

O/558/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003284731

BY FRANGO UKI LTD

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASS 43

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 412490 BY

SUMIT CHADHA

BACKGROUND AND PLEADINGS

1. On 23 January 2018, Frango UKI Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 16 February 2018 and registration is sought for the following services:

Class 43 Restaurants.

2. The application was opposed by Mr Sumit Chadha (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade marks:



(UK registration no. 2343977)

Filing date 20 September 2003; registration date 19 March 2004

(“the First Earlier Mark”)



(UK registration no. 2343978)

Filing date 20 September 2003; registration date 19 March 2004

("the Second Earlier Mark")

The logo for 'Frangos' is written in a red, cursive, handwritten-style font. The letters are connected and have a slightly irregular, artistic feel. The 'F' is particularly prominent with a large loop at the top.

(UK registration no. 2343979)

Filing date 20 September 2003; registration date 19 March 2004

("the Third Earlier Mark")

3. The opponent relies on the following services for which the earlier marks are registered:

Class 43 Restaurant, bar and catering services; booking and or reservation services for restaurants.

4. The opponent submits that the respective services are identical or similar and that the marks are similar.

5. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of its marks.

6. The applicant is represented by Hanna IP and the opponent is represented by Forresters IP LLP. The opponent filed evidence in the form of the witness statement of Puja Chadha. No evidence was filed by the applicant. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

7. As noted above, the opponent's evidence consists of the witness statement of Puja Chadha. Mrs Chadha is the opponent's wife and the Managing Director of Kingston

(Frangos) Ltd trading as Frangos (which is the licensee of the earlier marks). I have read Mrs Chadha's evidence in full and, in particular, I note as follows:

- a) The marks have been used in relation to a restaurant located in Kingston Upon Thames since 2003¹.
- b) Photographs of the restaurant, that Mrs Chadha states were taken in 2016², display the Third Earlier Mark and the following variant³:



- c) Print outs from the opponent's website dated between 19 August 2014, 25 May 2015 and 11 August 2016 use the word only FRANGOS⁴.
- d) Turnover relating to services sold under the marks is set out below⁵:

2013/2014	£881,612
2014/2015	£801,047
2015/2016	£778,555
2016/2017	£712,358
2017/2018	£627,439
2018/2019	£529,075

¹ Witness statement of Puja Chadha, para. 6

² Witness statement of Puja Chadha, para. 8

³ Exhibit PC2

⁴ Exhibit PC2

⁵ Witness statement of Puja Chadha, para. 9

e) The Daily Sales Report for the restaurant shows net sales made each day between 23 January 2013 and 23 January 2018⁶. By way of example:

30 January 2013	£2,296.46
30 January 2014	£1,590.75
30 January 2015	£2,408.66
30 January 2016	£4,610.17
30 January 2017	£1,373.32

f) Receipts dated 2015, 2016 and 2017 confirm sales made and display the word FRANGOS⁷.

g) Records show the following gross sales made through Deliveroo for the following periods⁸:

16 December 2016 to 30 December 2016	£3,540.00
1 November 2017 to 15 November 2017	£2,747.04
16 January 2018 to 31 January 2018	£2,750.09

h) Annual marketing and advertising expenditure is as follows⁹:

2013/2014	£34,252
2014/2015	£17,053
2015/2016	£12,742
2016/2017	£24,357
2017/2018	£32,464

⁶ Exhibit PC3

⁷ Exhibit PC5

⁸ Exhibit PC6

⁹ Witness statement of Puja Chadha, para. 15

DECISION

8. Section 5(2)(b) of the Act states as follows:

“5(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.”

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or 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.”

10. Given the date of filing, the trade marks upon which the opponent relies qualify as earlier trade marks under the above provisions.

Proof of use

11. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier marks. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A-(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

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

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

(5) In relation to a Community trade mark 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 Community.

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

12. Section 100 of the Act is also relevant, which reads:

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

13. According to section 6(3)(a) of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the applied for mark. The relevant period is, therefore, 17 February 2013 to 16 February 2018.

14. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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 Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

15. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

Form of the mark

16. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that (my emphasis):

32. “31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be

fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

17. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

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

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character

identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

18. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

19. Where the opponent’s marks have been used as registered this will, clearly, be used upon which the opponent may rely. The opponent has also used the following variant:



20. This uses all the same elements that appear in the First Earlier Mark as registered but arranged differently and without the word “FAMOUS”. Although the elements of the mark have been rearranged and one word omitted, I am satisfied that this does not alter the distinctive character of the mark as per *Nirvana*. The mark is also, of course, presented on a circular background in the variant use, but as per *Colloseum*, use in combination with additional matter is use upon which the opponent may rely. I am satisfied that this is an acceptable variant of the First Earlier Mark.

21. The variant uses the same elements that appear in the Second and Third Earlier Mark, but with various additional elements. As per *Colloseum*, use in combination with additional matter is use upon which the opponent may rely. I am satisfied that this is an acceptable variant of the Second and Third Earlier Marks.

Sufficient Use

22. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself¹⁰.

23. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

24. The opponent’s evidence shows that the earlier marks have been used on receipts, on the opponent’s websites and at the restaurant premises located in Kingston upon Thames. Whilst turnover and sales figures are relatively modest given the size of the restaurant market, they are not insignificant. Further, the opponent has sought to create a market for the services by investing in marketing and advertising each year. I am satisfied that the opponent has shown genuine use of the mark during the relevant period.

Fair Specification

25. I must now consider whether, or to what extent, the evidence shows use of the services relied upon.

26. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there

¹⁰ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

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.”

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

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

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

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

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

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

28. The opponent’s evidence relates to restaurant and take away services. There is nothing in the evidence to suggest that this extends to bar and catering services. Further, whilst I recognise that part of offering restaurant services will be taking reservations and bookings for that restaurant, this does not constitute use of the mark in relation to booking and reservation services. These are services that the opponent is undertaking for itself rather than offering to a third party to create or maintain a share in the market for those services. I consider a fair specification for the earlier marks to be:

Class 43 Restaurant services.

Section 5(2)(b)

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

(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 to mind the earlier mark, 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

30. In light of my findings above, the competing services are as follows:

Opponent's services	Applicant's services
<u>Class 43</u> Restaurant services.	<u>Class 43</u> Restaurants.

31. These services are, self-evidently, identical.

The average consumer and the nature of the purchasing act

32. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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.”

33. The average consumer for the services will be a member of the general public. Purchases of the services can, of course, range significantly in price and frequency (from Michelin starred restaurants to fast food outlets). However, even where the cost is fairly low and purchases are likely to be relatively frequent, a number of factors will still be taken into consideration (such as type of food offered, hygiene rating and whether the establishment is suitable for the particular occasion). I, therefore, consider that a medium degree of attention will be paid during the purchasing process.

34. The services are likely to be purchased following inspection of the premises frontage or the website of the restaurant in question. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase of the services, given that word-of-mouth recommendations may play a part.

Comparison of trade marks




35. 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 the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

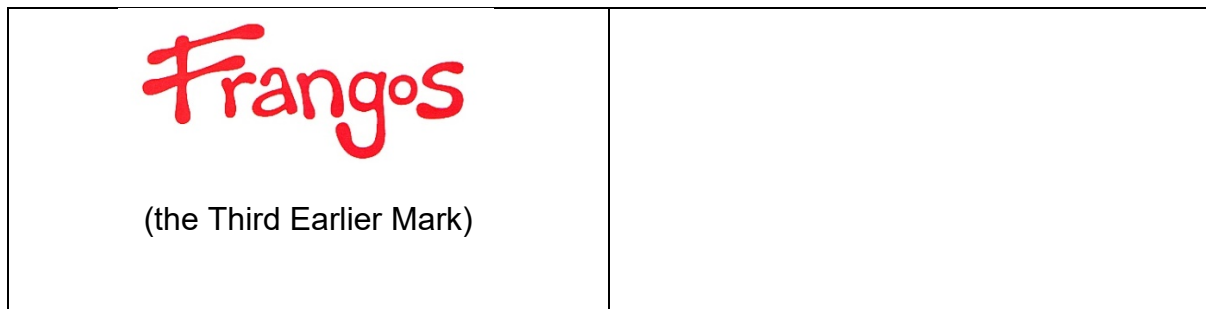
“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in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

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

36. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

37. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
 <p>(the First Earlier Mark)</p>  <p>(the Second Earlier Mark)</p>	



Overall Impression

38. The First Earlier Mark consists of the word FRANGOS presented in a red stylised title case font, with a chicken device above it and the words FAMOUS FIRE GRILLED CHICKEN below it, in much smaller yellow font. The word FRANGOS and the chicken device play a roughly equal role in the overall impression of the mark, with the colour and font, as well as the words FAMOUS FIRE GRILLED CHICKEN playing a lesser role due to their size and descriptive nature.

39. The Second Earlier Mark consists of the word FRANGOS presented in the same colour and font beneath the chicken device. The word itself and the device play a roughly equal role in the overall impression of the mark, with the colour and stylisation playing a lesser role.

40. The Third Earlier Mark consists of the word FRANGOS presented in the same colour and font. The mark is dominated by the word itself, with the stylisation and use of colour playing a lesser role.

41. The applicant's mark consists of the word FRANGO presented in a red title case font, which is preceded by the device of a chicken and followed by the words FOR CHICKEN LOVERS which are presented in yellow, smaller font. The overall impression lies in the combination of the device and the word FRANGO itself, with the use of colour playing a lesser role. The words FOR CHICKEN LOVERS will also play a lesser role due to their descriptive nature.

Visual Comparison

The First Earlier Mark and the applicant's mark

42. The word element of the applicant's mark is duplicated entirely in the opponent's mark, with the addition of an 'S' on the end. The large text in both marks is presented in red, with small text present beneath it in yellow. This smaller text in both marks is likely to be given little trade mark significance due to its descriptive nature. Both marks also contain chicken device (albeit different ones). The font used differs in each mark. I consider the marks to be visually similar to a medium to high degree.

The Second Earlier Mark and the applicant's mark

43. The same points apply as noted above, although, in this case, the opponent's mark does not contain any smaller text beneath it. However, given the descriptive nature of this in both marks, I do not consider that it significantly impacts the similarity of the marks. I consider them to be similar to a medium to high degree.

The Third Earlier Mark and the applicant's mark

44. Again, the marks coincide in the main word element of the applicant's mark being duplicated in the opponent's mark, with the addition of an 'S' on the end. The main text in both marks is presented in red. Again, the smaller text is missing from the opponent's mark, but due to its descriptive nature this is not significant. The main point of visual differences is the chicken device in the applicant's mark which has no counterpart in the opponent's mark. The texts used also differ. I consider the marks to be similar to a medium degree.

Aural Comparison

45. It is likely that in all of the marks only the main word element will be pronounced (FRANGO/FRANGOS). If this is the case, then they will be aurally highly similar. If the smaller text is pronounced, then the marks will be aurally similar to a medium degree.

Conceptual Comparison

The First Earlier Mark and the applicant's mark

46. The applicant states in its counterstatement that the word FRANGO is Portuguese for chicken. However, this meaning is unlikely to be known by the UK average consumer. The words FRANGO and FRANGOS are likely to be viewed as made-up or foreign language words and will be attributed no particular meaning by the average consumer. The presence of the chicken device in each mark will be viewed as a point of conceptual similarity. The smaller text, which both refer to chicken, will also act as a point of conceptual similarity. I consider the marks to be conceptually similar to a high degree.

The Second Earlier Mark and the applicant's mark

47. Again, the words are unlikely to be attributed any particular meaning. However, the presence of the chicken device in each will act as a point of conceptual similarity. I consider the marks to be conceptually similar to a medium to high degree.

The Third Earlier Mark and the applicant's mark

48. The same points apply regarding the wording – they are conceptually neutral. However, the presence of the chicken device in the applicant's mark, which has no counterpart in the opponent's mark will act as a point of conceptual difference between them.

49. As the First Earlier Mark shares the greatest degree of similarity with the applicant's mark and, therefore, represents the opponent's best case, I will proceed in respect of this mark.

Distinctive character of the earlier trade mark

50. 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-2779, 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).”

51. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

52. The word FRANGOS will be seen as an invented word which is neither allusive nor descriptive. This, in itself has a high degree of inherent distinctive character. The presence of the chicken and the additional wording will be either descriptive or allusive

of the type of food provided under the services. The use of stylisation and colour also plays a role in the mark's distinctiveness. I consider First Earlier Mark to be inherently distinctive to a high degree.

Likelihood of confusion

53. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

54. I have found the marks to be visually similar to a medium to high degree, aurally similar to at least a medium degree and conceptually similar to a high degree. I have found the earlier mark to have a high degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who will select the services primarily by visual means (although I do not discount an aural component). I have found the services to be identical.

55. Bearing in mind the principle of imperfect recollection, the degree of similarity between the marks and the distinctiveness of the First Earlier Mark, I consider that the average consumer is likely to mistakenly recall one mark for the other. This is particularly the case given that the marks are applied for/registered in relation to identical services. I consider there to be a likelihood of direct confusion.

56. I now turn to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

57. Even if the differences between the marks are identified by the average consumer, taking all of the above factors into account, I consider that the marks will be viewed as alternative marks used by the same or economically linked undertakings. I therefore consider there to be a likelihood of indirect confusion.

CONCLUSION

58. The opposition is successful, and the application is refused.

COSTS

59. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£900** as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the applicant's statement	£200
Preparing evidence	£600
Official fee	£100
Total	£900

60. I therefore order Frango UKI Ltd to pay Mr Sumit Chadha the sum of £900. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

24 September 2019

S WILSON

For the Registrar