

O/559/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003302645

BY TAST GROUP LTD

TO REGISTER THE TRADE MARK:

T a S T

CUINA CATALANA

IN CLASS 43

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 413771 BY

TASTING TAPAS, S.L.

BACKGROUND AND PLEADINGS

1. On 9 April 2018, Tast Group 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 29 June 2018. Registration is sought for the following services:

Class 43 Provision of food and drink in restaurants; Restaurant and bar services;
Restaurants.

2. The application is opposed by Tasting Tapas, S.L. (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade marks:



EUTM no. 17879894

Filing date 26 March 2018

Relying on all services for which the mark is applied for, namely:

Class 43 Hotel catering services; restaurants.

(“the First Earlier Mark”)



EUTM no. 14264956

Filing date 17 June 2015; registration date 12 November 2015

Relying on all services for which the mark is registered, namely:

Class 43 Catering services and catering; restaurants.

("the Second Earlier Mark")



EUTM no. 14835235

Filing date 26 November 2015; registration date 27 April 2016

Relying on all services for which the mark is registered, namely:

Class 43 Hospitality and catering, restaurants.

("the Third Earlier Mark")

TAST MARKET

EUTM no. 15433626

Filing date 12 May 2016; registration date 11 October 2016

Relying on all services for which the mark is registered, namely:

Class 35 Advertising, organisation of exhibitions for commercial, promotional or advertising purposes relating to gastronomy; Commercial retailing and wholesaling, And sale via global computer networks of all kinds of beverages and foodstuffs.

Class 43 Hotel catering services; restaurants.

(“the Fourth Earlier Mark”)

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

4. The applicant filed a counterstatement denying the claims made.

5. The opponent is represented by Page White & Farrer and the applicant is represented by Wilson Gunn. The opponent filed evidence in chief in the form of the witness statement of James Philip Cornish dated 22 January 2019. The applicant filed evidence in the form of the witness statement of Tomas Maunier dated 24 April 2019. The opponent filed evidence in reply in the form of the witness statement of Ramon Andrew Mulet dated 19 June 2019. No hearing was requested, but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

The Opponent’s Evidence in Chief

6. As noted above, the opponent’s evidence in chief consists of the witness statement of James Philip Cornish dated 22 January 2019, which is accompanied by 17 exhibits. Mr Cornish is the trade mark attorney acting on behalf of the opponent. I have read Mr Cornish’s statement in its entirety and, in particular, I note as follows:

a) Mr Cornish has filed extracts from a UK review website in which the applicant's services are referred to using the word TAST alone¹;

b) The words CATALAN and CATALONIA refer to a particular community in Spain²;

c) The word CUINA means "kitchen", "cooking", "cuisine", "cooker" or "stove" in the Catalan language³;

d) The opponent operates a number of restaurants in Spain, which have been referenced in English articles, some of which are published on UK based websites, including one published on the Guardian website in October 2012⁴; and

e) The opponent has received a number of invoices from what Mr Cornish describes as its marketing/PR firm dated between November 2016 and January 2019 which relate to the TAST brand⁵.

The Applicant's Evidence

7. As noted above, the applicant's evidence consists of the witness statement of Tomas Maunier dated 24 April 2019, which is accompanied by 14 exhibits. Mr Maunier is a director of the applicant; a position he has held since November 2017. I have read Mr Maunier's evidence in its entirety and, in particular, I note as follows:

a) The launch of the applicant's restaurant has received publicity in the UK which Mr Maunier states pre-dates the application for the First Earlier Mark;

¹ Exhibit JPC3

² Exhibit JPC5

³ Exhibit JPC6

⁴ Exhibit JPC13

⁵ Exhibit JPC15 (I note that the descriptions of the services are in Spanish and, although an English translation has been provided it has not been certified and I cannot, therefore, take it into account. However, the word TAST is visible in the description of the invoices and so the services clearly relate to that brand in some way).

b) The word TAST, when translated into English has a number of meanings, including “tasting” and “snack”⁶;

c) TAST is a word commonly used in the names of restaurants in Spain⁷; and

d) UK tourists accounted for 8% of all tourists in the Catalan region⁸ and, although I note that Mr Maunier states that these figures relate to 2013, the document itself is undated⁹.

8. The applicant also filed written submissions in lieu. Whilst I do not propose to summarise those here, I have taken them into consideration and will refer to them below where necessary.

The Opponent’s Evidence in Reply

9. As noted above, the opponent’s evidence in reply consists of the witness statement of Ramon Andreu Mulet dated 19 June 2019, which is accompanied by 7 exhibits. Mr Mulet is the President of the opponent; he has been connected with the opponent for 19 years. I have read Mr Mulet’s evidence in its entirety and, in particular, I note as follows:

a) Mr Mulet has provided extracts from a number of websites which have found no result for the meaning of TAST in Spanish dictionaries¹⁰; and

b) An article on the British Council website dated 28 March 2019 states that 62% of British people can only speak English, with only 38% being able to speak a foreign language¹¹.

⁶ Witness statement of Mr Maunier, para. 10

⁷ Exhibit TM08

⁸ Exhibit TM12

⁹ Witness statement of Mr Maunier, para. 14

¹⁰ Exhibit RAM5

¹¹ Exhibit RAM7

10. The opponent also filed written submissions in lieu. Whilst I do not propose to summarise those here, I have taken them into consideration and will refer to them below where necessary.

PRELIMINARY ISSUES

11. The opponent has filed evidence to show that, in practice, the applicant is using the word TAST alone. Whilst this may be the case, it is not relevant to the decision I must make. I must make my comparison based upon the marks as applied for/registered; differences or similarities that result from the way the parties use their marks in practice cannot form part of that assessment.

12. The applicant has made reference to the fact that it used and publicised its mark prior to the opponent's application for the First Earlier Mark. It has, of course, opposed registration of the First Earlier Mark and proceedings are currently ongoing before the EUIPO. As the First Earlier Mark is the subject of ongoing opposition proceedings, I will consider the opposition in relation to the Second, Third and Fourth Earlier Marks only in the first instance. I will return to the First Earlier Mark only if it is necessary to do so.

DECISION

13. Section 5(2)(b) of the Act reads 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.”

14. 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.”

15. The trade marks upon which the opponent relies qualify as earlier trade marks under the above provisions. As the earlier marks had not completed their registration process more than 5 years before the publication date of the application in issue in these proceedings, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the services it has identified.

Section 5(2)(b) – case law

16. 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 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 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

17. The competing services are as follows:

Opponent's services	Applicant's services
The Second Earlier Mark <u>Class 43</u> Catering services and catering; restaurants.	<u>Class 43</u> Provision of food and drink in restaurants; Restaurant and bar services; Restaurants.
The Third Earlier Mark <u>Class 43</u> Hospitality and catering, restaurants.	
The Fourth Earlier Mark <u>Class 35</u> Advertising, organisation of exhibitions for commercial, promotional or advertising purposes relating to gastronomy; Commercial retailing and wholesaling, And sale via global computer networks of all kinds of beverages and foodstuffs.	

<u>Class 43</u>	
Hotel catering services; restaurants.	

18. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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 that:

“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.”

19. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) 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;

(f) 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.

20. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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.”

21. “Restaurants” appears identically in both the applicant’s specification and all three of the opponent’s specifications. These are, self-evidently, identical.

22. “Provision of food and drink in restaurants” in the applicant’s specification is, self-evidently, identical to “restaurants” in the opponent’s specifications.

23. “Restaurant [...] services” in the applicant’s specification is, self-evidently, identical to “restaurants” in the opponent’s specification.

24. “[...] bar services” in the applicant’s specification will, in my view, be highly similar to “restaurants” in the opponent’s specifications. This is because restaurants do not just involve the provision of food services but also the provision of beverages. Restaurants normally have their own bars from which drinks are provided. Consequently, I consider these services will overlap in user, trade channels, nature and method of use and will be highly similar.

The average consumer and the nature of the purchasing act

25. 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.”

26. 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 relatively frequent, a number of factors will still be taken into consideration (such as type of food or drink offered and hygiene rating). I therefore consider that a medium degree of attention will be paid during the purchasing process.

27. The services are likely to be purchased following inspection of the premises frontage, the website of the service provider or advertisements. 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 also play a part.

Comparison of trade marks



28. It is clear from *Sabel BV v. Puma AG* (particularly at paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to

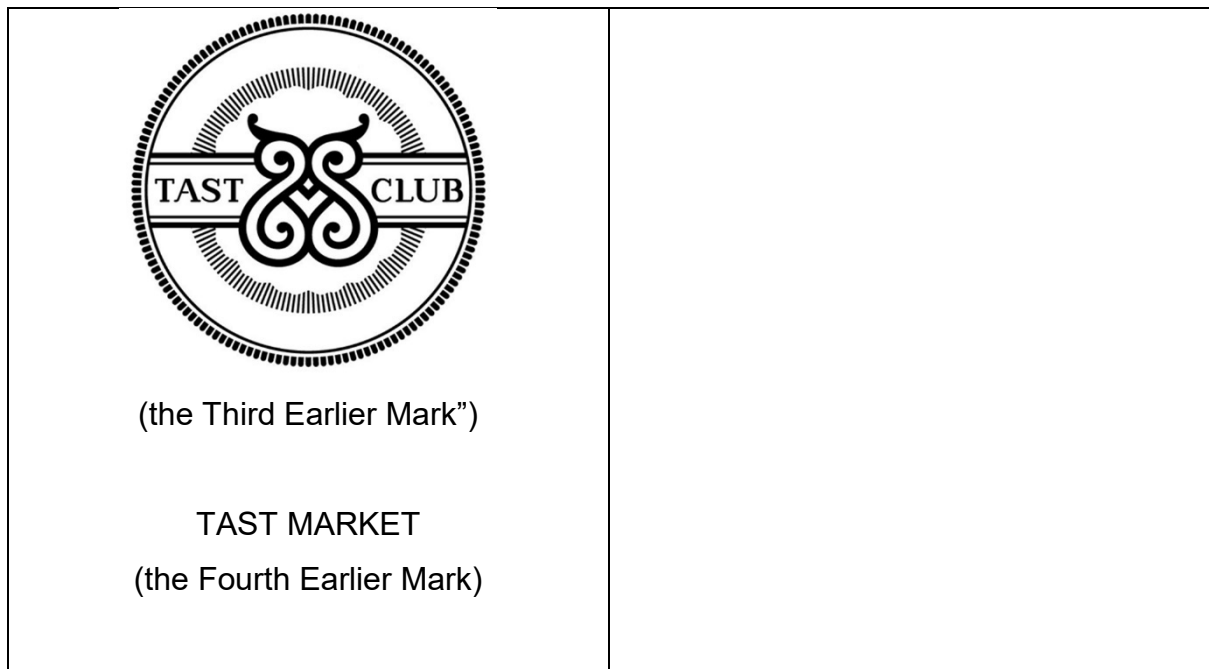
analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant component. The CJEU stated at paragraph 34 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.”

29. 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 and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

30. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
 <p data-bbox="311 1832 679 1868">(the Second Earlier Mark)</p>	



Overall Impression

31. The eye is naturally drawn to the word TAST in the applicant’s mark due to its size relative to the other words in the mark. It is this word that plays the greater role in the overall impression. The stylisation and the words CUINA CATALANA play a lesser role.

32. The Second Earlier Mark consists of the letters TA-T which are intersected by a swirling device and followed by the word OUT. The device may be viewed as an S by some consumers, although others may see it only as a device. The word OUT may be considered to have some allusive qualities for the services. The overall impression of the mark lies in the combination of these elements.

33. The Third Earlier mark consists of the words TAST CLUB presented in a circular device with a swirling device at its centre. The eye is naturally drawn to the elements of the mark that can be read. The word CLUB may be considered to be allusive for the services. I consider the word TAST and the devices will play an approximately equal role in the overall impression of the mark, with the word CLUB playing a slightly lesser role due to its allusive nature.

34. The Fourth Earlier Mark consists of the word TAST MARKET. The word MARKET may be seen as a reference to the way in which the services are provided and so may play a slightly lesser role in the overall impression due to its somewhat allusive nature, with the word TAST playing a slightly greater role.

Visual Comparison

The Application and the Second Earlier Mark

35. Visually, the marks are presented in different fonts. The words CUINA CATALANA in the applicant's mark have no counterpart in the opponent's mark. The word OUT in the opponent's mark has no counterpart in the applicant's mark. They are both presented in different fonts. As noted above, the swirling device in the opponent's mark makes it ambiguous as to what the first word in the mark is. Even if it is recognised as a letter S the use of a device rather than the conventional letter will be a point of visual difference. If the letter S is recognised then I consider that overall there will be a low to medium degree of visual similarity between the marks. If the letter S is not recognised then there will be no more than a low degree of visual similarity.

The Application and the Third Earlier Mark

36. Visually, both marks contain the word TAST. The text in each mark differs with the word CLUB in the opponent's having no counterpart in the applicant's mark and the words CUINA CATALANA having no counterpart in the opponent's mark. The stylisation in the applicant's mark is also not present in the opponent's mark and the devices in the opponent's mark are not present in the applicant's mark. I consider the marks to be visually similar to no more than a medium degree.

The Application and the Fourth Earlier Mark

37. Visually, both marks contain the word TAST. The words CUINA CATALANA in the applicant's mark have no counterpart in the opponent's mark. The word MARKET in the opponent's mark has no counterpart in the applicant's mark. The stylisation of the applicant's mark is also absent from the opponent's mark, however, notional use of

the opponent's mark would cover stylised use of the word TAST and so this difference is not particularly significant. I consider the marks to be visually similar to at least a medium degree.

Aural Comparison

The Application and the Second Earlier Mark

38. The pronunciation of the opponent's mark will depend on whether the word S is recognised. If it is recognised then the word TAST will be pronounced identically in both marks. The words CUINA CATALANA, given their size, may or may not be pronounced. If the word TAST is recognised in the opponent's mark and the words CUINA CATALANA in the applicant's mark are not pronounced, they will be aurally similar to a medium degree. If the word TAST is recognised in the opponent's mark and the words CUINA CATALANA are pronounced, the marks will be aurally similar to a low to medium degree. If the letter S is not recognised in the opponent's mark then they will be aurally similar to only a low degree.

The Application and the Third Earlier Mark

39. Aurally, the only elements of the opponent's mark that will be pronounced are the words TAST CLUB. If the words CUINA CATALANA in the applicant's mark are not pronounced, then the marks will be aurally similar to a medium to high degree. If the words are pronounced, then the marks will be aurally similar to a medium degree.

The Application and the Fourth Earlier Mark

40. If only the word TAST in the applicant's mark is pronounced then the marks will be aurally similar to a medium to high degree. If the words CUINA CATALANA are also pronounced, then the marks will be aurally similar to a medium degree.

Conceptual comparison

41. The evidence of the parties focused on the use of Spanish (specifically, Catalan) words in both marks. The average consumer in this case is a member of the UK general public. Whilst the words CUINA and CATALANA may be well known in Spain, I do not consider them to be well known in the UK. I accept that the words Catalan and Catalonia may be known by some average consumers as a reference to a particular area in Spain, but I do not consider that to be the case for the word CATALANA. I also do not consider the word CUINA a word with which the average UK consumer is likely to be familiar. Whilst I accept that many UK tourists visit Spain each year, and that some people may be familiar with them, I do not consider that sufficient to find that a significant proportion of average consumers would be sufficiently familiar with, not just the Spanish language but, specifically, the Catalan dialect, to know the meaning of these words. I consider that these words are likely to be recognised as foreign language words to which the UK public attribute no particular meaning. Consequently, they will be conceptually neutral.

42. The same applies to the word TAST. In my view, this word will be seen as either a made-up word, a foreign language word or a misspelling of the English word TASTE. Again, I do not consider that a significant proportion of UK average consumers would recognise the translation. If the word TAST is viewed as a made-up or foreign language word with no particular meaning, it will be conceptually neutral in all of the marks. If it is viewed as a misspelling of the word TASTE then this will be a point of conceptual similarity between the marks.

43. The words OUT, CLUB and MARKET will all be attributed their ordinary dictionary meaning. These words may have allusive qualities (such as food being offered to 'take out', food and drink provided in a club setting and a market-style counter from which food can be selected at a restaurant). Nonetheless, these words will be a point of conceptual difference as they have no counterpart in the applicant's mark.

44. If the word TAST is recognised as a misspelling of the word TASTE, then the marks will all be conceptually similar to a medium degree (provided the S is recognised as such in the Second Earlier Mark). If the word TAST is viewed as a made-up or foreign

language word with no meaning then it will be conceptually neutral, with the point of difference being the addition of the word MARKET in the opponent's mark which has no counterpart in the applicant's.

Distinctive character of the earlier trade marks

45. 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).”

46. 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.

47. As noted above, I will proceed on the basis of the Fourth Earlier Mark, considering only the distinctiveness of that mark, in the first instance. However, I will return to consider the distinctiveness of the opponent's other marks if necessary.

48. The opponent has filed evidence to support its claim that the distinctive character of its marks has been enhanced through use. I recognise that the opponent operates a number of restaurants in Spain, all of which appear to use the word TAST. As noted above, I also recognise that many UK tourists visit Spain each year. However, I do not consider this to be sufficient to justify a finding of enhanced distinctiveness in the UK. There is no evidence of use of the opponent's mark in the UK. Consequently, I have only the inherent position to consider.

49. The word TAST, as noted above, is likely to be seen either as a made-up word, a foreign language word with no particular meaning or a misspelling of the word TASTE. The word MARKET will be given its ordinary dictionary meaning and is likely to be seen as alluding to the way in which the opponent's services are offered. If the word TAST is viewed as a made-up word or foreign language word, I consider the mark to be highly distinctive. If it is viewed as a misspelling of the word TASTE, whilst it will be allusive to the services for which it is registered, it will still be an unusual misspelling. I consider that in those circumstances, the earlier mark will be inherently distinctive to no more than a medium degree.

Likelihood of confusion

50. 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.

51. I have found the Fourth Earlier Mark and the applicant's mark to be visually similar to at least a medium degree. They will be aurally similar to a medium to high degree if only the word TAST in the applicant's mark is pronounced. If all of the words in the applicant's mark are pronounced, then they will be aurally similar to a medium degree. If the word TAST is recognised as a misspelling of the word TASTE then the marks will be conceptually similar to a medium degree. If the word TAST is viewed as a made-up or foreign language word with no particular meaning, then it will be conceptually neutral with the point of difference being the word MARKET which has no counterpart in the applicant's mark. I have found the earlier mark to have a high degree of inherent distinctive character where the word TAST is viewed as a made-up or foreign language word with no particular meaning, or no more than a medium degree of inherent distinctive character if it is viewed as a misspelling of the word TASTE. 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 highly similar or identical.

52. Notwithstanding the principle of imperfect recollection, I do not consider that the marks will be mistakenly recalled or misremembered as each other. I do not think that the words MARKET and CUINA CATALANA will be overlooked. Consequently, I do not consider there to be a likelihood of direct confusion.

53. 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.”

54. Although the differences between the marks are likely to be recognised, I consider that the presence of the word TAST in each of the marks will lead the consumer to consider that the services are provided by the same or economically linked undertakings. Even where the word TAST is recognised as a misspelling of TASTE, the use of the same misspelling in relation to identical or highly similar services will lead the consumer to believe that there is a connection between the service providers. I consider there to be a likelihood of indirect confusion.

Final Remarks

55. As I have found a likelihood of confusion in respect of the Fourth Earlier Mark, I will not return to consider the likelihood of confusion in respect of the opponent’s other earlier marks as they will not put the opponent in a better position.

CONCLUSION

56. The opposition succeeds in its entirety and the application is refused.

COSTS

57. 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 **£1,300** as a contribution towards its costs. The sum is calculated as follows:

Preparing a statement and considering the applicant's statement	£200
Preparing evidence, reviewing the applicant's evidence and preparing evidence in reply	£700
Preparing written submissions in lieu	£300
Official fee	£100
Total	£1,300

58. I therefore order Tast Group Ltd to pay Tasting Tapas, S.L. the sum of £1,300. 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