BL O/0064/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO UK00003740038

EATalia/EAT-alia (series)

IN THE NAME OF FABRICE LE ROY

AND IN THE MATTER OF OPPOSITION NO. 433456

BY TICCO FOODS LIMITED

AND IN THE MATTER OF AN APPEAL FROM DECISION NO. O/0494/24

OF CATRIN WILLIAMS DATED 30 MAY 2024

Representation

Appellant: Mr Fabrice Le Roy appeared in person

Respondent: Mr Michael Harrison (of Azrights International Limited)

DECISION

Introduction

1. This is an appeal by Mr Fabrice Le Roy ("Mr Le Roy") against decision BL O/0494/24 of Catrin Williams, sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 30 May 2024.

2. Mr Le Roy applied to register EATalia/EAT-alia (series) on 6 January 2022 under No. UK00003740038 for the following services in classes 42 and 43 (the "Application"):

> Class 42: Design of restaurants; Planning [design] of restaurants; Design services in relation to restaurants.
>
> Class 43: Food preparation; Contract food services; Fast food restaurants; Food preparation services; Takeaway food services; Restaurants; Restaurant services; Tourist restaurants; Self-service restaurants; Restaurants (Selfservice -);Take-out restaurant services; Self-service restaurant services; Fastfood restaurant services; Bar and restaurant

services; take-away restaurant services; Salad bars [restaurant services]; Restaurant and bar services; Takeaway restaurant services; Provision of food and drink in restaurants; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Providing food and drink for guests in restaurants; Restaurant services for the provision of fast food.

3. Ticco Foods Limited ("Ticco") filed an opposition to the Application 12 May 2022 under S. 5 (2) (b) of the Trade Marks Act 1994 ("the Act"), relying on its earlier trade mark registration No. 3482609 Eataliano/ EATALIANO (series) (the "Registration") dated 20 April 2020. The Registration covered:

> Class 30: Pasta-based prepared meals; prepared pizzas; prepared foodstuffs in the form of sauces.
>
> Class 35: Retail services relating to food and drink; online retail services relating to food from Italy; online retail services relating to alcoholic and non-alcoholic drink from Italy.
>
> Class 39: Food and drink delivery services; delivery of prepared and unprepared food; delivery of dry pasta, fresh pasta, cheese, charcuterie, anchovies, tuna, flour, sauces, oils, vinegars, panini, biscuits, snacks, spreads, desserts and sundries, all being from Italy.

4. The Opposition was ultimately directed against the Application's class 43 services only. The basis of the opposition under S. 5 (2) (b) was that the applicant's mark was highly similar to the opponent's and the respective goods and services are similar, giving rise to a likelihood of confusion.

5. Mr Le Roy defended the opposition, denying Ticco's claims in full.

6. Neither party sought a hearing. Mr Le Roy filed evidence. Both sides filed written submissions . The decision of the Hearing Officer was made on the papers.

The Hearing Officer's Decision

7. At [40-41] of the Decision the Hearing Officer set out the correct approach to determining a likelihood of confusion:

> "40. 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 i.e. that 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 (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 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]).

41. 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 the goods and services down to the responsible undertakings being the same or related."

8. In para. [42] of their Decision, the Hearing Officer summarised their findings with regard to the factors they would consider in the determination of the objection to registration under s.5(2)(b):

"42. Earlier in this decision I concluded that:

- The competing goods and services are similar to a medium degree;
- The average consumer will comprise members of the general public who will demonstrate a medium level of attention during the selection process;
- The purchasing process will be predominantly visual in nature, though aural considerations will not be discounted;
- The opponent's earlier mark holds between a low and medium degree of inherent distinctiveness;
- The opponent's mark is visually and aurally similar to both the applicant's marks to a high degree.
- The opponent's mark is conceptually similar to both the applicant's marks to a very high degree.

9. Having done so they then concluded:

"43. The respective marks differ only by way of the addition of the letters "no" at the end of the opponent's mark so I find that the differences between "Eatalia" and Eataliano" may be unnoticed or forgotten by consumers when paying a medium degree of attention,

> consequently, bearing in mind the principle of imperfect recollection, I consider that the parties' marks will be misremembered or inaccurately recalled for one another. Taking all of this into account, whilst bearing in mind the levels of similarity between the respective goods and services, the high degree of similarity between the marks and having regard to the interdependency principle, I find that there exists a likelihood of direct confusion between the marks such that the average consumer will be confused as to the origin of the respective goods and services."

10. The opposition therefore succeeded against the contested Class 43 services. Ticco was awarded costs of £500.

11. Mr Le Roy filed a Notice of Appeal under S. 76 of the Trade Marks Act 1994 ("the Act") on 27 June 2024.

12. Ticco filed a Respondent's Notice on 23 July 2024.

Standard of Review

13. An appeal is by way of review, not re-hearing. The Court of Appeal has recently summarised the test to be applied to appeals of this kind in *Lidl Great Britain Ltd v Tesco Stores Ltd* [2024] EWCA Civ 262, where Arnold LJ stated the position to be as follows at [110]:

> "110. It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable: *Volpi v Volpi* [2022] EWCA Civ 464, [2022] 4 WLR 48 at [2] (v) (Lewison LJ). Equally, it is common ground that, in so far as the appeals challenge multi-factorial evaluations by the judge, this Court is only entitled to intervene if the judge erred in law or principle: compare *Magmatic Ltd v PMS International Group plc* [2016] UKSC 12, [2016] Bus LR 371 at [24] (Lord Neuberger of Abbotsbury) and *Actavis Group PTC EHF v ICOS Corp* [2019] UKSC 15, [2019] Bus LR 1318 at [78]- [81] (Lord Hodge), and see *Re Sprintroom Ltd* [2019] EWCA Civ 932, [2019] BCC 1031 at [72]-[78] (McCombe, Leggatt and Rose LJJ) which was cited with approval by the Supreme Court in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 at [49] (Lord Briggs and Lord Kitchin).

14. The judgment of Joanna Smith J. in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24] is an appropriate summation of the detail of the approach to be followed:

> "24. Although I was referred to numerous cases on the subject …. the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:
>
> i) The appeal is by way of a review, not a rehearing;
>
> ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference;
>
> iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible";
>
> iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question. There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision", with decisions of primary fact at one end of the spectrum and multi- factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.
>
> v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions.
>
> vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible;
>
> vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal". Expert tribunals are charged with applying the law in the

specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts.
viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden". The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted. The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained.
ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account."

15. I also note BL O/0639/24 *LIFE'S* where at [8] and then [11] Mr Geoffrey Hobbs KC stated:

" 8. *(A)…* Decision is not liable to be set aside by this Tribunal on appeal unless it can be regarded as rationally insupportable, whether by reason of an identifiable flaw in the treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account a material factor, which undermines the cogency of the conclusion, or for being contrary to principle or plainly wrong: *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 at paras [46] to [50] per Lord Briggs and Lord Kitchin SCJJ (with whom Lord Hodge, Lord Hamblen and Lord Burrows SCJJ agreed); *Volpi v Volpi* [2022] EWCA Civ. 464 at paras [2], [3] per Lewison LJ (with whom Males and Snowden L.JJ agreed).

……

11. …it is necessary in order to maintain the required distance between the role of decision taker at first instance and the role of decision taker on appeal for this Tribunal to proceed on the basis that the Decision below should stand unless the matters on which the Opponent relies are by force of what they reveal sufficient to establish — to the standard indicated in para. [8] above — that the Decision is vitiated by error."

16. I bear these principles in mind.

The Appeal

17. The grounds of appeal were as follows:

> "Our trade mark is fundamentally different. Ticco Foods Limited is trying to appropriate a brand that is already widely used by many company's (sic) and that has actually been copied from the world leader of our market:
> EATALY.CO.UK
> EATALY.IT
> EATALY.NET"

18. There are, therefore, two strands. First, that the Hearing Officer should have concluded that the Marks were different. Secondly, in effect, (and as I understood it at the Hearing) that the earlier mark was itself derived or appropriated from another brand.

Respondent's Notice

19. Ticco filed a Respondent's notice on 23 July 2024. In essence, this merely denied the grounds of appeal and pleaded that the Decision of the Hearing Officer should be upheld for the reasons that they gave.

Merits

20. At the hearing Mr Le Roy argued of his Application that:

> "It is very distinctive. The three letters -- this I did not really find in the initial decision. E, A, T, the first three letters are in capitals. This is nowhere in our Opponent's mark, registered mark. The confusion between the two marks is absolutely impossible. Our brand is EATalia, which is Italy. Basically it is the name of a country. The brand of our Opponent is Eataliano and Eataliano is a person. So the meanings are fundamentally different. Our brand represents a country, our Opponent's brand represents a person.
>
> Orally it is impossible to mistake the two brands. Our brand has three syllables, our Opponent's brand has four syllables. You cannot be mistaken. It is absolutely impossible. Visually our brand has two less letters and more importantly the three first letters are capital letters.

So we believe the initial decision is wrong because the two brands do not have the same meaning, they do not have the same appearance and they do not sound the same. The public cannot be mistaken. It is absolutely impossible and our brand is fundamentally distinctive because visually again – this has been I think forgotten in the initial decision – the three first letters are capital letters and this is fundamentally different than the registered trade mark of our Opponent."

21. I can see from the Decision and the first-instance submissions of Mr Le Roy that this is no more than a restatement of the arguments that were put to the Hearing Officer.

22. In response, for Ticco, Mr Harrison submitted that the Hearing Officer's Decision was sound and that Mr Le Roy's position was no more than a disagreement with the Hearing Officer's conclusion, mere disagreement not being amenable to appeal.

23. This appeal is a review, not a re-hearing, of the Hearing Officer's decision. The assessment of the similarity – or dissimilarity – of the marks was an evaluative exercise for the Hearing Officer. It cannot be set aside unless it is rationally unsupportable, contrary to principle or is wrong. Re-stating the arguments made below cannot succeed without identifying and demonstrating such an error. Mr Harrison is correct in pointing out that disagreement alone is not enough[1].

24. The Hearing Officer dealt with the similarity of marks at [27-36]. I can see at [27-28] that the Hearing Officer properly instructed themselves on the relevant legal principles. They went on to apply them thus:

"30. The opponent's mark is a series of two word only marks, both of which are made up of solely of the word "Eataliano" (albeit one is presented in capital letters and the other is in title case). For reasons I will go on to explain later in this decision, nothing turns on this difference so I shall refer to these marks in the singular. As there are no other additional elements, the overall impression of the mark resides in the word itself.

31. The applicant's mark is a series of two word only marks consisting of the word "EATalia". The sole difference between the series of two marks is the hyphen separating

[1] *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch), [24 (ii)]

the letters “EAT” and “alia”. In respect of both marks, the overall impression lies solely in the wording.

Visual comparison

32. In their submissions, the applicant has commented upon the use of upper and lower case letters in the mark that create a visual difference. Since the registration of word-only marks provides protection for the words themselves, irrespective of whether they are presented in upper, lower or title case, I do not consider that this discrepancy creates a point of significant difference – the monopoly of a word mark is not limited by any features such as fonts or capitalisation appearing on the register. The marks overlap in their first seven letters and I note that the beginning of marks are generally considered to have more impact. A point of visual difference is created through the additional letters “no” at the end of the opponent’s mark which has no counterpart in the applicant’s marks. Overall, I consider the marks to be visually similar to a high degree. In respect of the applicant’s second mark in its series, I do not consider that the added hyphen creates a significant difference and as such, I also find these marks to be visually similar to a high degree.

Aural comparison

33. Aurally, the opponent’s mark consists of five syllables that will be pronounced EAT-AH-LEE-AH-NO. Turning to the applicant’s marks, they consist of four syllables that will be pronounced EAT-AH-LEE-AH. While the opponent’s mark consists of an additional syllable (that has no counterpart in the applicant’s mark) that sits at the end of the mark, the first four syllables of the opponent’s mark are identical to the four syllables which make up the applicant’s mark. Consequently, the points of aural identity are sufficient to warrant a finding of high aural similarity.

Conceptual comparison

34. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including Ruiz Picasso v OHIM [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

35. The applicant has submitted that their mark represents a country (Italia i.e.Italy), whereas the opponent's mark represents an Italian person or the Italian language (Italiano).

36. I am of the view that consumers will break the respective marks down into verbal elements which suggest a concrete meaning or resemble words which are known to them. As such, consumers will perceive the opponent's mark as a portmanteau of the words "Eat" and "Italiano". Similarly, I find that consumers will perceive the applicant's marks as a portmanteau of the words "Eat" and "Italia". Even if a significant proportion of consumers do recognise the semantic differences between "Italia" and "Italiano" as set out by the applicant, I still find there to be a strong conceptual link as both marks will still convey the concepts of food/eating and Italy. Consequently, I find there to be a very high level of conceptual similarity between the opponent's mark and both the applicant's marks."

25. From this it is clear the Hearing Officer took into account the matters raised by the Applicant in this aspect of the appeal and then made an appropriate evaluation. The Hearing Officer therefore did what they were required to do. As Mr Hobbs said in *LIFE'S*[2], in order to maintain the required distance between the role of decision taker at first instance and decision taker on appeal, it is necessary for this Tribunal to proceed on the basis that the Decision below should stand unless the matters on which the Applicant relies are by force of what they reveal sufficient to establish that the Decision is vitiated by error.

26. That being so, I am satisfied that the Hearing Officer carried out a principled evaluation of the similarity of the parties' marks on the basis of, *inter alia*, Mr Le Roy's submissions below, and that no error has been identified by the Appellant. Mr Le Roy may not agree with that evaluation but mere disagreement with the Hearing Officer's conclusion is not sufficient to warrant appellate intervention, nor can I simply re-hear and determine Mr Le Roy's submissions for myself.

27. I now turn to Mr Le Roy's point regarding the origination/"appropriation" of the Opponent's mark.

28. Before me, Mr Le Roy submitted:

[2] BL O/0639/24, ibid.

"Everybody knows that there is a worldwide leader, the name is Eataly. They started this trend 25 years ago. So you cannot appropriate a brand that actually has been initiated by people in the north of Italy who have invented the slow food movement. That is again misleading the public".

29. In response Mr Harrison submitted that such matters were outside the scope of the opposition and had in any event been dealt with by the Hearing Officer following submissions by Mr Le Roy at first instance.

30. The Hearing Officer dealt with this as a preliminary matter:

"11. The applicant also refers to a company unrelated to these proceedings that uses the name "Eataly" in relation to Italian restaurants and grocery stores. The applicant claims that the opponent has therefore copied their "Eataliano" mark from somebody else.

12. While the applicant's evidence and submissions are noted, they refer to a mark (Eataly) that is not at issue in these proceedings. As a result, I do not consider that this line of argument and evidence supports the applicant and I will say no more about the unrelated "Eataly" mark."

31. The Hearing Officer was entirely correct to approach the matter in this way. The issue in this opposition was limited to a S. 5 (2) (b) analysis of the Application as against the Registration and nothing more. The status and validity of Ticco's mark, and the position of EATALY, were not in issue in these proceedings and were properly discounted.

32. Finally, whilst I do not have to decide it, for the sake of completeness I will deal with an additional, unpleaded point raised by Mr Le Roy at the outset of his submissions. It concerned the existence of other "Eatalia" businesses. Mr Le Roy submitted that:

"Beyond our interest, maybe beyond our Opponent interest, I would like maybe to start with the interest of the general public. There are currently, only in London, about 10 cafe named EATALIA. In the whole country, maybe near to 100. In the world, if you make a quick search, you find several thousand. So we believe the decision is wrong because it is paving the way for hundreds of lawsuits because a company in England has registered

a brand that is close to the name EATALIA and wants to appropriate this brand. On your point, it is not about our interest, it is not maybe about our Opponent's interest. It is really about the general public interest."

33. Mr Le Roy reiterated this in his submissions in Reply:

> "…for the interest of the general public and the IPO itself maybe, granting exclusive use of the brand that is used all around the country and all around the world would look very strange."

34. The first thing to note, as Mr Le Roy conceded, is that this was not raised before the Hearing Officer, nor was the supposed use by third parties supported by any evidence.

35. Secondly, even if there was any basis for considering it in this appeal (which there was not), on the pleaded defence and appeal, the comparison under S. 5 (2) (b) remains as between the Application as filed and the Registration as registered, without regard for external factors. In principle, there are mechanisms by which external factors such as the distinctiveness or the activities of an Opponent can be brought into play (for example, by evidence or by challenging the validity of an earlier mark under S. 47) but these were not engaged in this case. For the avoidance of any doubt, I do not advance any view as to whether such matters would have influenced this case even if they had been properly put in issue. I merely note that Mr Le-Roy's point has no merit on the basis of the case before me.

Disposal

36. In the light of the above, the appeal is dismissed in full. The opposition under section 5(2)(b) of the Act has succeeded. The Application is refused for the following services:

Class 43: Food preparation; Contract food services; Fast food restaurants; Food preparation services; Takeaway food services; Restaurants; Restaurant services; Tourist restaurants; Self-service restaurants; Restaurants (Selfservice -);Take-out restaurant services; Self-service restaurant services; Fastfood restaurant services; Bar and restaurant services; take-away restaurant services; Salad bars [restaurant services]; Restaurant and bar services; Takeaway restaurant services; Provision of food and drink in restaurants; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Providing food and drink for guests in restaurants; Restaurant services for the provision of fast food.

37. The Application may proceed to registration for the services that were not subject to opposition, namely:

    Class 42: Design of restaurants; Planning [design] of restaurants; Design services in relation to restaurants.

Costs

38. The appeal having failed, Ticco is entitled to its costs. Both sides agreed that the normal scale should apply. As the Hearing Officer correctly noted, the applicable scale is Annex A to TPN2/2016.

39. The Hearing Officer awarded Ticco £500. On this appeal, I calculate the additional sum as follows:

Considering the Appeal and preparing the Respondent's Notice	£250
Preparing for and attending Hearing	£800
Total costs of appeal	£1300

40. The total sum of £1800 is to be paid by Mr Le Roy to Ticco within 21 days of the date of this Decision.

Philip Harris
Appointed Person
23 January 2025