

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3534931

IN THE NAME OF KENMARK KITCHENS LIMITED FOR THE TRADE MARK



IN CLASSES 35 AND 43

AND THE OPPOSITION THERETO UNDER NO. 422981

BY CITY STORAGE SYSTEMS LLC

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF CLARE BOUCHER (O/537/23) DATED 9 JUNE 2023.

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DECISION  
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**Introduction**

1. This is an appeal by City Storage Systems LLC ("**Appellant**") from decision O/537/23 of Ms C. Boucher ("**Decision**") concerning the opposition by the Appellant to Kenmark Kitchen Limited's ("**Respondent**") application for the trade mark shown below ("**Application**"), filed on 18 September 2020, in respect of the services listed below<sup>1</sup>.

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<sup>1</sup> The application originally also included services in Class 39 (*Food delivery; Delivery of food; Food delivery services; Delivery of food by restaurants; Delivery of food and drink prepared for consumption*), but these were withdrawn.



#### Class 35

*Franchising (Business advice relating to – takeaways and restaurants); Business advice relating to franchising; Business assistance relating to franchising; Assistance in franchised commercial business management; Franchising (Business advisory services relating to – takeaways and restaurants); Business advisory services relating to franchising; Business advertising services relating to franchising; Management advisory services related to franchising; Business advice relating to restaurant franchising; Administration of the business affairs of franchises; Business management advisory services relating to franchising; Provision of business advice relating to franchising; Advisory services relating to publicity for franchisees; Provision of business information relating to franchising; Business advice and consultancy relating to franchising; Business assistance relating to the establishment of franchises; Advisory services relating to the operation of franchises; Advice in the running of establishments as franchises; Assistance in product commercialization, within the framework of a franchise contract; Business advisory services relating to the establishment and operation of franchises; Providing assistance in the field of business management within the framework of a franchise contract; Services rendered by a franchisor, namely assistance in the running or management of industrial or commercial enterprises; Supply chain management services; Website traffic optimisation; Website traffic optimization; Providing business information in the field of social media; Providing marketing consulting in the field of social media; Advertising and marketing services provided by means of social media; Marketing services in the field of restaurants; Business management assistance in the operation of restaurants; Business advisory services relating to the setting up of restaurants; Business management assistance in the establishment and operation of restaurants; On-line ordering services in the field of restaurant take-out and delivery; Loyalty scheme services; Administrative loyalty card services; Administration of consumer loyalty programs; Administration of loyalty rewards programmes; Administration of loyalty rewards programs; Loyalty, incentive and bonus program services; Sales promotion through customer loyalty programs.*

#### Class 43

*Restaurant information services; Providing restaurant services; Carry-out restaurants; Fast food restaurants; Providing reviews of restaurants and bars; Provision of food and drink in restaurants; Restaurant services for the provision of fast food; Reservation and booking services for restaurants and meals; Making reservations and bookings for restaurants and meals; Services for providing food and drink; temporary accommodation; restaurant services; catering services; contract food services; preparation of food and drink; restaurant services for the provision of fast food; Take-away food services; Take-away fast food services; Providing of food and drink via a mobile truck; Providing food and drink in restaurants and*

*bars; Takeaway services; provision of information, advisory and consultancy services in relation to the aforesaid services.*

2. The Appellant opposed the Application under section 5(2)(b) of the Trade Marks Act 1994, relying upon the following marks:

<b>Number</b>	<b>Mark</b>	<b>Filing and registration date</b>	<b>Services</b>
IR1437079	<b>CLOUDKITCHENS</b>	15/10/2018, 03/05/2019	<p><i>Class 36: Real estate management services; rental of real estate; leasing of real estate.</i></p> <p><i>Class 39: Delivery of food by restaurants; food delivery.</i></p> <p><i>Class 43: Providing temporary kitchen facilities; providing temporary kitchen facilities for coworkers in the nature of co-working facilities equipped with kitchen equipment and appliances; providing temporary kitchen facilities, namely, providing facilities for the use of kitchen equipment and appliances; contract food and beverage services; providing specialized facilities for food preparation; providing social function facilities for special occasions.</i></p>
IR1436742		17/10/2018, 20/06/2019	<p><i>Class 36: Real estate management services; rental of real estate; leasing of real estate.</i></p> <p><i>Class 43: Providing temporary kitchen facilities; providing temporary kitchen facilities for coworkers in the nature of co-working facilities equipped with kitchen equipment and appliances; providing temporary kitchen facilities, namely, providing facilities for the use of kitchen equipment and appliances; contract food and beverage services; providing specialized facilities for food preparation; providing social function facilities for special occasions.</i></p>

3. I shall refer to the above as the “**Earlier Marks**”.
4. Neither party requested a hearing, so a decision was made on the papers. In the Decision, C. Boucher for the Registrar held that the opposition was partly successful.
5. On 10 July 2023 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

## The Hearing Officer's decision

6. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):
  - a. The Earlier Marks are inherently distinctive to an average degree for the Class 39 and 43 services, and to a slightly higher than average level for the Class 36 services;
  - b. The Hearing Officer found some services to be identical, some highly similar, some similar to a medium degree, some similar to a low degree, and the remainder dissimilar;
  - c. The average consumer of the Respondent's services held to be identical or similar to the Appellant's services is a member of the general public at large, exercising an average degree of attention for the food-related services, and a slightly higher than average degree of attention for the temporary accommodation services;
  - d. The selection of services will be made primarily on a visual basis, but aural considerations will also be important, as word-of-mouth recommendations are likely to play a part;
  - e. There is a low degree of visual similarity, a medium degree of aural similarity and a high degree of conceptual similarity between the Application and the Earlier Mark;
  - f. Whereas there is no likelihood of direct confusion, the Hearing Officer found a likelihood of indirect confusion in respect of the services which had any degree of similarity with those in the Early Marks;
  - g. Therefore, the opposition succeeded in respect of the services set out below, with the Application proceeding to registration for all remaining services:

*Class 35: On-line ordering services in the field of restaurant take-out and delivery.*

*Class 43: Providing restaurant services; Carry-out restaurants; Fast food restaurants; Provision of food and drink in restaurants; Restaurant services for the provision of fast food; Services for providing food and drink; temporary accommodation; restaurant services; catering services; contract food services; preparation of food and drink; restaurant services for the provision of fast food; Take-away food services; Take-away fast food services; Providing of food and drink via a mobile truck; Providing food and drink in restaurants and bars; Takeaway services.*

## Grounds of Appeal

7. In the Grounds of Appeal and skeleton argument, the Appellant contends that the Hearing Officer erred in her assessment of similarity of services. Specifically, for all services which the Hearing Officer held to be dissimilar, other than "*Website traffic optimisation; Website traffic optimization; providing marketing consulting in the fields of social media*", the Appellant contended that the Hearing Officer should have made a finding of similarity. Further or alternatively, the Appellant contends that there are multiple occasions where she found a low degree of similarity between the services, but failed to maintain the objection pleaded, despite having found a likelihood of confusion in other instances even where there is a low degree of similarity between the services. Finally, the Appellant contends that on occasion she has not undertaken a comparison of the relevant services at all.
8. The Appellant's Trade Mark Attorneys, Messrs Jennings and Hickey, expanded upon the above at the hearing, and I set out below further details as are necessary to understand my overall conclusions. The Respondent did not participate in the appeal.

## Standard of review

9. The approach to be adopted in an appeal hearing has been laid down a number of times in case law. It was recently summarised in *Axogen v Aviv* [2022] EWHC 95 (Ch) at §24-25:

### “Appellate Function

24. Although I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS O/039/21*), 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 (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);
- 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 (*NINEPLUS O/039/21* at [14]);
- 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" (*Actavis Group* at [81]);
- iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a "spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision" (*TT Education* at [52(ii)]), 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 (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).
- 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 (*Actavis Group* at [80]).

- vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal" (*REEF* at [26], *Actavis Group* at [78]). 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 (*Shanks* at [28] citing the warning given by Baroness Hale in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).
  - 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" (see *REEF* at [29]). 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 (*English* at [17], *Fage* at [115]). 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 (*English* at [19]).
  - 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 (*TT Education* at [52(vi)]).
25. In the context of appeals relating to the likelihood of confusion, an evaluative issue described by Mr Iain Purvis QC sitting as an Appointed Person in *ROCHESTER Trade Mark* BL O/049/17 at [31] as "indeterminate and open to debate", Mr Purvis QC went on to say this at [33]:
- "...the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:
- (i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case
  - (ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person
  - (iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal
  - (iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. Jacob J (as he then was) made this point in the passing off case *Neutrogena v Golden* [1996] RPC 473 at 482:
- 'It was certainly my experience in practice that my own view as to the likelihood of deception was not always reliable. As I grew more experienced I said more and more "it depends on the evidence."'

Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.

34. I shall therefore approach this appeal on the basis that in the absence of a distinct and material error of principle, I ought not to interfere with the decision of the Hearing Officer unless I consider that his view on the issue of likelihood of confusion was clearly wrong in the sense that it was outside the range of views which could have been reasonably taken on the established facts."

10. I shall bear all the above in mind when reviewing the Decision.

#### **A preliminary issue – the identity of the average consumer**

11. Certain of the services in the Application are clearly aimed at the general public, for example *“Providing restaurant services”* and *“Take-away food services”*. Other services are aimed at professionals, for example *“Advisory services relating to the operation of franchises”* and *“Sales promotion through customer loyalty programs”*.

12. As it happens, all the Respondent’s services which the Hearing Officer held to have any degree of similarity to those in the Earlier Mark fall within the former category, and therefore the Hearing Officer rightly considered the question of likelihood of confusion only through the eyes of the general public. Should I decide that the Hearing Officer erred in respect of any of the services she held to be dissimilar, I shall have to consider who the average consumer would be for those services, and consider also their degree of attention in selecting the services.

#### **Discussion**

13. Looking at each of the services under appeal, my analysis is as follows.

##### **(1) Franchising services in Class 35**

14. The services in question are:

*“Franchising (Business advice relating to – takeaways and restaurants); Business advice relating to franchising; Business assistance relating to franchising; Assistance in franchised commercial business management; Franchising (Business advisory services relating to - takeaways and restaurants); Business advisory services relating to franchising; Management advisory services related to franchising; Business advice relating to restaurant franchising; Administration of the business affairs of franchises; Business management advisory services relating to franchising; Provision of business advice relating to franchising; Provision of business information relating to franchising; Business advice and consultancy relating to franchising; Business assistance relating to the establishment of franchises; Advisory services relating to the operation of franchises; Advice in the running of establishments as franchises; Assistance in product commercialization, within the framework of a franchise contract; Business advisory services relating to the establishment and operation of franchises; Providing assistance in the field of business management within the framework of a franchise contract; Services rendered by a franchisor, namely, assistance in the running or management of industrial or commercial enterprises”*.

15. Certain of these services relate specifically to franchising of restaurants and takeaways, with the remainder being open-ended and relating to franchising more generally. The Hearing Officer dealt with the former at §23, where she said:

“I shall deal first with a group of services relating to restaurant franchising: *Franchising (Business advice relating to – takeaways and restaurants)*; *Franchising (Business advisory services relating to - takeaways and restaurants)*; *Business advice relating to restaurant franchising*. I understand these services to involve the provision of advice and other support to franchisees in the establishment, day-to-day running and development of their businesses. I agree with the opponent that there will be some overlap with the customers of its Class 36 services, as franchisees will need premises from which to operate. I understand that the Class 36 services would involve the finding of tenants, the setting up of rental arrangements, dealing with renewals of leases, negotiating changes to rents, and so on. In my view, the purpose and nature of these services are therefore different. They would not share the same trade channels.”

16. As for the similarity with the Appellant’s Class 39 and 43 services, the Hearing Officer rejected any similarity at §§24-25 on similar grounds – although there is some overlap in user, the purpose and nature of the services are different, and the trade channels are not the same.
17. The Appellant has a number of criticisms of the Hearing Officer’s analysis. First, it says that she has “artificially segmented the Opponent’s services and not appreciated the Opponent’s business as a cohesive whole”, and “These specific services offered by the Opponent, are all clearly directed together at a professional / business user in the restaurant / takeaway sector. If you look at the sector targeted by the Applicant’s services, this is the same sector”. The Appellant expanded upon this during the hearing, clarifying that it was not contending that the Hearing Officer should have looked at the Appellant’s business as a matter of evidence, but rather should have considered the package of services registered in the Earlier Marks and drawn inferences as to the reality of the business package offered by the Appellant when assessing similarity. Furthermore, she should have taken into account that the Respondent had withdrawn, in response to the opposition, its application in relation to services for food delivery in Class 39 (as mentioned in footnote 1 above). She should have inferred from that withdrawal that the Respondent recognised that it was operating in the same business sector as the Appellant.
18. I do not agree. The authors of Kerly state at 11-055: “It is the goods or services covered by the specifications of the marks at issue that must be considered when making this assessment, and not the goods or services actually marketed under those marks”, referring to *Present-Service Ullrich GmbH & Co KG v OHIM* (T-66/11) [2013] E.T.M.R. 29. In that case, the General Court said at 45:

“Secondly, the applicant’s claim that it operates in a completely different commercial sector from the intervener is also irrelevant. In order to assess the similarity of the goods or services at issue for the purposes of art.8(1)(b) of Regulation 207/2009, the group of goods or services protected by the marks at issue must be taken into account, and not the goods or services actually marketed under those marks”.
19. It seems to me that the converse is true – the fact that the parties may operate in the same commercial sector is equally irrelevant to assessment of similarity of services. The similarity or otherwise of services is to be assessed solely on the basis of those registered, and it is impermissible to take into account the services actually provided, whether on the basis of evidence of an opponent’s business, or (as contended here) on the basis of inferences drawn from an opponent’s registered marks and/or an applicant’s withdrawn classes. Accordingly, I reject this first criticism.

20. Secondly, the Appellant contends that the Hearing Officer “failed to take into account the fact that the end consumer for both the Opponent’s services and the Applicant’s services outlined above can be one and the same, namely a potential franchisee who is more than likely to be an individual who eats in restaurants or enjoys takeaways and who in any event will have an above average level of interest in the catering sector. Noting that the marks are confusingly similar (which has not been challenged by the Applicant), the said end consumer will naturally assume a connection as to the commercial origin between the respective businesses”. The Appellant made the same submission as regards its Class 39 and 43 services.
21. In my view, this submission impermissibly blurs the distinction between the assessment of similarity of services and the assessment of likelihood of confusion. The Hearing Officer reminded herself at §37 that “Where there is no similarity between the services, there is no likelihood of confusion to be considered: see *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA, paragraph 49”. The Hearing Officer first had to decide whether there was any similarity at all between the services. Only if there was at least some similarity could she have then gone on to assess likelihood of confusion. The fact that confusion may occur is not a relevant factor in deciding whether there is any similarity of services.
22. Thirdly, the Appellant states it is “self-evident that the potential success of any food / restaurant businesses is very much location driven. For example, fast-food restaurants or takeaways need to be in a location where there is heavy ‘footfall’ or, in the case of drive-throughs, in a location easily accessible by road with ample parking space. Conversely, sit-down restaurants need to be located in areas that are both appealing and conveniently accessible to its target consumers, emphasising the importance of matching the business type with the right location”. It contends that factor, together with the Hearing Officer’s finding that there will be some overlap in customers for the Respondent’s Class 35 services and the Appellant’s Class 36 services, means that she should have made a finding of similarity of services.
23. Again, I do not agree. A person wishing to set up a franchised restaurant/takeaway will need to consider many factors, including location, supply of utilities, supply of food ingredients, hiring of staff, delivery of food to customers, printing of menus, creation of a website etc. Simply because the same person would use two different services in furtherance of the same aim is not sufficient to make a finding of similarity – were it otherwise, supply of electricity or printing services (both of which are essential for a restaurant/takeaway) would be similar to the Appellant’s “*leasing of real estate services*”. The Hearing Officer carried out a careful analysis and concluded that the services do not share the same trade channels, are not complementary or in competition, and that the overlap in users is insufficient for her to conclude any level of similarities. She made no error of principle in doing so, and was not wrong.
24. Finally, with regard to the services relating to franchising more generally, the Hearing Officer said at §26:

“Having made the findings of dissimilarity in paragraphs 23-25 above, I do not see any reason why I should find any similarity with respect to these services ...”.
25. The Appellant contends that as “all the Opponent’s services can be offered within the context of a franchise and noting that as per the Opponent’s evidence this is a familiar business model in the restaurant and catering field, this was a clear and obvious error”. Given that the Hearing Officer rejected any similarity in relation to the Class 35 services specifically related to

restaurants/takeaways, the position cannot be any better (from the Appellant's perspective) in relation to more general services.

26. Accordingly, I dismiss the appeal in relation to the Respondent's Franchising services in Class 35.

**(2) Advertising services in Class 35**

27. The services in question are:

*"Business advertising services relating to franchising; Advisory services relating to publicity for franchisees; Providing business information in the field of social media; Advertising and marketing services provided by means of social media; Marketing services in the field of restaurants"*.

28. The Hearing Officer held that there was no similarity, as the services are no more similar to the Appellant's services than those she had considered and rejected specifically in relation to restaurant/takeaway franchising.

29. The Appellant contends "Why wouldn't the catering professional who utilized the Opponent's services to establish a restaurant presume that a business trading under the confusingly similar name was also offering marketing services in a 'one stop shop'?"

30. The raises the same point I discussed at paragraph 21 above – the similarity of services must be considered before the likelihood of confusion can be considered. Given that I have upheld the Hearing Officer's decision in relation to the franchising of restaurants/takeaways services, her decision in relation to advertising services in Class 35 is unimpeachable.

**(3) Loyalty services**

31. The services in question are:

*"Loyalty scheme services; Administrative loyalty card services; Administration of consumer loyalty programs; Administration of loyalty rewards programmes; Administration of loyalty rewards programs; Loyalty, incentive and bonus program services; Sales promotion through customer loyalty programs"*.

32. The Appellant contends "The above are services which are aimed at both the ordinary consumer and the professional. Some 'chains' such as McDonalds are large enough to warrant operating their own loyalty card scheme. Some are so small that they operate their own card / stamp system. However, there are a number of loyalty schemes which operate across a number of different brands. These serve to give their member brands a greater footprint and visibility. Further they also give the professional user greater insight into their customer base. The Opponent submits that this is another piece of the restaurant / takeaway infrastructure such that the ordinary professional consumer would presume that it is part of the Opponent's business".

33. Again, this raises the same point I discussed at paragraph 21 above, and impermissibly blurs the distinction between assessment of similarity of services and likelihood of confusion.

34. The Appellant further contends that "The ordinary consumer who attends restaurants and orders from takeaways would reasonably presume that the loyalty card services offered would be related to the company whose restaurants they attended and / or whose takeaways they ordered". I do not agree that this is the case, and indeed the preceding paragraph of the

Appellant's skeleton argument (cited at paragraph 32 above) recognises that "there are a number of loyalty schemes which operate across a number of different brands". Therefore, it is simply not the case that members of the public would presume that the loyalty card of a restaurant/takeaway must be related to the restaurant/takeaway itself.

35. I accordingly dismiss the appeal in relation to loyalty services.

**(4) Services in Class 43**

36. The services in question are:

*"Restaurant information services; Providing reviews of restaurants and bars; Reservation and booking services for restaurants and meals; Making reservations and bookings for restaurants and meals; provision of information, advisory and consultancy services in relation to Restaurant information services, Providing restaurant services, Carry-out restaurants, Fast food restaurants, Providing reviews of restaurants and bars, Provision of food and drink in restaurants, Restaurant services for the provision of fast food, Reservation and booking services for restaurants and meals, Making reservations and bookings for restaurants and meals, Services for providing food and drink, temporary accommodation, restaurant services, catering services, contract food services, preparation of food and drink, restaurant services for the provision of fast food, Take-away food services, Take-away fast food services, Providing of food and drink via a mobile truck, Providing food and drink in restaurants and bars, Takeaway services".*

37. The Hearing Officer compared "*Reservation and booking services for restaurant and meals; Making reservations and bookings for restaurants and meals*" to the Appellant's "*Contract food and beverages services*" and concluded that they are not similar. The Appellant contends that she should have used its services covered in Class 39, i.e., "*Delivery of food by restaurants; food delivery*" as the comparator, and that her decision to refuse "*On-line ordering services in the field of restaurant take-out and delivery*" whilst allowing registration for "*Reservation and booking services for restaurant and meals; Making reservations and bookings for restaurants and meals*" is illogical. Specifically, the Appellant contends that "*Reservation and booking services*" for a meal in a restaurant is analogous to on-line ordering services for a takeaway.

38. Whereas I understand the Appellant's logic in this regard, it is important to remember that it is the similarity between the Appellant's and Respondent's services that is the key factor, and not the similarity between two different services of the Respondent. The Appellant's "*food delivery*" is clearly similar to on-line ordering for delivery, as the former is complementary to the latter. However, "*food delivery*" is not similar to "*Reservation and booking services for restaurant and meals; Making reservations and bookings for restaurants and meals*", even though the latter may have some similarities to "*on-line ordering services*".

39. With regard to the information services, the Appellant contends that the Hearing Officer was wrong to reject services such as "*restaurant services for the provision of fast food*", on the basis of similarity with the Appellant's "*contract food and beverage services*" in Class 43, but allow "*Provision of information, advisory and consultancy services in relation to restaurant services for the provision of fast food*". It contends that this is at odds with the EUIPO Board of Appeal case R 2132/2022, in which the mark **coop coffee** was opposed by the Swedish owner of **COOP**. The services applied for included "Services for providing food and drink; information, advice and reservation services for the provision of food and drink".

40. The BoA decided that: “The contested information, advice and reservation services for the provision of food and drink are similar [to “*services for providing food and drink*” in the opponent’s earlier mark] as they usually coincide in relevant public and distribution channels. Furthermore, they are complementary”.
41. This decision was handed down on 2 June 2023, and as a post-Brexit decision was not binding on the Hearing Officer. The Hearing Officer was entitled to form her own view, took everything into account she was required to do so, and came to a view that cannot be said to be wrong.
42. Finally, the Appellant contends that as well as comparing the Respondent’s “*information, advisory and consultancy services in relation to Restaurant information services...*” to the Appellant’s “*Contract food and beverage services*” in Class 43, she should also have compared them to “*Providing temporary kitchen facilities; providing temporary kitchen facilities for coworkers in the nature of co-working facilities equipped with kitchen equipment and appliances; providing temporary kitchen facilities, namely, providing facilities for the use of kitchen equipment and appliances; providing specialized facilities for food preparation; contract food and beverage services*”. I do not see that this argument takes the Appellant anywhere, as the latter services are no more similar to “*information, advisory and consultancy services in relation to Restaurant information services...*” than are “*Contract food and beverage services*”.

**(5) Other services**

43. A small number of services rejected by the Hearing Officer were not specifically addressed in the Appellant’s skeleton argument, as follows:

*“Supply chain management services; Business management assistance in the operation of restaurants; Business advisory services relating to the setting up of restaurants; Business management assistance in the establishment and operation of restaurants”.*

44. In my view, the Hearing Officer was right to make a finding of no similarity in respect of each of the above, given her findings at §§23-25 in relation to franchising services for restaurants/takeaways.

**Conclusion**

45. The appeal is dismissed, and the Application may proceed to registration for the following services:

Class 35

*Franchising (Business advice relating to – takeaways and restaurants); Business advice relating to franchising; Business assistance relating to franchising; Assistance in franchised commercial business management; Franchising (Business advisory services relating to - takeaways and restaurants); Business advisory services relating to franchising; Business advertising services relating to franchising; Management advisory services related to franchising; Business advice relating to restaurant franchising; Administration of the business affairs of franchises; Business management advisory services relating to franchising; Provision of business advice relating to franchising; Advisory services relating to publicity for franchisees; Provision of business information relating to franchising; Business advice and consultancy relating to franchising; Business assistance relating to the establishment of franchises; Advisory services relating to the*

*operation of franchises; Advice in the running of establishments as franchises; Assistance in product commercialization, within the framework of a franchise contract; Business advisory services relating to the establishment and operation of franchises; Providing assistance in the field of business management within the framework of a franchise contract; Services rendered by a franchisor, namely, assistance in the running or management of industrial or commercial enterprises; Supply chain management services; Website traffic optimisation; Website traffic optimization; Providing business information in the field of social media; Providing marketing consulting in the field of social media; Advertising and marketing services provided by means of social media; Marketing services in the field of restaurants; Business management assistance in the operation of restaurants; Business advisory services relating to the setting up of restaurants; Business management assistance in the establishment and operation of restaurants; Loyalty scheme services; Administrative loyalty card services; Administration of consumer loyalty programs; Administration of loyalty rewards programmes; Administration of loyalty rewards programs; Loyalty, incentive and bonus program services; Sales promotion through customer loyalty programs.*

#### Class 43

*Restaurant information services; Providing reviews of restaurants and bars; Reservation and booking services for restaurants and meals; Making reservations and bookings for restaurants and meals; provision of information, advisory and consultancy services in relation to Restaurant information services, Providing restaurant services, Carry-out restaurants, Fast food restaurants, Providing reviews of restaurants and bars, Provision of food and drink in restaurants, Restaurant services for the provision of fast food, Reservation and booking services for restaurants and meals, Making reservations and bookings for restaurants and meals, Services for providing food and drink, temporary accommodation, restaurant services, catering services, contract food services, preparation of food and drink, restaurant services for the provision of fast food, Take-away food services, Take-away fast food services, Providing of food and drink via a mobile truck, Providing food and drink in restaurants and bars, Takeaway services.*

#### **Costs**

46. Clearly, the Respondent has been the successful party in this appeal. However, given that it played no part in the appeal, it has incurred no costs and I therefore make no order for costs in this appeal.
47. The £100 costs award to the Respondent by the Hearing Officer still stands, and is payable by the Appellant within 14 days of this decision.

**Dr. Brian Whitehead**

**29 January 2024**

#### **Representation**

Mr Steven Jennings and Mr Mark Hickey of Lane Intellectual Property for the Opponent / Appellant

The Applicant / Respondent did not participate in the appeal