

**O-222-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3140963  
BY DIDY'S LTD TO REGISTER A TRADE MARK IN CLASS 43**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 406407 BY TAHIR MAHMOOD MIRZA**

**AND**

**IN THE MATTER OF REGISTRATION NOS 2566282 AND 2566281  
IN CLASSES 16, 29, 30, 35 AND 43  
IN THE NAME OF TAHIR MAMOOD MIRZA**

**AND**

**APPLICATIONS FOR A DECLARATION OF INVALIDITY  
UNDER NOS 501251 AND 501265 BY DIDY'S LTD**

## **BACKGROUND AND PLEADINGS**

### **The opposition**

1. The first claim in these consolidated proceedings is an opposition to the registration of trade mark number 3140963 for the trade mark **JR JUST ROOSTERS**. The trade mark was applied for on 16 December 2015 by Didy's Ltd ("Didy's") for the following services:

Class 43: Services for providing food and drink; food preparation; food preparation services; preparing and serving food and drink for consumption on or off the premises; restaurants; restaurant services; restaurant services for the provision of fast-food; delicatessens; grill restaurants; carry-out restaurants; self-service restaurants; contract food services; catering; catering for the provision of food and drink; catering services for the provision of food and drink; cafeterias; catering in fast-food cafeterias; snack-bars; canteens; takeaway services; wine tasting services; bars; bar services; hospitality services [food and drink]; corporate hospitality (provision of food and drink); night club services [provision of food]; arranging of wedding receptions [food and drink]; consultancy services relating to food preparation; rental of food service equipment; provision of information relating to restaurants; temporary accommodation.

2. The application was published for opposition purposes on 22 January 2016. On 11 April 2016, Tahir Mamood Mirza filed a notice of opposition. The opposition is based on sections 5(2)(b) and 3(6) of the Trade Marks Act 1994 ("the Act") and is directed against all of the services in the application. Under s. 5(2)(b), Mr Mirza relies upon the following earlier trade marks:

(1) UK trade mark 2566282 (series of two) (“the device mark”):



(2) UK trade mark 2566281 (series of two) (“the word mark”):

**Roosters Piri Piri**

**ROOSTERS piri piri**

3. Both marks were filed on 2 December 2010 and have a registration date of 15 April 2011. In his opposition, Mr Mirza relies only upon the specifications in class 43, which are identical for both marks. However, for reasons which will become clear, I set out the specifications in full here. They are identical for both marks, except where highlighted in class 29:

Class 16: Menus; menu cards; printed menus; packaging materials of plastic, card and/or paper for use with food, foodstuffs, and/or food articles; packaging containers and/or cartons of card and/or paper; printed advertising and promotional materials; printed matter relating to food and services for the provision of food and drink.

Class 29: Chicken; chicken pieces; chicken food products, all being cooked; fried chicken; prepared meals containing [principally] chicken; cooked meat; prepared meals containing [principally] meat; salads including vegetable salads; prepared salads; prepared meals and/or ready meals in this class; french fries; chicken burgers; desserts in this class; cooked meals consisting principally of vegetables; cooked food products containing vegetables; prepared meals consisting principally of vegetables; edible oils for use in basting food products; dips(foodstuffs); chicken flavouring; prepared cooked foods and snacks included in class 29 including those prepared from/made of meat, poultry and vegetables and combinations of products thereof; all being goods used as

meals, constituents, parts or accompaniments of meals, ready meals and snack foods sold by restaurants, canteens and take-aways. (The final clause of 2566281 reads instead “all being goods used as meals, ready meals, snack foods and constituents, parts or accompaniments of meals, ready meals and snack foods sold by restaurants, canteens and take-aways”).

Class 30: Salt, mustard, pepper, vinegar; sauces in this class; salad dressings; spices in the form of powders; spice mixes; seasonings; seasoning mixes; mayonnaise; desserts in this class; marinades; ice cream; dips (foodstuffs); coffee drinks; tea based beverages; all being goods used as meals, ready meals, snack foods and constituents, parts or accompaniments of meals, ready meals and snack foods sold by restaurants, canteens and take-aways.

Class 35: Business advice, consultancy and information services relating to franchises and franchising; business advisory, consultancy and information services relating to the setting up and/or running of restaurants and/or take-away or fast-food outlets; advertising, promotional, publicity and marketing services; business management; business administration; office functions; commercial management advisory services; business advice and assistance; business consultancy; business information services; provision of business advice, consultancy and assistance in the establishment and operation of franchises; public relation services; services of a franchisor including advisory, assistance, consultancy and information relating to the administration and management of the business affairs of franchises; advice, consultancy and information services relating to the above.

Class 43: Restaurants, snack bars, cafeterias, road-houses, canteens, take-away or fast-food outlets; services for the provision of food and drink; the preparation and serving of food and drink products; catering; restaurant chains; central kitchen (food preparation) services; advice, consultancy and information relating to the above.

4. In his notice of opposition, Mr Mirza claims, under s. 5(2)(b), that the word “ROOSTERS” is the dominant and distinctive element in both earlier marks and that:

“the respective marks are similar from a visual, aural and conceptual perspective. Moreover, the application seeks protection in class 43 for services which are identical and similar to those of the Opponent’s earlier trademark [sic]. It is therefore submitted that the likelihood of confusion or association between the marks would exist”.

5. Under s. 3(6), Mr Mirza claims, in summary, that the applicant had previously been a franchisee for “the ‘Roosters piri piri brand’” and was, therefore, aware of the earlier marks and the opponent’s rights. He alleges that the application containing the word “Roosters” was made for identical services “to try and associate themselves with the mark and business of the Opponent and leverage off the name branding and intellectual property rights of the Opponent”.

6. Didy’s filed a counterstatement, in which it denies the basis of the opposition. In respect of the claim under s. 5(2)(b), it denies that the marks are visually, aurally or conceptually similar. It also denies that the word “ROOSTERS” is dominant in the earlier marks “as this is simply descriptive of the kind of food that is being sold in the Opponent’s outlets”. Regarding the claim under s. 3(6), Didy’s asserts that it “applied for its trade mark with the intention of protecting its own brand, and not in bad faith”. It denies that its application was made to associate its brand with the earlier marks and “suggests that such a link is unlikely considering the addition of the distinctive element “JR JUST” in the Applicant’s mark”.

### **The invalidations**

7. The second and third claims relate to the validity of Mr Mirza’s earlier marks, namely UK trade marks 2566282 and 2566281. The mark details are shown at paragraphs 2-3, above. On 4 July 2016, Didy’s filed applications for invalidation of both earlier marks

under the provisions of s. 47 and ss. 3(1)(b) and 3(1)(c) of the Act. The invalidations are directed against all of the goods and services in the registrations. The claims are similar for both marks and for both grounds. In summary, Didy's claims, under s. 3(1)(b), that:

- the marks are devoid of any distinctive character because they do not perform the distinguishing function of identifying the goods and services of one undertaking from those of other undertakings;
- "Roosters" and "piri piri" are descriptive and the marks are thus incapable of indicating trade origin. With regard to the device mark, the device "depicts what kind of animal the average consumer will eat when in a restaurant that cooks chicken".

8. In support of its ground under s. 3(1)(c), Didy's claims that:

- The marks are "wholly descriptive of the subject goods and services", because they designate "the "kind" of the products in the registration, that being cooked chicken made with hot chilli pepper sauce being sold in a restaurant";
- The device in 2566282 "merely reinforces the word elements "Roosters Piri Piri";
- "To allow the registration of such a non-distinctive and descriptive sign is highly likely to impede on other business' ability (primarily in the food and drink trade) to use this descriptive term to advertise or convey information about their goods or services" and would allow an unfair competitive advantage;
- Both marks are likely to be used in the future to describe the goods and services; the word mark is already being used in that way.

9. Mr Mirza filed counterstatements in both invalidations, in which he denies the basis of the invalidity actions.

10. Mr Mirza was initially represented by RevoMark but is now represented by Owen White Solicitors; Didy's have been represented throughout by Trade Mark Wizards. Both parties filed evidence. While neither party asked to be heard, both parties filed submissions in lieu of a hearing. I have read all of the papers carefully and will bear both parties' comments in mind, referring to them, as necessary, below.

## EVIDENCE

### Mr Mirza's evidence

11. This consists of three witness statements of Tahir Mamood Mirza. The first two witness statements are dated 25 October 2016 and each has 14 exhibits. One is headed for UKTM 2566282 and the other UKTM 2566281. The exhibits are almost identical for both statements, as is the evidence contained within the statements. The evidence is, therefore, summarised only to the extent that I consider necessary. Mr Mirza's statements also contain submissions, which I do not summarise here, though I have read them all and will keep them in mind.

12. Mr Mirza states that he is the registered proprietor of both UKTM 2566281 and 2566282, as well as being a director of RPP Franchise Limited (Company Number 08932923) ("Franchise"). He explains that Franchise is "a franchisor to the 'Roosters' franchise network which operates a business of fast food restaurants throughout the UK" and that Franchise uses the marks with his consent.<sup>1</sup> Mr Mirza states that Franchise operates "the 'Roosters' or 'Roosters Piri Piri' chain of fast food restaurants which are either franchisor owned stores or operated by a franchisee".<sup>2</sup> He indicates that there are currently (presumably, at the date of the witness statement) 35 restaurants in the UK.<sup>3</sup> A list of restaurant locations is provided at paragraph 12.

13. In addition, Mr Mirza states that food sales for "[Franchise] and its network of franchisees" were in excess of £14,000,000 in 2014-2015, rising to more than £15,000,000 in 2015-2016. Annual sales of drink exceeded £3,500,000 in each of those periods. In total, overall sales in 2014-2015 amounted to more than £17,800,000 and, in 2015-2016, over £18,900,000.<sup>4</sup>

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<sup>1</sup> Paragraph 1.

<sup>2</sup> Paragraph 3.

<sup>3</sup> Ibid.

<sup>4</sup> Paragraphs 8-10.

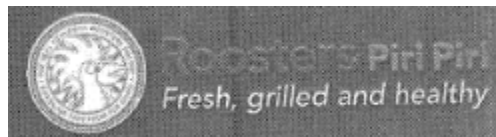
14. Mr Mirza indicates that Franchise spent approximately £150,000 on “the latest branding and designs for the marks”. He also gives details of the staff employed “to implement the branding across the network”. However, the period to which these statements relate is not clear. Mr Mirza claims that each Franchise restaurant spends approximately £5,000 per year on menu leaflets and advertising, and that Franchise spends around £15,000 on social media.<sup>5</sup>

15. At exhibit TM2 is a photograph of a shop front which bears the words “Roosters Piri Piri”. There is no device. The exhibit is not dated.

16. Exhibits TM3 and TM4 show copies of “the Roosters Piri Piri delivery menu” and another menu, respectively. The latter states that that it is the menu for the Portsmouth restaurant. Neither is dated. TM3 shows the mark in the following form:



The mark on the menu at TM4 is as follows:

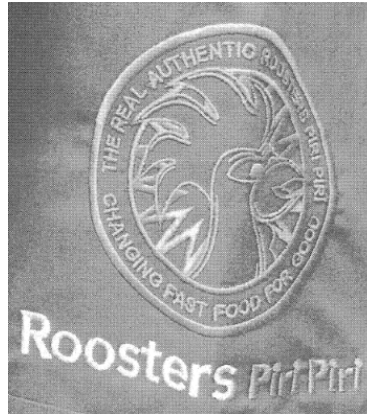


17. Exhibit TM5 shows undated images of staff uniforms. The words “Roosters Piri Piri” are visible on an apron (p. 2) and the following version of the mark, embroidered on a shirt, is shown at pp. 3-4:

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<sup>5</sup> Paragraph 11.





18. Exhibit TM6 is said to be copies of business cards and other branded stationery. None is dated. The only legible image is that showing the front and back faces of a business card (p. 1), which is reproduced below:



19. Exhibit TM7 is a screenshot of an email. The image is too poor to make out the exact device in use. I note that the email address is given as “@roosterspiripiri.com”. It is not dated.

20. Exhibit TM8 is a screenshot of the Roosters Piri Piri page from facebook.com. The words “Roosters Piri Piri” are visible. Above the words is a device which is not clear, though the stylised image of the bird appears to be the same as that in the device at TM6. The image is not dated.

21. Images of packaging and wrappers bearing the same mark as at TM6, above, are exhibited at TM10 and TM13. These include images of “samples of the Roosters Piri Piri drinks cup and chip bag” (TM10) and items such as a burger wrap and carrier bag (TM13). The bags in the latter exhibit also show the [www.roosterspiripiri.com](http://www.roosterspiripiri.com) website address. Neither exhibit is dated. I also note that TM11 includes a photograph of branded salt, pepper, mayonnaise and ketchup sachets. However, the image of the mark is not clear and the exhibit is not dated.

22. Exhibit TM12 consists of undated photographs of 3kg tubs of basting sauces which bear the word “ROOSTERS” on their label. It seems likely that these are for use in the opponent’s restaurants.

23. Exhibit TM14 consists of two screenshots from [just-eat.co.uk](http://just-eat.co.uk) and one from [deliveroo.co.uk](http://deliveroo.co.uk) for different “Roosters Piri Piri” restaurants. All have UK addresses but none of the screenshots is dated.

24. Mr Mirza filed a further witness statement, dated 12 January 2017, after having had sight of Didy’s evidence. It has no exhibits and contains only submissions. Although I take those submissions into account, I will not summarise them here but will refer to them as appropriate later in this decision.

### **Didy’s evidence**

25. Didy’s evidence consists of two witness statements of Indira Ramphul, the sole director and shareholder of Didy’s.<sup>6</sup> It is clear that Mrs Ramphul is the controlling mind of Didy’s.

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<sup>6</sup> Mrs Ramphul’s relationship with Didy’s is explained at paragraph 22 and annex 5 of her second witness statement (see below).

## Indira Ramphul's first statement

26. Mrs Ramphul's first witness statement is dated 15 November 2016 and is accompanied by 22 exhibits.

27. Mrs Ramphul exhibits at IR1 two dictionary definitions of the word "rooster". The most relevant are as follows:

Oxford Living Dictionaries: "North American: A male domestic fowl; a cock"; and

Merriam-Webster: "a: an adult male domestic chicken: cock"

28. Exhibit IR2 is a web print from Thesaurus.com for the term "rooster". Tabs underneath the term include one with the words "as in chicken". "Chicken" is not listed as a synonym, though "hen" and "poultry" are.

29. Exhibit IR3 is a print from Oxford Living Dictionaries which gives the definition of the term "piri-piri" as "Portuguese term for hot chilies or the hot sauce made from them".

30. Exhibit IR4 is a list of other UK trade marks which contain the word "rooster". None of the marks is the same as any of the marks in issue and, apart from their class number, specifications for the marks are not provided. The exhibit does not assist.

31. Exhibits IR5 to IR17 consist of prints showing websites for restaurants which have the word "rooster" or "roosters" in their name. Some also include a device. All appear to be UK websites and the majority of the restaurants are clearly in the UK (e.g. IR6 "Rooster House", in Birmingham, IR14 "Royal Rooster", in Poole). Mrs Ramphul also exhibits menus for most of these restaurants. While some appear to specialise in chicken (e.g. IR7, "ROOSTERS CHICKEN AND GRILL"), others have a range of foods on offer (e.g. IR5, IR9). None of the exhibits is dated, save for printing dates in November 2016.

32. Exhibit IR18 is a print of the “Roosters Piri Piri Aylesbury” web page. It includes references to “Roosters Rice and Piri Piri Fries” and “Piri Piri Wraps” and a claim that “[o]ver two decades we have worked with the industry specialist and culinary experts to refine our signature Piri Piri flavours”.

33. Exhibit IR19 is a franchise agreement between Roosters Piri Piri Limited (company number 7111558) (“Limited”), Didy’s and Mrs Ramphul. The agreement is not signed but Mrs Ramphul admits that her company was a franchisee of Limited.<sup>7</sup> She states that she entered into the franchise agreement “in early 2013” and that a restaurant was opened on 27 June 2013 but that “the franchisor-franchisee relationship between us and [Limited] came to an end in December 2013/January 2014”.<sup>8</sup> Mrs Ramphul states that she does not know the precise relationship between Limited and Mr Mirza but that “Mr Mirza was the person with whom I had most dealings regarding the franchise agreement”.<sup>9</sup>

34. Mrs Ramphul gives an account of how she coined the name “JR JUST ROOSTERS” following the breakdown of the franchise agreement. She states that “I chose the word ROOSTERS because I felt that it was a descriptive word that would confer to the public that I specialised in chicken: I am a chicken specialist and approximately 90% of my revenue comes from chicken”.<sup>10</sup> Mrs Ramphul says that “I was aware at that time that there were a large number of other restaurants that used the descriptive word ROOSTER(S) as part of their trading name. I therefore considered that [Limited] could not possibly have a monopoly over the word ROOSTER(S)”.<sup>11</sup> She adds, “I decided to add the word JUST to the beginning of my brand name to ensure that the public would be able to differentiate my restaurant from all those other restaurants using the word ROOSTERS, including those that were part of the ‘Roosters Piri Piri’ brand”.<sup>12</sup> Mrs Ramphul indicates that she specialises in “peri peri” style food but that she avoided

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<sup>7</sup> Paragraph 23.

<sup>8</sup> Paragraphs 24-25.

<sup>9</sup> Paragraph 23.

<sup>10</sup> Paragraph 28.

<sup>11</sup> Ibid.

<sup>12</sup> Paragraph 29.

using those words in her new brand name “to further reinforce the distinction between my restaurant and those that were part of the ‘Roosters Piri Piri’ brand”.<sup>13</sup>

35. At IR21 are prints taken from Didy’s website, showing use of the words “Just Roosters” in plain and stylised font. The prints are not dated.

36. Mrs Ramphul states that the sign at Didy’s premises “contains only the word ROOSTERS” but that the intention is to change this sign “as soon as possible and, importantly, as soon as the Applicant has funds sufficient to be able to do so”.<sup>14</sup> She exhibits at IR22 a chain of email correspondence, beginning in November 2014, regarding design approval and payment for a new sign. There are several emails from the sign writers in which they request payment of a deposit for the sign. The last email in the exhibit is dated 3 March 2015 and is from Indira Ramphul, where she states “I still have not changed the Roosters sign yet. When I am ready I will let you know” (p. 1).

37. According to Mrs Ramphul, her “local and regular” customers know her restaurant by the name “JUST ROOSTERS” or “JR”. There is, however, no evidence to support that assertion.

38. Mrs Ramphul provides information about the incorporation of a company on 28 August 2014 under the name “Just Roosters Piri Piri Ltd”. The explanation she provides for incorporating that company is:

“I was considering running the restaurant at the Premises through a new company, rather than continuing to run it through Didy’s Ltd. The reason for this was that following the breakdown in our relationship with [Limited], Mr Mirza and his colleagues had been orchestrating an aggressive smear campaign against Didy’s Ltd and we wanted to have a back up plan in case the actions of Mr Mirza et al damaged our reputation irreparably. We chose

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<sup>13</sup> Paragraph 31.

<sup>14</sup> Paragraph 32.

the name as we have invested a lot of money into the JUST ROOSTERS brand, and to reflect our trading name JUST ROOSTERS and the type of food we sold. In the event, we decided to weather the storm and to persevere with Didy's Ltd. Just Roosters Piri Piri Ltd never traded and as such it was dissolved on 26 January 2016 [...]"<sup>15</sup>

#### Indira Ramphul's second statement

39. Mrs Ramphul's second witness statement, dated 13 February 2017, was filed in response to the evidence submitted by Mr Mirza. It is accompanied by eight annexes.

40. Annex 1 contains information from Companies House about Limited. The web prints are not dated. A Tahir Khalid Mirza, with the same correspondence address as Mr Mirza, is listed as director. His date of appointment is also 23 December 2009. A Tahir Mahmood Mirza is also identified as a shareholder (p. 6). Mrs Ramphul indicates that she cannot be sure whether these individuals are Mr Mirza. It is however, probable that they are Mr Mirza, the other party to the proceedings.

41. Annex 2 consists of web prints from Companies House about Franchise, along with abbreviated accounts dated 31 March 2016. Mrs Ramphul states that these documents show that Mr Mirza is not recorded as a director of Franchise at Companies House. At p. 2, a Tahir Khalid Mirza, whose address corresponds to that of Mr Mirza, is listed as a resigned director of the company. The resignation date is 19 December 2016.

42. Annex 3 consists of information printed from the Companies House website about RPP Shirley Limited, which was dissolved on 12 May 2015. Mrs Ramphul does not explain why this company and Mr Mirza's possible connection to it are relevant to the instant proceedings.

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<sup>15</sup> Paragraph 35.

43. Annex 4 contains prints from the IPO website recording the assignment of trade marks 2566281 and 2566282 from Limited to Mr Mirza on 18 February 2013. Didy's has not called into question the validity of the assignment, so it is not clear why this evidence is relevant. Mrs Ramphul indicates that she is not aware of the details of any licence agreement and notes that no licence is recorded on the register. As it need not be recorded, this information does not assist either way.

44. Annex 5 consists of information from Companies House, showing Mrs Ramphul's connection to Didy's (see paragraph 25, above).

45. Annex 6 consists of prints from Companies House which show that a company called Just Roosters Limited was incorporated on 21 August 2014 and dissolved on 30 August 2016. Mrs Ramphul is listed as the sole director and shareholder. Annex 7 provides equivalent information about Just Roosters Piri Piri Limited. The company was incorporated on 28 August 2014 and dissolved on 26 January 2016. Mrs Ramphul is recorded as secretary, director and shareholder.

46. Mrs Ramphul states that she dissolved Just Roosters Piri Piri Limited because "by then the 'JR JUST ROOSTERS' brand was becoming established. I decided that I would either continue to operate that brand through [Didy's] or that I might operate it through [Just Roosters Limited]" and that "[a]t no point did I intend to operate using the brand 'JUST ROOSTERS PIRI PIRI'. I decided to rebrand as 'JUST ROOSTERS' shortly after the termination of the franchise agreement in early 2014, long before the incorporation of [Just Roosters Piri Piri Limited]".<sup>16</sup>

47. Mrs Ramphul submits that "a former franchisee of [Limited] in Swindon now trades as 'ROOSTERS GRILL SHACK'". She exhibits at annex 8 documents in support of this claim. These are a print from what appears to be the hungryhouse website for a restaurant in Swindon named "Roosters Grill Shack" and a page headed "Roosters Piri Piri- Swindon", which lists various other names by which the business is known.

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<sup>16</sup> Paragraph 36.

“Roosters Grill Shack” is among them. The final page of the exhibit is a web print from roosters-grill-shack.co.uk. This evidence does not assist Didy’s, as the use by another restaurant, not party to the proceedings, of the word “ROOSTERS” may or may not be legitimate and the exhibit sheds no light on that.

48. That concludes my summary of the evidence, insofar as I consider it necessary.

## **DECISION**

### **The applications for invalidation**

49. In a case such as this, it is appropriate to consider the applications for invalidation first. Both are based upon ss. 3(1)(b) and 3(1)(c), which read:

“3(1) The following shall not be registered –

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which 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,

(d) [...]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it”.



50. Section 47 also applies:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered”.

51. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union 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).”

52. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation and is identical to article 3(1)(b) of the Trade Marks Directive and s. 3(1)(b) of the Act) were conveniently summarised by the Court of Justice of the European Union (“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)".

53. The case law under s. 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) 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 Melkunie*, 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).

...

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]”.

54. Whether the question is one of distinctiveness or descriptiveness, the examination must be carried out through the perception of the relevant public. This includes both the average consumer of the goods and services and those in the trade. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the CJEU held that:

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50)”.

55. As I indicated, above, the invalidations are directed against all of the goods and services in the registrations, which are spread across five classes. Given the breadth of the specifications at issue, the relevant public will include both members of the general public and business to business users. Didy’s has focused in its evidence and

submissions on the goods in class 29 and services in class 43. If the marks do not designate a characteristic of the goods in class 29, it is difficult to see how the invalidations could succeed against the remaining goods and services in Mr Mirza's specifications. I will, therefore, focus initially on the goods in class 29, though I will keep in mind the other goods and services listed.

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56. Although registered as a series ("Roosters Piri Piri"/ "ROOSTERS piri piri"), the only difference between the marks is the use of upper and lower case, which has no effect on the distinctive character of the mark. For convenience, I will refer to the mark in the singular but my comments are applicable to both marks. Mr Mirza sensibly accepts that 'piri piri' is "a Portuguese term for hot chilies or the hot sauce made from them" and that it is "a descriptive term in relation to food items [...]".<sup>17</sup> Accordingly, the crux of the matter is whether "Roosters" also describes a characteristic of the goods and services and whether the mark as a whole is descriptive.

57. Mrs Ramphul's evidence shows that "rooster" is a term meaning an adult male chicken.<sup>18</sup> There cannot, I think, be any dispute about that. Didy's maintains that "the word 'ROOSTERS' is synonymous with the word 'CHICKEN'".<sup>19</sup> Its evidence showing synonyms of the word "roosters" is at exhibit IR2. I acknowledge that the different possible meanings of "roosters" are distinguished in that exhibit by the tabs "as in chicken", "as in poultry" and "as in fowl". I attach little weight to that reference, however, as "chicken" does not feature as a synonym of the word "roosters" in the list itself. It is also notable that the dictionary definitions provided at IR1 include definitions of the term "rooster" as "a cock" but not "chicken".

58. In addition, Mrs Ramphul's evidence at IR5 to IR17 shows information for restaurants which serve chicken. Although "rooster" or "roosters" may appear in their

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<sup>17</sup> Second witness statement, paragraph 6.

<sup>18</sup> IR1.

<sup>19</sup> Submissions dated 22 March 2017 ("Submissions II"), paragraph 40.



business name, nowhere does the evidence show that the word “rooster” is used to identify the meat being served: without exception, on their menus and in their business information, the restaurants refer to chicken, not rooster meat. This lends support to Mr Mirza’s submission that “ROOSTER is not the normal way of representing or referring to chicken meat”.<sup>20</sup>

59. I have considered exhibit IR18 which, according to Mrs Ramphul, shows descriptive use of the term “Roosters Rice”. The exhibit contains no context for the use of “Roosters Rice”, other than an indication that the dish is a starter. Without a clear indication of the goods on which the mark is being used, there is no way for me to determine whether this is descriptive use and I cannot agree with Mrs Ramphul’s assessment of this piece of evidence.

60. Taking into account all of the above, I am satisfied that the term “rooster” is not interchangeable with the word “chicken” and is not a direct description of the goods in class 29 of the specification, although I accept that it is allusive. The combination of the term “Rooster” with the descriptor “Piri Piri” does not, in my view, render the word “Rooster”, or the mark as a whole, descriptive. Bearing all of the evidence and submissions in mind, I am not persuaded that “Roosters Piri Piri” and “ROOSTERS piri piri” would be perceived by the relevant public as designating a characteristic of the goods in class 29.

61. Didy’s is in no better a position in relation to the other goods and services in the specification. The mark may be allusive in relation to some of the goods and services (for example, it may allude to the type of food which appears on menus in class 16 or which is served in restaurants covered by restaurant services in class 43) but it is not descriptive. I find that, in respect of UK mark number 2566281, the grounds in respect of s. 3(1)(c) fail in their entirety.

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<sup>20</sup> Submissions II, p. 5.

62. I have concentrated, so far, on s. 3(1)(c). In terms of the ground pleaded under s. 3(1)(b), the case law for which I set out earlier, I see no reason, absent a successful pleading under s. 3(1)(c), why the mark would be devoid of distinctive character. I note that Didy's has argued that it is in the public interest for the term "roosters" to be kept free for other traders to use because:

"To allow the registration of such a non-distinctive and descriptive sign is highly likely to impede on other business' ability (primarily in the food and drink trade) to use this descriptive term to advertise or convey information about their goods or services. Where there are a limited number of possible ways of describing one's goods or services, the provision of legal monopolies over such signs will enable one trader, to prevent other traders from using the term to refer to their goods or services in accordance with honest practices in industrial or commercial matters".<sup>21</sup>

63. It is evident that Didy's argument here is also predicated on the marks being descriptive. As Didy's has not advanced a materially different basis for the objection under s. 3(1)(b), it stands or falls with the objection under 3(1)(c) and my finding is that the ground under s. 3(1)(b) also fails.

64. I have noted Didy's claim that "there are other companies that use the word "ROOSTERS" in trade. Hence, this word is diluted meaning that the Registrant cannot monopolise or own this word".<sup>22</sup> In *Nude Brands Limited v Stella McCartney Limited, YSL Beauté Limited, L'Oréal (U.K. Limited)* [2009] EWHC 2154 (Ch), Floyd J said:

"29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly

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<sup>21</sup> Applications for invalidation, paragraphs 9 (501251) and 10 (501265)

<sup>22</sup> Submissions dated 15 November 2016 ("Submissions I"), paragraph 44.

does not go as far as establishing ground 7(1)(d) [corresponding to s. 3(1)(d) in the UK Act ]- customary indication in trade. Ground 7(1)(b) [s. 3(1)(b)] is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c) [s. 3(1)(c)]”.

65. The same considerations apply in the instant case. Although Didy’s has shown that other traders use “Roosters”, it is clearly being used as a brand name. That does not help Didy’s in establishing that the mark falls foul of either s. 3(1)(b) or s. 3(1)(c). Didy’s evidence also falls a long way short of establishing under s. 3(1)(d) (which, in any event, has not been pleaded) that “rooster” solus or in combination has become customary in the current language or in the *bona fide* and established practices of the trade.

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66. I now turn to the figurative mark, which is also registered as a series of two:



67. I found, above, that the words “Roosters Piri Piri” do not offend under either s. 3(1)(b) or s. 3(1)(c). Those findings also apply here and are unaffected by the marginally different specification. In this case, however, the contested mark has an additional element, namely the stylised representation of a cockerel’s head. The device in these marks is not a realistic representation but is an outline drawing with cartoonish characteristics, though it is certainly recognisable as a cockerel. Even if I considered that the device does no more than reinforce the message conveyed by the word “Roosters”, I have found the word, alone or in combination as “Roosters Piri Piri”, to be

distinctive in relation to the goods and services. The inclusion of the device does not make the marks as wholes descriptive of the goods and services at issue and the objection under s. 3(1)(c) fails accordingly. As with the word marks, Didy's has not advanced a materially different case under s. 3(1)(b) and I see no reason why the marks would be devoid of distinctive character, absent a successful pleading under s. 3(1)(c). The pleading under s. 3(1)(b) fails along with that under s. 3(1)(c).

68. Given my finding that the earlier marks do not offend under either s. 3(1)(b) or s. 3(1)(c) on a prima facie basis, there is no need for me to consider whether the marks have acquired distinctiveness under the proviso in s. 47(1). The earlier marks are valid and may be relied upon in the opposition against UK trade mark number 3140963. It is to that matter that I now turn.

### **The opposition**

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

69. I will first consider the opposition under s. 5(2)(b), which reads:

“5 (2) A trade mark shall not be registered if because -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

70. As neither trade mark had completed its registration process more than 5 years before the publication date of the application in suit, they are not subject to proof of use,

as per s. 6A of the Act. Mr Mirza can, as a consequence, rely upon all of the services he has identified.

71. 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of services**

72. At paragraph 22 of its written submissions dated 15 November 2016, Didy's states: "[w]ith regard to the services in Class 43, it is accepted that these services are identical/highly similar". Accordingly, I proceed on the basis that the services at issue are at least highly similar.

## The average consumer and the nature of the purchasing act

73. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' services. I must then decide 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”.

74. Didy's submits that “the Contested Services are used by ordinary members of the public at large. The degree of attention can be deemed average”.<sup>23</sup> Mr Mirza submits that the average consumer “will be any prospective consumer of prepared foods and drinks and fast food restaurant services. These are inexpensive high volume services and due regard must be had to the commercial realities of the market place, including the doctrine of imperfect recollection”.<sup>24</sup>

75. I agree that members of the general public will be one group of average consumer for the services at issue, though in the case of the bar services and wine tasting services in the application, that will be adults over 18. However, for some of the services for which registration is sought, such as corporate hospitality services and consultancy services relating to food preparation, the average consumer is likely to consist of

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<sup>23</sup> Submissions I, paragraph 9.

<sup>24</sup> Submissions, p. 2.

professional users. I also bear in mind that the average consumer for some of the applied-for services, such as catering services, will include both members of the general public and business users.

76. The services at issue are most likely to be selected following the visual inspection of websites, advertisements (online or in printed publications) and posters, as well as the signage of premises on the high street. For all of the services at issue, word-of-mouth recommendations may play a part. Consequently, while I recognise an oral component, I consider that the selection of all of the services at issue is likely to be dominated by visual considerations.

77. The average consumer's level of attention will vary across the category, depending on factors such as the type of food and drink provided, the cost of the service offered and the nature of the establishment/event. In relation to the food and drink services provided in restaurants (or other eating establishments) and bars, the member of the general public will, generally speaking, purchase the services with an average degree of attention. As regards services such as contract food services, catering services and (corporate) hospitality services, for both groups of average consumer, considerable sums are likely to be laid out and the quality and efficiency of the service are likely to be of concern. As a result, I consider that both groups of average consumer purchasing these services will pay a reasonably high, though not the highest, degree of attention to the selection of the service.

### **Comparison of trade marks**

78. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.



79. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.

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

81. Mr Mirza’s best case lies with the earlier word mark: if his opposition based on the word mark fails, he will be in no better a position with the composite mark, which is less similar to the mark applied for. Consequently, I will carry out my comparison based on the word mark, returning to the device mark if necessary.

82. The trade marks to be compared are as follows:

<b>Mr Mirza’s trade marks (series of two)</b>	<b>Didy’s trade mark</b>
Roosters Piri Piri  ROOSTERS piri piri	JR JUST ROOSTERS

83. Mr Mirza submits that “the element ROOSTERS is the dominant and distinctive component of each of the three trade marks”.<sup>25</sup> For its part, Didy’s submits that “there is no dominant element in either the Sign or the work [sic, presumably “word”] marks that would cause the average consumer to focus on one element of either” and adds that “if anything, the average consumer will focus on the letters ‘JR’ in the [application]”.<sup>26</sup>

84. The only difference between the two marks in Mr Mirza’s series of earlier marks is the differing use of upper and lower case. As fair and notional use would permit the use of either mark in upper or lower case, or a combination of upper and lower case, this difference is not relevant and I will refer to these marks in the singular.

85. In terms of the overall impressions, the earlier mark divides into the two elements “Roosters” and “piri piri”. As “piri piri” describes a type of food, the term has little or no inherent distinctiveness in relation to the services at issue. The word “Roosters” therefore plays the greatest role in the overall impression.

86. The mark applied for consists of the initials “JR” and the words “JUST ROOSTERS”, all presented in capital letters. “JUST ROOSTERS” will be seen as a phrase. Having said that, I consider that the word “ROOSTERS” is slightly more dominant in the overall impression, as the function of the word “JUST” is to qualify the word “ROOSTERS”. Although the letters “JR” are at the beginning of the mark, they reflect the initial letters of the words “JUST ROOSTERS” and play a weaker role.

87. There is some visual similarity between the marks, as both share the common element “Roosters”/“ROOSTERS”. However, the other elements in the marks are different. Bearing in mind my assessment of the overall impression, I consider that there is a medium degree of visual similarity between the marks.

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<sup>25</sup> Submissions, p. 2.

<sup>26</sup> Submissions II, paragraphs 20(b)-20(c).

88. In terms of aural similarity, Mr Mirza submits that “it is by reference to the common dominant and distinctive component ROOSTERS that these trade marks would be recollected, referred to and recommended by consumers orally”.<sup>27</sup> Didy’s submits that the marks are aurally dissimilar and that:

“the alliterative nature of the first two ‘words’ in the Sign [is] more significant: aurally, the Sign may even be perceived to consist of two separate initials, ‘J’ and ‘R’ followed by the words ‘JUST’ and ‘ROOSTERS’, potentially indicating that the initials refer to those words and leading the average consumer to perceive it as four separate words”.<sup>28</sup>

89. Mr Mirza’s mark will be spoken as it is written, with each of the three words “Roosters Piri Piri” being articulated. As far as Didy’s mark is concerned, the words “JUST ROOSTERS” will be articulated. Some average consumers will verbalise the letters “JR” but, given their weak role in the overall impression and the fact that they are the initial letters of the words “JUST ROOSTERS”, it is also likely that some average consumers will not articulate them. There is a degree of similarity because of the identical word “Roosters”/“ROOSTERS”, although I take account of its differing position in the marks. The other elements in the marks are not similar, particularly given the contrasting soft “P” and hard “J” sounds, respectively. I consider that, if the average consumer pronounces the application in full as “JR JUST ROOSTERS”, the marks are aurally similar to a low degree. That would be elevated to a medium degree of similarity for those average consumers who articulate the mark as “JUST ROOSTERS”.

90. Conceptually, both marks evoke the image of roosters. As I have already indicated, “piri piri” in the earlier mark is likely to be taken as descriptive for the vast majority of the services at issue and will be given little or no trade mark significance. Didy’s has not claimed that the initials “JR” in the application have any particular meaning and I am not aware of one. The word “JUST” is likely to be understood as meaning “only” and as

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<sup>27</sup> Submissions, p. 3.

<sup>28</sup> Submissions II, paragraph 20(o)

such does not create a separate concept but rather reinforces the concept of “ROOSTERS”. The marks are conceptually similar to a reasonably high degree.

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

91. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, 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-2779, 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)".

92. Registered trade marks possess varying degrees of distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the services, to those with high inherent distinctive character, such as invented words which have no allusive qualities (KODAK is the paradigm example). Mr Mirza has claimed that the earlier mark is highly distinctive either per se or because of the use which has been made of it.<sup>29</sup>

93. I found, at paragraphs 60-61 of this decision, that the term "roosters" is allusive of the food sold in Mr Mirza's establishments (or those of his licensees), though it is not descriptive. The parties agree that "piri piri" is a type of hot chilli sauce. Accordingly, I consider that the earlier mark is possessed of a lower than average degree of inherent distinctive character.

94. That leads to the use that has been made of the mark. The material date for the assessment is the filing date of the application, namely 16 December 2015. Mr Mirza states that the mark was first used in the UK in 2010.<sup>30</sup> There is very little evidence showing use of the word mark alone. Having said that, given the presence of the words "Roosters Piri Piri" with the device, I am satisfied that the benefit of that use would have accrued to the use of the words "Roosters Piri Piri" alone. However, none of the evidence is dated.

95. Mr Mirza gives "annual revenue" figures for food and drink in the year 2014-2015 at over £17.5m and, in 2015-2016, in excess of £18.9m.<sup>31</sup> Although it is not clear what the exact figures were at the relevant date, the two years' figures point to a reasonably

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<sup>29</sup> Submissions II, p. 3.

<sup>30</sup> Paragraph 6.

<sup>31</sup> Paragraph 10.

consistent turnover and it is likely that a significant proportion of the 2015-2016 sales were made in the period prior to December 2015. Mr Mirza gives details of 31 restaurant locations in the UK.<sup>32</sup> They are concentrated in London and the south-east of England but I note that there are some restaurants further afield, namely Nottingham, Southampton, Portsmouth and Seaham. TM4 contains a Portsmouth restaurant menu and TM14 (p. 2) gives details of the Southampton restaurant.

96. Mr Mirza states that each restaurant spends approximately £5,000 per year on “menu leaflets, newspaper advertising and local TV advertising” and that Franchise spends £15,000 on social media each year.<sup>33</sup> Apart from an undated Facebook page,<sup>34</sup> there is no evidence to show the nature of the advertising or social media activity. There is no evidence of advertising on a national scale, either in national newspapers or on the main national network channels. Although Mr Mirza has given evidence about the cost of rebranding, that in itself does not show whether or to what extent the average consumer has been exposed to the mark.

97. I am mindful that the relevant perspective in determining whether the mark has enhanced its distinctiveness through use is that of the average consumer in the UK. Taken from that perspective, and whilst accepting that the mark has been used, I come to the conclusion that, despite turnover figures which are not insignificant, the local nature of the use and the low level of advertising spend (which does not appear to have been national in its scope), will not have enhanced the degree of distinctiveness to any material extent.

### **Likelihood of confusion**

98. Determining whether there is a likelihood of confusion is not scientific but involves a global assessment of a number of factors, bearing in mind the interdependence between them (*Canon* at [17]). It is a matter of considering all of the relevant factors

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<sup>32</sup> Paragraph 12.

<sup>33</sup> Paragraph 11.

<sup>34</sup> Exhibit TM8

from the point of view of the average consumer and deciding whether he is likely to be confused. In making my decision, I must keep in mind 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 (*Lloyd Schuhfabrik* at [26]).

99. Confusion can be direct (where the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). Indirect confusion was explained by Iain Purvis, Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*, Case BL-O/375/10, where he stated that:

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

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but

the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

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

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

100. Whilst keeping in mind the similarity between the marks as a result of the shared word “ROOSTERS”/“Roosters”, I consider that the additional elements in the application will be recalled or remembered by the consumer. Consequently, when the marks are taken in their totality, I do not think it likely that the average consumer will directly confuse the marks, even when the effects of imperfect recollection are taken into account. However, in terms of indirect confusion, the word “Roosters” is the most memorable element of the earlier mark, where it plays an independent distinctive role. Although that word has a lower than average degree of inherent distinctive character, it is not possessed of the very lowest level of distinctiveness. That memorable element of the earlier mark is replicated in a part of the application which also plays a dominant role (the words “JUST ROOSTERS”). I remind myself that the services are at least highly similar and that they will be selected with an average or reasonably high degree of attention. Whilst I bear in mind that the average consumer will encounter the marks in their totalities, I consider that the combined effect of the common presence of the word “Roosters”/“ROOSTERS” will signal to the average consumer that the undertakings responsible for the services are the same or economically linked. That gives rise to a likelihood of indirect confusion.



101. I note that Didy's has filed evidence of other companies using the word "roosters" in their business names. Use by other traders of similar brand names does not, of itself, mean that there is no likelihood of confusion between two specific marks. The nature of the services at issue is that they are likely to be offered by individual undertakings in one locality. That is borne out by Didy's evidence, which shows twelve restaurants that appear to be single undertakings scattered throughout the country. The evidence does not establish that the average consumer will have been exposed to sufficient use of different marks containing the word "roosters", or with sufficient frequency, to disturb the finding I have made, above.

### **Other grounds**

102. The opposition having succeeded with the word mark, it is not necessary for me to consider the opposition based on the device mark. I will comment only briefly on the ground under s. 3(6) of the Act ("bad faith"), the relevant provision for which states:

"(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith".

103. The law in relation to s. 3(6) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

"130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07

*Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal,

29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

“41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be

determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)'''.

104. Didy's evidence shows that it entered into a short-lived franchise agreement with Limited in 2013. Mrs Ramphul also states in her evidence that Mr Mirza was the principal person with whom she dealt regarding the franchise agreement. I note that Didy's evidence casts doubt on the position of Mr Mirza within Franchise but he is clearly the owner of the earlier marks and his evidence that the marks were used under licence has not been seriously challenged. Moreover, the question of whether Didy's application constitutes an act of bad faith is independent of Mr Mirza's standing with the franchisor.

105. Mrs Ramphul would clearly have been aware of the use of the earlier marks. Although she asserts in her evidence a desire to distance her company from that of her

former franchisor, that claim is undermined by the admission in her statement of 15 November 2016 that her restaurant's signage had still not been changed, despite the franchise agreement having been terminated almost two years previously.<sup>35</sup> The incorporation of a company which contains the entire word mark used by the opponent casts further doubt on the stated intention to create distance between the two parties. The application, after the parties had fallen out, for a trade mark which features prominently the word "ROOSTERS" would be regarded as an act of bad faith. The opposition under s. 3(6) succeeds.

## **Conclusion**

106. The opposition has been successful and, subject to appeal, the application will be refused.

## **Costs**

107. Mr Mirza has been successful in all three actions and is entitled to a contribution towards his costs. Although separate evidence was filed for each invalidation, the proceedings had already been consolidated and this duplication was neither necessary nor helpful. I also take into account that the counterstatements in the invalidations were identical. The relevant guidance for awards of costs is Annex A of Tribunal Practice Notice ("TPN") 4 of 2007. Using that TPN as a guide but bearing in mind my comments, above, I award costs to Mr Mirza on the following basis:

Official fees:	£200
Preparing and considering the notice of opposition and counterstatements (x3):	£400
Preparing and considering evidence:	£500

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<sup>35</sup> Paragraph 32; paragraph 25.

Written submissions: £300

Total: £1400

108. I order Didy's Ltd to pay Tahir Mamood Mirza the sum of **£1400**. This sum is 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 11<sup>TH</sup> day of May 2017**

**Heather Harrison  
For the Registrar  
The Comptroller-General**