O/0562/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3717520

BY CHRYSO THRASYVOULOU COSTAPPIS

TO REGISTER:

AS A TRADE MARK IN CLASSES 30 & 43

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 429179 BY

NADEEM OULACH

BACKGROUND AND PLEADINGS

1. On 3 November 2021, Chryso Thrasyvoulou Costappis ("the applicant") applied to register the trade mark shown on the front cover of this decision in the United Kingdom in respect of the following goods and services:

> *Class 30*
>
> *Bakery goods; Confectionery; Gluten-free bakery products; Coffee; Preparations for making bakery products; Sherbets [confectionery]; Liquorice [confectionery]; Rock [confectionery]; Dairy confectionery; Frozen confectionery; Pastilles [confectionery]; Confectionery bars; Flour confectionery; Boiled confectionery; Chocolate confectionery; Pastila [confectionery]; Confectionery ices; Marshmallow confectionery; Truffles [confectionery]; Peanut confectionery; Lozenges [confectionery]; Ice confectionery; Sesame confectionery; Fruit confectionery; Sherbet [confectionery]; Nut confectionery; Fondants [confectionery]; Sugar confectionery; Zephyr [confectionery]; Zefir [confectionery]; Mixes for making bakery products; Chocolate fillings for bakery products; Mallows [confectionery]; Lollipops [confectionery]; Almond confectionery; Ginseng confectionery; Coffee substitutes; Ground coffee; Coffee essence; Decaffeinated coffee; Coffee pods; Coffee mixtures; Flavoured coffee; Unroasted coffee; Iced coffee; Coffee bags; Substitutes (Coffee -); Coffee concentrates; Coffee oils; Coffee essences; Instant coffee; Coffee capsules; Prepared coffee and coffee-based beverages; Artificial coffee; Coffee (Artificial -); Coffee beverages; Coffee drinks; Malt coffee; Coffee beans; Coffee extracts; Coffee (Unroasted -); Chocolate coffee; Coffee flavourings; Coffee flavorings; Confectionery containing jelly; Liquorice flavoured confectionery; Dessert mousses [confectionery]; Prepared desserts [confectionery]; Peppermint for confectionery; Bubble gum [confectionery]; Fruit jellies [confectionery]; Flavoured sugar confectionery; Potato flour confectionery; Orange based confectionery; Confectionery (Non-medicated -); Mousses (Dessert -) [confectionery]; Low-carbohydrate confectionery; Clear gums [confectionery]; Confectionery containing jam; Ice cream confectionery; Stick liquorice [confectionery]; Mint for confectionery; Chocolate confectionery products; Sherbets [confectionery ices]; Chocolate flavoured confectionery; Jellies (Fruit -) [confectionery]; Coated nuts [confectionery]; Acid drops [confectionery]; Truffles (rum -) [confectionery]; Fruit drops [confectionery]; Non-medicated confectionery; Boiled sugar confectionery; Confectionery chocolate products; Mixtures of malt coffee with coffee; Coffee based beverages; Freeze-dried coffee; Coffee substitutes [artificial coffee or vegetable preparations for use as coffee]; Mixtures of coffee essences and coffee extracts; Coffee extracts for use as substitutes for coffee; Coffee based drinks; Coffee capsules, filled;*

Beverages (Coffee-based -); Mixtures of coffee; Ready-to-eat puddings; Ready-to-eat cereals; Chocolate-based ready-to-eat food bars; Ready-to-eat cereal-derived food bars; Ready to eat savory snack foods made from maize meal formed by extrusion; Hamburgers in buns; Puddings in powder form; Confectionery in frozen form; Ice in block form; Coffee in ground form; Confectionery in liquid form; Sandwiches; Cheeseburgers [sandwiches]; Hamburger sandwiches; Chicken sandwiches; Open sandwiches; Frankfurter sandwiches; Filled sandwiches; Fish sandwiches; Toasted sandwiches; Wraps [sandwich]; Wrap sandwiches; Turkey sandwiches; Sandwiches containing meat; Sandwiches containing hamburgers; Sandwiches containing chicken; Sandwiches containing salad; Sandwich wraps [bread]; Toasted cheese sandwich; Ice cream sandwiches; Sandwiches containing fish; Hot dog sandwiches; Sandwiches containing fish fillet; Sandwiches containing minced beef; Toasted cheese sandwich with ham; Sandwich spread made from chocolate and nuts; Pastries; Pastry; Danish pastries; Savory pastries; Puff pastry; Pastry mixes; Fruit pastries; Shortcrust pastry; Frozen pastries; Frozen pastry; Chocolate pastries; Macaroons [pastry]; Almond pastries; Pastry shells; Pastry cases; Viennese pastries; Pastry dough; Pâté [pastries]; Filo pastry; Long-life pastry; Poppy seed pastry; Pastries containing fruit; Frozen pastry sheets; Sopapillas [fried pastries]; Prepared desserts [pastries]; Pastries with fruit; Pastries containing creams; Orange based pastry; Flaky pastry containing ham; Mixtures for making pastries; Pastry shells for monaka; Spring roll skin [pastry]; Pastries filled with fruit; Aromatic preparations for pastries; Fruit filled pastry products; Frozen pastry stuffed with meat; Frozen pastry stuffed with vegetables; Skin [pastry] for spring rolls; Pastries containing creams and fruit; Pastries consisting of vegetables and poultry; Pastries consisting of vegetables and fish; Pastries, cakes, tarts and biscuits (cookies); Pastries consisting of vegetables and meat; Frozen pastry stuffed with meat and vegetables; Cakes; Plum-cakes; Plum cakes; Iced cakes; Rice cakes; Cakes (Rice -); Cake preparations; Cake dough; Chimney cakes; Fruit cakes; Cake doughs; Cream cakes; Breakfast cake; Barm cakes; Cake powder; Millet cakes; Cake bars; Treacle cake; Candy cake; Cake flour; Almond cake; Moon cakes; Cake frosting; Cake mixes; Sponge cake; Cake Pops; Chocolate cakes; Chocolate cake; Tea cakes; Frozen cakes; Malt cakes; Cake icing; Powder (Cake -); Cake mixtures; Cake batter; Sponge cakes; Vegan cakes; Sponge fingers [cakes]; Fruit cake snacks; Iced fruit cakes; Dough for cakes; Flavourings for cakes; Flavorings for cakes; Ice cream cakes; Petits fours [cakes]; Chocolate covered cakes; Frosting [icing] (Cake -); Frozen yogurt cakes; Iced sponge cakes; Ice-cream cakes; Rice cake snacks; Candy cake decorations; Flapjacks [griddle cakes]; Cake frosting [icing]; Icing for cakes; Chocolate decorations for cakes; Sticky rice cakes (Chapsalttock); Powder for making cakes; Pounded rice cakes (mochi); Japanese

sponge cakes (kasutera); Mixes for making cakes; Steamed sponge cakes (fagao); Aromatic preparations for cakes; Candy decorations for cakes; Mixtures for making cakes; Chocolate-coated rice cakes; Korean traditional rice cake [injeolmi]; Stir fried rice cake [topokki]; Cake decorations made of candy; Crystallized sugar for decorating cakes; Oat cakes for human consumption; Cereal cakes for human consumption; Candied cakes of popped rice; Japanese style steamed cakes (mushi-gashi); Half-moon-shaped rice cake [songpyeon]; Sweet pounded rice cakes (mochi-gashi); Chocolate-based fillings for cakes and pies; Flavourings, other than essential oils, for cakes; Custard-based fillings for cakes and pies; Flavourings for cakes other than essential oils; Flavorings, other than essential oils, for cakes; Deep chocolate cake made with chocolate sponge; Dried sugared cakes of rice flour (rakugan); Flavorings [flavourings], other than essential oils, for cakes; Cakes (Flavorings [flavourings], other than essential oils, for -); Soft pin-rolled cakes of pounded rice (gyuhi).

Class 43

Coffee shops; Coffee shop services; Take away food services; Take-away food services; Take away food and drink services; Take-away food and drink services; Cake decorating.

2. On 14 December 2021, the application was opposed by Nadeem Oulach ("the opponent"). The opposition is based on sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act")[1] and concerns all the goods and services in the application.[2]

3. Under section 5(2)(b), the opponent is relying on UK Trade Mark ("UKTM") No. 3120337, which has a filing date of 31 July 2015 and a registration date of 16 October 2015. It is registered for *Services for providing Greek food & drinks* in Class 43 and is shown below:

[1] 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.

[2] The opposition was also brought under section 5(3), but this ground was withdrawn during the proceedings.

4. This mark qualifies as an earlier mark under section 6(1) of the Act by virtue of its earlier filing date. As it had completed its registration procedure more than five years before the application date of the contested mark, the mark must have been genuinely used or there must be proper reasons for non-use. The opponent has stated that it has used the mark for the services relied on.

5. Under section 5(2)(b), the opponent claims that the marks are identical and the services are identical or similar. Consequently, it claims that there exists a likelihood of confusion on the part of the relevant public in the UK. I say more about these pleadings below. It also says that it has been contacted by customers asking if the applicant's business is another branch of the opponent's business.

6. Under section 5(4)(a), the opponent claims to have used the following signs in Chelmsford and Derby for *Authentic Greek hot/cold food and drinks in my restaurants as well as takeaway services for the same goods*:

ZORBA THE GREEK

www.zorbathegreek.co.uk

7. The opponent claims to have acquired goodwill under the signs and adds that the business is expected to expand into further locations, which may coincide with that of the applicant. It argues that the dominant and distinctive element of the contested mark is the phrase "ZORBA THE GREEK" and that use of the contested mark would constitute a misrepresentation to the public that would damage the goodwill in its business through diversion of custom, dilution of its unregistered marks and loss of reputation. Consequently, use of the contested mark would be contrary to the law of passing off.

8. The applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of use of the earlier mark. It notes that its business is in a different location and that the nature of the goods and services each party supplies is different. It says that it sells custom-made celebration cakes and serves coffee and cake, rather than main meals, to its customers.

EVIDENCE AND SUBMISSIONS

9. Only the opponent filed evidence. This comes from Nadeem Oulach, also known as Nadeem Ullah, the founder and owner of 2 restaurants, one in Chelmsford and one in Derby, trading under the name "ZORBA THE GREEK". He states that he is also the founder and director of a company called Micael Ltd, to which he licenses use of the earlier trade mark registered in his name. No further reference is made to this company and its relationship to the restaurants is unclear. Mr Oulach's witness statement goes to the use made of the earlier mark and the claims of goodwill and is dated 5 June 2023. It is accompanied by 13 exhibits.

10. The opponent also filed written submissions dated 5 June 2023.

11. Neither party requested a hearing or filed final written submissions.

REPRESENTATION

12. In these proceedings, the opponent is represented by Swindell & Pearson Ltd and the applicant by Augustins Solicitors.

PRELIMINARY ISSUE

13. As I have already noted, the opposition has been brought under sections 5(2)(b) and 5(4)(a) of the Act. However, the opponent's pleadings under the first of these sections claim that the marks are identical and that the respective marks cover the same goods and services. Before he secured professional representation, the opponent filed a claim under section 5(1), which requires identity of both the marks and the goods and services. On 22 December 2021, the IPO wrote to Mr Oulach to inform him that the respective marks were clearly not identical and so a claim under section 5(1) had no prospect of success. Mr Oulach was invited to review his notice of opposition. He subsequently amended the ground to section 5(2)(b), but retained the

text that he had used in his original form. I consider that this is likely to have been an oversight and so shall proceed to examine the section 5(2)(b) claim.

14. The applicant claims that the likelihood of a member of the public confusing the opponent's Greek restaurant in Chelmsford with its bakery in Enfield *"is so remote as to be negligible"*. However, it is important to keep in mind the fact that a UKTM covers the whole of the territory of the United Kingdom. Fair use of the contested mark would include its use in either Chelmsford or Derby, the location of the opponent's two restaurants. This argument therefore has no weight and I shall say no more about it.

DECISION

Proof of Use

15. Section 6A of the Act is as follows:

> "(1) This section applies where-
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in sections 5(1), (2) or (3) obtain, and
>
> (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
>
> (1A) In this section '*the relevant period'* means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
>
> (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
>
> (3) The use conditions are met if-

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form (the 'variant form') differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[(5) Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

…"

16. The application that is the subject of this opposition was filed on 3 November 2021. The relevant period in which genuine use must be shown is 4 November 2016 to 3 November 2021.

17. The case law on genuine use was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247:

"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 *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 Bundersvereinigung 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] and [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]."

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council* [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:

> '19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know.
> …
>
> 22. … it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case

> of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal … comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.'"

The evidence

18. The annual turnover for restaurant and takeaway services provided from the opponent's Chelmsford branch was £76,000 in 2017, £84,000 in 2018, £126,000 in 2019, £152,536 in 2020 and £190,945 in 2021.[3] Mr Oulach confirms that the figures include the support given through the Government's "Eat Out to Help Out" scheme inaugurated in 2020 following the first COVID-19 lockdown period. He explains that this scheme contributed 50% of the cost of food and non-alcoholic drinks purchased in participating restaurants, cafés and public houses. I shall therefore proceed on the basis that all the revenue figures relate to sales of the services provided by the opponent. Elsewhere, the evidence indicates that the restaurant itself is relatively small, seating 40 diners.[4] However, Mr Oulach states that the takeaway side of the business saw significant increases during the periods of lockdown.

19. Mr Oulach has also provided turnover figures for the Derby restaurant. In 2021, sales amounted to £320,420. An article from *The Derby Telegraph* dated 1 October 2021 states that it would be opening *"soon"* and that the premises had been undergoing refurbishment over the past couple of weeks.[5] The words "ZORBA THE GREEK" can be seen on a sign in the photograph:

[3] Paragraph 10.
[4] Exhibit NO9.
[5] Exhibit NO10.

New restaurant Zorba The Greek will be "opening soon" on Bold Lane, Derby city centre
(Image: Derby Telegraph)

20. A later article from the same source, dated 20 November 2021, is entitled “We take a Greek person to review Derby’s new Greek restaurant” and states that the restaurant has been open for a few weeks.[6] I infer from this evidence that the restaurant opened in October or (at the latest) early November 2021. I am unable to say how much of the 2021 revenue is likely to have been earned during the relevant period. However, I remind myself that genuine use may include use of a mark for services that are about to be marketed and for which preparations to secure customers are under way. I consider that an article in a local newspaper, which includes comments from Mr Oulach himself, would constitute a preparation to secure customers.

21. Expenditure on marketing and promotion was consistent throughout the relevant period, at £7,200 per year. Mr Oulach states that this funded advertising on Facebook, Instagram and Google Ads and payments to an employee to carry out the restaurants’ social media activity. No examples of advertising have been provided. Exhibits NO5 and NO6 contain screenshots from the Derby restaurant’s Facebook and Instagram accounts respectively, but these are undated.

[6] Exhibit NO11.

22. Further photographs and screenshots from the opponent's website and social media accounts are also undated. The earlier mark is shown on the signage of the Derby restaurant in an undated photograph, although Mr Oulach confirms in his witness statement that this sign has been present since the opening of the restaurant in 2021.[7]

23. The photograph of the Chelmsford premises is also undated and Mr Oulach says nothing in his witness statement about use of this particular form of the mark.[8]

24. Exhibit NO9 contains an article from the EssexLive news website. It is dated 21 May 2023 and while it concerns events of that year, it also confirms that a restaurant

[7] Exhibit NO1 and paragraph 15.
[8] Exhibit NO2.

under the name “ZORBA THE GREEK” served Greek food from the premises for more than six years.

Does the evidence show genuine use of the earlier mark?

25. The evidence is fairly light, but I remind myself that there is no *de minimis* level. The turnover from the Chelmsford restaurant is relatively modest, but it is a single, small restaurant with a takeaway service. While diners may travel some distance to go to a restaurant, the customers for a takeaway service are likely to be locally based. I also note that turnover rose year-on-year during the relevant period. Preparations were under way to open a second restaurant in Derby and it is possible (although I am unable to say for certain) that it had begun trading by the relevant date. However, before I make any findings as to whether the use is such that I can consider it genuine, I shall deal with the issue of the form of the mark.

26. The mark as registered is as follows:

27. It shows the words “ZORBA” and “GREEK” in a blue, upper-case angular typeface, which is shadowed to give a 3D effect. The word “THE” is in smaller, black upper-case letters in the same typeface, but without the shadow effect. The words are presented on a white background with “GREEK” placed slightly lower than “ZORBA”. Above and below the words are identical blue borders containing a white “Greek key” motif. The distinctive character of the mark lies mainly in the verbal element, with the typeface and borders playing a lesser role.

28. It can be seen in this form on the photograph of the Derby restaurant reproduced in paragraph 22 above. However, as I have already noted, it is not clear when this restaurant opened. The image accompanying the article from 1 October 2021 (and reproduced in paragraph 19 above) shows the words “ZORBA THE GREEK”, presented in white on a blue background, in a standard typeface, with a single word on each line. It is the verbal element alone that creates the overall impression of this sign. I have no dated evidence showing the form in which the mark was used on the

Chelmsford restaurant. However, I am satisfied that the words “ZORBA THE GREEK” were in use.

29. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Professor Phillip Johnson, sitting as the Appointed Person, considered the correct approach to an assessment of whether use of the mark in a different form constitutes genuine use of a registered mark. He said:

> “13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).
>
> 14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.
>
> 15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.
>
> 16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is supposed figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered

and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

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

30. I found the word element of the registered mark to be the most distinctive element. Consequently, I find that use of the phrase "ZORBA THE GREEK" without any figurative elements represents an acceptable variant use of the earlier mark. In my view, the omission of the borders and stylisation does not change the distinctive character of the earlier mark. I am therefore satisfied that the opponent has shown genuine use of the earlier mark for restaurant and takeaway services relating to Greek food and drinks.

31. The earlier mark is registered for *Services for providing Greek food & drinks* in Class 43. I must therefore consider whether this is a fair specification, based on the services in respect of which I have found the mark to be used. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification. He said:

"244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.

245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other categories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark."

32. The phrase *Services for providing food and drink* appears in the heading of Class 43 and encompasses a range of services, from restaurants and takeaway food services, to catering for events, personal chef services, food decoration and food sculpture. In my view, the average consumer, who is a member of the general public, would perceive these services as subcategories that may be viewed independently. I find that a fair specification for the earlier mark is *Services for providing Greek food & drinks, namely restaurant services and takeaway restaurant services.*

Section 5(2)(b)

33. Section 5(2)(b) of the Act is as follows:

"A trade mark shall not be registered if because–

…

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

34. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union ("CJEU") in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

35. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Goods and services are complementary when

> "… there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that

customers may think that the responsibility for those goods lies with the same undertaking."[9]

36. In making my comparison of the goods and services, I shall bear in mind the principles of interpretation of terms. These were conveniently summarised by Arnold LJ in *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), at paragraph 56:

> "(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.
>
> (2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.
>
> (3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.
>
> (4) A term which cannot be interpreted is to be disregarded."

37. I also find it helpful to note the comments of Floyd J (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

> "12. … Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language

[9] *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

unnaturally so as to produce a narrow meaning which does not cover the goods in question."

38. I shall begin by construing the term that I found the opponent was able to rely on: *Services for providing Greek food & drinks, namely restaurant services and takeaway restaurant services*. I consider that *restaurant services* involve the provision of meals to customers who consume the food and drinks on the premises, while *takeaway restaurant services* involve the provision of food (which is likely to be of a volume and type that the average consumer would consider to constitute a meal) to customers for eating elsewhere. The average consumer would understand the food supplied in the opponent's restaurant and takeaway restaurant services to be traditional Greek food or food inspired by Greek flavours.

Class 30

39. The applicant's specification in this Class is very long and includes a variety of beverages, prepared foods, mixes and ingredients. I have noted that in its counterstatement the applicant says that it provides different goods and services to its customers than those of the opponent. However, I am required to base my assessment on the specification applied for.

40. The opponent submits that all the goods are similar to its services, as they are complementary, since there is a close connection between them, in that the goods are important for the use of the services in such a way that the average consumer may think that they are the responsibility of the same undertakings. However, the applicant's specification contains some goods – for example, *Korean traditional rice cake [injeolmi]* – that would not be used by a restaurant or takeaway business specialising in Greek food and drink. I will therefore undertake a more detailed comparison. Where appropriate, I shall group terms together, and I remind myself that this may be done where the terms are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons: see *SEPARODE Trade Mark*, BL O-399-10, paragraph 5.

Bakery goods; Confectionery; Gluten-free bakery products; Dairy confectionery; Frozen confectionery; Confectionery bars; Flour confectionery; Chocolate confectionery; Confectionery ices; Marshmallow confectionery; Peanut confectionery;

Ice confectionery; Sesame confectionery; Fruit confectionery; Nut confectionery; Fondants [confectionery]; Mallows [confectionery]; Almond confectionery; Ginseng confectionery; Confectionery containing jelly; Dessert mousses [confectionery]; Prepared desserts [confectionery]; Fruit jellies [confectionery]; Potato flour confectionery; Orange based confectionery; Confectionery (Non-medicated -); Mousses (Dessert -) [confectionery]; Low-carbohydrate confectionery; Confectionery containing jam; Ice cream confectionery; Chocolate confectionery products; Sherbets [confectionery ices]; Chocolate flavoured confectionery; Jellies (Fruit -) [confectionery]; Non-medicated confectionery; Confectionery chocolate products; Ready-to-eat puddings; Confectionery in frozen form; Confectionery in liquid form; Sandwiches; Chicken sandwiches; Open sandwiches; Filled sandwiches; Fish sandwiches; Toasted sandwiches; Wraps [sandwich]; Wrap sandwiches; Turkey sandwiches; Sandwiches containing meat; Sandwiches containing chicken; Sandwiches containing salad; Sandwich wraps [bread]; Toasted cheese sandwich; Ice cream sandwiches; Sandwiches containing fish; Sandwiches containing fish fillet; Sandwiches containing minced beef; Toasted cheese sandwich with ham; Pastries; Savory pastries; Fruit pastries; Frozen pastries; Chocolate pastries; Almond pastries; Pastries containing fruit; Prepared desserts [pastries]; Pastries with fruit; Pastries containing creams; Flaky pastry containing ham; Pastries filled with fruit; Fruit filled pastry products; Frozen pastry stuffed with meat; Frozen pastry stuffed with vegetables; Pastries containing creams and fruit; Pastries consisting of vegetables and poultry; Pastries consisting of vegetables and fish; Pastries, cakes, tarts and biscuits (cookies); Pastries consisting of vegetables and meat; Frozen pastry stuffed with meat and vegetables; Cakes; Plum-cakes; Plum cakes; Iced cakes; Rice cakes; Cakes (Rice -); Chimney cakes; Fruit cakes; Cream cakes; Breakfast cake; Millet cakes; Cake bars; Treacle cake; Candy cake; Almond cake; Sponge cake; Cake Pops; Chocolate cakes; Chocolate cake; Frozen cakes; Malt cakes; Sponge cakes; Vegan cakes; Sponge fingers [cakes]; Iced fruit cakes; Ice cream cakes; Petits fours [cakes]; Chocolate covered cakes; Frozen yogurt cakes; Iced sponge cakes; Ice-cream cakes; Oat cakes for human consumption; Cereal cakes for human consumption; Candied cakes of popped rice; Deep chocolate cake made with chocolate sponge

41. This group contains foods that, in my view, encompass foods that may be served in the establishments covered by the opponent's services, so there is a degree of

similarity in the trade channels. Before proceeding any further with my analysis, I need to explain my inclusion of the term *Confectionery* and related terms, such as *Chocolate confectionery*, within this group. Neither party has provided me with a definition of the word "confectionery". I consider that it is commonly used to refer to sweets and chocolates. However, I also note that the specification includes the term *Flour confectionery*, which I would interpret to refer to sweet edible items that are made from flour. These could encompass dessert items one would expect to find in an establishment delivering the opponent's services. Consequently, I have included some of the confectionery-related terms here, where they appear to me to fall within this group.

42. There is also some similarity in purpose between the services and the applicant's goods in that they will all be purchased with the aim of satisfying hunger. It is possible that they may be selected (along with other goods) as an alternative to eating at a restaurant or purchasing a takeaway meal, so there is some degree of competition. I accept that the goods and services are likely to be targeted at the same users, because they will be purchased by members of the general public. The nature and method of use of the goods and services are different. In my view, there is some complementarity as food goods are essential to the provision of the opponent's services, giving rise to a likelihood that the average consumer will believe that they come from the same source. Consequently, I find that there is a medium to high degree of similarity between these goods and services.

Ready-to-eat cereals; Chocolate-based ready-to-eat food bars; Ready-to-eat cereal-derived food bars; Ready to eat savory snack foods made from maize meal formed by extrusion; Hamburgers in buns; Cheeseburgers [sandwiches]; Hamburger sandwiches; Frankfurter sandwiches; Sandwiches containing hamburgers; Hot dog sandwiches; Sandwich spread made from chocolate and nuts; Tea cakes; Fruit cake snacks; Rice cake snacks; Flapjacks [griddle cakes]; Chocolate-coated rice cakes

43. These are goods that in my view are unlikely to be provided by Greek restaurants or takeaways. Consequently, I consider that the trade channels will not be shared. I also take the view that there will not be complementarity between the goods and the services. Nevertheless, they share some similarity in purpose as, like the goods I considered in the last paragraph, they will be purchased with the aim of satisfying

hunger. There may also be some competition and they will be targeted towards the same users. The nature and method of use of the goods and services are different. Taking all these factors into account, I find that there is a low degree of similarity between the goods and services.

Pastila [confectionery]; Zephyr [confectionery]; Zefir [confectionery]; Danish pastries; Macaroons [pastry]; Viennese pastries; Sopapillas [fried pastries]; Barm cakes; Moon cakes; Sticky rice cakes (Chapsalttock); Pounded rice cakes (mochi); Japanese sponge cakes (kasutera); Steamed sponge cakes (fagao); Korean traditional rice cake [injeolmi]; Stir fried rice cake [topokki]; Japanese style steamed cakes (mushi-gashi); Half-moon-shaped rice cake [songpyeon]; Sweet pounded rice cakes (mochi-gashi); Dried sugared cakes of rice flour (rakugan); Soft pin-rolled cakes of pounded rice (gyuhi).

44. This group consists of specific food items that belong to cuisines other than Greek. I understand that pastila and zephyr (or zefir) come from Russia and countries of the former Soviet Union; that sopapillas are Mexican; that pounded rice cakes (mochi), sweet pounded rice cakes (mochi-gashi), dried sugared cakes of rice flour (rakugan), and soft pin-rolled cakes of pounded rice (gyuhi) are Japanese; that moon cakes and steamed sponge cakes (fagao) are Chinese; that sticky rice cakes (Chapsalttock), stir-fried rice cake [topokki] and half-moon-shaped rice cake [songpyeon] are Korean; that macaroons [pastry] are associated with French patisserie; and that barm cakes are English. The rest of the terms are self-explanatory.

45. There is some similarity in purpose between the opponent's services and the applicant's goods in that they will all be purchased with the aim of satisfying hunger. It is possible that they may be selected (along with other goods) as an alternative to eating at a restaurant or purchasing a takeaway meal, so there is some degree of competition. I accept that the goods and services are likely to be targeted towards the same users, because they will be purchased by members of the general public. These goods will reach the market through different trade channels to those of the opponent's services. I also consider that the goods and services are not complementary. The average consumer would not believe that a Greek restaurant or takeaway service also produces any of these goods. The nature and method of use of the goods and services

are different. Taking all these factors into account, I find that there is a low degree of similarity between the goods and the services.

Preparations for making bakery products; Mixes for making bakery products; Chocolate fillings for bakery products; Peppermint for confectionery; Mint for confectionery; Puddings in powder form; Pastry; Puff pastry; Pastry mixes; Shortcrust pastry; Frozen pastry; Pastry shells; Pastry cases; Pastry dough; Pâté [pastries]; Filo pastry; Long-life pastry; Poppy seed pastry; Frozen pastry sheets; Orange based pastry; Mixtures for making pastries; Pastry shells for monaka; Spring roll skin (pastry); Aromatic preparations for pastries; Skin (pastry) for spring rolls; Cake preparations; Cake dough; Cake doughs; Cake powder; Cake flour; Cake frosting; Cake mixes; Cake icing; Powder (Cake -); Cake mixtures; Cake batter; Dough for cakes; Flavourings for cakes; Flavorings for cakes; Frosting [icing] (Cake -); Candy cake decorations; Cake frosting [icing]; Icing for cakes; Chocolate decorations for cakes; Powder for making cakes; Mixes for making cakes; Aromatic preparations for cakes; Candy decorations for cakes; Mixtures for making cakes; Cake decorations made of candy; Crystallized sugar for decorating cakes; Chocolate-based fillings for cakes and pies; Flavourings, other than essential oils, for cakes; Custard-based fillings for cakes and pies; Flavourings for cakes other than essential oils; Flavorings, other than essential oils, for cakes; Flavorings [flavourings], other than essential oils, for cakes; Cakes (Flavorings [flavourings], other than essential oils, for -)

46. These goods are ingredients or mixes that need further preparation, or combination with other ingredients, before they are eaten. In *Top Dog Eats Limited v J Sainsbury PLC*, BL O-044-16, Ms Emma Himsworth QC, sitting as the Appointed Person, held that the distinction that the Hearing Officer had made at first instance between “ready-to-eat” foods and raw ingredients, or foods that required further processing, was not sustainable. The comparison in those proceedings was between goods in Class 29 and services in Class 43. These goods included *Meat extracts*, which I consider to be the closest comparisons to the goods at issue here. This is because *Meat extracts* are highly concentrated substances that are used to enhance the flavour of finished dishes, although I note that in some instances they may be consumed with minimal preparation (for example, being spread on toast).

47. Ms Himsworth explained that all the goods in Class 29 had undergone some form of preparation for consumption or conservation; that some of those goods identified by the Hearing Officer as “ready-to-eat” products might in fact require further processing, while those identified as raw ingredients could be eaten without any additional preparations. There was also some evidence that providers of services in Class 43 also produced foodstuffs, some of which were ready-to-eat and some of which were not.

48. To my knowledge, the goods in this group are not consumed on their own but are used as ingredients or, as with *Icing for cakes*, for example, as constituent parts of other dishes. In this respect, they differ from the Class 29 goods considered in *Top Dog*. The users of the goods will be members of the general public and food manufacturing and catering businesses. There is therefore some overlap in user. However, their nature, method of use and purpose are different. In my view, the trade channels are also likely to be different. I find that there is no competition and that the goods and services are not complementary, as I have no evidence to indicate that the average consumer would believe that the services and the goods came from the same undertaking. Consequently, I find that this comparison is not on all fours with the comparison made in *Top Dog*, where there was some evidence of common origin. No such evidence has been adduced in these proceedings. I find that the goods are dissimilar to the services.

Coffee; Coffee substitutes; Ground coffee; Coffee essence; Decaffeinated coffee; Coffee pods; Coffee mixtures; Flavoured coffee; Unroasted coffee; Iced coffee; Coffee bags; Substitutes (Coffee -); Coffee concentrates; Coffee oils; Coffee essences; Instant coffee; Coffee capsules; Prepared coffee and coffee-based beverages; Artificial coffee; Coffee (Artificial -); Coffee beverages; Coffee drinks; Malt coffee; Coffee beans; Coffee extracts; Coffee (Unroasted -); Chocolate coffee; Coffee flavourings; Coffee flavorings; Coffee based beverages; Freeze-dried coffee; Coffee substitutes [artificial coffee or vegetable preparations for use as coffee]; Mixtures of coffee essences and coffee extracts; Coffee extracts for use as substitutes for coffee; Coffee based drinks; Coffee capsules, filled; Beverages (Coffee-based -); Mixtures of coffee; Mixtures of malt coffee with coffee; Coffee in ground form;

49. This group includes prepared beverages that are frequently offered to customers of the opponent's services, and the coffee (or substitute) required to make those beverages. The purpose of the beverages is to satisfy thirst, although I am aware that consumers may also purchase caffeinated drinks to increase their levels of alertness. There is some similarity in purpose with the opponent's services, as, in my view, the consumer of these services would frequently be looking to satisfy their thirst as well as their hunger. The users of the goods and services are the same, although their nature and method of use differ. I consider there is likely to be a degree of complementarity and competition, and so I find that the goods and services are similar to a medium degree.

Sherbets [confectionery]; Liquorice [confectionery]; Rock [confectionery]; Pastilles [confectionery]; Boiled confectionery; Truffles [confectionery]; Lozenges [confectionery]; Sherbet [confectionery]; Sugar confectionery; Lollipops [confectionery]; Liquorice flavoured confectionery; Bubble gum [confectionery]; Flavoured sugar confectionery; Clear gums [confectionery]; Stick liquorice [confectionery]; Coated nuts [confectionery]; Acid drops [confectionery]; Truffles (rum -) [confectionery]; Fruit drops [confectionery]; Boiled sugar confectionery

50. Earlier in my decision, I discussed the meaning of the term *Confectionery* and construed the broad term to include sweet edible items that are likely to be served in establishments providing the opponent's services. However, these goods are unlikely to be provided in restaurants or takeaways. They are sweet snacks and would be consumed as a treat rather than as part of a meal. They would not be eaten to satisfy hunger and so I do not consider that there is competition between the goods and the services. The users are the same as those of the opponent's services, but the trade channels, method of use, nature and purpose are different. They are not complementary. I find them to be dissimilar.

Ice in block form

51. *Ice in block form* is used for cooling other products, such as drinks. It has the same end users as the opponent's services and shares the same trade channels. I find that it is complementary to restaurant services, as the provision of certain drinks depends

on the goods and the average consumer will believe that the goods and services have the same source. I find the goods and services to be similar to a medium degree.

Class 43

Take away food services; Take-away food services; Take away food and drink services; Take-away food and drink services

52. The applicant's services are broader terms that include the opponent's *Services for providing Greek food and drinks, namely … takeaway restaurant services.* In such circumstances, the two terms are considered to be identical: see *Gérard Meric v OHIM*, Case T-133/05, paragraph 29.

Coffee shops; Coffee shop services

53. In my view, the primary purpose of coffee shop services is the supply of those beverages. However, such establishments frequently offer a variety of food items to their customers for consumption on or off the premises. There is therefore a degree of similarity in purpose between the applicant's and the opponent's services and some competition. The users will be the same, and there will be some similarity in the method of use and nature of the service. I consider that it is likely that there will be some coffee shops that either specialise in Greek food and drinks, or who offer them as part of a wider range. Consequently, I find that there is a high degree of similarity between the services.

Cake decorating

54. The opponent submits that these services are identical or highly similar to its own services. However, this is under the cover of a general submission about all the Class 43 services and, while it makes specific submissions on the two groups that I have already considered, it does not have anything to say on *Cake decorating* in particular. In my view, *cake decorating* is the activity of covering a cake with edible decorations, for example with icing or chocolate, to make it attractive to the eye. Cakes can be made to resemble a wide range of different objects or scenes. The purpose is therefore to produce something aesthetically pleasing and so it differs from the purpose of the opponent's services. However, it seems to me likely that restaurants would engage in

this activity to some extent, as decorated cakes may be served for desserts or presented for celebrations held in the restaurants. Therefore, there is some similarity in trade channels and users and a degree of complementarity, as the average consumer would be likely to believe that the cake had been decorated by the provider of the restaurant services. I therefore find that the services are similar to a low degree.

Final remarks on the goods and services comparison

55. I have found that the following goods are dissimilar to the opponent's services:

> *Preparations for making bakery products; Sherberts [confectionery]; Liquorice [confectionery]; Rock [confectionery]; Pastilles [confectionery]; Boiled confectionery; Truffles [confectionery]; Lozenges [confectionery]; Sherbert [confectionery]; Sugar confectionery; Mixes for making bakery products; Chocolate fillings for bakery products; Lollipops [confectionery]; Liquorice flavoured confectionery; Peppermint for confectionery; Bubble gum [confectionery]; Flavoured sugar confectionery; Clear gums [confectionery]; Stick liquorice [confectionery]; Mint for confectionery; Coated nuts [confectionery]; Acid drops [confectionery]; Truffles (rum -) [confectionery]; Fruit drops [confectionery]; Boiled sugar confectionery; Puddings in powder form; Pastry; Puff pastry; Pastry mixes; Shortcrust pastry; Frozen pastry; Pastry shells; Pastry cases; Pastry dough; Pâté [pastries]; Filo pastry; Long-life pastry; Poppy seed pastry; Frozen pastry sheets; Orange based pastry; Mixtures for making pastries; Pastry shells for monaka; Spring roll skin (pastry); Aromatic preparations for pastries; Skin (pastry) for spring rolls; Cake preparations; Cake dough; Cake doughs; Cake powder; Cake flour; Cake frosting; Cake mixes; Cake icing; Powder (Cake -); Cake mixtures; Cake batter; Dough for cakes; Flavourings for cakes; Flavorings for cakes; Frosting [icing] (Cake -); Candy cake decorations; Cake frosting [icing]; Icing for cakes; Chocolate decorations for cakes; Powder for making cakes; Mixes for making cakes; Aromatic preparations for cakes; Candy decorations for cakes; Mixtures for making cakes; Cake decorations made of candy; Crystallized sugar for decorating cakes; Chocolate-based fillings for cakes and pies; Flavourings, other than essential oils, for cakes; Custard-based fillings for cakes and pies; Flavourings for cakes other than essential oils; Flavorings, other than*

essential oils, for cakes; Flavorings [flavourings], other than essential oils, for cakes; Cakes (Flavorings [flavourings], other than essential oils, for -).

56. Under section 5(2)(b), some similarity between the goods and services is essential: see *eSure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 CA, paragraph 49. The opposition under this ground therefore fails for the goods listed above.

Average consumer and the purchasing process

57. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. 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: see *Lloyd Schuhfabrik*, paragraph 26.

58. The average consumer of the Class 30 goods is a member of the general public, although they will also be bought by trade customers. They will buy them from supermarkets, convenience stores, other food shops and wholesalers, either in person or online. This means that the consumer will see the mark, either on the goods or a website. They may also have seen the goods advertised on television, print media, online or billboards. Purchasing will therefore be largely a visual process. The goods will be bought fairly frequently and will be inexpensive. I find that the average consumer will be paying no more than a medium degree of attention, although in the case of a customer in the catering industry this may be slightly higher.

59. For the Class 43 services, the average consumer is a member of the general public who will purchase most of the services on a fairly frequent basis. The exception is *Cake decorating*, as in my view this is most likely to be purchased in the context of a celebration such as a birthday. The price of the services may vary. Sometimes the consumer needs to find something to eat very quickly. On other occasions, they will make a more considered choice, taking account of the range of options on the menu, the ingredients used, the cleanliness of the restaurant, takeaway outlet or coffee shop, and whether the service caters for any dietary requirements that the consumer has. On balance, then, I find that the level of attention paid when purchasing these services

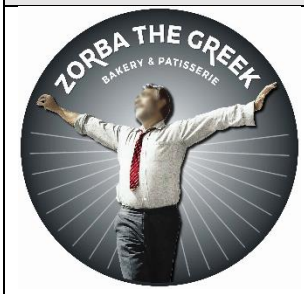
will be somewhere between low and medium. When purchasing *Cake decorating* services, the level of attention will be medium or slightly higher than that, given the context in which the purchases are most likely to be made.

60. During the purchasing process, the average consumer will see the marks in use on signage on the premises. They may also have seen advertisements or reviews on social media, websites and printed publications. The purchasing process will largely be a visual one. However, I cannot ignore the aural element of the marks as the consumer may receive word-of-mouth recommendations.

Comparison of marks

61. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks: see *Bimbo*, paragraph 34.

62. The respective marks are shown below:

Contested mark	**Earlier mark**
	ZORBA THE GREEK

63. I have already described the overall impression of the earlier mark in paragraph 26 above. I found that the dominant and distinctive part of the mark is the verbal element "ZORBA THE GREEK". These will be seen as a unit and play the greatest role in the overall impression of the mark, with the typeface and borders playing only minor roles.

64. The contested mark is a composite mark. It consists of the image of what appears to be a middle-aged man with his arms outstretched. The opponent submits that the man is either taking part in a traditional Greek dance or is about to do so, and that this concept reinforces the Greek theme. It is possible that some consumers may make that connection, but it is my view that some will not. I do consider that the average consumer will think that the mark refers to a Greek person named Zorba and that he is shown in the figurative element. The image is set in a circle which is a dark grey towards the edges but lightens gradually towards the centre. Thin light lines radiating from the man suggest that the sun is behind him. At the top of the circle there are two lines of words. The first, in large white capital letters, contains the words “ZORBA THE GREEK”. The letters are in an ordinary typeface except for the letter “R”, which, each time that it is used, has a long leg. The second line consists of the words “BAKERY & PATISSERIE”. These are smaller and are non-distinctive in relation to the goods and services for which registration is sought. Verbal elements are generally considered to be more distinctive than figurative elements, as the average consumer is more likely to identify the mark through the words: see *Migros-Genossenschafts-Bund v European Union Intellectual Property Office (EUIPO) (CReMESPRESSO)*, Case T-68/17, paragraph 52. The words “ZORBA THE GREEK” make the greatest contribution to the overall impression of the mark, with the image of the man also making a contribution. The colours and radiating lines will have a minor impact.

Visual comparison

65. Both marks contain the words “ZORBA THE GREEK”, albeit in different typefaces. The words “BAKERY & PATISSERIE”, the image of the man, the radiating lines, the colours used in the contested mark, and the borders and typeface of the earlier mark, are clear visual differences between them. Taking all these factors into account, I find that the marks are visually similar to a low degree.

Aural comparison

66. In considering the aural impact of the contested mark, it is my view that the words “BAKERY & PATISSERIE” will not be articulated by the average consumer. In making this finding, I have borne in mind the decision of Mr Philip Harris, sitting as the Appointed Person, in *Purity Hemp Company Improving Life as Nature Intended*,

BL O/115/22. At paragraph 31, he said that the descriptiveness of an element does not in itself render that element negligible or *"aurally invisible"*. In the present case, the words "BAKERY & PATISSERIE" are considerably smaller than the words "ZORBA THE GREEK" and their articulation would add a further eight syllables to a five-syllable phrase. It is my view that both these factors will lead to the average consumer saying the contested mark as "ZORBA THE GREEK". Consequently, I find that the marks are aurally identical.

Conceptual comparison

67. The applicant claims that *Zorba the Greek* is the name of a well-known film starring Anthony Quinn that was released in 1964. It continues:

> "The title of the film, and the main character has become something of a stereotypical and iconic reference, widely used to give some connection and an air of authenticity to anything purported to be Greek in nature."

68. In contrast, the opponent has filed a news article in Exhibit NO11 that suggests that the average consumer is more likely to be aware of the film if they are of retirement age.[10] I have no further evidence to indicate the level of awareness of the film, or the wider use of the phrase to denote goods and services that are Greek in nature. I note that the applicant states that there are several other restaurants trading under the name in London, Tunbridge Wells and Liverpool.[11] However, it has not provided me with any dated evidence to corroborate this assertion.

69. I must be cautious not to attribute my own personal knowledge to the average consumer. In *Chorkee Ltd v Cherokee Inc.*, BL O/048/08, Ms Anna Carboni, sitting as the Appointed Person, said:

> "36. … While the Applicant contended in its Counterstatement that the earlier marks would be recognised to refer to the Cherokee tribe and that the tribe was well known to the general public, no evidence was submitted to support this. By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice

[10] Page 2.
[11] See counterstatement.

> may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one's own personal experience, knowledge and assumptions are more widespread than they are."

70. In my view, some consumers would be aware of the film, but, given its age, a significant proportion would not. However for both these groups, the phrase "ZORBA THE GREEK" will have the same meaning for them in each of the marks. It will bring to mind either the film or a Greek person named Zorba. There is nothing to indicate whether this is a forename or a surname. It is my view that the man in the contested mark will be identified as Zorba and his open posture and the radiating lines suggest a welcoming, happy disposition. The words "BAKERY & PATISSERIE" inform the consumer of the type of business they can expect. The earlier mark shares the conceptual meaning of a Greek person named Zorba, but there is no further information in the mark to enable the consumer to identify whether Zorba is a man or woman. I find that there is a medium degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

71. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

> "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)."

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

73. Earlier in my decision, I found that it was the words "ZORBA THE GREEK" that were the distinctive element of the earlier mark. I have already referred to the applicant's argument that the phrase is often used in connection with Greek things, but there is no evidence to support this. In my view, "ZORBA" is a name that would strike a significant proportion of consumers (that is, those who are not aware of the film) as being unusual. Consequently, I find that the earlier mark has a higher than average degree of distinctive character.

74. The level of inherent distinctive character may be enhanced through the use that has been made of the mark. The factors that are relevant were listed by the CJEU in the passage from *Lloyd Schuhfabrik Meyer* quoted above. Although I have no information on the size of the market for restaurants and takeaways serving Greek food and drink, the sales figures have been relatively modest and until just before the relevant date there was only one restaurant. Some local press coverage shows that efforts were made to promote the mark in the relevant areas. I note that Exhibit NO13 contains an email showing the Chelmsford restaurant has won an award, but this dates from 2023, which is after the relevant date. Taking the evidence as a whole, it falls short of what would be required to show that the distinctive character of the earlier mark had been enhanced through use.

Conclusions on likelihood of confusion

75. The likelihood of confusion must be assessed globally, taking into account all relevant factors. It is not simply a case of applying a formula and seeing what comes out. I am required to make my assessment from the perspective of the average consumer and should also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services or vice versa. I keep in mind that the average consumer rarely has the opportunity to make direct

comparisons between trade marks and must instead rely upon the imperfect picture of them they have in their mind.

76. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting 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 recognised 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."

77. I found that the purchasing process for the contested Class 30 goods would be a visual one. Even if the goods are ordered over the phone, the average consumer is likely to have seen the mark in a catalogue, on a website or in other promotional material. In my view, the visual differences between the marks are sufficient for them not to be mistaken one for the other. The aural aspect of the mark has a bigger role to play in respect of the Class 43 services, as the average consumer may receive word-of-mouth recommendations about restaurants, takeaway outlets and coffee shops and that the level of attention paid would be low to medium. I found that the marks were aurally identical. Where the services are identical or highly similar, I consider that there is a likelihood of direct confusion.

78. This leaves *Cake decorating*, which I found to be similar to a low degree to the opponent's services. I also found that the level of attention paid during the purchase of these services would be slightly higher than the remaining Class 43 services. This

higher level of attention makes it unlikely in my view that the marks will be mistaken for each other.

79. Moving on to the question of indirect confusion, I remind myself that in paragraph 17 of his decision in *LA Sugar*, Mr Purvis gave the following examples of when indirect confusion could occur:

> "(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)."

80. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

> "12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.
>
> 13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a

likelihood of indirect confusion given that there is no likelihood of direct confusion."

81. Earlier in my decision, I found that the earlier mark had a higher than average degree of distinctive character, and that it was the phrase "ZORBA THE GREEK" that gave it this distinctive character. This element appears in its entirety in the contested mark and makes the greatest contribution to the overall impression of that mark. I find that, even if the average consumer recognises that the two marks are different, they will assume that they are two marks of the same undertaking: one with a figurative element and the non-distinctive words "BAKERY & PATISSERIE" and the other presenting the words "ZORBA THE GREEK" with some decoration. The non-distinctive words would be interpreted by the average consumer as indicating a specific range of products and services. I therefore find that the opposition succeeds under section 5(2)(b) for the following goods and services:

Class 30

Bakery goods; Confectionery; Gluten-free bakery products; Coffee; Dairy confectionery; Frozen confectionery; Confectionery bars; Flour confectionery; Chocolate confectionery; Pastila [confectionery]; Confectionery ices; Marshmallow confectionery; Peanut confectionery; Ice confectionery; Sesame confectionery; Fruit confectionery; Nut confectionery; Fondants [confectionery]; Zephyr [confectionery]; Zefir [confectionery]; Mallows [confectionery]; Almond confectionery; Ginseng confectionery; Coffee substitutes; Ground coffee; Coffee essence; Decaffeinated coffee; Coffee pods; Coffee mixtures; Flavoured coffee; Unroasted coffee; Iced coffee; Coffee bags; Substitutes (Coffee -); Coffee concentrates; Coffee oils; Coffee essences; Instant coffee; Coffee capsules; Prepared coffee and coffee-based beverages; Artificial coffee; Coffee (Artificial -); Coffee beverages; Coffee drinks; Malt coffee; Coffee beans; Coffee extracts; Coffee (Unroasted -); Chocolate coffee; Coffee flavourings; Coffee flavorings; Confectionery containing jelly; Dessert mousses [confectionery]; Prepared desserts [confectionery]; Fruit jellies [confectionery]; Potato flour confectionery; Orange based confectionery; Confectionery (Non-medicated -); Mousses (Dessert -) [confectionery]; Low-carbohydrate confectionery; Confectionery containing jam; Ice cream confectionery; Non-medicated confectionery; Chocolate confectionery products; Sherbets [confectionery ices]; Chocolate flavoured confectionery; Jellies (Fruit -) [confectionery]; Confectionery chocolate products; Mixtures of malt coffee with coffee; Coffee based beverages; Freeze-dried coffee; Coffee substitutes [artificial coffee or

vegetable preparations for use as coffee]; Mixtures of coffee essences and coffee extracts; Coffee extracts for use as substitutes for coffee; Coffee based drinks; Coffee capsules, filled; Beverages (Coffee-based -); Mixtures of coffee; Ready-to-eat puddings; Ready-to-eat cereals; Chocolate-based ready-to-eat food bars; Ready-to-eat cereal-derived food bars; Ready to eat savory snack foods made from maize meal formed by extrusion; Hamburgers in buns; Confectionery in frozen form; Ice in block form; Coffee in ground form; Confectionery in liquid form; Sandwiches; Cheeseburgers [sandwiches]; Hamburger sandwiches; Chicken sandwiches; Open sandwiches; Frankfurter sandwiches; Filled sandwiches; Fish sandwiches; Toasted sandwiches; Wraps [sandwich]; Wrap sandwiches; Turkey sandwiches; Sandwiches containing meat; Sandwiches containing hamburgers; Sandwiches containing chicken; Sandwiches containing salad; Sandwich wraps [bread]; Toasted cheese sandwich; Ice cream sandwiches; Sandwiches containing fish; Hot dog sandwiches; Sandwiches containing fish fillet; Sandwiches containing minced beef; Toasted cheese sandwich with ham; Sandwich spread made from chocolate and nuts; Pastries; Danish pastries; Savory pastries; Fruit pastries; Frozen pastries; Chocolate pastries; Macaroons [pastry]; Almond pastries; Viennese pastries; Pastries containing fruit; Sopapillas [fried pastries]; Prepared desserts [pastries]; Pastries with fruit; Pastries containing creams; Flaky pastry containing ham; Pastries filled with fruit; Fruit filled pastry products; Frozen pastry stuffed with meat; Frozen pastry stuffed with vegetables; Pastries containing creams and fruit; Pastries consisting of vegetables and poultry; Pastries consisting of vegetables and fish; Pastries, cakes, tarts and biscuits (cookies); Pastries consisting of vegetables and meat; Frozen pastry stuffed with meat and vegetables; Cakes; Plum-cakes; Plum cakes; Iced cakes; Rice cakes; Cakes (Rice -); Chimney cakes; Fruit cakes; Cream cakes; Breakfast cake; Barm cakes; Millet cakes; Cake bars; Treacle cake; Candy cake; Almond cake; Moon cakes; Sponge cake; Cake Pops; Chocolate cakes; Chocolate cake; Tea cakes; Frozen cakes; Malt cakes; Sponge cakes; Vegan cakes; Sponge fingers [cakes]; Fruit cake snacks; Iced fruit cakes; Ice cream cakes; Petits fours [cakes]; Chocolate covered cakes; Frozen yogurt cakes; Iced sponge cakes; Ice-cream cakes; Rice cake snacks; Candy cake decorations; Flapjacks [griddle cakes]; Sticky rice cakes (Chapsalttock); Powder for making cakes; Pounded rice cakes (mochi); Japanese sponge cakes (kasutera); Steamed sponge cakes (fagao); Chocolate-coated rice cakes; Korean traditional rice cake [injeolmi]; Stir fried rice cake [topokki]; Oat cakes for human consumption; Cereal cakes for human consumption; Candied cakes of popped rice; Japanese style steamed cakes (mushi-gashi); Half-moon-shaped rice cake [songpyeon]; Sweet pounded rice cakes (mochi-gashi); Deep chocolate cake made with chocolate

sponge; Dried sugared cakes of rice flour (rakugan); Soft pin-rolled cakes of pounded rice (gyuhi).

Class 43

Coffee shops; Coffee shop services; Take away food services; Take-away food services; Take away food and drink services; Take-away food and drink services; Cake decorating.

82. It fails with respect to the following goods:

Class 30

Preparations for making bakery products; Sherbets [confectionery]; Liquorice [confectionery]; Rock [confectionery]; Pastilles [confectionery]; Boiled confectionery; Truffles [confectionery]; Lozenges [confectionery]; Sherbet [confectionery]; Sugar confectionery; Mixes for making bakery products; Chocolate fillings for bakery products; Lollipops [confectionery]; Liquorice flavoured confectionery; Peppermint for confectionery; Bubble gum [confectionery]; Flavoured sugar confectionery; Clear gums [confectionery]; Stick liquorice [confectionery]; Mint for confectionery; Coated nuts [confectionery]; Acid drops [confectionery]; Truffles (rum -) [confectionery]; Fruit drops [confectionery]; Boiled sugar confectionery; Puddings in powder form; Pastry; Puff pastry; Pastry mixes; Shortcrust pastry; Frozen pastry; Pastry shells; Pastry cases; Pastry dough; Pâté [pastries]; Filo pastry; Long-life pastry; Poppy seed pastry; Frozen pastry sheets; Orange based pastry; Mixtures for making pastries; Pastry shells for monaka; Spring roll skin [pastry]; Aromatic preparations for pastries; Skin [pastry] for spring rolls; Cake preparations; Cake dough; Cake doughs; Cake powder; Cake flour; Cake frosting; Cake mixes; Cake icing; Powder (Cake -); Cake mixtures; Cake batter; Dough for cakes; Flavourings for cakes; Flavorings for cakes; Frosting [icing] (Cake -); Cake frosting [icing]; Icing for cakes; Chocolate decorations for cakes; Mixes for making cakes; Aromatic preparations for cakes; Candy decorations for cakes; Mixtures for making cakes; Cake decorations made of candy; Crystallized sugar for decorating cakes; Chocolate-based fillings for cakes and pies; Flavourings, other than essential oils, for cakes; Custard-based fillings for cakes and pies; Flavourings for cakes other than essential oils; Flavorings, other than essential oils, for cakes; Flavorings [flavourings], other than essential oils, for cakes; Cakes (Flavorings [flavourings], other than essential oils, for -).

Section 5(4)(a)

83. Section 5(4)(a) of the Act states that:

> "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 or 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 4(A) is met
>
> …"

84. Subsection 4(A) is as follows:

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

85. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the 'classical trinity' that must be proved in order to reach a finding of passing off at [406]:

> "First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the

defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

86. *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 are 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."

87. The relevant date is the date of commencement of the action complained of. This is the date of application for the contested mark (or, if relevant, its priority date), but where the mark has been used before the date of application, it is necessary to consider the position at the start of trading: see *Advanced Perimeter Systems v Keycorp Limited (MULTISYS)*, BL O-410-11, paragraph 43. The applicant describes itself as being a bakery in Enfield, an outer suburb of London. However, it is not clear whether it was actually trading at the time of the application for the contested mark, and, if so, for how long. The opponent states in his notice of opposition that customers have asked whether the applicant's business is a branch of his, but he provides no details either there or in his witness statement. I shall therefore confine myself to considering the position at the application date (3 November 2021).

Goodwill

88. The opponent must show that it had goodwill in a business at the relevant date and that one or more of the signs relied upon are associated with, or distinctive of, that business. The signs relied on are shown below:

ZORBA THE GREEK

www.zorbathegreek.co.uk

89. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at [224]:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

90. In *Smart Planet Technologies, Inc. v Rajinda Sharma (Recup Trade Mark)*, BL O/304/20, Mr Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After doing so, he concluded that:

> "34. ... a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon."

91. However, this does not need to be significant or substantial goodwill throughout the whole of the UK. In *Caspian Pizza Limited & Ors v Shah & Anor* [2017] EWCA Civ 1874, Patten LJ said:

> "23. It is, I think, implicit in these provisions that opposition under s.5(4) based on earlier use of the mark does not have to be use throughout the UK or alternatively in a geographical area which overlaps with the place where the applicant for registration actually carries on business using the same or a similar mark. As the Hearing Officer explained in *SWORDERS*, the application for a national mark operates as a notional extension of the use of the mark over the whole of the country. The only requirement is that the opponent should have established goodwill in the mark over an identifiable geographical area that would qualify for protection in passing off proceedings. Reputation may be enjoyed on such a small scale that it does not generate goodwill at all: see *Knight v Beyond Properties Pty Ltd & Ors* [2007] EWHC 1251 (Ch). But goodwill which is established in a particular locality will be capable of preventing registration of a countrywide mark."

92. I have already set out what the evidence says about the opponent's sales in paragraphs 18 and 19 above. I do not consider that the evidence shows that the Derby restaurant had been trading for long enough for goodwill to have been established in that area. The evidence specifically pertaining to Chelmsford are the turnover figures and marketing expenditure set out in paragraphs 18 and 21, and the following:

a) The undated photograph of the premises reproduced in paragraph 23 above;

b) An undated screenshot from www.zorbathegreek.co.uk headed "Chelmsford" and stating that the restaurant will be re-opening on Wednesday 24 May under new management;[12]

c) An article from Essex Live dated 21 May 2023 reporting on the re-opening of the restaurant and describing it as *"tiny"*, seating only 40 customers;[13] and

d) A printout from restaurantguru.com stating that Zorba the Greek in Chelmsford has been recommended on the website. However, this is dated 2023.[14]

[12] Exhibit NO8.
[13] Exhibit NO9.
[14] Exhibit NO13.

93. Mr Oulach also states that the domain name www.zorbathegreek.co.uk was registered in 2012, transferred to his ownership in 2015 and used continuously thereafter.[15] However, I have no information on the number of users or any screenshots from before the relevant date.

94. While the evidence is not extensive, I am satisfied that it shows that the opponent has acquired protectable goodwill in Chelmsford in relation to a Greek restaurant and takeaway and that the sign **ZORBA THE GREEK** is distinctive of that goodwill.

Misrepresentation

95. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

> "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] RPC 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 RPC 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 RPC 97 at page 101."

96. When I considered the opposition under section 5(2)(b), I found that some of the services in the application were identical or highly similar to the opponent's restaurant and takeaway services. Although the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer", it is unlikely,

[15] Paragraph 28.

in the light of the Court of Appeal's decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, that the difference between the legal tests will produce different outcomes. I believe that to be the case for the following services: *Coffee shops; Coffee shop services; Take away food services; Take-away food services; Take away food and drink services; Take-away food and drink services*. This is because registration of the contested mark would cover its use in Chelmsford, where I found that the opponent enjoys protectable goodwill.

97. For the goods and the remaining service, it does not seem to me likely that the consumer would assume that a small restaurant in Chelmsford was producing its own range of foodstuffs or that it had diversified into *Cake decorating*. It is important to recall here that under section 5(2)(b) once the proof of use condition had been met that I was making a notional assessment on the basis of how the respective marks could fairly be used and whether they were likely to be confused. Here I must ask myself whether the opponent's customers will be deceived. In *W.S. Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPCC 18 (PCC), Mr Iain Purvis QC, sitting as a Recorder of the Court, said that:

> "54. Mr Aikens stressed in his argument the difference between 'mere wondering' on the part of a consumer as to a trade connection and an actual assumption of such a connection. In *Phones 4U Ltd v Phone4U.co.uk. Internet Ltd* [2007] RPC 5 at 16-17 Jacob LJ stressed that the former was not sufficient for passing off. He concluded at 17:
>
> > 'This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former'."

98. In my view, the opponent's customers will not assume that there is a trade connection.

Damage

99. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millett LJ described the requirements for damage in passing off cases at [715]:

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

100. I consider that, if the contested mark were used for *Take away food services; Take-away food services; Take away food and drink services; Take-away food and drink services* the opponent is likely to suffer damage through loss of sales as its customers mistakenly order their take away food from the applicant. If the contested mark were used for *Coffee shops* and *Coffee shop services*, damage would, in my view, arise through injurious association, which was described as follows by Warrington LJ in *Ewing v Buttercup Margarine Company Limited* [1917] 2 Ch 1 (COA):

> "To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me."

101. I find that damage is made out for all the services for which I found there to be misrepresentation.

102. The opposition succeeds under section 5(4)(a) in relation to the following services:

Class 43

Coffee shops; Coffee shop services; Take away food services; Take-away food services; Take away food and drink services; Take-away food and drink services.

CONCLUSION

103. The opposition has been partially successful. Application No. 3717520 may, subject to a successful appeal, proceed to registration for the following goods:

Class 30

Preparations for making bakery products; Sherbets [confectionery]; Liquorice [confectionery]; Rock [confectionery]; Pastilles [confectionery]; Boiled confectionery; Truffles [confectionery]; Lozenges [confectionery]; Sherbet [confectionery]; Sugar confectionery; Mixes for making bakery products; Chocolate fillings for bakery products; Lollipops [confectionery]; Liquorice flavoured confectionery; Peppermint for confectionery; Bubble gum [confectionery]; Flavoured sugar confectionery; Clear gums [confectionery]; Stick liquorice [confectionery]; Mint for confectionery; Coated nuts [confectionery]; Acid drops [confectionery]; Truffles (rum -) [confectionery]; Fruit drops [confectionery]; Boiled sugar confectionery; Puddings in powder form; Pastry; Puff pastry; Pastry mixes; Shortcrust pastry; Frozen pastry; Pastry shells; Pastry cases; Pastry dough; Pâté [pastries]; Filo pastry; Long-life pastry; Poppy seed pastry; Frozen pastry sheets; Orange based pastry; Mixtures for making pastries; Pastry shells for monaka; Spring roll skin [pastry]; Aromatic preparations for pastries; Skin [pastry] for spring rolls; Cake preparations; Cake dough; Cake doughs; Cake powder; Cake flour; Cake frosting; Cake mixes; Cake icing; Powder (Cake -); Cake mixtures; Cake batter; Dough for cakes; Flavourings for cakes; Flavorings for cakes; Frosting [icing] (Cake -); Cake frosting [icing]; Icing for cakes; Chocolate decorations for cakes; Mixes for making cakes; Aromatic preparations for cakes; Candy decorations for cakes; Mixtures for making cakes; Cake decorations made of candy; Crystallized sugar for decorating cakes; Chocolate-based fillings for cakes and pies; Flavourings, other than essential oils, for cakes; Custard-based fillings for cakes and pies; Flavourings for cakes other than essential oils; Flavorings, other than essential oils, for cakes; Flavorings

[flavourings], other than essential oils, for cakes; Cakes (Flavorings [flavourings], other than essential oils, for -).

COSTS

104. Both parties have enjoyed some success in these proceedings, with the greater share going to the opponent. I therefore make an award of costs to the opponent in line with the scale set out in Tribunal Practice Notice No. 2/2016. I have taken into account the partial nature of the success and assess these costs as follows:

£200 for the official fee for filing the Notice of Opposition;

£250 for preparing a statement and considering the other side's statement;

£500 for preparing evidence and filing written submissions.

105. I therefore order Chryso Thrasyvoulu Costappis to pay Nadeem Oulach the sum of £950. This sum should be paid within twenty-one days of the expiry of the appeal period, or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful or withdrawn.

Dated this 18th day of June 2024

Clare Boucher
For the Registrar,
Comptroller-General