

**O-427-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION 2636723  
IN THE NAME OF NGON LONDON LIMITED CO  
IN RESPECT OF THE FOLLOWING TRADE MARK IN CLASS 43:**

**NGON**

**AND**

**AN APPLICATION FOR INVALIDITY (NO. 500949) BY  
NGON NGON LLP**

## **Background and pleadings**

1. The trade mark **NGON** was filed on 2 October 2012 by Ngon London Limited Co (“the proprietor”). It was published for opposition purposes on 7 December 2012 and subsequently registered on 15 February 2013. It is registered for the following class 43 services:

Services for providing food and drink; restaurant, bar and catering services; booking and reservation services for restaurants; takeaway services; information and advice in relation to all the aforesaid services.

2. Ngon Ngon LLP (“the applicant”) seeks the invalidation of the registration. In summary, its pleaded grounds are as follows:

- Section 3(1)(b) of the Trade Marks Act 1994 (“the Act”) - It is claimed that the word NGON is a Vietnamese word meaning delicious or tasty – the applicant considers this to be a “straightforward descriptive term and devoid of any distinctive character”.
- Section 3(1)(c) of the Act - It is claimed that the word NGON is used within the Vietnamese restaurant and food industry to denote the kind, quality and characteristics of the goods being sold by the proprietor.

3. By way of background, the applicant claims that both it and the proprietor operate Vietnamese restaurants, the applicant under the name NGON NGON, the proprietor under the name NGON.

4. The proprietor filed a counterstatement denying the grounds. I note the following:

- There are no other restaurants using the term NGON in their names and no other UK registrations for that term.
- An analogy is drawn with the word YUM which has a similar meaning to NGON and which was accepted in Europe (including the UK) for chicken and noodles.

The applicant considers the word NGON to be less understood than YUM and, thus, “argues towards registrability”.

- The average consumer is not unduly narrow and does in fact represent a diverse range of people. It is stated that Vietnamese is spoken by only 0.05% of the UK population.

5. Both sides have been professionally represented throughout the proceedings, the applicant by Bircham Dyson Bell LLP, the proprietor by Waterfront Solicitors LLP. Both sides filed evidence. Neither side requested a hearing, nor were written submissions filed in lieu.

### **The applicant’s evidence**

6. This comes from Ms Clara Bakosi, a paralegal at Bircham Dyson Bell LLP. She provides a witness statement and accompanying exhibits. Her evidence consists of a mixture of fact and submission. Annex 1 to her witness statement contains a print from Google Translate. This online translation tool translates the word NGON as TASTY. No languages are shown on the print, but there is no reason to doubt the claim that the word NGON is Vietnamese. Annex 2 contains further references from other sources which Ms Bakosi states are Vietnamese dictionaries. Vdict.com translates NGON as “delicious; tasty; succulent”. An example of the word in a sentence is given as “cai banh ngon lam sao” which means “what a delicious cake”. Cambridge Dictionaries Online (English to Vietnamese) also supports that NGON means delicious/succulent – “thom ngon” is translated as “a delicious meal”, “mong va ngon” as “a succulent peach”. Annex C contains a print from Yahoo Answers (the full URL is preceded by the word Malaysia). The question asked is “How do you say “delicious” in Vietnamese?” Five answers are provided by users, four of which make reference to the word NGON.

7. Annex D contains prints of 8 restaurant reviews on the Tripadvisor review website, as follows:

- A review of a Vietnamese restaurant in West Berlin (New Jersey) called Pho Le. The review (by a registered US user) is written in English and begins with “Delicious Pho [Pho being a dish served there]!! Pho rat ngon!!”.
- A review (by a registered UK user) of a restaurant in Vietnam called Miss Ly Café. The review, which is written in English, is headed “Ngon!!! (delicious)”.
- A review (by a registered US user, who lived in Vietnam for over two years) of a restaurant in Pennsylvania called Pho Miss Saigon. The review, which is written in English, is headed “Ngon Oi La Ngon” which the reviewer states “means delicious but with emphasis”, but might instead be translated as “Wonderful good”.
- A review (by a registered Vietnamese user) of a Spanish Tapas Bar in Vietnam called THBC. Written in English, it is headed “Ngon Qua! (Very Delicious!!)”.
- A review (by a registered Thai user) of the Hanoi Street Food Tour in Vietnam. Written in English, the review is headed “Ngon (delicious)”.
- A review (by a registered Australian user) of a hotel in Vietnam called Hanoi Boutique Hotel 1. Written in English, the review is headed “Great Hotel, friendly staff, ngon breakfast”.
- A review (by a registered Vietnamese user) of a restaurant in Vietnam called Crystal Jade Palace. Written in English, the review is headed “ngon va tuet”.
- A review (by a registered Vietnamese user) of a restaurant in Vietnam called Banh My 25. Written in English, the review is headed “Banh My 25 – NGON”.

8. Annex 5 contains an article from what Ms Bakosi states is a travel website at [www.travelandleisure.com](http://www.travelandleisure.com). It is headed “Quan Com Ngon” which is the name of an open air restaurant which brings together a collection of street food vendors in Hanoi, Vietnam. After describing the restaurant, it is added that “(Ngon means “delicious” by the way)”. It is not clear whether this website is aimed at the UK public.

9. Annex 6 contains a web print from the website Westeast Design. Ms Bakosi states that the print relates to the proprietor's business. The print contains details of Ngon Deli. A description of the business reads:

“Branded as: “ngon”, pronounced [non] *adjective*, *Vietnamese translation: Delicious – is a café/deli based in West London.*”

10. Annex 7 contains prints from www.ngondeli.com which Ms Bakosi says is the proprietor's own website. On two of the three provided pages, it is stated in the top right hand corner that “ngon [non] *adjective* – Vietnamese translation: *Delicious*”. Also, in an explanation about the business, it is stated that it provides “..healthy and of course, “ngon” food”. On a third page there are a number of reviews one of which begins:

“Ngon – which means “delicious” in Vietnamese, and is pronounced a little like “non” of “nahn” – lives up to its name!”.

11. It is clear from the above that the proprietor operates a Vietnamese restaurant. Also in Annex 7 there is an article in the Chiswick & Brook Green magazine about Ngon (the restaurant). It begins “Meaning “delicious”, this restaurant needs to live up to its name”.

12. In view of the above, Ms Bakosi states that NGON means delicious in the Vietnamese language and is a commonly used word in this respect.

13. Ms Bakosi states that she has no direct knowledge of the proprietor's claim that there are no other restaurants with NGON in their name and no other relevant trade marks for the term NGON. She puts the proprietor to proof on this. Further, she does not accept the proprietor's claim that NGON is distinctive and that the registration of YUM is indicative of registrability of NGON. She adds that YUM is not synonymous with NGON because it is a slang word and has a marginally higher degree of distinctiveness compared to the word delicious. It is added that there are no registrations for word marks comprising the word DELICIOUS or TASTY in various food related classes (Annex 8 contains details from the IPO's database which appears

to show that registrations for this word are either in non-food classes, or otherwise contain a figurative element in addition to the word). It is further added that the registration of YUM is for goods in classes 29, 30 and 31 and is therefore not analogous (presumably because this dispute concerns food related services). Ms Bakosi puts the proprietor to proof on what is said about the average consumer.

14. Ms Bakosi states that the word NGON “is popular in the Vietnamese restaurant industry and/or to an extent the general restaurant industry”. Annex 9 consists of prints from the Tripadvisor website after a search for the word NGON was made. There are 81 restaurants listed which have the word NGON in their name, 12 of which are in Europe. Most are in Vietnam, there are others in the US, Japan, Thailand, France, Germany and other countries. Only two are in the UK, which appear to be the restaurants of the applicant and the proprietor. It is stated that the list is not exhaustive as the uses represent only restaurants which have reviews on Tripadvisor or who have a web presence. It is added that many Vietnamese restaurants are family run and may not have a web presence. Ms Bakosi speculates that there are likely to be many more which use NGON in their names due to the descriptive/generic nature of the word.

15. Annex 10 contains examples of other trade mark registrations which include the word NGON, as follows:

- A European Union Trade Mark (“EUTM”) (no. 6433742) owned by a company with an address in Vietnam, filed in 2007 and registered in 2008. It contains the words “quan an ngon” alongside a figurative element. The text translates as “tasty restaurant”. The registration covers services in class 43.
- An International registration (no 1113745) owned by a company with an address in Vietnam, filed in 2011 with protection conferred at the end of 2012. It is not clear where protection has been conferred, although, given that the print is from the IPO’s database, it is safe to assume that protection was conferred either in the UK or EU. Although the representation provided does not actually show it, the second line of text apparently reads “CHUYEN Ca Phe

Nygon & Bahn Mi Gion” which translates as “specializing in delicious coffee & crisp bread”. The mark covers services in class 43.

- An International registration (no 1029530) owned by a company with an address in Vietnam, filed in 2009 with protection conferred in Australia (in 2011) and France and the Republic of Korea in 2011. As well as a figurative element, the mark includes text which reads “Hai Thien [in larger font than] Ngon do bi quyet, tot vi Chu Tam” which translates as “Recipe makes it delicious, carefulness makes it delightful”. The mark covers goods in class 30.
- What appears to be a German registration (3020140253720) for a figurative mark which includes the words PHO NGON. There is no translation of these words but based on the earlier evidence, it would appear to translate as “delicious pho” (pho being a type of food). The mark is registered in class 43 and was applied for in 2014.
- A trade mark (no 4120020022759) from the Republic of Korea for the words PHO NGON. Filed in 2011, its current status is listed as ended.
- A figurative mark (no 4120020022760) filed in the Republic of Korea which includes the words PHO NGON. Also filed in 2011 with the same status as above.

16. Annex 11 contains some further marks as follows:

- US application (78123204) (now abandoned) for a figurative mark containing the words NGON NGON which was filed in 2002. It was applied for in respect of goods in class 30.
- US application (86100768) (now abandoned) for the words NGON BISTRO which was filed in 2013. It was applied for in class 43.

17. Ms Bakosi states that the marks either have figurative elements or, where they are just for the word NGON (although there are none for the word alone), they were abandoned. Ms Bakosi speculates that the abandoned marks must have that status

due to refusals of registration. Ms Bakosi states that with the proprietor's mark currently being registered, it is able to rely on that mark to prevent parties from using the word NGON – she considers it unreasonable to allow one party to own exclusive trade mark rights in the word.

18. Ms Bakosi completes her evidence by stating that:

- i) A significant (and therefore material) portion of the average consumer in the relevant industry understands and appreciates the meaning of the word NGON as meaning delicious.
- ii) The proprietor's use will have helped educate the relevant public as to the meaning of this word.
- iii) That the proprietor's mark does not include a figurative element to give it distinctiveness, nor has it been used for it to acquire distinctiveness.

### **The proprietor's evidence**

19. This comes in the form of a witness statement and accompanying exhibits from Ms Lucy Marlow, Associate Solicitor at Waterfront Solicitors LLP. Her evidence is accompanied by observations in reply.

20. Evidence is given as to the proportion of people in the UK who are Vietnamese, or speak Vietnamese:

- LEM1 is an extract from the 2011 census showing that the population of England and Wales was over 56 million of which 29k were Vietnamese. Ms Marlow states that this equates to 0.05% of the population.
- LEM2 is an extract from the website Ethnologue relating to languages of the world. The population of the UK is given as 64 million (apparently a 2015 UNDESA figure) with Vietnamese being spoken by 15k people. Mr Marlow states that this equates to 0.02% of the population.



- LEM3 consist of prints from the website of Companies House of five companies which appeared in a search for NGON prior to October 2012 (the date on which the mark was filed). The names include the words: NGONYA, NGONGYAMA (x2), MGONG TEA and N GON. It is added that none of the companies are listed as operating in the restaurant field. There are others registered after that date.
- LEM4 is an extract from the European Trade Marks Database TM VIEW which shows only one UK trade mark incorporating the word NGON – the mark being that of the proprietor.

21. From the proprietor's observations in reply, I note the following:

- It is accepted that the applicant's evidence shows that NGON is a Vietnamese word that translates as tasty, luscious, succulent, savoury or delicious.
- But, the evidence does not show that the average consumer would understand the word.
- That having a potentially descriptive meaning in another (non-English) language does not give rise to refusing the registration. Reference is made to the *Matratzen* case to which I will return shortly.
- The Yahoo Answers evidence does not show any common meaning by the average consumer in the UK. It shows replies of five individuals and it is not clear if they are from the UK.
- The Tripadvisor reviews have been provided by only 1 person in the UK and relate to foodstuffs provided outside the UK. It is stated that the review relates to the goods provided not the actual service itself. Similar observations are made about the restaurant detailed in the travel website.
- That the evidence from the proprietor's own website references the food not the service. Such use is also after the filing date.

- That at the relevant date there were no other companies with NGON in their names or trade marks.
- Only a small proportion of the UK population speaks Vietnamese and are likely to understand the word NGON.
- Of the 81 restaurants identified by the applicant which contain the word NGON, only one is in the UK, that being the proprietor's restaurant. However, and as I noted earlier, also listed is the applicant's restaurant NGON NGON.

### **Decision – sections 3(1)(b) and (c)**

22. These two provisions prevent, respectively, registration of trade marks which are “..devoid of any distinctive character” or “..consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services”. The grounds can be relied upon to invalidate an existing registration given the provisions of section 47(1) of the Act.

23. Even if a mark falls foul of these grounds, there is a proviso to section 3(1) which means that a registration shall not be refused if the trade mark has acquired a distinctive character through use. However, as the proprietor has filed no evidence of use, this is not pertinent. I must simply determine whether the trade mark is, *prima facie*, objectionable under either section 3(1)(b) and/or (c).

24. It must be borne in mind that these grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(b) of the Act. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union (“CJEU”) stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those

grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

25. In terms of section 3(1)(c), this is the equivalent of Article 7(1)(c) of the Community Trade Mark Regulation, the case-law of which was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C- 191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, *inter alia*, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P)

[2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkuniei*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

26. In terms of section 3(1)(b), this is the equivalent of article 7(1)(b) of the Regulation, the principles of which were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product

in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

27. Given that this case revolves around the descriptiveness/distinctiveness of a non-English word, it is useful to record some of the specifically relevant case-law. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the CJEU held that the distinctive character of a trade mark must be assessed from the perspective of the relevant public in the territory in which registration is sought. That case related to the validity of the word MATRATZEN in Spain, a word which means "mattress" in German. The Court stated:

“25. It is possible that, because of linguistic, cultural, social and economic differences between the Member States, a trade mark which is devoid of distinctive character or descriptive of the goods or services concerned in one Member State is not so in another Member State (see, by way of analogy, concerning the misleading nature of a trade mark, Case C-313/94 Graffione [1996] ECR I-6039, paragraph 22).

26. Consequently, Article 3(1)(b) and (c) of the Directive does not preclude the registration in a Member State, as a national trade mark, of a term borrowed from the language of another Member State in which it is devoid of distinctive character or descriptive of the goods or services in respect of which registration is sought, unless the relevant parties in the Member State in which registration is sought are capable of identifying the meaning of the term.”

28. Helpful guidance was also provided by Ms Anna Carboni (sitting as the Appointed Person) in *Pooja Sweets & Savouries Ltd V Pooja Sweets Limited*, BL O-195-15. She held that where goods are targeted at the general public, the mere fact that they might be of greater interest to a particular sub-set of the relevant public did not justify narrowing the assessment of distinctiveness to just that sub-set of the relevant public:

“44. So the first step is to identify the relevant public. The specification for the Application in classes 29 and 30 lists a variety of mainstream foodstuffs, clearly aimed at the general public, as well as some which might be argued to be aimed at a more limited section of the public, in particular, “*Asian fruit, vegetables and savouries; ... cold savoury snacks (chaat); ... Bombay mix...*” in class 29 and “*spices; ... ice cream including kulfi; ...Asian sweets and confectionery; ... pita bread, naan bread, chapattis, poppadoms, parathas, unleavened bread, ...*” in class 30. There was no particular evidence in the case concerning this subset of the goods, and neither side argued for a different type of average consumer for such goods. Given the widespread availability of such foods in shops and restaurants in the United Kingdom, I think that it would be going too far to say that these foods are specifically targeted at the Asian population; and there is certainly no reason to find that they are aimed at a particular religious community, such as Hindus or Muslims.



45. As far as the services in classes 35 and 43 are concerned, these are all of a very general description (including, for example, “*retail services connected with food and drinks*” and “*restaurant, takeaway, café and bar services; catering services*”), save that the class 43 specification includes, “*services for the provision of fast foods including Asian foods*”. Once again, while one might expect that a higher proportion of people of Asian origin than those of non-Asian origin would be customers of outlets that sell fast Asian foods, there is no doubt that in this country such outlets are targeted at a wide range of non-Asians as well as Asians. Similarly, Asian fast food services cannot in general terms be said to be targeted at any particular religious community, even if a particular outlet might be so targeted, for example, because of where it happens to be situated.

46. It therefore seems to me that, for all the goods and services in issue, the descriptiveness objections have to be assessed in this case from the perspective of the average consumer, based on the public at large.

47. As I have mentioned above, the hearing officer made a finding later in the Decision that the average consumer would have no knowledge of the word “pooja”, let alone its meaning. Having reviewed the evidence, I agree. On that basis, it could not be said that either of the two marks comprised in the Application would currently be understood by the average consumer to refer to food, drink and services associated with pooja ceremonies.

48. The hearing officer referred to evidence in the case suggesting that the Hindu population of England and Wales was 1.2%, that poojas are regularly conducted by Hindus in the UK, and that Tooting itself regularly supplies foodstuffs for poojas. The question thus arises whether the descriptiveness objections should be maintained if it is the case that a small subset of the target public, comprising Hindus in the UK who are aware of the meaning of the word “pooja” and also aware of the kind of food, drink and services supplied for poojas by Tooting, would perceive the marks of the Application to be descriptive in respect of some of the goods and services.

49. As I understand the authorities, these circumstances would not be enough to block registration of the marks under sections 3(1)(b)/(c), since they would not meet the relevant test, which is to assess the situation by reference to the average consumer. An analogy can be drawn with other cases where the goods concerned are aimed at a specialist consumer in addition to the general public. So, for example, in 12.03.2008, T-341/06, *Compagnie générale de diététique*, ECLI:EU:T:2008:70 at §34, the General Court held that, even if it were the case that the specialist and professional public of restaurateurs would be aware that the word “garum” meant a particular type of fish sauce, this did not mean that an application to register GARUM as a trade mark for “fish” and “fish preserves” should be rejected on the grounds of being descriptive, since the average consumer would not assign any particular meaning to it.

50. This outcome also accords with the guidance given by the CJEU in *MATRATZEN* (09.03.2006, C-421/04, *Matratzen Concord v Hukla*, ECLI:EU:C:2006:164) to the effect that articles 3(1)(b) and (c) of the Directive do not preclude the registration in a particular EU Member State, as a national trade mark, of a term borrowed from the language of another Member State in which it is devoid of distinctive character or descriptive of the goods or services in respect of which registration is sought, unless the relevant parties in the Member State in which registration is sought are capable of identifying the meaning of the term.”

29. See also, to similar effect, the judgment of the General Court in *Aranynektar v OHIM*, Case T-503/15. Although in the context of whether there exists a likelihood of confusion, I also note what the CJEU stated in *Loutfi v AMJ Meatproducts NV and Another*, Case C-147/14:

“Article 9(1)(b) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that, in order to assess the likelihood of confusion that may exist between a Community trade mark and a sign which cover identical or similar goods and which both contain a dominant Arabic word in Latin and Arabic script, those words being visually similar, in circumstances where the relevant public for the Community trade

mark and for the sign at issue has a basic knowledge of written Arabic, the meaning and pronunciation of those words must be taken into account.”

30. The Court had earlier said this in relation to the relevant public:

“The determination of the relevant public and the finding of the identity or similarity of the goods and services covered by the Community trade marks and the sign considered, stem from the factual assessment that the national court must undertake. In the present case, the national court has found that the relevant public must be defined as being the public consisting of Muslim consumers of Arab origin who consume ‘halal’ food products in the European Union and who have at least a basic knowledge of written Arabic. In addition it has held, as is apparent from paragraph 12 of the present judgment, that the goods covered by the two Community marks and the sign considered are identical or at least similar.”

31. In the above case the goods were Halal foodstuffs, which the referring court held were mainly targeted at Muslim consumers. Therefore, where it is shown that the goods or services are mainly targeted at a particular section of the public in the UK, for example, by the use of foreign script, or the type of goods or services at issue, it is appropriate to take account of the perception of the trade marks amongst that section of the relevant public. I consider this to have some analogous merit in respect of section 3(1) cases such as the subject proceedings.

### **The relevant public**

32. The specification for the contested registration reads:

Services for providing food and drink; restaurant, bar and catering services; booking and reservation services for restaurants; takeaway services; information and advice in relation to all the aforesaid services.

33. There is nothing, on the face of it, which suggests that the services are targeted at a particular sub-section, such as people who are Vietnamese, or who are of

Vietnamese origin. It is clear, though, that the proprietor does operate a Vietnamese restaurant and it is likewise clear that Vietnamese restaurants would fall within the ambit of a number of the broad terms in the specification. However, there is no evidence to suggest that Vietnamese restaurants are targeted at people of Vietnamese origin. It is typical within the restaurant industry for restaurant to specialise in the cuisine of a particular country. But it does not follow that such restaurants target people of that particular ethnic background to any greater extent than it would target people of other origins. Ms Carboni stated this in relation to the services before her:

“Once again, while one might expect that a higher proportion of people of Asian origin than those of non-Asian origin would be customers of outlets that sell fast Asian foods, there is no doubt that in this country such outlets are targeted at a wide range of non-Asians as well as Asians. Similarly, Asian fast food services cannot in general terms be said to be targeted at any particular religious community, even if a particular outlet might be so targeted, for example, because of where it happens to be situated.”

34. Thus, the situation is not on a par with, say, the sale of Halal food or, another well-trodden example, the sale of Yashmaks<sup>1</sup>. The relevant public for the services at issue is, therefore, the general public in the UK.

### **Knowledge of the meaning of the word NGON**

35. The proprietor has filed evidence to show that the proportion of people in the UK who are Vietnamese or who speak Vietnamese is small. There is a difference in the figures provided from the two evidential sources (they are measuring slightly different things). However, whatever way one looks at it, this is strong evidence to support the proposition that the proportion of the UK public that will know the meaning of the word NGON is tiny. It would follow from such a finding that the average UK consumer for the services at issue will not know the meaning of the word NGON.

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<sup>1</sup> This is the example given in the IPO's Manual of Trade Marks Practice – see page 130

36. However, I also need to consider the evidence put forward by the applicant. The applicant suggests that the use made by the proprietor in connection with the name may have helped educate the public as to its meaning. I reject this submission. First, there is nothing to show that such use took place before the relevant date<sup>2</sup>. Second, the degree to which the proprietor has used its mark and the degree to which its manner of use will have educated members of the relevant public is not known – it would need to have been a very successful business for its marketing to have educated the general public in the UK as to the meaning of the word. Even if this was the case, the flip-side of that would have been that it would have simultaneously educated the public that the word NGON was, given the manner of use, a trade mark.

37. Whilst I accept that the rest of the applicant's evidence shows that the word NGON, as a matter of fact, means delicious or tasty in Vietnamese, I do not accept that the evidence shows that the meaning of the word NGON is known in the UK (other than by the tiny proportion of people who speak Vietnamese). The Tripadvisor reviews are mainly reviews of overseas restaurants posted by overseas users. The reviews in the magazine is similarity not UK orientated. That a reasonably large number of restaurants around the world may have NGON in their names does not assist because none (other than those of the parties) are in the UK. The various trade mark applications/registrations similarly prove nothing in terms of the knowledge of the word in the UK.

38. My finding is that only a tiny proportion of the general public will know of the meaning of the word NGON and, therefore, for average consumers of the services in the UK the word NGON is meaningless.

### **Application of facts to grounds**

39. I begin by observing that the discussion between the parties as to the registration of the mark YUM is not pertinent. The subject mark must be considered on its merits. Whilst bearing in mind that the grounds of invalidation have independent scope, my finding as to the lack of knowledge of the meaning of the word NGON means that the

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<sup>2</sup> The date on which the mark was filed – 2 October 2012.

grounds under section 3(1)b) and (c) fail. If the mark is meaningless then it will not be perceived as a description (section 3(1)(c)) and there is no reason why the mark will not perform the essential distinguishing function (section 3(1)(b)).

40. The applicant argues that it should be free to use the word NGON as part of its name, as has been done by the large number of restaurants shown in the evidence. Such an argument appears to be based on the need to keep free principle, a principle which underpins section 3(1)(c) of the Act. However, the underlying general interest is based upon the need to keep descriptive words free for the legitimate descriptive use (as opposed to trade mark use) of other traders. In circumstances where the services in question are not ethnically targeted, but where, instead, the relevant public is the general UK population, the need to keep free argument fails because legitimate descriptive use of the term is extremely unlikely due to the fact, put simply, that the relevant public will not know what the word means. This is exemplified by the fact that the proprietor, when using the word as a trade mark, went to the trouble of explaining what the word meant. The fact that there may be numerous restaurants using the word in their name around the world does not impact upon this finding.

41. In addition to all of the above, even for the tiny sub-set of the relevant public who may know of the meaning of the word (which according to Ms Carboni would not be enough to engage the grounds of invalidity – see para 49 of her decision), I agree with the proprietor that the word would relate more to food than the actual services in question. Thus, its capacity to be taken as a description of the service is lessened which, in turn, increases its capacity to perform the essential distinguishing function. This, together with the fact that the mark is a Vietnamese word, means that the grounds would even fail from that perspective also.

### **Outcome**

42. Both grounds of invalidation have failed. The mark may remain registered.

## **Costs**

43. The proprietor having been successful, it is entitled to a contribution towards its costs. My assessment is set out below:

*Preparing a counterstatement and considering the other side's statement of case - £300*

*Filing and considering evidence (and observations in reply) - £800*

**Total - £1100**

44. I order Ngon Ngon LLP to pay Ngon London Limited Co the sum of £1100 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 September 2016**

**Oliver Morris**

**For the Registrar,**

**The Comptroller-General**