

O-237-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3000674
BY
BILAL HUSSAIN**

TO REGISTER THE TRADE MARK

PAPA TONY'S

IN CLASS 43

AND

**THE OPPOSITION THERETO
UNDER NO 400767
BY
SOTERIS PAPACAOULLAS**

BACKGROUND

1. On 5 April 2013, Bilal Hussain (the applicant) applied to register the trade mark **PAPA TONY'S** in class 43 of the Nice Classification system.¹ The specification stands as follows:

Class 43

Services for providing food and drink; catering services; restaurant, bistro, brasserie, delicatessen, cafe, ice cream parlour, tea shop and coffee bar services; bar and wine bar services; takeaway restaurant services; preparation of meals, foodstuffs and beverages; preparation of meals, foodstuffs and beverages for consumption off the premises; take away food services; take away beverage services; provision of facilities for the consumption of food and beverages; business catering services; mobile catering services; services for the organisation of the catering at functions; advice and assistance relating to food and drink and the preparation thereof; information, advisory and consultancy services relating to all of the aforementioned services.

2. The application was published on 31 May 2013, following which Soteris Papacaoullas, (the opponent) filed notice of opposition against the application.

3. The opposition was brought under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon UK trade mark 2526274 for the services shown below:

Mark details and relevant dates	Services relied on
<p>Series mark:</p> <p>Papas Papa's</p> <p>Filing date: 17 September 2009</p> <p>Date of entry in the Register: 8 January 2010</p>	<p>Class 43 Restaurant services and takeaway services specialising in fish and chips.</p>

4. The opponent states:

"The mark is identical with our earlier mark for identical goods or services as our earlier mark. The mark consists of 'Papa' our mark is 'Papa's'. The addition of 'TONY'S' is not differential enough, and merely looks as though the mark is a division of the earlier mark."

5. On 25 November 2013 the applicant filed a counterstatement, denying the grounds of opposition.

6. Neither the opponent nor the applicant filed evidence or submissions in the period allowed for the filing of evidence. Neither side filed written submissions in lieu of attendance at a hearing nor did they request a hearing.

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

7. I give this decision following a review of all of the material before me.

DECISION

Section 5(1) and 5(2)(a)

8. In order to succeed under either of these sections the opponent must be relying on a mark which is identical to that applied for. Since, at the very least, the application includes the additional second word 'TONY's', which is not present in the opponent's series of marks, these are clearly not identical marks and the opposition under these sections must fail on that basis.

9. The remaining ground of opposition is section 5(2)(b) which reads as follows:

"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, 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. The opponent's mark is an earlier mark which had not been registered for five years at the date of publication of the application. Consequently, the proof of use requirements set out in section 6A of the Act, do not apply.² Accordingly in these proceedings, the opponent is entitled to rely on its earlier mark for the full specification as registered.

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*,

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

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.

The average consumer

13. In accordance with the above cited case law, I must determine who the average consumer is for the services at issue and also identify the manner in which those services will be selected in the course of trade.

14. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited* [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

15. Services for the provision of food and drink, be they cafés, takeaway restaurants or any other types of establishment listed in the parties’ specifications, are normal everyday services provided to members of the general public. In the case of catering services, they may be purchased by a member of the general public for a special occasion and will also be commissioned by businesses providing catering on a regular basis, or as part of a particular event or function. A member of the public is likely to pay no more than an average level of attention to the purchase, whereas a business commissioning the services is likely to pay an above average level of attention to what is not a casual purchase. They may need to consider, inter alia, the nature of the event, cost and venue. In both cases the purchase is likely to be primarily visual, being made from advertising leaflets, flyers and websites and in the case of a member of the general public, possibly at the point of sale. However, I do not rule out the potential for oral use of the mark where word of mouth recommendation plays a part.

Comparison of goods and services

16. The goods and services to be compared are as follows:

The opponent’s services	The applicant’s services
Class 43 Restaurant services and takeaway services specialising in fish and chips.	Class 43 Services for providing food and drink; catering services; restaurant, bistro, brasserie, delicatessen, cafe, ice cream parlour, tea shop and coffee bar services; bar and wine bar services; takeaway restaurant services; preparation of meals, foodstuffs and beverages; preparation of meals, foodstuffs and beverages for consumption off the premises; take away food services; take away beverage services; provision of facilities for the consumption of food and beverages; business catering

	<p>services; mobile catering services; services for the organisation of the catering at functions; advice and assistance relating to food and drink and the preparation thereof; information, advisory and consultancy services relating to all of the aforementioned services.</p>
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17. In comparing the services, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05, which, whilst it deals with goods specifically, is analogous to a comparison of services:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

18. At paragraph 15 of its counter-statement, the applicant concedes:

“The term ‘services for providing food and drink’ is however, considered to be identical to the Opponent’s services”.

19. In addition, the applicant’s ‘takeaway restaurant services’ are also identical to the opponent’s ‘takeaway services’. These two terms in the applicant’s specification are the high point of similarity, with the remaining services being similar to varying degrees. For reasons which will become apparent later in the decision, I will not continue that assessment here.

Comparison of marks

20. It is clear from *Sabel BV v. Puma AG* (particularly at paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

22. The marks to be compared are:

The opponent's mark(s)	The applicant's mark
Papas Papa's	PAPA TONY'S

23. In its counter-statement, the applicant states:

"The Applicant admits the existence of [the opponent's] trade mark, but denies and challenges its relevance and validity, particularly as the marks PAPAS and PAPA'S do not appear to be a valid series, given that they have different identities – PAPAS relates to more than one papa and PAPA'S relates to something belonging to one papa."

24. I am aware that it is not uncommon to encounter words where a necessary apostrophe has been omitted. However, in this case, given the apostrophe in the latter mark which is not present in the former, I intend to make separate assessments of each mark.

25. With regard to the overall impression of the marks the applicant states:

"9... The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The memorable part of the Applicant's Mark is TONY or TONY'S, and may be referred to by customers as TONY'S or PAPA TONY'S. It is inconceivable that customers will refer to the Applicant's Mark as PAPA or PAPA'S."

10. Marks must normally be assessed by relevance [sic] to the overall impressions created by them, bearing in mind their distinctive and dominant components. The term TONY'S is not negligible in the overall impression as it is the main dominant and distinctive term of the Applicant's Mark."

26. The opponent's marks are both presented in title case with no stylisation. The first is 'Papas', the second, 'Papa's'. The overall impression of both marks is based solely on each of those words.

27. The applicant's mark consists of two words 'PAPA' and 'TONY'S' in block capitals with no form of stylisation. Neither part of the mark is emphasized, the words hanging together to indicate the identity of a single individual. Consequently, the overall impression of the mark is based on its totality.

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Visual similarities

28. Any similarity between these marks rests in the fact that they both begin with the four letters PAPA. The differences are that the opponent's mark has an additional letter 'S' at the end while the applicant's is followed by the word 'TONY'S', resulting in marks which

are clearly of different lengths and different numbers of words. Overall these marks are visually similar to a low degree.

Aural similarities

29. Aurally the opponent's mark may be pronounced as in the plural of 'Papa' i.e. ending with a 'z' sound or in a way that rhymes with 'tapas', i.e. ending with an 's' sound though both are so similar as to be virtually identical in practice

30. The applicant's mark consists of words known to the average consumer and will be pronounced as it appears, 'PAPA TONY'S'.

31. Any similarity rests in the repeated 'PA-PA' sound at the start of both marks, though the differences are such that overall these marks are aurally similar to a low degree.

Conceptual similarities

32. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.³ The assessment must be made from the point of view of the average consumer who cannot be assumed to know the meaning of everything.⁴

33. The opponent's earlier mark has two possible meanings. If, as the applicant suggests, it is given a meaning it will be that of a number of fathers, papas. In my view 'Papas' will likely be seen as an invented word by the average consumer.

34. The applicant's mark has a clear meaning being the identity of a single individual called Tony who is either a 'papa' or has been given that name, perhaps as a nickname.

35. If the opponent's mark is seen, as I believe it will be, as an invented word, the competing marks are conceptually distinct as the applicant's clearly has a meaning. If the opponent's mark is seen as the plural of 'papa', there is still a difference in so far as the opponent's mark refers to a number of individuals who are not identified and the applicant's refers to a particular person named Tony. In this case I would put the level of conceptual similarity at a fairly low level.

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36. Visually my findings are the same as those above in relation to the other mark in the series. The marks are visually similar to a low degree, coinciding in the first four letters.

37. Aurally, the opponent's mark 'Papa's' will, with the addition of the apostrophe, be seen as the common English word 'Papa' used in its possessive form. However, as I commented in paragraphs 29-32 above, the only similarity exists in the repeated PA-PA sound at the start of the marks, resulting in a low degree of aural similarity between these marks.

³ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

⁴ See the comments of Anna Carboni, sitting as the Appointed Person in *Cherokee*, BL O-048-08, paragraphs 36 and 37.

8. Conceptually, the opponent's mark has an obvious meaning which is that the services or undertaking from which they are provided belong to either a papa/father, or an individual called Papa.

39. The applicant's mark, as I have found above, refers to services or undertakings provided by an individual called Papa Tony. Consequently, the conceptual similarity in this case is at a medium level. Both refer to possession of something by an individual, though the identity of those individuals is different.

Distinctive character of the earlier mark

40. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

41. The opponent's mark is the two words, 'Papas' and 'Papa's'. Neither is stylised in any way. The first will be seen by the average consumer as an invented word and therefore, cannot be said to be descriptive or allusive of the services at issue. It enjoys a high level of inherent distinctive character. The second is the common word 'Papa's' which is the known word 'Papa' with the addition of a possessive apostrophe and 's'. It will be seen as something belonging to a Papa or someone named Papa. Consequently, it does not describe the opponent's services but could be suggestive of the identity of the provider of those services. In my view, it enjoys an average degree of inherent distinctive character.

Likelihood of confusion

42. Included in the applicant's counter-statement is reference to 65 other marks on the registers of the UK and OHIM “*that currently comprise the term PAPA in class 43.*”

43. It has long been established that state of the register evidence of this type does not assist the applicant. It does not indicate whether the marks are being used, or give any

indication of the goods on which there is use, or what agreements may be in place between the parties. It is not, therefore, an indicator of whether or not there will be confusion in the market place in relation to the respective trade marks.⁵ I shall give it no further consideration.

44. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁶ I must also keep in mind the average consumer for the services, the nature of the purchasing process and have regard to 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.

45. The high point of the opponent's case is the second mark in its series 'Papa's' which, like the applicant's mark, has a possessive element and will be clearly understood by the average consumer. The services are identical to the applicant's⁷. The earlier mark has a medium degree of inherent distinctive character. Taking the opponent's best case, in my experience (and in the absence of evidence from either party to these proceedings) the average consumer of these types of services is familiar with undertakings of this type operating under a person's name and is used to making distinctions between such undertakings on that basis. Given the clear differences between these marks, which I have outlined above and even when used in respect of identical services which will be bought with no more than an average degree of care, I consider there will not be a likelihood of confusion. **The opposition fails under section 5(2)(b) of the Act.**

COSTS

46. The opposition having failed, the applicant is entitled to a contribution towards its costs. In its counter-statement the applicant says:

"A Form TM7a was filed but the name of the opponent was clearly stated as the Applicant. The Applicant had therefore no details to assess the merits of the opposition and no identity of the Opponent to consider withdrawing its application. The Applicant feels that a negative cost award should be awarded against the Opponent for not providing sufficient warning to consider withdrawing its application, and for not providing their identity, irrespective of the opposition decision".

47. Having checked the form it is clear that a contact address for the prospective opponent's address for service was provided on the TM7a and it was sent to the applicant under cover of a letter from the Registry, which included its own contact details. It would have been a simple matter to contact either address/contact number to ascertain the identity of the opponent. Whilst this is not ideal, it did not, in my view, result in undue prejudice to the applicant of the kind that would necessitate an increased cost award nor put it to any extra work. I make the award on the following basis:

⁵ see *Jacob J in British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 and the General Court in *Zero Industry Srl v Office of Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)*, Case T-400/06 and *GfK AG v Office of Harmonisation in the Internal Market (trade Marks and Designs)(OHIM)*, Case T-135/04

⁶*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

⁷ *There are others services included in the applicant's specification but given my findings in respect of identical services, I need give these no further considerations.*

Preparing a statement and considering the other side's statement: £400

Total: £400

48. I order Soteris Papacaoullas to pay Bilal Hussain the sum of £400. 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 22ND day of May 2015

**Ms Al Skilton
For the Registrar,
The Comptroller-General**