

O-429-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3036791 BY
AD-HOC WINE BARS LIMITED
TO REGISTER THE TRADE MARK:**



AD-HOC

IN CLASS 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000097 BY
DE GUSTIBUS SRL**

BACKGROUND

1. On 4 January 2014, Ad-Hoc Wine Bars Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 17 January 2014, for the following services in class 43:

Services for providing food and drink; restaurant, wine bar, café, public house and catering services; booking and reservation services for restaurants; nightclub services for the provision of food and drink; advice, information and consultancy services for all the aforesaid services.

2. The application is opposed by De Gustibus Srl (“the opponent”) under the fast track opposition procedure. The opposition, which is directed against all of the services in the application, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for which the opponent relies upon the services shown below in the following Community Trade Mark (“CTM”) registration:

No. 12031861 for the trade mark:



“Mark Description - The trademark consists of a black square with a grey border. Inside the square there are the words "AD HOC" on two lines with the letter "H" in grey. Underneath the word "HOC" there is a line, underneath which there is the text "IL TARTUFO" in grey. At the top, above the word "AD", in the centre of the square, there is a circle with jagged edges. Inside there are the letters "AH" in fanciful characters. The text and the circle are in white, other than that which has been described as being grey.

Colours Claimed/Indication Black, grey, white.”

The trade mark was applied for on 1 August 2013 and was entered in the register on 3 December 2013; it is registered in respect of, inter alia:

Class 43 - Services for providing food and drink; Temporary accommodation; Accommodation bureaux [hotels, boarding houses]; Day-nurseries [crèches]; Cafés; Cafeterias; Retirement homes; Tourist homes; Providing campground facilities; Rental of temporary accommodation; Canteens; Rental of lighting apparatus other than for theatrical sets or television studios; Rental of cooking apparatus; Rental of transportable buildings; Rental of drinking water

dispensers; Rental of meeting rooms; Rental of chairs, tables, table linen, glassware; Rental of tents; Boarding for animals; Boarding houses; Hotel reservations; Temporary accommodation reservations; Boarding house bookings; Restaurants; Self-service restaurants; Hotels; Bar services; Holiday camp services [lodging]; Food and drink catering; Motels; Snack-bars.

3. In its Notice of Opposition, the opponent states:

“2. The sign in the applicant’s mark is wholly contained in the opponent’s mark. The word ADHOC is the distinctive and dominant elements of both marks therefore, the marks are visually and phonetically similar. The word ADHOC contains no certain meaning in respect of either mark, thus, the comparison of the marks is conducted from a visual and phonetic viewpoint only.”

4. The applicant filed a counter statement in which the basis of the opposition is denied. It states:

“1. The applicant is a UK company incorporated in February 2012 which carries on business as a wine bar and restaurant.

2...The opponent is a business specialising in all things related to truffles, the delicacy particularly popular in Italy (known as Il Tartufo).

3...the applicant asserts its honest concurrent use of the trade mark since February 2012 pursuant to section 7 of the 1994 Act. As stated above, the applicant was incorporated in February 2012 and has been trading as AD HOC under the applicant’s mark since August 2012. In that time, there has been no confusion between the marks so far as the applicant is aware and the applicant was wholly unaware of the opponent’s mark and has not taken advantage of that mark or any reputation it may have. The applicant relies on the decision of the CJEU in Budsjovicky Budvar [C-482-09] Sept. 22 2011.

4. It is admitted that the applicant’s mark is partially similar to the opponent’s mark. However, upon comparison of the marks, the level of similarity is so low and it is denied that such similarity would cause a likelihood of confusion.”

Having referred to the description of the opponent’s trade mark reproduced above, the applicant states:

“The colours claimed/indication are black, grey and white. As such, this is a highly stylised figurative mark which is particularly distinctive and quite different from the applicant’s mark.”

Having commented upon the similarity in the competing services (to which I will return later), the applicant states:

“6. Further, it is denied that there exists a likelihood of confusion on the part of the public. Specifically:

- a) The bar and restaurant sector is a crowded market place in which a number of businesses and proprietors own and operate with brands which incorporate the words AD HOC. As such, the opponent's mark so far as it relates to the words AD HOC has a low degree of inherent distinctive character, which leads to a reduced likelihood of confusion. The average consumer is used to differentiating between distinct undertakings using the words AD HOC, particularly in a scenario where they are highly stylised and related to the use of truffles.
- b) The opponent's mark uses the words AD HOC in conjunction with the words IL TARTUFO, such that factually the distinctive character of the opponent's mark is low so far as it relates solely to AD HOC, leading to a reduced likelihood of confusion. As everything to do with the opponent's business relates to truffles, which is clearly evidenced by the wording on the mark, the public are simply not going to be confused by the two marks.
- c) In general, the goods and services for which the applicant's mark is to be registered and used relate simply to bar/restaurant services and related services. This is very different from the many classes of goods and related products provided under the opponent's mark for its business relating to truffles.
- d) There is a low level of similarity between the marks. The applicant's mark is a figurative mark with a sufficient degree of stylisation of the word AD HOC to visually differentiate it from the opponent's mark which is comprised of a number of other words or types of stylised indication. This ensures that the overall impression given by the applicants mark is different to that of the opponent when viewed by the public. This is particularly true when the opponent's mark is being used for various food/truffle related purposes in Italy whilst the applicant's mark is being used for small bar/restaurants in the UK."

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if: (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken. In an official letter dated 3 July 2014, the parties were allowed until 17 July 2014 to seek leave to file evidence and/or to request a hearing. In a letter dated 17 July 2014, the applicant stated:

"Please accept this letter as a request pursuant to rule 62(5) that this matter be listed for oral hearing. The applicant submits that it is both just and

equitable for an oral hearing given that this matter is of utmost importance to its business.

An oral hearing is:

1. necessary in order that the full use and context of the respective marks can be considered by the registrar by way of oral representation; and
2. proportionate to the cost of both parties and the commercial value of the matter at stake, given that whilst it will not significantly increase the costs of the matter which must be contrasted against the detrimental effect on the applicant's business should it not obtain registration of its highly stylised mark given the goodwill that has been acquired over the last two years through use of that mark.

In addition, the applicant seeks leave to file evidence to show that in two years of trading there has been no confusion experienced between the two marks and there remains no likelihood of confusion in the future given the entirely different businesses operated by the applicant and the opponent."

7. In an official letter dated 11 August 2014, the Tribunal responded to these requests in the following terms:

"The Hearing Officer has considered the requests outlined in your letter dated 17 July 2014.

The Hearing Officer does not believe that reliance on the absence of confusion in the marketplace will assist your case for the reasons provided in TPN 4/2009, which states:

"6. Parties are also reminded that claims as to a lack of confusion in the market place will seldom have an effect on the outcome of a case under section 5(2) of the Act.

7. In *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J held:

'22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s.10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of

the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.'

8. (In *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch) Warren J commented:

'99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says...')

9. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett LJ stated:

'Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.'

With regard to a request for an oral hearing, the Hearing Officer does not think it would be necessary. An opportunity will be given to file submissions in lieu of a hearing."

8. The parties were allowed until 25 August 2014 to request a hearing to challenge the preliminary view and until 8 September 2014 to file written submissions; no challenge to the preliminary view was received. Both parties filed written submissions, which I will bear in mind, and, if necessary, refer to below.

DECISION

9. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

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

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

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

10. 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.”

11. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. Given the interplay between the date on which the application was published and the date on which the opponent’s earlier trade mark was entered in the register, the earlier trade mark is not subject to proof of use, as per section 6A of the Act.

Section 5(2)(b) – case law

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

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of services

13. The competing services are as follows:

Opponent's services in class 43	Applicant's services
Services for providing food and drink; Temporary accommodation; Accommodation bureaux [hotels, boarding houses]; Day-nurseries [crèches]; Cafés; Cafeterias; Retirement homes; Tourist homes; Providing campground facilities; Rental of temporary accommodation; Canteens; Rental of lighting apparatus other than for theatrical sets or television studios; Rental of cooking apparatus; Rental of transportable buildings; Rental of drinking water dispensers; Rental of meeting rooms; Rental of chairs, tables, table linen, glassware; Rental of tents; Boarding for animals; Boarding houses; Hotel reservations; Temporary accommodation reservations; Boarding house bookings; Restaurants; Self-service restaurants; Hotels; Bar services; Holiday camp services [lodging]; Food and drink catering; Motels; Snack-bars.	Services for providing food and drink; restaurant, wine bar, café, public house and catering services; booking and reservation services for restaurants; nightclub services for the provision of food and drink; advice, information and consultancy services for all the aforesaid services.

14. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)*

[1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market.
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J stated:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, in which the General Court (GC) stated:

"29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03

Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

In relation to complementary goods and services, the comments of the Court of First Instance (now the GC) in *Boston Scientific Ltd v OHIM* case T-325/06 are relevant:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander Q.C., sitting as the Appointed Person, in case BL O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

Finally, the comments of Jacob J in *Avnet Incorporated v Isoact Limited* - [1998] FSR 16 are relevant i.e:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

15. In its counterstatement, the applicant states:

“5. It is denied that all of the goods and services of the application are identical with or similar to the opponent’s mark. **It is admitted that services providing food and drink, restaurant, wine bar, café, public house and catering services are nearly identical to the opponent’s mark.** It is not admitted that the booking and reservation services for restaurants are highly similar nor are the nightclub services for the provision of food and drink. The advice information consultancy services for all the aforesaid services are not similar...” (my emphasis).

16. As both parties' specifications include the phrase "services for providing food and drink", these services are clearly identical. In addition, as (at least) this phrase in the opponent's specification would include the "restaurant, wine bar, café, public house and catering services" included in the application, the services are, on the principles outlined in *Meric*, identical (rather than "nearly identical") as the applicant admits.

17. Insofar as the services in the application which remain are concerned, the opponent argues that:

"Booking and reservation services for restaurants" (in the application),

are highly similar to:

"Hotel reservations; temporary accommodation reservations; boarding house bookings; restaurants; self service restaurants" (in its earlier trade mark),

that:

"Nightclub services for the provision of food and drink" (in the application)

are highly similar to:

"Services for providing food and drink; cafés; cafeterias; canteens; restaurants; self-service restaurants; bar services; food and drink catering; snack-bars" (in its earlier trade mark),

and that:

"Advice, information and consultancy services for all the aforesaid services" (in the application),

are highly similar to the services to which they relate and which are contained in the specification of its earlier trade mark. In its submissions, the opponent states:

"49. As all of the above services are highly similar with regard to their nature – services allowing the public to make reservations/services for providing food and drink to the public, they are all used by the public at large via the same methods – online/telephone bookings/the provision of food and drink services in a public place such as a nightclub, bar, restaurant and the services are complementary – reservation services can be for booking seats at a restaurant, a room at a hotel and the provision of food and drink can be in respect of a nightclub, a restaurant, a café etc. In addition to this, it is submitted that the services at issue are ancillary services, closely allied, since they are provided by the same type of entity. For example, it is both conceivable and reasonable to assume that an entity providing services relating to food and drink will also provide booking services for restaurants and, an entity, providing food and drink services for nightclubs may also provide food and drink services for bars and cafés..."

Booking and reservation services for restaurants

18. Contacting a restaurant either by telephone or on-line to book a table does not, in my view, constitute a booking/reservation service. Such a service is, in my experience, more likely to be provided by a third party, with the average consumer contacting the provider of that service to make a booking which will be taken on the restaurant's behalf. However, the average consumer will, in my view, see some similarity in intended purpose between "restaurants" in the opponent's specification and the applicant's "booking and reservation services for restaurants", as the services ultimately combine to result in the average consumer dining in a restaurant. Although the methods of use of the services differ and there is no element of competition, there is, in my view, a degree of complementarity, leading to a moderate degree of similarity between "restaurants" and "booking and reservation services for restaurants". That said, there is, in my view, a high degree of similarity between the applicant's "booking and reservation services for restaurants" and, for example, the opponent's "hotel reservations", as the average consumer is likely, in my experience, to expect a provider of hotel reservation services to also provide the option to book a restaurant.

Nightclub services for the provision of food and drink

19. Nightclub services are, of course, proper to class 41. Insofar as the above services are concerned, they simply relate to the provision of food and drink in a nightclub. As such services would be included in the phrase "Services for providing food and drink" in the opponent's specification the competing services are, as a consequence, identical on the principle outlined in *Meric*.

Advice, information and consultancy services for all the aforesaid services

20. All undertakings provide advice, information etc. on the services they provide. The use of the words "for all the aforesaid services" indicates that the above services are inextricably linked to the services to which they relate. Applied to the matter at hand, these services are either identical or similar to the same degree as the services in the opponent's specification to which they relate.



The average consumer and the nature of the purchasing process

21. 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. The average consumer of the services at issue is a member of the general public. As such services are most likely to be selected following a visual inspection of, for example, signage on the high street or from the pages of a magazine or website, visual considerations are likely to feature large in the selection process. That said, as, for example, restaurants, hotels etc, are often the subject of oral recommendations, I must also keep aural considerations in mind. The degree of care taken when selecting such services is likely to vary considerably. For example, whilst the average consumer is, in my experience, likely to pay a relatively low degree of attention to the selection of a café for an impromptu cup of tea, they are likely to pay a somewhat higher degree of attention to, for example, the selection of a

booking portal, and an even higher degree of attention to the selection of, for example, a restaurant for a special occasion or a hotel to host a wedding.

Comparison of trade marks

22. The competing trade marks are as follows:

Opponent's trade mark	Applicant's trade mark
	

23. It is well established that 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 elements 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.

24. The applicant's trade mark consists of the letter "A" and letters "HOC" presented in upper case in a very slightly stylised but unremarkable typeface. In between the letters "A" and "H" is an upper case letter "D" in the same typeface as the other letters and presented at an angle. Attached to the letter "D" is a stem, the combination of which is, in my view, reminiscent of a device of a wine glass; within the bottom left portion of the bowl of the letter "D" (device of a wine glass) is a small circular device which, in my view, is likely to be construed as either an olive or cherry. Although the applicant's trade mark consists of a number of elements, none of these elements dominates the mark or changes the overall impression created which, in my view, is of the words AD HOC.

25. The opponent's trade mark also consists of a number of elements. The first is the lower case letters "a" and "h" presented in white and elided in what is described in the mark description as "a circle with jagged edges" (also presented in white). The second element is the letters "ad" presented in lower case, below which appears the letters "hoc" also presented in lower case. The letters "ad" and "oc" are presented in the same size font in white; the letter "h" is in the same font and is presented in grey. The third element is an underlining which is likely to go unnoticed. The fourth element is the words "IL TARTUFO" presented in upper case in grey. The fifth and final element is a black square with a grey border, which acts as a background for the other elements. Although the opponent claims the colours black, grey and white, I note that in *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 at [96] Kitchin LJ stated:

“A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours.”

As the applicant’s trade mark is unlimited as to colour, this means that if the application achieves registration, the applicant may use its trade mark in the same combinations of colours as the opponent. As a consequence, the fact that the opponent claims colours as an element of its mark is not a point that assists the applicant.

26. Although the opponent’s trade mark consists of a number of elements, the overall impression created is, given the size and positioning of the words in relation to the other elements in the trade mark, like the applicant’s trade mark, of the words *ad hoc*. In reaching this conclusion, I am mindful that the trade mark also contains the letters “ah” appearing in white in a white circular device at the top centre of the trade mark and the words *IL TARTUFO* appearing in grey below the words *ad hoc*. The letters “ah” are significantly smaller than the words *ad hoc*, and although distinctive in their own right would, in my view, be construed as echoing the first two letters of the words *ad hoc*. As to the words *IL TARTUFO*, once again these words are much smaller than the words *ad hoc*, and for anyone other than an average consumer familiar with the Italian language (for whom the words are likely to mean “the truffle”), they are unlikely to convey any concrete meaning (beyond perhaps being words in a foreign language, possibly Italian). However, even for those familiar with the Italian language and the meaning of these words, their presence in the opponent’s trade mark does not, in my view, change the overall impression the trade mark creates. I will bear these conclusions in mind when approaching the visual, aural and conceptual comparison.

27. As the overall impression created by both trade marks focuses on the presence in each of the words *ad-hoc*, the competing trade marks are, notwithstanding the other elements of which they are made up, visually similar to a reasonable degree. Insofar as the degree of aural similarity between the trade marks is concerned, it is well established that when a trade mark consists of a combination of words and figurative elements, it is by the word elements that the average consumer is most likely to refer to the trade mark. I have no doubt that the average consumer will refer to the applicant’s trade mark as *ad hoc*. As to the opponent’s trade mark, I very much doubt that the average consumer will refer to it as “ah *ad hoc* *IL TARTUFO*.” Much more likely, in my view, is that it will be referred to as either “*ad hoc*” or “*ad hoc* *IL TARTUFO*”. In the former situation the marks would be aurally identical and in the latter, as the “*ad hoc*” element would be articulated first, aurally similar to a fairly high degree. Finally, in relation to the conceptual comparison, the words *ad hoc* are, in my view, likely to be fairly well known to the average consumer as meaning (as per collinsdictionary.com) “for a particular purpose only; lacking generality or justification.” As both trade marks convey this overall impression, and as nothing in either trade mark changes this overall impression, the competing trade marks are, in my view, conceptually identical. However, if the average consumer is unfamiliar with the words *ad hoc*, then the conceptual position is likely to be neutral i.e. when considered as totalities, neither trade mark is likely to convey any concrete conceptual image.

Distinctive character of the opponent's earlier trade mark

28. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought 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.

29. As these are fast track opposition proceedings to be determined absent evidence, I have only the inherent characteristics of the opponent's trade mark to consider. Having identified the definition of the words ad hoc above, in my view, it neither describes nor is it non-distinctive for the services for which the opponent's trade mark is registered. However, as it is a fairly well known term with which the average consumer is likely to be familiar, but keeping in mind the other elements in the trade mark, the opponent's trade mark is, in my view, possessed of a normal degree of inherent distinctive character.

Likelihood of confusion

30. In determining whether there is a likelihood of confusion, a number of factors need to be borne 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. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind 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 competing services are either identical or similar to a high degree;
- the average consumer is a member of the general public who, whilst selecting the services by predominantly visual means, is also likely, albeit to a lesser extent, to rely upon oral recommendations in relation to some of the services at issue;
- the degree of attention paid to the selection of the services will range from relatively low to fairly high depending on the service being selected;
- the overall impressions created by both trade marks focuses on the words ad hoc;

- the competing trade marks are visually similar to a reasonable degree and if not aurally identical, at least aurally similar to a fairly high degree;
- the competing trade marks are either conceptually identical or, if the average consumer is unfamiliar with the words ad hoc, conceptually neutral;
- the opponent's trade mark is possessed of a normal degree of inherent distinctive character.

31. In its counterstatement, the applicant admits that the “applicant’s mark is partially similar to the opponent’s mark”, but argues that the level of similarity is so low there will be no likelihood of confusion. It provides further comments in this regard in its written submissions, submissions which I note have been filed in the form of a witness statement from the applicant’s professional representative, Philip Herbert, a solicitor and partner in the firm of Hamblins LLP. In paragraph 7 above, I noted that the applicant had sought, and been refused, leave to file evidence in these proceedings. To the extent that the statement includes evidence (including an exhibit consisting of 19 pages) I have not taken it into account. I have adopted a similar approach in relation to exhibit 4 attached to the opponent’s written submissions.

32. Whilst in its counterstatement and submissions, the applicant refers to the use that the parties have made of their respective trade marks, as the opponent points out in its submissions, that is irrelevant. Rather, what I must do for the purposes of these proceedings is to compare the applicant’s trade mark and specification as applied for with the opponent’s trade mark and specification as registered. Also in its counterstatement and submissions, the applicant refers to its use of its trade mark since August 2012 and the fact there have been no instances of confusion. The absence of confusion is a bad point and was comprehensively dealt with in the official letter of 11 August 2014. In addition, as no evidence has been admitted into these proceedings, any use the applicant may have made of its trade mark is irrelevant. However, even if the applicant had been granted leave to file evidence of the use it has made of its trade mark, as the opponent’s trade mark is not subject to proof of use, it was not necessary for the opponent to provide evidence; as a consequence, any evidence filed by the applicant would have been of no assistance to it in any case. Had the applicant wished to assert the rights it considers it has, it ought to have proceeded as indicated in TPN 4/2009 i.e:

“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or

invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

33. As to the applicant's claim that other businesses operate in the same sector with brands which incorporate the words AD HOC (and claims as a consequence the words ad hoc have a lower degree of distinctive character), as no evidence has been filed in support of such a claim (and as the opponent disputes such a claim in its written submissions) once again it does not assist the applicant.

34. Given, the identity/high degree of similarity in the competing services, the nature of the average consumer and selection process, the degree of visual, aural and conceptual similarity in the competing trade marks I have identified above, the degree of inherent distinctive character the opponent's trade mark possesses and as none of the applicant's additional arguments assist it, I have no hesitation concluding that there will be a likelihood of confusion. Even if the differences in the competing trade marks are considered sufficient to avoid direct confusion i.e. where one trade mark is mistaken for the other, there will, in my view, be at least indirect confusion i.e. where the average consumer assumes the services of the applicant are provided by an undertaking economically linked to the opponent.

Conclusion

35. The opposition based upon section 5(2)(b) of the Act to all of the services in the application succeeds in full and, subject to any successful appeal, the application will be refused.

Costs

36. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of TPN 4/2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£200
Opposition fee:	£100
Written submissions:	£200
Total:	£500

37. I order Ad-Hoc Wine Bars Limited to pay to De Gustibus Srl the sum of **£500**. 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 7th day of October 2014

C J BOWEN
For the Registrar
The Comptroller-General