O/0837/24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3867931
IN THE NAME OF AD ASTRA BC LTD
TO REGISTER AS A SERIES OF 2 TRADE MARKS

IN CLASS 43

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 440442
BY AZUMI LIMITED

BACKGROUND AND PLEADINGS

1. On 15 January 2023, AD ASTRA BC LTD ("the applicant") applied to register, as a series of two, the trade marks shown on the cover page of this decision in the United Kingdom. The application was accepted and published for opposition purposes on 3 February 2023, in respect of services in class 43, as listed in the table under paragraph 13 of this decision.

2. The application is opposed by Azumi Limited ("the opponent"). The opposition was filed on 26 April 2023 and is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the services in the application. The opponent relies upon the following three marks:

ZUMA
UK trade mark registration number 3634560
Filing date: 29 April 2021
Registration date: 20 August 2021
Registered in Class 43
Relying on all services, as listed in the table under paragraph 13 of this decision.
(The '560 mark); and

zuma

zuma

Series of 2 marks
UK trade mark registration number 3641222
Filing date: 13 May 2021
Registration date: 20 August 2021
Registered in Class 43
Relying on all services, as listed in the table under paragraph 13 of this decision.
(The '222 mark); and

AZUMI

UK trade mark registration number 3627084

Filing date: 15 April 2021

Registration date: 17 September 2021

Registered in Classes 35 and 43

Relying on all services in class 43 only, as listed in the table under paragraph 13 of this decision.

(The '084 mark).

3. The above marks qualify as earlier marks under section 6(1) of the Act. As none of the marks had completed its registration procedure more than five years before the application date for the contested mark, they are not subject to the use provisions contained in section 6A of the Act.

4. The opponent submits that the word element of the applicant's mark and the earlier marks are visually and aurally highly similar and that there are no conceptual differences that could help distinguish between them; and that the opposed services are identical, or at the very least highly similar, to the services covered by the earlier marks. In view of this, the opponent submits that there is a real risk of both direct and indirect confusion on the part of the public and that the application should be refused in its entirety. It requests that an award of costs be made in favour of the opponent.

5. The applicant filed a counterstatement denying the claims of a likelihood of confusion and submits that the marks are "completely different", although it admits that both parties are "running similar goods".

6. Neither party elected to file evidence and neither party requested a hearing. Only the opponent filed written submissions in lieu of a hearing, which will be referred to as and where appropriate during this decision. Therefore this decision is taken following careful consideration of the papers.

7. In these proceedings, the opponent is represented by Boult Wade Tennant LLP and the applicant is unrepresented.

DECISION

8. 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.

Section 5(2)(b)

9. Section 5(2)(b) is relied on and reads as follows:

> "5(2) A trade mark shall not be registered if because -
>
> (a) …
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
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> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

10. Section 5A states:

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

11. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v*

Klijsen Handel B.V. Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

Comparison of services

12. Pursuant to section 60A of the Act, goods and services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes.

13. The services to be compared are all in class 43, as follows:

Applicant's services
Sushi restaurant services; Fast-food restaurant services; Hotel restaurant services; Take-out restaurant services; Restaurant and bar services; Bar and restaurant services; Take-away restaurant services; Restaurant services; Carvery restaurant services; Ramen restaurant services; Salad bars [restaurant services]; Tempura restaurant services; Restaurant reservation services; Washoku restaurant services; Restaurants; Carry-out restaurants; Japanese restaurant services; Self-service restaurant services; Mobile restaurant services; Grill restaurants; Spanish restaurant services; Reservation of

restaurants; Booking of restaurant seats; Udon and soba restaurant services; Serving food and drink for guests in restaurants; Catering in fast-food cafeterias; Serving food and drink in restaurants and bars; Restaurants (Self-service -); Self-service restaurants; Restaurant services for the provision of fast food; Tourist restaurants; Bistro services; Fast food restaurants; Restaurant services incorporating licensed bar facilities; Delicatessens [restaurants]; Providing food and drink for guests in restaurants; Provision of food and drink in restaurants; Providing restaurant services; Eateries; Restaurant information services; Providing food and drink in restaurants and bars; Catering of food and drinks; Food and drink catering for banquets; Catering (Food and drink -); Food and drink catering; Catering of food and drink; Serving food and drink in doughnut shops; Brasserie services; Restaurant services provided by hotels; Reservation and booking services for restaurants and meals; Cafe services; Hotel catering services; Food and drink catering for institutions; Hotel reservations; Agency services for reservation of restaurants; Providing food and drink in bistros; Serving food and drink in Internet cafes; Takeaway food and drink services; Take-away food and drink services; Food and drink catering for cocktail parties; Cocktail lounge buffets; Take-away food services; Takeaway food services; Serving food and drink for guests; Resort hotel services; Making reservations and bookings for restaurants and meals; Serving food and drinks; Providing food and drink in doughnut shops; Catering for the provision of food and drink; Catering services for company cafeterias; Reservation of hotel accommodation; Hotel reservation services; Café services; Take-away fast food services; Hospitality services [food and drink]; Wine bar services; Hotel accommodation reservation services; Providing reviews of restaurants and bars; Providing hotel and motel services; Pet hotel services; Providing room reservation and hotel reservation services; Catering for the provision of food and beverages; Corporate hospitality (provision of food and drink); Beer bar services; Providing food and drink in Internet cafes; Snack bar services; Catering services for providing European-style cuisine; Consultancy services in the field of food and drink catering; Tapas bars; Providing reviews of restaurants; Catering services for providing Japanese cuisine; Coffee bar services; Catering; Self-service cafeteria services; Night club services [provision of food]; Catering services for providing Spanish cuisine; Private members dining club services; Cafeteria services.

Opponent's services (identical to all three earlier marks[1])

*Restaurant services; bar services; **café services**; provision of food and drink; catering services; takeaway services; cocktail lounge services; temporary accommodation; hotel*

[1] With the exception of the emboldened term "***café services"*** which is relied upon under the earlier '222 mark only.

services; reservation services and booking services (including online) for restaurants; reservation services and booking services (including online) for hotels and temporary accommodation; advisory and information services relating to the selection, preparation and serving of food and alcoholic beverages; sommelier services.

14. Where goods or services in the specification of one party are included in a broader term from the other party's specification, those goods or services are considered to be identical: *Gérard Meric v OHIM,* Case T-133/05, at [29].

15. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

> "23. In assessing the similarity of the goods or services concerned, … all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

16. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* ("*Treat*") [1996] R.P.C. 281 include an assessment of the users and the channels of trade of the respective goods or services.

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

> "82. ...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".

18. For the purposes of considering the issue of similarity of the goods and/or services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.[2]

19. Specifications for services should not be interpreted widely but confined to the core of the possible meanings attributable to the terms: *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), at [56].

20. As mentioned previously, in its counterstatement, the applicant has admitted similarity of the competing services (although it has referred to goods, rather than services), but it has not said to what degree it considers them to be similar. I will therefore proceed to make my own comparison of the services at issue. As the services relied upon in class 43 are identical in all three of the opponent's earlier marks, with the exception of the term *"café services"* which is only relied upon under the '222 mark, unless expressly stated otherwise, the comparison of the applicant's services will apply equally to the services relied upon under each of the earlier marks.

21. Given that the essential purpose of a restaurant, bistro, brasserie, café or a bar is to provide food and/or drink, and the term "catering" also refers to the provision of food and drink, I consider the applicant's services listed below to be either self-evidently identical to the opponent's services, or they encompass/are encompassed by those relied upon by the opponent, such as "*Restaurant services"* and/or "*bar services"* and/or "*provision of food and drink"* and/or "*catering services"* and are therefore identical as per the principle outlined in *Meric*:

Sushi restaurant services; Fast-food restaurant services; Hotel restaurant services; Take-out restaurant services; Restaurant and bar services; Bar and restaurant services; Take-away restaurant services; Restaurant services; Carvery restaurant services; Ramen restaurant services; Salad bars [restaurant services]; Tempura restaurant services; Washoku restaurant services; Restaurants; Carry-out restaurants; Japanese restaurant services; Self-service restaurant services; Mobile restaurant services; Grill restaurants; Spanish restaurant services; Udon and soba

[2] Paragraph 5

restaurant services; Serving food and drink for guests in restaurants; Catering in fast-food cafeterias; Serving food and drink in restaurants and bars; Restaurants (Self-service -); Self-service restaurants; Restaurant services for the provision of fast food; Tourist restaurants; Bistro services; Fast food restaurants; Restaurant services incorporating licensed bar facilities; Delicatessens [restaurants]; Providing food and drink for guests in restaurants; Provision of food and drink in restaurants; Providing restaurant services; Eateries; Providing food and drink in restaurants and bars; Catering of food and drinks; Food and drink catering for banquets; Catering (Food and drink -); Food and drink catering; Catering of food and drink; Serving food and drink in doughnut shops; Brasserie services; Restaurant services provided by hotels; Cafe services; Hotel catering services; Food and drink catering for institutions; Providing food and drink in bistros; Serving food and drink in Internet cafes; Takeaway food and drink services; Take-away food and drink services; Food and drink catering for cocktail parties; Cocktail lounge buffets; Take-away food services; Takeaway food services; Serving food and drink for guests; Serving food and drinks; Providing food and drink in doughnut shops; Catering for the provision of food and drink; Catering services for company cafeterias; Café services; Take-away fast food services; Hospitality services [food and drink]; Wine bar services; Catering for the provision of food and beverages; Corporate hospitality (provision of food and drink); Beer bar services; Providing food and drink in Internet cafes; Snack bar services; Catering services for providing European-style cuisine; Tapas bars; Catering services for providing Japanese cuisine; Coffee bar services; Catering; Self-service cafeteria services; Night club services [provision of food]; Catering services for providing Spanish cuisine; Private members dining club services; Cafeteria services.

22. The following services are self-evidently identical to, or encompass/are encompassed by, the opponent's "*reservation services and booking services (including online) for restaurants"*:

Restaurant reservation services; Reservation of restaurants; Booking of restaurant seats; Reservation and booking services for restaurants and meals; Agency services for reservation of restaurants; Making reservations and bookings for restaurants and meals.

23. The applicant's services listed below are self-evidently identical to the opponent's "*reservation services and booking services (including online) for hotels and temporary accommodation"*:

Hotel reservations; Reservation of hotel accommodation; Hotel reservation services; Hotel accommodation reservation services; Providing room reservation and hotel reservation services.

24. I consider the term "consultancy services" would include the provision of advice and information and as such the applicant's broad term ***"Consultancy services in the field of food and drink catering"*** encompasses the opponent's "*advisory and information services relating to the selection, preparation and serving of food and alcoholic beverages"*, rendering the services identical as per the principle outlined in *Meric.*

25. I see little distinction between the terms "hotel" and "motel" with both providing temporary accommodation to travellers. The applicant's ***"Resort hotel services; Providing hotel and motel services"*** either cover or are covered by the opponent's "*hotel services"*, rendering the services identical as per *Meric*.

26. I consider that the applicant's *"**Restaurant information services**"* may be provided by the restaurant itself or by independent third parties. There will be an overlap in users of the information services with the opponent's "*Restaurant services"*, and although the services are different in their essential nature, there is an element of complementarity to the extent that consumers could reasonably expect both services to be provided by the same undertaking. Overall, I consider there to be a medium degree of similarity between the services.

27. Given the nature of the services, I would expect "***Providing reviews of restaurants and bars; Providing reviews of restaurants****"* to be made by independent third parties, rather than by the actual establishment at the centre of the review. While there will be an overlap in users of the applicant's services with users of the opponent's "*Restaurant services; bar services"*, the essential nature and purpose of the services are different, as are the channels of trade. Although the user

may first access the applicant's services before selecting a particular restaurant or bar, I do not find the services to be complementary in a trade mark sense and I do not consider that the average consumer would expect them to originate from the same undertaking. Consequently, I find the services to be dissimilar, or at best, similar to a very low degree.

28. While in principle, the opponent's broad term "*hotel services*" could encompass the applicant's ***"Pet hotel services"***, I am mindful that as per *Skykick*, specifications for services should not be interpreted widely. In my view, the average consumer will immediately perceive the opponent's services as intended for people rather than animals. Although I accept that some hotels also admit animals alongside their owners, you would not expect those same owners to stay at a pet hotel. Therefore, the temporary boarding of pets in a pet hotel fundamentally serves a different purpose to that of hotels per se, which is to provide accommodation for human guests. The end users and nature of the services are therefore different, they are neither in competition nor complementary in a trade mark sense and the channels of trade are different. Overall, I consider the services to be dissimilar.

29. Under section 5(2)(b), a degree of similarity between the services is essential for there to be a finding of likelihood of confusion: see paragraph 49 of *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA. In relation to the services which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of such services, with the opposition failing to that extent.

The average consumer and the nature of the purchasing act

30. The average consumer is a legal construct, 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 purpose 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 or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

31. In my view, the average consumer for the overlapping services will most likely be the general public who will be exposed to the services through signage displayed on the premises themselves, through advertisements in magazines and newspapers, or via websites and search engines on the internet. The selection process will be predominantly visual, although I do no discount word of mouth recommendations or where the services are advertised orally, for example, via local radio.

32. The cost of the services for the provision of food and drink will vary greatly, ranging from inexpensive for snack bar services or the provision of fast food and the like, to relatively expensive for the provision of fine dining experiences, while the services offered by many undertakings will fall somewhere between the two ends of the scale. For the former, the services may be chosen on impulse, purchased relatively frequently and with a lesser degree of consideration, whereas the latter is likely to be a much less frequent occurrence, and will have been carefully chosen and table reservations are likely to have been made following full consideration of the services being offered. Specific dietary requirements may also need to be considered as part of the selection process at all points along the spectrum. Similarly, hotel services will also vary in cost between budget hotels and high end establishments, and in general are likely to be patronised less frequently than the services solely providing food and drink. The physical location and the facilities being offered will also play a part in the selection of accommodation.

33. Overall, I consider that the average consumer of each of the overlapping services will pay between an average to high (although not the highest) degree of attention during the selection of those services.

Comparison of marks

34. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM* Case C-591/12P, that:

> "34. ....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

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

36. The respective trade marks are shown below:

Opponent's trade marks	**Applicant's trade mark**
The '560 mark **ZUMA** The '222 mark (series of 2) zuma zuma The '084 mark **AZUMI**	Series of 2  

37. The opponent submits that while the overall impression of the applicant's mark is in the mark as a whole, the word element speaks louder than the device and is the dominant and distinctive component, or at the least has an independent distinctive character.

38. The applicant submits in its counterstatement that the word "AZUMA" at the bottom of the Chinese characters "is a very small embellishment" which it submits is intended for customers who do not know the Chinese characters.

Overall impression

39. The opponent's '560 mark consists of the single word "ZUMA" presented in a standard black typeface in capital letters. As the mark contains no other elements, the overall impression therefore rests in the word itself.

40. The '222 mark is a series of two marks comprising the same verbal element "ZUMA", both marks presented in the same stylised script, one in black and the other in dark blue. I find nothing extraordinary about the stylisation which to my mind does not add to the trade mark message conveyed by the word itself. As such, it does little to contribute to the overall impression of the mark, which lies in the word as presented.

41. The opponent's '084 mark consists of the single word "AZUMI" presented in a standard black typeface in capital letters. As the mark contains no other elements, the overall impression therefore rests in the word itself.

42. The applicant's mark has been accepted and published as a series of two marks, pursuant to section 41(2) of the Act. Each mark in the series contains an identical verbal element, being the word "AZUMA" presented in capital letters in what I consider to be unremarkable handwritten red lettering. I note that registration of a mark in black and white covers use of the mark in colour.[3] In each mark in the series, above the word element are what I interpret as being two Chinese characters, presented in white against a red background. The characters are identical in both marks of the series,

[3] See paragraph 5, *Specsavers* [2014] EWCA Civ 1294.

the only difference being that in the first mark, the characters are positioned side by side (horizontally), while in the second mark of the series, they are positioned vertically, one above the other. I agree with the opponent that the word element plays an independent role in the applicant's mark as a whole. Although the Chinese characters element is larger than the word in the overall impression, I consider that they would be seen as non-distinctive in relation to food services offering oriental cuisine. Accordingly, I consider that it is the word "AZUMA" which makes the greatest contribution to the overall impression. For the services which clearly indicate other types of cuisine, such as the applicant's "*Spanish restaurant services"* and "*Tapas bars"*, I consider that the word element would still make a greater contribution to the overall impression of the mark, with the Chinese characters making a lesser contribution.

43. While there are differences in the layout of the applicant's series of marks, as outlined above, the marks have been deemed to meet the criteria to be accepted as a series. For convenience, I will refer to the series in the singular, unless I consider it appropriate to do otherwise.

44. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, although I accept that this is not always the case.

Visual comparison

45. The opponent's '560 mark and its '222 mark comprise the same single word "ZUMA", with the additional stylisation to the '222 mark noted above. The applicant's mark comprises the stylised word element "AZUMA", alongside the Chinese characters as previously described which play no part in the opponent's marks, creating a visual disparity. Although the Chinese characters in the applicant's mark would not go unnoticed, the opponent's marks are wholly incorporated within the distinctive word "AZUMA" in the applicant's mark. Overall, I consider there to be a medium degree of visual similarity between the competing marks.

46. The opponent's '084 mark consists of the single word "AZUMI", being five letters in length, the word element "AZUMA" in the applicant's mark also comprises five letters. The word elements share the same first four letters, in the same order, differing only in the final letter of the respective words. The Chinese characters contained within the applicant's mark play no part in the opponent's mark, however, given the similarities between the word elements, I consider there to be a medium degree of visual similarity between the competing marks overall.

Aural comparison

47. The identical verbal element "ZUMA" in the opponent's '560 mark and in its '222 mark will be pronounced as two syllables, ZOO-MAH. The verbal element in the applicant's mark "AZUMA" will be voiced as three syllables, AH-ZOO-MAH. I consider that the average UK consumer would see the Chinese characters as a non-verbal element and as such, there are no other elements within the applicant's mark which will be articulated. The marks therefore differ orally by only the first syllable present in the applicant's mark. Overall, I consider the marks to be aurally similar to a high degree.

48. The opponent's '084 mark will be pronounced as three syllables AH-ZOO-MEE, as opposed to the three syllables voiced in the applicant's mark, AH-ZOO-MAH. Given the identity of the shared first two syllables, I consider the marks to be aurally similar to a high degree.

Conceptual comparison

49. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006][4].

50. In my view, the average UK consumer will be conversant with the likes of Chinese and other Asian foods, with Chinese restaurants and take-away food outlets being particularly popular and well established throughout the United Kingdom. As such, the

[4] Paragraph 56.

services provided under the applicant's mark are targeted at the wider UK public, rather than a niche Chinese speaking enclave within the British Isles. I do not consider that a significant proportion of consumers would understand the meaning of the Chinese characters and would instead merely perceive them as an indication of the type of cuisine being provided or as the origin of the provider. The applicant submits that the word "AZUMA" is a very common word and name, however, without evidence to the contrary, I consider that the average (English speaking) consumer would perceive it as an invented word with no recognisable semantic content.

51. I also consider that the words "ZUMA" in the opponent's '560 and '222 marks, and the word "AZUMI" in the earlier '084 mark, would each be seen as invented words with no allusive qualities or clear concept. As such, only the applicant's mark has any conceptual content by way of the Chinese characters which are not present in the opponent's marks, while the word element in each of the competing marks are conceptually neutral.

Distinctive character of the earlier marks

52. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. The factors I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97:

> "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)."

53. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence of use has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

54. Earlier in this decision, I considered the opponent's marks "ZUMA" and "AZUMI" would each be seen as invented words with no allusive qualities. Overall, I consider the three earlier marks to be high in inherent distinctive character.

Likelihood of confusion

55. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

56. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

> “16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”
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> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
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> (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).”

57. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

58. Earlier in this decision, I found the contested services ranged between identical to dissimilar to the opponent's services. I found that the average consumer of the overlapping services would pay between an average to high (although not the highest) degree of attention during the selection of those services, and that the services would be selected by predominantly visual means, although I did not discount oral considerations. I considered the applicant's mark to be visually similar to each of the opponent's marks to a medium degree, and aurally similar to a high degree, and I found the word elements within each of the competing marks to be conceptually neutral, with only the applicant's mark enjoying any conceptual content by way of the Chinese characters not present in any of the opponent's marks. I considered that the word element within the applicant's composite mark plays an independent and distinctive role within the mark as a whole.[5] I found the earlier marks to be inherently distinctive to a high degree.

59. I have weighed up each of the competing factors in my decision, including the differences as well as the similarities between the competing marks. The average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind. I bear in mind that in relation to the assessment of the likelihood of confusion, it is the section of the public with the lowest level of attention which must be taken into consideration.[6] I also take into account the non-distinctive nature of the Chinese characters within the applicant's mark in relation to many of the services at issue, which in my view are unlikely to be recalled by a significant proportion of the average consumer. I consider this to be the case even where the services relate to the provision of cuisine which is obviously not of predominantly oriental origin (such as for Spanish restaurant services). Given the high degree of inherent distinctive character of the earlier marks, as well as the degree of visual and aural similarity between them, in my view, the similarities between the word elements in the marks are such that they are likely to be mistakenly remembered as each other. Consequently, I find that there is a likelihood of direct confusion in relation to all the services for which I found a medium degree of similarity or higher.

[5] See *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), at [18-21].
[6] Case T-247/12, *Argo Group International Holdings Ltd. v OHIM*.

60. I accept that there will be some consumers who note the differences between the marks, therefore, taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

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

62. Keeping in mind the global assessment of the competing factors in my decision, given that the applicant’s mark is dominated by the words “AZUMA”, it is my view that those consumers who notice the additional Chinese characters within the applicant’s mark are still likely to misremember the word elements of the competing marks. As such, they are likely to conclude that the additional Chines characters of the applicant’s mark is attributable to variant brands from the same, or economically connected, undertakings. Consequently, I consider there to be a likelihood of indirect confusion in relation to all services for which I found identity or similarity to at least a medium degree.

63. The opposition under section 5(2)(b) succeeds in respect of the services outlined in paragraphs 21 to 26 of this decision only.

CONCLUSION

64. The applicant has been partially successful. Subject to any successful appeal, the application by AD ASTRA BC LTD may proceed to registration in respect of the following services only in class 43:

Providing reviews of restaurants and bars; Providing reviews of restaurants; Pet hotel services.

COSTS

65. Both parties have enjoyed a share of success, with the greater part going to the opponent, who is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023. I have made a slight reduction to the costs to reflect the partial extent of the success. Applying the guidance in the TPN, I award the opponent the sum of £700, which is calculated as follows:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£250
Preparing and filing written submissions:	£350
Total:	**£700**

66. I therefore order AD ASTRA BC LTD to pay Azumi Limited the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of August 2024

Suzanne Hitchings
For the Registrar,
the Comptroller-General