

TRADE MARKS ACT 1994



IN THE MATTER OF TRADE MARK APPLICATION NO 3188003 BY NOW CLICK 2 EAT LIMITED TO REGISTER A DEVICE MARK AS A TRADEMARK IN CLASS 43

AND OPPOSITION THERETO (UNDER NO. 408132) BY VIKAS KUNNURE

DECISION

INTRODUCTION

1. By a decision dated 17 May 2017, taken after written submissions alone, the Registrar’s hearing officer Ms June Ralph, dismissed an opposition to registration of the mark in issue brought by the opponent under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent appeals, contending that, although the hearing officer correctly stated the principles for evaluating similarity and likelihood of confusion, she adopted an incorrect approach to their application in a number of ways.
2. The rival marks are as follows:

Opponent’s mark	Applicant’s mark
 The logo consists of the text "Click-EAT" in a red, sans-serif font. The "i" in "Click" has a dot, and the "A" in "EAT" has a horizontal bar.	 The logo features the text "NOW CLICK 2 EAT" in a yellow, sans-serif font. The "i" in "CLICK" has a dot. Above the text is a red curved line with a dot at its peak. A yellow arrow points from the bottom left towards the "2".

3. The specifications of the respective marks were extensive and were set out in the decision under appeal. They focus on the provision of services relating to food and drink in class 43 and among the long list of services for the applicant was made were “*Services for providing food and drink; restaurants, takeaways fast food services, bar and catering services; booking and reservation services for restaurants; Catering services for parties. Catering services for the provision of food; Catering services for the provision of food and drink*”. Since there is no dispute that many of the services are either very similar or identical to those for which the opponent’s mark is registered, it is unnecessary at this stage to consider them further in detail.

Approach to appeal

4. In *Apple Inc v Arcadia Trading Ltd* [2017] EWHC 440 (Ch) (10 March 2017) Arnold J approved the summary of the principles in *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) as follows:

“Standard of review

The principles applicable on an appeal from the Registrar of Trade Mark were recently considered in detail by Daniel Alexander QC sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [14]-[52]. Neither party took issue with his summary at [52], which is equally applicable in this jurisdiction:

"(i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR 52.11). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong (Patents Act 1977, CPR 52.11).

(ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multifactorial decisions often dependent on inferences and an analysis of documentary material (*REEF, DuPont*).

(iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B and others*).

(iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an

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Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country* and others).

(v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).

(vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson* and others)."

5. Neither side took issue with that summary, which has been applied in other cases. It is consistent with other more recent authorities on the approach to appeals before the Appointed Person.
6. The opponent was represented on the appeal. The applicant took no active part in it contending, in effect, that the mark was unobjectionable for the reasons given in the hearing officer's decision.

The decision under appeal and the criticisms of it

7. Having set out the familiar legal principles for evaluating similarity and likelihood of confusion, the hearing officer conducted the evaluation as follows:

"18. The opponent's mark consists of the two words Click-EAT in colour, separated by a hyphen. The colour is recorded as Orange Pantone 18-1561 TPX. I note the applicant mentions the colour of the opponent's mark in his submission: "...they have not portrayed their brand in its true identity for e.g. the colour is a very important part of the brand identity and they have not displayed their brand in its truest form as evidence." I do not think the opponents have set out to disguise their mark. That the opponent's mark has appeared in

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correspondence as black and white, I put down to material having been emailed, faxed or photocopied in multiple copies. However for this decision I am considering the opponent's mark as it was registered and I do not think that the colour will have that much impact. Rather it is the words Click-EAT which will dominate the overall impression of the mark.

19. The applicant's mark is a composite one comprising several separate devices of cutlery, an arrow and an arc and circle, as well as the stylised words and numeral NOW CLICK 2 EAT. This mark is also presented in colour. It is a general rule of thumb that words speak louder than devices. I consider that rule to be applicable here. Although the device elements are distinctive and have substantial visual impact, it is the word element, NOW CLICK 2 EAT, by which the mark is likely to be referred to and which carries the greater weight in the overall impression of the mark.

20. In a visual comparison of the marks, the only point of similarity are the words CLICK and EAT. The opponent's mark has no other visual elements whereas the applicant's mark has an arc and circle device placed above the words, cutlery devices forming part of the words themselves and an arrow resembling a computer cursor below the words. I find there is a low degree of visual similarity.

21. In an aural comparison of the marks, it is unlikely that a consumer would vocalise the device elements of the applicant's mark. It is more likely that only the words NOW CLICK 2 EAT (with the numeral 2 being commonly swapped for the word 'to') would be vocalised. The opponent's mark would be vocalised as CLICK EAT. The two common elements of the marks are CLICK and EAT and they are pronounced in the same way and are aurally identical. I consider there to be a medium degree of aural similarity.

22. In a conceptual comparison of the marks, to the extent that either mark has an 'immediately graspable concept', which at its most literal could be seen as an instruction to click then eat, then it would be highly similar, if not identical. The arc and circle device element is unlikely to form part of a conceptual hook but the cutlery and arrow device may reinforce the notion of clicking and eating."

....

24. The opponent did not file any evidence showing use for the services relied on so I can only consider the inherent distinctiveness of the earlier mark.

25. As previously stated the earlier mark contains two words CLICK-EAT separated by a hyphen. Although this mark does not directly describe the provision of food and drink ordered on line, or restaurant reservation services provided on line, as it is truncated and lacks a correct grammatical structure, I find that the mark does at least allude to those services. I find that it has a low level of inherent distinctiveness for those services. In relation to the opponent's services which are not provided on-line (the specification is not limited to on

line services), the distinctiveness is higher but I would still pitch it as below average.

LIKELIHOOD OF CONFUSION

26. I must now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors:

a) The interdependency principle, whereby a lesser degree of similarity between the services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).

b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).

c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

27. I have found that the marks are visually similar only to a low degree, aurally similar to a medium degree and conceptually similar to a high degree, if not identical. In addition I have found that a varying degree of attention will be paid to purchasing of the services. I also remind myself that the purchasing process will be largely visual and so this factor is particularly important. Taking these factors into account, together with the low/below average degree of inherent distinctiveness of the earlier mark, I find that, notwithstanding the identical services in play, there is no likelihood of confusion either directly or indirectly, even having regard for the potential for imperfect recollection of the marks.

8. The opponent criticises this evaluation in a number of ways.

(i) Colour

9. First, the opponent contends that the hearing officer failed to take adequate account of the fact that the respective marks were both predominantly reddish orange in colour. However, the hearing officer said that she did not consider that the colour would have much influence. While I think that is correct, it seems to me that colour would affect the issue of similarity of marks to some degree, all the more so if visual comparison was important. There is substance in the criticism that the hearing officer seems to have given this factor no importance at all rather than evaluating the weight it would have been likely to have. However, if that had been the only issue, I would not have regarded it as sufficient to warrant interference.

(ii) Device elements

10. Second, it is said that the hearing officer overestimated the impact of the device elements in differentiating the marks, given them undue weight given their descriptive character for services relating to food. In my view, there is also something in that point, especially since the hearing officer also (and rightly) treated the verbal element as the most important part of the marks. Equally, if that had been the only issue, it would have fallen into the category of points where the hearing officer was entitled to make that evaluation.

(iii) Different perceptions of the mark

11. Third, it is said that the hearing officer left out of account the fact that the verbal element of the mark could reasonably be perceived as “NOW, CLICK EAT 2”.

12. In my judgment this point has the greatest substance. The way in which the mark is depicted lends itself to being read in that way at least by some. There is nothing which requires it to be read as “NOW CLICK 2 EAT” and it could well be treated by some members of the public as indicating that, now, a second CLICK EAT was available. Thus understood, the mark in issue may be viewed as a brand extension of the opponent’s mark, denoting a new but related business. The hearing officer did not consider this potential issue. Nor did she consider whether, as a result, there was a realistic possibility of indirect confusion. As Mr Iain Purvis QC, sitting as the Appointed Person, explained in *LA Sugar Ltd v By Back Beat Inc. O/375/10*, a risk of indirect confusion arises where a consumer appreciates that there is a difference between the two marks but thinks that they nonetheless denote goods or services coming from the same trade source, because key features of the respective marks are common. The paradigm case is one in which the consumer is likely to think that there has been a brand extension.

13. In my judgment, the hearing officer therefore left out of account both a realistic way in which the mark could be perceived in evaluating similarity and a realistic way in which confusion may occur as a result of the similarities that existed. It is noteworthy, in this connection that she concluded that the mark had low visual similarity, medium aural similarity but high conceptual similarity. As to the latter she considered that the concept

of the marks was very similar. That, to my mind, would increase the prospect of consumers considering that one mark denoted a brand extension of the other.

14. In consequence, I consider that the opponent is correct to submit that this matter requires reconsideration on the basis that the hearing officer approached the evaluation in too narrow a way, involving an error of principle. In my judgment, having regard to (a) her findings as to the degree of conceptual similarity with which I agree, (b) my view that the visual similarity was somewhat higher than the hearing officer allowed for, both as a result of the similarity in colour and as a result of the fact that the verbal elements of the mark could be perceived as a “NOW, CLICK EAT 2” and (c) the fact that there was medium aural similarity, it is necessary to consider the issue of likelihood of confusion afresh on that basis.

Principles

15. The principles upon which that evaluation is to be done are not in doubt and were set out by the hearing officer as follows:

“7. The leading authorities which guide me are from the Court of Justice of the European Union (‘CJEU’): *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

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in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

16. The hearing officer’s evaluation of the characteristics of the average consumer were not challenged. She described them as follows:

“13. The average consumer for these services will be the general public and businesses. There will be a varying level of attention paid depending on the particular service. For example the purchase of a takeaway or a fast food meal is likely to be less considered as these are common casual purchases whereas the selection of a catering provider for an event will be a more considered process depending on the event, cost and venue.

14. With regard to the purchasing process, selection of food and drink provision is primarily a visual act. Consumers are likely to read advertising material, menus and the like or search the internet to find a suitable caterer or restaurant or they will see the frontage of a food provider’s premises. However, I also consider there could be an aural element if catering providers or restaurants are recommended by word of mouth or if food is ordered over the telephone.”

17. As to the distinctiveness of the marks, I agree with the hearing officer that the marks are not particularly distinctive. The majority of the services for which it is registered would be provided at physical premises. Typical use of both marks would be on signs,

menus, till receipts and so on. In respect of services so provided, the “click” element would not be descriptive. However, they are more descriptive in respect of such services provided over the internet (such as ordering take-away food). Nonetheless, I am not persuaded that the common elements of the marks are so non-distinctive that, if confusion was otherwise likely, this would avoid it for all or some of the services simply because they were provided on-line. Moreover, it was not suggested in this case that different arguments should apply to different services and I have therefore approached this re-evaluation on the basis that there is no distinction although, should the issue arise in any other context (for example were the earlier mark to be asserted in respect of services provided over the internet), this point may need to be considered again with the benefit of proper evidence.

18. Having regard to all of the factors, including those referred to by the hearing officer, I consider that there is a risk of confusion. This arises primarily out of the risk of the applicant’s mark being perceived to be a brand extension of the opponent’s mark in the manner described above but also, in part, from the fact that the average consumer who is assumed to have the concept of the opponent’s mark in mind but does not recall the detail of it may regard the applicant’s mark as denoting the opponent’s services as a result of an imperfect recollection of the conceptual similarities which would not be diminished by the other differences between the marks.
19. There is therefore sufficient risk that the average consumer would be confused in two ways to justify refusal of the application under section 5(2)(b) of the Act.

OVERALL CONCLUSION

20. The appeal succeeds and the mark will be refused registration pursuant to section 5(2)(b) of the Act for all of the services applied for.

Costs

21. The hearing and the skeletons before me and before the hearing officer were brief. No evidence was filed. In my view the opponent should be entitled to costs in this tribunal and before the hearing officer in each case of £300, making a total of **£600**.

DANIEL ALEXANDER QC

Appointed Person

30 September 2017

Representation

Andrew Marsden of Wilson Gun for the opponent/appellant

The applicant/respondent was not represented