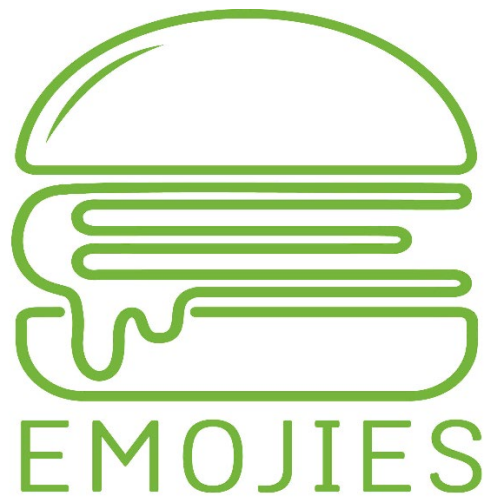


O-064-21

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF**  
**TRADE MARK APPLICATION NO. 3427630**  
**BY EMOJIES LTD**  
**TO REGISTER**



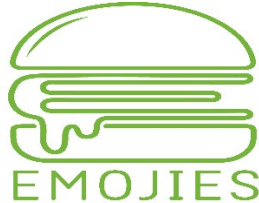
**AS A TRADE MARK IN CLASS 43**

**AND**

**OPPOSITION THERETO**  
**UNDER NO. 418949**  
**BY EMOJI COMPANY GMBH**

## Background and pleadings

1. On 10 September 2019, Emojies Ltd (“the applicant”) applied to register the trade mark shown below under number 3427630:



2. The application was published for opposition purposes on 27 September 2019 for the following services:

Class 43 Fast food restaurants; Fast-food restaurant services; Food and drink catering; Restaurants; Restaurants (Self-service -); Bar and restaurant services; Booking of restaurant seats; Carry-out restaurants; Grill restaurants; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Providing information about restaurant services; Providing restaurant services; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Hotels; Hotels and motels; Hotels, hostels and boarding houses, holiday and tourist accommodation; Houses (Boarding -);Ice cream parlors; Ice cream parlour services; Information and advice in relation to the preparation of meals; Information relating to hotels; Japanese restaurant services; Juice bar services; Juice bars; Leasing of furniture; Leasing of metal and non-metal transportable buildings; Letting of holiday accommodation; Linen hire; Lounge services (Cocktail -);Making hotel reservations for others; Making reservations and bookings for restaurants and meals; Marquee hire; Marquees (Rental of -);Mobile catering; Mobile catering services; Mobile creches; Mobile restaurant services; Motel services; Motels; Night club services [provision of food];Nurseries and day care centers; Nurseries, day-care and elderly care facilities; Office catering services for the provision of

coffee; Old people's home services; Operating membership accommodation; Organisation of catering for birthday parties; Outside catering; Outside catering services; Personal chef services; Pet boarding services; Pet day care services; Pet hotel services; Pizza parlors; Preparation and provision of food and drink for immediate consumption; Preparation of food and beverages; Preparation of food and drink; Preparation of Japanese food for immediate consumption; Preparation of meals; Preparation of Spanish food for immediate consumption; Preschooler and infant care at daycare centers; Private members dining club services; Private members drinking club services; Providing accommodation for functions; Providing accommodation for meetings; Providing accommodation in hotels and motels; Providing assisted living facilities [temporary accommodation]; Providing banquet and social function facilities for special occasions; Providing campground facilities; Providing child care centers; Providing community centers for social gatherings and meetings; Providing conference rooms; Providing convention facilities; Providing drink services; Providing emergency shelter services in the nature of temporary housing; Providing exhibition facilities in hotels; Providing facilities for exhibitions; Providing facilities for fairs and exhibitions; Providing food and beverages; Providing food and drink; Providing food and drink catering services for convention facilities; Providing food and drink catering services for exhibition facilities; Providing food and drink catering services for fair and exhibition facilities; Providing food and drink for guests; Providing food and drink for guests in restaurants; Providing food and drink in bistros; Providing food and drink in doughnut shops; Providing food and drink in Internet cafes; Providing food and drink in restaurants and bars; Providing food to needy persons [charitable services]; Providing guesthouse services; Providing hotel accommodation; Providing hotel and motel services; Providing

information about bar services; Providing information about bartending; Providing information about creche services; Providing information about restaurant services; Providing information about temporary accommodation services; Providing information about temporary accommodation via the Internet; Providing information in the nature of recipes for drinks; Providing lodging information via the Internet; Providing of food and drink; Providing of food and drink via a mobile truck; Providing on-line information relating to holiday accommodation reservations; Providing online information relating to hotel reservations; Providing restaurant services; Providing reviews of restaurants; Providing reviews of restaurants and bars; Providing room reservation and hotel reservation services; Providing temporary accommodation; Providing temporary accommodation as part of hospitality packages; Providing temporary accommodation in boarding houses; Providing temporary accommodation in holiday flats; Providing temporary accommodation in holiday homes; Catering services specialising in cutting ham for fairs, tastings and public events; Catering services specialising in cutting ham for weddings and private events; Cattery services; Charitable services, namely providing food and drink catering; Charitable services, namely, providing food to needy persons; Charitable services, namely providing temporary accommodation; Child care services; Child minding services; Children's creches; Children's residential home services; Club services for the provision of food and drink; Cocktail lounge buffets; Cocktail lounge services; Cocktail lounges; Coffee bar services; Coffee shop services; Coffee shops; Coffee supply services for offices [provision of beverages]; Consultancy provided by telephone call centers and hotlines in the field of temporary accommodation; Consultancy services in the field of food and drink catering; Consultancy services relating to baking techniques; Consultancy services relating to food; Consultancy services relating to food preparation;

Consultancy services relating to hotel facilities; Consulting services in the field of culinary arts; Contract food services; Cookery advice; Cooking apparatus (Rental of -); Corporate hospitality (provision of food and drink); Creche services; Creche services provided in shopping locations; Day care centers; Day nursery services; Day-care center services; Day-nurseries; Day-nurseries [crèches]; Day-nursery [crèche] services; Decorating of food; Drink dispensing machines (rental of); Electronic information services relating to hotels; Emergency shelter services [providing temporary housing]; Event facilities and temporary office and meeting facilities; Grill restaurants; Guest house services; Guest houses; Guesthouse; Guesthouses; Hire of bed linen; Hire of interior chairs; Hire of interior lighting; Hire of interior matting; Hire of interior tables; Hire of marquees; Hire of pavilions; Hire of temporary office space; Hiring of furniture; Hiring of furniture for conferences; Hiring of furniture for exhibitions; Hiring of furniture for presentations; Hiring of mats; Hiring of rooms for social functions; Holiday accommodation services; Holiday camp services [lodging]; Holiday lodgings; Holiday planning services [accommodation]; Homes for the elderly [retirement]; Homes (Retirement -); Homes (Tourist -); Hookah bar services; Hookah lounge services; Hospitality services [accommodation]; Hospitality services [food and drink]; Hostels; Hotel accommodation reservation services; Hotel accommodation services; Hotel catering services; Hotel information; Hotel reservation services; Hotel reservation services provided via the Internet; Hotel reservations; Hotel restaurant services; Hotel room booking services; Hotel services; Hotel services for preferred customers; Fast food restaurants; Fast-food restaurant services; Food and drink catering; Food and drink catering for banquets; Food and drink catering for cocktail parties; Food and drink catering for institutions; Food and drink preparation services; Food preparation; Food preparation for others on an outsourcing

basis; Food preparation services; Food sculpting; Food service apparatus (Rental of -); Restaurant and bar services; Restaurant information services; Restaurant reservation services; Restaurant services; Restaurant services for the provision of fast food; Restaurants; Restaurants (Self-service -).

3. Emoji company GmbH (“the opponent”) filed a notice of opposition on 27 December 2019. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all the services in the application. The opponent relies upon all the services in the following European Union (“EU”) trade mark registration:<sup>1</sup>

**Mark:** emoji

**EU registration no.** 017995704

**Filing date:** 19 April 2018

**Date of entry in register:** 09 August 2018

**Services:**

Class 43 Boarding for animals; Rental of furniture, linens and table settings; Services for providing food and drink; Providing temporary accommodation; Pet boarding services; Pet day care services; Dog day care services; Cattery services; Boarding for horses; Boarding for pets; Services for the housing of pet fish; Services for the housing of pet birds; Rental of rugs; Rental of lighting apparatus; Hiring of furniture for presentations; Hiring of furniture for conferences; Rental of furniture; Rental of kitchen sinks; Rental of kitchen worktops for preparing food for immediate consumption; Rental of pillows; Rental of internal furnishings; Hire of interior lighting; Rental of towels for hotels; Rental of glassware; Rental of beverage fountains; Rental of crockery; Rental of floor coverings for hotels; Hiring of mats; Hire of interior matting; Rental of floor

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<sup>1</sup> Although the UK has now left the EU, as these proceedings were commenced before 31 December 2020, the UK’s departure from the EU does not impact upon the opponent’s ability to rely upon the EU trade mark.

coverings; Rental of futon; Rental of blankets; Rental of catering equipment; Rental of lighting apparatus (Domestic -); Rental of cutlery; Rental of quilts; Rental of beds; Rental of cotton candy making machines; Hire of bed linen; Rental of wall hangings for hotels; Rental of curtains for hotels; Hire of interior tables; Rental of carpets; Hire of interior chairs; Rental of chairs and tables; Rental of chairs, tables, table linen, glassware; Rental of tableware; Rental of chafing dishes; Rental of chocolate fountains; Rental of popcorn poppers; Hiring of furniture for exhibitions; Rental of furniture for hotels; Provision of temporary furnished accommodation; Leasing of metal and non-metal transportable buildings; Emergency shelter services [providing temporary housing]; Rental of temporary accommodation; Hire of pavilions; Booking of temporary accommodation via the Internet; Travel agency services for booking accommodation; Hospitality services [accommodation]; Provision of information relating to the booking of accommodation; Holiday accommodation services; Creche services provided in shopping locations; Reception services for temporary accommodation [management of arrivals and departures]; Accommodation booking agency services [time share]; Agency services for the reservation of temporary accommodation; Accommodation letting agency services [time share]; Tour operator services for the booking of temporary accommodation; Room booking; Booking of accommodation for travellers; Accommodation exchange services [time share]; Consultancy provided by telephone call centers and hotlines in the field of temporary accommodation; Operating membership accommodation; Charitable services, namely providing temporary accommodation; Nurseries, day-care and elderly care facilities; Hotels, hostels and boarding houses, holiday and tourist accommodation; Event facilities and temporary office and meeting facilities; Providing information about temporary accommodation via the Internet; Providing information about temporary

accommodation services; Accommodation bureau services; Temporary accommodation reservations; Temporary room hire; Accommodation services for functions; Room hire services; Rental of rooms as temporary living accommodations; Rental of transportable buildings; Arranging and providing temporary accommodation; Arranging temporary housing accommodations; Rental of tents; Provision of caravan park facilities; Providing temporary housing accommodations; Rental of rooms for social functions; Booking agency services for hotel accommodation; Tourist home services; Holiday camp services [lodging]; Consultancy services relating to hotel facilities; Providing temporary lodging for guests; Providing temporary accommodation as part of hospitality packages; Providing temporary accommodation in holiday homes; Providing temporary accommodation in holiday flats; Providing temporary accommodation in boarding houses; Providing campground facilities; Resort hotel services; Hotels and motels; Guesthouses; Tourist hostels; Rating holiday accommodation; Appraisal of hotel accommodation; Travel agencies for arranging accommodation; Booking of campground accommodation; Booking of hotel rooms for travellers; Booking agency services for holiday accommodation; Travel agency services for reserving hotel accommodation; Travel agency services for making hotel reservations; Tourist camp services [accommodation]; Hotel accommodation services; Hostels; Hotel reservation services provided via the Internet; Resort lodging services; Provision of hotel accommodation; Rental of temporary accommodation in holiday homes and flats; Providing temporary trailer park facilities; Providing accommodation in hotels and motels; Arranging of accommodation for holiday makers; Reservation of temporary accommodation in the nature of holiday homes; Travel agency services for booking temporary accommodation; Reservation of rooms for travellers; Reservation of tourist accommodation;



Booking of hotel accommodation; Arranging of accommodation for tourists; Information relating to hotels; Making hotel reservations for others; Hotel services for preferred customers; Provision of information relating to hotels; Electronic information services relating to hotels; Tourist inns; Services for reserving holiday accommodation; Hotel services; Youth hostel services; Motel services; Boarding house services; Providing lodging information via the Internet; Providing travel lodging information services and travel lodging booking agency services for travelers; Providing on-line information relating to holiday accommodation reservations; Providing online information relating to hotel reservations; Accommodation bureau services [hotels, boarding houses]; Boarding house bookings; Hotel reservations; Providing room reservation and hotel reservation services; Temporary accommodation provided by dude ranches; Temporary accommodation services provided by holiday camps.

4. The opponent argues that there is a likelihood of confusion, including a likelihood of association, because the respective marks are similar, and the services are either identical or similar. The applicant filed a counterstatement denying the grounds of opposition.
5. The opponent is represented by Hucke & Schubert and the applicant is represented by Blacks Solicitors LLP. Neither side filed evidence. Only the applicant filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers filed by the parties.

#### **Section 5(2)(b)**

6. Section 5(2)(b) of the Act is as follows:

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

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

## Case law

7. The following principles are gleaned from the judgments 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 C3/03, *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 the 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.

## **The average consumer and the nature of the purchasing act**

8. 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 these services are likely to be selected by the average consumer.
9. 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”.

10. The parties' respective specifications include a wide range of services such as restaurant, bar and catering services to day-care, or holiday accommodation services. I consider that the average consumer of the competing services includes both professionals and the general public. The service providers are most likely to be chosen after perusal of the internet, from catalogues or brochures, or after viewing signage on, for example, a high street. Visual considerations are, therefore, likely to dominate the selection process for the services. There may also be aural considerations, for example, when the choice is informed by oral recommendations. The average consumer is likely to consider factors such as type of cuisine, location, or customer rating when selecting the services. The degree of care the average consumer will display when selecting such services is likely to vary. Contrast, for example, a low degree of care is likely to be taken when one selects a venue for an impromptu snack, while a medium to a fairly high degree of attention is likely to be paid when selecting day-care services or a restaurant for an important family event.

## Comparison of services

11. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

12. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (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.

13. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

14. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

“[...] 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”.

15. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

16. I find the following services specified by the applicant to be identically contained in the opponent specification: *providing of food and drink; preparation and provision of food and drink for immediate consumption; preparation of food and beverages; preparation of food and drink; hotels; hotels and motels; hotels, hostels and boarding houses, holiday and tourist accommodation; houses (Boarding -); Information relating to hotels; leasing of metal and non-metal transportable buildings; making hotel reservations for others; motel services; motels; operating membership accommodation; pet boarding services; pet day care services; pet hotel services; cattery services; providing accommodation for functions; providing accommodation for meetings; providing accommodation in hotels and motels; providing assisted living facilities [temporary accommodation]; providing guesthouse services; providing hotel accommodation; providing hotel and motel services; providing on-line information relating to holiday accommodation reservations; providing online information relating to hotel reservations; providing room reservation and hotel reservation services; providing temporary accommodation; charitable services, namely providing temporary accommodation; electronic information services relating to hotels; emergency shelter services [providing temporary housing]; event facilities and temporary office and meeting facilities; guest house services; guest houses; guesthouse; guesthouses; hire of bed linen; hire of interior chairs; hire of interior lighting; hire of interior matting; hire of interior tables; hire of pavilions; hire of temporary office space; linen hire; hiring of*

*furniture; hiring of furniture for conferences; hiring of furniture for exhibitions; hiring of furniture for presentations; hiring of mats; hiring of rooms for social functions; holiday camp services [lodging]; letting of holiday accommodation; holiday accommodation services; holiday lodgings; holiday planning services [accommodation]; homes (Tourist -); hospitality services [accommodation]; Providing campground facilities.*

17. The phrase “services of providing food and drink” in the opponent’s specification is broad enough to encompass all services provided by persons or establishments whose aim is to prepare and present food and drink for immediate consumption. These services will include restaurants, coffee shops or catering services to hookah lounge services that also sell food and beverages. Therefore, the applicant’s *fast food restaurants; fast-food restaurant services; food and drink catering; restaurants; restaurants (Self-service -); bar and restaurant services; carry-out restaurants; grill restaurants; providing food and drink for guests in restaurants; providing food and drink in restaurants and bars; providing information about restaurant services; providing restaurant services; serving food and drink for guests in restaurants; serving food and drink in restaurants and bars; pizza parlors; ice cream parlors; ice cream parlour services; Japanese restaurant services; juice bar services; juice bars; lounge services (Cocktail -); mobile catering; mobile catering services; mobile restaurant services; night club services [provision of food]; office catering services for the provision of coffee; organisation of catering for birthday parties; outside catering; outside catering services; personal chef services; preparation of Japanese food for immediate consumption; preparation of meals; preparation of Spanish food for immediate consumption; providing drink services; providing food and drink catering services for convention facilities; providing food and drink catering services for exhibition facilities; providing food and drink catering services for fair and exhibition facilities; providing food and drink for guests; providing food and drink for guests in restaurants; decorating of food; providing food and drink in bistros; providing food and drink in doughnut shops; providing food and drink in Internet cafes; providing food and drink in restaurants and bars; providing food to needy persons [charitable services]; providing of food and drink via a mobile truck; providing restaurant services;*



*catering services specialising in cutting ham for fairs, tastings and public events; catering services specialising in cutting ham for weddings and private events; charitable services, namely providing food and drink catering; charitable services, namely, providing food to needy persons; club services for the provision of food and drink; cocktail lounge buffets; cocktail lounge services; cocktail lounges; coffee bar services; coffee shop services; coffee shops; coffee supply services for offices [provision of beverages]; grill restaurants; hookah bar services; hookah lounge services; hospitality services [food and drink]; contract food services; hotel catering services; fast food restaurants; fast-food restaurant services; food and drink catering; food and drink catering for banquets; food and drink catering for cocktail parties; food and drink catering for institutions; food and drink preparation services; food preparation; food preparation for others on an outsourcing basis; food preparation services; restaurant and bar services; restaurant services; restaurant services for the provision of fast food; restaurants; restaurants (Self-service -) fall within the broad category of the opponent's services of providing food and drink. The competing goods are, therefore, identical under the *Meric* principle.*

18. The contested *food sculpting services* concerns artistically carving or shaping food. The nature and focus of these services are different from the opponent's services of providing food and drink. The competing services share purpose as both concern presenting food to consumers. In the absence of evidence to the contrary, I think food sculpting services are, most likely, offered by establishments that provide services of providing food. The services are, therefore, likely to coincide in their distribution channels. The services are also complementary in the sense described by the case law in that it seems to me food sculpture is unlikely to be requested in isolation from accompanying food (i.e. not sculpted). Considering these factors, I find that the services are similar to a high degree.

Providing reviews of restaurants; providing reviews of restaurants and bars; providing information about bar services; providing information about bartending; providing information about restaurant services; providing information in the nature of recipes for drinks

19. The applicant's above-mentioned services are most likely to be offered online or through events such as tasting events run by restaurants or bars in connection with their services of providing food and drink. Given that the purpose of the applicant's services is to provide information to customers, they differ in purpose with the opponent's services of provision of food and drink that concerns preparing and providing food and drink and facilities for the consumption of food and drink. They do not compete. However, I consider that there is an overlap in users and trade channels. The services are likely to be complementary in the sense described by the case law. Considering these factors, I find that the competing services are similar to a medium degree.

20. *Making reservations and bookings for restaurants and meals; booking of restaurant seats* in the application allow users to reserve a table to dine-in. These services are offered in connection with the provision of food and drink. Although these services may include a third party arranging the booking on behalf of a range of restaurants as a standalone service, the same service may, for example, be offered directly by restaurants themselves, for example by a group of restaurants that operates in a chain. The competing services, therefore, overlap in users and channels of trade. Table reservation services are likely to be important for the opponent's services and from the average customer's point of view, both services are likely to be provided by the same undertaking. The competing services are, therefore, complementary in the sense described by the case law. Considering these factors, I find that the services are similar to at least a medium degree.

21. *Providing banquet and social function facilities for special occasions; providing community centers for social gatherings and meetings; providing conference rooms; providing convention facilities; providing exhibition facilities in hotels; providing facilities for exhibitions; providing facilities for fairs and exhibitions* in the application are identical to the opponent's provision of event facilities and meeting facilities services under the *Meric* principle.

22. *Providing temporary accommodation as part of hospitality packages; providing temporary accommodation in boarding houses; providing temporary accommodation in holiday flats; providing temporary accommodation in holiday homes* in the application are identical to the opponent's providing temporary accommodation under the *Meric* principle.
23. As marquees are large tents used for social or commercial gatherings, the applicant's services, namely, *hire of marquees; marquee hire; marquees (Rental of -)* are identical to the opponent's rental of tents under the *Meric* principle.
24. The applicant's *drink dispensing machines (rental of)* is identical to rental of beverage fountains in the opponent's specification under *Meric* principle.
25. *Creche services; creche services provided in shopping locations; day care centers; day nursery services; day-care center services; day-nurseries; day-nurseries [crèches]; day-nursery [crèche] services; nurseries and day care centers; nurseries, day-care and elderly care facilities; old people's home services; preschooler and infant care at daycare centers; providing child care centers; child care services; mobile creches; child minding services; children's creches; homes for the elderly [retirement]; homes (Retirement -)* in the application are identical to the opponent's nurseries, day-care and elderly care facilities because they are either identically contained in the opponent's specification or falls within the broad term of the opponent's services under the *Meric* principle.
26. Given the overlap in users and channels of trade, and complementarity, I find the applicant's *providing information about creche services* are similar to the opponent's nursery services to a medium degree.
27. *Children's residential home services* in the application provide temporary care to children when parents are unavailable for their care. As day-care or nursery services in the opponent's specification also concern providing care to children, the competing services overlap in their purpose. However, unlike the

opponent's services that do not involve an overnight stay, staying at children's residential homes may be of considerable length – although they are not meant for a permanent stay. Therefore, the nature of the services is different. It does not appear to me, nor there is evidence that children's residential home services routinely offer day-care services as well. Accordingly, I do not consider that the services coincide in their trade channels. Their users are not materially the same, notwithstanding that the services that may involve parents and children. They are neither complementary, nor do they compete. Considering these factors, I find that the competing services are similar to a low degree.

28. I turn next to the applicant's *information and advice in relation to the preparation of meals; cookery advice, consultancy services in the field of food and drink catering; consultancy services relating to baking techniques; consultancy services relating to food; consultancy services relating to food preparation; consulting services in the field of culinary arts*. There is a thematic overlap with the opponent's 'services for providing food and drink', but the services differ in nature and purpose. The applicant's services are offered to help businesses set up or improve the services of providing food and drink; whereas, in contrast, the opponent's 'services for providing food and drink' concern preparing and presenting food to customers or offering facilities for food consumption. The users differ, because the applicant's services are most likely to be used by businesses while the general public uses the opponent's services. Although the applicant's services are likely to be important for the opponent's services, it does not appear, nor there is evidence that the average consumer is likely to think that the same undertaking offers both the services. The services are, therefore, not complementary in the sense described by the case law. They do not compete either. It is possible that the services overlap on the basis that the providers of the applicant's consultancy services may have gained relevant experience through having directly run establishments that provide food and drinks to customers, but I have no evidence to find similarity based on that point. Considering all relevant factors, I find that competing services are dissimilar. If I am wrong in this finding, then the services are similar only to (at best) a very low degree.

## **Distinctiveness of the earlier mark**

29. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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-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).”

30. Invented words usually have the highest degree of distinctive character, while words which are allusive of the services have the lowest. Distinctiveness can also be enhanced through use of the mark. The opponent has not filed any evidence of use of the mark. Therefore, I have only the inherent position to consider.

31. The opponent's mark contains the word "emoji". The applicant submits:

"The Applicant questions the validity of the Earlier Mark given that the word "emoji" is a generic term and is the common name for the goods or services for which it is registered. According to the Oxford English Dictionary the word means "a small digital image or icon used to express an idea, emotion, etc, in electronic communications" and is derived from the Japanese word for pictograph. Further, the Earlier Mark is entirely descriptive of the goods or services for which it is registered and is non-distinctive."<sup>2</sup>

32. Emoji is a visual cue used to convey mood or expressions in electronic communications. I am aware from my own experience that the term is may be used by undertakings across various sectors to capture customer satisfaction information, and widely used among customers to give words context when communicating online. However, I am not convinced by the applicant's argument that the term "emoji" is a description of the category of services covered by the opponent's specification. Instead, I find that the opponent's mark is neither allusive nor suggestive of its services and, therefore, possesses a medium degree of distinctive character in relation to all the opponent's services in Class 43.

### **Comparison of marks**

33. 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 marks must be assessed by reference to the overall impressions created by the 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:

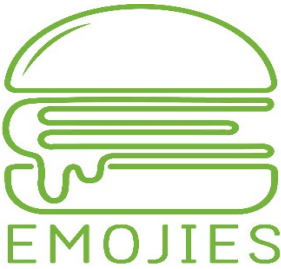
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<sup>2</sup> See the applicant's written submissions dated 12 October 2020 para 5.

“.....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.”

34. It would be wrong, therefore, artificially to 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.

35. The trade marks to be compared are as follows:

Opponent’s trade mark	Applicants’ trade mark
emoji	

36. The opponent’s trade mark is simply the word-only mark emoji. The overall impression and the distinctiveness of the mark lie in this word.

37. The applicant’s mark consists of the word “EMOJIES” in green upper-case letters. Above the word appears a device element in the same shade of green as the word. I note that the applicant and the opponent concede that the device is a stylised representation of a burger. I agree that the parties’ perception accords with how the average consumer will also recognise the device element. Based on similar considerations as discussed at paragraph 32, the word “emojies” possesses a medium degree of distinctive character in relation to the applicant’s services. The device is allusive that the applicant’s services are related to food and drink and possesses only a weak distinctive character.

Although it is less allusive in relation to the remainder of the services, I consider that the device's distinctiveness is no more than low. Due to its size and positioning, the device does contribute to the overall impression of the mark. However, given its low distinctive character, I find that the mark's overall impression is dominated by the word "EMOJIES".

38. On visual similarity, the opponent submits:

"From a visual perspective the marks share the first five letters "EMOJI". The only difference between the marks is the last two letters "ES" which seem to denote a plural of "emoji". Therefore, the marks are visually similar."<sup>3</sup>

39. Visually the opponent's mark is wholly contained in the applicant's mark. In terms of differences, the applicant's mark contains a device element absent from the opponent's mark. Although the applicant's mark ends with the additional letters "ES", I note that this difference is only at the end of the word and is likely to have a less impact on the average consumer. The colour and case difference between the marks is irrelevant to my comparison as the notional and fair use would entitle the opponent to use its mark in the same colour and case as the applicant. Weighing up the similarities and differences, I find that the marks are visually similar to a medium degree.

40. In an aural comparison, it is well-established that when a trade mark consists of a combination of words and figurative components, the trade mark is most likely to be referred to by the words. The competing marks contain three syllables each. The opponent's mark will be pronounced entirely conventionally. The average consumer will pronounce the applicant's mark like the plural form of the opponent's mark. The difference in sound between the marks is, therefore, only in the last syllable. Considering these factors, I find that the marks are aurally similar to a fairly high degree.

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<sup>3</sup> See the statement of grounds.



41. In a conceptual comparison, the marks contain the concept of emoji - in the applicant's mark, the average consumer is likely to perceive this concept in a plural form. As rightly noted by the applicant, emoji means "a small digital image or icon used to express an idea, emotion, etc. in electronic communications". The applicant's mark contains an additional device element that will invoke a "burger" concept. Considering these factors, I find that the marks are conceptually similar to a medium degree.

### **Likelihood of confusion**

42. A likelihood of confusion is made on a global assessment of all factors relevant to the circumstances of the case (*Sabel* at [22]). It is necessary for me to factor in the distinctive character of the earlier trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion (*Sabel* at [24]). I must also have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa (*Canon* at [17]). I must also keep in mind the average consumer of the services, the nature of the selection process and that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

43. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertaking being the same or related).

44. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he 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”.

45. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting 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 another mark to mind. This is mere association not indirect confusion.

46. Earlier in this decision, I concluded:

- That the contested services are either identical or similar to various degrees to the services covered by the opponent’s mark;
- That the services will be selected primarily by visual means, with a degree of attention that varies from low to a fairly high degree;
- That the marks are visually and conceptually similar to a medium degree and aurally similar to a fairly high degree;
- That the opponent’s mark, as a whole, is distinctive to a medium degree.

47. The applicant submits:

“Although the words “EMOJIES” and “emoji” are visually and aurally similar, the presence of the prominent and distinctive burger logo readily distinguishes the Proposed Mark from the Earlier Mark to the extent that the public is unlikely to associate the Proposed Mark with that of the

Earlier Mark and there would be no confusion by the public of the two marks.”<sup>4</sup>

48. I disagree with the applicant. Balancing the factors noted at paragraph 46, I find that where the competing services are identical, or similar to a medium degree, there is a likelihood of direct confusion. Following the decision in *Kurt Geiger*,<sup>5</sup> it is the distinctive character of the identical or similar elements in the competing marks that is key in determining a likelihood of confusion. The impact of the similar words - emoji/emojies, which are the most memorable aspect of the respective marks - on the average consumer when selecting identical or services that are similar to a medium degree, in my view, is enough to result in a likelihood of direct confusion, especially allowing for imperfect recollection. The additional burger element possesses only a low degree of distinctive character in relation to services connected with food and drink and is, therefore, not enough to dispel a likelihood of direct confusion. I bear in mind that the burger logo has no apparent connection to certain services such as hiring bed linen or guesthouse services. However, given the identity between those competing services, it is unlikely that the average consumer even if he or she pays a fairly high degree of attention would retain the differences between the marks as part of his or her recollection of each mark. Moreover, even if the presence of the burger logo operated to avoid direct confusion, I do not discount the possibility for an indirect confusion.

49. However, I consider that there is no likelihood of confusion either direct or indirection in relation to the applicant’s children’s residential home services. This is because these services are similar to the opponent’s services only to a low degree. The average consumer who is likely to pay a fairly high degree of attention when selecting the services is likely to remember the difference between the marks. With that degree of attention, he or she is unlikely to mistake one mark for the other, nor think that the marks are variant marks used by the same or economically linked undertaking.

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<sup>4</sup> See the applicant’s written submissions dated 12 October 2020, para 2.

<sup>5</sup> *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

50. I also consider that there is no likelihood of confusion in relation to the applicant's following services:

Class 43: Information and advice in relation to the preparation of meals; cookery advice, consultancy services in the field of food and drink catering; consultancy services relating to baking techniques; consultancy services relating to food; consultancy services relating to food preparation; consulting services in the field of culinary arts.

The significant distance between the competing services is such that it is unlikely that the average consumer would be confused, be it direct or indirect.

## **Conclusion**

51. The opposition is partially successful. The application will proceed to registration only in relation to:

Class 43: Children's residential home services; information and advice in relation to the preparation of meals; cookery advice, consultancy services in the field of food and drink catering; consultancy services relating to baking techniques; consultancy services relating to food; consultancy services relating to food preparation; consulting services in the field of culinary arts.

## **Costs**

52. Both parties have achieved a measure of success. However, the opponent is more successful than the applicant. I award costs to the opponent on the following basis:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200

Total: £300

I consider it appropriate to reduce the costs awarded to emoji company GmbH by 30% to reflect its partial success.

53. I order Emojies LTD to pay emoji company GmbH the sum of **£210**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 28<sup>th</sup> day of January 2021**

**Karol Thomas  
For the Registrar  
The Comptroller-General**