

O-565-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3157886 BY
MICHAEL A. JOWETT
TO REGISTER:**

WINGWING

AS A TRADE MARK IN CLASS 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 407165 BY STICKY SISTERS LIMITED**

BACKGROUND & PLEADINGS

1. On 4 April 2016, Michael A. Jowett (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the services shown in paragraph 10 below. The application was published for opposition purposes on 13 May 2016.

2. On 15 August 2016, the application was opposed in full by Sticky Fingers Limited (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon European Union Trade Mark (“EUTM”) registration no. 14174015 for the trade mark **WING INN** which was applied for on 26 May 2015 and entered in the register on 28 September 2015. The opponent relies upon the services shown in paragraph 10 below.

3. The applicant filed a counterstatement in which the basis of the opposition is denied. The applicant states, inter alia:

“...The more distinctive part of the [opponent’s trade mark] is therefore the word WING, which might refer to the small town of Wing in Buckinghamshire, or might refer to a wing for example of a bird.”

4. In these proceedings, the opponent is represented by Nucleus IP Limited and the applicant by Coller IP Management Ltd. Whilst both parties filed evidence and submissions during the evidence rounds neither elected to be heard nor did they file written submissions in lieu of attendance at a hearing.

DECISION

5. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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

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

6. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. In these proceedings, the opponent is relying upon the trade mark shown above, which qualifies as an earlier trade mark under the above provisions. As this earlier trade mark had not been registered for more than five years at the date when the application was published, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon it in relation to all the services it has identified.

The evidence

8. The opponent filed two witness statements, both from Ese Akpogheneta, a trade mark attorney at Nucleus IP. The first statement, dated, 8 May 2017, was accompanied

by two exhibits and the second, dated 29 August 2017, by five exhibits. The applicant also filed two witness statements, both from Peter Mansfield, a patent and trade mark attorney at Coller IP Management Ltd. Both statements, dated 27 February and 4 July 2017 respectively, were accompanied by two exhibits. As a good deal of this evidence does not assist me in reaching a decision, I shall not summarise it here. I will, however, refer to the evidence and the submissions which accompanied it as and when I consider it appropriate to do so.

Section 5(2)(b) – case law

9. The following principles are gleaned from the decisions of the courts of the European Union 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 greater degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of services

10. The competing services are as follows:

Opponent's services in class 43	Applicant's services in class 43
Services for providing food and drink; restaurant services; bar services; café services; catering; canteens; preparation of foodstuffs or meals for consumption on or off the premises; food and drink takeaway services; providing prepared meals; the provision of food-ordering services through an-online computer network; information, advisory and consultancy services relating to all the aforesaid.	Cafe, cafeteria, restaurant, snack-bar, coffee shop and catering services; services for the provision of food and drink; consultancy and advisory services, all relating to catering.

11. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

12. The opponent's specification includes (i) "Café services", (ii) "restaurant services", (iii) "catering" and (iv) "services for providing food and drink" which are identical to (i) "café" and "cafeteria services", (ii) "restaurant services", (iii) "catering services" and (iv) services for the provision of food and drink" in the applicant's specification. In addition, as, inter alia, "services for providing food and drink" in the opponent's specification would include "snack-bar" and "coffee shop services" in the application, such services are identical on the *Meric* principle. Finally, as the opponent's specification includes both the term "catering" and the phrase "information, advisory and consultancy services relating to all the aforesaid", the applicant's "consultancy and advisory services all relating to catering" is, once again, identical.

The average consumer and the nature of the purchasing act

13. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' services; I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

14. The average consumer of the services at issue is a member of the general public. As such services are most likely to be selected having considered, for example, signage appearing on the high street and promotional material (in hard copy and on-line), visual

considerations will be an important part of the selection process. However, as such services are also, in my experience, very likely to be the subject of word-of-mouth recommendations, aural considerations will be a not insignificant feature of the selection process. The degree of care the average consumer will display when selecting the services at issue is likely to vary. Consider, for example, the fairly high degree of care likely to be paid to the selection of a caterer for a wedding or important family event with the relatively low degree of care likely to be paid to the selection of a bar for an impromptu drink. I will return to this point when I consider the likelihood of confusion.

Comparison of trade marks

15. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, 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.”

16. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
WING INN	WINGWING

17. In reaching the conclusions which follow I have taken account of, but do not intend to record here, the parties' competing submissions on this aspect of the case.

18. The opponent's trade mark consists of two separate words both presented in block capital letters. Collinsdictionary.com defines "INN" as "a pub or small hotel providing food and accommodation". That is the meaning the word conveyed to me and, more importantly will, in my view, be how the average consumer understands the word. Although the word "INN" will contribute to the overall impression the opponent's trade mark conveys, when considered in the context of the services upon which the opponent relies, it has very little, if any, distinctive character.

19. As the word "WING" appears as the first word in the opponent's trade mark, it will make an important contribution to the overall impression it conveys. The average consumer will be very familiar with the word "WING". As to its meaning and distinctiveness, the applicant has provided evidence and submissions to support its contention that "WING" is a civil parish in Buckinghamshire (and as a consequence lacks distinctive character). I note that in its submissions, the applicant repeats a comment made in its counterstatement, when it states:

"11... WING is a geographical place name (as well as being a food item)..."

20. When considered in the context of the services at issue and the likely size of the geographical location in question (which is likely to be unknown to the vast majority of average consumers), it is that latter meaning which, in my view, the average consumer is most likely to attribute to the word "WING" i.e. the wing of a bird as an item of food. Support for that approach can be found in the applicant's submission above as well as

in the opponent's evidence (exhibits EAA1-EAA5), which provides pages from, inter alia, the applicant's website and "third party food delivery and directory websites". Although all the exhibits appear to be from after the material date in these proceedings, I note that exhibit EAA3 (from the applicant's Facebook page) contains the following:

"Starting the week trying to be healthy...Watcha looking at..Who we kidding...It's time for Krispy Korean Chicken wings, legs & burgers."

21. Exhibit EAA4 contains an extract from the Jinn website which describes the applicant in the following terms:

"You think you know fried chicken? Think again! Inspired by the chicken and beer chimaek joints of Korea and their New York imitators our crispy crackly wings are the best you've ever tasted. Flipping the bird to all competition."

22. Although that evidence relates to the applicant, when considered in the context of the opponent's "services for providing food", "restaurant services" and "catering" services which relate to the provision of, for example, chicken wings, the word "WING" has little or no distinctive character. It could, however, be argued that when considered in relation to the opponent's "café services" and "services for providing drink" the word "WING" is distinctive. However, even in relation to such services the average consumer will, in my view, attribute to the word "WING" the meaning mentioned above, leading them to conclude that, for example, the café provides wings as part of its offering together with, for example, drinks or other foodstuffs which complement wings. Considered overall, like the word "INN", the word "WING" has very little if any distinctive character. Thus the overall impression the opponent's trade mark conveys and its distinctiveness lies in its totality.

23. Despite the applicant's submission to the effect its trade mark has a "very distinctive and unusual representation" which it describes as a "pseudo 3-D", I am satisfied that despite its presentation, the average consumer will immediately construe it as

consisting of the word “WING” repeated i.e. as “WING WING”. I have already commented upon the distinctiveness of the word “WING” above. Although the stylisation will contribute to the overall impression conveyed, as the average consumer is accustomed to seeing trade marks being presented in a wide range of formats, it does not add a great deal to the trade mark’s distinctive character. Rather, it is the repetition of the word “WING” that will dominate the overall impression the trade mark conveys and which will make by far the greatest contribution to its distinctive character.

The visual, aural and conceptual comparison

24. Presented as two separate words and the two same words conjoined, the competing trade marks consist of seven and eight letters respectively. The first four letters i.e. “W-I-N-G” are identical. Both trade marks also contain the letters “I-N” (albeit in the fifth and six letter positions in the opponent’s trade mark and the sixth and seventh letters positions in the applicant’s trade mark). Although the stylisation in the applicant’s trade mark creates a visual difference, considered overall, the competing trade marks are still visually similar to an above average degree.

25. As the words in the competing trade marks will be well-known to the average consumer their pronunciation is entirely predictable i.e. both will be pronounced as two syllables i.e. “WING INN” and “WING WING”. Notwithstanding that the “W” in the second syllable of the applicant’s trade mark will create a point of aural difference, the similar aural rhythm resulting from the identical first syllables and the similar sounds created by the word “INN” and the “ING” ending in the applicant’s trade marks, results in a fairly high degree of aural similarity between them.

26. Finally, the conceptual comparison. Considered in the context of the services at issue, the opponent’s trade mark is, in my view, likely to convey the concept of an inn which provides, inter alia, foodstuff in the form of, for example, chicken wings. As for the applicant’s trade mark, the emphasis created by the repetition of the word “WING” is, in my view, most likely to suggest a specialism in wings. As the competing trade marks

both convey the concept of wings, they are, to that limited extent, conceptually identical. However, as the concept conveyed by the word “INN” is entirely alien to the applicant’s trade mark, it creates a clear point of conceptual difference.

Distinctive character of the earlier trade mark

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

28. As the opponent has not provided any evidence of the use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. In view of my conclusions above in relation to the words “WING” and “INN” in the context of the services at issue, it follows that absent use, the opponent’s trade mark is possessed of a low degree of inherent distinctive character. It is, of course, only the distinctive character of the shared component that matters; I shall return to this point below.

Likelihood of confusion

29. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also

keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that:

- the competing services are identical;
- the average consumer of the services is a member of the general public. Such a consumer will select the services at issue using a combination of visual and aural means paying a varying degree of attention during that process;
- the overall impression conveyed by the opponent's trade mark and its distinctiveness lies in its totality;
- the overall impression conveyed by the applicant's trade mark and its distinctiveness will be dominated by the repetition of the word "WING";
- the competing trade marks are visually similar to an above average degree, aurally similar to a fairly high degree and conceptually similar to the extent that both evoke the concept of wings as an item of food;
- considered as a totality, the opponent's earlier trade mark is possessed of a low degree of inherent distinctive character.

30. Insofar as the last bullet point is concerned, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He stated:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use,

the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

31. In other words, simply considering the level of distinctive character possessed by the earlier trade marks is not enough. It is important to ask “in what does the distinctive character of the earlier trade marks lie?” Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

32. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and services down to the responsible undertakings being the same or related.

33. In reaching a conclusion, I begin by reminding myself that identical services are involved and, inter alia, there is a fairly high degree of aural similarity and an above average degree of visual similarity between the competing trade marks; these are all points in the opponent's favour. However, the degree of visual, aural and conceptual similarity between the competing trade marks stems, primarily, from the inclusion in both of the word “WING” which has very little if any distinctive character i.e. these are all points in the applicant's favour. Having weighed these competing positions, I am satisfied that when selecting an undertaking to provide the services at issue, the average consumer will be alive to the fact that the word “WING” has the meaning mentioned above. This, together with the additional conceptual message the word “INN” in the opponent's trade mark introduces is, in my view, sufficient to avoid a likelihood of

either direct or indirect confusion, even if the average consumer pays only a relatively low degree of attention during the selection process (which would make them more prone to the effects of imperfect recollection). As the degree of attention paid during the selection process increases, the prospect of confusion (on either basis) reduces still further. As a consequence of the above conclusions, the opposition fails.

34. For the sake of completeness, I should add that the applicant's evidence and submissions relating to the examination of what is now the opponent's earlier trade mark at the European Union Intellectual Property Office ("EUIPO") and the presence of a still earlier EUTM in class 43 for the trade mark "WING WING" in the name of a Canadian company, has played no part in my conclusions. As the opponent points out in its submissions and as the applicant ought to have been aware, such evidence is irrelevant.

Conclusion

35. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

36. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Using the TPN mentioned as a guide, but making no award to the applicant in relation to its evidence (which played no part in these proceedings), I award costs to the applicant on the following basis:

Reviewing the Notice of Opposition and preparing a counterstatement:	£200
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Filing of written submissions:	£200
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Total:

£400

37. I order Sticky Sisters Limited to pay to Michael A. Jowett the sum of **£400**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 09th day of November 2017

C J BOWEN

For the Registrar