O/1022/24

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. 3326610
IN THE NAME OF AZHER BAIG
TO REGISTER AS A TRADE MARK

IN CLASSES 39, 41 AND 43

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 414792
BY VUR VILLAGE TRADING NO 1 LIMITED

BACKGROUND AND PLEADINGS

1. On 23 July 2018, Azher Baig ("the applicant") applied to register the trade mark shown on the cover page of this decision in the United Kingdom. The application was accepted and published for opposition purposes on 21 September 2018, in respect of services in classes 39, 41 and 43, as listed in the table under paragraph 13 of this decision.

2. The application is opposed by VUR Village Trading No 1 Limited ("the opponent"). The opposition was filed on 20 December 2018 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 EU mark[1]:

VILLAGE

EU Registration No. 014764757[2]

EU Registration date: 10 March 2017

Registered in classes 41, 43 and 44

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

3. The above mark qualifies as an earlier mark under section 6(1) of the Act. As it had not completed its registration procedure more than five years before the application date for the contested mark, it is not subject to the use provisions contained in section 6A of the Act.

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[1] As per the first TM7 filed in these proceedings, the opponent originally based its opposition upon sections 5(2)(b) and 5(3) of the Act, seeking to rely on three earlier rights under both sections of the Act. In its written submissions dated 23 December 2019, it stated that for the sake of procedural economy, the opponent now sought to rely on EUTM No. 1476757 only, under section 5(2)(b) only. On 24 January 2020 the opponent filed an amended form TM7 to reflect this. Accordingly, the applicant was invited to file an amended form TM8 in defence, should it so wish, although no amended TM8 has since been received. I further note that these proceedings were suspended as EUTM No. 1476757 was subject to cancellation proceedings in the EU. The opponent having confirmed that the EU registration has been maintained, the UK opposition proceedings have been brought out of suspension.

[2] Although the UK has left the EU and the transition period has now expired, these proceedings were launched before IP Completion Day (i.e. before 11pm on 31 December 2020). The earlier EUTM relied upon is therefore still relevant in these proceedings – please see Tribunal Practice Notice 2/2020 for further information.

4. The opponent submits that the applicant's mark should not be registered because it is similar to the earlier mark and that the services covered by the marks are identical or similar, such that there exists a likelihood of confusion on the part of the public.

5. The applicant filed a counterstatement denying the claims and submits that the differences between the marks are substantial, which along with the lack of distinctiveness attached to the word VILLAGE in relation to the contested services serve to negate any likelihood of confusion between the marks.

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

7. In these proceedings, the opponent is represented by Taylor Wessing LLP and the applicant is represented by Lincoln IP.

PRELIMINARY ISSUE

8. In its written submissions dated 23 December 2019, the opponent has provided three separate tables in which it compares the opposed services in classes 39 and 43 respectively against the class 43 services upon which it relies and the opposed services in class 41 against the class 41 services for which the earlier mark has been registered. However, on both the original form TM7 as well as the amended form TM7 filed on 24 January 2020, under Q1 of SECTION A, in response to the question "Which goods or services covered by the earlier mark are relied upon for the opposition?", the opponent has ticked the box which states "Some goods and services" which it then specifies as being "All the services in Class 43 for which the trade mark is registered". The opponent has therefore never sought to rely upon its services in class 41. Accordingly, I will disregard the submissions made by the opponent comparing the opposed services in class 41 against the registered services of the earlier mark in class 41 and I will instead compare each of the opposed services against the

opponent's services in class 43, being the only services relied upon in these proceedings.

DECISION

9. 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)

10. 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,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

11. 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."

12. 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

13. The services to be compared are:

Opponent's services
Class 43 *Hotels; hotel reservation services; hotel accommodation; arranging, provision and rental of accommodation; arranging, provision and rental of temporary accommodation; accommodation bureau services; accommodation reservation services; booking agency services for holiday accommodation; booking agency services for hotel accommodation; booking of accommodation for travellers; provision of on-line booking services relating to accommodation; reservation services for booking meals; reservation services for the booking of accommodation; rental of temporary accommodation; rental of meeting rooms; hospitality services (provision of food and drink); hospitality services (accommodation);*

provision of hospitality suites; room rental; rental of rooms and buildings in which to stage exhibitions; provision of banqueting services; the provision of food and drink; bars, wine bars and cocktail lounge services provided within a hotel; bistros; cafes; cafeterias; canteens; catering; restaurant services; self-service restaurant services; snack-bar services; public house services; inn services; camp services; campground facilities; caravan park facilities; child care services; child minding services; provision of day nurseries for children (creches); arranging, provision and rental of wedding reception venues; arranging and provision of wedding reception food and drink; arranging and provision of wedding reception accommodation; information, advisory and consultancy services relating to all the foregoing.
Applicant's services
Class 39 *Delivery of food by restaurants.*
Class 41 *Training relating to the restaurant industry.*
Class 43 *Catering (Food and drink -); Catering for the provision of food and beverages; Catering for the provision of food and drink; Catering in fast-food cafeterias; Catering of food and drink; Catering of food and drinks; Catering services; Catering services for company cafeterias; Catering services for conference centers; Catering services for educational establishments; Catering services for hospitality suites; Catering services for hospitals; Catering services for nursing homes; Catering services for providing European-style cuisine; Catering services for providing Japanese cuisine; Catering services for providing Spanish cuisine; Catering services for retirement homes; Catering services for schools; Catering services for the provision of food; Catering services for the provision of food and drink; Catering services specialised in cutting ham by hand, for fairs, tastings and public events; Catering services specialised in cutting ham by hand, for weddings and private events; Catering services specialising in cutting ham for fairs, tastings and public events; Catering services specialising in cutting ham for weddings and private events; Business catering services; Charitable services, namely providing food and drink catering; Consultancy services in the field of food and drink catering; Food and drink catering; Food and drink catering for banquets; Food and drink catering for cocktail parties; Food and drink catering for institutions; Hotel catering services; Mobile catering; Mobile catering services;*

Office catering services for the provision of coffee; Organisation of catering for birthday parties; Outside catering; Outside catering services; Providing food and drink catering services for convention facilities; Providing food and drink catering services for exhibition facilities; Providing food and drink catering services for fair and exhibition facilities; Rental of catering equipment; Agency services for reservation of restaurants; Bar and restaurant services; Booking of restaurant seats; Carry-out restaurants; Carvery restaurant services; Delicatessens [restaurants]; Fast food restaurants; Fast-food restaurant services; Grill restaurants; Hotel restaurant services; Japanese restaurant services; Making reservations and bookings for restaurants and meals; Mobile restaurant services; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Providing information about restaurant services; Providing restaurant services; Providing reviews of restaurants; Providing reviews of restaurants and bars; Provision of food and drink in restaurants; Provision of information relating to restaurants; Ramen restaurant services; Reservation and booking services for restaurants and meals; Reservation of restaurants; Salad bars [restaurant services]; Self-service restaurant services; Self-service restaurants; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Spanish restaurant services; Sushi restaurant services; Take-out restaurant services; Tempura restaurant services; Tourist restaurants; Travel agency services for booking restaurants; Restaurant and bar services; Restaurant information services; Restaurant reservation services; Restaurant services; Restaurant services for the provision of fast food; Restaurant services incorporating licensed bar facilities; Restaurant services provided by hotels; Restaurants; Restaurants (Self-service -).

14. Where the services in the specification of one party are included in a broader term from the other party's specification, those services are considered to be identical: See *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 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 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 or services. 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 services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.[3]

<u>The contested services in class 39</u>

Delivery of food by restaurants.

19. The opponent submits that the applicant's class 39 food delivery services are highly similar to the opponent's "*restaurant services*" in class 43. It submits that the delivery of meals by restaurants is a common practice and that the services share the same target market, with the same purpose i.e. to provide meals to customers and would more often than not share the same trade source, being the restaurant itself. I agree with the opponent's reasoning and I consider the services to be complementary

[3] Paragraph 5

to the extent that the consumer would expect both the applicant's "*delivery of food by restaurants"* and the opponent's "*restaurant services"* to originate from the same or related undertakings. I consider the services to be similar to a high degree.

The contested services in class 41

Training relating to the restaurant industry.

20. The applicant's above training services are very broad and could cover, inter alia, the training of chefs, waiting staff and administration personnel. While it is likely that the personnel engaged in the delivery of the opponent's "*restaurant services"* in class 43 will have undertaken some form of training, including training conducted "in-house", it does not follow that a restaurant would also offer training as a service to those within the restaurant industry at large being outside the confines of its own business. In *Commercy AG v OHIM* Case T-316/07, the Board of Appeal ("BOA") found that just because goods are used by an undertaking in order to provide its services, the respective goods and services are targeted at different consumers, and as such, there can be no complementary connection between them.[4] As per *Commercy*, I consider the users of the respective services to be different, with the training services in class 41 targeted at providers within the restaurant industry, while the restaurant services themselves are consumed by the general public. Although the general public will benefit from the personnel serving them being well-trained, the services are different in nature, method of employ and purpose, and each will be sourced through distinct channels of trade. Neither, as per *Boston Scientific,* are they complementary in a trade mark sense. In my view, it is unlikely that the average consumer would expect the opponent's "*restaurant services*" in Class 43 and the applicant's "*Training relating to the restaurant industry"* in class 41 to be provided by the same undertaking. Considered overall, I find the services to be dissimilar.

[4] At [49-62].

The contested services in class 43

Catering (Food and drink -); Catering for the provision of food and beverages; Catering for the provision of food and drink; Catering in fast-food cafeterias; Catering of food and drink; Catering of food and drinks; Catering services; Catering services for company cafeterias; Catering services for conference centers; Catering services for educational establishments; Catering services for hospitality suites; Catering services for hospitals; Catering services for nursing homes; Catering services for providing European-style cuisine; Catering services for providing Japanese cuisine; Catering services for providing Spanish cuisine; Catering services for retirement homes; Catering services for schools; Catering services for the provision of food; Catering services for the provision of food and drink; Catering services specialised in cutting ham by hand, for fairs, tastings and public events; Catering services specialised in cutting ham by hand, for weddings and private events; Catering services specialising in cutting ham for fairs, tastings and public events; Catering services specialising in cutting ham for weddings and private events; Business catering services; Charitable services, namely providing food and drink catering; Food and drink catering; Food and drink catering for banquets; Food and drink catering for cocktail parties; Food and drink catering for institutions; Hotel catering services; Mobile catering; Mobile catering services; Office catering services for the provision of coffee; Organisation of catering for birthday parties; Outside catering; Outside catering services; Providing food and drink catering services for convention facilities; Providing food and drink catering services for exhibition facilities; Providing food and drink catering services for fair and exhibition facilities; Bar and restaurant services; Carry-out restaurants; Carvery restaurant services; Delicatessens [restaurants]; Fast food restaurants; Fast-food restaurant services; Grill restaurants; Hotel restaurant services; Japanese restaurant services; Mobile restaurant services; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Providing restaurant services; Provision of food and drink in restaurants; Ramen restaurant services; Salad bars [restaurant services]; Self-service restaurant services; Self-service restaurants; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Spanish restaurant services; Sushi restaurant services; Take-out restaurant services; Tempura restaurant services; Tourist restaurants; Restaurant and bar services; Restaurant services; Restaurant

services for the provision of fast food; Restaurant services incorporating licensed bar facilities; Restaurant services provided by hotels; Restaurants; Restaurants (Self-service -).

21. Given that the essential purpose of a restaurant or a bar is to provide food and/or drink, and the term "catering" also refers to a service which provides food and drink, I consider that all of the applicant's above services are encompassed by the opponent's broad term "*the provision of food and drink"*, rendering them identical as per the principle outlined in *Meric*.

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

22. These services are all covered by the opponent's broad term "*reservation services for booking meals"* and are therefore identical as per *Meric*.

Consultancy services in the field of food and drink catering; Providing information about restaurant services; Provision of information relating to restaurants; Restaurant information services.

23. The applicant's services are either self-evidently identical to, or encompassed by, the opponent's "*the provision of food and drink; restaurant services; information, advisory and consultancy services relating to all the foregoing"*.

Providing reviews of restaurants; Providing reviews of restaurants and bars.

24. Given the nature of the applicant's above services, I would expect them 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 "*bars, wine bars and cocktail lounge services provided within a hotel; restaurant services"*, the essential nature and purpose of the services are different, as are the channels of trade and methods of employ. 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. Overall, I find the services to be dissimilar.

Rental of catering equipment.

25. The applicant's services are broad but would most likely include the rental of cooking equipment in which to prepare food and drink, as well as storage and display equipment. As such, the services are different in nature, purpose and method of use to the opponent's "*provision of food and drink".* As per *Commercy*, the respective services are targeted at different users, the applicant's services being predominantly directed towards providers of food and drink, while the opponent's services are directed at the public consuming the food and drink. The services are sourced through different trade channels and are not considered complementary to the extent that the average consumer would automatically expect them to come from the same undertaking. Even allowing that some catering businesses providing food and drink also offer the rental of glassware, crockery and cutlery to the general public, this in itself is insufficient for a finding of similarity as the respective services are still different in nature, purpose and method of use. Overall, I consider the services to be dissimilar.

26. Under section 5(2)(b), a degree of similarity between the services is essential for there to be a finding of a likelihood of confusion: see paragraph 49 of *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA.

27. 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

28. 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].

29. The average consumer of the overlapping services will most likely be the general public. The consumer 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 not discount word of mouth recommendations or where the services are advertised orally, for example, via local radio.

30. The cost of the services will vary greatly, ranging from inexpensive for delivery services and the provision of fast food and the like, to relatively expensive for services which cater for special events such as birthdays and weddings or for the provision of fine dining experiences, with the services offered by many undertakings falling 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 following full consideration of the services being offered and the necessary requirements warranted by the particular occasion. Specific dietary requirements may also need to be considered as part of the selection process at all points along the spectrum, as will the physical location of premises and the facilities being offered.

31. Overall, I consider that the average consumer of each of the overlapping services will pay between an average to high degree of attention during the selection of those services.

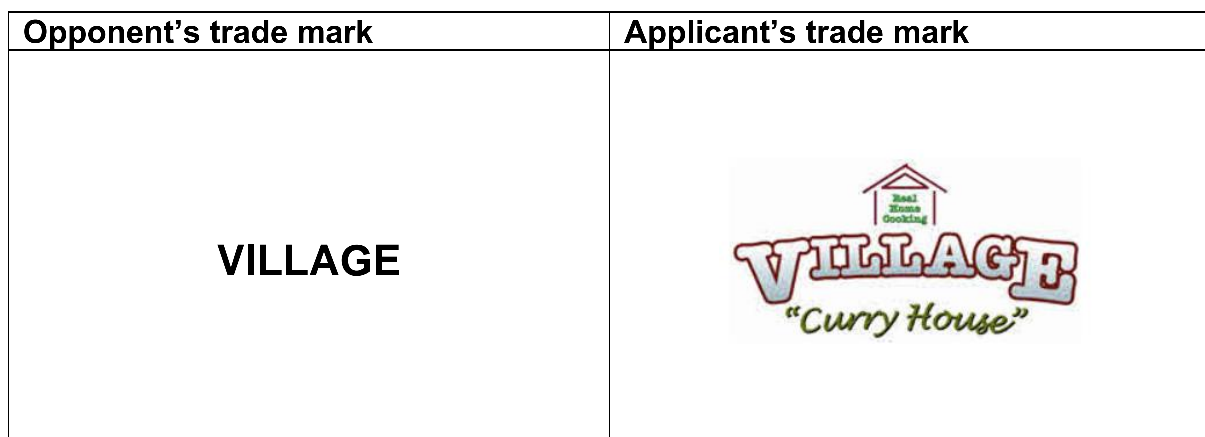
Comparison of marks

32. 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."

33. The respective trade marks are shown below:

Opponent's trade mark	**Applicant's trade mark**
VILLAGE	

Overall impression

34. The opponent's mark consists of the word "VILLAGE", 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.

35. The applicant's mark consists of the word "VILLAGE" presented in a relatively standard, burgundy outlined block script, with the letters being infilled in a white to grey shade graduated from top to bottom. While all the letters are presented in upper case, the first letter "V" and the last letter "E" are slightly larger than the remaining letters, with the word as a whole curved upwards from left to right. Positioned centrally above the word "VILLAGE" is a simplistic representation of a building with a pitched roof, and

within this device element are the words "Real Home Cooking", although due to their size, the words, which are presented in a green typeface, are indistinct. Positioned centrally below the word "VILLAGE" are the words "Curry House" in inverted commas, presented in a khaki-coloured cursive script in title case. I consider the words to be indicative of the type of fare being offered by the undertaking and are therefore non-distinctive in relation to food services offering curry as the principal cuisine. Returning to the device element, I note that in its counterstatement, the applicant submits that it is "a distinctive depiction of a house". To my mind, the device is likely to be perceived as alluding to a restaurant or given the other word element within the composite mark, colloquially, a "curry house", from which many of the services emanate, and is not particularly distinctive. Given the descriptive nature of the words within, coupled with their diminutive size, they will, in my view, be easily overlooked and contribute little to the overall impression of the mark. Accordingly, I consider that it is the word "VILLAGE" which dominates and makes the greatest contribution to the overall impression. For the services which clearly indicate other types of cuisine, such as the applicant's "*Carvery restaurant services*" and "*Spanish restaurant services*", I consider that the word "VILLAGE" would still make a greater contribution to the overall impression of the mark, with the words "Curry House" and the device element making a lesser contribution[5].

36. Although I accept that it is not always the case, I note that in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court ("GC") noted that the beginning of words tend to have more visual and aural impact than the ends.

Visual comparison

37. The competing marks share the identical word element "VILLAGE", and although this has been stylised in the applicant's mark as noted earlier in paragraph 35, I do not consider the stylisation to be particularly remarkable. I consider that the additional words "Real Home Cooking" in the applicant's mark would be easily overlooked although the device itself and the words "Curry House" would not go entirely unnoticed and thus create a visual disparity between the marks. The single word "VILLAGE" in

[5] See *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, at [37].

the opponent's mark is also the dominant element of the applicant's mark and the element to which the eye is drawn. Given that the opponent's mark in its entirety is incorporated within the applicant's mark, the difference in stylisation thereof notwithstanding, overall, I consider there to be a medium degree of visual similarity between the competing marks.

Aural comparison

38. Although the applicant's mark comprises three separate sets of word elements, realistically, given the diminutive size of the words "Real Home Cooking", I do not consider that they would be articulated. I acknowledge that just because words within a mark as a whole are descriptive, this does not automatically render them negligible or aurally invisible.[6] I accept that some consumers would not voice the words "Curry House" and as such, it is only the dominant word element "VILLAGE" which would be pronounced, rendering the applicant's mark aurally identical to the opponent's mark. To those consumers who also voice the "Curry House" element, the applicant's mark as a whole would be pronounced as five syllables, VILL-IDGE-KUH-REE-HOUSE, as opposed to the two syllables which make up the opponent's mark, VILL-IDGE. Taking into account the dominant "VILLAGE" element, which has the most impact at the start of the mark as per the guidance in *El Corte Inglés*, I find the marks to be aurally similar to a medium degree.

Conceptual comparison

39. With regard to conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, the GC held:

> "8. … In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the 'concepts' that the signs at issue convey. The term 'concept' means, according to the definition given, for example, by the Larousse dictionary, a 'general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the

[6] *Purity Hemp Company Improving Life as Nature Intended* decision, case BL O/115/22, at [31].

various perceptions which that person has of it and to organise knowledge about it."

40. The opponent submits that the marks share the conceptual meaning "a community of people", while the applicant's mark will also evoke "home cooking" and "curry" or "Indian cuisine" which it submits is purely descriptive of the various restaurant services covered in the application. As such, it submits that the marks are conceptually highly similar. The applicant submits that the opponent has artificially dissected the contested mark and has compared one feature of it in isolation with its own mark.

41. As per the case law outlined earlier in this decision under paragraph 32, while it would be wrong to artificially dissect the trade marks, 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. As noted in the previous paragraphs, I consider that it is the word "VILLAGE" which plays a dominant role in the context of the applicant's mark as a whole.

42. I consider that the average consumer would understand the dictionary-defined word "VILLAGE" to mean a small community of houses and other buildings, often located in a rural area. They will attribute the same meaning to the word on sight of both the opponent's and the applicant's marks, making this shared element conceptually identical. As found earlier in the decision, I consider the words "Real Home Cooking" in the applicant's mark will be easily overlooked, while the additional words "Curry House" merely convey the type of fare being offered. Consequently, I consider that the shared word "VILLAGE" renders the marks as a whole as being conceptually similar to a very high degree.

Distinctive character of the earlier marks

43. 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)."

44. 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/ or 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.

45. The opponent submits that the VILLAGE mark has no descriptive meaning in relation to the services for which it is registered. In its counterstatement, the applicant submits that the word VILLAGE in relation to the contested services is a non-distinctive term and that consumers will see the term VILLAGE as descriptive of, for example, a restaurant which is located within a village. With regard to the applicant's submissions, which must also apply in relation to the services registered under the earlier mark, I refer to *Formula One Licensing BV v OHIM,* Case C-196/11P where the CJEU held that a registered trade mark must be considered to possess at least some degree of distinctive character.[7]

[7] At [41 – 44].

46. The earlier mark comprises the single, dictionary-defined word "VILLAGE". While to some consumers this may be allusive of from where the services relied upon emanate, the mark does not specify which village that may be. Overall, I find the mark to be at the lower end of the spectrum of distinctiveness, although not of the very lowest degree.

Likelihood of confusion

47. 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]).

48. 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."

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

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

50. Earlier in this decision, I found:

- The contested services to range between identical as per the guidance outlined in *Meric*, to dissimilar;

- The level of attention paid by the general public as the average consumer of the overlapping services would be between an average to high degree;

- The services at issue would be selected by predominantly visual means, although I did not discount aural considerations;

- The competing trade marks to be visually similar to a medium degree and aurally similar to a medium degree in cases where the words ”VILLAGE” and “Curry House” were voiced in the applicant’s mark, although I accepted that the marks were aurally identical where only the shared “VILLAGE” element was voiced. I considered the marks overall to be conceptually similar to a very high degree due to the identity of the shared word “VILLAGE”;

- The earlier mark to be at the lower end of the spectrum of distinctiveness, although not of the very lowest degree.

51. Although the average consumer views the mark as a whole, case law also directs me to bear in mind the dominant and distinctive elements of the marks. In spite of the distinctive character of the earlier mark being at the lower end of the spectrum, I am mindful of the decision in *L’Oréal SA v OHIM*, Case C-235/05 P, in which the CJEU confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion.[8] Allowing for imperfect recollection, I consider the differences between the marks to be insufficient to avoid them being mistakenly recalled as each other. Given the dominance of the shared “VILLAGE” element, I consider that the average consumer will recall the word “VILLAGE” but will be less certain about the additional, non-distinctive elements present in the applicant’s mark. I take into account the degree of similarity between the respective services which offsets a lesser degree of similarity between the marks. I also 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.[9] Consequently, taking into account the consumer who pays an average degree of attention to the selection of the services, I consider that there is a likelihood of direct confusion in relation to those services for which identity or a degree of similarity was found.

[8] At [45].
[9] Case T-247/12, *Argo Group International Holdings Ltd. v OHIM*.

52. 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.

53. 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.

54. I bear in mind the various factors in my decision and the principle of interdependency between them, and I acknowledge the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*. I do not consider the common element to be so strikingly distinctive that the average consumer would assume that only the brand owner would be using it in a trade mark. However, I take into account the common element in the context of the applicant’s mark as a whole, with the opponent’s mark being encompassed in its entirety within the contested mark. I further acknowledge that the additional words and device element present within the applicant’s mark do little to diminish the conceptual similarity between the marks as a whole. I consider it reasonable that a significant proportion of the average consumer would make a connection between the marks, and that those consumers who notice the differences between them will conclude that they are attributable to either a brand refresh or are variant brands from the same, or economically connected, undertakings. Consequently, I consider there to be a likelihood of indirect confusion between the competing marks in relation to all services for which I found identity or similarity.

CONCLUSION

55. The opposition under section 5(2)(b) succeeds in respect of the following services:

Class 39 - *Delivery of food by restaurants.*

Class 43 - *Catering (Food and drink -); Catering for the provision of food and beverages; Catering for the provision of food and drink; Catering in fast-food cafeterias; Catering of food and drink; Catering of food and drinks; Catering services; Catering services for company cafeterias; Catering services for conference centers; Catering services for educational establishments; Catering services for hospitality suites; Catering services for hospitals; Catering services for nursing homes; Catering services for providing European-style cuisine; Catering services for providing Japanese cuisine; Catering services for providing Spanish cuisine; Catering services for retirement homes; Catering services for schools; Catering services for the provision of food; Catering services for the provision of food and drink; Catering services specialised in cutting ham by hand, for fairs, tastings and public events; Catering services specialised in cutting ham by hand, for weddings and private events; Catering services specialising in cutting ham for fairs, tastings and public events; Catering services specialising in cutting ham for weddings and private events; Business catering services; Charitable services, namely providing food and drink catering; Consultancy services in the field of food and drink catering; Food and drink catering; Food and drink catering for banquets; Food and drink catering for cocktail parties; Food and drink catering for institutions; Hotel catering services; Mobile catering; Mobile catering services; Office catering services for the provision of coffee; Organisation of catering for birthday parties; Outside catering; Outside catering services; Providing food and drink catering services for convention facilities; Providing food and drink catering services for exhibition facilities; Providing food and drink catering services for fair and exhibition facilities; Agency services for reservation of restaurants; Bar and restaurant services; Booking of restaurant seats; Carry-out restaurants; Carvery restaurant services; Delicatessens [restaurants]; Fast food restaurants; Fast-food restaurant services; Grill restaurants; Hotel restaurant services; Japanese restaurant services; Making reservations and bookings for restaurants and meals; Mobile restaurant services; Providing food and drink for guests in restaurants;*

Providing food and drink in restaurants and bars; Providing information about restaurant services; Providing restaurant services; Provision of food and drink in restaurants; Provision of information relating to restaurants; Ramen restaurant services; Reservation and booking services for restaurants and meals; Reservation of restaurants; Salad bars [restaurant services]; Self-service restaurant services; Self-service restaurants; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Spanish restaurant services; Sushi restaurant services; Take-out restaurant services; Tempura restaurant services; Tourist restaurants; Travel agency services for booking restaurants; Restaurant and bar services; Restaurant information services; Restaurant reservation services; Restaurant services; Restaurant services for the provision of fast food; Restaurant services incorporating licensed bar facilities; Restaurant services provided by hotels; Restaurants; Restaurants (Self-service -).

56. The applicant has been partially successful. Subject to any successful appeal, the application by Azher Baig may proceed to registration in respect of the following services only:

Class 41 - *Training relating to the restaurant industry.*

Class 43 - *Rental of catering equipment; Providing reviews of restaurants; Providing reviews of restaurants and bars.*

COSTS

57. 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") 2/2016, as was pertinent at the time the opposition proceedings were launched. I have made a 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 £600, which is calculated as follows:

Official fee[10]:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Preparing and filing written submissions:	£300
Total:	**£600**

58. I therefore order Azher Baig to pay VUR Village Trading No 1 Limited the sum of £600. 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 25th day of October 2024

Suzanne Hitchings
For the Registrar,
the Comptroller-General

[10] I note that the opponent paid an official fee of £200 to take into account the initial opposition under section 5(2)(b) and section 5(3) of the Act. As the opposition under section 5(3) was later withdrawn, I award the official fee of £100 to reflect the grounds of the opposition under section 5(2)(b) only.