

O-269-17

TRADE MARKS ACT 1994

**IN THE MATTER OF THE REQUEST FOR PROTECTION IN THE UK
OF INTERNATIONAL REGISTRATION NO. 1192322
BY TOBY'S ESTATE COFFEE (ASIA) PTE. LTD.**

FOR THE TRADE MARK

TOBY'S ESTATE

IN CLASSES 30 AND 43

AND

**THE OPPOSITION THERETO UNDER NUMBER 402611
BY
OLD KENTUCKY RESTAURANTS LIMITED**

Background

1. Toby's Estate Coffee (Asia) PTE. Ltd. ("the holder") is the holder of international trade mark registration number 1192322, TOBY'S ESTATE. The holder requested protection in the UK for its international registration ("IR") on 20 December 2013 (claiming a priority date of 25 November 2013 from Singapore) for the following goods and services:

Class 30: *Coffee, tea, chocolate and chocolate drinking beverages, chocolate-coated coffee beans.*

Class 43: *Tea room services; coffee shop services for serving coffee and accompanying snacks such as biscuits, packaged nuts and dried fruit, snack bars, chocolate bars, cake, fresh bakery products and sandwiches; coffee bar services; mobile café services for providing tea and coffee-based beverages and accompanying snacks such as biscuits, packaged nuts and dried fruit, snack bars, chocolate bars, cake, fresh bakery products and sandwiches; provision of tea and coffee-based beverages and accompanying snacks such as biscuits, packaged nuts and dried fruit, snack bars, chocolate bars, cake, fresh bakery products and sandwiches prepared for consumption from kiosks.*

2. The IR was accepted and published in the *Trade Marks Journal* for opposition purposes¹ on 2 May 2014. Old Kentucky Restaurants Limited ("the opponent") opposes the IR under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act ("the Act"). For sections 5(2)(b) and 5(3), the opponent relies upon the following earlier trade mark registrations:

¹ In accordance with The Trade Marks (International Registration) Order 2008.

(i) 1291064

TOBY

Class 43: *Restaurant, public house, bar and canteen services.*

Filing date: 20 October 1986; date registration procedure completed: 18 August 1989.

(ii) 2123617 (series of two marks)



Class 29: *Meat, fish, poultry and game products; preserved fruits and vegetables; jams; pickles; desserts; prepared meals; snack foods.*

Class 30: *Coffee, tea, cocoa and coffee, tea and cocoa beverages; sugar; bread; confectionery; condiments; desserts; ices; prepared meals; snack foods and puddings; biscuits and cakes.*

Class 43: *Public house services, bar services, cafe services, restaurant services, catering services for the provision of food and drink.*

Filing date: 13 February 1997; date registration procedure completed: 19 March 1999. This mark has a status of expired. Renewal of the registration was due on 13 February 2017. Section 6(3) of the Act (which applies to IRs, by virtue of The Trade Marks (International Registration) Order 2008), states that an earlier mark

“...whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.”

(iii) 2107456

TOBY CARVERY

Class 42: *Public house services; bar services; cafe services; restaurant and catering services; catering services for the provision of food and drink.*

Filing date: 12 August 1996; date registration procedure completed: 7 March 1997.

(iv) 1013366

Toby's TakeAway

Class 29: *Meat; fish, poultry and game, none being live; preserved, dried or cooked fruits and vegetables; and pickles.*

Class 30: *Coffee; mixtures of coffee and chicory, coffee essences and coffee extracts; chicory and chicory mixtures, all for use as substitutes for coffee; tea, cocoa; bread, biscuits (other than biscuits for animals), cakes, pastry and non-medicated confectionery; and ices.*

Filing date: 27 June 1973; date registration procedure completed: 18 July 1975.

This registration is subject to a disclaimer in respect of 'TakeAway'.

3. The opponent claims under section 5(2)(b) that there exists a likelihood of confusion owing to the similarities/identity between the marks and the goods/services. Under section 5(3) of the Act, the opponent claims that the earlier marks have a reputation in the goods and services relied upon, as set out above,

such that use of the IR would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier marks.

4. The opponent's claim under section 5(4)(a) of the Act is based upon use of the sign TOBY, since 1980, throughout the UK, in relation the goods and services set out above. The opponent claims that the use of the IR would constitute a misrepresentation and damage to its goodwill and use is therefore liable to be prevented under the law of passing off.

5. The opponent's earlier trade mark registrations had been registered for more than five years on the date on which the opposed IR was published. They are therefore subject to proof of genuine use under section 6A of the Act. The relevant period for proof of use is the five years ending on the date on which the IR was published in the UK for opposition purposes; i.e. 3 May 2009 to 2 May 2014. The holder, in its counterstatement, requests that the opponent's claim to have made genuine use of its marks is made good. The IR denies all the grounds of opposition.

6. Both parties are professionally represented and have filed evidence. The matter came to be heard on 6 March 2017, by video conference. Mr Jonathan Moss, of Counsel, instructed by Nucleus IP Limited, represented the opponent. Mr Martin Krause, of Haseltine Lake LLP, represented the holder.

Evidence

7. The opponent's evidence comes from Steven Brookes, who is the Company Solicitor at Mitchells & Butlers PLC ("M&B"). The opponent is part of the M&B group of companies. Mr Brookes refers to the opponent's marks in his evidence as 'TOBY'.

8. Mr Brookes states that the TOBY brand was launched in 1985 and was developed from the TOBY GRILL RESTAURANT of the early 1980s. Mr Brookes' witness statement is dated 17 May 2016; he states that, as of this date, there were 173 branches in Great Britain. Other statistics about TOBY are given:

- 461,000 followers on Facebook
- 24,500 followers on Twitter
- 1.2 million email subscribers to its marketing database
- Serves 39 million drinks annually
- Serves 26 million meals annually
- At Christmas, serves 500,000 turkey meals and uses 500,000 beef joints.

9. Mr Brookes describes Exhibit SB1 as comprising extracts from the M&B website. The exhibit also contains an internal email, dated 16 May 2016, detailing some 'key facts', which match some of those given by Mr Brookes (whose statement is dated the day after the email). Other facts are:

- TOBY pubs and restaurants are open from 7am to 11pm serving breakfast, take away coffee, coffee and cake, lunch and dinner.
- Each restaurant serves on average 3300 meals a week, with about a quarter of all meals being sold on Sundays.
- Breakfast 'now' accounts for approximately 15% of all meals.
- The Toby App was launched on 21 January 2016 and has 80k downloads.
- Toby Carveries are predominantly located in suburban locations on commuter routes with good roadside presence.
- Toby Carvery had 72% awareness in 2015 and was listed as the 19th most recognised brand: Coffe Peach Business Tracker².
- The brand promise is 'Home of the Roast'.
- The marketing budget for 2016 to 2017 was £2.4million, the same as for the previous financial year.

10. One of the M&B website prints refers to 'Toby Carvery' being the 'Home of the Roast' and refers to Toby as being one of Britain's best loved carvery brands. Another gives details of a 'Toby Carvery Sandwich Express' in Cardiff, the second such branch.

² Page 10 of Exhibit SB1 describes this entity as an industry sales monitor for the UK pub and restaurant sector.

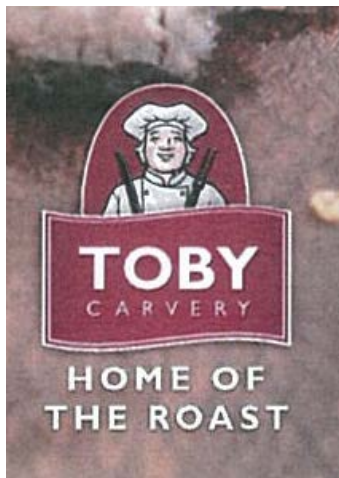
11. Annual marketing spend has been between 2 and 3 million pounds per year, with turnover figures as follows:

2012	£213,416,000
2011	£198,289,000
2010	£195,092,000
2009	£196,698,000
2008	£190,521,000
2007	£178,255,000

12. Exhibit SB2 consists of pages from www.tobycarvery.co.uk. The first few pages are from the website as it was in April 2016, which is after the relevant dates for these proceedings. These pages refer almost entirely to roast dinners, with some references to all-you-can-eat breakfasts. The remaining pages in the exhibit are from the internet archive, the Wayback machine; Mr Brookes states that these prove use of the various TOBY brand identities and demonstrate the evolution of the TOBY logo over the relevant period.

13. I note that these pages show use of a composite mark which is comparable to the composite mark relied upon, except that the mark used has the words TOBY CARVERY on the banner, rather than just the word TOBY, and that “A Slice of British Tradition” is not present in the mark as used. The use focuses on roasts/carveries, but does also mention the choice of a variety of starters, puddings and specials, such as curries. The home page, at various dates in 2010 and 2011, says “Welcome to Toby Carvery”. The tabs at the top of the website include “Find a Toby” and textual references to the restaurants and the food use both “Toby Carvery” and “Toby”. In 2012, the tabs at the top of the home page include “Breakfast” and the home page, as it appeared on 12 March 2012, included an offer for two breakfasts for £6.00. The home page in July 2013 included a salad offer, and in August 2013 an offer for a sandwich and a drink for £4.99. The home page in April 2013 included “1p off your pint”. In 2014, the composite mark in use appears to

have changed so that the device of a man is a chef, rather than an eighteenth century diner, and the other elements of the mark are less 'busy':



14. Exhibit SB3 comprises prints from the menu and drinks section of the website. They are not dated and have not been downloaded from the internet archive. Two of the pages include an introduction to the new Toby App, which Mr Brookes states was introduced in January 2016. These pages therefore date from at least January 2016, which is after the relevant date. The first page of the exhibit is the breakfast menu, with an option for adding unlimited tea and coffee for £1. Mr Brookes states:

“Coffee is an integral part of TOBY. As part of its breakfast offering coffee is available on an unlimited basis for a set charge and at other times of day on a standalone basis, or alongside lunch, dinner, snacks, cake, or afternoon tea.”

15. Mr Brookes states that, since 2014, TOBY has been engaged in developing a strategy with Lavazza to expand its sales of takeaway coffee, including a trial at 19 TOBY venues. Exhibit SB6 includes a copy of a redacted internal memo regarding the 'Coffee Project' across M&B. It is undated, so appears to be a draft. This exhibit includes a page giving details of the 'go live' dates at the 19 venues. It is undated. Six venues in Essex are shown as 'live', whilst the remaining thirteen venues (in the South East and North of England) have 'go live' dates of 6 May 2016 and 13 May 2016. A print from the website shows the updated 'chef' version of the TOBY logo.

16. Mr Brookes states that the public have become accustomed to using TOBY and TOBY CARVERY interchangeably, with users of Twitter and other review websites referring to having eaten at a 'TOBY'. To support this statement, Mr Brookes exhibits prints from TripAdvisor and Twitter (Exhibits SB5 and SB6). The TripAdvisor reviews refer to the carvery, breakfasts and the quality of the beerkeeping. Most do not refer to TOBY or TOBY CARVERY but, of those that do, both are mentioned. It is fair to say that of the comments which are dated within the relevant period, there are more bad reviews than good. The Twitter comments date from 2015 and 2016, after the relevant period.

17. Mr Brookes states that TOBY offers are frequently advertised in national and local press. Some examples are included in Exhibit SB7. The only example which falls within the relevant dates is an offer for free ice cream in 2011, in the Edinburgh Press. There are three pages in this exhibit which are undated and unexplained (pages 266 to 268), one of which contains a reference to coffee and cake. However, I infer that these pages date from summer 2016 because the first one refers to the Toby App, which was not launched until January 2016, and they all refer to summer specials. They also show the updated 'chef' logo.

18. The holder's evidence comes from Robert Tanna, its Chief Operating Officer, and from Jane More O'Ferrall, the holder's trade mark attorney.

19. Mr Tanna states that the holder's trade mark was coined because the founder of the business was named Toby Smith and 'estate' is a word which indicates a domain or area of land, often in the context of crop cultivation. The remainder of Mr Tanna's evidence is not relevant because it concerns the holder's activities outside of the UK.

20. Mr Krause did not refer, at the hearing, to any of the holder's evidence. Ms More O'Ferrall's evidence consists of the following:

- Prints from the website of the top eighteen brands shown in the Coffey Peach Business Tracker evidence supplied by the opponent.
- A list of M&B's brands.

- A print from M&B's 2015 Annual Report which refers to M&B's brands.
- Prints from various websites which give information about leading restaurant chains in the UK.
- Prints from three online dictionaries which give definitions for 'estate'.
- Prints listing the popularity of boys' names in the UK in 2012 and 2013 (Toby is 49th).
- Prints from websites giving information about –
 - Toby's Restaurant, Winslow, Bucks
 - The Toby Inn, Bolton
 - Toby Cottage Restaurant, Woking, Surrey
 - Toby's Baguettes, Watford
 - Toby's Fish & Chip Shop, Kirkaldy, Fife
 - The Royal Toby, Rochdale
 - Toby's Tea Room, Bradford
 - Toby's Fish & Chips, Hull
 - Toby's Curry House, Sheffield
 - Toby Indian Restaurant and Take-away, Birmingham.

21. Ms More O'Ferrall's witness statement simply refers to the exhibit without explaining their relevance or what they are meant to show. The opponent complained and the holder was directed to file a supplementary witness statement explaining the relevance of the evidence in order that the opponent could decide whether it wished to reply to any of it. Ms More O'Ferrall filed a brief supplementary witness statement. This did not take matters much further with respect to the M&B evidence, but it was explained that the evidence was meant to show that Toby is not an unusual given name for males in the UK and that there are third party businesses providing food and drink which trade under names which include 'Toby'. The opponent chose not to file evidence in reply.

Decision

Proof of use

22. Section 6A of the Act states:

“(1) This section applies where—

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

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

(3) The use conditions are met if—

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes—

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

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

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

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

(7) Nothing in this section affects—

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

23. The enquiry under section 6A of the Act is identical to that set out under section 46, the part of the Act which deals with the issue of revocation on the grounds of non-use, because both sections 6A and 46 cover genuine use of a mark. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07

Silberquelle GmbH v Maselli-Strickmode GmbH [2009] ECR I-2759 (to which I added references to Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

[218] ...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the

import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

24. Section 100 of the Act states:

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

25. This means that the evidence adduced by the opponent is crucial. In *Plymouth Life Centre, O/236/13* Mr Daniel Alexander QC, sitting as the appointed person, observed that:

“20. Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time to review the material that it has to prove use of it.

...

The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the

proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

26. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller-General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or

services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

27. The relevant dates for proving use are 3 May 2009 to 2 May 2014. Considering the size of its turnover and the length of time the opponent has operated, it is surprising that much of its evidence consists of pages from its website, many of which post-date the relevant dates, and current statistics (Mr Brooks’ witness statement post-dates the IR’s publication date by two years). It is important to remember that an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself³. However, the press exhibits are all far too late to be taken into account, other than the Edinburgh example, from 2011, for free ice cream. The coffee and cake page is from 2016 (and shows the ‘chef’) logo. This exhibit cannot be said to show use of any of the marks for coffee and/or cake. The plans to expand takeaway coffee sales with Lavazza did not commence until 2014 and did not ‘go live’ until 2016. This evidence does not assist in showing use on coffee or the provision of coffee as a discrete takeaway offering during the relevant period (also, it is the updated chef logo which is used).

28. The holder concedes that the opponent has made genuine use of its mark TOBY CARVERY in relation to carvery services. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, stated:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

³ Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (“OHIM”) General Court (“GC”).

29. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation

to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

30. The evidence shows that, in addition to the actual carvery services, the opponent has used TOBY CARVERY in relation to the provision of other types of food, such as starters, puddings, salads, sandwiches and curries. Customers at a TOBY CARVERY during the relevant period were also able to purchase beer from a bar. Furthermore, there is evidence that breakfasts were provided during the relevant period. Applying the guidance from the above authorities, I find that the opponent has shown genuine use of TOBY CARVERY in relation to *public house services; bar services; restaurant services*. However, there is no use on ‘café services’, nor on catering services, the meaning of which, to the average consumer, is the provision of bespoke food and drink for a particular event or occasion.

31. There is also use by the opponent (and by reviewers, colloquially) of TOBY, as a single word; I find that the opponent may rely upon its TOBY registration (1291064) in relation to *restaurant, public house and bar services*, but not in relation to ‘canteen services’. Canteens are, typically, food service locations within offices, schools or other institutions, usually self-service. There is no evidence of such services being provided under the mark TOBY.

32. In relation to the composite TOBY mark, with the device of an eighteenth century diner, I bear in mind the following authorities which give guidance when considering use of variant marks. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act, which mirrors that of section 6A(4), as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

33. In *Hypen GmbH v EU IPO*, Case T-146/15, the General Court ("GC") held that use of the mark shown on the left below constituted use of the registered mark shown on the right. The court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered.



34. The court set out the following approach to the assessment of whether additional components are likely to alter the form of the registered mark to a material extent.

"28. ..a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, *ATLAS TRANSPORT*, T-482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, *Maestro de Oliva*, T-4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, *Borrajo Canelo v OHIM — Tecnoazúcar (PALMA MULATA)*, T-381/12, not published, EU:T:2014:119, paragraph 30).

29 For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, *Klement v OHIM — Bullerjan (Form of an oven)*, T-317/14, not published, EU:T:2015:689, paragraph 33).

30 It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, *Sabores de Navarra v OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA)*, T-46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31 It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, *Fruit of the Loom v OHIM — Blueshore Management (FRUIT)*, T-514/10, not published, EU:T:2012:316, paragraph 38).”

35. These findings indicate that the relative distinctiveness of the registered mark and the components added to (or omitted from) it in use are relevant factors to take into account in the required assessment. In this instance the addition of a circle around the registered mark was not sufficient to alter the distinctive character of the registered mark. I consider that the composite mark, as used in the relevant period (i.e. the eighteenth century male figure), qualifies as use of the registered mark because the elements which are omitted or added (‘carvery’ is added, and ‘A slice of

British Tradition' is omitted) are either descriptive or very weak in distinctive character.

36. I find that there was use of the composite mark in the relevant period in relation to *public house services, bar services and restaurant services*. The opponent also relies upon this registration in respect of goods registered in classes 29 and 30.

37. In *Aegon UK Property Fund Limited v The Light Aparthotel LLP*, BL O/472/11), Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“17. unless it is obvious, the proprietor must prove that the use was in relation to the particular goods or services for which the registration is sought to be maintained.

18. In *Céline SARL v. Céline SA*, Case C-17/06 (*Céline*), the Court of Justice gave guidance as to the meaning of “use in relation to” goods for the purpose of the infringement provisions in Article 5(1) of the Directive. Considering a situation where the mark is not physically affixed to the goods, the court said at [23]:

“...even where the sign is not affixed, there is use “in relation to goods or services” within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party.”

19. The General Court has, on more than one occasion, proceeded on the basis that a similar approach applies to the non-use provisions in what is now Article 42 of the European Union Trade Mark Regulation. For example, in *Strategi Group*, Case T-92/091, the General Court said:

“23. In that regard, the Court of Justice has stated, with regard to Article 5(1) 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), that the purpose of a company, trade or shop name is not, of itself, to distinguish goods or services. The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being carried on. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being carried on, such use cannot be considered as being ‘in relation to goods or services’ (*Céline*, paragraph 21).

24. Conversely, there is use ‘in relation to goods’ where a third party affixes the sign constituting his company name, trade name or shop name to the goods which he markets. In addition, even where the sign is not affixed, there is use ‘in relation to goods or services’ within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party (see *Céline*, paragraphs 22 and 23).

20. Those passages must be read together with the general requirements of proof of use in *Ansul* at [43] that there is genuine use of a trade mark where the mark is used in accordance with its essential function namely to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services.”

38. In *Cactus SA v OHIM*, Case T-24/13, the General Court held that the owner of what was then a CTM (now an EUTM) who used the mark only as the name of a shop had used the mark “in relation to” the natural plants, flowers and grains sold in the shop (as well as in relation to retail services for those goods). This is because it had demonstrated that the public would link the (otherwise unbranded) goods to the mark used for the shop and regard the user of that mark as being responsible for the quality of the goods. The court stated that:

“69 Accordingly, in view of the context of the present case, as described in paragraphs 66 to 68 above, and, in particular, the applicant’s specific expertise in the plants and flowers sector, which it publicises, it must be considered that the documents submitted by the applicant which show the earlier marks establish to the requisite standard that there is a link between those marks and plants, flowers and seeds which bear no mark. Those documents show that the applicant offers for sale or sells those goods with the earlier marks as the only indication of a trade mark, with the result that those marks are the only signs that provide an indication of the commercial origin of the goods in question.

70 That conclusion is not affected by the consideration referred to by the Board of Appeal and OHIM that, in the light of the registration of the earlier marks in relation to retail services in Class 35, the earlier marks must be regarded as designating the applicant’s stores which retail plants, flowers and seeds, not those goods themselves. Although the earlier marks are also registered to designate retail services in respect of the sale of plants, flowers and seeds, as is apparent from paragraphs 31 to 39 above, that does not mean, given the context of the present case described in paragraphs 66 to 68 above, that those same marks may not also designate plants, flowers and seeds which bear no mark and which are offered for sale in shops operated by the applicant.

71 In those circumstances, it must be concluded that the Board of Appeal erred in deciding that the applicant had not proved genuine use of the earlier marks in relation to ‘natural flowers and plants, grains’ in Class 31.”

39. The opponent’s evidence shows that the TripAdvisor reviews refer to the quality of the meals received, as well as the services themselves. It seems to me that the position taken in these two authorities is applicable to certain of the opponent’s goods registered under the composite mark because the public would link the (otherwise unbranded) meals to the mark used for the restaurant services and regard the user of that mark as being responsible for the quality of the goods. However, this this does not apply to all of the goods. Customers visit a TOBY

CARVERY to obtain a meal, but they do not go to obtain parts of meals, or meal constituents. There is no evidence that during the relevant period there was any specific custom for coffee, as opposed to coffee being an adjunct to a meal. None of the reviews refer to coffee, but they do refer to meals. Consequently, the opponent may rely upon its composite mark in relation to *prepared meals* in classes 29 and 30, and *public house services, bar services and restaurant services* in class 43.

40. The final earlier mark, registration 1013366, Toby's TakeAway, is registered only in classes 29 and 30, and does not cover prepared meals. It follows that the opponent may not rely upon this registration.

41. In summary, the opponent may rely upon the following:

(i) TOBY CARVERY for *public house services; bar services; restaurant services*.

(ii) TOBY for *restaurant, public house and bar services*.



(iii) for *prepared meals, public house services, bar services and restaurant services*.

Section 5(2)(b) of the Act

42. 5(2)(b) of the Act states:

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

(a) ...

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

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

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

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when

all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods and services

44. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

45. ‘Complementary’ was defined by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”.

46. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

47. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

48. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent*

Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

49. The goods and services to be compared are:

Earlier marks	IR
<p data-bbox="188 965 560 1003">Class 29: <i>prepared meals</i></p> <p data-bbox="188 1077 560 1115">Class 30: <i>prepared meals</i></p> <p data-bbox="188 1352 719 1440">Class 43: <i>public house services, bar services and restaurant services.</i></p>	<p data-bbox="809 1077 1401 1218">Class 30: <i>Coffee, tea, chocolate and chocolate drinking beverages, chocolate-coated coffee beans.</i></p> <p data-bbox="809 1352 1406 1989">Class 43: <i>Tea room services; coffee shop services for serving coffee and accompanying snacks such as biscuits, packaged nuts and dried fruit, snack bars, chocolate bars, cake, fresh bakery products and sandwiches; coffee bar services; mobile café services for providing tea and coffee-based beverages and accompanying snacks such as biscuits, packaged nuts and dried fruit, snack bars, chocolate bars, cake, fresh bakery products and</i></p>

	<i>sandwiches; provision of tea and coffee-based beverages and accompanying snacks such as biscuits, packaged nuts and dried fruit, snack bars, chocolate bars, cake, fresh bakery products and sandwiches prepared for consumption from kiosks.</i>
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50. There is no similarity on any meaningful level between the opponent's prepared meals (classes 29 and 30) and the holder's goods in Class 30. The most that can be said is that there may be a similarity in channels of trade, but this is at the most general of levels. They do not share nature, purpose, are not in competition and are not complementary. There is also no meaningful similarity between the opponent's services and the holder's class 30 goods.

51. Both parties have cover for services in class 43 which provide the consumer with prepared food and beverages. Although there is a difference between a tea room and a pub, there is less of a difference between tea rooms, cafes and restaurants, whether of fixed location or mobile. All these types of premises provide services of the same nature (prepared food and drink). They share the same purpose which is providing the consumer with the means to satiate hunger and thirst and/or the location and service for a social occasion. They are in competition and may be co-located; for example, a coffee shop and a restaurant. There is a high degree of similarity which is not reduced by the holder having specified the type of goods which are the subject of the service which, in any case, are only described as 'such as' and therefore are examples of the goods.

The average consumer and the purchasing process

52. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

53. The average consumer of the goods and services at issue is a member of the general public. Visual considerations will be an important part of the selection process; for example, after viewing promotional material, signage and menus. However, such services may also be selected as a result of word-of-mouth recommendations; I, therefore, bear in mind that there may be an aural aspect to the purchasing process. The degree of care the average consumer will display when selecting such services is likely to vary considerably, ranging from a quick cup of tea in a café to dining in a restaurant to celebrate an occasion.

Comparison of marks

54. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

55. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

56. The opponent’s word marks give it a better chance of success than the complex mark, so I will restrict my assessment to the word marks. The parties’ marks are shown below:

The earlier marks	The IR
<p data-bbox="359 472 614 506">TOBY CARVERY</p> <p data-bbox="443 544 529 577">TOBY</p>	<p data-bbox="979 510 1230 544">TOBY'S ESTATE</p>

57. TOBY is a well-known male forename. It is the dominant and distinctive element of the mark TOBY CARVERY because CARVERY describes carvery restaurant services. It is the only element of the mark TOBY.

58. The overall impression of TOBY'S ESTATE is of some kind of estate belonging to an individual named TOBY. Both words are equally important to the overall impression because TOBY is in the possessive form, qualifying the noun which it possesses (ESTATE).

59. There is a reasonable level of visual and aural similarity between TOBY CARVERY and TOBY'S ESTATE, and a good level in relation to the comparison between TOBY and TOBY'S ESTATE because there are less visual differences between the marks.

60. The degrees of conceptual similarity between the marks vary. As I have said already, TOBY is well-known as a male forename. Although it is not in the possessive form in TOBY CARVERY, I think that the average consumer would approximate the meaning, as a whole, to a carvery which is run by an individual called TOBY. As above, the concept of TOBY'S ESTATE is an estate of some description belonging to an individual named TOBY. CARVERY and ESTATE have entirely different meanings. In the context of food, one is a type of restaurant service; the other means property of some description. Taking into account that both marks contain a reference to TOBY, but that the nouns belonging to TOBY have very

different meanings, the overall conceptual similarity between TOBY CARVERY and TOBY'S ESTATE is low to medium.

61. The earlier mark, TOBY, creates a simple concept of the male forename. It is not in possessive form, unlike TOBY'S ESTATE, which signifies an individual to which something (the estate) belongs. Taking into account that both marks contain a reference to the same male forename, there is a medium degree of conceptual similarity between the marks.

62. I will factor in the various aspects of the comparison of marks when I make the global assessment as to whether there is a likelihood of confusion.

Distinctive character of the earlier marks

63. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁴ 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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or

⁴ Case C-342/97

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).”

64. Whilst TOBY is not descriptive for restaurants and bars, it is a common male forename and personal names are frequently used as trade marks for such services. CARVERY describes a type of restaurant service. Therefore, the inherent distinctiveness of the TOBY CARVERY and TOBY marks is no more than average.

65. One of the principles which must be taken into account in deciding whether there is a likelihood of confusion is that 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. With this in mind, I need to assess whether the use made of the earlier marks has improved the distinctiveness levels to any meaningful degree. The relevant date for this assessment is the priority date of the IR, 25 November 2013.

66. The marks benefit from the use made of them such that their inherent levels of distinctive character have been enhanced. However, the evidence, although proving use to the extent set out in paragraph 41 of this decision, does not entitle the opponent to claim an enhanced level of distinctive character for all of the goods and services upon which it may rely. The thrust of the evidence, prior to the relevant date, is that there is a reputation for a carvery restaurant, serving roast dinners. For example, the evidence shows that 25% of all the meals sold are on Sundays, the traditional day of the week for a roast dinner. The ‘brand promise’ on the website is ‘Home of the Roast’, and there are various prints within the evidence showing ‘Toby’ chefs giving advice on matters such as how to cook roast potatoes. One of the M&B prints refers to Toby as being one of Britain’s best-loved carvery brands. Exhibit SB2, printed in 2016 from tobycarvery.co.uk, refers almost entirely to roast dinners. The statistics given in Exhibit SB1 date from 2016, so it is not possible from the stated breakfast ‘now’ accounts for 15% of all meals to say what the position was in November 2013, particularly as the first time a tab appears on the website for breakfasts was in 2012. I find that the distinctive character of the earlier marks is enhanced to a high level, but only in respect of carvery services for roast dinners.

Likelihood of confusion

67. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found that the parties' class 43 services are highly similar, but that there is no similarity between the holder's class 30 goods and any of the opponent's goods or services. A likelihood of confusion presupposes that there is some level of similarity between goods and services (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*, paragraph 22). Therefore, the opposition under section 5(2)(b) of the Act must fail in respect of the holder's class 30 goods because they are not similar to any of the goods or services covered by the earlier marks.

68. That leaves me to make a global assessment of all the factors examined so far in this decision in relation to the IR in class 43. In the opponent's favour are that the services are highly similar, that there is a reasonable/good level of visual and aural similarity between the marks and that, in relation to carvery/roast dinner services, the earlier marks are highly distinctive. Pulling in the holder's direction is a no higher than medium level of conceptual similarity, and that the earlier marks are averagely distinctive (but no more than that) for services other than carvery services.

69. The holder has put in evidence three definitions for the word 'estate', from the online Oxford, Cambridge and Collins dictionaries. They are, more or less, the same. The oxforddictionaries.com entry gives the meaning of estate as:

"1. An area or amount of land or property, in particular:

1.1 An area of land and modern buildings developed for residential, industrial, or commercial purposes.

1.2 An extensive area of land in the country, usually with a large house, owned by one person, family, or organisation.

1.3 All the money and property owned by a particular person, especially at death.

1.4 A property where coffee, rubber, grapes, or other crops are cultivated.”

70. Although estate may be meaningful in relation to coffee itself, it is, at best, allusive in relation to the holder’s services, for services which serve estate-grown coffee.

71. In *Unilever Plc v RDPR Limited*, BL O/016/10, Mr Iain Purvis QC, sitting as the Appointed Person, said this about enhanced distinctive character and the global assessment:

“18. It seems to me that any increase in the likelihood of confusion as a result of enhanced distinctiveness through reputation inevitably diminishes as one moves away from the core products in relation to which the mark has been used. Particularly with marks which are not fanciful or invented words, the “trigger” which creates an association in the mind of the public between a mark and its proprietor is not simply familiarity with the mark, but familiarity with the mark in a particular context.”

The context in which the earlier marks enjoy enhanced distinctive character is for roast dinner carvery services. This limits the extent to which the reputation increases a likelihood of confusion. Carvery services for roast dinners are a specific type of service. Considering that TOBY is not invented or fanciful, the average consumer is far less likely to connect the marks when used in relation to the holder’s services than they would if it was seen being used on carvery services or services

which are more pub or restaurant-based than café or tearoom-based. It seems to me that the enhanced level of distinctive character in a confined area of trade does not help the opponent's case under section 5(2)(b).

72. Inherently, the earlier marks are no more than averagely distinctive. In *Bimbo*, the CJEU stated (my emphasis):

“19. As to the merits, according to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see Case C-334/05 P *OHIM v Shaker* EU:C:2007:333, paragraph 33, and Case C-193/06 P *Nestlé v OHIM* EU:C:2007:539, paragraph 32).

20. The existence of a likelihood of confusion on the part of the public must be assessed globally, account being taken of all factors relevant to the circumstances of the case (see, to that effect, Case C-251/95 *SABEL* EU:C:1997:528, paragraph 22; *OHIM v Shaker* EU:C:2007:333, paragraph 34; and *Nestlé v OHIM* EU:C:2007:539, paragraph 33).

21. The global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks at issue, must be based on the overall impression given by the marks, account being taken, in particular, of their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, to that effect, *SABEL* EU:C:1997:528, paragraph 23; *OHIM v Shaker* EU:C:2007:333, paragraph 35; and *Nestlé v OHIM* EU:C:2007:539, paragraph 34).

22. The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining

each of the marks in question as a whole (*OHIM v Shaker* EU:C:2007:333, paragraph 41).

23. The overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker* EU:C:2007:333, paragraphs 41 and 42, and *Nestlé v OHIM* EU:C:2007:539, paragraphs 42 and 43 and the case-law cited).

24. In this connection, the Court of Justice has stated that it is possible that an earlier mark used by a third party in a composite sign that includes the name of the company of the third party retains an independent distinctive role in the composite sign. Accordingly, in order to establish the likelihood of confusion, it suffices that, on account of the earlier mark still having an independent distinctive role, the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark (Case C-120/04 *Medion* EU:C:2005:594, paragraphs 30 and 36, and order in Case C-353/09 P *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraph 36).

25. None the less, a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately (see, to that effect, order in Case C-23/09 P *ecoblue v OHIM and Banco Bilbao Vizcaya Argentaria* EU:C:2010:35, paragraph 47; *Becker v Harman International Industries* EU:C:2010:368, paragraphs 37 and 38; and order in *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraphs 36 and 37)."

73. In *Deakins*, BL O/421/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated:

"24. It is not correct to proceed on the basis that an element of a composite mark retains an independent distinctive role if, together with the other component or components of the mark, it *'forms a unit having a different*

meaning as compared with the meaning of those components taken separately: *Bimbo SA v. OHIM* C-591/12P, EU:C:2014:305 at paragraph [25]. And even if a component of a composite mark is found to be sufficiently 'unitary' to retain an independent distinctive role, it still remains necessary for any assessment of '*similarity*' to be made by reference to the composite mark as a whole in the manner summarised in *Bimbo SA* at paragraphs [34] and [35]:

[34] Indeed, as the Advocate General observed in points 25 and 26 of his Opinion, 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.

[35] The determination of which components of a composite sign contribute to the overall impression made on the target public by that sign is to be undertaken before the global assessment of the likelihood of confusion of the signs at issue. Such an assessment must be based on the overall impression produced by the trade marks at issue, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, as has been stated in paragraph 21 above. Therefore, this does not involve an exception, that must be duly substantiated, to that general rule."

74. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo* on the court's earlier judgment in *Medion*. In that case, Arnold J. considered the registrability of a composite word mark - JURA ORIGIN - which included the opponent's earlier trade mark - ORIGIN. The latter was registered for similar goods - wine - to those of the applicant - whisky. The opponent also had an earlier CTM consisting of the word ORIGIN and a device made up of vine leaves. This mark was

registered for alcoholic goods at large and therefore covered identical goods to whisky. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

75. The judge found that the mark JURA ORIGIN formed a unit having a different meaning to those of the individual components. In the present case, I have found that TOBY will be perceived as the common male forename. This is the meaning of the earlier mark for TOBY, solus. Although TOBY is included in the first element of the IR, it is in its possessive form and its role in the overall impression of the IR is to qualify the thing that is possessed, an estate. The concept of the IR is of an estate owned by Toby, and ownership creates the idea of an individual, rather than the simple forename.

76. In my view, TOBY'S ESTATE forms a unit with a different meaning as compared to its components taken separately. However, even if I am wrong about that and TOBY does play an independently distinctive role within the mark, I must, nevertheless, make an assessment by reference to the composite mark as a whole. I find that the overall impression of the IR, whilst containing the same male forename as the earlier mark, will not lead to direct confusion (mistaking one mark for the other) because the visual differences, combined with the concept created by the IR, are sufficient to militate against imperfect recollection. In addition, I do not think that there will be indirect confusion, in the sense of an assumption of economic connection (whilst not directly mistaking one mark for another). This is because estate is not a natural word to use to indicate a brand extension or a sub-brand for these services.

77. In relation to TOBY CARVERY, although I have found that the average consumer is likely to interpret that as a carvery belonging to Toby, thereby bringing the possessive nature of Toby's into closer alignment with the IR, the whole mark comparison takes the marks further away visually, aurally and conceptually.

78. If, which I doubt, there is any calling to mind of any of the marks, it will be fleeting and put down to simple coincidence brought about by the commonality of the name, and the fact that forenames in general are commonly used as names of cafés, bars and restaurants. There will be no confusion. **The section 5(2)(b) ground fails.**

Section 5(3) of the Act

79. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

80. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective

marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in

particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

81. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between the marks, in the sense of the earlier marks being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

82. The first condition is reputation. The CJEU gave guidance in relation to assessing reputation in *General Motors*:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

83. When I assessed the distinctive character of the earlier marks under section 5(2)(b) of the Act, I said that the evidence was sufficient to find that the marks’ inherent distinctive character had been enhanced through use, but only in relation to carveries serving roast dinners. For the reasons I gave earlier, I find that the evidence is sufficient to support a claim to a *Chevy* standard of reputation, but only in relation to this narrow area.

84. As I mentioned earlier in this decision, the evidence shows that the reputation for the services is of a particular nature, a nature which is not very complimentary. In short, the majority of the TripAdvisor reviews about the quality of the service (and the food) are negative, some severely so.

85. The second requirement is that the relevant public will make a link between the marks. Although I have found that there is no likelihood of confusion, no likelihood of confusion does not preclude a link, as stated by the CJEU in *Ferrero SpA v OHIM*, Case C-552/09 P:

“53 It is true that those provisions differ in terms of the degree of similarity required. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue such that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) may be the consequence of a lesser degree of similarity between the earlier and later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see, to that effect, *Adidas-Salomon and Adidas*

Benelux, paragraphs 27, 29 and 31, and *Intel Corporation*, paragraphs 57, 58 and 66).

54 On the other hand, it is not apparent either from the wording of those provisions or from the case-law that the similarity between the marks at issue must be assessed in a different way, according to whether the assessment is carried out under Article 8(1)(b) of Regulation No 40/94 or under Article 8(5).”

86. However, the evidence shows that the ‘trigger’ which creates the association in the mind of the relevant public (the general public) between the earlier marks and the opponent is highly specific in context. That trigger is that the marks identify carvery services for roast dinners which are frequently of low quality. Coupled with the fact that the dominant element of the earlier marks is a common male forename, and that there is a conceptual distance between the earlier marks and the IR, I think that a link is unlikely, unless of the fleeting sort, too fleeting to have the effects envisaged in the three heads of damage.

87. However, in case I am wrong about that, and a link would be made, I will look at the three heads of damage.

88. I will begin with unfair advantage, which was described by the CJEU in *L’Oréal v Bellure* (my emphasis):

“41. As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.

....

115. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

89. Trade marks are not only indicators of origin, but are also communication tools which send out messages. In the case of the earlier marks, the message sent out is that the services are of low quality, and many reviewers stated that they would not return. The opponent has not filed evidence of positive reviews which either match or exceed the number of negative reviews. It is difficult to see what advantage the holder would gain because there does not appear to be prestige or a power of attraction of the type which would give the IR an advantage. It cannot be said that there would be 'clear exploitation' of the earlier marks. There would not be any unfair advantage.

90. Mr Krause picked out from the opponent's evidence some of the reviewers' comments, which reflect the general tone of the reviewer's opinions, although some people did appear to be content with what they'd experienced:

- Page 122: "Still unimpressive".
- Page 123: "Could do with bigger portions"; "Budget price, budget quality".
- Page 126: "Where was the meat?"
- Page 127: "Poor management. Not bad if you could find the staff. Not the best experience".
- Page 134: "Disappointed. Awful. Don't waste your money. The meal we didn't have".
- Page 135: "Like Fawlty Towers".
- Page 139: "A disappointing carvery. Good food. Very poor service. Unforgivingly bad".
- Page 145: "Horrible". "Never again. Disappointing".

- Page 147: "Disgusting".

91. It is difficult to see how the opponent's reputation could suffer damage. Mr Moss submitted that if the comments reflect the opponent's business model, then it might suffer if the services of the later IR were of better quality (and more expensive) than people associated with the earlier marks. I think that is unlikely.

92. The CJEU described detriment to distinctive character in *L'Oréal v Bellure*, as follows:

"39. As regards detriment to the distinctive character of the mark, also referred to as 'dilution', 'whittling away' or 'blurring', such detriment is caused when that mark's ability to identify the goods or services for which it is registered is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so (see, to that effect, *Intel Corporation*, paragraph 29)."

93. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, the CJEU stated (my emphasis):

"34. According to the Court's case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment).

35. Admittedly, paragraph 77 of the *Intel Corporation* judgment, which begins with the words '[i]t follows that', immediately follows the assessment of the weakening of the ability to identify and the dispersion of the identity of the

earlier mark; it could thus be considered to be merely an explanation of the previous paragraph. However, the same wording, reproduced in paragraph 81 and in the operative part of that judgment, is autonomous. The fact that it appears in the operative part of the judgment makes its importance clear.

36. The wording of the above case-law is explicit. It follows that, without adducing evidence that that condition is met, the detriment or the risk of detriment to the distinctive character of the earlier mark provided for in Article 8(5) of Regulation No 207/2009 cannot be established.

37. The concept of ‘change in the economic behaviour of the average consumer’ lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers’ perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds.

38 The General Court, at paragraph 53 of the judgment under appeal, dismissed the assessment of the condition laid down by the *Intel Corporation* judgment, and, consequently, erred in law.

39. The General Court found, at paragraph 62 of the judgment under appeal, that ‘the fact that competitors use somewhat similar signs for identical or similar goods compromises the immediate connection that the relevant public makes between the signs and the goods at issue, which is likely to undermine the earlier mark’s ability to identify the goods for which it is registered as coming from the proprietor of that mark’.

40. However, in its judgment in *Intel Corporation*, the Court clearly indicated that it was necessary to demand a higher standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, within the meaning of Article 8(5) of Regulation No 207/2009.

41. Accepting the criterion put forward by the General Court could, in addition, lead to a situation in which economic operators improperly appropriate certain signs, which could damage competition.

42. Admittedly, Regulation No 207/2009 and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case'."

94. Section 5(3) only covers detriment to the distinctiveness of the earlier marks in relation to the services for which there is a reputation: carveries serving roast dinners. Mr Moss submitted that since advertising spend is £2.6 million, with 170-odd restaurants, "[i]nvariably, it is going to dilute the brand if there is something called TOBY'S ESTATE out there that are offering very similar services." However, paragraph 37 of *L'Oréal v Bellure* states that "[T]he mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) of Regulation No 207/2009, in as much as that similarity does not cause any confusion in their minds." It seems to me that something more is required than the opponent has shown. There is no evidence that would lead me to find detriment or the risk of detriment to the distinctive character of the earlier marks. **The section 5(3) ground fails.**

Section 5(4)(a) of the Act

95. Section 5(4)(a) states:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

96. The requirements to succeed in a passing off action are well established and are summarised in *Halsbury’s Laws of England* 4th Ed. as being that:

i) the claimant’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

ii) there is a misrepresentation by the defendant (whether or not intentional) which is likely to deceive the public into believing that the defendant’s goods or services are those of the claimant;

and iii) the claimant has suffered or is likely to suffer damage as a result of the erroneous belief created by the defendant’s misrepresentation.

97. There is one possible difference between the position under trade mark law and the position under passing off law. In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40), it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. In the

current case, this ground does not appear to take the opponent any further forward for the reasons identified earlier in this decision in relation to the section 5(2)(b) ground.

98. Mr Moss submitted that the 5(4)(a) ground was effectively the same as the section 5(3) ground in the sense that lack of control over quality could lead to damage to reputation/goodwill (it should be noted that this is not fertile ground for a section 5(3) ground).

99. In *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5, in the Court of Appeal, Jacob LJ said:

“16 The next point of passing off law to consider is misrepresentation. Sometimes a distinction is drawn between "mere confusion" which is not enough, and "deception," which is. I described the difference as "elusive" in *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40. I said this, [111]:

"Once the position strays into misleading a substantial number of people (going from 'I wonder if there is a connection' to 'I assume there is a connection') there will be passing off, whether the use is as a business name or a trade mark on goods."

17 This of course is a question of degree—there will be some mere wonderers and some assumers—there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former.

18 The current (2005) edition of *Kerly* contains a discussion of the distinction at paras 15–043 to 15–045. It is suggested that:

"The real distinction between mere confusion and deception lies in their causative effects. Mere confusion has no causative effect (other than to confuse lawyers and their clients) whereas, if in answer to the question:

'what moves the public to buy?', the insignia complained of is identified, then it is a case of deception."

19 Although correct as far as it goes, I do not endorse that as a complete statement of the position. Clearly if the public are induced to buy by mistaking the insignia of B for that which they know to be that of A, there is deception. But there are other cases too—for instance those in the Buttercup case. A more complete test would be whether what is said to be deception rather than mere confusion is really likely to be damaging to the claimant's goodwill or divert trade from him. I emphasise the word "really."

100. I doubt whether the opponent's customers will even get as far as wondering if there is a connection between the parties' marks and I am certain that the use of the IR would not cause a substantial number of the public to be misled into purchasing the holder's services, believing that they are provided by the opponent. There will be no misrepresentation and, hence, no damage. **The section 5(4)(a) ground fails.**

Outcome

101. The opposition fails under all grounds. The IR may proceed to protection in the UK.

Costs

102. The holder is entitled to a costs award as it has been the successful party. Both parties were content for the scale of costs to apply (the scale in Tribunal Practice Notice 4/2007 applies). The holder's evidence did not assist, so I will reduce the award accordingly. The award breakdown is as follows:

Considering the notice of opposition and preparing the counterstatement	£400
Considering the opponent's evidence	£1000

Preparation for and attendance at the hearing £400

Total £1800

103. I order Old Kentucky Restaurants Limited to pay Toby's Estate Coffee (Asia) PTE. Ltd. the sum of £1800 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 6TH day of June 2017

Judi Pike

For the Registrar,

the Comptroller-General