

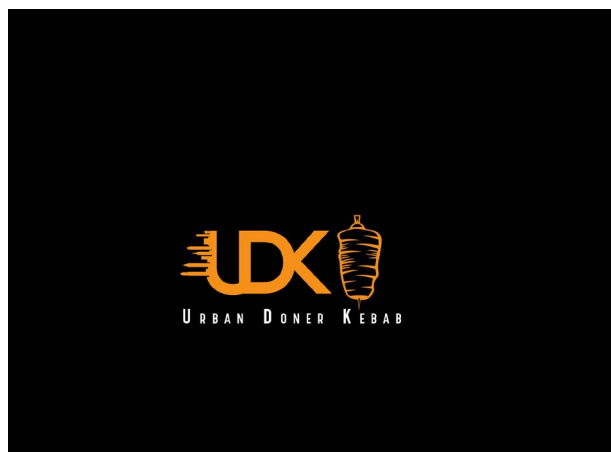
O/557/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3563441

**IN THE NAME OF SYED
HASAN**

**TO REGISTER THE FOLLOWING TRADE
MARK:**



IN CLASS 43

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 424406
BY GDK INTERNATIONAL LIMITED**



Background and pleadings




1. On 3 December 2020, Syed Hasan ('the applicant') applied to register the trade mark shown on the cover page of this decision. It was accepted and published in the Trade Marks Journal on 12 February 2021 in respect of the following services:

Class 43: Fast food restaurants; Restaurant services for the provision of fast food; Take-away fast food services.

2. On 12 May 2021, GDK International Limited ("the opponent") filed a notice of opposition against the application. The opposition is brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") and is directed against all the applied for services.

3. Under sections 5(2)(b) and 5(3), the opponent relies upon the following trade marks:

Earlier Mark	Registration no.	Registration date	Services relied upon
	UK 3066763 "The first earlier mark"	7 November 2014	Class 43: Services for providing food and drink; food preparation; fast-food restaurants; restaurant services; hospitality service [food and drink]; food cooking services; catering of food and drink; offsite services for providing food and drink;
GDK	UK 3050740 "The second earlier mark"	22 August 2014	catering services; delicatessens [restaurants]; grill restaurants; self-service restaurants; carry-out restaurants; snack-bars; salad bars; wine bars; wine bar services; restaurant services incorporating licensed bar facilities; provision of information relating
	UK 3066762 "The third earlier mark"	7 November 2014	

	IR 1414475 ¹ “The fourth earlier mark”	23 April 2018	to restaurants and bars; consultancy services in relation to food and drink preparation; rental of food service equipment; temporary accommodation.
 <p>(1)</p>  <p>(2)</p>	UK 3227008 “The fifth earlier mark”	28 July 2017	Class 43 Services for providing food and drink; food preparation; fast-food restaurants; restaurant, canteen, buffet, food bar, snack bar, salad bar, coffee shop, delicatessen and cafeteria services; grill restaurants; self-service restaurants; take away fast food restaurants; carry-out restaurants; hospitality services [food and drink]; catering services; wine bar services; restaurant services incorporating licensed bar facilities; consultancy services in relation to food and drink preparation; rental of food service equipment.

4. For the purposes of the opposition under section 5(2)(b), the opponent relies upon all the services for which the earlier marks are registered. In its notice of opposition, the opponent contends that the competing trade marks are highly similar and that the respective services are identical or similar, giving rise to a likelihood of confusion.

5. In respect of section 5(3), the opponent claims that the earlier marks have a significant reputation in respect of all the services for which they are registered, and the earlier marks have a high level of distinctiveness which has been enhanced

¹ Although the UK has left the EU and the EUTM relied upon by the applicant enjoys protection in the UK as a comparable trade mark, the EUTM remains the relevant right in these proceedings. That is because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it stood at the date of application.

through use. The opponent contests that the applicant's mark and services are highly similar to that of the opponents, and this would lead the average consumer to believe that the services are provided under control of the opponent. It is claimed that the opponent has invested large sums in marketing in respect of its earlier marks and the applicant's mark would free ride on the investment by the opponent in promoting its mark. The opponent also states that their services promote an ethos of healthy eating, nutritional balance and the use of high-quality ingredients. Use of the applicant's mark would therefore run a high risk of compromising the opponent's reputation in this regard, as the opponent would have no control over the quality of services provided by the applicant. Finally, the opponent argues that use of the applicant's mark would damage the distinctive character and cause detriment to the power of attraction of the opponent's marks and there would therefore be a serious risk that the economic behaviour of the average consumer would change as a result.

6. By virtue of their earlier filing dates, the opponent's trade marks are earlier marks, in accordance with section 6 of the Act. The first, second and third earlier marks had completed their registration processes more than five years before this date and are therefore subject to the proof of use provisions contained in section 6A of the Act. The fourth and fifth earlier marks completed their respective registration processes less than five years before the filing date of the application and are therefore not subject to proof of use pursuant to section 6A of the Act.

7. Turning to the 5(4)(a) claim, the opponent relies upon the use of the following three unregistered marks:



(ii) **GDK**



8. All three marks are said to have been used "as early as 2016" throughout the UK in relation to, "*Services for providing food and drink; food preparation; fast-food restaurants; restaurant, canteen, buffet, food bar, snack bar, salad bar, coffee shop,*

delicatessen and cafeteria services; grill restaurants; self-service restaurants; take away fast food restaurants; carry-out restaurants; hospitality services [food and drink]; catering services; restaurant services incorporating licensed bar facilities.” It is claimed that use of the applicant’s mark, in respect of the services applied for, will lead to misrepresentation and damage to the opponent’s goodwill associated with its earlier signs.

9. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use in respect of its first, second and third earlier marks.

10. The opponent is represented by Lincoln IP whereas the applicant is represented by Handsome IP Ltd. While the opponent filed evidence, the applicant did not. Neither party requested a hearing nor filed written submissions in lieu. I now make this decision after careful consideration of the papers before me.

11. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

12. The opponent’s evidence was filed in the form of a witness statement dated 13 December 2021 from the company’s CEO, Imran Sayeed and accompanying 16 exhibits. Whilst I do not intend to summarise the evidence here, I have taken it into consideration in reaching my decision and I will refer to it below where necessary.

DECISION

Proof of use

13. The applicant has requested proof of use in these proceedings in respect of the opponent's first, second and third earlier marks, in respect of all of the services relied upon. Although proof of use has been requested in respect of the third earlier mark, I note that the opponent's fourth earlier mark which is not subject to proof of use, displays an identical logo and is registered for identical services in class 43. It is well established that under fair and normal use, a mark registered in black and white or in greyscale may be used in colour. As such, I find that although the third mark is presented in greyscale whereas the fourth mark is presented in black and white they provide the opponent with identical protection, and it is not necessary for me to consider proof of use for the third mark as the opponent may instead rely on the protection offered by the fourth earlier mark. I will therefore focus my assessment on the opponent's first and second earlier marks.

Relevant statutory provision: Section 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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if -

(a) within the relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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 European Union 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 Union.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union

Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

14. Section 100 is also relevant, which reads:

“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.”

15. Consequently, the onus is upon the opponent to prove that genuine use of the registered trade marks was made within the UK in the relevant period, and in respect of the services as registered. In accordance with section 6A(1A) of the Act, that period is the five-year period ending on the date of application of the contested mark i.e., 4 December 2015 to 3 December 2020.

Variant use

16. Before I move on to assess if the opponent has shown genuine use, I must first consider if I find the use of the marks as shown in the evidence to be use of the marks as registered. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

17. I note that the first earlier mark is displayed in a greyscale colour scheme whereas the evidence provided predominantly shows use of the mark in the following colours:



18. As I have outlined above, the registration of a trade mark in black and white or as in this case in grey and white covers use of the mark in colour. This is because colour is an implicit component of a trade mark registered in black and white (as opposed to extraneous matter).³ Thus a black and white version, or as in this case a grey and white version of a mark should normally be considered on the basis that it could be used in any colour, and it follows that the use of a mark registered in black and white, or as in this case in grey and white in another colour is acceptable use of the mark as registered. I acknowledge there may be exceptions for marks used in complex colour arrangements where these alter the distinctive character of the mark as registered. However, in this instance I find the opponent has simply applied the solid colour orange to the letter G and the device. I consider it to be normal and fair use of the mark as registered, and in any case, it is my view that this use of colour does not alter the distinctive character of the registered mark. I therefore find the use above to be use of an acceptable variant of the first earlier mark.

² Exhibit G8

³ See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47

The second earlier mark

19. Turning to the opponent's second mark, I consider if the logo shown above and featuring heavily in the opponent's evidence constitutes use of an acceptable variant of the same. I acknowledge that where a registered mark is used as part of another mark or with additional matter, this may still constitute use of an acceptable variant of the mark as registered, where this element continues to act independently as an indicator of origin.⁴ However, it is my view that in this instance, the logo shown above is not simply the use of the letters "GDK" with additional matter. In the logo shown, the letter "G" is placed behind the letters "DK" and tipped on its side. It is my view that the mark "GDK" is a simple short mark which appears to be an acronym, and that it inherently holds a fairly low level of distinctive character. However, it nonetheless constitutes the second earlier mark in its entirety, and it is within this element that the distinctive character of the second earlier mark is held. It is my view that the alterations made to the stylisation of the letters as shown in the logo above add to the distinctive character of the mark, and as such the use of the logo shown does not constitute an acceptable variant of the opponent's second earlier mark.

Relevant case law

20. 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 Court of Justice of the European Union ("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 Marken BV v Hagelkruis Beheer BV*

⁴ *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

[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].”

Use of the mark

The second earlier mark

21. As discussed previously, I do not find the use of the logo mark shown in the evidence to constitute use of an acceptable variant of the opponent’s mark GDK. I therefore consider the use that has been shown of this mark alone. I note there are a couple of references to the mark in press articles, which show German Doner Kebab being referred to as the abbreviated GDK. Further, I note the occasional use of the letters GDK by the opponent, such as on social media pages Facebook, Instagram and Twitter, which refer to ‘GDK – German Doner Kebab’, but I note these pages are dated 21 May 2021 and display only recent posts, meaning this use falls outside of the relevant period.⁵ The vast majority of the use shown within the relevant time period is in relation to the opponent’s logo marks, or refer to German Doner Kebab in full. The opponent has not provided evidence of GDK, or an acceptable variant being used on its stores, and with consideration to the sum of the evidence, it is my view this does not support a finding that the opponent has made genuine use of the mark GDK on its own in relation to the services for which it has been registered. .

The first earlier mark

22. In his witness statement, Mr. Sayeed explains that GDK International Limited became the worldwide brand owner for the German Doner Kebab chain of fast-food restaurants in 2016. He states that the brand operates on an ethos of a healthy and nutritionally balanced approach to traditional kebabs.⁶ He claims that since opening their first store in the UK in 2015, the opponent has rapidly expanded their business, such that there are currently (as at the date of his witness statement) 78 German Doner Kebab stores in the UK with a further 24 outlets due to open in the near future⁷.

⁵ See Exhibit G10 to the Witness Statement of Imran Sayeed

⁶ Paragraph 2 of the Witness Statement of Imran Sayeed

⁷ Paragraph 3 of the Witness Statement of Imran Sayeed

Mr. Sayeed has also provided turnover figures for the opponent's restaurants in the UK for the period from 2018-2020 which is as follows:

Year	Total Turnover
2018	£15,746,000.00
2019	£9,764,000.00
2020	£64,952,744.70

23. Further, Mr. Sayeed explains that the opponent has invested large amounts in promotion and advertising its German Doner Kebab brand in the UK with the following figures provided:

Year	Spending Figures
2018	£896,306.37
2019	£1,493,264.83
2020	£1,588,397.63

24. Whilst I acknowledge that the figures in 2020 may relate to sales and advertising spend from after the relevant date of 3 December 2020, it is reasonable to assume from the way the figures follow on consistently from previous years, and on the basis that the majority of the year 2020 falls prior to the relevant date, that at least a significant portion of these figures will be in respect of turnover and spending prior to 3 December 2020.

25. I note that some of the evidence filed by Mr. Sayeed is dated after the filing date of the contested mark and therefore outside of the relevant period however, several of the exhibits show use of the first mark within the relevant period such as advertisements,⁸ food packaging,⁹ and signage outside the opponent's restaurants.¹⁰ Further, I note Exhibit G3 presents a screenshot from a YouTube video displaying the opponent's first mark in their advertising campaign "Get Dat Kebab" dated 3 June

⁸ Exhibit G3

⁹ Exhibit G9

¹⁰ Exhibits G8, G9, G14 & G16

2019. The image shows that the video has had over 200,000 views. In his witness statement, Mr. Sayeed explains that the campaign ran during 2019 and was covered in the wider press¹¹.

26. Exhibit G8 shows examples of press coverage displaying the opponent's mark on shop signage and interior decoration. The articles are from various news outlets such as The Mirror dated 19 October 2020, The Courier dated 16 December 2017, Milton Keynes Citizen dated 16 November 2018 and Asian Image dated 29 June 2019. The articles all detail the success of the opponent's brand and its expansion as new restaurants open throughout the UK. Notably, the article in The Mirror states, "German Doner Kebab has said it is opening another 12 restaurants this year and creating 480 jobs by the end of 2020 as it pushes on with rapid growth plans despite turmoil in the UK's dining sector." It is clear from these articles that at least a significant portion of the sales and advertising figures are attributable to food and drink services provided under the opponent's first mark (or an acceptable variant of the same).

Genuine Use

27. Considering the sum of the evidence, including the UK turnover between 2018 and 2020, the advertising expenditure between 2018 and 2020, and the use of the first earlier mark on restaurant signage, food packaging and press articles (those of which are dated within the relevant timeframe), it is my view that the opponent has made use of the mark within the relevant timeframe. Again, with consideration to the sum of the evidence, it is my view particularly with reference to the consistent and substantial sales figures and advertisement of the mark over the last three years, the use made by the opponent does not appear to be token, solely for the purpose of preserving the rights conferred by the registration of the opponent's mark. Rather, I find the use to be for the purpose of creating and preserving a share of the UK market for the services for which it is registered. As such, I find that there is genuine use of this mark in relation to services falling within those food and drink services protected by the opponent in class 43.

¹¹ Paragraph 5 of the Witness Statement of Imran Sayeed

Fair Specification

28. I now need to consider what constitutes a fair specification for the first earlier mark, having regard for the services upon which genuine use has been shown. 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 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.”

29. 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."

30. The opponent covers services in class 43 including those such as services for providing food and drink broadly. Whilst I consider that the use shown by the opponent is in respect of services falling within this category, I also consider that this category of goods may be broken up into several subcategories. I do not find that the use shown warrants protection for this category at large, and I do not believe this is how the consumer would fairly describe the services offered by the opponent. However, I do find that the consumer would consider *fast-food restaurants and carry-out restaurants* to be a fair description of the services evidenced. I will therefore assess the grounds under section 5(2)(b) and 5(3) based on that specification.

Section 5(2)(b)

31. 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”.

32. 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.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a 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 the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

My Approach

33. The opponent has relied upon five earlier rights under this ground of opposition. Previously in my decision, I found there to be no genuine use of the opponent's second mark and as such, I will not consider this mark further. Further, as previously stated, the opponent's third mark offers identical protection to the fourth mark, so it is not necessary for me to consider both these marks, and as such I intend to consider the opponent's fourth earlier mark which is not yet subject to proof of use, and therefore may be relied upon for the full set of services registered. Finally, I find the opponent's first mark and fourth mark to be considerably more similar visually to the contested mark than the opponent's fifth mark relied upon, and I therefore find it appropriate to proceed initially by considering the opponent's first and fourth earlier marks only. However, in the event that there is no likelihood of confusion, I will return to consider the opponent's fifth earlier mark, and if the opponent's position under this ground may be improved by its reliance on the same.

Comparison of Services

34. 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".

35. 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services;

c) The respective trade channels through which the goods or services reach the market;

d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

36. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods 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”.

37. Though expressed in reference to goods, the same principle also applies to services. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux- Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

38. The services to be compared are as follows:

Opponent's services	Applicant's services
Mark 1 Class 43: fast-food restaurants and carry-out restaurants	Class 43: Fast food restaurants; Restaurant services for the provision of fast food; Take-away fast food services.
Mark 4 Class 43: Services for providing food and drink; food preparation; fast-food restaurants; restaurant services; hospitality service [food and drink]; food cooking services; catering of food and drink; offsite services for providing food and drink; catering services; delicatessens [restaurants]; grill restaurants; self-service restaurants; carry-out restaurants; snack-bars; salad bars; wine bars; wine bar services; restaurant services incorporating licensed bar facilities; provision of information relating to restaurants and bars; consultancy services in relation to food and drink preparation; rental of food service equipment; temporary accommodation.	

39. The term *fast-food restaurants* appear in both the earlier specifications and the applicant's specification are self-evidently identical.

40. I find that the *restaurant services for the provision of fast food* in the applicant's specification is also self-evidently identical to *fast-food restaurants* covered by both the earlier specifications.

41. I consider the applicant's term *take-away fast food services* would include *carry-out restaurants* included in both earlier specifications. These services are therefore identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

42. 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.”

43. The average consumer for the services in question is the general public and the cost of these services is likely to be fairly low. In terms of the purchasing process, I agree with the opponent that this process will be fairly “casual”. Notwithstanding the casual purchasing process, consumers may consider factors such as types of food on offer, ingredients used and, allergens and/or other particular dietary requirements. Overall, I would expect a medium degree of attention to be paid during the purchasing process.

44. The selection of these services will likely be selected on the high street or online with the trade marks displayed on shop front displays, brochures or viewed on a webpage or via social media platforms. I find that the selection process would primarily be visual however, I do not discount that there will be an aural component

in the selection of the services in the form of word-of-mouth recommendations and telephone orders.

Comparison of marks

45. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

46. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade 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.

47. The marks to be compared are as follows:

Opponent's marks	Applicant's mark
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Mark 1



Mark 4



48. The opponent's first earlier mark consists of the letters DK in front of the letter G presented at a tilted angle. Beneath the lettering are the words "German Doner Kebab" in a smaller font and to the right is a stylized doner kebab rotisserie device. The wording and device element are presented on a grey rectangular background. I find the "GDK", and particularly the bold lettering DK placed in front of the 'G' to be the most dominant and distinctive part of the mark due in part to its size and positioning, in addition to the fact it is a word element. The device element plays a secondary role in the mark along with the "German Doner Kebab" wording which, although somewhat descriptive of the services, will not go unnoticed by the average consumer. The grey rectangular element merely serves as a backdrop for all the other elements and has no impact on the overall impression of the mark.

49. The opponent's fourth earlier mark also consists of the letters DK in front of the letter G presented at a tilted angle with a stylized done kebab rotisserie device to the right of the lettering. The lettering and device element are presented in grey and white shades on a black background. Again, due in part to its size, positioning and with it being a word element, I consider the "GDK" lettering, and particularly the "DK" to be the most dominant and distinctive part of the mark. The device plays a secondary role

in the mark whereas the black background, serving as a backdrop, has no impact on the overall impression of the mark.

50. The applicant's mark comprises of the letters "UDK" in an orange font. The three letters are conjoined with no spacing between them. A sideways stylized illustration of a cityscape protrudes from the left-hand side of the letter U. The wording "Urban Doner Kebab" is presented in a white font beneath the "UDK" element and a stylized doner kebab rotisserie device is presented to the right of the "UDK" element outlined in orange. These elements are presented on a black rectangular background. Beneath this, the same elements are presented in identical positioning in an orange outline, on a white rectangular background.

51. Despite likely being viewed as an acronym, I find the two UDK elements are the most dominant and distinctive part of the mark. The wording and kebab devices will therefore play a secondary role in addition to the use of the orange colour. The cityscape element protruding from the side of the letter U may, in some instances, simply be considered as decorative lines coming from the U, and I find this only contributes in a small way to the overall impression of the mark itself. The logos are repeated twice, and it is my view that due to the contrast with the black background, the consumers attention will initially be drawn to the top logo.

Visual comparison

Opponent's first mark and the applicant's mark

52. Both marks appear to adopt the same positioning of their lettering, device and wording elements. Though the marks both adopt the letters DK, a point of difference lies in the use of the letter G vs the letter U, and the stylization choice as the opponent's mark presents the letter G at a tilted angle behind the letters DK whilst the lettering in the applicant's mark appears conjoined and contains the protruding cityscape element. Both marks contain a figurative rotisserie device element, albeit presented in slightly different stylizations. This is located in the same position of the logo elements, and it is my view this increases the visual similarity. The wording in the marks coincide in their use of "Doner Kebab", though in the opponent's mark, this wording is qualified with the word "German". This has no counterpart in the applicant's mark which instead

uses the word “Urban”. I note the difference in colour schemes as the opponent’s mark is presented in greyscale whilst the applicant’s mark is presented in black, white and orange, but as previously mentioned, it is my view that the use of greyscale in the earlier marks means it may be used in a range of colours including orange. A further point of visual difference is that applicant’s mark fully reproduces the main elements of its mark twice. Overall, I consider the marks to be visually similar to between a medium and high degree.

Opponent’s fourth mark and the applicant’s mark

53. As per my previous comparison above, the marks adopt the same positioning of their lettering and device elements however, I note that the wording “Urban Doner Kebab” in the applicant’s mark has no counterpart in the opponent’s mark. Again, the marks both adopt the letters DK yet a point of difference lies in the use of the letter G vs the letter U, and the stylization choices as previously stated in my comparison above. The marks both contain a figurative rotisserie device element, albeit presented in slightly different stylizations. This is located in the same position of the logo elements, and it is my view this increases the visual similarity. As stated above, I am of the view that the use of a black and white colour scheme in the opponent’s mark means it may be used in a range of colours including those similar to that of the applicant’s mark. Again, a point of visual difference is that applicant’s mark fully reproduces the main elements of its mark twice. Considering the points of similarity and the points of difference, I find the marks to be visually similar to a medium degree.

Aural comparison

Opponent’s first mark and the applicant’s mark

54. I find that the acronym in the opponent’s mark will be pronounced in three syllables as GEE-DEE-KAY due to the dominance of these elements. My finding is on the basis that the G is presented in a larger font than the DK lettering and the “German Doner Kebab” wording also present in the mark will further indicate the order in which the lettering should be pronounced. I accept in some cases though that a small minority may pronounce the letters as “DKG” or simply as “DK”. In some

circumstances, the smaller wording element will also be pronounced in six syllables as GER-MAN DON-ER KE-BAB. The applicant contends that their mark will be pronounced “UDK, Urban Doner Kebab, UDK, Urban Doner Kebab” owing to the fact that the lettering and wording is presented twice in their mark. I find it more likely however, that the average consumer will articulate this wording once and verbalise the acronym as YOU-DEE-KAY. In some scenarios, the wording may also be articulated in six syllables as UR-BAN DON-ER KE-BAB. When only the acronyms are verbalised in both marks, there is a point of difference between the G vs U element. The remainder of the DK pronunciation in both marks is identical. When the wording in both marks is pronounced, aurally the marks coincide in their use of “Doner Kebab”. A point of difference lies with the wording “German” and “Urban” though, I agree with the opponent that both words beginnings include short “er” sound and conclude with a short “-un” sound. In both scenarios, I find the marks to be aurally similar to a medium to high degree.

Opponent’s fourth mark and the applicant’s mark

55. The opponent’s fourth mark comprises only of the lettering GDK. I find that the size and prominence of the letter G will result in the mark being articulated as “GDK” however, I accept in some circumstances, a small minority may pronounce the letters as “DKG” or simply as “DK”. As stated above, the lettering in the applicant’s mark is the most dominant and is therefore likely to be the part of the mark which is verbalised. The applicant’s mark will therefore most likely be pronounced as YOU-DEE-KAY. In circumstances where only the acronyms are articulated in both marks, I find there is a medium to high level of similarity. I accept that in some cases, the wording in the applicant’s mark will be verbalised as UDK UR-BAN DON-ER KE-BAB and the only point of aural similarity will be the letters DK, as such, in these circumstances, I find the marks to be aurally similar only to a low degree.

Conceptual comparison

Opponent’s first mark and the applicant’s mark

56. Conceptually, both marks refer to doner kebabs and adopt the use of a rotisserie kebab device which will evoke the same concept. Further, both marks utilize

acronyms to abbreviate their names. Differences lie in the use of “German” in the opponent’s mark and “Urban” in the applicant’s mark. Whilst the opponent’s mark will evoke the concept of doner kebabs originating from Germany, the applicant’s mark will evoke the concept of doner kebabs being provided in an urban setting. The applicant’s concept is further reinforced by its use of the cityscape illustration, though as previously stated, this element of the mark may go unnoticed. Overall, I find the marks to be conceptually similar to a medium to high degree.

Opponent’s fourth mark and the applicant’s mark

57. Again, through the use of a rotisserie kebab device in both marks, the marks both appear to refer to doner kebabs which will evoke the same concept. Both marks utilize lettering however, the wording in the applicant’s mark make it obvious that the UDK lettering is an acronym for “Urban Doner Kebabs” whereas the GDK lettering in the opponent’s mark does not appear to have any attributable meaning. Further, the applicant’s “Urban” wording along with the use of the cityscape illustration mark will evoke the concept of doner kebabs being provided in an urban setting, a concept which is not present in the opponent’s mark. I find the marks to be conceptually similar to no more than a medium degree.

Distinctive character of the earlier mark

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

59. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

60. The opponent has submitted that the distinctiveness of its marks has been enhanced through use. However, I will begin by initially assessing the inherent distinctiveness of the marks.

61. In relation to the services *fast-food restaurants* and *carry-out restaurants*, I am of the view that the first earlier mark carries several allusive qualities. I find this on the basis that the average consumer will recognise that the “Doner Kebab” element of the mark relates to a popular type of fast food and this allusiveness will no doubt be

emphasised by the mark's rotisserie device element. Further, I find that the "German" element of the mark may indicate to the average consumer that the doner kebabs at the opponent's restaurant are of a German origin, adding to the descriptive element. I consider that the GDK element of the mark, would be considered as an acronym of "German Doner Kebab". Overall, I find that the first mark possesses a low to medium level of inherent distinctiveness.

62. Turning to the opponent's fourth earlier mark, I find the kebab rotisserie device to be somewhat allusive of the services however, this mark uses the lettering GDK without any additional wording. I do not consider the letters GDK to be allusive of the services and therefore find this mark to possess no more than a medium degree of inherent distinctiveness.

63. I now turn to consider whether the distinctiveness of the earlier marks has been enhanced through use.

64. In his witness statement, Mr Sayeed states that the German Doner Kebab business has been trading in the UK since 2015, when their first store opened in Birmingham. The business has grown considerably since that time, leading up to the relevant date with currently (at the date of the witness statement) 78 stores open in the UK and a further 24 outlets due to open shortly.

65. Further, there are several national and local press articles publicising the opponent's restaurants success and detailing the opening of new restaurants throughout the UK, which assist in showing that a number of these restaurants were open prior to the relevant date, that being the filing date of the application on 3 December 2020. An article published in The Mirror on 19 October 2020 states, "While most of the restaurant world is closing branches and laying people off, German Doner Kebab is expanding as it opens 12 new restaurants across 6 major UK cities."¹² Local news outlet Telegraph and Argus also reports on the restaurant's success in its article dated 30 May 2019 stating, "Restaurant chains across the country have faced rising costs and a decline in consumer confidence...but bosses at German Doner Kebab say the firm's biggest problem is finding new restaurants sites fast enough to match its

¹² See Exhibit G8

ambitions.”¹³ Luton Today also acknowledges the restaurant’s growth in its article dated 6 October 2020, reporting, “A gourmet kebab restaurant in Luton has been recognized as one of the best places to grab a bite according to UK consumers...The fast-casual brand is now recognized as one of the country’s fastest-growing restaurant chains, opening 35 new restaurants in the UK during the past three years.”¹⁴

66. As previously stated, I consider the turnover and advertising expenditure figures shown in paragraphs 21 and 22 of this decision to be substantial and it is reasonable to assume the majority of these figures falls prior to the relevant date. The articles dated within the relevant period and advertising campaign as shown in paragraphs 26 and 27 of this decision demonstrate consistent use of the first earlier mark throughout the relevant period and I am satisfied that at least considerable amount of the turnover and advertising expenditure figures relate to the first mark.

67. I therefore find that the inherent distinctiveness of mark 1 is likely to have been elevated to an above medium degree at the relevant date.

68. I consider that the GDK and rotisserie logo in the fourth earlier mark maintains its independent role as an indication of origin when used alongside the wording (as shown in mark 1) in line with *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12. As such, I find for the same reasons as with mark 1, the distinctive character of the fourth earlier mark has been enhanced through use to an above medium level.

Likelihood of confusion

69. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind that the average consumer rarely has the opportunity

¹³ See Exhibit G8

¹⁴ See Exhibit G16

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]).

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

71. Earlier in my decision, I found the respective services to be *Merix* identical in respect of both the earlier marks. I identified the average consumer to be a member of the general public who will purchase the goods predominantly by visual means, though I do not discount an aural element to the purchase. I also concluded that a medium degree of attention will be paid during the purchasing process.

72. In respect of the first earlier mark, I found it to be visually similar to the applicant's mark to between a medium to high degree, aurally similar to between a medium to high degree and conceptually similar to a medium to high degree. I also found the first earlier mark to have a low to medium level of inherent distinctive character for *fast-food restaurants* and *carry-out restaurants* which has been enhanced through use to an above medium level.

73. In respect of the fourth earlier mark, I found it to be visually similar to the applicant's mark to a medium degree and conceptually similar to no more than a medium degree. I considered the marks to be aurally similar to a medium to high degree in circumstances where only the acronym is verbalised, however in circumstances where the wording in the applicant's mark is also verbalised, I found them to be aurally similar only to a low degree. I also found this mark to have no more than a medium level of inherent distinctive character in respect of its services and this has been enhanced through use to an above medium level.

74. I have taken all of the relevant factors into consideration in reaching my decision and I find that there are key similarities in the stylisation and layout of the marks and the purchasing process is predominantly visual. I also bear in mind that

the earlier marks possess an above medium of distinctiveness through use. These factors along with the consumer's imperfect recollection and identity of the services lead me to believe that the applicant's mark will likely be mistaken for both the opponent's first and fourth marks, leading to a likelihood of direct confusion.

75. I now go on to consider indirect confusion.

76. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example.)

77. These examples are not exhaustive but provide helpful focus.

78. Firstly, I note that I found the opponent’s earlier marks enjoy an enhanced level of distinctiveness to an above medium degree through the use made of them. At this point, I also consider 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 and in this case I have found the respective services to be identical. As previously stated, the marks share a very similar layout and stylisation. I find if the average consumer notices the differences between the marks such as the “German” vs “Urban” wording in the first earlier mark, or the exclusion of the wording in the fourth earlier mark, or the use of ‘U’ instead of ‘G’ for example, they will also acknowledge the common elements such as the choice of very similar layout, stylisation, devices, use of acronyms including DK and the “Doner Kebab” elements. Whilst each of these elements alone may not lead the consumer to assume an economic connection between the marks, it is my view that the cumulative effect of all of these similarities is persuasive. Taking all of these factors into account, I find that should the consumer notice the differences between the marks and not be directly confused, the use of the common elements in the respective marks along will nonetheless lead to a likelihood of the consumer concluding that the services derive from the same undertaking, albeit using a variation of their doner kebab brand. Consequently, I consider there to be a likelihood of indirect confusion between the marks

79. Given that I have found a likelihood of confusion based on the opponent’s earlier first and fourth mark, I do not consider it necessary to consider the remaining marks on the basis that doing so will not improve the opponent’s position.

80. I will now proceed to consider the remaining grounds of the opposition.

Section 5(3)

81. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

82. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L’Oreal v Bellure, Case C-323/09, Marks and Spencer v Interflora, Case C383/12P, Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the

mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

83. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. Secondly, the opponent must establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

84. The relevant date for the assessment under section 5(3) is the date of the application at issue, being 3 December 2020.

My Approach

85. Earlier in my decision, I found that genuine use had been shown in respect of the first earlier mark, but not in respect of the second earlier mark, and as such I do not need to consider the opponent's second earlier mark under this ground. I identified that the third earlier mark offered the same protection as the fourth earlier mark and as such, it was not necessary for me to find proof of use, and that instead the opponent may rely on its identical protection under its fourth earlier mark. I therefore intend to consider the opponent's fourth earlier mark, but not its third earlier mark relied upon under this ground. I also found that the opponent's first and fourth earlier marks are also the most similar to the applicant's mark. I will therefore adopt a similar approach under the opponent's section 5(3) ground that I did for its section 5(2)(b) ground in that I will initially focus on the opponent's first mark and fourth marks. If the

opposition fails under this ground in respect of these earlier marks, I will proceed to consider the opponent's position in respect of its fifth mark.

Reputation

86. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

87. As previously stated in my decision, Mr. Sayeed has explained in his witness statement that since opening their first store in the UK in 2015, the opponent has rapidly expanded their business, such that there are currently (as at the date of his witness statement) 78 German Doner Kebab stores in the UK with a further 24 outlets

due to open in the near future¹⁵. I also refer to paragraph 26 in this decision where I noted several examples of news articles within the relevant period that reported on the opening of new restaurants throughout the UK. All of the articles referred to in paragraph 26 included images displaying the use of mark 1 prominently on shop exterior and interior signage.. I also noted that the opponent's turnover and advertising expenditure figures from 2018-2020 were substantial and that it was reasonable to assume that the majority of these figures were before the relevant date. I therefore find that it is reasonable to assume that a considerable amount of the turnover and advertising expenditure figures can be attributed to the first earlier mark.

88. From the evidence filed, I am satisfied that the opponent's first earlier mark had a modest reputation for *fast-food restaurants* and *carry-out restaurants* in the UK at the relevant date.

89. Turning to the fourth earlier mark, I found earlier in my decision that the GDK and rotisserie logo in the fourth earlier mark maintains its independent role as an indication of origin when used alongside the wording (as shown in mark 1) in line with *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12. In view of this, I am also content that opponent's fourth earlier mark had a modest reputation for *fast-food restaurants* and *carry-out restaurants* in the UK at the relevant date as per *General Motors*.

Link

90. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

91. I have previously assessed this under section 5(2)(b). The first earlier mark is visually similar to between a medium and high degree and aurally and conceptually

¹⁵ Paragraph 3 of the Witness Statement of Imran Sayeed

similar to a medium to high degree. The fourth earlier mark is visually similar to a medium degree and conceptually similar to no more than a medium degree. In circumstances where only the acronym is verbalised the fourth earlier mark and the applicant's mark are aurally similar to a medium to high degree, however in circumstances where the wording in the applicant's mark is also verbalised, the marks have a low degree of similarity.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

92. The respective services are identical with the relevant public being the general public who will pay a medium degree of attention during the purchasing process.

The strength of the earlier mark's reputation

93. I found that the earlier marks had a modest reputation at the relevant date.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

94. I find that the low to medium degree of inherent distinctive character of the first earlier mark had been enhanced to an above medium level at the relevant date. I also found that the fourth earlier mark had no more than a medium degree of distinctive character which had been enhanced through use to an above medium level at the relevant date.

Whether there is a likelihood of confusion

95. Previously in my decision, I found there to be a likelihood of direct and indirect confusion.

96. Having considered all of the factors, I am of the view that the opponent's modest reputation held amongst the relevant public in the UK, its enhanced level of

distinctive character and the level of similarities between the marks would result in the use of the applicant's mark bringing to mind the earlier mark in respect of all of the applied for services. I therefore find there is a link between the marks in respect of the same.

Damage

97. The opponent has pleaded that use of the applicant's mark would constitute an unfair advantage for the applicant, would be detrimental to the opponent's reputation and would dilute the distinctive character and repute of the opponent's earlier marks.

Unfair advantage

98. In *Argos Limited v Argos Systems Inc.* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods/services offered under the later trade mark was required to establish unfair advantage.

99. This may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark: see *Claridges Hotel Limited v Claridge Candles Limited and Anor*, [2019] EWHC 2003 (IPEC).

100. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the

reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

101. The opponent has pleaded that the applicant’s mark would free ride on the investment made by the opponent in promoting its marks and stimulate sales to an extent which is disproportionately high in comparison to its investment. They go on to claim that this would be unfair to the opponent as they have invested large sums in marketing. Given the modest reputation of the opponent’s first and fourth marks, and noting the likelihood of confusion between the mark in respect of all of the applied for goods, and the link with the applicant’s mark, it is my view that it is quite clear that there is potential for the applicant to gain an unfair advantage by using its mark in this instance, on the basis that consumers may engage with services under the applicant’s mark on the basis that they believe these to be offered by the opponent. Further, the applicant, by using the similar “UDK”, “Urban Doner Kebab” and rotisserie device elements, would achieve instant familiarity in the eyes of consumers, thereby securing a commercial advantage, benefitting from the opponent’s reputation without paying financial compensation. Such commercial advantage would not exist were it not for the reputation of the opponent’s marks. Therefore, I find it likely that the applicant’s mark will take unfair advantage of the opponent’s first and fourth marks.

102. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent’s other heads of damage.

103. The opposition based upon section 5(3) succeeds in respect of the opponent’s first and fourth marks. I do not consider it appropriate to proceed to assess the reliance upon the opponent’s remaining marks on the basis that it will not improve the opponent’s position.

Section 5(4)(a)

104. The final ground of opposition is under section 5(4)(a). Under this ground, the opponent relies upon the three following marks:



105. The opponent pleads that the three marks have been used throughout the UK since as early as 2016 in respect of the following services:

“Services for providing food and drink; food preparation; fast-food restaurants; restaurant, canteen, buffet, food bar, snack bar, salad bar, coffee shop, delicatessen and cafeteria services; grill restaurants; self-service restaurants; take away fast food restaurants; carry-out restaurants; hospitality services [food and drink]; catering services; restaurant services incorporating licensed bar facilities.”

106. Earlier in my decision, I found that the evidence did not show use of the second earlier “GDK” word mark and as such, I do not consider that the opponent will hold any goodwill under this this sign. Whilst the evidence shows some use of the opponent’s third earlier mark under section 5(4)(a), it is my view that the opponent’s strongest case for goodwill and misrepresentation is held in the first mark relied upon under this ground and I will therefore begin by considering the same.

Legislation

107. Section 5(4)(a) of the Act reads as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the

United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa)

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

108. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

General principles of Section 5(4)(a)

109. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but

it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

110. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

Relevant date

111. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O- 410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the Registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

112. As the applicant’s mark does not have a priority date and there is no evidence that the applicant’s mark was used prior to the application date, the relevant date for assessment of the opponent’s claim under section 5(4)(a) of the Act is the date of the application for registration, being 3 December 2020.

Goodwill

113. The first hurdle for the opponent is that they need to show that they had the necessary goodwill in a business at the relevant date.

114. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

115. Earlier in my decision at paragraphs 17 and 18, I considered that the evidence showed use of opponent's first mark including the use of the orange and black colour scheme. Considering the sum of the evidence filed showing the use of this sign including sales figures, advertising expenditure, press articles and advertising campaigns, I am satisfied that the opponent has demonstrated that it had a protectable goodwill in relation to *fast-food restaurants* and *carry-out restaurants* as distinguished by this sign at the relevant date.

Misrepresentation and damage

116. Earlier in my decision under section 5(2)(b), I found that there exists a likelihood of confusion between a near identical mark to that relied on under this ground but presented in grey scale and the contested mark. Whilst the mark relied upon under this ground makes use of the colour orange and therefore potentially offers a more limited protection than the opponent's first earlier mark relied upon under 5(2)(b) which may be used in any colour, in the current circumstances this does not reduce the likelihood of confusion with the contested mark, on the basis that it also makes use of a very similar colour orange.

117. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

118. Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewison L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “*a substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

119. With consideration to the above, I find here that the legal test for misrepresentation in relation to the opponent’s mark relied upon under this ground, will not produce a different outcome to that under section 5(2)(b) in relation to the opponent’s first earlier mark. I therefore find there is a likelihood of misrepresentation.

120. Where there is a misrepresentation, I must consider if damage will follow. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of

damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation."

121. Given that I have found that there is a misrepresentation in respect of all of the applicant's services, I consider that damage through diversion of sales is easily foreseeable. The opposition under section 5(4)(a) is therefore successful in its entirety.

122. As I have found the opponent's claim under Section 5(4)(a) successful in respect of its first unregistered mark, I do not consider it necessary to make any further assessments on the remaining unregistered marks relied upon.

Conclusion

123. The opposition is successful in its entirety based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Act. Subject to any successful appeal against my decision, the application will be refused in the UK.

COSTS

124. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. Using that TPN as a guide, I award the opponent the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official Fee:	£200
Preparing a statement and considering the other side's statement:	£200
Filing evidence:	£800

125. I therefore order Syed Hasan to pay the sum of £1200 to GDK International Limited. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 29th day of June 2022

Catrin Williams
For the Registrar