 'La-hore Ex-press' and the opponent's mark will be pronounced 'la-hore'. The device element of the opponent's mark will not be enunciated. Taking the similarities and dissimilarities into account, I find the marks to be phonetically similar to a high degree.

Conceptual comparison

51. By conceptual similarity, it is meant 'semantic' conceptual similarity. The opponent's mark simply evokes the well-known Pakistani city of Lahore. The colours and device elements used will not vary or disturb that simple evocation.
52. The applicant's mark will likewise evoke that same Pakistani city. The additional, following, word 'Express', will simply evoke the notion of speed. The words 'Lahore Express' do not convey any recognisable object or 'thing' to the average UK consumer; for example, 'Orient Express' is a well-known train. There would be no such recognition as far as 'Lahore Express' is concerned.
53. On that basis I consider the respective marks to be conceptually highly similar.

Distinctive and dominant elements

54. I need to bring my individual findings together, taking account both of the distinctive and dominant element of the respective marks and the primarily visual nature of the selection of the goods and services. The distinctive and dominant element of both marks is the word 'Lahore'. Many will recognise Lahore as a Pakistani city (but, of course, remote as far as the UK is concerned) and the word will therefore, to many UK consumers, be somewhat 'evocative' of Pakistani food in general. The point about being 'evocative' is that the word 'Lahore' will not directly describe a particular and objective characteristic of the food. The average UK consumer is unlikely to recognise the term as describing a specific type of 'Lahori' or 'Lahorian' cuisine, in other words. This is a point I shall return to in my analysis of distinctiveness below.
55. The other elements in the respective marks are subsidiary to the word 'Lahore'. Specifically, the word 'Express' in Mr Ioannou's mark, and in the context of the goods and services for which the mark is applied for, will act in

a descriptive capacity or otherwise will not materially contribute to the overall distinctiveness of his mark. In particular, the word 'Express' would simply convey the notion that the services are speedy, such as in, for example, a take away service. In relation to food itself, the word 'Express' will also simply evoke the notion of speed, as in the food will be ready to serve or can be prepared at speed. The device element of Mr Asghar's mark will be viewed as, essentially, decorative, having neither impact on the word Lahore and nor obviously, representing, of itself, any independent meaning or point of reference. I have also found above at para 19 that visual selection will be an important factor (without ignoring the other factors) in the selection process.

56. Taking these factors into account, I find that, overall, the respective marks are similar to a high degree.

Distinctiveness of the earlier mark

57. Before proceeding to bring all my findings together in an overall global assessment, I need to make an assessment of the distinctive character of the earlier mark. Though I have already identified Lahore as distinctive, this exercise involves 'grading' the earlier mark on a scale of distinctiveness; an invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness, KODAK being the prime example. But, for example, a recognisably laudatory, or potentially descriptive term, will be low on the scale of distinctiveness.

58. Mr Ioannou argues, in effect, that 'Lahore' has 'low distinctiveness' by referring to the frequent use of the word in trade or on the trade marks register. The presence on the register of other marks with the word 'Lahore' in them does not mean such a word is necessarily, in real market conditions, low in distinctiveness. It simply means that others regard it as an attractive trade mark.

59. Lahore will, as I have said, be recognised by many average consumers as a Pakistani city. In terms of its resonance as far as the goods and services are concerned, such a word will, in respect of many of the food items and services specified, evoke, but without *objectively describing*, the type of food or cuisine on offer, or even perhaps the ambience of the particular food establishment. It cannot, as a result, be said the earlier mark is 'highly distinctive' as 'Lahore' is not, for example, an invented word, but at the same time, neither is it obviously a laudatory or descriptive term. It is simply, and for many, 'evocative', and on that basis I find that the earlier mark is distinctive to an average degree.

Likelihood of confusion

60. At this point I need to remind myself of my various findings and bring them together in a global assessment taking, of course, into account, the doctrine of imperfect recollection, namely that consumers rarely have the opportunity to compare marks side by side.
61. I have found the respective marks to be similar to a high degree. I have found the respective average consumers to overlap in terms of their identities and the purchasing process not to involve the consumers in the highest attention to detail or circumspection. I have found the earlier mark to be distinctive to an average degree. I have found many of the goods and services to be identical, highly or moderately similar
62. In all the circumstances I find that there is a likelihood of confusion and the opposition succeeds in respect of all those goods and services I have found either to be identical, highly or moderately similar. The opposition fails, however, in respect of all the goods and services I have found not to be similar.
63. It would help if I recall exactly which the goods and services fall into which category. The opposition *fails* in respect of:

Class 29

Jams, meat extracts, edible oils and fats;

Class 30

Coffee, tea, cocoa, sugar, rice, flour and preparations made from cereals, bread, pastry and confectionery, honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 32

Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines.

Class 33

Alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails.

Class 39

Transport; packaging and storage of goods; travel arrangement; distribution of electricity; travel information; provision of car parking facilities.

Class 43

Booking and reservation services for restaurants and holiday accommodation, retirement home services, crèche services

64. The opposition *succeeds* in respect of:

Class 29

Meat, fish, poultry and game, eggs, milk; prepared meals; preserved, dried and cooked fruits and vegetables; potato crisps; jellies; compotes; milk products, soups.

Class 30

Ices; tapioca; sago; prepared meals; pasta dishes; sandwiches; pies; pizzas.

Class 43

Services for providing food and drink, restaurant, bar and catering services; temporary accommodation, provision of holiday accommodation.

65. There is just one final argument made by Mr Ioannou, with which I feel I should deal. He says no-one should have a 'monopoly' in the word 'Lahore', on the basis that, for example, use of 'American Express' does not prevent others from using 'America(n)' in their names or marks. He also points to several examples of companies in London using the word 'Lahore' in their names. This submission can be dealt with fairly briefly.

66. The fact a mark is, or contains, a geographical indication does not constitute grounds, of itself, to refuse the protection given by trade mark registration, nor is the fact that others may be using such a term already in their trading names or marks. Those others may or may not have a defence, in the event they are

sued, or, alternatively, based upon their own prior rights, be in position to seek to invalidate a later trade mark application. Mr Ioannou himself has applied for such 'monopoly' protection, albeit of a term which also includes the descriptive word, 'express'.

67. In other words, this may be case of 'first come, first served' in terms of registration of the word 'Lahore' for restaurant services, but there are no grounds upon which to refuse registration. I appreciate this is something of an 'absolute' grounds point, which has not been expressly pleaded by Mr Ioannou, but in the circumstances, and especially as Mr Ioannou is unrepresented, I felt it would be helpful to provide an answer to his point.

Costs

68. On balance, I believe the parties have achieved roughly equal success. I have rejected many of the Mr Asghar's claims as to identity or similarity of goods and services, but at the same time accepted his arguments in respect of the marks themselves, and in relation to the core restaurant services, Mr Asghar has been successful. Overall, however, I feel this is a case in which it is not easy to say either party is clearly successful against the other and on that basis I make no award of costs.

Dated this 25th day of October 2011

**Edward Smith
For the Registrar,
the Comptroller-General**