

O/852/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3636706

**IN THE NAME OF SOUL
FOOD INVESTMENTS
LTD**

**TO REGISTER THE FOLLOWING TRADE
MARK:**



IN CLASSES 35, 43 AND 45

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 426765**

BY SOUL HOLDINGS INC.

Background and pleadings

1. On 5 May 2021, Soul Food Investments Ltd ('the applicant') applied to register the trade mark shown on the front page of this decision. It was accepted and published in the Trade Marks Journal on 16 July 2021 in respect of the following services:

Class 35: Restaurant management for others; Business management of restaurants; Business advice relating to restaurant franchising; Business advisory services relating to the running of restaurants; On-line ordering services in the field of restaurant take-out and delivery; Business assistance relating to franchising; Business advice relating to franchising; Franchising services providing business assistance; Business advertising services relating to franchising; Franchising (Business advice relating to -); Franchising services providing marketing assistance; Franchising (Business advisory services relating to -); Business advisory services relating to franchising; Provision of business information relating to franchising; Business advice and consultancy relating to franchising; Business management advisory services relating to franchising; Advice in the running of establishments as franchises; Business assistance relating to the establishment of franchises; Providing assistance in the management of franchised businesses; Assistance in franchised commercial business management; Management advisory services related to franchising; Administration of the business affairs of franchises; Marketing services in the field of restaurants; Business management assistance in the operation of restaurants; Business management assistance in the establishment and operation of restaurants; Business advisory services relating to the setting up of restaurants; Advertising consultation; Management consulting; Business consulting.

Class 43: Restaurants; Restaurant services; Restaurant information services; Reservation of restaurants; Fast food restaurants; Hotel restaurant services; Take-out restaurant services; Fast-food restaurant services; Bar and restaurant services; Booking of restaurant seats; Restaurant and bar services; Providing reviews of restaurants; Providing information about restaurant services;

Restaurant services provided by hotels; Provision of food and drink in restaurants; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Making reservations and bookings for restaurants and meals; Reservation and booking services for restaurants and meals; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Restaurant services for the provision of fast food; Take away food services; Take-away food services; Take-away fast food services; Take away food and drink services; Take-away food and drink services.

Class 45: Licensing of franchise concepts; Consultancy services relating to the legal aspects of franchising.

2. On 10 September 2021, Soul Food Investments Ltd (“the opponent”) filed a notice of opposition against the application. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the applied for services. This is on the basis of its earlier rights, the details of which are set out below:

Earlier Mark	Registration no.	Filing/Registration date	Services relied upon
SOUL FOODS (Mark 1)	UK00003209807	31 January 2017 16 June 2017	Class 35: Management of franchised restaurants; business management of franchised restaurants.
SOUL RESTAURANTS (Mark 2)	UK00003209805	31 January 2017 24 April 2017	Class 35: Management of franchised restaurants; business management of franchised restaurants. Class 43: Café restaurants; cafés; restaurant services.
SOUL COFFEE HOUSE (Mark 3)	UK00003209809	31 January 2017 26 May 2017	Class 35: Management of franchised restaurants; business management of franchised restaurants. Class 43: Café restaurants; cafés; restaurant services.

3. By virtue of their earlier filing dates, the opponent's trade marks constitute earlier marks, in accordance with section 6 of the Act.

4. In its notice of opposition, the opponent contends that the distinctive elements of the applicant's mark are visually, conceptually and aurally similar to the opponent's marks and the applied for services are either identical or highly similar to the opponent's services, giving rise to a likelihood of confusion. The opponent also submits that as a result of its family of SOUL marks, the opponent has enhanced the distinctiveness of SOUL, increasing the likelihood of confusion with other SOUL marks.

5. The applicant filed a counterstatement, denying all the claims made by the opponent.

6. The opponent is represented in these proceedings by Blake Morgan LLP whereas the applicant has not appointed professional representation. Neither party filed evidence or submissions and neither party requested a hearing, nor did they file any written submissions in lieu. I now make this decision after careful consideration of the papers before me.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Preliminary Issue

8. The opponent has relied upon three earlier rights under Section 5(2)(b) and as previously outlined, they have also claimed that the three earlier marks constitute a family of marks.

9. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the Court of Justice of the European Union ("CJEU") stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to ‘marks in a series’.”

10. In order to establish its claim of a family of marks, the opponent must therefore demonstrate that its three earlier marks were present on the UK market at the relevant date. In this case, the opponent did not file any evidence of the same and as such, I find the opponent’s claim of a family of marks not to hold any relevance in this case.

Proof of Use

11. As the opponent’s marks have been registered for less than 5 years at the filing date of the application in issue, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the services it has identified.

DECISION

Section 5(2)(b)

12. Section 5(2)(b) of the Act 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. 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.

The principles:

- (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 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 Services

14. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

15. 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

16. The General Court (GC) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

17. Though expressed in reference to goods, the same principle also applies to services. For the purposes of considering the issue of similarity of goods or 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).

18. The services to be compared are as follows:

Opponent's Services	Applicant's Services
<p>(Marks 1, 2 & 3)</p> <p><i>Class 35: Management of franchised restaurants; business management of franchised restaurants.</i></p>	<p><i>Class 35: Restaurant management for others; Business management of restaurants; Business advice relating to restaurant franchising; Business advisory services relating to the running of restaurants; On-line ordering services in the field of restaurant take-out and delivery; Business assistance relating to franchising; Business advice relating to franchising; Franchising services providing business assistance; Business advertising services relating to franchising; Franchising (Business advice relating to -);Franchising services providing marketing assistance; Franchising (Business advisory services relating to -);Business advisory services relating to franchising; Provision of business information relating to franchising; Business advice and consultancy relating to franchising; Business management advisory services relating to franchising; Advice in the running of establishments as franchises; Business assistance relating to the establishment of franchises; Providing assistance in the management of franchised businesses; Assistance in franchised commercial business management; Management advisory services related to franchising; Administration of the business affairs of franchises; Marketing services in the field of restaurants; Business management assistance in the operation of restaurants; Business management assistance in the establishment and operation of restaurants; Business advisory services relating to the setting up of restaurants; Advertising consultation; Management consulting; Business consulting.</i></p>

<p>(Marks 2 & 3)</p> <p><i>Class 43: Café restaurants; cafés; restaurant services.</i></p>	<p><i>Class 43: Restaurants; Restaurant services; Restaurant information services; Reservation of restaurants; Fast food restaurants; Hotel restaurant services; Take-out restaurant services; Fast-food restaurant services; Bar and restaurant services; Booking of restaurant seats; Restaurant and bar services; Providing reviews of restaurants; Providing information about restaurant services; Restaurant services provided by hotels; Provision of food and drink in restaurants; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Making reservations and bookings for restaurants and meals; Reservation and booking services for restaurants and meals; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Restaurant services for the provision of fast food; Take away food services; Take-away food services; Take-away fast food services; Take away food and drink services; Take-away food and drink services.</i></p>
	<p><i>Class 45: Licensing of franchise concepts; Consultancy services relating to the legal aspects of franchising.</i></p>

The first earlier mark

Class 35 Services

Administration of the business affairs of franchises; Business management of restaurants

19. Both these terms broadly relate to the operation and management of franchises or restaurants. I find in both cases they would include the management of franchised restaurants and are therefore identical to *business management of franchised restaurants* in line with *Meric*.

Restaurant management for others; Providing assistance in the management of franchised businesses; Assistance in franchised commercial business management; Business management assistance in the operation of restaurants; Business management assistance in the establishment and operation of restaurants; Business assistance relating to franchising; Business assistance relating to the establishment of franchises; Franchising services providing business assistance

20. These services all relate to assisting others in business management in the field of restaurants or franchises. The opponent's *Management of franchised restaurants* may relate to management services provided by a third party or provided by a franchise company themselves to someone wishing to run a franchise restaurant. I therefore find that these services would encompass the above terms in the applicant's specification and would be identical on the principle outlined in *Meric*.

Business advice relating to restaurant franchising; Business advice relating to franchising; Franchising (Business advice relating to -); Franchising (Business advisory services relating to -); Business advisory services relating to franchising; Provision of business information relating to franchising; Business advice and consultancy relating to franchising; Business management advisory services relating to franchising; Advice in the running of establishments as franchises; Management advisory services related to franchising; Business advisory services relating to the running of restaurants; Business advisory services relating to the setting up of restaurants; Management consulting; Business consulting

21. The purpose of these services is not the management of a business itself but to provide advice about the management of a business, a franchise, or a restaurant. I consider there to be a general overlap in terms of nature to *business management of franchised restaurants* as all the applicant's services relate to the operation of franchises, restaurants, or businesses. Franchising is a well-known business model and I consider that some entities who facilitate *business management of franchised restaurants* would also provide advisory, information or consulting services to the franchisor. I also consider that the services would share a complementary relationship on the basis that the applicant's terms are all important and/or indispensable to the *business management of franchised restaurants* such that the average consumer may

be likely to think that they originate from the same undertaking¹. Overall, I find these goods to be similar to a high degree.

On-line ordering services in the field of restaurant take-out and delivery

22. I consider that services such as this are either provided by a third party on behalf of restaurants or in some cases, these services would also be provided by the restaurants themselves. In cases where restaurants seek out these services from a third party on their behalf, I consider there to be an overlap in users of these services and users of *business management of franchised restaurants*. I acknowledge however, that the general public would also constitute another group of users of on-line take-away services. Furthermore, I find that a service such as the opponent's *business management of franchised restaurants* would oversee the day-to-day running of a franchised restaurant including the management of take-out and delivery services and to that extent, there is an overlap in terms of nature. I also note that third parties offering the management of franchised restaurants may also offer their online ordering services to restaurants. However, the services will not be in competition and their purposes differ. Overall, I find there is a low level of similarity between these services.

Marketing services in the field of restaurants; Franchising services providing marketing assistance; Business advertising services relating to franchising; Advertising consultation

23. I consider that marketing and advertising services in the field of restaurants would encompass the process of identifying customer needs and determining how best to meet those needs in addition to the promotion of the restaurant itself. As these services are both necessary for the successful running of a franchised restaurant, I find there is a limited overlap in terms of nature with the opponent's *business management of franchised restaurants*. Further, I find that a professional undertaking which provides *business management of franchised restaurants* may also offer some marketing or advertising services in the field of restaurants. The services differ in terms

¹ *Boston Scientific Ltd v OHIM*, Case T-325/06

of purpose as broadly speaking, the purpose of the applicant's services is to provide services and/or advice for the purpose of increasing awareness of a business, whereas I find that the purpose of *business management of franchised restaurants* is to provide services to facilitate the smooth and efficient operation of a franchised restaurant. I find there is a low level of similarity between these services.

Class 43 Services

Restaurants; Restaurant services; Fast food restaurants; Hotel restaurant services; Take-out restaurant services; Fast-food restaurant services; Bar and restaurant services; Restaurant and bar services; Restaurant services for the provision of fast food; Hotel restaurant services; Provision of food and drink in restaurants; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Take away food services; Take-away food services; Take-away fast food services; Take away food and drink services; Take-away food and drink services

24. Although the above services and the opponent's *Management of franchised restaurants* broadly relate to restaurants, their purposes differ as one is to provide food to the general public whereas the other provides management to a business person in the field of restaurant franchising. The users therefore differ as does the nature and method of use. There would be no competitive relationship between the services and there is no evidence to suggest that there is a complementary relationship to the extent that the consumer would believe the services to derive from the same undertaking. Without evidence to demonstrate this, it does not appear obvious to me that the relationship between these services would lead to a finding of complementarity in line with the case-law. I therefore consider these services to be dissimilar.

Restaurant information services; Providing information about restaurant services

25. I consider that providers of the opponent's *Management of franchised restaurants* services may also provide the above informational services relating to restaurants on behalf of the restaurant providers. These services may include the

provision of opening times, menus and restaurant locations to the general public. Where these services are offered by third parties for restaurants, there will be an overlap in users. Differences lie in the nature and purpose of these services, and I do not find there to be any competitive relationship. I find there is a low degree of similarity between these services.

Reservation of restaurants; Booking of restaurant seats; Making reservations and bookings for restaurants and meals; Reservation and booking services for restaurants and meals

26. I find that the opponent's *Management of franchised restaurants* would entail the day to day running of a restaurant including the supply of catering and administrative staff and general business functions. I note the reservation and booking services above are often offered by third parties on behalf of restaurant providers to facilitate the smooth running of a restaurant, and I find that the above services and the opponent's services may often be offered by the same entities. I also find that restaurants seeking out the opponent's *management of franchised restaurants* would also be users of the applicant's services. I note however, the general public would also be users of the applicant's services and there are differences between the respective services in terms of nature and purpose. Further, I do not consider there to be a competitive or complementary relationship between the services and overall, they are similar to a low degree.

Providing reviews of restaurants

27. I find the very nature of *Management of franchised restaurants* which would include the logistical day-to-day running of a franchised restaurant differs from *providing reviews of restaurants*. I also find the purposes differ, one being to ensure the successful operation of a franchised restaurant and the other being to provide reviews of those restaurants. Although there is a general link overall as both services relate to restaurants, I do not find there to be a complementary nor a competitive relationship between these services. Users of the opponent's services would be business professionals whereas the users of the applicant's services would likely be

a member of the general public. I do not find there to be any similarity between these services.

Class 45 Services

Licensing of franchise concepts; Consultancy services relating to the legal aspects of franchising

28. Whilst I consider that the nature and purpose of the above services differ from that of the opponents, they all relate in some way to franchising and it would be reasonable to assume that there would be an overlap in users. However, I do not consider that these services will be offered by the same entities, with these being legal services as opposed to management and business management services. Further, I do not find these services to be complementary or in competition with one another. Overall, I find these services to be dissimilar.

The second and third earlier marks

Class 35 & 45 Services

29. The opponent's three earlier marks all offer the same scope of protection in class 35 and as such, my findings regarding the similarity of the services in classes 35 and 45 are outlined in paragraphs 19 to 23 and paragraph 28 respectively in this decision.

Class 43 Services

Restaurants; Restaurant services; Fast food restaurants; Hotel restaurant services; Take-out restaurant services; Fast-food restaurant services; Bar and restaurant services; Restaurant and bar services; Restaurant services for the provision of fast food; Hotel restaurant services; Provision of food and drink in restaurants; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Take away food services; Take-away food services; Take-away

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

30. I consider the above services to be encompassed within the opponent's *restaurant services* and are therefore identical on the principle outlined in *Meric*.

Restaurant information services; Providing information about restaurant services

31. Though the nature and purpose of these services differ to *restaurant services*, they would no doubt be offered by from the same undertaking to the same users being members of the general public. I also find there to be a complementary relationship between the above services as they would be important or indispensable to *restaurant services* to the extent that consumers would believe they derive from the same or related undertakings. Overall, I find there to be a medium degree of similarity.

Reservation of restaurants; Booking of restaurant seats; Making reservations and bookings for restaurants and meals; Reservation and booking services for restaurants and meals

32. As previously outlined, these services are often provided by a third party acting as an intermediary between the restaurant and the customer. However, I note these services will also be provided by the restaurants themselves to the general public. It therefore stands that there are two different user groups being the general public and restaurant owners. There would therefore be an overlap in users between these services and *restaurant services* where the general public are concerned. The general public would see some similarity between these services and *restaurant services* as they ultimately result in the customer dining at the restaurant. Further, there is a degree of complementarity in that one is important to the other to the extent that the general public are likely to think that the services may be provided by the same undertaking. I acknowledge however that the nature of the respective services differ and there is no competition between them. I consider these services to have a medium degree of similarity.

Providing reviews of restaurants

33. Although these services and the opponent's *restaurant services* both broadly relate to restaurants, they would likely be provided by different entities and would also differ in terms of nature and purpose. Further, I do not find there to be a complementary nor a competitive relationship between these services. There would be an overlap in users though as the general public may seek out restaurant reviews before choosing a restaurant to visit, however, I do not find the general overlap in user sufficient to find similarity between the services in this instance. I find these services to be dissimilar.

34. In relation to *Licensing of franchise concepts; Consultancy services relating to the legal aspects of franchising Providing reviews of restaurants* which I have found not to be similar to any of the services covered by the three earlier marks, there can be no likelihood of confusion and the opposition to those services fails.

The average consumer and the nature of the purchasing act

35. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the services are likely to be selected by the average consumer. 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. 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.”

36. The services at issue in these proceedings are, broadly, a range of services which encompass business services related to the management of franchises or

restaurants in class 35 and restaurant services in class 43. Relevant consumers of these services are likely to both include the general public and business users.

37. In terms of the general public, the services are likely to be purchased fairly frequently. The cost of such services is likely to vary considerably depending on the type of restaurant and consumers may consider factors such as types of food on offer, ingredients used and, allergens and/or other particular dietary requirements during the selection process. The attentiveness the average consumer will display when selecting the services is therefore likely to vary however overall, I would expect a medium degree of attention to be paid during the purchasing process.

38. As for business users, the services are likely to be less frequent purchases for the ongoing needs of the business. The cost of the services may vary, though, overall, the required outlay will not be insignificant. Business users will be aware of the importance of their selection as well as the potentially negative consequences of choosing the wrong service provider. Business users try to ensure that the services are provided to a professional standard and suitable for their needs. I therefore find that business users would display an above-average level of attention during the purchasing process.

39. Both groups of relevant consumers are likely to select the services having considered promotional material and reviews (whether on-line or in hard copy) or (in the case of restaurant services) on signage appearing on the high street. Visual considerations are therefore likely to dominate the selection process, although I do not discount the fact that these services may also be selected via word-of-mouth recommendations and therefore aural considerations will also apply.

Comparison of marks


40. 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 Court of Justice of the European Union 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 relevant 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.”

41. 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 trade 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.

42. The marks to be compared are as follows:

Opponent's marks	Applicant's mark
SOUL FOODS (Mark 1)	
SOUL RESTAURANTS (Mark 2)	
SOUL COFFEE HOUSE (Mark 3)	

Overall impression

43. The opponent's first mark consists of the words "SOUL FOODS" presented in a standardized typeface. There are no other elements to contribute to the overall impression which lies in the wording itself.

44. The second earlier mark consists of the words “SOUL RESTAURANTS” in a standardized typeface with no other additional elements. Keeping in mind the services for which this mark is registered, I find the distinctive element of this mark to be “SOUL”. Although the “RESTAURANTS” element would certainly not go unnoticed by the average consumer, the descriptive role in which it plays results in this element playing a secondary role in the overall impression.

45. The third earlier mark consists solely of the words “SOUL COFFEE HOUSE” in a standardized typeface. Again, I consider “SOUL” to play the distinctive role in this mark whilst the “COFFEE HOUSE” element plays a secondary role due to its descriptive nature of the services for which the mark is registered.

46. The applicant’s mark contains the word “Soulfood” presented in a standard black font with the word “BRANDS” presented in a smaller, standard black font to the bottom right. Centrally positioned above the wording is a figurative bar chart and arrow element consisting of three gold bars each becoming taller from left to right and a black arrow which emanates from behind the bar chart and curves in an upward motion towards the right. Due in part to its size and positioning and owing to the fact that it is the verbal element of the mark, I find that the “Soulfood” element plays the dominant part in the overall impression. The figurative bar chart and arrow element is mainly decorative and plays a secondary role in the overall impression. I consider the “BRANDS” element to indicate to the consumer that “SOULFOOD” is a company responsible for a group of brands, and therefore to be of little distinctiveness itself. Its contribution, whilst still being noticed, would be minimal.

Visual comparison

The first earlier mark

47. The marks coincide visually in their use of the wording “SOUL FOOD”, although I acknowledge the minor differences in that the opponent’s mark is presented in two words as “SOUL FOODS” whereas the applicant’s mark is presented in one word as “SOULFOOD”. I also note that the applicant’s “SOULFOOD” wording is presented in a slightly stylized font, however fair and normal use of the of the opponent’s mark

would permit the use of this stylized font. There are further differences in the presence of the wording “BRANDS” and the figurative element in the applicant’s mark which has no counterpart in the opponent’s mark. Balancing the points of similarity and difference, together with my assessment of the overall impression of the marks, my view is that there is between a medium and high level of visual similarity between the respective marks.

The second earlier mark

48. The marks both contain the wording “SOUL” however, the applicant’s mark presents this element as “SOULFOOD”. This is where any similarity between the marks ends. The opponent’s mark contains the wording “RESTAURANTS” which has no counterpart in the applicant’s mark. Further, the applicant’s mark contains the additional “BRANDS” and figurative elements which are not present in the opponent’s mark. I find there is a low degree of visual similarity between these marks.

The Third earlier mark

49. Again, the marks both contain the wording “SOUL”, but this is the only similar element between the marks. The “SOUL” element in the applicant’s mark is conjoined to the wording “FOOD” to create the word “SOULFOOD” and the “BRANDS” and figurative elements also have no counterparts in the opponent’s mark. The opponent’s mark also contains the wording “COFFEE HOUSE” which creates a further point of difference. I consider these marks to be visually similar to a low degree.

Aural comparison

The first earlier mark

50. The opponent’s first mark will be pronounced in two syllables using the usual English pronunciation of the words “SOUL FOODS”. Owing to the size and nature of the “BRANDS” element in the applicant’s mark, I do not find it likely that this element will be verbalised. As such, I consider that the applicant’s mark will be pronounced in two syllables as “SOUL FOOD”, rendering the marks aurally similar to a high degree.

However, if I am wrong and “BRANDS” is verbalised in the applicant’s mark, I still find there is a medium to high level of aural similarity between the marks.

The second earlier mark

51. The second mark will be pronounced in four syllables using the standard English pronunciation of the words “SOUL REST-AU-RANTS”. As outlined above, I find the applicant’s mark would most probably be pronounced as “SOUL FOOD”. In scenarios such as this, I consider the marks to be aurally similar to a medium degree. If the “BRANDS” element in the applicant’s mark is verbalised, this creates a further point of difference, and I find the marks would be aurally similar to a low degree.

The third earlier mark

52. The opponent’s third mark will be pronounced in four syllables as “SOUL COFFEE HOUSE” whereas the applicant’s mark would most likely be pronounced in two syllables as “SOUL FOOD”. The only common element between the marks is “SOUL” and the opponent’s mark is noticeable longer. In cases where the applicant’s mark is pronounced “SOUL FOOD”, I find there is a low to medium level of similarity. If the “BRANDS” element in the applicant’s mark is verbalised, this creates a further point of difference, and I find the marks would be aurally similar to a low degree.

Conceptual comparison

The first earlier mark

53. Collins dictionary defines “Soul food” as an informal term used to describe “food, such as chitterlings or yams, traditionally eaten by Black people in the southern US.”² Whilst there will be a portion of consumers that are likely to see the term “Soul Food” in both marks and think of this definition, it is my view that not all UK consumers will recognise this exact definition, and this would be true for both marks. However, even where the exact definition is not known, I find it likely that consumers will interpret

² [Soul food definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com/en/english-uk/dictionary/soul-food)

these elements in both marks as referring to food that is good for the soul. I consider the bar chart and arrow element in the applicant's mark, may bring to mind the concept of a successful business making a profit, especially when taken into context with the nature of some of the applicant's services. The "brands" element, if noticed by the consumer, will convey the idea that "Soulfood" is a parent company that owns brands offering goods or services involving soul foods. Overall, I find the marks to be conceptually similar to a medium degree.

The second earlier mark

54. The word "soul" carries several dictionary definitions such as "the spirit or immaterial part of human beings", "the essential part or fundamental nature of anything" or "a type of music resulting from the addition of jazz, gospel, and pop elements to the urban blues style"³. I find that when faced with the opponent's mark, the average consumer would be likely to think of one of these definitions and the term "restaurants" would likely be perceived as locations where you can sit at a table and eat and pay for a meal. When considering the mark as a whole, I find for some consumers the mark will convey the concept of restaurants where soul music is played. However, for a further significant group of consumers, the mark will simply be considered as giving the name of the restaurants along with the descriptor 'restaurants' and for these consumers it will convey the concept of 'soul' as defined and 'restaurants' separately. I have outlined my findings on the conceptual meaning of the applicant's mark above. Where the concept of a soul as a human spirit is conveyed in some manner across both of the marks, I find there is a low degree of conceptual similarity between these marks. In the other instances, such as where the consumer considers the mark to convey the concept of a restaurant where soul music is played, I find the marks to be conceptually dissimilar.

The third earlier mark

55. I find that consumers will think of one of the standard dictionary definitions of the word "soul" when faced with the third earlier mark and the term "coffee house" would be perceived as an establishment that sells coffee, soft drinks and snacks to

³ [Soul definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com)

the general public. It is again true that the consumer might consider these elements independently or take the mark to convey the concept of a coffee house where soul music is played. My conceptual findings of the applicant's mark are as above, and I consider these marks to have a low degree of similarity where the concept of 'soul' as a human spirit is conveyed in some respect across both marks.

Distinctive character of the earlier mark

56. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, 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).”

57. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, 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 that has been made of it.

58. The first earlier mark consists of the ordinary dictionary words “SOUL FOODS” in a standard font and there are no further elements to add to the inherent distinctiveness. As previously outlined, the definition of these words refers to a type of American cuisine, though I accept that this definition may not be grasped by all consumers. Nevertheless, even where the exact meaning is not known I have found the consumer will interpret this as referring to food that is good for your soul. I therefore consider the wording to be at least allusive to the services for which the mark is registered as they are all in relation to the management of restaurants. As such, I find the opponent’s first earlier mark is inherently distinctive to a fairly low degree.

59. The second earlier mark consists of the ordinary dictionary words “SOUL RESTAURANTS” with no additional elements. While I do not find the word “soul” to always be allusive to the services for which the mark is registered, I consider the term “restaurant” carries a descriptive element. I also consider that SOUL is an ordinary English word. I find this mark to hold a medium degree of inherent distinctiveness where it is not allusive of the services.

60. The third earlier mark consists only of the wording “SOUL COFFEE HOUSE” and I consider again that although the term “soul” is not descriptive of the goods, the “coffee house” element carries descriptive qualities in relation to the registered goods. I find the third earlier mark is inherently distinctive to a medium degree where it does not allude to the services.

Likelihood of confusion

61. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

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

63. Earlier in my decision, I found the similarity of the respective services to vary from identical to dissimilar. I identified the average consumer to be either a member of the general public or a business professional who will purchase the services predominantly by visual means, though I do not discount an aural element to the purchase. I also concluded that a medium degree of attention will be paid during the purchasing process in respect of the general public and a higher degree of attention will be paid by the business professional.

64. In respect of the first earlier mark, I found it to be visually similar to the applicant's mark between a medium and high degree and conceptually similar to a medium degree. In instances where the applicant's mark is not fully verbalized, I found the marks to be aurally similar to a high degree and where the applicant's mark is fully verbalized, the respective marks are similar to a medium to high degree.

65. I found the opponent's second earlier mark to be visually and conceptually similar to the applicant's mark to a low degree. In instances where the applicant's mark is not fully verbalised, I found the marks to be aurally similar to a medium degree

and where the applicant's mark is fully verbalised, the respective marks are similar to a low degree.

66. I found the opponent's third earlier mark to have a low degree of visual and conceptual similarity compared to the applicant's mark. In instances where the applicant's mark is not fully verbalised, I found the marks to be aurally similar to a low to medium degree and where the applicant's mark is fully verbalised, the respective marks are similar to a low degree.

67. In this instance, I found that the first earlier mark has a fairly low degree of inherent distinctiveness. I also note the varying degrees of similarity between the respective services however, as per *Canon*, it should be considered that a lesser degree of similarity between the services may be offset by a greater degree of similarity between the marks. Considering this, along with all the relevant factors, I am of the view that the average consumer may misremember the marks by way of imperfect recollection. I find that the device and "brands" elements may be unnoticed or forgotten and I find that the differences between the applicant's wording of "Soulfood" versus the opponent's "Soul Foods" in particular may be forgotten or go unnoticed. It is on this basis that I find the consumer is likely to mistake one mark for the other and as such, I find there is a likelihood of direct confusion between the applicant's mark and opponent's first mark in respect of all of the similar services.

68. In terms of the second and third earlier marks. I remind myself that I found these earlier marks to both hold a medium degree of inherent distinctiveness where the marks are not considered allusive of the services. However, I found a lower degree of visual, aural and conceptual similarities between these marks and the applicant's mark. Although I consider the device and "brands" elements may be unnoticed or forgotten in the applicant's mark, the presence of the terms "restaurants" and "coffee house" in the opponent's second and third marks respectively create a point of difference as does the presence of the term "food" in the applicant's mark. I find in the applicant's mark, the dominant element "SOULFOOD" hangs together to give a unitary meaning, making it less likely to be misremembered for "SOUL RESTAURANTS" or "SOUL COFFEE HOUSE". These differences are enough for me to consider that the average consumer paying a medium or high level of attention will

not confuse the marks, even where the services are identical, and as such I do not find there would be a likelihood of direct confusion in respect of the opponent's second and third earlier marks.

69. I now go on to consider indirect confusion.

70. 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.)

71. These examples are not exhaustive but provide helpful focus.

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

73. Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

74. The first earlier mark and the applicant’s mark share a common element and as previously outlined; I find that the slight differences of “Soulfood” versus “Soul Foods” may go unnoticed. Further, I do not consider the additional bar chart or “brands” elements present in the applicant’s mark to be particularly distinctive. I find that if the average consumer does notice the differences in the marks by way of the figurative bar chart and “brands” element, they would consider the applicant’s mark to merely be a stylized version of the opponent’s mark and would therefore consider the services to derive from the same undertaking or alternatively, for the opponent’s mark to be a sub-brand of the applicant’s mark, which will represent the parent company. As such, I find there is also a likelihood of indirect confusion in respect of the first earlier mark.

75. As previously stated, I note that the opponent’s second and third earlier marks share a common element with the applicant’s mark, namely the word SOUL. However, within the applicant’s mark, I found this element forms a unit with the word FOOD to indicate a type of cuisine, or a food that is good for your soul. As the shared element

in the marks, namely 'SOUL' does not appear to play an independent role in the applicant's mark, this points away from a finding of indirect confusion between the marks. I have carefully considered all of the factors, including the identity of some of the goods and the medium degree of distinctiveness of the earlier marks, and if the marks may be perceived as a sub brand or brand extension of one another, or for them to be considered to represent economically linked undertakings and I can see no logical reason for this. With this in mind, I find that should the consumer notice the common "Soul" element shared between the marks, they would regard this as a coincidence. Accordingly, I see no reason why the average consumer would believe that the marks originate from the same or economically linked undertakings, even when I have found the contested services to be identical. I therefore do not consider there to be a likelihood of indirect confusion in respect of the second and third earlier marks.

Conclusion

76. The opposition under section 5(2)(b) of the Act has succeeded in relation to the following services, and subject to a successful appeal, the application will be refused for:

Class 35: Restaurant management for others; Business management of restaurants; Business advice relating to restaurant franchising; Business advisory services relating to the running of restaurants; On-line ordering services in the field of restaurant take-out and delivery; Business assistance relating to franchising; Business advice relating to franchising; Franchising services providing business assistance; Business advertising services relating to franchising; Franchising (Business advice relating to -); Franchising services providing marketing assistance; Franchising (Business advisory services relating to -); Business advisory services relating to franchising; Provision of business information relating to franchising; Business advice and consultancy relating to franchising; Business management advisory services relating to franchising; Advice in the running of establishments as franchises; Business assistance relating to the establishment of franchises; Providing assistance in the management of franchised businesses; Assistance in franchised commercial business management; Management advisory services related to

franchising; Administration of the business affairs of franchises; Marketing services in the field of restaurants; Business management assistance in the operation of restaurants; Business management assistance in the establishment and operation of restaurants; Business advisory services relating to the setting up of restaurants; Advertising consultation; Management consulting; Business consulting.

Class 43: Restaurant information services; Providing information about restaurant services; Reservation of restaurants; Booking of restaurant seats; Making reservations and bookings for restaurants and meals; Reservation and booking services for restaurants and meals.

77. The application will proceed to registration, subject to appeal, in respect of the following services:

Class 43: Restaurants; Restaurant services; Fast food restaurants; Hotel restaurant services; Take-out restaurant services; Fast-food restaurant services; Bar and restaurant services; Restaurant and bar services; Restaurant services for the provision of fast food; Hotel restaurant services; Provision of food and drink in restaurants; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Take away food services; Take-away food services; Take-away fast food services; Take away food and drink services; Take-away food and drink services; Providing reviews of restaurants

Class 45: Licensing of franchise concepts; Consultancy services relating to the legal aspects of franchising.

COSTS

78. Both parties have enjoyed a measure of success, though the opponent has been more successful in this case.

79. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. Using that TPN as a guide, I award costs to the opponent including a 10% reduction on costs to account for the applicant's partial success.

Official TM7 fee:	£100
Filing a notice of opposition and considering the holder's counterstatement:	£200
Total:	£300
Total (including 10% reduction):	£270

80. I therefore order Soul Food Investments Ltd to pay the sum of £270 to Soul Holdings Inc. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 3rd day of October 2022

Catrin Williams
For the Registrar