

O-510-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3056179 BY

YOLO FOOD COMPANY LTD

TO REGISTER THE THE FOLLOWING SERIES OF TRADE MARKS:

FOR SERVICES IN CLASS 43

Series: 1



Series: 2



Series: 3



Series: 4



AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000199 BY
YOU ONLY LIVE ONCE (YOLO) LTD**

The background

1) On 19 May 2014 Yolo Food Company Ltd (“the Applicant”) applied to register the following series of trade marks:

Series: 1



Series: 2



Series: 3



Series: 4



The application was published for opposition purposes on 24 October 2014 for goods and services in classes 29, 30, 32, 33, 35, 39 and 43, but only the services applied for in class 43, as shown below, are opposed in these proceedings:

Class 43: *Restaurant services; delicatessens being restaurants; grill restaurants; restaurant information services; carvery restaurant services; hotel restaurant services; self-service restaurants; fast-food restaurants; carry-out restaurants; take-out restaurant services; provision of food and drink in restaurants; making reservations and bookings for restaurants and meals.*

2) The application is opposed by You Only Live Once (YOLO) Ltd (“the Opponent”) under the fast track opposition procedure. The opposition, which is directed against the services in class 43 of the application, as shown above, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for which the Opponent relies upon

the earlier UK trade mark registration no 3023140 in respect of the following mark and list of services in class 43:



Class 43: *Services for providing food and drink*

3) The mark was applied for on 07 October 2013 and its registration process was completed on 31 January 2014. The significance of these dates is that (1) the opponent's mark constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is not subject to the proof of use conditions contained in section 6A of the Act, its registration procedure having been completed less than five years before the publication of the Applicant's mark.

4) On 21 November 2013, the Applicant filed a counterstatement, claiming that: the services of the earlier registration are not clearly defined and the Opponent should not be able to rely on vague terms; the Opponent has not clarified which of the opposed services are identical and which similar to those of the earlier mark, nor where there is a likelihood of confusion; the Applicant will file evidence to show that the word element common to both marks is both common on the register and in the course of trade in relation to the opposed services; there is no likelihood of confusion.

5) In a letter of 8 May the Registry informed the Applicant of its view that that the Opponent's claim that the services in Class 43 of the earlier mark are identical or similar to those covered by the Applicant's mark in Class 43 is acceptable.

6) 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.”

The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions.

Tribunal Practice Notice 2/2013 states:

“6. The Registrar can usually make an assessment of the likelihood of confusion between the opposed mark and the earlier mark(s) relied on by the opponent, without further evidence. Therefore applicants should not expect to have the automatic right to file evidence in a fast track opposition.

7. Where either party considers it necessary to file (further) evidence, a request for leave to file such evidence should be submitted as soon as possible and, at the latest, within 14 days of the serving of the Form TM8 (counterstatement). Each such application will be considered on its merits.”

7) The Applicant duly sought leave to file evidence to show that the element common to the competing marks was common in this particular trade, and on 11 June 2015 leave to file such evidence was granted. The evidence was accepted following queries raised by the Registry. The Opponent filed no evidence.

8) Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) 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. A hearing was neither requested nor considered necessary. Both parties filed written submissions. I therefore give this decision after a careful review of all the papers before me.

The evidence

9) The Applicant’s evidence consists of a witness statement, dated 23 June 2015, of Miss Natasha Linda Hybner, a trainee trade mark attorney with the firm of Swindell & Pearson Limited, which represents the Applicant in these proceedings. The statement is accompanied by 26 exhibits.

10) **EXHIBIT NLH002** consists of an article from the BBC’s website reporting that (amongst others) the word YOLO had now been added to the Oxford Online Dictionary. It states that words are added to oxforddictionaries.com once enough independent evidence from a range of sources has been gathered to prove their widespread use in English. It also points out that the reported words would not for now appear in the paper version of the Oxford English Dictionary, but could do so in the foreseeable future if they continued to be frequently used for years to come. The article is dated 14 August 2014 (three months after the date of filing of the contested mark) but since it is not credible that use of the word could spring up, and evidence of its widespread use be collated and verified, all within three months, this obviously reflects earlier usage, as confirmed by the further evidence below. **EXHIBITS NLH003 to NLH005** are extracts from the *Wikipedia* website. **EXHIBIT NLH003** states that the word YOLO is an acronym of “you only live once”, that both are used in youth culture and music, and were popularised in a 2011 song by Drake, a Canadian rapper. **EXHIBIT NLH005** refers to the impact of Drake’s use of YOLO and its popularity as a Twitter hashtag. References are to North American sources. **EXHIBIT NLH004** refers to ‘You Only Live Once’ as a track name on an album of *The Strokes* which was released 3 January 2006, achieving “silver sales” in the UK. **EXHIBIT NLH022** consists of an article dated 25 November 2014 (6 months

after the contested mark was applied for) from The Daily Mail online, reporting that the UK confectionary manufacturer *Swizzels* had updated its well-known *Love Heart* sweets “for the social media generation” by including “contemporary” messages such as ‘YOLO’.

11) **EXHIBIT NLH001** comprises information from the register on 10 marks (five UK registrations, four European Community Registrations and one International Application) consisting of, or containing, the word YOLO, and covering (amongst others) goods or services in classes 29, 30, 32 and 43. They include a mark covering confectionery which was applied for six months after the application for the contested mark was filed. **EXHIBIT NLH007** shows a search conducted on the Companies House website on 19 June 2015 detailing approximately 50 companies in the UK whose names include the word YOLO. There is no indication as to their field of business or actual trading status at the date of application for the Applicant’s mark. 17 are marked as dissolved.

12) **EXHIBIT NLH006**, which consists of the result of a search conducted on 18 June 2015 on the Yell search engine site, lists 9 businesses in the UK using YOLO in their name. They include 2 bars and clubs, a bistro, sandwich shop, wedding planning business, printing firm, advertising and graphic designer, driving school and a business listed under “New Age & Ethnic Shops”.

13) **EXHIBIT NLH012** consists of three Facebook posts of 20 January 2014 and 25 December 2014 from the *YOLO Burger & Milkshake Bar* in Oldham. The mark used by the bar is the same as that of UK trade mark registration No. 3002557 for the “youonlyliveonce: enjoy it ” YOLO device mark appearing in **EXHIBIT NLH001**, and the registered address of the mark’s proprietor is that of the bar. **EXHIBIT NLH014** contains fifteen Tweets made by *Yolo Lounge* on the social media site Twitter in the period between the 28 December 2013 and 31 May 2015. **EXHIBIT NLH021** consists of a website review taken from TripAdvisor of *Yolo*, a restaurant in Bathgate, Scotland. The earliest review that can be seen is dated 13 September 2014.

14) **EXHIBITS NLH008 and NLH009** comprise 15 posts made on Facebook between June 2013 and September 2014 promoting “party” events held every Thursday under the name *YOLO* at The Viper Rooms in Harrogate and Sheffield. **EXHIBIT NLH010** shows *YOLO Event Planning*’s Facebook page linked to The Viper Rooms in Harrogate and **EXHIBIT NLH011** consists of pages from The Viper Room in Harrogate’s current website referencing the *YOLO* club night as run every Thursday. Miss Hybner states that Harewood Entertainment Ltd (which is the registered proprietor of UK trade mark registration No. 2616807 for *YOLO*, shown in **EXHIBIT NLH001** as covering, amongst other things, night club services and services for providing food and drink) owns The Viper Rooms, though she does not specify the source of this information.

15) Other exhibits comprise the following Facebook posts: three from *YOLO Bar & Club* in Wolverhampton made between 30 September 2013 and 3 July 2014; five from *YOLO Burger & Milkshake Bar* in Bolton made between the 1 February 2014 and 8 September 2014; five from *Yolo Juice*, a company providing smoothies and juices in West Scotland, made between 8 February 2014 and 3 March

2014. three from the *YOLO Glasgow*, a frozen yogurt bar in Glasgow made between the 9 October 2013 and 30 May 2014. Tweets made on Twitter by *Yolo Glasgow* between 28 August 2013 and July 2014 are also included. Further exhibits evidence the existence of a nightclub in West Lothian containing a *YOLO* restaurant and bar, though there is nothing to show when trading took place. An extract from a blog, dated 16 June 2015 (over a year after the contested mark was applied for), reports the launch of “YOLO sushi specials” by the Yo Sushi restaurant chain.

Section 5(2)(b)

16) Section 5(2)(b) of the Act 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”.

17) 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.

(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

18) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market

d) 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;

e) 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.

19) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05 (“*Meric*”), the General Court (“the GC”) stated that:

“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 where 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)”.

Meric involved a comparison of goods, but the principle applies equally to services.

20) In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06 (*Boston Scientific*), the GC stated that “complementary” means:

“...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”.

21) In its counterstatement the Applicant objects that “the services of the earlier registration are not clearly defined as to what they are and therefore the Opponent should not be able to rely on these vague terms in the opposition”. However, In *IP TRANSLATOR* (case C-307/10) the CJEU stated:

“49 Accordingly, Directive 2008/95 requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection sought.

54 In that connection, it must be observed that some of the general indications in the class headings of the Nice Classification are, in themselves, sufficiently clear and precise to allow the competent authorities to determine the scope of the protection conferred by the trade mark, while others are not

such as to meet that requirement where they are too general and cover goods or services which are too variable to be compatible with the trade mark's function as an indication of origin”.

22) Precision and clarity must therefore not be confused with breadth of specification. In *IP TRANSLATOR* the CJEU says that the wording of a specification needs to be clear and precise, not that it cannot be broad. It also permits general terms, for example class headings from the Nice classification, to be used, as long as they are not vague. The earlier mark's *services for providing food and drink* does not fall foul of this requirement for clarity and precision¹.

23) Of the contested class 43 services, all of the following clearly fall within the ambit of the earlier mark's *services for providing food and drink*, and are thus identical under the guidance in *Meric: restaurant services; delicatessens being restaurants; grill restaurants; carvery restaurant services; hotel restaurant services; self-service restaurants; fast-food restaurants; carry-out restaurants; take-out restaurant services; provision of food and drink in restaurants*.

24) The *restaurant information services* and *making reservations and bookings for restaurants and meals* of the contested mark are offered in connection with the *services for providing food and drink* of the earlier mark. They may sometimes be provided by third party businesses, but they will most often be provided by the providers of the restaurant services themselves, and share the same providers and distribution channels. There is also complementarity. Their end users will be the same, and will see a close connection between them in the sense explained in *Boston*. These services are therefore very similar

The average consumer and the purchasing process

25) 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.”

¹ See Practice Amendment Notice PAN 03/13: Lists of goods/services and the use of Class Headings

26) For the purposes of my global assessment of the likelihood of confusion I must take into account notional use of the competing marks over the range of services for which they are registered. *Services for providing food and drink* cover a wide spectrum of services. Restaurant services range from expensive restaurants to fast food outlets, and although their consumers may sometimes consist of businesses, they are, for the most part, normal, everyday services chosen by members of the general public. The same is true in respect of *restaurant information services and making reservations and bookings for restaurants and meals*. All these services will usually involve a reasonable amount of attention, neither higher nor lower than the norm (though, especially in the case of fast food restaurant services, they may include impulse purchases); however, the average consumer is still deemed to be reasonably well informed and reasonably circumspect and observant. Visual considerations are an important part of the purchasing process, the relevant marks being encountered, for example, on signage, on the Internet, in advertisements and brochures, *Yellow Pages* listings, etc.; but word-of-mouth recommendations and telephone ordering may also play a part, and aural aspects will not be overlooked in my assessment.

Comparison of the marks

27) 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.”

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 impression created by the marks.

28) The contested marks consist of the word *yolo* presented in lower case rounded lettering against a general background, the colour of which differs in the different marks of the series. Although the letters appear in the same colour as the background, a white surround is interposed between the letters and the background, so that it is this white surround which presents the letters to the eye, creating an effect of depth. The top right-hand part of the final letter bears a small device in the form of a stylised representation of a pair of leaves. The mark is dominated by the word *YOLO*, which clearly forms its distinctive focus, though its stylisation also makes a not inconsiderable contribution to the overall impression of the mark, viewed as a whole. The small, stylised leaf device also contributes something to the

overall impression of the mark, but its contribution is relatively minor and it has less relative weight than the word element of the mark in the perception of the average consumer.

29) The earlier mark consists of the word *yolo* presented in white in lower case cursive script and surrounded by an elaborate white frame, both word and frame being presented against a general grey background. The frame certainly makes a contribution to the overall impression of the mark as a whole, but the focus of the mark lies on the central word *yolo* and this is the dominant and distinctive element of the mark. The stylisation of the word *yolo* also contributes to the overall impression.

30) The marks to be compared are shown below:

The contested marks	The earlier mark
<p style="text-align: center;">1</p>  <p style="text-align: center;">2</p>  <p style="text-align: center;">3</p>  <p style="text-align: center;">4</p> 	

31) An obvious visual difference between the competing marks is that the elaborate frame device in the earlier mark is missing in the contested marks. The small leaf device of the contested marks has no counterpart in the earlier mark. The word *yolo* is presented in cursive script in the earlier mark, and in separate print letters in the

contested marks. There are also, however, clear visual similarities and common elements. The word *yolo* plays a central role in both marks. In both the contested and the earlier marks it is presented in lower case. I consider that the rounded typeface of the contested marks tends to reduce the effect of the visual difference between its print and the cursive script of the earlier mark, particularly when the principle of imperfect recollection is borne in mind in assessing the general impression left in the mind of the viewer. Both word and figurative elements are in both marks picked out in white against a darker background. Viewing the contested marks as a whole, they have at least a medium degree of visual similarity overall.

32) The Applicant describes the earlier mark as having a “battleship grey” background, and submits that the word element common to the competing marks is in different colours. I would first observe briefly that bringing colour into the comparison in this case is misconceived. This is because the Opponent has not claimed grey as a colour in its registration. I therefore see the grey of the earlier mark not as a colour, but simply as tonal contrast. Without limitation to colours, it is deemed registered in all colours, and the colour of the contested mark(s) becomes irrelevant². I would add, however, that even taking colour into account would not materially affect my assessment of the visual similarity of the competing marks. It may be technically true that the letters of the word element in the contested marks appear in the background colour, while they appear in white in the earlier mark. However, as I have already observed, they are in both cases picked out in white. The material visual impression in both cases consists in the presentation of word and device elements in white against a uniform darker background.

33) It is not normal for device elements of a mark to be expressed aurally. The sole verbal element in the competing marks consists of the same word. They will be pronounced identically.

34) In its written submissions the Opponent states:

“We do not dispute the term YOLO to be prevalent in society”.

This concession could have been framed in clearer terms, but I consider that it amounts to an admission that the average consumer of the contested services would be familiar with the acronym YOLO and aware of its meaning and use. The evidence in any case shows that by the time the contested mark was applied for the word YOLO was a word that appeared to be in use, particularly in youth culture and music. It was understood as a fashionable acronym for the phrase “you only live once” – a saying already well established as a colourful and vivid way of expressing the general philosophy that opportunities for enjoyment in life should not be allowed to pass. This conceptual content is common (and central) to the competing marks through the prominence of the word *yolo* in each. It is difficult to see the unobtrusive leaf device in the contested marks as providing a strong conceptual hook to establish a material conceptual difference in the mind of the consumer. Insofar as it registers, in the context of the contested services it may perhaps be seen as an allusive pictorial reference to the freshness of food served or, possibly, its vegetarian nature.

² See the observations of Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) at paragraph 119.

The purpose of a frame is to provide a neat or attractive border around something – in the case of the earlier mark, the word *yolo* – and as such it is conceptually neutral. The conceptual content of the competing marks is, if not identical, at least very highly similar.

The use of *YOLO* by other traders and its perception by the relevant public

35) In its written submissions the Applicant states:

“6. The Opponent and the Applicant both agree that the element YOLO which is common to both marks is prevalent in society. The Applicant maintains that the common element is of low distinctive character as part of the marks as a whole and that this prevalence strongly counts against a likelihood of confusion

9. The Applicant has filed evidence of the commonness of the word YOLO in general parlance and in the market and on the register in relation to the opposed services and the Applicant maintains that this will not give rise to a likelihood of confusion and the opposition should be refused”

36) I shall deal with the issue of likelihood of confusion later in my decision; but the Applicant’s contention that the word YOLO is of weak distinctiveness in relation to the contested services is also clearly of relevance to my assessment of the distinctive character of the earlier mark, so it is appropriate to look at the evidence on this at this point.

37) It is well settled that the kind of “state of the register” evidence contained in **EXHIBIT NLH001** does not show whether the marks are being used, or indicate the services on which there is use, or what agreements may be in place between the parties concerned. It does not, therefore, suffice to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned³.

38) Similar considerations apply in respect of the list of company registrations in **EXHIBIT NLH007**. The Yell search results do purport to reflect trading activity, but the information is very basic, one does not know how it is collected and verified, or how well it reflects the position at the time of the application for the contested mark. However, further evidence on three of the businesses listed is provided in **EXHIBITS NLH012, NLH014 and NLH021** (though in the case of **EXHIBIT NLH021** the evidence does not specifically show trading before the contested mark was applied for).

39) I accept that the evidence shows that by the time the contested mark was applied for in May 2014 the following undertakings, providing food and drink in

³ 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

various ways, were using the word YOLO in their business names: *YOLO Burger & Milkshake Bar* in Oldham, *Yolo lounge* (a bar and bistro in Hounslow), *The Viper Rooms* (which organised night-club-style “party” events held under the name *YOLO* in Harrogate and Sheffield), *YOLO Bar & Club* in Wolverhampton, *YOLO Burger & Milkshake Bar* in Bolton, *Yolo Juice* (providing smoothies and juices) in West Scotland, and *YOLO Glasgow*, a frozen yogurt bar. However, the use of YOLO in marks by other traders, including in relation to the provision of food and drink, does not necessarily indicate that the term is lacking in distinctiveness⁴. I consider that the evidence falls short of establishing that YOLO was so commonly used in trade in the UK in respect of the contested or similar services as to weaken its distinctive character materially.

40) In paragraph 34) I have already noted the Opponent’s concession that the term YOLO is “*prevalent in society*”. I also accepted that the evidence in any case shows that by the time the contested mark was applied for the word YOLO was a word that appeared to be in use, particularly in youth culture and music, and was understood as a fashionable acronym for the phrase “you only live once”. However, this does not mean that the term is of weak distinctive character. It is true that it could function as a slogan. In *Audi v OHIM C-398/08* the CJEU has clearly held, however, that slogans can be registrable as trade marks:

“45 On that point, it should be noted that the laudatory connotation of a word mark does not mean that it cannot be appropriate for the purposes of guaranteeing to consumers the origin of the goods or services which it covers. Thus, such a mark can be perceived by the relevant public both as a promotional formula and as an indication of the commercial origin of goods or services. It follows that, in so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood – perhaps even primarily understood – as a promotional formula has no bearing on its distinctive character”.

41) Insofar as the meaning of “YOLO” is recognised it may have application in the context of food and drink. However, though it has an allusive quality, it is not directly descriptive or laudatory of the contested services, or even straightforwardly promotional. The message does not follow obviously but requires a certain measure of interpretation, a cognitive step, and it has a certain resonance. I find that in relation to the contested services the term *YOLO* has at least a reasonable degree of inherent distinctive character, rather than a low degree, as the Applicant contends.

The distinctiveness of the earlier mark

42) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is

⁴ See *Floyd J in Nude Brands Limited v Stella McCartney Limited and others* [2009] EWHC 2154 (Ch) at paragraph 29.

sought and by reference to the way it is perceived by the relevant public (see *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). In determining the distinctive character of a mark, I 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 undertakings⁵.

43) I have no evidence of acquired distinctiveness to consider. This leaves the question of inherent distinctiveness. I have already found that in relation to the contested services the term *YOLO* has at least a reasonable degree of inherent distinctive character, rather than a low degree, as the Applicant contends. The stylisation of the word, and the elaborate frame device surrounding it certainly contribute to the distinctive character of the mark, but the distinctive weight of the mark lies predominantly on the word *YOLO*. Viewed as a whole, the mark has at least a normal degree of distinctive character.

Likelihood of Confusion

44) 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.

45) I have found at least a medium degree of visual similarity, aural identity, and, if not identity, at least a very high degree of conceptual similarity between the competing marks. I have found the earlier mark to have at least a normal degree of distinctive character. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C., as the Appointed Person, pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

46) The Applicant submits that the common element of the competing marks – *YOLO* – is of low distinctive character, that the distinctiveness in the earlier mark is

⁵ See *Lloyd Schuhfaand the identity of the competing servicesbrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 at paragraph 22.

found in the elaborate picture frame and that of the contested marks in their ornamentation, so that a likelihood of confusion will not arise. I cannot agree. I find that the *YOLO* element common to both marks is of at least reasonable inherent distinctiveness, and that the distinctive weight of both the earlier and the contested marks lies on this word – which also forms the visual focal point both of the earlier and of the contested marks. I have noted above the differences made by the figurative and device elements of the competing marks, and by the differing scripts used. I have also, however, pointed out that in both earlier and contested marks the focal (and distinctive) word *YOLO* is presented in lower case, picked out in white against a darker background, and that the rounded typeface of the contested marks tends to reduce the effect of the visual difference between its print and the cursive script of the earlier mark, particularly when the principle of imperfect recollection is borne in mind in assessing the general impression left in the mind of the viewer. I also bear in mind my findings on the average consumer, and that the contested services are identical with, or very similar to, those of the earlier mark. Nevertheless, and bearing in mind my finding on the purchasing process, I consider that the visual differences between the marks are sufficient to make direct confusion of the marks unlikely.

47) However, even if differences between the competing marks are noticed, there is still a likelihood of indirect confusion. In this connection it is helpful to bear in mind the observations of Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 (“*L.A. Sugar*”), where he noted that:

“Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark” ”.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

48) I appreciate that in the example given by Mr Purvis in paragraph 17(a) of his decision in *L.A. Sugar Limited v By Back Beat Inc* (quoted at paragraph 27 above) he spoke of marks where “the common element” is “strikingly distinctive”, but his examples were clearly intended to be illustrative in the context of that case, and not to impose rigid rules. Each case must be assessed on its own facts. My assessment must take account of the overall impression created by the marks. YOLO is the only verbal element present in both parties’ marks and the respective presentations of this word will leave a strong impression of similarity in the mind of the average consumer. I believe this similarity will produce a general impression of commonality too great to be regarded as coincidental by the average consumer. S/he will believe that the marks are used by the same or by economically linked undertakings – that they “come from the same stable”. There will be indirect confusion. **Accordingly, the opposition succeeds in respect of the contested services.**

Outcome

49) **The opposition has succeeded in respect of the following services only, which were those opposed, and for which the opposed marks may not proceed to registration:**

Class 43: Restaurant services; delicatessens being restaurants; grill restaurants; restaurant information services; carvery restaurant services; hotel restaurant services; self-service restaurants; fast-food restaurants; carry-out restaurants; take-out restaurant services; provision of food and drink in restaurants; making reservations and bookings for restaurants and meals.

The opposed marks may proceed to registration in respect of the remaining goods and services of the application, which were unopposed.

Costs

50) You Only Live Once (YOLO) Ltd has been successful and is entitled to a contribution towards its costs. The award reflects the fact that the written submissions were brief and the evidence light. I hereby order Yolo Food Company Ltd to pay You Only Live Once (YOLO) Ltd the sum of £700. This sum is calculated as follows:

<i>Opposition fee</i>	£ 100
<i>Preparing a statement and considering the other side’s statement</i>	£ 100
Preparing submissions and considering the other side’s evidence	£ 500

The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30TH day of October 2015

**Martin Boyle
For the Registrar,
The Comptroller-General**