

O-208-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3085151
BY OPTP DINER, FAISAL KHALID, HARIS KHALID & KAMRAN SHEIKH
TO REGISTER THE TRADE MARK
GUN SMOKE
IN CLASS 43
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 404195 BY
RIZWAN ALI**


BACKGROUND

1) On 8 December 2014, Optp Diner, Faisal Khalid, Haris Khalid & Kamran Sheikh (hereinafter the applicants) applied to register the trade mark GUN SMOKE in respect of the following services:

Class 43: Restaurant and bar services, including kiosks; preparation of food and drink; catering services; take away and food delivery services; services related to supply of food and beverages; providing prepared meals; preparation of foodstuffs, beverages or meals for consumption on and off the premises.

2) The application was examined and accepted, and subsequently published for opposition purposes on 27 February 2015 in Trade Marks Journal No. 2015/009.

3) On 24 April 2015 Mr Rizwan Ali (hereinafter the opponent) filed a notice of opposition, subsequently amended. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
	3066562	31.07.14 07.11.14	43	Services for providing food and drink; restaurant, bar and catering services; takeaway services; information and advice in relation to all the aforesaid services.
GUNS AND SMOKE	3066743	01.08.14 07.11.14	43	Services for providing food and drink; restaurant, bar and catering services; takeaway services; information and advice in relation to all the aforesaid services.

a) The opponent contends that his marks and the mark applied for are identical / very similar and that the services in class 43 for which his marks are registered are identical and/or very similar to those applied for by the applicants in class 43. He contends that the application offends against Section 5(1), 5(2)(a) & 5(2)(b) of the Act.

4) On 28 July 2015 the applicants filed a counterstatement, basically denying that the marks are similar, and claiming that the opponent had a reputation limited to Barnet in North London which would reduce the likelihood of confusion and that he copied the mark from the applicant's businesses in Pakistan and the UAE in the hope of taking advantage of the applicants' reputation in both countries and thus the application was in bad faith.

5) Only the applicants filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 18 April 2016 when the applicants were represented by Mr Groves of Messrs C.J. Jones Solicitors LLP; the opponent chose not to attend.

APPLICANTS' EVIDENCE

6) The applicants filed a witness statement, dated 21 December 2015, by Peter John Groves their legal representative. He provides his evidence from his own knowledge and also from information provided to him by his clients. He states that the applicants have operated a number of restaurants in Pakistan under the name GUN SMOKE since 2010 and had the mark registered for goods in class 29 in Pakistan in 2004. They also had the words GUN SMOKE and a large device registered in Pakistan in regard to services in class 43 in 2006. They also own trade mark registrations in the UAE and Saudi Arabia. The restaurants in Pakistan have received publicity via social media and also sites such as Tripadvisor. The restaurants have also been advertised in Pakistan.

7) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

8) The only ground of opposition is under section 5(2)(b) which reads:

“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) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

10) The opponent is relying upon his trade marks listed in paragraph 3 above which are clearly earlier trade marks. Given the interplay between the dates that the opponent’s marks were registered and the date that the applicants’ mark was published, the opponent’s marks are not subject to proof of use.

11) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

The average consumer and the nature of the purchasing decision

12) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. 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.”

13) Both parties have specifications, broadly speaking, of restaurant, catering and takeaway services, for which the customers will be the general public, including businesses. Such services will usually be found on the high street and the signs advertising them will attract custom. I accept that advertising in print and on the Internet will also play a part in the selection. Whilst the services will be mostly chosen by visual means I must not overlook the aural consideration when such establishments are recommended by word of mouth. The average consumers’ attention will vary considerably. If looking for a venue for a celebration then considerable care will be chosen to ensure that the food and ambience are right. However, in the case of takeaway food the selection process is likely to be far less discerning. Overall the average consumer is likely to pay a medium degree of attention to the selection of such services.

Comparison of services

14) In the judgment of 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”.

15) 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.

16) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 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”.

17) In making the comparison I note that the specifications of the opponent’s two marks are identical. I shall therefore just carry out one comparison test. The services of the two parties are:

Applicants’ services	Opponent’s services
Restaurant and bar services, including kiosks; preparation of food and drink; catering services; take away and food delivery services; services related to supply of food and beverages; providing prepared meals; preparation of foodstuffs, beverages or meals for consumption on and off the premises.	Services for providing food and drink; restaurant, bar and catering services; takeaway services; information and advice in relation to all the aforesaid services.

18) The applicants accept that the services are similar. I would go much further. The following words, “Restaurant and bar services; catering services; take away services”, in the applicant’s specification can be found in that of the opponent and so these are identical services. The terms “preparation of food and drink; services related to supply of food and beverages; providing prepared meals; preparation of foodstuffs, beverages or meals for consumption on and off the premises” are clearly encompassed within the opponent’s services, and are also identical to the opponent’s specification. Lastly, I regard “Kiosk services” and “food delivery services” to be encompassed by the opponent’s “takeaway services”. **To my mind, the services of the two parties are identical.**

Comparison of trade marks

19) To my mind, the opponent’s strongest case lies with his 3066743 mark. I shall therefore use this mark for my comparison test. 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 them, 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.”

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

Opponent’s trade mark	Applicants’ trade mark
GUNS AND SMOKE	GUN SMOKE

21) The applicants contend that “the verbal element of the opponent’s trade mark comprises two distinct elements, guns and smoke. The applicants’ mark consists of the single noun gunsmoke, although I note that there is a gap between the words. Visually the marks both start with the same word “Gun” (albeit the opponent’s mark is in the plural) and also end with the same word “smoke”. The only other point of difference is the inclusion of the word “and” between these two elements in the opponent’s mark. They are therefore visually similar to at least a medium degree. Aurally the same contentions apply, and the marks are aurally similar to at least a medium degree. The only difference is the inclusion of the word “and”. Conceptually there is a slight difference in that the mark in suit clearly refers to smoke from a gun, whereas the opponent’s mark merely links guns and smoke. They still have a conceptual similarity albeit to a lesser extent. At the hearing the applicants accepted that the marks were similar. Overall the marks are similar to at least a medium degree.

Distinctive character of the earlier trade mark

22) 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 *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).”

23) 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:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

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".

24) The mark has no meaning in respect of the services for which it is registered. The mark is inherently distinctive to a medium degree. The opponent has not shown use of his mark and as such the opponent cannot benefit from enhanced distinctiveness.

Likelihood of confusion

25) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the services by predominantly visual means, although not discounting aural considerations and that the degree of care and attention they pay will vary but they are likely to pay a medium degree of attention to the selection of such services.
- the services of the two parties are identical.
- the marks of the two parties are similar to at least a medium degree.
- the opponent's mark has a medium level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.

26) The applicants contended that the opponent's reputation would be limited to a small geographical area and also that the opponent had applied for its mark in bad faith as it had copied the mark from its well-known restaurants in Pakistan. Firstly the question of limited geographical scope does not apply under section 5(2)(b), and in respect of the bad faith issue I note that the applicant has not sought to invalidate the opponent's marks.

27) In view of all the above, and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the services applied for under the mark in suit and provided by the applicants are those of the opponent or provided by some undertaking linked to him. **The opposition under Section 5(2) (b) therefore succeeds.**

COSTS

28) As the opponent has been successful he is entitled to a contribution towards his costs. I note that he has represented himself and therefore apply a 50% discount to the normal level of costs provided to those professionally represented.

Preparing a statement and considering the other side's statement	£150
Considering the other side's evidence	£150
Expenses	£100
TOTAL	£400

29) I order OPTP Diner, Faisal Khalid, Haris Khalid, and Kamran Sheikh jointly to pay Rizwan Ali the sum of £400. This sum to 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 25th day of April 2016

**George W Salthouse
For the Registrar,
the Comptroller-General**