

O-687-22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3628936

BY RAJA BALAL HUSSAIN

FOR THE TRADE MARK



IN CLASS 29

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 426160

BY YOUNG & CO'S BREWERY PLC

BACKGROUND AND PLEADINGS

1. On 20 April 2021 Raja Balal Hussain (“**the Applicant**”) applied for the following figurative mark as a UK trade mark:



2. On 2 July 2021, the trade mark was published for opposition purposes in the Trade Marks Journal in respect of the following goods:

Class 29: *Burgers; Chicken burgers; Meat burgers; Vegetable burgers; Veggie burger patties.*

3. On 13 August 2021, the application was opposed, in full, by Young & Co’s Brewery PLC (“**the Opponent**”). The opposition is brought under section 5(2)(b) and section 5(4)(a) of the Trade Marks Act 1994 (“**the Act**”). Under section 5(2)(b) the Opponent relies on its registration for the following trade mark:

UK trade mark no. 3114942

Filing date 25/06/2015

Registration date 09/10/2015

Relying on goods and services in classes 29 and 43

4. An “earlier trade mark” is defined in section 6(1) of the Act as:

“(a) a registered trade mark or international trade mark (UK), which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

5. The filing date of the Opponent's registration is prior to the filing date of the contested mark. The Opponent's mark therefore constitutes an earlier mark under the Act.

6. Since the Opponent's mark had been registered for more than five years when the contested mark was applied for, it is subject to the use provisions under section 6A of the Act. The Opponent duly provided statements of use in respect of its mark. The Applicant did not request that the Opponent provide proof that it had used its mark and the Opponent is therefore able to rely on all of the goods and services listed in its Form TM7 notice of opposition, these being:

Class 29: *Processed meat products; meat products being in the form of burgers; burgers; meat burgers; vegetable burgers; prepared meals made from meat [meat predominating]; prepared meals consisting principally of vegetables; potato snacks.*

Class 43: *Public house and catering services; services for providing food and drink; take away services relating to food and drink; restaurant services.*

7. Under section 5(4)(a), the Opponent relies on the following sign:

BURGER SHACK

Used throughout the UK since 2015.
Used in relation to Processed meat products; meat products being in the form of burgers; burgers; meat burgers; vegan burgers; vegetable burgers; prepared meals made from meat [meat predominating]; prepared meals consisting principally of vegetables; potato snacks; Public house and catering services; services for providing food and drink; take away services relating to food and drink; restaurant services.

The Opponent's case

Section 5(2)(b)

8. Under section 5(2)(b) the Opponent submits that:

- (i) the Applicant's mark is visually highly similar to its mark and is phonetically and conceptually identical;
- (ii) the Applicant's goods are identical to the goods under the earlier mark and highly similar to the services;
- (iii) there is a very high likelihood of confusion, including a likelihood of association and the marks and goods and services are so similar that consumers will automatically assume that the Applicant's goods originate from the Opponent, or that there is a licensing arrangement.

Section 5(4)(a)

9. Under section 5(4)(a), the Opponent submits that:

- (i) as a result of the use it has made of its sign, the Opponent has acquired substantial goodwill throughout the UK, in particular in London, Surrey, Bristol, Devon, Exeter, Kent, Somerset;
- (ii) use of the Applicant's highly similar mark would clearly amount to misrepresentation;
- (iii) this misrepresentation would cause damage to the Opponent including loss of sales, loss of prestige and of goodwill in the industry, which could lead to loss of licensing opportunities and loss or reduction of expansion opportunities;
- (iv) the Opponent is therefore entitled to prevent use of the Applicant's mark under UK law.

The Applicant's case

10. In their counterstatement, the Applicant:

- (i) disagrees with the Opponent's claims;
- (ii) submits that their logo and name is unique and is different to the Opponent's;
- (iii) states that they are not trying to copy the Opponent's design or name.

Representation and papers filed

11. Only the Opponent has filed evidence in these proceedings, which comprises the witness statement of Gillian McLaren dated 14 February 2022. Ms McLaren is Director of Marketing at the Opponent company. Through her witness statement, Ms McLaren introduces 16 exhibits, numbered GM1 to GM16 which show how the burger shack brand has been used and has developed since its launch in 2015. Neither of the parties requested a hearing and this decision is therefore taken following careful consideration of the papers before me, which include submissions in lieu of a hearing filed by the Opponent. The Applicant has not filed submissions.

12. The Opponent is represented by Mewburn Ellis LLP; the Applicant has not engaged professional representation in these proceedings.

DECISION

Impact of EU law

13. 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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Section 5(2)(b)

14. Section 5(2)(b) of the Act states:

“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”.

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of the goods and services

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

17. The goods to be compared are:

Opponent's goods	Applicant's goods
<i>burgers;</i> <i>meat burgers;</i> <i>vegetable burgers;</i> <i>Processed meat products;</i> <i>meat products being in the form of burgers;</i> <i>prepared meals made from meat [meat predominating];</i> <i>prepared meals consisting principally of vegetables;</i> <i>potato snacks.</i>	<i>Burgers;</i> <i>Meat burgers;</i> <i>Vegetable burgers;</i> <i>Chicken burgers;</i> <i>Veggie burger patties.</i>

18. *Burgers; meat burgers* and *vegetable burgers* under the Opponent's mark are plainly identical to the corresponding, identically worded goods under the Applicant's mark.

19. The Opponent's *burgers* would encompass different kinds of burger, including the Applicant's *chicken burgers* and *veggie burger patties* and therefore these goods are identical, under the *Merici* principle set out above.

20. In conclusion, I find all of the Applicant's goods to be identical to those under the Opponent's earlier mark. As I have found identity in respect of the goods, it is not necessary for me refer to the Opponent's services in my comparison for reasons which will become apparent.

Average consumer and the purchasing act

21. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select them.

22. In *Hearst Holdings Inc*,¹ Birss J. explained that:

"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 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 word "average" denotes that the person is typical ..."

23. As identity was found in respect of the goods under the Opponent's mark, I confine myself to assessing the average consumer and purchasing act of those identical goods.

24. The goods are all types of burgers, which I consider to be a fairly frequent and relatively low-cost purchase. I find that the consumer will pay an average degree of attention when purchasing the goods. I note that the Opponent submits that no more than a moderate degree of attention is likely to be paid.

25. The goods will in most cases be purchased from a supermarket, where the consumer will make a selection from a range of products in a refrigerator or freezer. I

¹ *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), at paragraph 60.

find therefore that the purchasing process is predominantly visual in nature, but that verbal considerations also play a part in respect of word of mouth recommendations.



Comparison of the marks

26. It is clear from *Sabel BV v. Puma AG*² (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 CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*,³ that:

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

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

28. The Applicant’s and Opponent’s marks are shown below:

Opponent’s mark	Applicant’s mark
	

² Case C-251/95.
³ Case C-591/12P.

29. The overall impression of the Opponent's mark is of the words "BURGER Shack", where "BURGER" is written in capital letters, formed from repeated red lines and "Shack" is written in a cursive-style blue typeface. The descriptive connotations of the Opponent's mark (which I shall return to later) mean that, in my view, the stylisation of the words, in particular of the first word "BURGER" have roughly equal impact in the overall impression, to the words considered alone.

30. The overall impression of the Applicant's mark is of the words "BURGER SHACK" in capital letters, on a grey rectangular background. The size of these words and their positioning in the centre of the mark, mean that they are dominant within the Applicant's mark. To the left of "BURGER SHACK" is a stylised image of a burger. This stylised burger shape appears twice more above the grey rectangle where there are two devices that appear to represent a sign that you would see outside a restaurant or fast food establishment. The first of these devices is merely an outline, with the second having lines and dots in red and yellow which represent the features of a burger, together with the words "BURGER SHACK". In my view, these images in the Applicant's mark hold less weight in the overall impression than the central words "BURGER SHACK". The Applicant's mark also features the phrases "REAL BURGERS" and "REAL TASTE", in relatively small letters, to the right of "BURGER SHACK". Given the descriptive nature of these terms and their overall size within the mark, I consider them to have very low weight in the overall impression of the Applicant's mark.

31. Visually, the marks align in respect of the words "BURGER" and "Shack", although it is noted that the font is different. Visually, the marks differ in respect of the additional figurative elements and words in the Applicant's mark. Overall, taking account of the dominance of the words "BURGER SHACK" in the Applicant's mark, I find the marks to be visually similar to a medium degree.

32. Aurally, the marks align in respect of the words "BURGER" and "Shack". I consider that the words "REAL BURGERS" and "REAL TASTE" in the Applicant's mark are merely straplines that will not be verbalised by the consumer. This being the case, I find the marks to be aurally identical.

33. The concept of both marks is informed by the words “burger shack”, meaning a “very simple and small building made from pieces of wood, metal, or other materials”⁴ from which burgers are provided. The less dominant straplines “REAL BURGERS” and “REAL TASTE” are descriptive in nature and do little to alter the overall identity of the Applicant’s mark. I therefore find the marks to be conceptually highly similar.

Distinctive character of the earlier mark

34. Distinctive character is the capacity of the mark to identify the goods or services for which it is registered as coming from a particular undertaking, and to distinguish those goods or services from those of other undertakings: see *Lloyd Schuhfabrik Meyer*, paragraph 22.

35. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words. The inherent distinctive character may be enhanced through the use that has been made of the mark.

36. In *Lloyd Schuhfabrik Meyer*, the CJEU set out how an assessment of a mark’s distinctive character should be made:

“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).

⁴ See Cambridge Dictionary online.

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).”

37. As stated above, the Opponent’s mark refers to a very simple and small building made of wood, metal, or other materials from which burgers are provided. The words in the mark are written in contrasting stylised typefaces and in different colours. In respect of the Opponent’s services in Class 43, I consider the mark to possess a low degree of distinctive character overall, taking account of the descriptive nature of the words and the stylisation of the typeface. In respect of the Opponent’s goods in Class 29, while the word “BURGER” is entirely descriptive, the addition of “Shack” is somewhat unusual. I find the Opponent’s mark **BURGER** *Shack* to possess a medium degree of distinctive character in respect of the goods under Class 29.

38. Whilst not explicitly claimed by the Opponent, I will also consider whether the distinctive character of its mark has been enhanced through use. The evidence shows that the Opponent has offered restaurant and takeaway services under the mark for around five years, with fairly significant levels of sales, reaching £1.7 million in 2020. Investment has been made in promoting the Opponent’s mark, with up to around £60,000 spent in a single year. In respect of restaurant and takeaway services, I consider that there has been an enhancement of the distinctive character of the Opponent’s mark, resulting in a medium degree of distinctive character for these services. There is no evidence to show that the Opponent has made separate sales for goods and I therefore find no enhancement of distinctive character for the Opponent’s goods.

Likelihood of confusion

39. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all of the factors, weighing them, and looking at their combined effect, in accordance with the authorities set out earlier, in particular at my paragraph 15.

40. There are two types of confusion that I may find. The first type is direct confusion which occurs where the consumer mistakes one mark for another. The second type is indirect confusion, where the consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that the goods or services derive from the same, or a related economic undertaking.

41. 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)".

42. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

43. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

44. In this case, I have found the goods under the marks to be identical. I have found the marks to be aurally identical, conceptually highly similar and visually similar to a medium degree. I have found visual considerations will predominate, but aural considerations will also play a part in the purchase of the goods. I have found the Opponent's mark **BURGER** *Shack* to possess a medium degree of distinctive character in respect of goods, and a low degree of distinctive character for its services, which has been enhanced in respect of restaurant and takeaway services, resulting in a medium degree of distinctive character. I have found that the words and the stylisation in the Opponent's mark have a roughly equal impact and that the words “BURGER Shack” are dominant within the Applicant's mark:



45. The Applicant has argued that there are differences between the marks. I accept that this is the case, however, identity of marks is a requirement under sections 5(1) and 5(2)(a) of the Act, whereas these proceedings are brought under section 5(2)(b), which specifies *similarity* of the marks. The Applicant also argues that they have not sought to copy the Opponent's mark. This does not change my assessment as intention to copy an earlier mark is not a relevant factor under section 5(2)(b).

46. In considering direct confusion first, both marks contain the words "BURGER SHACK", but the words are written in a different typeface and there are additional figurative and verbal features in the Applicant's mark. I consider that the differences that I have identified between the marks mean that the average consumer is unlikely to confuse the marks directly, that is to mistake one mark for the other, even for identical goods. I find that there is no likelihood of direct confusion.

47. I now turn to consider whether there is indirect confusion between the Applicant's and Opponent's marks. I remind myself that indirect confusion is based upon a thought process whereby the average consumer recognises there are differences between the marks, but the common element leads the consumer to consider the later mark to be another brand of the owner of the earlier mark. I have found the words in the mark **BURGER** *shack* to be roughly equal in dominance to the stylisation of the typeface, and that the words "BURGER SHACK" are the dominant feature in the Applicant's mark. Keeping in mind the identical nature of the goods and taking account of my finding that the words "BURGER SHACK" are averagely distinctive in respect of the goods (and there has been no enhancement through use), I consider that the inclusion of the words in both marks will lead to confusion because the other elements in the marks are not sufficient to distinguish commercial origin. I find there is a likelihood of indirect confusion.

Conclusion under section 5(2)(b)

48. The opposition succeeds under section 5(2)(b), in respect of all the goods applied for.

Section 5(4)(a)

49. Section 5(4)(a) states:

“(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.”

50. 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.”

51. 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).”

52. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff 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 feature 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 successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court 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 plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(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 confusion or 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.”

53. The Applicant has not filed any evidence that it has used its mark. This means that the position under section 5(4)(a) must be assessed at the date when the Applicant applied to register its trade mark, that is 20 April 2021.⁵

Goodwill

54. The Opponent relies on the plain word sign “BURGER SHACK” and must show that its business had sufficient goodwill which was distinguished by use of this sign at the relevant date so that it can be concluded that misrepresentation would occur, and

⁵ *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC, sitting as the Appointed Person.

damage would follow. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1902] AC 217 at 223:

“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.”

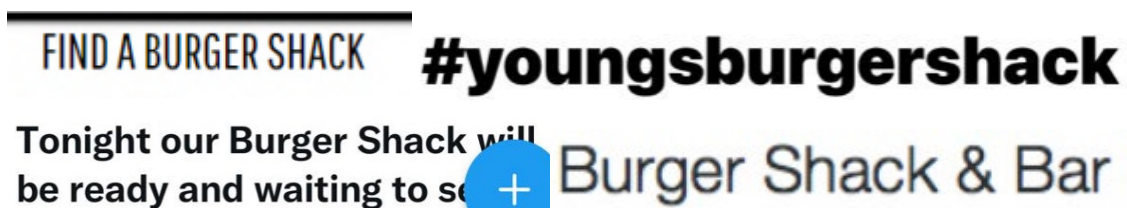
55. The evidence shows that the Opponent had used a form of the sign “BURGER SHACK” over a period of around five years prior to the filing of the Applicant’s mark. Some of the documents and sales/promotional figures are dated after the filing date of the contested mark and so will not assist the Opponent in demonstrating goodwill prior to that date.

56. The Opponent is a long established brewery and owner of pubs, operating under the name “Youngs”. The evidence shows that the Opponent has used different forms of the sign “BURGER SHACK” in respect of restaurant and takeaway services. This appears to have begun with huts being set up in the outside space of their pubs and has now moved on to standalone “BURGER SHACK” restaurants being established and a mobile “BURGER SHACK” caravan bringing their takeaway services to different venues. The evidence does not include the specific dates that the Opponent’s venues were established, however, I accept that there were a range of venues at the relevant date, in and around London and across the south of England.

57. Ms McLaren’s witness statement indicates that sales have increased each year, reaching £1.7 million in 2020, which is the last full year of turnover figures prior to the contested mark being filed. Marketing expenditure varied each year between 2016 and 2020, with figures ranging from £4,500 to £61,000. The evidence includes menus, fliers, social media posts and photographs of venues where the sign appears in various formats, including those shown below. The Opponent’s mark has appeared in a range of specialist publications, on various blog posts, in TimeOut, a few local newspapers and a London-focused magazine.⁶

⁶ Exhibit GM14

58. The exhibits show that services have been provided principally under the **BURGER Shack** sign, but also in a range of other formats, for example:



59. In my decision under section 5(2)(b), I have found the words “BURGER SHACK” to be low in distinctive character and also descriptive, in respect of restaurant and takeaway services, as they describe a location where burgers are provided from. In this respect, I note the comments of Mr Thomas Mitcheson QC in the *RECUP*⁷:

40. Various articles from Packaging News in the period 2015-2017 had been exhibited but again no attempt had been made to assess their impact on the average consumer and these all pre-dated the acquisition of the goodwill in the UK. I appreciate that the Registry is meant to be a less formal jurisdiction than, say, the Chancery Division in terms of evidence, but the evidence submitted in this case by Party A as to activities prior to 28 January 2018 fell well short of what I consider would have been necessary to establish sufficient goodwill to maintain a claim of passing off.

41. This conclusion is fortified by the submissions of Party B relating to the distinctiveness of the sign in issue. Recup obviously alludes to a recycled, reusable or recyclable cup, and Party B adduced evidence that other entities around the world had sought to register it for similar goods around the same time.

⁷ *Sharma v Smart Planet Technologies, Inc* BL O/304/20.

The element of descriptiveness in the sign sought to be used means that it will take longer to carry out sufficient trade with customers to establish sufficient goodwill in that sign so as to make it distinctive of Party A's goods."

60. Accordingly, the distinctiveness of the sign relied upon by the Opponent is a factor. Keeping this in mind, I turn to consider the extent of the goodwill shown by the evidence. In the examples of the Opponent's sign set out above, there is some use of the plain words "BURGER SHACK", however these are few and far between. Also, the examples of the word "BURGER SHACK" appear to be descriptive use, directing consumers to information about their services. I consider that the sign in which the goodwill exists will be the figurative form of the words "BURGER SHACK", which are all variations on the same style of typeface in **BURGER** Shack. This being the case, I find that the plain word sign "BURGER SHACK" has not been shown to be distinctive of the Opponent's business.

61. As the Opponent has not shown protectable goodwill in the plain word sign "BURGER SHACK", the claim under section 5(4)(a) fails and it is not necessary for me to go on to consider misrepresentation and damage. I will comment briefly on misrepresentation in case I am incorrect in my finding on goodwill. Had I found that the Opponent had goodwill in their sign, I do not consider that misrepresentation would have been shown to occur due to the low distinctive character and descriptive nature of the words "BURGER SHACK" in respect of the restaurant and takeaway services. In *Office Cleaning Services Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39, Lord Simonds stated that:

"Where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run unless the first user is allowed unfairly to monopolise the words. The court will accept comparatively small differences as sufficient to avert confusion. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered."

62. Accordingly, I consider that the differences between the sign relied upon by the Opponent and the Applicant's mark would mean that, had I found goodwill, no misrepresentation would occur.

Conclusion under section 5(4)(a)

63. The opposition under section 5(4)(a) fails.

Overall conclusion

64. The opposition is successful, and subject to any successful appeal by the Applicant, the contested mark will be refused for all of the goods applied for.

COSTS

65. The Opponent has been successful in these proceedings and is entitled to a contribution towards the costs of bringing this action, in line with the scale published in the Annex to Tribunal Practice Notice (2/2016). The costs award takes account of the very brief counterstatement filed by the Applicant and that no evidence or submissions were filed by the Applicant during the evidence rounds.

Official fees	£200
Preparing a statement of grounds	£300
Preparing evidence	£1,000
Preparing submissions in lieu of a hearing	£400
TOTAL	£1,900

66. I order Raja Balal Hussain to pay Young & Co's Brewery PLC the sum of £1,900. The sum is to be paid within 21 days of the end of the period allowed for appeal, or if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 17th day of August 2022

Charlotte Champion

For the Registrar