

O-309-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3044027
BY POPDOGS HOTDOGS LTD
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 29, 30 & 43:**




AND

OPPOSITION THERETO (No 402505) BY TOP DOG EATS LTD

Background and pleadings

1. The above trade mark was filed by Popdogs Hotdogs Ltd (“the applicant”) on 27 March 2014. It was published for opposition purposes on 11 April 2014. Registration of the mark is opposed by Top Dog Eats Ltd (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on Community trade mark registration 11837101, which was filed on 22 May 2013 and registered on 30 November 2013. In view of all this, this case boils down to an alleged conflict between the following marks and goods/services:

Applied for mark	Earlier mark
 <p>Class 29: Frankfurters; French fries; Hotdog sausages; Vegetarian sausages; Chili con carne.</p> <p>Class 30: Hot dogs (prepared);Buns.</p> <p>Class 43: Catering for the provision of food and beverages; Fast food restaurant services.</p>	<p>TOP DOG</p> <p>Class 43: Services for providing food and drink; Temporary accommodation; Accommodation bureaux [hotels, boarding houses]; Bar services; Boarding for animals; Boarding house bookings; Boarding houses; Cafés; Cafeterias; Canteens; Day-nurseries [crèches]; Food and drink catering; Holiday camp services [lodging]; Hotel reservations; Hotels; Motels; Providing campground facilities; Rental of chairs, tables, table linen, glassware; Rental of cooking apparatus; Rental of drinking water dispensers; Rental of lighting apparatus other than for theatrical sets or television studios; Rental of meeting rooms; Rental of temporary accommodation; Rental of tents; Rental of transportable buildings; Restaurants; Retirement homes; Self-service restaurants; Snack-bars; Temporary accommodation reservations; Tourist homes.</p>

2. Given its date of filing, the opponent’s mark qualifies as an earlier mark in accordance with section 6 of the Act. Furthermore, given the date on which it was registered, the proof of use provisions contained in section 6A of the Act do not apply. The earlier mark may, consequently, be taken into account for all of its services. The opponent claims that the marks are visually, aurally and conceptually similar. The opponent highlights the various points of similarity between the marks, and, furthermore, it states that the letter P (in the applicant’s mark) is stylised in such a way as to make it appear like a letter T, and, therefore “it is equally likely to be perceived by consumers as TOPDOGS as it is POPDOGS”.

3. The applicant filed a counterstatement “strongly denying that the opposed trade mark would cause any likelihood of confusion to the general public...”

4. The opponent has been professionally represented throughout the proceedings by Bird & Bird LLP. The applicant is self-represented. The opponent filed evidence and a set of written submissions. The applicant filed evidence which, to a large extent, contained submission rather than evidence of fact. Neither side requested a hearing. The applicant filed written submissions in lieu of a hearing, the opponent did not.

The evidence

5. The opponent provided a witness statement by its trade mark attorney, Ms Theresa Castle. Her evidence contains website prints showing 22 examples of restaurant chains selling their own branded goods in supermarkets. For example, exhibit 1 contains a print from the website of Sainsbury's showing the retail sale of Pizza Express branded food products. I do not consider it necessary to summarise this evidence in any further detail.

6. The applicant filed a witness statement by its founder and manager, Mr Monty Bhurjee. It consists predominantly of submission as opposed to factual evidence. I will bear the submissions in mind but will not summarise them here. Mr Bhurjee does, however, provide the results of what he describes as a survey. Tribunal Practice Notice ("TPN") 2/2012 relates to survey evidence. The existence of this TPN was brought to the attention of the applicant, but, despite this, the applicant did not seek permission for the survey to be admitted. The applicant was consequently advised by the tribunal that the survey evidence would be disregarded. That would normally be all I would say on the matter, however, given that the applicant has not been professionally represented in the proceedings, I will explain the primary difficulties that would have arisen with this survey even if permission had been formally sought for it to be included. Firstly, the survey is described as a "question put to the general public". However, it was conducted purely on Facebook and, then, it is reasonable to assume, on the applicant's own Facebook page. It therefore has little "general public" significance as the only people the question was exposed to were those familiar with Popdogs' Facebook page. Indeed, even then, there are only around 25 responses, which has little statistical value. However, these problems are exacerbated by the fact that the question put provides the context of what the dispute is all about, which will have led to all of the respondees going through a process of analysis and evaluation beyond that which an average consumer would have adopted in the normal course of trade. Thus, the survey conducted is of no assistance to the tribunal.

7. The opponent filed reply evidence, again from Ms Castle. She picks up on the following points raised by the applicant:

- i) In response to a submission from Mr Bhurjee that the T and P will not be confused because the applicant's mark is handwritten, bespoke and not part of a digital font, Ms Castle states that this is a reason why confusion could arise. After making some submissions on the way in which the applicant's mark is depicted, she states that "it is common knowledge that cursive writing is less legible than printed letters". She provides at Exhibit THEC1 an article from the Guardian about the decline of writing by hand,

which contains a reference to the effect that print is easier to read than script.

- ii) In response to the applicant's submission that there have been many instances of businesses using marks which constitute a play on the words "hot dog", and thus it is not surprising that Pop Dogs has some aural similarity to Top Dog, Ms Castle states that the other businesses mentioned by Mr Bhurjee have "easily and purposefully chosen names which do not cause confusion with the word top".

The case-law and legislation

8. Section 5(2(b) of the Act states that:

“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.”

9. The following principles are gleaned from the judgments 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.

(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.

Average consumer and the purchasing act

10. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. 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.”

11. The goods and services concerned are not specialist ones and will be purchased/used by members of the general public. They are not highly considered purchases, even when the services in class 43 are being considered. No more than

an average degree of consideration will be deployed by the average consumer when selecting the goods or a service provider. The selection process will be more by the eye than by oral request. The goods will most often be self-selected from a shelf or the online equivalents. In relation to the services, the mark will be encountered on signage, menus, websites etc. I will not, though, completely ignore the aural aspects of the marks because the goods could still be ordered by oral means and restaurant services booked by telephone etc.

The goods/services

12. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

13. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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.”

14. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“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).”

15. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L 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*.”

16. In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he 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) (IPTRANSLATOR)* [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.”

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

17. Even if goods/services are not worded identically, they can still be considered identical if one term falls within the ambit of another (or vice versa), as per the judgment in *Gérard Meric v OHIM*, Case T-133/05.

18. I begin by considering the applicant's class 43 services which read:

Catering for the provision of food and beverages; Fast food restaurant services.

19. The applicant accepts some similarity, but it highlighted in its written submissions the diverse range of services covered by the opponent's mark. It does not matter that the opponent's specification covers multiple terms. The services include "services for providing food and drink". Such a term encompasses the services applied for by the applicant and, consequently, must be considered identical. The opponent's services also cover restaurant services (potentially of all types) which is also identical at least to the applicant's fast food restaurant services.

20. The applicant's goods in classes 29 and 30 read:

Class 29: Frankfurters; French fries; Hotdog sausages; Vegetarian sausages; Chili con carne.

Class 30: Hot dogs (prepared); Buns.


21. The opponent's mark is not registered for any goods, but it claims that the applicant's goods are similar to its services. It provides evidence of restaurant providers also offering branded products in supermarkets. The applicant, in its submissions, does not see any relevance in this as the applicant is a street food provider with no interest in selling goods in a supermarket. The submission put forward by the applicant is misconceived because it is the inherent nature of the goods/services in question that should be considered as opposed to the actual/proposed use of them. From that perspective, it must be observed that there is a clear competitive relationship. The average consumer may choose to either purchase food products (such as hot dogs) from a shop and cook them at home, or, alternatively, to go out for such food. There is, of course, an inherent difference between the nature of any good and the nature of a service (which also impacts on the method of use), but the purpose is similar in terms of both the goods and the services relating to the consumption of food. As the opponent has pointed out, it is not uncommon for restaurateurs to provide their branded goods in supermarkets. I consider the goods to be reasonably similar to the service of the provision of food.

Comparison of marks

22. It is clear from *Sabel BV v. Puma AG* (particularly 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 CJEU 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.”

23. It would be wrong, therefore, to artificially dissect the trade marks, 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. The marks to be compared are:

Applied for mark	Earlier mark
	<p>TOP DOG</p>

24. The earlier mark is comprised of the two words TOP and DOG. However, the words combine to create a known phrase which, in this case, results in the distinctiveness of the mark being based on its totality, with neither word dominating the other in the overall impression. The applicant’s mark is made up of the (stylised) word Popdogs built into a stylised picture of a hot dog. Although a hot dog per se would not be the most distinctive feature of a mark to be used in relation to hot dogs (and related services), its stylisation and manner of presentation means that it is still an important aspect of the mark’s overall impression. I still feel that the word Popdogs has greater relative weight than the device, but the device still contributes to the overall impression.

25. Conceptually, Popdogs has no concrete meaning beyond what will be taken as some form of play on the word hotdog. That concept will be re-enforced by the picture in the mark. In terms of TOP DOG, from an abstract perspective the phrase indicates a dominant person in a particular field. As such, this may create a conceptual difference with the applied for mark. However, taken in context with the services of the earlier mark, the average consumer, whilst still recognising this meaning, may also see a play on words with hot dog. Whilst this means that there may be some conceptual similarity, when the full conceptual meaning of the earlier mark is borne in mind, any conceptual similarity must be considered as low.

26. Aurally, the applied for mark will be articulated as POP-DOGS, the earlier mark as TOP-DOG. The difference in articulation at the end of the mark is not in my view greatly significant. There is, though, more significance to the difference at the beginning of the mark. Nevertheless, there is some clear and obvious similarity which I assess as being reasonably high.

27. Visually, there is some similarity on account of the shared letters “op” and “dog”. There are, though, differences on account of the different beginning letters (the P for a T), the addition of the stylised hot dog and the additional letter S in the applied for mark (although I stress, again, that this latter difference is not particularly significant). The colour pink in the applied for mark does not count as a difference because it is possible that the earlier mark could be used in that same colour. The opponent argues that the P in the applied for mark could just as easily be seen by the average consumer as a T. It considers that cursive script is normally less clear than printed script. The latter point is just, of course, a generalisation. Some cursive script can be very clear, it all depends on the script, or in this case, the script of the applied for mark. The letter in the applied for mark is a P not a T. Whilst it is presented in a cursive script, I see no reason why it would be seen as a T. I am, thus, not persuaded by the opponent’s argument in this regard. That being said, given the similarities I have identified, I cannot say that there is no visual similarity, but weighing the similarities and the differences, and bearing in mind my assessment of the overall impression of the mark, I consider there to be only a moderate level of visual similarity.

Distinctiveness character of the earlier mark

28. 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).”

29. No evidence of use of the earlier mark has been provided so I have only its inherent qualities to consider. In my view, the mark makes a clear allusion to the quality of the service provider (that they are the leading/dominant provider in the field), albeit, whilst also creating a play on words with hotdog. Whilst I do not say that

the earlier mark is low in inherent distinctive character, it is nevertheless not a greatly distinctive mark. I consider it to have a moderate level of inherent distinctive character. I accept, though, that when taken in the context of services which have nothing to do with hot dogs, the play on words is missing. Nevertheless, the mark is still suggestive of quality and still only has a moderate level of distinctive character.

Likelihood of confusion

30. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

31. I will focus initially on the services in class 43. That there is identity between the services is an important point because a lesser degree of similarity between the marks may be offset by a greater degree of similarity (in this case identity) between the services. Bearing in mind the factors I have identified, and bearing in mind the concept of imperfect recollection, my finding is that there is no likelihood of confusion. Having found that Popdogs will not be misread as Topdogs, I see no reason why the consumer will confuse the marks. Top dogs has a concrete meaning not shared by Popdogs, which I feel mitigates against the similarities I have identified. Any conceptual similarity is low and is based purely on a shared play (but played in different ways) on a description. This is not something which increases the likelihood of confusion. I see no reason why Popdogs will be misrecalled or misremembered as Top dog. There is also the pictorial element which further helps to distinguish. I do not consider the similarities that exist will lead the average consumer to either directly mistake one mark for the other, or to otherwise believe that the services come from the same or an economically linked undertaking. The opposition fails, a finding that I extend to the goods of the application for similar reasons.

Costs

32. The applicant has succeeded and is entitled to a contribution towards its costs. I must bear in mind, though, that the applicant was not professionally represented and, so, would not have incurred any legal fees. I also take account of the fact that the applicant's evidence had no real evidence of fact and that the survey it provided was not formally part of the proceedings. My assessment is as follows:

Preparing a statement and considering the other side's statement - £150

Considering and filing evidence - £150

Written submissions - £250

Total - £550

33. I therefore order Top Dog Eats Ltd to pay Popdogs Hotdogs Ltd the sum of £550. This should be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of July 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**