

O/0485/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003948912

BY THE SUSHI CO LTD

IN CLASSES 30 AND 43

AND OPPOSITION THERETO UNDER NO. 444883

BY BENTO LONDON LIMITED

AND IN THE MATTER OF REGISTRATION NO. UK00002656352

IN THE NAME OF BENTO LONDON LIMITED

IN CLASS 43

AND AN APPLICATION FOR REVOCATION ON GROUNDS OF NON-USE

UNDER NO. 509173 BY THE SUSHI CO LTD

AND IN THE MATTER OF REGISTRATION NO. UK00003847555

IN THE NAME OF BENTO LONDON LIMITED

IN CLASSES 29, 30, 35 AND 43

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 509169 BY THE SUSHI CO LTD

BACKGROUND AND PLEADINGS

1. On 23 August 2023, The Sushi Co Ltd (“TSC”) applied to register the following trade mark in the UK, given application no. 3948912 (“the 912 Mark”):



2. The application for the 912 Mark was published for opposition purposes on 22 September 2023, and protection is sought for the following goods and services:

Class 30 Sushi; Snack food (Rice-based -); Rice-based snack food.

Class 43 Sushi restaurant services; Carry-out restaurants.

3. On 22 December 2023, the application for the 912 Mark was opposed by Bento London Limited (“Bento”) based upon sections 5(2)(b) and 3(6) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b) of the Act, Bento relies upon the following trade marks:



UKTM no. 3847555

Filing date: 9 November 2022

Registration date: 24 March 2023

(“the 555 Mark”)



UKTM no. 2656352

Filing date: 13 March 2013

Registration date: 5 July 2013

("the 352 Mark")



UKTM no. 3847562

Filing date: 9 November 2022

Registration date: 24 February 2023

("the 562 Mark")

4. Bento relies upon all goods and services for which the 555, 352 and 562 Marks are registered, as set out in the Annex to this decision. Bento claims that the marks are similar, and the goods and services are similar, with the result that there is a likelihood of confusion.

5. Under section 3(6) of the Act, Bento claims that TSC knew or ought to have known about Bento's use of the 352, 555 and 562 Marks and that the intention of TSC was to cause detriment to Bento's interests, causing loss of sales and to ride on their established goodwill and reputation. As such, Bento claims that TSC's conduct in applying for the 912 Mark was dishonest. Bento also claims that TSC had previously applied for the same mark which was subject to undefended invalidation proceedings, meaning that the re-filing amounts to an abuse of process. Consequently, Bento claims that TSC has acted in bad faith.

6. TSC filed a counterstatement denying the grounds of opposition and putting Bento to proof of use of the 352 Mark.

7. On 14 July 2025, TSC applied for a declaration of revocation on grounds of non-use in respect of the 352 Mark pursuant to section 46(1)(a) and (b) of the Act. Under section 46(1)(a) of the Act, TSC claims non-use in the 5-year period following the date of registration of the 352 Mark, namely 6 July 2013 to 5 July 2018 (with an effective date of revocation of 6 July 2018). Under section 46(1)(b) of the Act, TSC claims non-use in the 5-year period: 14 July 2020 to 13 July 2025 (with an effective date of revocation of 14 July 2025).

8. Bento filed a counterstatement denying the claims made.

9. On the same date, TSC applied for a declaration of invalidity in respect of the 555 Mark pursuant to sections 5(4)(a) and 47 of the Act. TSC relies upon the following signs which it claims to have used in London and online since January and May 2022, respectively:



10. TSC claims to have used the signs in relation to “sushi restaurant services and associated goods and services, being the provision of food and drink by dine-in, collection and delivery services across the London region”. TSC claims that use of the 555 Mark would be contrary to the law of passing off.

11. Bento filed a counterstatement denying the claims made.

12. On 22 October 2025, the proceedings were consolidated pursuant to Rule 62(1)(g) of the Trade Marks Rules 2008.

HEARING AND REPRESENTATION

13. A hearing took place before me on 11 February 2026, by video conference. Bento was represented by Mr Ian Bishop of RightPro IP and Legal Consultancy Ltd and TSC was represented by Mr Daniel Byrne of Venner Shipley LLP. Both parties filed skeleton arguments in advance of the hearing.

EVIDENCE AND SUBMISSIONS

14. Bento filed evidence in chief in the form of:

- a. The first witness statement of Rasim Baran Dumanoglu dated 15 May 2024, which is accompanied by 5 exhibits (RDB1 to RDB5). Mr Dumanoglu is the director of Bento.
- b. A Statement of Use given by Mr Dumanoglu dated 17 May 2024, which is accompanied by 10 exhibits (Exhibits RBD1 to RBD10).

15. TSC filed evidence in the form of:

- a. The witness statement of Varanand Reddy Sama dated 22 July 2024. Ms Sama is the Director of TSC.
- b. The witness statement of Camilla Sexton dated 22 July 2024, which is accompanied by 1 exhibit (Exhibit CS1). Ms Sexton is a Chartered Trade Mark Attorney who works at TSC's representative firm.

16. Bento filed evidence (purporting to be) in reply in the form of the witness statement of Hatice Ahu Guneyli Havelock dated 23 September 2024, which is accompanied by two exhibits (Exhibits 1 and 2). Ms Havelock is a representative of Bento in these proceedings.

17. As a result of an application filed on 15 October 2024, TSC were permitted to file further evidence in reply to the witness statement of Ms Guneyli Havelock, which set out matters regarding the bad faith claim for the first time. That further evidence took the form of the first witness statement of Raheel Choudhary dated 18 February 2025, which is accompanied by two exhibits (RC1 and RC2). Mr Choudhary is one of the owners of TSC.

18. Following the consolidation of all three cases, a further evidence timetable was set. As a result of that, TSC filed evidence in the form of:

- a. The second witness statement of Mr Choudhary dated 1 December 2025, which is accompanied by eight exhibits (Exhibits 1 to 8).
- b. The second witness statement of Ms Sexton dated 1 December 2025, which is accompanied by one exhibit (Exhibit CS2).

19. Bento filed evidence and submissions in the form of the witness statement of Alp Erenel dated 25 November 2025. Mr Erenel has been in franchising discussions with Bento. This was accompanied by written submissions dated 24 March 2025.

20. Bento filed evidence in reply in the form of the second witness statement of Mr Dumanoglu dated 19 January 2026, which is accompanied by three exhibits (Exhibits 1 to 3).

RELEVANCE OF EU LAW

21. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

Revocation: the 352 Mark

22. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that

paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

23. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

24. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable

number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation

has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

25. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

Preliminary Point

26. The 352 Mark was assigned to Bento on 3 March 2019. There have been arguments raised by TSC about whether Bento was using the 352 Mark under a valid licence prior to that date. There is also concern raised by TSC about whether the evidence of use shown actually relates to the 352 Mark or whether it relates to another brand (BUNCO). For reasons that will become clear, nothing will turn on this and so I will not address it any further.

Evidence and Assessment

Genuine Use

27. There is reference in Bento’s evidence to the fact that restaurants have been operating under the SUSHICO brand since 1997 in Turkey. For the avoidance of doubt, I must assess the use that has been made of the 352 Mark in the UK during the relevant periods. As such, use in Turkey is irrelevant.

28. In terms of use in the UK, Mr Dumanoglu states that he has been intending to open a branch in London for quite some time, and incorporated Bento in 2017 with that intention. In 2019, Mr Dumanoglu states that he conducted “field research” and decided to start by opening a delivery only kitchen in Shoreditch, London. A number

of invoices have been provided which are said to relate to this field research and project proposals, but it is not clear to me specifically what these invoices are for.¹ Photographs of sushi and a delivery bag, with a Deliveroo receipt attached, have been provided; most of these are undated, although one is dated 14 March 2020.² They all display the 352 Mark. Mr Dumanoglu states that between 15 December 2019 and 15 March 2020, Bento generated £20,885 worth of turnover from these activities. A number of Deliveroo commission statements, VAT invoices and invoices for supplies and catering equipment have been provided.³ In March 2020, Bento had to cease its delivery services due to the pandemic.

29. It seems to me that there is evidence of a food preparation and delivery operation taking place, at least between December 2019 and March 2020.⁴ Plainly, that use is after the end of the relevant period which runs from 6 July 2013 to 5 July 2018. That is not fatal to Bento's case because the provisions of section 46(3) mean that use after the end of the relevant period, but before the commencement of the revocation proceedings can prevent revocation of the mark. However, the use shown is only over a four-month period. Even accounting for a turnover in excess of £20,000 during that time, that is a relatively small amount given the size of the market in issue. It is unclear to what extent there has been promotional activities. Taking all of the evidence into account, I am not convinced that the evidence of use is sufficient to establish genuine use even in relation to food preparation and delivery services.

30. Even if it could be said that the evidence filed is sufficient to establish genuine use during the relevant period 14 July 2020 to 13 July 2025, I would be required to assess what a fair specification would be for the use shown. Mr Bishop raised issue with TSC's comments regarding its activities as a "dark kitchen" and whether this amounted to a restaurant service or not. However, it seems to me that that is simply part of the legal assessment that I must make in considering a fair specification and one that it was entirely proper and appropriate for TSC to address. In my view, the use shown can

¹ Exhibit 1

² Exhibit 2

³ Exhibits 3, 4 and 5

⁴ See for example, exhibit 8

only be in relation to a food preparation and delivery service.⁵ However, the 352 Mark is registered for “Chinese·japanese·thai restaurant” only. In my view, the service of offering a restaurant relates to a place where customers can sit and eat a meal that is prepared for them. This is supported by the dictionary definitions that I have reviewed which, to my mind accord with the meaning that would be attributed to the word by the average consumer:

“A restaurant is a place where you can eat a meal and pay for it. In restaurants your food is usually served to you at your table by a waiter.”

Collins Dictionary

“An eating establishment at which meals are cooked and served to customers on the premises; a public eating house.”

Oxford English Dictionary

“A place where meals are prepared and served to customers.”

Cambridge Dictionary

31. Consequently, the use shown does not fall within the specification of the 352 Mark.

Proper Reasons for Non-Use

32. That is not the end of the matter, because in its Form TM8N, Bento states that up until 2018 there was a dispute between Bento and the previous owner of the mark. This was resolved in 2018 which enabled the opening of the delivery operation discussed above. However, Bento goes on to state:

“Commercial use started in 2019 and continued until it was interrupted by the global COVID-19 pandemic during the period relevant to Section 46(1)(b). In 2022, the mark was duly assigned to the Proprietor and before the commercial use of the mark was recommenced, the Proprietor became aware of the

⁵ I note that Mr Erenel entered into discussions with Bento in June 2023 regarding the possibility of franchising, but this evidence is far from sufficient to show preparations for use; other than contact being made. This is because it is not specified what preparatory activities (if any) took place during the relevant period.

Applicant, following reports of customer confusion. Since then, legal proceedings have been ongoing. Despite their genuine intention to resume the use, through entering into commercial agreements for the launch of a franchised restaurant and/or actively seeking suitable premises, the uncertainty caused by the prolonged dispute – exacerbated by the Applicant’s actions – has necessitated a temporary pause in use until the matter is resolved, as an action of prudent businessperson.”

33. This appears to be an attempt to raise a pleading of proper reasons for non-use, although it is not expressly stated as such. These arguments can, of course, only apply to the later of the two relevant periods (which runs from 14 July 2020 to 13 July 2025). I am, of course, aware that the Covid-19 pandemic was damaging for the restaurant industry (although perhaps less so for food delivery businesses than restaurants). However, the affected relevant period runs up until 13 July 2025, meaning a number of years of that period were clearly unaffected by the pandemic. Bento suggests that the failure to resume use during the latter part of that period was because of the ongoing dispute with TSC. It is stated in the Form TM8N that waiting for the conclusion of these proceedings before commencing use was the act of a prudent businessperson. Whilst that might be Bento’s position, that was, ultimately, a business decision it has made; a choice. The law is clear that proper reasons for non-use must relate to matters independent of the will of the proprietor of that mark.⁶ That is not the case here.

34. I am fortified in this finding by the fact that the General Court (“GC”) has previously made a similar finding.⁷ In any event, the first of these consolidated proceedings (being the opposition) was not commenced until 2023, and so it is not clear why use was not recommenced prior to that time. There is some reference in the evidence to a failure to secure the desired business premises, but that is merely business difficulties and does not amount to proper reasons for non-use. Taking all of this into account, I do not find the proprietor’s arguments regarding proper reasons for non-use compelling and the revocation action is successful in its entirety.

⁶ *Armin Häupl v Lidl Stiftung & Co. KG*, Case C-246/05

⁷ *Naazneed Investments Ltd/OHIM*, Case T-250/13

35. The effect of this decision is that the 352 Mark is revoked with effect from 6 July 2018.

Invalidation: the 555 Mark

36. Section 5(4)(a) of the Act states as follows:

“5(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.”

37. Section 5(4)(a) has application in invalidation proceedings by virtue of section 47 of the Act, the relevant parts of which state as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

38. 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).”

Relevant date

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

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

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

40. Where use of the contested mark commenced prior to the filing or priority date of that mark, the reason for re-assessing the applicant for invalidity's passing off right at the later date was explained by Mr Thomas Mitcheson QC as the Appointed Person in *Casablanca TM*, as follows:⁸

"Clearly if the activity ceased or changed materially between the date of commencement and the date of application for the trade mark then this must be taken into account, as it may mean that the true date of commencement of the activity complained of is later or that the activity complained of cannot properly be said to have properly commenced at all (if it was later abandoned)."

⁸ BL O/349/16 at paragraph 38

41. There is evidence of use on Bento's part in this case which pre-dates the filing date for the 555 Mark. If I were to consider that use "the commencement of the activity complained of", TSC would need to prove goodwill at both that date and the prima facie relevant date in order to bring a successful passing off claim. Given TSC's acceptance that it did not start using the sign relied upon until January 2022 and the potential benefit to Bento of relying on antecedent use, it is surprising to me that Mr Bishop expressly objected to Mr Byrne raising that point in his submissions. Mr Bishop expressly confirmed his wish that I do not consider any earlier use in reaching my decision.⁹ Consequently, with that request in mind, I will proceed to consider the position only in respect of the prima facie relevant date (being 9 November 2022).

Goodwill

42. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) goodwill was described as follows:

"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."

43. Mr Choudhary gives evidence that by 9 November 2022, TSC had 8 restaurants operating throughout the London area. An example of the branding used on those restaurants is as follows:

⁹ See page 19 of the transcript.



An article from January 2022 demonstrates that this is how the branding appears at that time.¹⁰

44. There is evidence that between January and November 2022, these restaurants generated approximately £1.6million in turnover. Mr Choudhary estimates that this equates to approximately just less than 60,000 customer transactions during that time. Given that these figures include the whole of November, and the relevant date was in early November, I recognise that a large proportion of the figures for that month will be after the relevant date.

45. There are examples of promotional activities in evidence, such as an interview article for *Wharf Life*, which has a circulation of 15,000.¹¹ For the period January to November 2022, TSC spent over £255,000 on promotional activities.

46. Clearly, trade had not been particularly longstanding at the relevant date and was limited to the London area. That being said, the use had been consistent over the 10/11 months prior to the relevant date and had generated a reasonable turnover. There had clearly been a reasonable investment in advertising. I bear in mind that even small businesses can generate a protectable goodwill.¹² Taking all of this into

¹⁰ Exhibit RC2

¹¹ Exhibit RC5

¹² *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

account, I am satisfied that TSC had a modest, but protectable, goodwill at the relevant date in relation to sushi restaurants.

Misrepresentation and damage

47. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

48. In *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590, Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

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

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

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

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

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

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

50. I have found TSC to benefit from a modest, but protectable, goodwill at the relevant date in relation to sushi restaurants. The signs relied upon were distinctive of that goodwill. The parties’ fields of activity are either identical or highly similar (in relation to the class 43 services in the specification of the 555 Mark) or connected (in relation to the remaining goods and services). This is because the goods in the specification of the 555 Mark could be sold through TSC’s restaurant services and there is an element of competition with regard to the class 35 retail services in the specification of the 555 Mark or there may be an overlap in trade channels in some circumstances.

51. Plainly, the marks both include the words SUSHI CO. The word SUSHI is plainly not distinctive for services concerned with sushi restaurants or the goods that they sell. Similarly, the word CO is a recognisable abbreviation for “company”. indicating the type of entity and, therefore, also non-distinctive. I note that Mr Bishop disputed this, referring to other marks with “CO” at the end for which it would not be understood

to mean company (Tesco and Texaco). However, the difference between those marks and the words in the present case is that they are both invented words, whereas the word CO in the present case follows a recognisable descriptive word. In my view, it will plainly be understood as a reference to a company which sells sushi or offers related services. The mark/signs also overlap in the use of the colours black, red and white. However, they are used in different ways. The common use of, at least, the colours red and white is, perhaps, not surprising given that the Japanese flag is red and white.¹³ In the 555 Mark, the word SUSHI is presented in a black, cartoon-like font, and the word CO is presented in white on a red circular background. In the sign relied upon the word SUSHI is presented in white beneath the word THE (which is also in white, but in a smaller font). The letter C in the word CO is presented in the same font and size as the word SUSHI, but the letter O is depicted much smaller and appearing beneath two chopsticks (perhaps intended to appear as a sushi roll). The centre of the O is red. All of this is presented on a black background (either rectangular or circular). In my view, given that the common elements are non-distinctive, the differing presentation of each of the mark/signs takes on a more significant role.

52. Although filed in relation to the opposition, given its potential relevance here, I have borne in mind the evidence of Mr Dumanoglu that they have encountered instances of customers believing that TSC's restaurants are those of Bento.¹⁴ The evidence provided concerns translations of messages from a handful of individuals asking about TSC's restaurants. It is not clear what relationship these individuals have with Bento. There is also some reference to an awareness on the part of at least one of these individuals to business activities in Turkey, which is not something that the relevant public in the UK would be aware of. Further, I note that one of the examples provided is from an employee of TSC who is not reflective of the views of the relevant public due to his status as an employee. In any event, to seemingly attempt to contact your employer's HR team through an external website link (as opposed to using internal contact details) is not reflective of the way in which the relevant public seeking the relevant goods and services would encounter the signs/mark. In my view, this evidence is simply not detailed or sufficiently clear to evidence misrepresentation.

¹³ Exhibit CS1

¹⁴ Exhibits 9 and 10

53. In any event, I am reminded of the words of Lord Simonds in *Office Cleaning Supplies Limited v Westminster Window & General Cleaners Limited* [1946] 63 RPC 39 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.”

54. Taking all of this into account, I do not find that a substantial number of the relevant public would be deceived into believing that use of the 555 Mark was use by, or connected with, TSC. Consequently, the 5(4)(a) claim fails.

Opposition: the 912 Mark

Section 5(2)(b)

55. Section 5(2)(b) of the Act reads as follows:

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

(a)...

(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.”

56. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

57. As I have revoked the 352 Mark with effect from 6 July 2018, it was not a valid earlier mark at the relevant date for the opposition (being the filing date of the 912 Mark i.e. 23 August 2023). As the invalidation action against the 555 Mark was unsuccessful it remains a valid earlier right for the purposes of the opposition. Both the 555 Mark and the 562 Mark qualify as earlier trade marks pursuant to section 6 of the Act. Consequently, Bento’s opposition will proceed on the basis of those marks only.

58. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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; and

(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 goods and services

58. The competing goods and services can be found in paragraph 2 and the Annex to this decision.

60. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC 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 for 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.”

Class 30

Sushi.

61. This term appears identically in the specification of the 555 and 562 Marks.

Snack food (Rice-based -); Rice-based snack food.

62. The specifications of the 555 and 562 Marks include the term “prepared and cooked meals and snacks”. I consider these terms to be identical on the principle outlined in *Merici*.

Class 43

Sushi restaurant services.

63. This term appears identically in the specifications of the 555 and 562 Marks.

Carry-out restaurants.

64. To my mind, this term refers to restaurants which also have an option for customers to collect (and carry out) food to eat at home. These services are identical on the

principle outlined in *Meric* to the terms “restaurants” and “takeaway services” in the specifications of the 555 and 562 Marks.

The average consumer and the nature of the purchasing act

65. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

66. In *Iconix Luxembourg Holdings*, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
- (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
- (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

67. The average consumer for the goods and services is a member of the general public. The goods and services are likely to vary in frequency of purchase and cost. However, factors such as ingredients, dietary requirements and quality are likely to be considered when purchasing the goods and factors such as location, food hygiene standards and customer service are likely to be considered when purchasing the services. Consequently, I consider that a medium degree of attention will be paid during the purchasing process.

68. The goods are likely to be self-selected from the shelves of a retail outlet or online equivalents and the services are likely to be purchased following perusal of signage on physical premises or websites. Consequently, I find that visual considerations will dominate the purchasing process. However, I do not discount an aural component to the purchase given that word-of-mouth recommendations may play a part.

Comparison of trade marks




69. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impression created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means

of, inter alia, an analysis of the components of a sign and of their 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.”

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

71. The respective trade marks are shown below:

Bento’s trade marks (the opponent)	TSC’s trade mark (the applicant)
 <p>(the 555 Mark)</p>  <p>(the 562 Mark)</p>	 <p>(the 912 Mark)</p>

Overall Impression

72. The 555 Mark consists of the words SUSHI CO. The word SUSHI is presented in a black cartoon-like font, and the word CO is presented in the same font (but in white) on a red circular background. The words themselves are non-distinctive, and so the font/stylisation and device play the greater role in the overall impression.

73. The 562 Mark consists of the word CO presented in a white cartoon-like font on a red circular background. The word CO, used in isolation, may be viewed as an

abbreviation for the word COMPANY or may be viewed as an acronym (which will not be particularly distinctive, given the limited number of two letter combinations available in the English language). Consequently, I find that the stylisation/device play at least an equal role in the overall impression.

74. The 912 Mark consists of the words THE SUSHI CO presented in a white font, with the word THE appearing above the word SUSHI, in a smaller font. The word CO consists of a letter C and a much smaller letter O, which appears to be depicting a sushi roll within a set of chopsticks. The words are all presented in white, with the centre of the O in red. All of these elements are presented on a black circular background. Again, the words THE SUSHI CO are non-distinctive, and so the font/stylisation and device elements all play a greater role in the overall impression.

Visual Comparison

The 912 Mark and the 555 Mark

75. The marks overlap in the presence of the words SUSHI CO and the use of the colours red, white and black (albeit applied in different ways). They both also contain circle devices, although these are different colours and appear as a background of only the letters CO in the 555 Mark and as a background for all elements in the 912 Mark. They differ in the particular ways that these elements are presented, the fonts and the chopstick device in the 912 Mark (which I note are allusive). Taking all of this into account, I find the marks to be visually similar to between a low and medium degree.

The 912 Mark and the 562 Mark

76. The marks overlap in the presence of the word CO and the use of circle devices and the colours white and red. However, they differ in the presence/absence of the words THE SUSHI, the chopstick device and the use of the colour black. Any visual similarity between the marks is at a very low degree.

Aural Comparison

The 912 Mark and the 555 Mark

77. The only elements of the marks that will be articulated are the words SUSHI CO in the 555 Mark and THE SUSHI CO in the 912 Mark. In my view, they are aurally highly similar.

The 912 Mark and the 562 Mark

78. The marks overlap in the articulation of the word CO, which will be identical in both. However, the words THE SUSHI in the 912 Mark have no counterpart in the 562 Mark. I find the marks to be aurally similar to a low degree.

Conceptual Comparison

The 912 Mark and the 555 Mark

79. Both marks convey the concept of a company that provides sushi or sushi-related services. The device used in the 912 Mark reinforces this message. Consequently, the marks are conceptually identical, albeit the common message is not a distinctive one.

The 912 Mark and the 562 Mark

80. The 562 Mark will either be viewed as an abbreviation for the word COMPANY or, because it is used in isolation, may be viewed as an acronym with no meaning. In the former circumstances, there will be some conceptual overlap with the 912 Mark, arising out of a common reference to a particular type of entity (albeit this is not a distinctive overlap). However, as this is qualified as being a company which provides sushi (or related services) within the 912 Mark, this only results in a low degree of conceptual similarity overall. If the 562 Mark is viewed as an acronym with no conceptual meaning, then they are conceptually dissimilar.

Distinctive character of the earlier trade marks

81. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

82. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

83. The 555 Mark consists of the words SUSHI CO, presented in a cartoon-type font. The word SUSHI is presented in black, and the word CO is presented in white on a red circular background. The words SUSHI CO are non-distinctive for the relevant

goods and services. Consequently, the distinctiveness of the mark lies in the particular presentation of those elements. In my view, the 555 mark is inherently distinctive to a low degree overall.

84. The 562 Mark consists of the word CO, presented in a white cartoon-type font on a red circular background. If this word is recognised as an abbreviation for the word COMPANY then it is non-distinctive. The 562 Mark will be inherently distinctive to a low degree overall. If it is viewed as an acronym, it will still not be particularly distinctive but will be distinctive to between a low and medium degree overall.

85. The relevant market for assessing enhanced distinctiveness is the UK market. I have discussed Bento's evidence of use above. The high point is a period of trade between December 2019 and March 2020. Clearly, this use is not particularly long-standing, there was a period of over 2 and a half years of inactivity between that trade and the relevant date. There is no evidence of market share (nor is it likely to be significant given the limited use) and the geographical spread of the use was limited to one dark kitchen serving the London area. Taking all of this into account, Bento's evidence falls well short of establishing any enhanced distinctiveness.

Likelihood of confusion

86. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between them and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

87. I have found as follows:

- a. The goods and services are identical.
- b. The average consumer for the goods and services is a member of the general public, who will pay a medium degree of attention during the purchasing process.
- c. The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase.
- d. The 912 Mark and the 555 Mark are visually similar to between a low and medium degree, aurally highly similar and conceptually identical.
- e. The 912 Mark and the 562 Mark are visually similar to a very low degree, aurally similar to a low degree and conceptually similar to either a low degree or dissimilar, depending on the perception of the average consumer.
- f. The 555 Mark is distinctive to a low degree and the 562 Mark is either distinctive to a low degree or to between a low and medium degree, depending on the perception of the average consumer.

88. For the avoidance of doubt, for the same reasons given above, I do not find the evidence filed regarding alleged evidence of confusion to be compelling.

89. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person stated that:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

90. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

91. In *Face2FaceHR Partners Limited v Peninsula Business Services Limited*, O/0368/23, Emma Himsworth K.C., as the Appointed Person, reviewed the case law in *Whyte and Mackay v Origin* [2015] EWHC 1271 (Ch) and *Nicoventures Holdings Limited v The London Vape Co Ltd* [2017] EHC 3303 (Ch), as well as guidance in the Common Communication on the Common Practice of Relative Grounds of Refusal - Likelihood of Confusion (impact of non-distinctive/weak components) dated 2 October 2014, which is referred to in the case law. Miss Himsworth summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness as follows, at paragraph 44:

“(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.

(2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.

(3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.

(4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.

(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.

(6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical.”

92. Whilst the 555 Mark and the 912 Mark are conceptually identical, it is important to bear in mind the common conceptual message they convey is non-distinctive. In my view, given the differing visual presentation of the words SUSHI CO in each mark and the non-distinctive nature of those words, the average consumer would not mistake one mark for the other in a predominantly visual purchasing process. I find this to be the case even when used on goods and services which are identical. I have borne in mind that the colours used in both marks are the same, but in my view, this does not render the marks sufficiently similar to result in them being mistaken one for the other, particularly given the way that those colours are used within each mark, which is quite noticeably different. The 562 Mark is even less similar to the 912 Mark and I see no reason why they would be mistaken one for the other. I do not consider there to be a likelihood of direct confusion.

93. I will now consider whether there is a likelihood of indirect confusion. 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)".

94. In my view, the differing presentations of the words SUSHI CO in the 912 and 555 Marks are not likely to result in indirect confusion arising, either in any of the ways envisaged by Mr Purvis or otherwise. In circumstances where the common element is weakly distinctive, and the common use of colour/circle devices is presented in noticeably different ways, I find that the average consumer would conclude that it was

coincidence, rather than indicative of a common or economically linked undertaking. Even if one mark brought the other to mind, this is mere association and not indirect confusion.¹⁵ I find this to be the case even where the marks are used on identical goods and services. The 562 Mark is even less similar to the 912 Mark and I can see no reason why the average consumer would conclude that the removal of the words THE SUSHI and the chopstick device from the mark, even when used on identical goods and services, would be consistent with a sub-brand or brand extension. In my view, there is no likelihood of indirect confusion.

95. The opposition based upon section 5(2)(b) of the Act is dismissed.

Section 3(6)

96. Section 3(6) of the Act states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

97. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

“(i) [...]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemaerker*

¹⁵ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

(C-320/12) EU:C:2013:435 (“*Malaysia Dairy*”), para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 (“*Sky CJEU*”), para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”), para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”), paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the

objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the

application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87).”

98. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

99. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards

on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

100. There was some dispute between the parties as to the scope of the bad faith pleading. However, for the sake of completeness, I will address each aspect of the arguments made by Bento. For reasons that will become clear below, nothing will turn on the pleadings point.

What, in concrete terms, was the objective that the applicant has been accused of pursuing?

101. In its Form TM7, Bento states that TSC had previously filed an identical trade mark (UKTM no. 3728752) against which Bento issued invalidation proceedings. These proceedings were not defended by Bento and the decision confirming the invalidity of that mark was issued on 15 August 2023 (8 days prior to the filing date of the 912 Mark). Bento went on to state:

“37. At the time [the 912 Mark] was filed, [Bento]’s highly similar mark, the registered by way of [the 352 Mark, the 555 Mark and the 555 Mark] [sic] had been used in the UK in respect of Japanese restaurant and takeaway services for some time. As such, at the time the registration was made, [TSC] knew, or ought to have known, that all rights in the SUSHICO mark were owned by [Bento].

38. The intention of [TSC] at the time the registration was made was to cause detriment to the interest of [Bento], loss of sales and to ride on their established goodwill and reputation. It is [Bento]’s view that the conduct of [TSC] at the time of filing [the 912 Mark] was dishonest.

39. We also would like to repeat our explanation above in Paragraphs between 9-14, as the re-filing of an invalidated mark, which left undefended during the invalidation process, should be regarded as an abuse of the UKIPO procedures

and trade mark protection & registration system and for this reason alone, the application should be refused.”

Was that an objective for the purposes of which the contested application could not be properly filed?

102. I accept that mere knowledge of another party’s business activities in the UK does not establish bad faith; *Lindt, Koton* (paragraph 55). However, if the intention was to cause detriment to another party or to ride on their established goodwill/reputation, then I accept that that is an objective for the purposes of which the contested application could not be properly filed. I also accept that filing an application with the intention of abusing the trade mark system is also an objective for the purposes of which the contested application could not be properly filed.

Was it established that the contested application was filed in pursuit of that objective?

103. Ms Güneyli Havelock has filed evidence to show that the previous company names of TSC were “Sushi Star Ltd” and “IRO Sushi London Ltd”. Ms Güneyli Havelock states that “[a]ccording to their websites, they were both established in 2014, which means they are both well-known and popular sushi restaurants”. However, no evidence is filed regarding those businesses and so I consider this to be assertion. Mr Choudhary accepts that the name IRO Sushi London Ltd was adopted because of TSC’s plans to become franchisees of IRO SUSHI. However, there is no evidence before me to prove that the name change to Sushi Star Ltd was as a result of copying the name of another business; the evidence suggests that the business by that name to which Ms Güneyli Havelock refers is based in Lebanon. Consequently, it is not clear to me that it would even be known to TSC (and no evidence has been filed to suggest otherwise).

104. The suggestion by Ms Güneyli Havelock appears to be that this is a pattern of behaviour on the part of TSC i.e. of using the trade marks of other companies. In this regard, Ms Güneyli Havelock has included a side-by-side comparison of TSC’s mark and the mark claimed to be used by IRO SUSHI:



105. I accept that there is some similarity between the marks arising from the circular background, the colours and the chopstick/sushi devices. Clearly, TSC is likely to have had knowledge of this logo if they had an intention to become a franchisee of IRO SUSHI. In any event, even if the device element of the 912 Mark was copied from IRO SUSHI's trade mark, that does not prove that the use of the words SUSHI CO (which are non-distinctive) is as a result of copying Bento. Given that there is only one instance (other than the present case) that Ms Güneyli Havelock is able to point to of alleged similarity between TSC's mark and the mark of another UK-based business, this does not, in my view, provide prima facie evidence that there is a pattern of behaviour on the part of TSC. If a party chooses to use devices/words within their trade mark which are non-distinctive or allusive of the goods and services provided, it should expect there to be other businesses which are also using the same elements. To do so is not, in my view, bad faith.

106. Further, given the very limited time in which Bento was actually trading under its mark, I see no reason to conclude that TSC would have been aware of it. Indeed, there is no evidence from Bento to suggest otherwise. Even if TSC had been aware of Bento, there is a complete lack of evidence of intention to cause detriment to, or derive any advantage from an association with, Bento. Given that Bento had not actually been trading in the 2 and a half years leading up to the relevant date, it is difficult to see what possible advantage TSC might have hoped to gain, or what detriment it might have intended to cause to Bento. Consequently, I do not find there to be a prima facie case of bad faith in this regard.

107. I will now consider the allegation of abuse of process. The previous trade mark of TSC that was subject to the application for invalidation on the part of Bento was not defended. There is no evidence, other than the re-filing itself, that there was a motive

or intention on the part of TSC to abuse the trade mark system. The burden is on Bento to prove that the application was filed with the intention claimed (i.e. to abuse the trade mark system). In my view, in the absence of any such evidence, Bento has not established a prima facie case. In any event, even if the re-filing alone was sufficient to establish a prima facie case, TSC has provided an explanation for the decision to file the 912 Mark. Mr Sama explains that TSC's previous representative overlooked the deadline for filing a defence to the invalidation, despite TSC having expressed an intention to defend. As Mr Byrne submitted, this is not a case where a substantive decision on the merits of the case had already been issued by this Tribunal. Whilst it would have been more appropriate to file a late-TM8 application, this does provide a legitimate explanation for the intention to file the 912 Mark which, in my view, would rebut any prima facie case made out by Bento.

108. The opposition based upon section 3(6) of the Act is dismissed.

CONCLUSION

109. The opposition against the 912 Mark is dismissed and, subject to any appeal, the 912 Mark may proceed to registration.

110. The application for revocation against the 352 Mark is successful and, subject to any appeal, the 352 Mark is revoked with effect from 6 July 2018.

111. The application for invalidation against the 555 Mark is dismissed and, subject to any appeal, the 555 Mark may remain registered.

COSTS

112. TSC has succeeded in relation to the revocation and the opposition; Bento has succeeded in relation to the invalidation. As TSC has been the more successful party, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. I have applied what I consider to be an appropriate reduction to account for Bento's success in the invalidation. With that in mind, I award TSC the sum of **£1,600**, calculated as follows:

Preparing forms and considering Bento's forms	£300
Preparing evidence and considering Bento's evidence	£800
Preparing written submissions and considering Bento's submissions	£300
Official fee for the revocation	£200
Total	£1,600

113. I therefore order Bento London Limited to pay The Sushi Co Ltd the sum of **£1,600**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 9th day of June 2026

S WILSON
For the Registrar

ANNEX

The 555 Mark

Class 29

Meat, fish, sashimi, seafood, poultry and game; meat and vegetable extracts; preserved, dried and cooked fruits and vegetables; eggs, milk and milk products; yoghurts and yoghurt drinks; fruit salads; pickles; preserves; salads; soups and stocks; meat extracts; soup mixes; miso soup; noodle soup; tofu; preparations made from any of the aforesaid; prepared and cooked meals and snacks.

Class 30

Sushi; rice; pasta; noodles; couscous; soya; instant noodles; coffee; tea; Japanese green tea; Udon; Okonomiyaki [Japanese savoury pancakes]; ramen [Japanese noodle-based dish]; cocoa and artificial coffee; rice; tapioca and sago; spices; vinegar; sauces; chilli pepper; chilli seasonings; curried food pastes; hot sauce; horseradish sauce; soy sauce; teriyaki sauce; sweet and sour sauce; spicy sauces; wasabi sauce; bakery goods; dried coriander for use as seasoning; rice noodles; noodles with soup; vermicelli; wontons; pies; meat pies; ginseng tea; herbal tea, infusions, sugar; flour and preparations made from cereals; bread; pastries and confectionery; desserts; cakes; biscuits; ices and ice creams; salad dressings; wasabi; pies and pasties; preparations made from any of the aforesaid; prepared and cooked meals and snacks.

Class 35

Retail services in relation to food and drinks, namely, sushi, sashimi, rice, pasta, noodles, couscous, soya, instant noodles, coffee, tea, Japanese green tea, Udon, Okonomiyaki [Japanese savoury pancakes], ramen [Japanese noodle-based dish], cocoa and artificial coffee, rice, tapioca and sago, spices, vinegar, sauces, chilli pepper, chilli seasonings, curried food pastes, hot sauce, horseradish sauce, soy sauce, teriyaki sauce, sweet and sour sauce, spicy sauces, wasabi sauce, bakery goods, dried coriander for use as seasoning, rice noodles, noodles with soup, vermicelli, wontons, pies, meat pies, ginseng tea, herbal tea, infusions, sugar, flour and preparations made from cereals, bread, pastries and confectionery, desserts, cakes, biscuits, ices and ice creams, salad dressings, wasabi, pies and pasties,

preparations made from any of the aforesaid, prepared and cooked meals and snacks- these services can also be provided through online websites; online ordering services.

Class 43

Restaurants; sushi restaurant services; restaurant services serving Japanese cuisine; food and drink catering in relation to Japanese cuisine; cafes; bars; eateries; canteens; food preparation; provision of food and drink; hospitality services; provision of food in drink in restaurants; booking of restaurant seats; takeaway services; snack-bars; information relating to the aforesaid provided from an Internet website or by means of telecommunications.

The 352 Mark

Class 43

Chinese·japanese·thai restaurant.

The 562 Mark

Class 29

Meat, fish, sashimi, seafood, poultry and game; meat and vegetable extracts; preserved, dried and cooked fruits and vegetables; eggs, milk and milk products; yoghurts and yoghurt drinks; fruit salads; pickles; preserves; salads; soups and stocks; meat extracts; soup mixes; miso soup; noodle soup; tofu; preparations made from any of the aforesaid; prepared and cooked meals and snacks.

Class 30

Sushi; sashimi; rice; pasta; noodles; couscous; soya; instant noodles; coffee; tea; Japanese green tea; Udon; Okonomiyaki [Japanese savoury pancakes]; ramen [Japanese noodle-based dish]; cocoa and artificial coffee; rice; tapioca and sago; spices; vinegar; sauces; chilli pepper; chilli seasonings; curried food pastes; hot sauce; horseradish sauce; soy sauce; teriyaki sauce; sweet and sour sauce; spicy sauces; wasabi sauce; bakery goods; dried coriander for use as seasoning; rice noodles; noodles with soup; vermicelli; wontons; pies; meat pies; ginseng tea; herbal tea, infusions, sugar; flour and preparations made from cereals; bread; pastries and confectionery; desserts; cakes; biscuits; ices and ice creams; salad dressings; wasabi;

pies and pasties; preparations made from any of the aforesaid; prepared and cooked meals and snacks.

Class 35

Retail services in relation to food and drinks, namely, sushi, sashimi, rice, pasta, noodles, couscous, soya, instant noodles, coffee, tea, Japanese green tea, Udon, Okonomiyaki [Japanese savoury pancakes], ramen [Japanese noodle-based dish], cocoa and artificial coffee, rice, tapioca and sago, spices, vinegar, sauces, chilli pepper, chilli seasonings, curried food pastes, hot sauce, horseradish sauce, soy sauce, teriyaki sauce, sweet and sour sauce, spicy sauces, wasabi sauce, bakery goods, dried coriander for use as seasoning, rice noodles, noodles with soup, vermicelli, wontons, pies, meat pies, ginseng tea, herbal tea, infusions, sugar, flour and preparations made from cereals, bread, pastries and confectionery, desserts, cakes, biscuits, ices and ice creams, salad dressings, wasabi, pies and pasties, preparations made from any of the aforesaid, prepared and cooked meals and snacks- these services can also be provided through online websites; online ordering services.

Class 43

Restaurants; sushi restaurant services; restaurant services serving Japanese cuisine; food and drink catering in relation to Japanese cuisine; cafes; bars; eateries; canteens; food preparation; provision of food and drink; hospitality services; provision of food in drink in restaurants; booking of restaurant seats; takeaway services; snack-bars; information relating to the aforesaid provided from an Internet website or by means of telecommunications.