

O-384-12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 2484948  
IN THE NAME OF ISS MEDICLEAN LIMITED  
IN RESPECT OF THE TRADE MARK:**



**just  
EAT**

**AND  
AN APPLICATION (NO. 84044) FOR A DECLARATION OF INVALIDITY BY  
JUST EAT HOST A/S**

## BACKGROUND

1. Trade mark No. 2484948 shown above stands registered in the name of ISS Mediclean Limited ("ISS"). It was applied for on 15 April 2008 and completed its registration procedure on 21 November 2008. It is registered for the following services in class 43:

Restaurant and catering services.

2. On 12 April 2011, Just Eat Host A/S ("JEH") filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and (b) and sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") which state:

"47(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) that there is an earlier trade mark in relation to which the conditions set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

And:

"5. - (2) A trade mark shall not be registered if because -

(a)....


(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or..."

3. JEH directs its application against all of the services for which ISS's trade mark stands registered. Under section 5(2)(b) it relies upon the following trade mark registration:

Trade Mark	No.	Application date	Registration completion date	Goods and services relied upon and best case
 Colours claimed: Orange and yellow letters.	CTM 3325974	22/8/2003	11/7/2006	Although JEH relies upon all the goods and services in classes 29, 30 and 43 for which the trade mark is registered, its best case lies with the services in class 43, namely:  Providing of food and drink; cafés, cafeterias, catering, diner transportable, canteens, restaurants, snack-bars, pizzeria.

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

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

JEH's registration qualifies as an earlier trade mark under the above provisions.

5. For its objection based upon section 5(4)(a) of the Act, JEH relies upon the trade mark shown above and the words JUST-EAT alone. It indicates that both signs have been used throughout the UK since April 2006 in relation to:

“Listing restaurant and takeaway restaurant particulars and menus on the Internet; restaurant and takeaway restaurant directory and search services; restaurant and takeaway restaurant opinion polling; restaurant and takeaway restaurant industry statistics; Internet advertising services for restaurants and takeaway restaurants; consumer generated reviews for restaurants and takeaway restaurants for the purposes of consumer research; order procurement services for restaurant and takeaway restaurants; food delivery services; booking and ordering services for restaurants and takeaway restaurants; takeaway restaurants services”.

6. On 9 June 2011, ISS filed a counterstatement which consists, in essence, of a denial of the grounds upon which the invalidation has been brought. However, it does admit that the services (but not the goods) contained in JEH's earlier trade mark are (with the exception of the phrase "diner transportable" which it says it doesn't understand), identical or similar to the services in its registration.

7. Both sides filed evidence. A hearing took place before me at which JEH was represented by Mr Simon Malynicz, of counsel, instructed by J A Kemp & Co. ISS was represented by Ms Angela Fox of R G C Jenkins & Co.

## **EVIDENCE**

### **JEH's evidence**

8. This consists of a witness statement from Hossein Alizadeh dated 17 October 2011. Mr Alizadeh is the Legal Counsel of Just-Eat Holding Limited which is the parent company of JEH. Mr Alizadeh states:

"JEH hold intellectual property rights, including goodwill, for and on behalf of Just Eat Holding Limited and the other Just Eat group companies."

9. In his statement, Mr Alizadeh refers to these two entities as "my company"; I shall refer to them as "his company". The main facts emerging from Mr Alizadeh's statement are:

- his company's activities began in Denmark in 2000 and have now expanded to a number of European countries including the UK;
- although a preliminary web page was available from November 2005, in March 2006 his company's website [www.just-eat.co.uk](http://www.just-eat.co.uk) went live using the trade mark the subject of its registration and the sign JUST-EAT (word only);
- exhibit HA2 consists of pages downloaded from the free online encyclopaedia *Wikipedia* on 11 August 2011 which Mr Alizadeh says: "provides a potted history of [his company] and whose details, I can confirm, are accurate as at today's date" [i.e. the date of his statement]. The article describes the applicant in the following terms:

"Just-Eat is a UK headquartered service for ordering takeaway food online. The service is available in the UK, Denmark, Canada, Ireland, The Netherlands, Belgium, Sweden, Norway, India and Switzerland. As of early 2011 Just-Eat has more than 15,000 restaurants across its worldwide network, with more than 7,000 in the UK alone..."

- exhibit HA3 consists of sample pages taken from the website dating from November 2005 and from 2006 to 2011. Mr Alizadeh states that the trade mark the subject of its registration was replaced by a new version in or around July 2009 which in turn was replaced by its current trade mark in February 2011. In use, JEH's earlier trade mark is accompanied by the letters .co.uk;
- exhibit HA4 consists of a table showing the number of restaurants in the UK that had signed up to use JEH's services since 2006. These are as follows: 2006 – 418; 2007 – 1248; 2008- 2752, 2009 – 5438, 2010 – 10330 and 2011- 13828;
- exhibit HA5 consists of a table showing the total number of take-away orders placed by individual customers using JEH's website between March 2006 and July 2011. Mr Alizadeh notes that by the end of March 2008, over 200,000 orders had been placed;
- turnover generated by Just Eat.co.uk Limited (which Mr Alizadeh states is the UK company that is associated with its website) had increased considerably from March 2006. He adds that turnover in that year amounted to £128,272 with the turnover in later years as follows: 2007 - £512, 695, 2008 - £962, 940, 2009 - £2,922,537 and £9,551, 557 in 2010. Exhibit HA6 consists of the annual accounts for Just Eat.co.uk Limited from 2006 to 2010 in support;
- Mr Alizadeh explains that in its efforts to build a high street presence, branded stickers containing his company's trade marks have been placed inside and outside member restaurants, and on pizza boxes, menus, delivery bags, delivery uniforms, delivery bikes and bus stop signs. Exhibit HA7 is, he explains, a copy of a sales presentation given to prospective partner restaurants in 2006/2007, together with photographs of shop fronts of partner restaurants "since 2006" and the latest trade mark user guidelines;
- in addition to creating a high street presence, Mr Alizadeh explains that from as early as 2006 advertisements have been placed in trade press such as *PC World* and *Google Adwords* purchased. From August 2008 marketing activities have expanded to encompass national television campaigns, newspaper campaigns, "millions of leaflet drops" and social media sites such as *Facebook*. Marketing spend in the UK promoting the JUST-EAT brand has been as follows: 2006 - £19,971, 2007 - £107, 272, 2008 - £249,055, 2009 – £961,508, 2010 - £2,858,740 and to June 2011 - £2,463,984;
- Mr Alizadeh says:
 

"10. My company's success in the UK since 2006 meant that it quickly established a market leading position in the field of on-line ordering for takeaway restaurants, which is a position it continues to hold as the market itself has grown as a result of the development of this particular form of e-commerce, largely due to the efforts and innovation of my company."

## ISS's evidence

10. This consists of a witness statement from Andrew Paul Jones dated 13 December 2011; Mr Jones is ISS's Service Development Director. Mr Jones' statement consists of a mixture of evidence and submissions. I will not summarise the submissions here, but will keep them in mind when making my decision. The main facts emerging from Mr Jones' statement are:

- ISS is a subsidiary of ISS A/S, a Danish company who supplies facility services, including office cleaning, catering, office support and other services relevant to running a business or industrial building or site;
- ISS provides restaurants within hospitals and medical facilities for use primarily by hospital staff, visitors to patients and those attending for outpatient treatment;
- in the UK ISS operates its hospital restaurants under its own branding;
- in or around 2007, ISS decided to refresh the branding of its hospital restaurant services by designing a new "umbrella brand" which would sit on top of a range of different sub-brands each denoting a different type of food station. An independent design agency was commissioned and the trade mark the subject of the registration appeared in the list presented to ISS;
- the name was chosen as it best represented the idea behind ISS's hospital restaurant services offering i.e. its restaurants were places that staff and visitors could go to "just eat";
- ISS launched its first hospital restaurant under the trade mark the subject of its registration in April 2007 at St Mary's Hospital Paddington; this was followed by a launch at the Kingston Hospital in July 2007. Since that time, restaurants using the trade mark have been opened or re-launched in the following hospitals: Hammersmith, Harefield, the Royal National Orthopaedic Hospital, Leicester, Derby, Charing Cross, Woolwich, Liverpool, Worcester, Hairmyres and Calderdale. Exhibit APJ1 consists of two undated photographs of the trade mark in use;
- in relation to the trade marks at issue in these proceedings Mr Jones says:

"10. In fact, the only element the marks share is the words JUST EAT. These words are completely descriptive in relation to services for the provision of food and restaurant services – they amount to no more than a common and simple encouragement to "just eat". They denote exactly what any food vendor or restaurant operator wants to encourage potential customers to do";
- in order to put the number of JEH's partner restaurants and turnover at the end of 2007 into context, Mr Jones refers firstly to exhibit APJ 3 which is a *Financial Times* article dated 23 November 2009 entitled "Recession sees

growth in fast food outlets". He describes the number of JEH's partner restaurants as "a drop in the ocean when considered against the backdrop of the enormous number of independent and franchise fast food and casual dining restaurants and takeaways across the UK". Secondly, exhibit APJ4 is an academic paper by Sue Bagwell and Simon Doff of The Cities Institute and Faculty of Life Sciences respectively at London Metropolitan University. The paper from August 2009 is entitled "Fast Food Outlets in Tower Hamlets and the Provision of Healthier Food Choices". In paragraph 2.1 it says, inter alia: "The market for fast food takeaways, restaurants and cafes including home delivery in the UK in 2007 was £9.3 billion per annum in 2007";

- exhibits AJP5 and AJP6 consist of printouts from *Wikipedia* which provides revision statistics for the Just Eat entry provided by Mr Alizadeh as exhibit HA2 and a copy of the entry as it appeared in July 2009. Having commented on the date of creation of the entry, the nature of the entry and the timing of the revisions made to it, Mr Jones says:

"21...All of this suggests to me that much of the content appearing in the Wikipedia entry exhibited by Mr Alizadeh is recent and may have been written with an eye to improving [JEH's] position in these proceedings. I do not think it can be taken at face value as reflecting any substantial public profile of [JEH's] abbreviated business name "Just-Eat" or [the trade mark the subject of its registration] as of 15 April 2008."

### **JEH's evidence-in reply**

11. This consists of a further witness statement from Mr Alizadeh dated 24 February 2012. The main facts emerging from Mr Alizadeh's second statement are:

- exhibit HA09 consist of extracts downloaded from the Internet on 16 February 2012 to demonstrate "how companies who provide restaurant or cafe services in the UK in general also provide those services at the location of hospitals". Examples provided include *Costa Coffee* at, for example, Kings College Hospital, *M&S* cafe at St George's Healthcare Trust and *Burger King* at Addenbrooke's Hospital. Also included in this exhibit is an article dated 14 January 2010 taken from *Sky News Online* entitled "Row Cooking Over Burgers in NHS Hospitals";
- exhibit HA10 consist of pages downloaded from (i) blog.just-eat.co.uk on 16 February 2012 relating to orders received by JEH's website from, inter alia, hospitals (ii) two pages from www.sourcewire.com dated 13 February 2009 and entitled "Tens of Thousands of NHS Hospital Patients Sneak Takeaways Into Wards" (iii) an extract from the review page of *The Italian Takeaway* in Huddersfield (who are one of JEH's partners) downloaded on 16 February 2012 and whose advertisement includes a reference to "and there is a 10% discount for hospital staff and students", (iv) a page from www.supersupper.co.uk downloaded on 16 February 2012 and entitled "Hospital Patients eating takeaway food" and (v) two pages taken from

www.guardian.co.uk dated 28 may 2006 entitled: “Burger Bars replace NHS coffee shops”, and on the basis of which Mr Alizadeh concludes:

“...contrary to [ISS’s] comments...my company and [ISS] are likely to operate in the same commercial environment.”

12. That concludes my summary of the evidence filed to the extent that I consider it necessary.

## **DECISION**

### **The opposition based upon section 5(2)(b)**

13. JEH’s application is based upon, inter alia, section 5(2)(b) of the Act. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

### **The CJEU cases**

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; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

### **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, 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.”

14. In these proceedings JEH is relying upon the trade mark shown in paragraph 3 above which completed its registration procedure on 11 July 2006. As this trade mark had not been registered for five years at the date on which JEH filed its application for invalidity (i.e. 12 April 2011) it is not subject to proof of use as per The Trade Marks (Proof of Use, etc) Regulations 2004.

### **The average consumer and the nature of the purchasing process**

15. 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 these services are likely to be selected by the average consumer in the course of trade. In its skeleton argument ISS said:

“15. [ISS's trade mark] covers restaurant and catering services. These can range from cheap to expensive, but are in the main everyday services selected visually from available options, the selection of which does not normally involve a great deal of time. Therefore, the immediate visual impact of the marks and the way they are remembered will dominate the consumer's perception and recollection...”

16. The average consumer for restaurant and catering services is the general public. As to how restaurant/catering services will be selected by the average consumer, my own experience suggests that visual considerations (having encountered the trade mark on, for example, signage in the high street, in advertisements in magazines, on posters and on the Internet) are most likely to dominate the selection process. That said, I accept that as caterers and restaurants are often recommended by word of mouth, oral/aural considerations will also play a part in the selection process. The level of attention paid to the selection of restaurants and caterers by the average consumer will, in my experience, vary depending on the nature of the occasion for which they are being selected and will range from minimal to reasonably high. For, example, I doubt that the average consumer would display the same degree of care when selecting a venue to have an impromptu cup of coffee as they would when selecting, for example, a caterer for a wedding. In short, as the cost and importance of the selection increases, so will the degree of care displayed by the average consumer when selecting the services.

**Comparison of services**

17. ISS's trade mark is registered for: "restaurant and catering services" in class 43. As the class 43 element of JEH's trade mark contains references to "catering" and "restaurants", the services are identical. Although ISS has indicated that it is prepared to limit the specification of its registration to "hospital restaurant services", I agree with the conclusion reached by ISS is its skeleton argument i.e:

"9...As these are, however, a sub set of restaurant and catering services generally, this amendment would have no effect on, and need not be considered in the context of the section 5(2)(b) case."

**Comparison of trade marks**

18. The trade marks to be compared are:

ISS's trade mark	JEH's trade mark
	

19. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

## **Distinctive and dominant elements**

20. JEH's trade mark contains the hyphenated words "Just" and "Eat" presented with enlarged initial letters "J" and "E" and with the letters "ust" in "Just" and "at" in "Eat" presented in a cursive script. Above the bar of the letter "t" in the word "Eat" is the ® symbol and above the letters "us" appears a device element presented in a circle; JEH claims the orange and yellow letters as an element of its trade mark. The most dominant element of JEH's trade mark is, in my view, the words "Just-Eat". While there is no suggestion that the device (described by both parties as a "chef") present in JEH's trade mark is anything other than distinctive, given its size and positioning within the trade mark as a whole, it is in my view, a dominant, but not the most dominant element of JEH's trade mark. The ® symbol which appears above the letter "t" in the word "Eat" is de minimus and will not be accorded any trade mark significance by the average consumer.

21. ISS's trade mark consists of the words "just" and "EAT". The word "just" is presented in small lower case letters and is presented above the word "EAT" which is presented in much larger slightly irregular upper case letters; it contains no additional elements and no claim is made to colour. While the word "EAT" is presented in much larger letters than the word "just", as, in my view, the word "just" and "EAT" "hang" together, there is, in my view, no dominant element within ISS's trade mark.

22. In her skeleton argument Ms Fox said:

"6. This case is essentially about monopolies in descriptive words. At its heart lies the question, may a trader use the trade mark registration system to obtain exclusive rights in descriptive words, that it can use to block others from use of those words in any form by the simple, expedient of combining them with distinctive visual stylisation?"

7. The use of stylised descriptive words in product packaging and labelling is ubiquitous, and this case therefore has commercial implications extending far beyond the parties. It is no overstatement to say that should JEH prevail, the outcome could cast a chilling effect on freedom of commercial speech."

Ms Fox went on to say:

"17. The only common elements are the words JUST EAT...These words are, however, descriptive in relation to restaurant and catering services. The average English consumer will understand them as signalling what the purveyor wants him or her to do and indeed what the goods or services enable him or her to do: namely, to "just eat"..."

And:

"19...It is beyond argument that the words appearing in the parties' respective marks are either purely descriptive in relation to restaurant and catering

services (in the case of EAT) or non-distinctive within the overall context (JUST)...”

23. Ms Fox also drew my attention to, inter alia, the comments of the General Court (GC) in *José Alejandro SL v Office for Harmonisation in the Internal Market (Trade Marks and Designs), Anheuser-Busch Inc* Intervening (Case T-129/01) in which the GC said:

“53. Accordingly, the suffix MEN in the mark claimed is likely to carry a suggestive or even descriptive connotation for the relevant public that the clothing, footwear and headwear covered by that mark are intended for male customers. The Court notes that the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark”,

and to OHIM’s Fourth Board of Appeal (and subsequently to the GC’s comments) in *CheapFlights International Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* – (case T461/09) in relation to a range of services in classes 38, 39 and 41 to 44. Having considered the following competing trade marks the Board said, inter alia:



“25. It cannot be denied that these two signs feature similar elements. Notwithstanding this fact, the Board comes to the conclusion that likelihood of confusion is excluded due to the descriptive character of the similar elements in relation to the goods and services at hand...

39. A company is certainly free to choose a very weak, partially descriptive trade mark and use it in the market or proceed to its registration, always provided that the minimum threshold of distinctiveness is passed. However, by doing so, it also has to accept that competitors are equally entitled to use trade marks with similar or identical descriptive and weak components. The Court of Justice has consistently held that there may be public interest in not monopolizing certain signs, in particular to protect competitors or consumers with regard to signs lacking any distinctive character, or being exclusively descriptive of the goods and services (see judgments of the Court of Justice of 4 May 1999 in Joined Cases C-108/97 and C-109/97 ‘Chiemsee’ [1999] ECR I-2779; of 6 May 2003 in Case C-104/01 (‘Libertel Orange’) [2003] ECR I-3793). The respondent has to accept not being allowed to monopolize the use of the term ‘Cheapflights’ together with the depiction of a plane for services that it provides in the field of travel arrangements.”

24. Although this decision was annulled by the GC on appeal, at the hearing Ms Fox argued that was not because the GC disagreed with the Board’s view of the

descriptive nature of the words and devices in the competing trade marks, but because the Board did not apply their conclusions to the individual services with sufficient rigour; I am inclined to agree with Ms Fox's view in this respect.

25. For his part, Mr Malynicz argued that while he accepted that the words "Just-Eat" may be at the lower end of the distinctiveness spectrum, unlike Cheapflights and the device of an aeroplane in relation to the offering of cheap flights, they were not totally descriptive of JEH's services in class 43 and even less so for some of its goods in class 29 and 30. He further argued that the meaning of the words "Just-Eat" were ambiguous i.e. were they a call to action or did they mean only eat.

26. While it was not referred to by either party at the hearing, I note that in *Bignell v Just Employment Law Ltd* - [2008] FSR 6, Mr Robert Englehart QC sitting as a deputy judge concluded that the words "Just Employment" were descriptive of, inter alia, legal services relating to employment matters. The Trade Marks Registry's approach to trade marks containing the word "Just" has been drafted with this decision in mind and indicates that trade marks containing, inter alia, the word "Just" can mean, inter alia, we specialise in (Just Education) or to denote purity (JUST JUICE) or to mean all that is required (JUST PLUG IT IN). Equally the practice indicates that:

"...this practice will not be applied blindly, and trade marks containing words such as "just" and "simply" will be assessed in their totality."

27. The words "Just" and "Eat" are so well known as to require no further explanation. While I agree with Ms Fox that when considered in relation to restaurant and catering services the word "Eat" is descriptive and non-distinctive, when the word "Just" is placed in front of it, the meaning conveyed by the combination is, as Mr Malynicz submitted at the hearing, in my view, ambiguous i.e. is it a call to action or does it mean only eat. While this ambiguity is of course inconclusive, as the message sent by the words "Just Eat" would, when considered in the context of the services at issue require, in my view, a degree of "unpacking" by the average consumer, the combination is, I think, slightly unusual and has, as a consequence, a degree of inherent distinctive character, albeit I agree with Mr Malynicz, a low degree. Although prayed in aid by Ms Fox, OHIM's Opposition Division appears to have taken a similar view in proceedings between Just-Eat A/S and Martin Knoll (opposition decision no. B711301 dated 24 February 2006) in which it considered the similarities between the trade mark upon which JEH relies in these proceedings and the trade mark JUST BITE IT in relation to goods and services in classes 29, 30, 31 and 43. The Opposition division said:

"With regard to English speaking part of the relevant public it should be noted that the word content of both marks is not very distinctive and hence weak to some degree with respect to the goods and services covered by the marks. Therefore, the stylisation and figurative device of the CTMA must be regarded as having certain prominence for the purpose of comparison." (my emphasis)

28. However, even if the words "Just Eat" have a low distinctive character and are considered a weak element of JEH's trade marks, this does not mean that they cannot be a dominant element; as the GC stated in *NEC Display Solutions Europe*

*GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-501/08:*

“35 That conclusion cannot be called into question by the applicant’s assertion that the word ‘more’ has no distinctive character. It should be borne in mind, that weak distinctive character of an element of a compound mark does not necessarily imply that that element cannot constitute a dominant element where – owing, in particular, to its position in the sign or its size – it may make an impression on consumers and be remembered by them (Case T 153/03 *Inex v OHIM – Wiseman* (representation of a cowhide) [2006] ECR II 1677, paragraph 32, and Case T 7/04 *Shaker v OHIM – Limiñana y Botella* (*Limoncello della Costiera Amalfitana shaker*) [2008] ECR II 3085, paragraph 44).”

29. Having come to that conclusion, it follows that I consider the words “Just Eat” to be both a distinctive and dominant element of the competing trade marks. I will approach the visual, aural and conceptual comparison with that conclusion in mind.

### **The visual, aural and conceptual comparison**

30. In her skeleton argument and at the hearing, Ms Fox accepted that the competing trade marks were phonetically and conceptually identical (although she of course argued that this identity stemmed from words which were, in her view, entirely descriptive). Insofar as the degree of visual similarity between the competing trade marks was concerned, in her skeleton argument Ms Fox said:

“16....Visually, the black and white cartoonish font style of [ISS’s trade mark], with its stacked vertical presentation, contrasting font styles and sizes, visual exuberance and bold emphasis of the word EAT is poles apart from the vivid orange and yellow colouration and controlled, consistent cursive font and stylisation of the [JEH’s trade mark] whose prominent “chef” logo crowns the mark and confers a very distinct visual impression. There is no visual similarity in the overall visual impression conveyed by these marks.”

31. Insofar as the colours present in JEH’s trade mark are concerned, at the hearing Mr Malynicz drew my attention to the comments of Mann J *in Specsavers International Healthcare Ltd v Asda Stores Ltd* (No. 2) [2011] F.S.R. 1 and asked me, when comparing the competing trade marks, to imagine ISS’s trade mark presented in the same colours as JEH’s trade mark, an approach with which Ms Fox agreed. While I note that at the hearing Mr Malynicz characterised the degree of visual similarity between the competing trade marks as “modest”, in my view, the presence in both parties’ trade marks of the distinctive words “Just Eat” results in an above average degree of visual similarity. The average consumer will remember the words rather than their particular typography and will not, in normal circumstances, be in a position to compare the trade marks side by side.

### **Distinctive character of JEH’s earlier trade mark**

32. I must now assess the distinctive character of JEH’s earlier trade mark. The distinctive character of a trade mark must be appraised first, by reference to the

services in respect of which it has been registered and, secondly by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

33. As Mr Malynicz indicated at the hearing that he was not relying upon any enhanced distinctive character, I have only the inherent characteristics of JEH's trade mark to consider. I have already concluded that the words "Just-Eat" in JEH's trade mark enjoy a degree, albeit a low degree, of inherent distinctiveness. The presence in JEH's trade mark of a highly distinctive (but not dominant) device element combined with the colours in which the letters in the trade mark are presented, improves the overall inherent distinctiveness of JEH's trade mark, resulting in a trade mark which, in my view, is possessed of a relatively low (but not the lowest) degree of inherent distinctive character.

### **Likelihood of confusion**

34. In determining whether there is a likelihood of confusion, I need to bear a number of factors in mind. The first is the interdependency principle i.e. 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. It is also necessary for me to keep in mind the distinctive character of JEH's earlier trade mark (as the more distinctive this trade mark is, the greater the likelihood of confusion), the average consumer for the services, the nature of the purchasing process and the fact 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. Earlier in this decision I concluded that:

the average consumer of restaurant and catering services is the general public;

while the average consumer will select these services by predominantly visual means, given the nature of the services at issue, oral/aural considerations will also come into play;

the degree of care the average consumer will display when making their selection will be dependent on the cost and nature of the service being sought, and will, as a consequence, range from minimal to reasonably high;

the competing services are identical;

the words "Just-Eat" and the device are distinctive and dominant elements of JEH's trade mark;

the words “just EAT” are the distinctive and dominant element of ISS’s trade mark;

the competing trade marks are phonetically and conceptually identical and visually similar to an above average degree;

JEH’s earlier trade mark is possessed of a relatively low (but not the lowest degree) of inherent distinctive character.

35. In reaching a conclusion, I bear in mind the following comments of the CJEU in *L’Oréal SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (case C-235/05 P):

“42. It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.

43. It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

44. In the second place, as was pointed out at paragraphs 35 and 36 of this judgment, the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case.

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.”

36. Having found that the words “Just Eat” are a distinctive and dominant element of JEH’s trade mark (albeit I accept a weak distinctive element), and bearing in mind



the totality of the competing trade marks and the identity in the services, the conclusion that there will be a likelihood of confusion is, in my view, inescapable.

## **Conclusion**

37. As a consequence of my decision above, JEH's request to invalidate ISS's trade mark has succeeded under section 5(2)(b) of the Act, and under the provisions of 47(6) of the Act the registration shall be deemed never to have been made.

### **The objection based upon section 5(4)(a)**

38. Section 5(4)(a) of the Act reads:

"5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) ....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

39. The elements of passing-off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position and stated:

"The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

40. In his skeleton argument Mr Malynicz said:

“17. The section 5(4)(a) case can be dealt with relatively briefly as it does not add greatly to the 5(2)(b) case.”

41. In her skeleton argument and at the hearing, Ms Fox (and as a consequence Mr Malynicz) spent some time on this aspect of JEH’s case. For example, given that ISS had started using its trade mark in April 2007, I heard submissions on, inter alia, the correct approach to the material date (and what specifications I needed to consider as a result), the acceptability of the proposed limitation of ISS’s specification to “hospital restaurant services”, the case law relating to goodwill in “common and descriptive signs”, the nature and extent of the use of the signs relied upon by JEH, the nature of the services upon which JEH has used its signs and the absence of instances of confusion (the latter of which ISS accepted was not determinative).

42. However, as JEH’s ground based upon section 5(4)(a) of the Act cannot, in my view, put them in any better position than that upon which they have already succeeded under section 5(2)(b) of the Act, I see no reason to deal with this alternative ground and decline to do so.

### **Costs**

43. JEH has been successful and is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using the TPN mentioned as a guide, I award costs to JEH on the following basis:

Preparing a statement and considering ISS’s statement:	£300
Official fee:	£200
Preparing evidence and considering and commenting on ISS’s evidence:	£750
Preparation for and attendance at a Case Management Conference held on 4 October 2011:	£200
Preparing for and attending the substantive hearing:	£750
<b>Total</b>	<b>£2200</b>

44. I order ISS Mediclean Limited to pay to Just Eat Host A/S the sum of **£2200**. 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 8th day of October 2012**

**C J BOWEN  
For the Registrar  
The Comptroller-General**