

O-076-18

TRADE MARKS ACT 1994

IN THE MATTER OF A REQUEST FOR PROTECTION IN THE UK  
OF INTERNATIONAL REGISTRATION NO 1286770  
BY HEATHER TIERNEY  
FOR THE TRADE MARK

THE BUTCHER'S DAUGHTER

IN CLASSES 32 AND 43

AND

OPPOSITION THERETO UNDER NO 406594  
BY ENTOURAGE B.V.

## Background

1. Heather Tierney (“the holder”) is the holder of international trade mark registration number 1286770, THE BUTCHER’S DAUGHTER. The holder requested protection in the UK for her international registration (“IR”) on 13 January 2016 for goods and services in classes 32 and 43 which I set out later in this decision.

2. The IR was accepted and published in the *Trade Marks Journal* on 11 March 2016. Entourage B.V. (“the opponent”) opposes the IR under section 5(2)(b) of the Trade Marks Act (“the Act”) relying on the following European Union trade marks (“EUTM”):

Mark	Dates	Services relied upon
EUTM9406661 THE-BUTCHER	Filing date: 28 September 2010 Date of entry in register: 20 May 2011	Services in class 43
EUTM14005417 The Butcher Social Club	Filing date: 28 April 2015 Date of entry in register: Not yet registered	Services in classes 41 and 43

3. The opponent claims the respective marks are visually, aurally and conceptually highly similar and cover identical and/or highly similar goods and services such that there is a likelihood of confusion, which includes the likelihood of association, on the part of the public. It claims the relevant public will either be confused or will assume that there is an economic association between the two undertakings “as the word “Daughter” implies a relationship”.

4. The opponent relies on the two marks set out above. They both have filing dates earlier than that of the IR. In the case of EUTM 9406661, the mark is registered and is an earlier mark as set out in section 6(1)(a) of the Act. In the case of EUTM 14005417, the mark is not yet registered but is subject to opposition proceedings before EUIPO. Should these proceedings be resolved and this mark achieve

registration, it would, in accordance with section 6(2) of the Act, become an earlier mark. Neither mark relied upon is subject to a requirement that the opponent should provide proof of its use. For reasons of procedural economy, I intend to consider the likelihood of confusion on the basis of the opponent's EUTM 9406661 only as, in my view, it provides the opponent with its strongest case.

5. Neither party filed evidence nor did they file written submissions in lieu of filing evidence. Neither party sought to be heard but the holder filed written submissions in lieu of a hearing. I will refer to these as necessary in this decision.

## **Decision**

6. Section 5(2)(b) states:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

## **The principles**

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 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 respective goods and services**

8. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) 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 für 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”.

9. As to what constitutes similar goods and services, in the judgment of the Court of Justice of the European Union “CJEU” in *Canon*, Case C-39/97, the court stated at paragraph 23:

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

10. ‘Complementary’ was defined by the GC in *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* Case T325/06:

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

11. I also take note of the relevant factors for assessing similarity identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281 which were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

12. With the above in mind, the goods and services to be compared are as follows:

Opponent's marks	The IR
Class 43: <i>Providing of (take-away) food and beverages (self-service); cafe, restaurant, bar and catering services; catering (food and drink-)</i>	Class 32: <i>Fruit juices and fruit drinks; vegetable juices; vegetable-fruit juices.</i>  Class 43: <i>Bar services; restaurant and café services.</i>

13. Whilst the holder has made submissions as to why her goods and services are dissimilar to certain services within the opponent's specification, she is silent as regards others. Her goods in class 32 are fruit and/or vegetable-based beverages. The high point of the opponent's case is that its specification covers services in class 43 for providing drinks. Whilst the nature of the respective goods and services differ, the users will overlap, there is commonality of trade channels and there is a complementary relationship between them as one is important for the other such that I consider they share a low degree of similarity.

14. Each of the holder's services in class 43 are included within, and therefore identical to, the opponent's cafe, restaurant, bar and catering services.

**The average consumer and the nature of the purchasing process**

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

16. 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.”

17. The holder's goods are ordinary, everyday purchases bought by the general public and which are widely available in stores, cafes, bars and other premises which sell food and drinks. They are relatively low cost items bought mainly by eye from a shelf or menu though I do not exclude the fact that aural considerations may also play a part in the purchasing process. The respective services are also widely available and bought by the general public. Again the purchase will be mainly visual, from an online search, physical advertisement or a sign on the outside of premises but as word of mouth recommendations may play a part in the selection, aural considerations must also be taken into account. The level of care taken over the purchase is likely to vary depending on, for example, whether it is a quick takeaway drink or a sit-down family meal but the goods and services are such that they will be bought with, at best, an average degree of care.

### Comparison of the respective marks

18. The marks to be compared are as follows:

The opponent's marks	The holder's mark
THE-BUTCHER (EUTM 9406661)	THE BUTCHER'S DAUGHTER

19. The opponent's earlier mark consists of the two words THE BUTCHER separated by a hyphen. Each word is presented in plain block capitals and, despite the inclusion of the hyphen, which may or may not be noticed by the average consumer, the distinctiveness rests in its whole. The holder's mark consists of the words THE BUTCHER'S DAUGHTER in plain block capitals. Whilst the addition of the apostrophe S to the word BUTCHER makes it clear that the daughter referred to is that of THE BUTCHER, neither element is more dominant than the other and the distinctiveness of the mark rests in its whole.

20. The holder submits that the respective marks are visually, phonetically and conceptually dissimilar. I disagree. Both visually and aurally, as each of the marks begin with the same two words, there is a degree of similarity between them. There are also differences between them in that the holder's mark includes the apostrophe S and word DAUGHTER which has no equivalent in the opponent's mark. When taken as wholes, the respective marks are visually and aurally similar to a medium degree.

21. Butcher is a surname, however, the use of the definite article in the opponent's mark leads away from it being interpreted in this way. Instead, the mark will bring to mind the image of a person involved in the slaughter of animals and the dressing and sale of their meat. The holder's mark brings to mind the daughter of someone who works or worked as a butcher. To the extent that both marks make reference to a butcher there is a low degree of similarity between them.



### **The distinctiveness of the earlier marks**

22. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated:

“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).”

23. The opponent has filed no evidence of any use of its mark. I therefore have only its inherent distinctiveness to consider. Its services are those providing food and drink and its mark could be said to allude to a business whose offering is heavily weighted to serving the needs of carnivores. The mark is not descriptive of such services, however, and I consider it has an average degree of inherent distinctiveness in relation to the services for which it is registered.

### **The likelihood of confusion**

24. 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 goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the earlier 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 goods and 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.

25. 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 them and goods/services down to the responsible undertakings being the same or related.

26. The holder submits that “the average consumer will perceive the mark THE BUTCHER’S DAUGHTER as a whole. The average consumer will not dissect the mark into three separate words [but] taking all factors into account, particularly given the conceptual differences between [the marks] it must be expected that consumers will not be subjected to confusion”.

27. For its part, the opponent submits that “the relevant public will either be confused or the relevant public will assume that there is a (sic) economic association between the two undertakings as the word “Daughter” implies a relationship.”

28. I do not consider the respective marks will be directly confused: the differences between them preclude such a finding. As regards indirect confusion, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained 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.

29. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

30. As regards the relevance of the conceptual message marks convey, the comments of the CJEU in *The Picasso Estate v OHIM*, Case C-361/04 P are relevant:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

I also take note, however, of the comments of the GC in *Nokia Oyj v OHIM*, Case T-460/07 where it stated:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

31. I agree with the holder that her mark will be perceived as a whole. I also agree that there are some conceptual differences between the two marks. I do not consider, however, that the conceptual differences are sufficient to neutralise the visual and aural similarities between the marks.

32. Whilst the opponent's mark may be seen as an allusion to the nature of (some of) its services, it is not descriptive of any of them. The word DAUGHTER is indicative of a relationship and, in this case, that relationship is a familial one with THE BUTCHER. I have no evidence on the point but it is not unusual, in my experience, for businesses to develop by setting up offshoot outlets, perhaps in smaller locations and offering a narrower range of goods and/or services or in temporary locations by way of pop-ups and, in each case, where the relationship with the originating business is highlighted. Taking all matters into account, I consider the average consumer will notice the difference between the respective marks but will conclude that the identical/similar goods and services at issue come from the same or economically linked undertakings i.e. there will be indirect confusion.

### **Summary**

33. The opposition succeeds in full.

### **Costs**

34. The opponent has succeeded and is entitled to an award of costs in its favour. For actions commenced after 1 July 2016, as here, the applicable scale of costs is set out in Tribunal Practice Notice "TPN" 2/2016. Using that TPN as a guide, I make the award on the following basis, noting that neither party filed evidence and that no hearing took place:

For preparing a statement and considering the statement of the other party:	£200
For written submissions:	£200

Fees: £100

**Total: £500**

35. I order Heather Tierney to pay Entourage B.V. the sum of £500. 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 1<sup>st</sup> day of February 2018**

**Ann Corbett  
For the Registrar**