

**O-582-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3035023  
BY  
RESTAURANT & GRILL LTD  
TO REGISTER THE TRADE MARK**

**Qubana**

**IN CLASS 43**

**AND  
OPPOSITION 402099 THERETO  
BY  
CUBANA CAFE LTD**


## Background and pleadings

1. The Applicant, Restaurant & Grill Ltd (trading as Qubana), represented by Urquhart-Dykes & Lord LLP, applied to register trade mark 3035023 “Qubana” in the UK on 16/12/2013. It was accepted and published in the Trade Marks Journal on 28/03/2014 in respect of the following services:

### Class 43

RESTAURANT AND BAR; Restaurant services.

2. The Opponent, Cubana Cafe Ltd (unrepresented), opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK trade marks, also in Class 43, as shown below:

Earlier Mark	Specification
CUBANA ("word mark")	Restaurant, bar and catering services; but none of the aforesaid services provided in the Counties of South Yorkshire, North Yorkshire, West Yorkshire, East Riding, Lancashire, Derbyshire or Nottinghamshire.
 ("stylised mark")	Restaurant, bar and catering services.

3. The stylised mark also bears the disclaimer below:

Registration of this mark is subject to the following limitation: The rights conferred are limited to services provided only in North Yorkshire, West Yorkshire, East Riding, Lancashire, Derbyshire and Nottinghamshire.

4. The Opponent argues that the respective services are highly similar and that the marks are visually similar and aurally identical. Given their filing dates (19/10/2002 for the word mark and 24/12/2007 for the stylised mark), the Opponent's marks are earlier marks within the meaning of section 6(1)(a) of the Act. As the registration procedures were completed before the start of the period of five years ending with the date of publication of the Applicant's mark, in accordance with section 6A the proof of use conditions will apply.
5. The Applicant filed a counterstatement on 28 August 2014 denying the claims made and requesting that the opponent provides proof of use of its earlier trade marks relied upon.
6. The parties have been in contact prior to the present proceedings, in relation to which the Opponent states in its Notice of Opposition:

*The applicants in this case, Restaurant and Grill Ltd t/a Qubana, originally used the Cubana name until challenged and then changed it to the Qubana name. Although this was not as blatant as trading as Cubana, this has caused confusion which we have brought to the attention of the owners.*

7. Whereas the Applicant states in its Counterstatement:

*[...] the Opponent has, for good and valuable consideration, consented to the Applicant's business name Qubana Restaurant and Grill, of which the distinctive and dominant element forms the mark of the Application. As a consequence of the consent from the Opponent, the Opponent is now estopped from bringing the opposition proceedings.*

8. The Opponent filed two witness statements in the name of Phillip Oppenheim, along with a number of exhibits, one of which was subsequently excluded as without prejudice material. The Applicant filed a witness statement in the name of Matthew Burton, along with exhibits. The evidence will be summarised to the extent that it is considered necessary. The Applicant also filed written submissions dated 21 July 2015, to which the Opponent responded in an email dated 29 July 2015.

9. No hearing was requested and so this decision is taken on the basis of the material before me.

### **Geographical Limitations**

10. Section 13(1)(b) of the Act makes provision for applicants to include territorial limitations on the extent of the rights in their marks. The effect of this, as in the present case, is to disentitle the proprietor from bringing proceedings for infringement in the territories that are excluded (the word mark), or put another way, infringement can only be pursued in the territories included (the stylised mark).

11. Prior to July 2004, these disclaimers and limitations were sometimes entered into specifications of goods and services, as appears to have been the case with the Opponent's word mark.

12. The stylised mark was applied for after the date on which the revised practice came into force, and so its limitation does not form part of its specification.

13. The IPO's Manual of Trade Marks Practice states:

The revised practice came into force on 26th July 2004. An application filed on or after this date with a territorial limitation contained in the body of the specification will face objection at the time of issue of the examination report. A pending application filed before this date which includes such a limitation within its specification (or if the Registrar has already agreed to a revised specification including a territorial limitation) will not be amended unless the applicant makes an appropriate request. In respect of registrations and other pending applications filed before the implementation date, the revised practice

will also apply to requests (or requirements) to enter territorial limitations made on or after 26th July 2004.

14. As the Opponent's word mark application was pending before the 26<sup>th</sup> July 2004 the change in practice did not affect the validity of the disclaimer. The effect of the disclaimer is that the Opponent's word mark enjoys no protection for infringement purposes in the counties of South Yorkshire, North Yorkshire, West Yorkshire, East Riding, Lancashire, Derbyshire or Nottinghamshire.
15. The effect of the limitation in the Opponent's stylised mark is that it only enjoys protection for infringement purposes in the counties of North Yorkshire, West Yorkshire, East Riding, Lancashire, Derbyshire or Nottinghamshire.
16. Notwithstanding these limitations, subject to the proof of use requirements in Section 6A being made out satisfactorily, the marks may still be relied upon for opposition purposes. This is because the application is for UK-wide rights and there may still be a likelihood of confusion between the marks on a UK-wide scale.

## **EVIDENCE**

17. The following points arise from the first witness statement (PO1) of Philip Oppenheim, Managing Director of the Opponent company:
  - Cubana Café Ltd operates a bar and restaurant called 'Cubana' which has been trading continuously in Waterloo, London since 1998. At the time of producing his Witness Statement, Mr Oppenheim states that a second 'Cubana' site was to open in Smithfield, London in 2015. Cubana serves 'typically Cuban' food and drink.
  - At Exhibit 2 to PO1 Mr Oppenheim provides a screenshot of the Cubana website. The word 'Cubana' appears in the browser tab, the URL, and the email address 'reservations@cubana.co.uk'. The stylised mark appears in a prominent location at the top of the page. Whilst Mr Oppenheim states that the website has been in existence since 1999, the screenshot is dated 16 January 2015.
  - Exhibit 3 is a single page printout of Cubana's twitter profile, albeit without any tweets visible. The profile features the word Cubana in the account name 'Cubana BarRestaurant', in the handle @cubanamojito, and in the web link 'cubana.co.uk', which appears twice. The stylised mark appears on an awning or marquee, and on signage at the physical restaurant in the header photo. The profile is shown to have been established in 2012, however the screenshot is dated 16 January 2015. The profile is shown to have made 1,619 tweets and have 968 followers at the time of the screenshot.
  - Exhibit 4 is similarly a single page printout dated 16 January 2015, this time of Cubana's facebook profile. The word Cubana appears in the profile name 'Cubana Bar-Restaurant', and is therefore repeated in

each post. It also appears in the web link “www.cubana.co.uk”. The word Cubana also appears in a variant form in the profile picture. The registered stylised mark does not appear. Like the twitter profile, this also appears to have been created in 2012, and had received 7480 visits and 4074 likes at the time of the screenshot.

- Exhibit 5 is a single page printout dated 16 January 2015 of the company’s listing on the review site Tripadvisor. The word Cubana appears at the top of the listing, and in the web link to the restaurant’s openable booking page. The stylised mark does not appear. Two reviews are visible in the screenshot, dating to 9 and 12 January 2015. Statistics are provided showing that the restaurant has received 233 reviews in total (of which only around 26% rank it lower than average), and by Tripadvisor metrics is ranked the 6,268<sup>th</sup> best restaurant in London out of 18,045.
- Exhibit 6 is also dated 16 January 2015, and appears to be a notice advertising Cubana as a location for film shoots. It states that the movie ‘One Day’ used it as a location, as have The One Show and Strictly Come Dancing. It is unclear when this occurred.
- Exhibits 7 and 8 are menus. They feature the stylised mark at the top, and the word Cubana appears a number of times throughout, e.g. drinks “prepared the Cubana way”. It is unclear during what period these menus have been used. They both bear an ‘RSPCA good business awards 2007 Innovation Award’ logo, and the bar menu features wines as young as 2014.
- Directors’ reports and financial statements for the year ended 31 December 2013 are provided at Exhibit 9 for the Opponent, and for its Holding Company at Exhibit 10. PO1 explains that the financial relationship between the Opponent and its Holding company are such that the records of both are needed to arrive at the overall financial picture. He states that for year-end 2013 net sales were ‘just over £1.4m’ and for 2014 they were ‘just under £1.6m’.

18. The following points arise from the witness statement of Matthew Burton, Managing Director of the Applicant company:

- The Applicant company Restaurant & Grill Limited operates a Cuban themed restaurant under the name Qubana in Wakefield, West Yorkshire. The restaurant has operated since September 2009, when it traded under the name Cubana Restaurant & Grill until challenged by the Opponent in November 2009, following which the Applicant changed its name to Qubana Restaurant & Grill.
- Exhibit MB2 is a letter said to record the settlement agreement reached over the name Qubana. However it is signed only by Mr Burton for the Applicant and I am not provided with any supporting context to assist me in construing the document. The Applicant claims that through this

the Opponents are estopped from bringing opposition proceedings, though the nature of the agreement is in dispute.

- Exhibit MB3 comprises a number of printouts dated 27 March 2015: a) of Qubana's listing on Tripadvisor; b) its Facebook profile; c) its listing on the Yorkshire Food Guide website; and d) its listing on Yelp. These are said to show its strong local reputation, in particular:
  - a) Qubana has 331 reviews on Tripadvisor and is listed in 17<sup>th</sup> place out of 341 restaurants in Wakefield. Over 80% of reviews are positive.
  - b) On Facebook it has received 13,955 visits and 1,452 likes. It is unclear how long the page has been established.

19. The Opponent filed a second witness statement by Phillip Oppenheim (PO2) in response to the Applicant's evidence. This offers further explanation of the position with regard to the estoppel claim and the reason behind the geographical limitations in the Opponent's marks. I refer to it where appropriate below. To it is annexed B2 which appears to be the premises licence for the Cubana Café, however it is silent as to what period it covers.

20. PO2 also refers to the Opponent's earlier Community trade mark. In their written submissions the Applicant objects to the Opponent's reliance on this mark as it was not pleaded in its Notice of Opposition. They also suggest that it is not owned by the Opponent. This would appear to be based on the exhibit B1 to PO2 which lists Cubana (UK) Limited (the Opponent's holding company) as the owner. However this is only the first page of a two page document, and the mark as registered is in fact jointly owned by the Opponent and its holding company. Nevertheless, the Opponent may not rely on this right for these proceedings, having not set it out in their statement of case (or sought leave to amend the statement of case) or pleaded it beyond a bare assertion in their second tranche of evidence.

## **Estoppel**

21. In PO1 Mr Oppenheim characterises the Opponent's position in the following terms:

We agreed not to challenge [the change of name to Qubana] on the basis that this use would be a one-off; the applicant did not at the time seek to register the trade mark Qubana.

However, we have since then found some confusion with our trade mark [...]

A sample of the Opponent's correspondence with the Applicant on this matter is given at the first exhibit to PO1.

22. The evidence of the Applicant is that the Opponent's challenge to their use of the name Cubana was resolved in a binding settlement agreement on 23 December

2009 which Mr Burton exhibits as MB2. The document contains a number of undertakings regarding the cessation of all trading under the name Cubana. These undertakings are said to be made on the understanding that the Opponent agrees to the change of name to Qubana. The Applicant also agrees to pay the Opponent's legal fees in that matter. The agreement is stated to be in full and final settlement of all claims set out in the Opponent's letter of 30 November 2009.

23. There are a number of issues with this evidence. I do not have the letter of 30 November 2009, nor any subsequent correspondence to assist me in construing the letter of the 23 December, which fatally is not signed by the Opponent. Without these things I am entirely unable to say whether its terms did indeed form a binding agreement, or an agreement of any sort.
24. Mr Oppenheim makes a number of arguments against the Applicant's reliance on this document in PO2, including that there was "no consideration" contrary to the Applicant's claims, and that the letter of 23 December "makes no mention of any formal agreement" to the use of the name Qubana. I do not find either assertion particularly persuasive, except in so far as the letter does not state what the terms to which it purported to agree were, but in any case it is unnecessary for me to make a finding on either point for the reasons given in paragraph 23 above.
25. Accordingly the Applicant's estoppel claim is not made out on the basis of the evidence before me and the Opposition may proceed.

### **Proof of use**

26. Section 6A(3)(a) of the Act provides that the relevant period in which genuine use must be established is the period of five years ending with the date of publication of the application. That being 28 March 2014, the relevant period is 29 March 2009 to 28 March 2014.
27. The earlier marks must meet the use conditions in respect of the services upon which the Opponent relies. The provisions of the Act are set out below:

Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

28. Section 100 of the Act is also relevant:

100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

29. In *Stichting BDO v BDO Unibank, Inc.*, [2013] EWHC 418 (Ch), Arnold J. stated as follows:

51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-



495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v OHIM* (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72].

30. Although minimal use may qualify as genuine use, the CJEU stated in Case C 141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its

judgment), that “not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

31. The quality of the Opponent’s evidence is low. I have noted that the printouts of social media profiles do show the date on which those profiles were created. However evidence of the state of these websites as at January 2015 is inconclusive as to its state within the relevant period. These printouts, as well as those from tripadvisor and the restaurant’s own website, merely invite me to make the inference that they reflect the use as it was in the relevant period.

32. As raised in the evidence summary, the stylised form of the word Cubana used in the twitter profile picture is in a form different in elements from the form in which the earlier marks were registered, so I must assess whether those differences alter the distinctive character of the marks, and is therefore to be discounted as use of the registered marks.


The marks to be compared are:

Registered Marks	Variant Mark
<p style="text-align: center;"><b>CUBANA</b></p> 	

33. I find that the variant mark does differ in distinctive character to the registered word mark, for the reasons given in Catwalk where Geoffrey Hobbs QC sitting as Appointed Person said:

The stylised form of the word CATWALK is indeed a variant of the word CATWALK as registered. The way in which the former individualises the latter may perhaps be analogised to the way in which a signature individualises the name it represents. It appears to me that in terms of its visual impact, there is visual individualisation to a degree which causes the stylised form of the word CATWALK to differ distinctively from the word CATWALK in ordinary letterpress.

In that case the marks to be compared were:

Registered Mark	Variant Mark
<p style="text-align: center;"><b>CATWALK</b></p>	

34. The cases are clearly analogous. Decisions of the Appointed Person are not binding, they are merely persuasive, but nevertheless I reach the same view. In *catwalk* the differences were listed as the split shading background, the contrasting black and white lettering, and the dots inside the letters. All three elements are present in the variant 'Cubana' mark, and consequently it may not be relied upon as evidence of use of the word mark. Neither may it be relied upon as evidence of use of the stylised mark, where the differences are even more stark. Even if it could be relied upon, the evidence of its use is similarly inconclusive as it is not shown to have been within the relevant period.
35. Moving on to the Opponent's stylised mark, the only evidence of use is its appearance on the undated website, menus and twitter header photo, whilst the word mark appears on twitter, facebook and tripadvisor, again not conclusively dated to the relevant period. With regard to the stylised mark, it can be inferred that the menus were printed no earlier than 2014 due to the vintages of the wines. It is possible that this use falls within the last three months of the relevant period, but that is not conclusive.
36. As such I must form a view on use based on inconclusive evidence showing use of the marks after the relevant period, and the Witness Statement of Mr Oppenheim to the effect that the restaurant has traded under the name Cubana since 1998. I am somewhat assisted in this by financial statements which show profits and loss for the years 2012 and 2013, showing a turnover in excess of £1m in both.
37. In *Awareness Limited v Plymouth City Council*, Case BL O/230/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:
- “22. The burden lies on the registered proprietor to prove use[...] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.
38. Despite the above, and despite the request for proof of use, the Applicant does not challenge that the name Cubana has been used in relation to an extant Cuban restaurant in London which has operated since at least the dispute over the name in 2009. It is in my view highly unlikely that the Applicants would have agreed to a change of name if the Opponents did not in fact trade under the name Cubana.

39. Taking the evidence as a whole, I conclude that, on the balance of probability, genuine use of the word mark is made out for restaurant and bar services, but not catering services of which I have no evidence. I consider that this would represent a fair specification for the use (*Roger Maier and Another v ASOS*, [2015] EWCA Civ 220). I conclude that genuine use of the stylised mark is not made out and consequently only the word mark may be relied upon in these proceedings.

## **DECISION**

### **Section 5(2)(b)**

Sections 5(2)(b) of the Act is 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.

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

### **The principles**

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

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

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

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

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

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

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

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

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

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

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

### **Comparison of services**

41. The application is for “RESTAURANT AND BAR; Restaurant services” in class 43. The Opponent’s earlier mark covers “restaurant” and “bar” services. Therefore the services are identical. It is immaterial for the purposes of the comparison of services that the parties both operate Cuban themed restaurants.

### **The average consumer**

42. 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.

43. 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.

44. The average consumer of restaurant and bar services is the general public, who will make their selection with a normal degree of care and attention based on visual inspection of the premises in person or online, or based on word of mouth recommendations where there may be an aural element.

### Comparison of marks

The respective trade marks are shown below:

Applicant's Mark	Opponent's Mark
<b>QUBANA</b>	<b>CUBANA</b>

45. 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 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.

46. 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.

47. The overall impression of both marks will be based upon the single words of which they consist.

48. Visually, the marks are of identical length and share all but the first letter. Consequently, I consider that the marks have overall a high degree of visual similarity.

49. Aurally the marks are identical – the ‘QU’ sound in the Applicant’s mark will be pronounced in the same way as the ‘CU’ sound of the Opponent’s mark, to rhyme with the word ‘queue’.
50. Conceptually, the Opponent’s mark consists of the single word ‘Cubana’, which is the feminine singular noun meaning ‘Cuban’ in a number of latinate languages. Even if the specific meaning was not recognised, the average consumer would recognise the overwhelming association with Cuba (on evocative effects see *Usinor SA v OHIM*, Case T-189/05). The Applicant’s mark by contrast is an invented word, but is similarly evocative of Cuba, and as such the marks have a high degree of conceptual similarity.

### **Distinctive character of the earlier trade mark**

51. In Case C-342/97 *Lloyd Schuhfabrik Meyer*, 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 *Windsurfing Chiemsee 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).

52. Although ‘Cubana’ is a foreign word, it entirely contains the word ‘Cuban’ and the allusion would be well understood by the average consumer. As a single word strongly allusive of a characteristic of the services, i.e. ‘Cubana’ for a Cuban restaurant, the earlier mark bears a low degree of inherent distinctive character. I am unable to find this has been enhanced through use on the basis of the evidence before me.

### **Likelihood of Confusion**

53. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent’s

trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

54. I have found that:

- the average consumer is a member of the general public who pays a normal degree of care and attention during the selection process;
- the services are identical;
- the competing marks are aurally identical, and visually and conceptually highly similar;
- the earlier mark is possessed of a low degree of inherent distinctive character.

55. Taking into account all of these factors and bearing in mind the above case law, I find that there is a likelihood of confusion. Bearing in mind the average consumer's imperfect recollection and the fact that they do not directly compare marks, these factors will lead to one mark being mistaken for another and therefore there will be direct confusion.

56. Even if I am wrong with regard to the use of the stylised mark and the mark should have been taken into account, the Opponent would be in no better position as they have succeeded on the basis of the word mark.

## **Conclusion**

57. The opposition under Section 5(2)(b) has succeeded and the application is refused.

58. I note that the Applicant offers in its written submissions to amend the application such that its rights are restricted to the counties of South Yorkshire, North Yorkshire, West Yorkshire, East Riding, Lancashire, Derbyshire and Nottinghamshire; areas which are disclaimed in the Opponent's mark. However, even if the two limitations were applied such that the rights in the two marks did not overlap, this would not preclude a likelihood of confusion among the relevant consumers, and so this would not assist the Applicant.

## **Costs**

59. The Opponent has been successful and is entitled to a contribution towards its costs. I note that the Opponent was not legally represented and would not have incurred associated legal expenses. In the circumstances I award the Opponent the sum of £450 as a contribution towards the cost of the proceedings. The sum is calculated as follows:



Preparing a statement and considering the other side's statement:	<b>£100</b>
Preparing evidence and considering and commenting on the other side's evidence:	<b>£250</b>
Fees:	<b>£100</b>
<b>Total:</b>	<b>£450</b>

60. I therefore order Restaurant & Grill Ltd to pay Cubana Cafe Ltd the sum of £450. 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 8th day of December 2015**

**Andrew Wall  
For the Registrar**