O/1135/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003981289

IN THE NAME OF ADAS CATERING GROUP LIMITED

FOR THE TRADE MARK:

IN CLASSES 39 AND 43

AND OPPOSITION THERETO UNDER NO. 446187

BY GDK INTERNATIONAL LIMITED

BACKGROUND AND PLEADINGS

1. On 18 November 2023, ADAS Catering Group Limited ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 1 December 2023 and registration is sought for the following services:

Class 39 Food delivery services.

Class 43 Take-away food services.

2. On 1 March 2024, the application was opposed by GDK International Limited ("the opponent") based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under section 5(2)(b) and 5(3) of the Act, the opponent relies upon the following trade marks:

GDK
UKTM no. 3050740
Filing date 9 April 2014; registration date 22 August 2014
("the First Earlier Mark")

GDK
UKTM no. 913419361[1]
Filing date 30 October 2014; registration date 16 February 2015
("the Second Earlier Mark")

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EU trade mark ("EUTM"). As a result of the opponent having an EUTM being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original filing date.

(series of 4)

UKTM no. 3760522

Filing date 1 March 2022; registration date 27 May 2022

(“the Third Earlier Mark”)

(together “the earlier marks”)

3. The opponent relies upon all goods and services for which the earlier marks are registered, as set out in the Annex to this decision.

4. Under section 5(2)(b) of the Act, the opponent claims that the marks are similar, and the goods and services are identical or similar, with the result that there is a likelihood of confusion.

5. Under section 5(3) of the Act, the opponent claims to have a reputation for the goods/services listed in the Annex to this decision. The opponent claims that use of the applicant’s mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character and/or repute of the earlier marks.

6. Under section 5(4)(a) of the Act, the opponent relies upon signs identical to those for which the earlier marks are registered, which it claims to have used throughout the UK since 2016 in relation to: “services for providing food and drink; food preparation; restaurant services; fast-food restaurants; take away restaurants; carry-out restaurants; food-delivery services.” The opponent claims that use of the applicant’s mark would be contrary to the law of passing off.

7. The applicant filed a counterstatement denying the grounds of opposition.

8. No hearing was requested, and neither party filed written submissions in lieu.

REPRESENTATION

9. The applicant is self-represented.

10. The opponent is represented by Lincoln IP.

EVIDENCE AND SUBMISSIONS

11. The opponent filed evidence in chief in the form of the witness statement of Elaine McLardy dated 24 June 2024, which is accompanied by 17 exhibits (EM01 to EM17). Ms McLardy is the Commercial Operations Manager of the opponent, a position she has held since March 2020.

12. The applicant filed evidence in the form of the witness statement of Darius Vitenas dated 27 August 2024, which is accompanied by 3 exhibits (A1 to A3). Mr Vitenas is a Director of the applicant, a position he has held since 2023.

13. The opponent filed submissions in reply dated 28 October 2024.

RELEVANCE OF EU LAW

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

DECISION

15. Given the filing dates of the parties' respective marks, the earlier marks qualify as earlier trade marks under section 6 of the Act. The First and Second Earlier Marks had been registered for more than 5 years at the filing date for the applicant's mark. They are, therefore, subject to the use conditions contained within section 6A of the Act.

However, the applicant did not request proof of use and, consequently, the opponent can rely upon all of the services for which those marks are registered. The Third Earlier Mark is not subject to the use provisions of section 6A and the opponent can, therefore, also rely upon all of the goods and services for which that mark is registered.

Preliminary matter

16. The applicant's evidence focuses upon its use of the applied-for mark. This evidence is not relevant to the assessment under sections 5(2)(b) and 5(3) because I must conduct a notional assessment based upon all the ways in which the parties' respective marks could be used across the breadth of their specifications. There is potential for use of an applied-for mark to be relevant under section 5(4)(a) as, where an applicant commences use of their mark prior to filing the contested application, that use may establish an earlier relevant date for proving goodwill. However, in this case, Mr Vitenas states that the applicant did not start using the mark until December 2023 which is after the filing date of the contested mark. Consequently, that use cannot possibly establish an earlier relevant date under section 5(4)(a). As a result, the applicant's evidence is not of assistance in relation to any of the grounds of opposition.

Section 5(2)(b)

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

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

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

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

19. The following principles 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 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 wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

20. The full specifications relied upon by the opponent can be found in the Annex to this decision. I have included, in the table below, only those terms that I consider represent the opponent's best case. With that in mind, the competing services are as follows:

Opponent's services	**Applicant's services**
The First Earlier Mark Class 43 Services for providing food and drink; carry-out restaurants. **The Second Earlier Mark** Class 43 Services for providing food and drink. **The Third Earlier Mark** Class 43 Services for providing food and drink; carry-out restaurants.	Class 39 Food delivery services. Class 43 Take-away food services.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the General Court stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

22. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, 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."

23. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

<u>Class 39</u>

24. The applicant's services in this class are food delivery services, which are likely to be provided by specialist delivery businesses or by restaurants themselves. Consequently, there will be an overlap in trade channels with the opponent's "services for providing food and drink". Similarly, it is not uncommon for restaurants to offer a

take-away service where customers attend the restaurant to pick up their food order (as represented by the opponent’s term “carry-out restaurants”) and a delivery service by which the food is delivered to the customer’s home. Clearly, there is an overlap in trade channels and users. The method of use and nature of the services will differ to the extent that one is a delivery service and the other a restaurant at which the customer would physically attend. The purpose of the services is the same i.e. to provide food to the customer. As a result, there is clear competition. In my view, these services are highly similar.

Class 43

25. In my view, the term “take-away food services” in the applicant’s specification is synonymous with “carry-out restaurants” in the specifications of the First and Third Earlier Marks. They are, therefore, self-evidently identical. This term also falls within the broader category of “services for providing food and drink” in the specifications of the earlier marks; they are, therefore, identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

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

27. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

> “60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

> "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

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

29. The services are likely to be purchased following perusal of signage on physical premises, websites and on advertisements. Consequently, visual considerations will dominate the purchasing process. However, I do not discount an aural component to the purchase, given that word-of-mouth recommendations may be made.

Comparison of trade marks

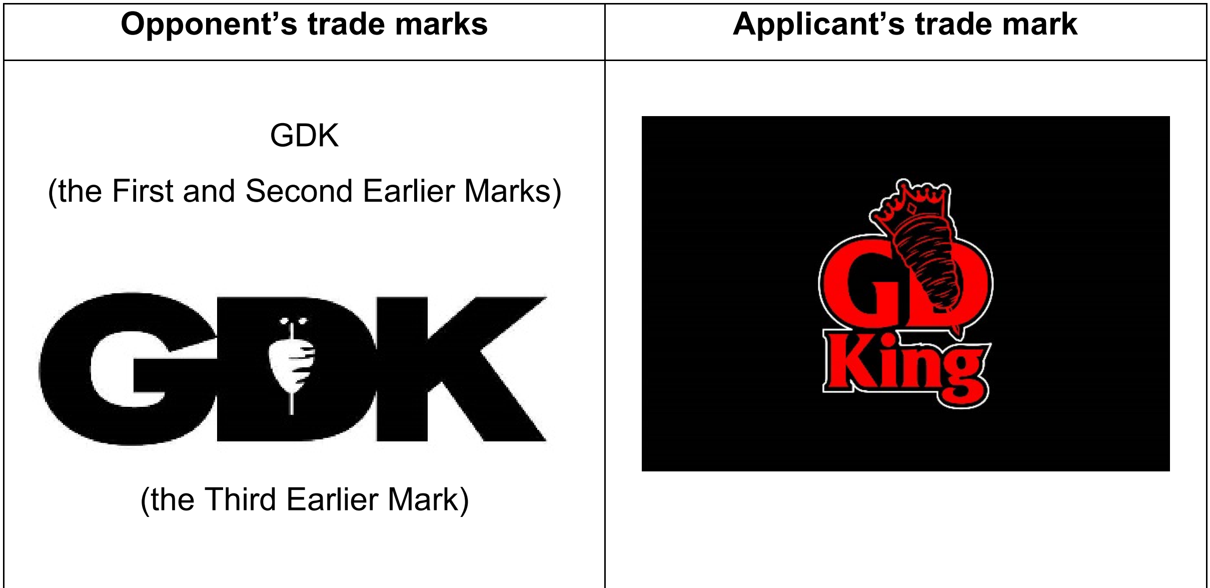
30. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impression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

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

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

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

32. The Third Earlier Mark consists of a series of four trade marks, which are all essentially the same mark presented in different colourways. One of these marks is presented in black and white and could, therefore, be used in any colour. Consequently, I will use that mark for the purposes of my comparison, as it represents the opponent's best case. With that in mind, the parties' respective trade marks are shown below:



Opponent's trade marks	Applicant's trade mark
GDK (the First and Second Earlier Marks) GDK (the Third Earlier Mark)	GD King

Overall Impression

33. The First and Second Earlier Marks consist of the letters GDK. There are no other elements to contribute to the overall impression, which resides in this string of letters.

34. The Third Earlier Mark consists of the same three letters, presented in a slightly stylised font. There is a device in the middle of the letter D. The eye is naturally drawn to the element of the mark that can be read, which is the letters GDK. However, the device also contributes to the overall impression, albeit to a lesser degree.

35. The applicant's mark consists of the letters GD above the word KING, all being presented in a slightly stylised red font with a black and white outline. There is a device

presented through the letter D. All of this is presented on a rectangular black background. In my view, the letter/word combination plays the greater role in the overall impression, with the device playing a slightly lesser role (although it certainly carries some weight given its size). The use of colour and background play a much lesser role.

Visual Comparison

36. The First and Second Earlier Marks and the applicant's mark coincide in the letters GD. They also coincide in the letter K, although this letter only appears in the applicant's mark as part of the word KING. The device and presentation of the letters above the word KING in the applicant's mark are also points of visual difference. I bear in mind that the First and Second Earlier Marks are word only and could be used in any font or colour. In my view, the marks are visually similar to between a low and medium degree.

37. The same is true of the comparison with the Third Earlier Mark. I note that the marks are presented in different fonts, but neither are particularly striking. The marks also both share a similar shaped device through the middle of the letter D, which is a point of similarity. I bear in mind that the Third Earlier Mark is registered in black and white and could, therefore, be used in any colour. In my view, the marks are visually similar to between a medium and high degree.

Aural Comparison

38. The same aural comparison will apply for all of the earlier marks, as the device element in the Third Earlier Mark will not be articulated. Clearly, the letters G and D will be pronounced identically in all of the marks. However, the letter K, when pronounced on its own in the earlier marks will be pronounced KAY (as in "hay"), whereas it will sound somewhat different when used as part of the word KING. In my view, the marks are aurally similar to a medium degree.

Conceptual Comparison

39. The parties appear to agree that the letters GDK will be known by the average consumer as meaning "German Doner Kebab". The applicant alleges that the letters/words GDKing will be understood as "German Doner King". If that is correct, then there will clearly be conceptual similarity between the marks. If not, then the elements GD/GDK will be conceptually neutral. However, I recognise that the word KING in the applicant's mark will be a point of conceptual difference in either scenario.

40. The same is true of the comparison with the Third Earlier Mark. I find that a significant proportion of average consumers will recognise the device in each mark as representing a kebab. This will, therefore, be an additional point of conceptual similarity.

My Approach

41. As I have found the Third Earlier Mark to represent the opponent's best case, I will consider the opposition based upon this mark in the first instance, returning to the First and Second Earlier Marks only if it is necessary to do so.

Distinctive character of the Third Earlier Mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, paragraph 49).

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

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

44. The Third Earlier Mark consists of the letters GDK in a slightly stylised font with a device incorporated into the letter D. I bear in mind that both parties appear to agree that the letters GDK will be understood by the average consumer as being an acronym for "German Doner Kebab". In the context of the services in issue, that is unlikely to be a particularly distinctive acronym. However, bearing in mind the particular presentation of those letters, with the kebab device incorporated as part of the letter D, I consider the Third Earlier Mark to be inherently distinctive to a medium (or average) degree.

45. Ms McLardy gives evidence as to the opponent's use of the mark in the UK, which she states commenced in July 2015. The opponent operates GERMAN DONER KEBAB stores in the UK, which Ms McLardy states are commonly known by the abbreviation GDK (often used in the style of the Third Earlier Mark). I bear in mind that a previous logo was in use by the opponent when it first started operating in the UK (being a different stylised version of the letters GDK), but certainly by 2021 the Third

Earlier Mark was in use.[2] The opponent has made the following sales via its UK stores (figures approximated):

2019 £42million
2020 £71million
2021 £120million
2022 £169million
2023 £177million[3]

46. The opponent has also invested significantly in advertising its stores in the UK, with the following amounts having been spent (again, amounts are approximated):

2018 £800,000
2019 £1.4million
2020 £1.5million
2021 £6.2million
2022 £4.4million
2023 £4million[4]

47. Ms McLardy has given examples of the opponent's promotional activities, which include the following:

a. In the years 2021, 2022 and 2023 the opponent partnered with Wireless Festival and created the "Wireless Boss Box" to mark this partnership, which went on sale in all UK restaurants in the lead up to the festival. The opponent sold just short of 300,000 units of this product and the associated media campaign had a reach of 21 million. A competition run by the opponent to win tickets to the event had around 90,000 entries.

[2] Exhibit EM7
[3] I bear in mind that the relevant date is in November 2023, so whilst not all of these sales will have taken place prior to that date, the majority are likely to have been.
[4] Again, given that the relevant date falls in November 2023, a significant proportion of this investment is likely to have taken place prior to the relevant date.

b. In 2021, the opponent ran an advertising campaign in collaboration with Doritos, which involved the development of a new menu item. The Third Earlier Mark is visible on the opponent's social media posts associated with this advertising campaign.[5] This was selected as one of the top 10 advertising campaigns of 2021 by TikTok and had a social reach of 3.5million in 6 weeks.

48. Ms McLardy states that the opponent's GDK brand has over 213,000 social media followers in the UK. It was listed as one of the top 5 "Most Loved Eating Out brands" in the UK by a data and market research company.[6]

49. It is clear from this evidence that the letters GDK have been used consistently in the UK (either in word format or in a stylised logo that differs to the Third Earlier Mark). However, the evidence suggests that the Third Earlier Mark has not been used for the duration of the opponent's activities in the UK, but has been used more recently (since at least 2021). However, given the scale of the opponent's business, I am satisfied that it has also acquired enhanced distinctiveness through use in relation to services for providing food and drink. In my view, the distinctiveness of the Third Earlier Mark has been enhanced to a high degree.

Likelihood of confusion

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

[5] Exhibit EM7
[6] Exhibit EM13

for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

51. I have found as follows:

a. The services are either identical or highly similar.

b. The average consumer for the services is a member of the general public who will pay a medium degree of attention during the purchasing process.

c. The purchasing process is predominantly visual, although I do not discount an aural component.

d. The Third Earlier Mark and the application are visually similar to between a medium and high degree and aurally similar to a medium degree. There is some conceptual similarity between the marks, although the word KING in the applicant's mark is a point of conceptual difference.

e. The Third Earlier Mark is inherently distinctive to a medium degree, which has been enhanced through use to a high degree for services for providing food and drink.

52. In my view, given the similarities between the marks, they are likely to be mistakenly recalled or misremembered as each other. This is particularly the case given that the average consumer tends to see what he expects to see. When taking account of the fact that the distinctiveness of the Third Earlier Mark has been enhanced to a high degree through use in relation to the relevant services, the average consumer may see the letters GDK, in combination with the kebab device incorporated into the letter D and jump to the conclusion that it is the opponent's mark that they are encountering.[7] As such, I find there to be a likelihood of direct confusion.

[7] *Kennedy Fried Chicken*, Case BL O/227/04

53. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

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

54. In my view, even if the different word/letter, "K" vs "King", are identified by the average consumer, the common use of a similar kebab device incorporated into the letter D, as part of a mark which uses the letters GDK, is likely to be viewed as indicating a mark being used by the same or economically linked undertakings. If the average consumer is not familiar with the meaning of GDK as "German Doner Kebab" then they are likely to view the letter K as standing for KING which would result in them viewing the applicant's mark as an extended version of the opponent's mark. Alternatively, if they are familiar with the meaning of GDK as "German Doner Kebab" then they are likely to view the letter K as having a double meaning (i.e. kebab and king), perhaps alluding to prestige. I am fortified in this finding by the fact that there is evidence that one of the opponent's promotional activities prior to the relevant date involves the sponsorship of a boxer who they describe as the "GDK King" in their social media post about his success.[8] This is posted from the opponent's UK social media account, and the Third Earlier Mark is clearly visible. Against this context, and in light of Ms McLardy's evidence above regarding the number of social media followers that the opponent has in the UK, there appears to me to be force in the argument that a significant proportion of average consumers are likely to consider that the applicant's mark originates from the opponent. I find there to be a likelihood of indirect confusion.

55. The opposition based upon section 5(2)(b) of the Act succeeds in its entirety.

<u>Section 5(3)</u>

56. Section 5(3) of the Act states:

"5(3) A trade mark which -

[8] Exhibit EM9

(a) is identical with or similar to an earlier trade mark, […] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

57. Section 5(3A) of the Act states:

"Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

58. Again, I will consider this ground based upon the Third Earlier Mark only in the first instance, as it represents the opponent's best case.

59. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L'Oreal v Bellure and Case C-323/09, Marks and Spencer v Interflora and Case C383/12P, Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29 and Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks

and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40.*

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in

order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

60. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the Third Earlier Mark and the application are similar. Secondly, the opponent must show that the Third Earlier Mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the Third Earlier Mark being brought to mind by the later mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

61. In *General Motors,* Case C-375/97, the CJEU held that:

"25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market

share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State‘. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout‘ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

62. In determining whether the opponent has demonstrated a reputation for the services relied upon, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with those services. In reaching this decision, I must take into account all of the evidence including “the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertaking in promoting it”.

63. Whilst I recognise that there is a difference between the tests for reputation and enhanced distinctiveness, the factors relevant to both are the same. For the same reasons given above, I find that the opponent has a strong reputation in the UK for services for providing food and drink.

Link

64. As I noted above, my assessment of whether the public will make the required mental ‘link’ between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

The marks are visually similar to between a medium and high degree and aurally similar to a medium degree. There is some conceptual similarity between the marks, although the word KING in the applicant’s mark is a point of conceptual difference.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

The services are either identical or highly similar.

The average consumer is a member of the general public, who will pay a medium (or average) degree of attention during the purchasing process.

The strength of the earlier marks' reputation

The Third Earlier Mark has a strong reputation in the UK.

The degree of the earlier marks' distinctive character, whether inherent or acquired through use

The Third Earlier Mark is distinctive to a medium degree, which has been enhanced through use to a high degree for services of providing food and drink.

Whether there is a likelihood of confusion

I consider there to be a likelihood of direct and indirect confusion.

Conclusions on Link

65. Given the similarity between the marks and the respective services, I find that a link will be made between them, particularly given the strength of the opponent's reputation and the common use of the device within the letter D.

Damage

66. I must now consider whether any type of damage pleaded will arise.

Unfair Advantage

67. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

> "80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

68. In its Form TM7, the opponent states:

> "Use of the contested trade mark by the applicant will take advantage of the significant reputation and cachet which attaches to the opponent's trade marks. This significant reputation has been acquired, at least in part, as a result of the substantial investment made by the opponent in growing its brand in recent years. Use of the applicant's trade mark will increase the credibility and appeal of the applicant's goods and services to the general public. Use of the contested mark would essentially ride on the coattails of the opponent's reputed marks, with the applicant benefiting from the power of attraction, reputation and prestige of the opponent's earlier marks. Use of the mark applied for would free ride on the investment made by the opponent's earlier marks. Use of the mark applied for would free ride on the investment made by the opponent in promoting its mark and stimulate sales in goods and services to an extent which

is disproportionately high in comparison to investment. This would be unfair to the opponent, which has invested large sums in marketing its activities under the trade mark.

69. To the extent that the relevant public believe that the services of the applicant are the services of the opponent, there will plainly be unfair advantage. Further, there is evidence that the opponent has won awards for its services and has invested significant amounts in promotional activities. It is, therefore, clear that there is a likelihood that the applicant will gain an unfair advantage from use of its mark as a result of benefitting from the investment made by the opponent in promoting the Third Earlier Mark and from association with a business that has been recognised for its success.

70. As I have found unfair advantage, I do not need to consider the other pleaded heads of damage.

71. The opposition based upon section 5(3) of the Act succeeds in its entirety.

Final Remarks on 5(2) and 5(3)

72. As the oppositions under these grounds have succeeded in their entirety based upon the Third Earlier Mark, I do not need to consider the First and Second Earlier Marks in any further detail.

Section 5(4)(a)

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

> "5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -
>
> > a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)…

b) …

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark."

74. I can deal with this ground swiftly. I find that the opponent had a strong goodwill for services for providing food and drink at the relevant date (being the filing date of the applied-for mark). Whilst the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer", it has been acknowledged that they are unlikely to produce different outcomes in practice.[9] I find that to be the case here. There is plainly a likelihood of misrepresentation and damage, given the identical or similar fields of activity.

75. The opposition based upon section 5(4)(a) succeeds in its entirety.

CONCLUSION

76. The opposition is successful and, subject to any appeal, the application is refused.

COSTS

77. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of **£2,200**, calculated as follows:

Preparing a Notice of opposition and considering the Counterstatement	£450

[9] *Marks and Spencer PLC v Interflora* [2012] EWCA (Civ) 1501

Preparing evidence and considering the applicant’s evidence	£1,200
Preparing written submissions	£350
Official fee	£200
Total	**£2,200**

78. I therefore order ADAS Catering Group Limited to pay GDK International Limited the sum of **£2,200**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 4th day of December 2025

S WILSON
For the Registrar

ANNEX

The First Earlier Mark

Class 43

Services for providing food and drink; food preparation; fast-food restaurants; restaurant services; hospitality service [food and drink]; food cooking services; catering of food and drink; offsite services for providing food and drink; catering services; delicatessens [restaurants]; grill restaurants; self-service restaurants; carry-out restaurants; snack-bars; salad bars; wine bars; wine bar services; restaurant services incorporating licensed bar facilities; provision of information relating to restaurants and bars; consultancy services in relation to food and drink preparation; rental of food service equipment; temporary accommodation.

The Second Earlier Mark

Class 43

Services for providing food and drink; Temporary accommodation.

The Third Earlier Mark

Class 29

Meat, fish, seafood, poultry and game; prepared meals containing meat, fish, seafood, poultry and game; chicken; lamb; beef; mutton; minced and ground meat; kebabs; burgers; prepared salad; potato salad; ready cooked meals consisting primarily of meat and vegetables; preserves; pickles; soups; lentils; falafel; dips; dairy products; cheese; cheese dips; yoghurt; eggs and egg based dishes; meat-based snack foods; vegetable based snack food; chips and french fries; fritters; snacks prepared from chickpeas and pulses; potato products; breaded and fried meat and vegetables; onion rings; vegetables (prepared); cooked vegetables; pre-cut vegetables for salad; fruit snacks; fruit desserts; fruit salads; frozen and chilled meals consisting primarily of meat and vegetables; frozen and chilled prepared meals consisting primarily of kebab or burger.

Class 30

Bread; rice; pasta; sandwiches and wrap sandwiches; tortillas; quesadillas; naan bread; burgers contained in bread rolls; beef burger sandwiches; pitta bread; pizzas;

pies; flatbreads; nachos; breadcrumbs; spices; dried herbs; spicy sauces; garlic sauce; spring rolls; burger sauces; spice rubs; cheese sauce; cheese balls (snacks); pizza sauce; curry sauce and mixes; marinades; salad sauces; salsa; salad dressing; seasonings; chutneys; couscous; natural sweeteners; flavourings (not essential oils); condiments; salt; pepper; ketchup; flour and preparations made from cereals; pastry; confectionery; biscuits; cakes; cereals; ready to eat cereals; breakfast cereals; snack bars containing grains, nuts and dried fruit; gravy.

Class 43

Services for providing food and drink; food preparation; fast-food restaurants; restaurant services; hospitality services [food and drink]; food cooking services; catering of food and drink; offsite services for providing food and drink; catering services; delicatessens [restaurants]; grill restaurants; self-service restaurants; carry-out restaurants; snack-bars; salad bars; wine bars; wine bar services; restaurant services incorporating licensed bar facilities; provision of information relating to restaurants and bars; consultancy services in relation to food and drink preparation; rental of food service equipment.