

O/370/17

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3168279
AND THE REQUEST BY ATLANTIC GRAPHIC SOLUTIONS LTD
TO REGISTER THE TRADE MARK**



**BUTCHER
AND GRILL**

The logo consists of the words 'BUTCHER' and 'GRILL' in a bold, black, distressed font. The word 'AND' is positioned between them, with a diagonal slash through it. The slash is composed of two parallel lines: a black one on the outside and an orange one on the inside.

FOR SERVICES IN CLASS 43

AND

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 407578
BY ENTOURAGE B.V.**

BACKGROUND AND PLEADINGS

1. On 7 June 2016, Atlantic Graphic Solutions Ltd (“the Applicant”) applied to register as a trade mark the figurative mark shown on the front page of this decision, in class 43 for “*Services for providing food and drink; restaurant services.*” The application was published for opposition purposes in the Trade Marks Journal on 8 July 2016.
2. It is opposed by Entourage B.V. (“the Opponent”) which relies on the following European Union trade marks, which in this decision I refer to as Mark A and Mark B:

Mark A:

Word mark
Registration No. EU009406661
Filed on 28 September 2010
THE-BUTCHER Entered in the register on 20 May 2011
Services in 43: *Providing of (take-away) food and beverages (self-service); cafe, restaurant, bar and catering services; catering (food and drink-).*

Mark B:

Word mark
Application No. EU014005417
Filed on 28 April 2015
The Butcher Social Club Not yet entered in the register
Services in class 41: *Entertainment; Cultural activities; Entertainment clubs; Night clubs and organising recreational events in relation to night clubs; Organising, Arranging and performing musical events, live performances by musicians and bands; Clubs (entertainment); Discotheque services.*

Services in class 43: *Services for providing food and drink; Temporary accommodation; Temporary accommodation; Services of bars and restaurants; Hospitality services and services provided in, or with*

regard to, restaurants, catering and other sites and facilities which procure beverages and food prepared for consumption; Hospitality services at discotheques or nightclubs.

3. Section 6(1)(a) of the Trade Marks Act 1994 (“the Act”) defines an “earlier trade mark”, as including “*a European Union trade mark ... which has a date of application for registration earlier than that of the trade mark in question ...*”. Mark A was filed in 2010 and Mark B in 2015, so both are earlier trade marks under the Act.
4. The Opponent relies in this opposition on all services covered by its earlier trade marks. Since Mark A was registered in 2010, it is subject to the proof of use provisions under section 6A of the Act, and the Opponent has duly provided a statement of use of Mark A in respect of all services under that mark. The Applicant has requested that the Opponent provide proof of use of the mark in respect of all services under that mark. The Opponent has filed evidence, which I summarise in this decision.
5. Since Mark B had not been registered for five years or more when the Applicant’s mark was published for opposition, that earlier mark is not subject to the proof of use provisions under section 6A of the Act.
6. The Opponent requests that the application be refused in its entirety. The opposition is based on section 5(2)(b) of the Act and the Opponent claims that the mark applied for is similar to its earlier trade marks and that the respective services are identical or similar, such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks. The Opponent made various arguments in its statement of grounds as part of its notice of opposition, which it repeated and supplemented in separate submissions filed along with its evidence. I shall refer to the Opponent’s points where appropriate.
7. The Applicant filed a notice of defence and counterstatement in which it denies that the marks are confusingly similar and gives its view that, overall, there is no likelihood of confusion. The Applicant indicated that submissions would follow the counterstatement, but in fact the Applicant provided no subsequent submissions or evidence.

8. The Applicant is represented in these proceedings by Withers & Rogers LLP, and the Opponent is represented by Novagraaf UK. Neither party requested a hearing and I take this decision based on a careful reading of the papers received.
9. In this decision I intend to focus, first, on the Opponent's case under section 5(2)(b) for its earlier trade mark "THE-BUTCHER" (Mark A), which is closer in terms of the marks themselves. As noted, this mark is subject to proof of use.

THE OPPONENT'S EVIDENCE

10. The Opponent has provided evidence that comprises a witness statement by Erik Straatman, dated 13 February 2017, together with Exhibits ES1 to ES5. Erik Straatman is a certified trade mark attorney with Novagraaf, which represents the Opponent in these proceedings. The witness explains that the Entourage Group (of which the Opponent is a part) operates several restaurants under the mark THE BUTCHER: THE BUTCHER (Amsterdam), THE BUTCHER on Wheels (a food truck), THE BUTCHER Berlin, THE BUTCHER Social Club. The restaurants are run by Bread & Butter who use the trade mark with permission from the Opponent¹ for the services registered in class 43. The Butcher restaurant is a burger restaurant with a discreet cocktail bar annexed, which opened in Amsterdam in 2012. A second restaurant opened in Amsterdam in 2014, and a third in Berlin in June 2016. There are said to be plans to open further restaurants in London, Ibiza and Dubai.
11. **Exhibit ES1** is a selection of printouts from the websites of the Entourage Group and THE BUTCHER. Not all the text is legible, but the materials show the use of Mark A to the extent set out below. There are references to :
 - (i) "THE-BUTCHER.COM";
 - (ii) "http://the-butcher.com";
 - (iii) "The Butcher";
 - (iv) THE BUTCHER; and

¹ Section 6A(3)(a) expressly includes use with consent of the proprietor.

(v) in this form:

The
BUTCHER

12. When referred to in text, the reference in this Exhibit tends to be to “THE BUTCHER”. The exhibit also includes pictures of form (v) of the mark in prominent use on the restaurant window and on staff t-shirts. None of the representations (i) – (v) is precisely the same as Mark A presented on the register. I will consider later in this decision whether use in these forms may satisfy the proof of use provisions for Mark A.
13. Exhibit ES1 also confirms that the restaurant opened in 2012, “in the heart of Holland’s most famous market: The Albert Cuypstraat in Amsterdam.” It confirms that in October 2014 THE BUTCHER opened a second burger bar at The Foodhallen in Amsterdam. Exhibit ES1 also includes an undated extract from The Butcher website, which offers a visitor to the site a choice of location, listing Amsterdam, Berlin and “Ibiza 2017.”
14. The materials show that drinks are offered and that the menu includes steaks, salads and vegetarian specials. They also show the particular style and image of the restaurant, which is described as a “*full service concept opening from 11a.m. until after midnight, whether you crave a late breakfast, a tasty lunch, a hearty dinner or a midnight snack ...*”.
15. **Exhibit ES2** comprises printouts from TripAdvisor and Lonely Planet which according to the witness statement are intended to show that “*the restaurants enjoy an excellent reputation both nationally (in the Netherlands) and internationally.*” The exhibit includes nine sample English language reviews from TripAdvisor. The extract shows the site had 494 reviews of The Butcher in Amsterdam, 287 of which were in English. The nine reviews are by customers from diverse countries including 4 from cities in the UK (others include USA, Finland and Spain). The most recent of the nine reviews shown is dated 7 June 2016, and the earliest of the nine is two months’ earlier (7 April 2016).
16. Reviews are broadly very positive, ranking the restaurant as 150th among over 3000 Amsterdam restaurants reviewed on TripAdvisor. The profile included on the website of Lonely Planet, appears to abbreviate the mark “Butcher”. The profile is not dated, but

describes the restaurant that opened in 2012. Since Lonely Planet is a travel guide, it may well have extended the promotional reach of the mark to visitors to Amsterdam, but I have no submissions on that point.

17. **Exhibit ES3** is a selection of press coverage from around the EU, with relevant parts translated, to show that the restaurants have received significant press coverage from 2012 to 2015. A total of 34 press pieces are listed, including coverage in *Marie Claire* (online 16 July 2012); *Esquire* (30 September 2012); *Playboy* (30 September 2012); *Cosmopolitan* (31 October 2012); *Elle* (31 January 2013 and online 23 January 2013); *Grazia* (June 2013). Most coverage is in Dutch, but the clippings include various English language publications, including a short review on Timeout.com (December 2012); coverage in the Inflight Magazine Easyjet (undated); a profile (with large photo of mark (v) visible on a staff t-shirt) from Overdose.am (29 June 2012); a publication in Telegraph (21 February 2013) and a profile from 2015 from the website of *The Daily Telegraph* under the title “*Best things to do in Amsterdam.*” The restaurant is variously referenced in this Exhibit as “The Butcher”, “The-butcher.com” and in form (v) shown above.
18. **Exhibit ES4** I found unclear. It appears to include an overview of financial figures relating to media coverage of THE BUTCHER from September 2013 – August 2014, with monthly totals in that period ranging from €4,000 (January 2014) to over €96,000 (May 2014). The exhibit includes numerous articles that mention The Butcher and for which circulation figures are given. The witness statement says Exhibit ES4 shows “*media value of the publications as from 2013 as at least €320,000.*” I find the phrase “media value” to be ambiguous. It could refer to money spent actively securing placements of advertising or promotional materials in publications such as those listed under Exhibit ES3. It could however refer to a notional sum that inclusion in magazine restaurant review and listings content may be worth, irrespective of whether it was actually procured with payment. The figures attributed to the various items are very precise, which could suggest actual sums paid for placement of advertising pieces, but it is unclear.
19. **Exhibit ES5** is a copy and certified translation of the judgment of the District Court of The Hague dated 20 February 2015, which involved reliance by the Opponent on Mark A in a trade mark dispute with another restaurant enterprise. While I note that Mark A was used

in that context, I must form my own view in this decision on the evidence and submissions before me.

20. That completes my summary of the evidence filed.

PROOF OF USE

21. The Opponent must show that the earlier mark has been put to genuine use in relation to the services for which it is registered during the 5 years up to the date when the Applicant's mark was published for opposition purposes. The relevant period for proving use in this case is therefore 9 July 2011 to 8 July 2016.

22. Section 6A states that the use conditions are met if :

“ ... (3) (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)

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

(6)”

23. Section 100 of the Act makes it clear that the burden of proof falls on the Opponent to show that it has used its mark.

24. The Opponent's evidence summarised above clearly shows use of the words "the butcher" in relation to its business, but in the various forms described in the paragraph above relating to Exhibit ES1. The first issue to consider is whether the forms in which they are used are sufficiently close to the form in which Mark A appears in the register so as to satisfy the provision in section 6A(4)(a). In *Nirvana Trade Mark*², Mr Richard Arnold Q.C. (as he then was) as the Appointed Person considered the question of whether the use of a mark in a different form constitutes genuine use of the mark as registered:

"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."*

25. In the present case, the evidence shows that the signs presented as the Mark A were mainly "THE BUTCHER", "The Butcher" and the variant form (v) shown below:

The logo consists of the word "The" in a cursive script font, positioned above the word "BUTCHER" in a bold, black, sans-serif font. A thin blue horizontal line is drawn across the middle of the word "BUTCHER".

26. Mark A is THE-BUTCHER. The distinctive character of the registered trade mark is the word "BUTCHER". The variant forms tend to omit the hyphen from Mark A. It is possible that the average consumer may register that difference, but I find the omission of a small hyphen does not alter the distinctive character of BUTCHER.³ A greater degree of

² BL O/262/06

³ By analogy as to extent of permissible alteration, see *Hyphen GmbH v EU IPO*, Case T-146/15, where the General Court held that the addition of a circle, being merely a banal surrounding for the registered mark, did

variation is present in variant form (v). It omits the hyphen, but also renders the word “the” in title case and in a cursive script, centred above the word “butcher” which is presented in uppercase and in thick font letters. The word appears in the EU trade mark register in uppercase, but it is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalisation that appears on the trade mark register.⁴ I consider these differences in orientation, case and font to be minor and that they do not alter the distinctive character of the earlier trade mark as registered.

27. I find use of “THE BUTCHER”, “The Butcher” and the variant form (v) to be acceptable forms of variant use permitted by section 6A(4)(a) of the Act. My task therefore proceeds to determine whether the submitted evidence is sufficient to show that Mark A has been put to genuine use during the relevant period in relation to all of the registered services on which relies.
28. This determination must be made in light of the numerous principles established in relevant case law. The case law on genuine use of trade marks was summarised by Arnold J in *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, who said as follows:

“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 Court of Justice of the European Union (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

not alter the distinctive character of the mark as registered. See too, *Menelaus BV v OHIM* judgment of the General Court in Case T-361/13 - 18 November 2015, particularly at paragraph 73.

⁴ See for example decision of Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14.

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 Bundesvereinigung 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].”

29. Since Mark A is a registered European Union Trade Mark, it is also necessary to bear in mind judicial comment in leading cases that have considered the geographic extent of the use required to be shown.

30. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union noted that:

“36. It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine

or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

31. The Court in *Leno Merken* held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

32. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

33. The General Court restated its interpretation of *Leno Merken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition (and cancellation) proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.
34. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant five year period. In making the required assessment I must consider all relevant factors, including:
- i) The scale and frequency of the use shown
 - ii) The nature of the use shown
 - iii) The goods and services for which use has been shown
 - iv) The nature of those goods/services and the market(s) for them
 - iv) The geographical extent of the use shown
35. In making my determination as to whether the evidence presented shows the necessary genuine use, I also take account of judicial comment as to probative and evidential issues in such cases. In *Awareness Limited v Plymouth City Council*⁵, Mr Daniel Alexander Q.C. sitting as the Appointed Person stated that:
- “22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly

⁵ Case BL O/230/13

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.”

36. In *Dosenbach-Ochsner*⁶, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person stated that:

“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.”

37. The Opponent’s submissions refer to relevant case law on genuine use, and claim that the Opponent’s evidence clearly shows actual use of the mark in respect of its services in class 43⁷ in the Netherlands and elsewhere in the EU, which is more than merely token and which is by way of real commercial exploitation of the mark on the market.

38. I find that the evidence clearly shows the existence of at least two restaurants in Amsterdam under Mark A. A third restaurant by that name is said to have opened in Berlin in June 2016 (just inside the relevant period) and a fourth is trailed to open Ibiza 2017, but that falls outside the relevant period. The evidence is very thin as to those being “... 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

⁶ *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13

⁷ The submissions refer to class 42 as covering these services, but this may be presumed to be a typographical error as the services are correctly described and correctly referenced elsewhere in the Opponent’s claim.

advertising campaigns” as stipulated in *Ansul* at [37]. Mention is made of plans for Dubai and the UK, but there is little or no supporting evidence on that point.

39. It is surprising that the evidence includes nothing to indicate financial turnover from the services under the trade mark during the five year period. I have also mentioned that I found unclear the information as to expenditure on advertising. However, there is substantial evidence that Mark A has been widely promoted during the relevant period, including in well-known publications and including English language articles in publications or on fora that are likely to be accessed beyond the Netherlands.
40. I note its relatively high ranking on TripAdvisor for restaurants in the Dutch capital city, that well over half of the reviews on TripAdvisor are in English and that the reviewers are from diverse countries, including the UK. Only one of the sample reviews in evidence falls within the relevant period (7 April 2016, by someone from the UK), but as the reviews sampled appear to be the most recent of a large number, it is reasonable to infer that many (perhaps the majority) of reviews on that site are likely fall within the relevant period. I also note the coverage in the Lonely Planet travel guide.
41. On balance I find that the evidence is sufficient to show genuine use of Mark A between 2012 and June 2016. The next step is to decide whether the Opponent’s use entitles it to rely on all of the services for which it is registered (or on some only). The evidence undoubtedly shows the earlier mark used at least in relation to “*restaurant, bar ... services*”. The witness statement mentions “THE BUTCHER on Wheels (a food truck)” and there is substantial evidence of the operation of THE BUTCHER restaurants, which given the nature of a burger bar, offers some evidence of the “*providing of (take-away) food*” - but the evidence on that point is thin. Despite the reference to a “*full service concept*” under Exhibit ES1, there is no explicit evidence for “*providing of beverages (self-service)*”, and little for “*cafe services.*” The evidence shows no use at all for “*catering services*”, the meaning of which, to the average consumer, is the provision of bespoke food and drink for a particular event or occasion.
42. Where proof of use of an earlier mark is validly requested and the submitted evidence is sufficient only for part of the services listed, the earlier mark is deemed registered for only those services and any analysis as part of an opposition is consequently restricted. In

*Euro Gida*⁸, Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person explained that “ ... 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.”

43. Consequently, the Opponent may rely on Mark A as a basis of its claim under section 5(2)(b) of the Act in relation to the following services in class 43: *cafe, restaurant and bar services*.

DECISION

44. The Opponent's claim is based on section 5(2)(b) of the Act, which states:

“... A trade mark shall not be registered if because-

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

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

45. The following decisions of the EU courts provide the principles to be borne in mind when considering section 5(2)(b) of the Act:

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;

⁸ *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10. That was a case based on revocation, but its principles for shaping a fair specification for the purposes of genuine use apply also to opposition cases. See also Carr J in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

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.

46. The principles are that:

- (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 the services

47. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the General Court stated⁹ that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application, or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark. This principle holds true for services as well as for goods.
48. The Applicant's services in class 43 for "*services for providing food and drink; restaurant services.*" The services on which the Opponent is able to rely for Mark A are "*cafe, restaurant and bar services*" in the same class. Restaurant services in both specifications are plainly identical. The Opponent's services fall within the Applicant's services for providing food and drink, so they too are identical based on *Meric*.

⁹ Case T- 133/05 at paragraph 29 of that judgment.

The average consumer and the purchasing process

49. It is necessary to determine who is the average consumer for the respective services and how the consumer is likely to select the services.
50. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:
- “60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect*
- ... the relevant person is a legal construct and ... the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical....”*
51. 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*).
52. The Opponent submits that *“the services are directed at the public at large and are every day type services. Overall, the average consumer of the services at issue will pay a reasonable level of attention but not a high degree of attention.”* I agree that the average consumer will be a member of the general public who will pay a reasonable level of attention when choosing a restaurant.
53. The purchasing act for the services will be visual as the mark will likely be prominently visible before entering a restaurant on various signage, and once inside a restaurant likely used on menus and even on staff apparel. Likewise the mark will likely be seen on websites or in advertising materials. However, I do not discount aural considerations which may also play a part, including through word of mouth recommendations.

Comparison of the marks

54. It is clear from *Sabel* 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 (CJEU) stated in *Bimbo* 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 would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

Opponent’s earlier registered EU trade mark - Mark A:	THE-BUTCHER
Applicant’s contested trade mark:	

56. The Opponent’s registration under Mark A is a word mark consisting of two words, “THE” and “BUTCHER”, with a hyphen between them.

57. The Opponent makes submissions about the overall impression of its earlier mark. It submits that the word 'the' within its earlier trade mark *“is merely a definite article and would be overlooked by the relevant public”* and that *“the dominant and distinctive part ... is therefore the word BUTCHER. This word is the first part of the mark of the contested application. It is a commonly accepted principle of trade mark law that the beginning of a mark is the dominant and more memorable part for consumers.”*
58. I agree that the dominant component contributing to the overall the impression of Mark A is the word “butcher.” I find that the inclusion of the definite article “the” is not negligible and makes it clear that the word “butcher” is used as a noun, however, the definite article is both shorter and secondary to that word, which dominates. The hyphen is very small and I consider it likely that the average consumer may overlook its presence. I find that the hyphen is a weak element in the overall impression of the mark.
59. The Applicant’s mark is figurative and consists of three words presented in thick block capitals, the first being BUTCHER, followed by AND and GRILL. The linking word “and” is presented in a significantly smaller font size than the other two words. A red diagonal line and a parallel longer black line cut across the bottoms of the final letters “R” and “D” in the words BUTCHER and AND, and across the top of the “G” in GRILL.
60. The word GRILL is one commonly used in connection with restaurant services – as in, for example, a bar and grill - being synonymous with an establishment that specialises in serving grilled meat, fish and vegetables. It is therefore descriptive and/or highly allusive in relation to the Applicant’s services and so carries little distinctive weight in the overall impression of the mark.
61. Similarly, the word “AND” serves as a common linking word, and its smaller size and position within the mark further lessen its impact in the overall impression of the mark. I find that it is the word BUTCHER that has the most impact in the Applicant’s mark because it is both the first and longest of the three words and it is not directly descriptive in relation to the relevant services.
62. The figurative device of the parallel lines is not negligible but, despite its inclusion of red, it is not especially striking and I find that it makes a subsidiary contribution to the impression overall.

Visual similarity

63. The marks share the same distinctive word BUTCHER, which I also consider to be the dominant component in the marks of both parties. I find Mark A and the Applicant's mark to be visually similar to a medium degree.

Aural similarity

64. The hyphen within Mark A will not be voiced, nor can the parallel lines device of the Applicant's mark be voiced. The marks include words that are not present in the other party's mark, but in light of the shared presence of the distinctive and dominant word BUTCHER, I find that the marks are aurally similar to a medium degree.

Conceptual similarity

65. The inclusion of the definite article in the Opponent's Mark A signifies the usage of the word as a noun, indicating a person whose trade is cutting up and selling meat in a shop. By contrast, it is possible that the average consumer may perceive within the concept of the Applicant's mark a usage of the word BUTCHER as a verb - and likewise for the word GRILL. (The mark in that conception becomes a phrase that could perhaps be suggestive of the immediacy of the prepared and cooked offerings – the phrase “butcher and grill” intended as something in the line of “click and go”.) However, I find it likely that a significant proportion of the public would perceive the words BUTCHER and GRILL within the Applicant's mark as nouns, just as the former word is used in the Opponent's Mark A. Since I find that the average consumer perceives BUTCHER in the same way in both marks, there is identity in that aspect. I therefore find that the marks are conceptually similar to a reasonably high degree.

Distinctive character of earlier trade mark

66. The distinctive character of an earlier mark must be considered. The more distinctive the earlier mark, either by inherent nature or by use, the greater may be the likelihood of

confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

*“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).*

*23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”*

67. Mark A comprises two familiar and standard English words. The mark is mildly allusive to a likely emphasis on the service of meat within the registered services, but it does not directly describe the relevant services so has at least a reasonable level of inherent distinctiveness. The level of distinctiveness of a mark may be enhanced through use, although it is only UK use that counts for enhanced distinctiveness because the issue is the effect that any use has on the perception of the UK consumer. Despite evidence as to promotional coverage over a number of years, its potential on-line reach to tourists and its apparently growing presence, the Opponent’s evidence shows no clear use of its mark in the UK at all and is not sufficient to show an enhanced level of distinctiveness in relation to the relevant services.

Conclusion as to likelihood of confusion

68. I now turn to reach a conclusion as to the likelihood of confusion between the marks if they were used in relation to the services specified.
69. Confusion can be direct (which in effect occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related). Indirect confusion, was considered by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*,¹⁰ where he noted that:

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

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case)*

¹⁰ Case BL-O/375/10

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

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

70. I make a global assessment of likelihood of confusion that takes account of my findings set out in the foregoing sections of this decision and of the various principles from case law outlined in paragraphs 21 and 22 above.

71. I have found identity between the parties’ services and that the relevant average consumer is a member of the public who would pay a reasonable level of attention when choosing the services at issue. In that selection process, visual considerations tend to predominate and I have found that the Applicant’s mark shares at least a medium degree of visual similarity with Mark A, along with a medium degree of aural and reasonably high degree of conceptual similarity. I have found at least a reasonable level of inherent distinctiveness in the earlier Mark A, but which is not enhanced by use.

72. When I weigh in the balance all of the above factors, I find in this case that there would be a likelihood of confusion on the part of the relevant UK public as to the origin of the services at issue. **Consequently, the opposition succeeds on the basis of section 5(2)(b).**

73. The Opponent has succeeded in full on the basis of Mark A and would be in no better a position in respect of Mark B. In the circumstances I do not consider it proportionate or necessary to consider the Opponent’s claim in relation to Mark B.

Costs

74. The Opponent has been successful and is entitled to a contribution towards its costs, which I assess based on the guidance in Tribunal Practice Notice 2/2016. I award the Opponent the sum of £1100 (one thousand one hundred pounds) as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Reimbursement of the official fee for Notice of Opposition and Statement of Grounds:	£100
Preparing a statement of grounds and considering the other side's statement:	£200
Preparation of evidence:	£500
Preparing submissions:	£300
Total:	£1100

75. I therefore order Atlantic Graphic Solutions Ltd to pay Entourage B.V. the sum of £1100 to be paid within fourteen days of the expiry of the appeal period, or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of August 2017

Matthew Williams

For the Registrar, the Comptroller-General