o/1175/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3881670

BY NOMAS GASTROBAR LTD

TO REGISTER THE TRADE MARK:

NOMAS GASTROBAR

IN CLASS 43

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 441231

BY NOMA AF 2003 ApS

Background and pleadings

1. On 23 February 2023, nomas gastrobar ltd ("the applicant") applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 10 March 2023. The services applied for are as follows:

> Class 43: Cafe services; Café services; Cafés; Coffee shops; Coffee shop services; Serving food and drink in Internet cafes; Restaurant and bar services; Bar and restaurant services; Ramen restaurant services; Providing food and drink in Internet cafes; Bistro services; Take-away restaurant services; Coffee bar services; Salad bars [restaurant services]; Serving food and drink in doughnut shops; Carvery restaurant services; Fast-food restaurant services; Hotel restaurant services; Self-service restaurant services; Providing food and drink in doughnut shops; Take-out restaurant services; Restaurant services; Restaurants (Self-service -); Self-service restaurants; Serving food and drink in restaurants and bars; Mobile restaurant services; Brasserie services; Restaurant services incorporating licensed bar facilities; Hookah lounge services; Catering in fast-food cafeterias; Snack bar services; Providing food and drink in restaurants and bars; Providing food and drink in bistros; Eateries; Tourist restaurants; Delicatessens [restaurants]; Cocktail lounge buffets; Restaurants; Provision of food and drink in restaurants; Office catering services for the provision of coffee; Hookah bar services; Serving food and drink for guests in restaurants; Restaurant reservation services; Self-service cafeteria services; Restaurant services for the provision of fast food; Take-away food and drink services; Booking of restaurant seats; Lounge services (Cocktail -); Cocktail lounge services; Catering of food and drinks; Grill restaurants; Takeaway food and drink services; Catering (Food and drink -); Food and drink catering; Catering of food and drink; Carry-out restaurants; Providing food and drink for guests in restaurants.

2. The application was opposed in full by NOMA AF 2003 ApS ("the opponent") on 7 June 2023. The opposition is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act").

3. The opponent relies on the following trade mark:

UK909871641

noma

Filing date: 6 April 2011
Registration date: 2 February 2012

Relying on all of its goods and services for the claim under section 5(2)(b) as follows:

> Class 16: Cookery books.
>
> Class 41: Education; providing of training; entertainment; sporting and cultural activities; all the aforesaid only relating to gastronomy.
>
> Class 43: Services for providing food and drink; temporary accommodation.

4. In relation to the claim under section 5(3), the opponent relies solely on 'services for providing food and drinks' from class 43.

5. The opponent claims that the marks are highly similar and the goods and services are identical or highly similar under the section 5(2)(b) claim and for the section 5(3) claim, it states that it has an extensive reputation in the UK and around the world and has used its mark substantially and promoted it since 2003. It states that use of the applied for mark will unfairly trade off their reputation and prestige whilst exploiting their marketing effort. Further, it claims that their reputation could be tarnished and might suffer a reduction of uniqueness and distinctiveness of their own mark.

6. The applicant has denied the claims made.

7. The applicant is representing themselves and the opponent is represented by Forresters IP LLP.

8. Both parties filed evidence. Neither party requested a hearing but the opponent filed submissions in lieu. This decision is therefore taken following careful consideration of the papers.

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.

Evidence

10. The opponent provided a witness statement from Mark Bhandal, a Chartered Trade Mark Attorney and senior associate at Forresters IP LLP, dated 11 December 2023, together with 14 exhibits. The main purpose of the evidence is to show that the opponent has a reputation for their mark.

11. The applicant filed a witness statement dated 8 February 2024 from Antonios Norouznia who is the managing director of Nomas Gastrobar Limited. This was accompanied by 5 exhibits.

Decision

Section 5(2)(b)

12. Section 5(2)(b) is being relied upon and is as follows:

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

public, which includes the likelihood of association with the earlier trade mark".

13. 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."

14. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "6. (1) In this Act an "earlier trade mark" means –
>
> a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

15. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3, which qualifies as an earlier trade mark under the above provisions. The trade mark has completed its registration process more than 5 years before the filing date of the application; however, the applicant did not request for them to prove use of the mark. The opponent can, as a consequence, rely upon all of the goods and services it has identified.

Case law

16. 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 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) I 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 great degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods and services

17. 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".

18. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

19. In *Gérard Meric v Office for Harmonisation in the Internal Market* (OHIM) ('Meric'), Case T-133/05, the General Court ("the GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHI–M - 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".

20. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

Contested services	Opponent's goods and services
Class 43: Cafe services; Café services; Cafés; Coffee shops; Coffee shop services; Serving food and drink in Internet cafes; Restaurant and bar services; Bar and restaurant services; Ramen restaurant services; Providing food and drink in Internet cafes; Bistro services; Take-away restaurant services; Coffee bar services; Salad bars [restaurant services]; Serving food and drink in doughnut shops; Carvery restaurant services; Fast-food restaurant services; Hotel restaurant services; Self-service restaurant services; Providing food and drink in doughnut shops; Take-out restaurant services; Restaurant services; Restaurants (Self-service -); Self-service restaurants; Serving food and drink in restaurants and bars; Mobile restaurant services; Brasserie services; Restaurant services incorporating licensed bar facilities; Hookah lounge services; Catering in fast-food cafeterias; Snack bar services; Providing food and drink in restaurants and bars; Providing food and drink in bistros; Eateries; Tourist restaurants; Delicatessens [restaurants]; Cocktail lounge buffets; Restaurants; Provision of food and drink in restaurants; Office catering services for the provision of coffee; Hookah bar services; Serving food and drink for	Class 16: Cookery books. Class 41: Education; providing of training; entertainment; sporting and cultural activities; all of the aforesaid only relating to gastronomy. Class 43: Services for providing food and drink; temporary accommodation.

guests in restaurants; Restaurant reservation services; Self-service cafeteria services; Restaurant services for the provision of fast food; Take-away food and drink services; Booking of restaurant seats; Lounge services (Cocktail -); Cocktail lounge services; Catering of food and drinks; Grill restaurants; Takeaway food and drink services; Catering (Food and drink -); Food and drink catering; Catering of food and drink; Carry-out restaurants; Providing food and drink for guests in restaurants.	

Cafe services; Café services; Cafés; Coffee shops; Coffee shop services; Serving food and drink in Internet cafes; Restaurant and bar services; Bar and restaurant services; Ramen restaurant services; Providing food and drink in Internet cafes; Bistro services; Take-away restaurant services; Coffee bar services; Salad bars [restaurant services]; Serving food and drink in doughnut shops; Carvery restaurant services; Fast-food restaurant services; Hotel restaurant services; Self-service restaurant services; Providing food and drink in doughnut shops; Take-out restaurant services; Restaurant services; Restaurants (Self-service -); Self-service restaurants; Serving food and drink in restaurants and bars; Mobile restaurant services; Brasserie services; Restaurant services incorporating licensed bar facilities; Hookah lounge services; Catering in fast-food cafeterias; Snack bar services; Providing food and drink in restaurants and bars; Providing food and drink in bistros; Eateries; Tourist restaurants; Delicatessens [restaurants]; Cocktail lounge buffets; Restaurants; Provision of food and drink in restaurants; Office catering services for the provision of coffee; Hookah bar services; Serving food and drink for guests in restaurants; Self-service cafeteria services; Restaurant services for the provision of fast food; Take-away food and drink services; Lounge services (Cocktail -); Cocktail lounge services; Catering of food and drinks; Grill restaurants; Takeaway food and drink services; Catering (Food and drink -); Food

and drink catering; Catering of food and drink; Carry-out restaurants; Providing food and drink for guests in restaurants

21. I consider that the opponent's term from class 43 'services for providing food and drink' is very wide and would encompass all of the above contested services. Therefore, I consider them to be identical under the *Meric* principles.

Booking of restaurant seats; Restaurant reservation services

22. Given that restaurants are included within 'services for providing food and drink' I consider that those businesses are also likely to offer booking services. There is an overlap in user and I believe the services would be complementary. The purpose differs as does the nature. There is no overlap in trade channels and they are not complementary. I find the services similar to no more than a medium degree.

Average consumer and the purchasing act

23. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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.

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

25. In my view, the average consumer of the services at issue is a member of the general public although I do not discount that there could be business users as well. The purchasing process is likely to be dominated by visual considerations, as the average consumer is likely to select the services at issue following inspection of the premises frontage, websites and advertisements. However, given that word-of-mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services.

26. There is a varying degree of cost for the services at issue ranging from very low to high and the average consumer will be considering the type of food and drink provided and the nature of the establishment. I believe that, generally speaking, the average consumer will pay a medium degree of attention to the purchasing process.

Comparison of the marks

27. 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 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."

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

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

29. The respective trade marks are shown below:

Contested Mark	Opponent's Mark
NOMAS GASTROBAR	**noma**

30. The opponent's mark is a singular word mark and therefore, that is where the overall impression lies.

31. The contested mark is also a word mark; however, it consists of two words. I consider that 'GASTROBAR' is descriptive or allusive to the services covered by the applicant's specification (which I will explain further later in this decision) and therefore, I find the dominant and distinctive component of the mark is 'NOMAS' with 'GASTROBAR' playing a much smaller role.

32. Visually, the marks are identical for the first four letters, with the opponent's mark being wholly incorporated within the contested mark. However, I also acknowledge that the contested mark also contains a further letter 's' at the end of the first word together with the 9 letter word 'GASTROBAR' thereafter. I therefore consider the marks to be visually similar to a medium degree.

33. Next, I will consider the aural comparison. I have not been given any guidance on the pronunciations but consider that a significant proportion of consumers would pronounce the earlier mark as *no/mah*. For the contested mark, I consider that 'GASTROBAR' would be given its ordinary everyday pronunciation and that 'NOMAS'

would be said as *no/mass.* Therefore, the beginning of the marks would overlap aurally and the contested mark encompasses the whole of the opponent's but the ends would differ. I find that the marks are aurally similar to no more than a medium degree.

34. Conceptually, I believe the average consumer will view the earlier mark as an invented term. For the contested mark, the element 'NOMAS' will also be viewed as an invented term and thus the two invented terms are neither similar nor dissimilar conceptually. However, 'GASTROBAR' does have a particular conceptual message which is as a term that is used to denote bars which also serve food - a portmanteau of 'gastronomy' and 'bar'. This is a point of conceptual difference between the marks.

Distinctive Character of the Earlier Mark

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

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber* and *Attenberger* [1999] ECR I-0000, 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)."

36. 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. I have been provided with evidence of reputation by the opponent which I can use to consider whether the distinctiveness has been enhanced.

37. In order to do this, first I must consider the level of inherent distinctiveness the earlier mark has. 'Noma' appears to be an invented term, as I have stated above. It does not appear to have any link or allusiveness to the goods and services registered. I therefore consider it to be inherently distinctive to a high degree.

38. It is the UK market that is relevant to an assessment of enhanced distinctiveness. The opponent has not provided me with any sales figures or details of their market within the UK. I note that at paragraph 15 of the Witness Statement of Mr Bhandal, he claims that NOMA has a "truly international appeal with customers booking from around the world (including the UK)" but I have no numbers regarding those bookings to assist me in making a finding. Further, I note the evidence at Exhibit MPB09 showing a pop-up restaurant in London; however, this was only in place for one day- 10 September 2023 and again I have no information on the turnover or number of bookings. Therefore, I find that the opponent has not shown enhanced distinctiveness in the UK market and so the distinctive character of the mark remains at its inherent level.

Likelihood of confusion

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible

undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

40. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found 'NOMAS' is the dominant and distinctive element of the contested mark, with 'GASTROBAR' being descriptive or allusive and therefore playing a much smaller role. With the earlier mark, the overall impression lies in the word 'noma' as that is the only element.
- I have found the marks to be visually similar to a medium degree.
- I have found the marks to be aurally similar to no more than a medium degree and conceptually dissimilar.
- I have found the earlier mark to be inherently distinctive to a high degree.
- I believe the average consumer for the goods and services to be a member of the general public or a business. The purchasing process is likely to be predominantly visual.
- I have concluded that a medium level of attention will be paid during the purchasing process.
- The services at issue are identical or similar to no more than a medium degree.

41. The earlier mark is wholly replicated within the contested mark, and the marks are visually similar to a medium degree and aurally similar to no more than a medium degree. I am satisfied that the average consumer paying a medium degree of attention is unlikely to recall the marks accurately and may not remember the additional 'S' in

the contested mark and might overlook the word ‘GASTROBAR’ due to it being descriptive/allusive. They are likely to mistake one mark for the other even where there is no particular concept to link the marks together. Consequently, I find there to be a likelihood of direct confusion between the marks.

42. In the event that I am wrong in finding there to be a likelihood of direct confusion, I will now go on to consider whether there could be indirect confusion. Mr Iain Purvis Q.C. said further in *L.A. Sugar Limited v Back Beat Inc*:

> “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).”

43. These examples are not exhaustive but provide helpful focus, as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

> "This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition."[1]

44. In the case of indirect confusion, the average consumer has noticed differences between the marks but still believes them to be linked. I believe the average consumer might imperfectly recall the 'NOMA/NOMAS' element and believe the presence of 'GASTROBAR' to be a brand extension, brand evolution or sub-brand due to its lower distinctiveness and being descriptive/allusive of the services. I therefore consider that indirect confusion is likely to occur in respect of all the services applied for.

Section 5(3)

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

> "5(3) A trade mark which –
>
> > (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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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."

46. 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 mark is protected."

[1] Paragraph 12

47. 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*).

48. The conditions of section 5(3) are cumulative. Firstly, the opponent's and applicant's marks must be similar or identical. Secondly the opponent must show that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have 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 earlier mark being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3)

requires that one or more types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the services 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.

49. The relevant date for the assessment under section 5(3) is the date of application i.e. 23 February 2023.

Reputation

50. 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."

51. In determining whether the opponent has demonstrated a reputation for the class 43 services, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the services. In reaching this decision, I

must take all of the evidence into account 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 undertakings in promoting it."

52. The earlier mark is a comparable mark. This means that Paragraph 10 of Schedule 2A of the Act is relevant. It reads as follows:

> "(1) Sections 5 and 10 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.
>
> (2) Where the reputation of a comparable trade mark (EU) falls to be considered in respect of any time before IP completion day, references in sections 5(3) and 10(3) to-
>
> > (a) the reputation of the mark are to be treated as references to the reputation of the corresponding EUTM; and
> >
> > (b) the United Kingdom include the European Union."

53. The majority of the opponent's evidence focuses on the awards that the restaurant has won, such as the following list from Wikipedia:

The World's 50 Best Restaurants, *Restaurant*

- 2006: 33rd Best Restaurant in the World
- 2007: 15th Best Restaurant in the World
- 2008: 10th Best Restaurant in the World
- 2009: 3rd Best Restaurant in the World
- 2009: Chefs' Choice
- 2010: Best Restaurant in the World
- 2011: Best Restaurant in the World
- 2012: Best Restaurant in the World
- 2013: 2nd Best Restaurant in the World
- 2014: Best Restaurant in the World
- 2015: 3rd Best Restaurant in the World
- 2016: 5th Best Restaurant in the World
- 2021: Best Restaurant in the World

54. They have also provided details as to its three Michelin stars and shown a screenshot of their entry on the Michelin website at Exhibit MPB06.

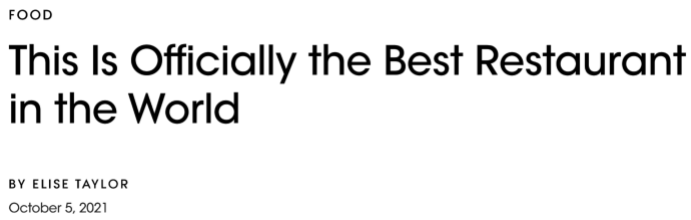
55. The opponent provided extracts from articles in The Guardian and Vogue both from October 2021.

Restaurants

This article is more than **2 years old**

Noma wins world's best restaurant as Denmark claims top two spots

Chef René Redzepi, famed for foraging techniques, claims first place for Copenhagen eatery



FOOD

This Is Officially the Best Restaurant in the World

BY ELISE TAYLOR
October 5, 2021

56. Exhibits MPB07 and MPB08 focus on the pop up restaurants run by the opponent. Firstly, there is a reference to a seven week pop up in Mexico – which falls outside of the relevant territories for the purposes of this decision. The same applies to the pop up in Kyoto. In an event, whilst a price point is mentioned in both exhibits for these pop up experiences, there is no indication as to how many bookings were available or how many customers were served during these pop ups. Although Exhibit MPB09 refers to the one day pop up in London which obviously is to be taken into account for reputational purposes, however, the same criticisms apply: no information is given as to the number of customers served that day or any indication of turnover on an already very short time period.

57. The opponent has not provided me with any evidence as to the market share, intensity or size of investment made in promoting its mark. I do not have any turnover figures, no indication of the number of diners they have served nor any length of a waitlist that might be expected for a fine dining situation. Geographically, there is one main restaurant which is in Copenhagen and there has been one pop up location within the UK for one day so the geographical extent is very limited.

58. I note in the case of *Azumi Limited v Zuma's Choice Pet Products Limited, Ms Zoe Vanderbilt* [2017] EWHC 609 (IPEC*)* that reputation was found for a high-end single premises restaurant which had won several awards. However, in that case it appears that in evidence an entire bundle of press articles was provided along with many reviews and, importantly, details of turnover figures, market share and booking numbers. Whilst I understand that it is not always possible to provide evidence to 'tick every box' in these cases, I consider that the evidence that has been provided to me does not enable me to make a finding of reputation. Even in light of its awards and the two articles (which both come from a single month), there is nothing that shows me a wider knowledge of the mark. Consequently, the opposition based on section 5(3) falls at the first hurdle.

Conclusion

59. The opposition succeeds in its entirety under section 5(2)(b). The opposition under section 5(3) fails.

Costs

60. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023 as these proceedings commenced after 1 February 2023. I award the opponent the sum of **£1300**, calculated as follows:

Official fee	£100[2]
Preparing the Notice of opposition and considering the counterstatement	£250
Preparing evidence and considerin the other side's evidence	£600

[2] As the section 5(3) ground failed, there is no award of costs for this.

Preparing of submissions in lieu of a hearing	£350
Total	**£1300**

61. I therefore order nomas gastrobar ltd to pay NOMA AF 2003 ApS the sum of £1300. This sum should 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 13th day of December 2024

L Nicholas
For the Registrar