

**DECISION OF THE CONTROLLER OF INTELLECTUAL PROPERTY IN  
PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

IN THE MATTER OF a Notice of Opposition to the registration of the TM 261209-



(series of 2)

**Opponent: Tossed Holdings Limited (subsequently FTMYFG Holdings Limited)**

**(Represented by Brand Protect Limited)**

**Applicant: Focus Food Limited**

**(Represented by TOMKINS & CO)**

**The Applied for Trademark**

1. Focus Food Limited (hereinafter “the Applicant”) Mine Road, Loughshinny, Skerries, Co. Dublin, Ireland has applied to register the mark TM No. 261209 in respect of “Services for providing food and drink; temporary accommodation; restaurant services; bar services; café services; salad bars [restaurant services]; cafeteria services; canteen services; food and drink catering; snack bar services; self-service restaurant services” in Class 43
2. The application for registration was filed on 09 May 2017 and the publication of the acceptance of the mark under TM 261209 appeared in Journal No. 2390 dated 24/07/2019
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 19 September 2019 by Brand Protect Limited of Rowood House, Murdock Road, Bicester OX26 4PP, United Kingdom, acting on behalf of Tossed Holdings Limited, (hereinafter “the Opponent”). The Applicant filed a counter-statement on 23 December 2019 and evidence was, in due course, filed by the parties under Rules 20 and 21 of the Trade Marks Rules, 1996 (“the Rules”).

4. Both parties elected to file written submissions in lieu of attending the Hearing. The parties were notified on 28 January 2022 that I had decided to dismiss the opposition and to allow the mark to proceed to registration. I now state the grounds of my decision, and the materials used in arriving thereat, in response to a request by the Opponent in that regard pursuant to Rule 27(2).

### **Grounds of the Opposition**

5. In its Notice of Opposition, the Opponent states it provides, amongst other goods and services, restaurant services. The type of goods provided in its restaurants include, but are not limited to, salads, wraps, chillis, curries, juices, teas and coffees.

It then refers to its proprietorship of a European Union Trademarks (EUTM 6030266 )



**tossed**

The mark is in respect of goods in Classes 29, 30 and 32 and services in Class 43.

6. The Notice of Opposition is based on

Section 10(2)(b) of the Act– *it is similar to an earlier trademark and would be registered for goods or services identical with or similar to those for which the earlier trademark is protected*

The Opponent stated that, for the purposes of Opposition, only “Services for providing food and drink” in Class 43 are relied on by the Opponent. The Opponent stated that, based on the findings of ECJ Case C-39/97 “Canon Kabushiki v Metro-Goldwyn-Mayer”, the services contained in their EUTM, and the opposed mark were similar or identical. Furthermore, a comparison of the signs at issue would lead to a likelihood of confusion including a likelihood of association for the average consumer of the Class 43 services at issue.

### **Counter-Statement**

In its Counter Statement the Applicant denies all the grounds of opposition. The Applicant denies the marks are similar or that there is a likelihood of confusion or that a likelihood of association. It was contended that the mark does not offend against Section 10(2)(b) of the Trade Marks Act 1996.

## **Rule 20 Evidence**

7. The Opponent submitted evidence under Rule 20 consisting of a Statutory Declaration from Neil Sebba, Managing Director for FTMYFG Holdings Limited dated 25 August 2020, and twelve exhibits (marked NS1 to NS12). I have examined in detail the Declaration and all the accompanying Exhibits which included certificates in relation to the Opponents mark, a selection of prints from the website of the Opponent showing the use of their mark, copies of pages from their social media channels, examples of their product being ordered online and then delivered by third parties, images from Google Maps showing a selection of the Opponent's establishments, samples of till receipts from these establishments, various news articles referencing the Opponent's business together with readership figures for the newspapers in which these appeared, a selection of Tripadvisor and Trustpilot reviews, website analytic data for the Opponent's website and sales turnover data for the period 2014 to 2019 inclusive.
  
8. In a communication dated 03 September 2020, the Office was advised that the earlier mark on which the Opposition was based, EUTM 006030266, was now owned by FTMYFG Holdings Limited who should thereafter be known as the Opponent.

## **Rule 21 Evidence**

9. The Applicant submitted evidence under Rule 21 consisting of a Statutory Declaration from Feidhlim O'Carroll, Managing Director of Focus Foods Limited dated 03 March 2021, and eight exhibits (marked FOC1 to FOC8). I have examined in detail the Declaration and all the accompanying Exhibits which included printouts from the Applicant's website showing use of their trademark during the period 2009 to 2021, details of the Applicant's sales turnover for the period 2008 to 2020, correspondence from the Applicant's accountant confirming turnover figures for the period 2008 to 2016, a copy of a Certificate of Incorporation dated April 2007 for the Applicant's company, evidence of packaging and branding including a copy of a food container showing use of the Applicant's mark, copies of advertisements with Google including customer comments, statements from suppliers to the Applicant with details of product sales to

them and a summary of activity on the Applicant's website for the month of October 2018.

## **Rule 22 Evidence**

10. The Opponent submitted evidence under Rule 22 consisting of a Statutory Declaration from Neil Sebba, Managing Director for FTMYFG Holdings Limited dated 14 May 2021. This was a supplement to the original Declaration dated 25 August 2020 and included three exhibits (marked NS13 to NS15). I have examined in detail the Declaration and all the accompanying Exhibits which included a letter dated 20 December 2016 sent on behalf of the previous owner of the Opponent's mark to the Applicant in relation to the rights claimed by the former based on their EUTM 006030266, a letter dated 16 January 2017 sent in response from advisors to the Applicant and a letter dated 06 February 2017 sent on behalf of the previous owner of the Opponent's mark to the Applicant's advisors disputing the claims made in their letter of 18 January 2017.

## **The Hearing**

11. Both parties confirmed their wish to have the matter decided based on their written submissions.

12. The Opponent's submission, dated 11 November 2021, summarised the background to the case as outlined previously. The submission repeated the points made in their Statutory Declarations dated 25 August 2020 and 24 May 2021. The submission then went on to argue at some length that a likelihood of confusion existed based on the facts of the case. The services in question were held to be mostly identical and the marks were similar based on the distinctive elements of both signs, the average consumer of the services in question would perceive them to be aurally identical and their imperfect recollection would lead to the possibility of direct and indirect confusion. Well known and established case law was quoted in support of their case.

13. The Opponent filed a supplementary submission dated 15 November 2021. In this, they argued that the term "TOSSED" contained in EUTM 006030266 has the requisite degree of distinctiveness required to act as a trademark for the goods and services for which it is registered.

14. The Applicant filed written submissions dated 11 November 2021 in support of their application to register their mark. In this, it was contended that the verbal element “tossed” lacked sufficient distinctiveness to be registrable on its own for services in Class 43, a full comparison of the marks in question, with reference to established EU case law, shows that the public could differentiate sufficiently between them. The submission furthermore argued that the thrust of the Opponent’s case as outlined in their Statutory Declaration was not really relevant to the current proceedings.
15. The Applicant filed a supplementary submission dated 14 November 2021. In this, they argued that the existence of identical or similar registrations at national level, in this case the United Kingdom, Canada and the United States of America, does not constitute a ground for allowing the registration of trademarks devoid of any distinctive character. Finally, they stated that they were not obliged to show honest concurrent use of their mark as it was not objected to at examination stage.

### **Likelihood of Confusion**

16. I now turn to the ground of opposition relating to Section 10(2)(b) and the issue of the likelihood of confusion in the marketplace. The relevant part of the Act reads as follows:

*(2) A trademark shall not be registered if because –*

*(a) .....*

*(b) it is similar to an earlier trademark and would be registered for goods or services identical with or similar to those for which the earlier trademark is protected,*

*there exists a likelihood of confusion on the part of the public, which includes the likelihood of association of the later trademark with the earlier trademark.*

17. Therefore, there are four basic requirements that must be met in order for an objection under this section to succeed. They are: (i) there must be “an earlier trademark”, (ii) the goods or services of the application must be identical with or similar to those in respect of which the earlier trademark is registered, (iii) the mark applied for must be similar to the earlier trademark, and (iv) there must be a resultant likelihood of confusion on the part of the relevant consumer.

18. The Opponent's mark was registered at the European Union Intellectual Property Office (EUIPO) prior to the relevant date, and it is an earlier trademark. Therefore, the first of the conditions is fulfilled.

19. The Opponent's earlier mark includes "Services for providing food and drink; temporary accommodation" in Class 43. The Applicant's mark includes "Services for providing food and drink; temporary accommodation; restaurant services; bar services; café services; salad bars [restaurant services]; cafeteria services; canteen services; food and drink catering; snack bar services; self-service restaurant services". The Class 43 services covered by the Applicant's application for registration are identical with or similar to the Class 43 services for which the Opponent's earlier EUTM 006030266 is registered and, therefore, the second condition is met.

### **Comparison of the marks**

20. I have compared the respective marks on the criteria of visual, aural and conceptual similarity and have attempted to make an overall assessment of the extent to which they should be regarded as similar or different. It is important to stress that this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the services for which the Applicant is seeking registration. In this assessment, I am mindful that the Court of Justice of the European Union (CJEU) noted in *Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, the appreciation of the visual, aural and conceptual similarity of the marks must be based on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.

21. When comparing the Applicant's mark to the Opponent's EUTM it is helpful to look at the two marks side-by-side:



22. I find there is some visual similarities between the marks. The Applicant's mark contains the verbal element "TOSS'D" while the Opponent's mark contains the verbal element "tossed". However, the representation of the letters are different. The wording in question in the Applicant's mark is entirely in upper case, it contains an apostrophe in place of the letter "E" and it is located towards the top of the mark and is represented in white lettering against a green background. The opponent's verbal element, "tossed", is in lower case, it is located at the bottom of the mark and is represented in pink lettering. In my opinion, the marks taken as a whole, are more visually dissimilar than similar. I rate the level of visual similarity between the marks as low.
23. The Applicant's mark contains a three word the verbal element "TOSS'D noodles and salads". The Opponent's mark contains a single word verbal element 'tossed'. In my opinion, the marks are more aurally dissimilar than similar. I find the level of aural similarity between the marks to be low to medium.
24. The Applicant's mark consists of the verbal element "TOSS'D noodles and salads" contained within a device element depicting what appears to be chopsticks in what could be seen as bowl looking like a leaf. Both verbal and figurative elements are depicted within a device dominated by the colour green. The Opponent's mark contains a common English word, "tossed" underneath a device containing a combination of what appears to be letters in an unusual font and dominated by the colour pink. I find there is no conceptual similarity between the marks.
25. Having completed my examination of the marks in respect of their visual, aural and conceptual characteristics, I find that there is an extremely low overall level of similarity between them.
26. A global assessment of the likelihood of confusion requires me to take all relevant factors into account, including the similarity between the services. Accordingly, I must be mindful that in Canon Kabushiki<sup>2</sup> the CJEU found "a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa". This must be considered as the Class 43 "Services for providing food and drink; temporary accommodation" services at issue are either identical or similar.
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27. I must also consider other factors identified by the CJEU in this area, including the following:

- (a) the more distinctive the earlier mark, the greater will be the likelihood of confusion;
- (b) in determining the distinctive character of the earlier mark, it is necessary to make an overall assessment of its capacity to identify the services for which it is registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings;
- (c) in making that assessment, account should be taken of the inherent characteristics of the mark; the market share held by it; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested in its promotion; the proportion of the relevant public which, because of the mark, identifies the services as originating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations;
- (d) a global appreciation of the likelihood of confusion as regards the visual, aural and conceptual similarity of the marks in question, must be based on the overall impression created by them, and the importance attached to each of those elements must take account of the category of services and the way in which they are marketed and used by the purchasing public;
- (e) the assessment must be made from the perspective of the average consumer who is deemed to be reasonably well-informed, observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture that he has of them in his mind,

28. These proceedings are concerned solely with services, not goods. The criteria for deciding a likelihood of confusion in terms of goods envisages a typical purchasing scenario where goods from the respective parties may be found on the same shelf of a store, or in the same store, or are in competition or are complimentary to each other. Therefore, the tests in respect of a likelihood of confusion in a typical purchasing scenario regarding goods, and the level of attention the purchasing consumer pays when purchasing the relevant goods, are not wholly applicable to services.

29. Competing providers of the same type of services for providing food and drink; temporary accommodation; are seldom found in the same store.



30. I am required to make an overall assessment of the likelihood of confusion that may exist between the Opponent's earlier trademark and the Applicant's mark. The confusion in question may be direct confusion, whereby the Applicant's services for providing food and drink; temporary accommodation; restaurant services; bar services; café services; salad bars [restaurant services]; cafeteria services; canteen services; food and drink catering; snack bar services; self-service restaurant services are mistaken for the services for providing food and drink; temporary accommodation of the Opponent, or indirect confusion, whereby the Applicant's services are associated in the mind of the consumer with those of the Opponent and a common commercial origin is inferred.

31. I have already found the respective marks share an extremely low level of similarity. That low level of similarity leads me to conclude the overall impression conveyed by the marks is that they are different. I have looked at the question of likelihood of confusion from a practical perspective in the context of the marketplace and I have put myself in the shoes of the average consumer of the food and drink and temporary accommodation services in question. Having done so, I am satisfied that a consumer, having experienced the relevant services of the Opponent, and having subsequently encountered the Applicant's mark for the same services, would not be likely to be confused or caused to wonder that the latter services were from the same commercial origin as the former, or that the service providers were economically linked.

32. In light of all the above, I find no likelihood of confusion would arise if both marks were used for their respective Class 43 services in the Irish marketplace. Accordingly, I find the application does not offend against Section 10(2)(b) and I dismiss the opposition on this ground.

33. For these reasons, I have decided that the prior registration and use of the Opponent's



trade marks **tossed** does not constitute any grounds for refusal of the application



to register the Applicant's mark . Therefore, I have decided to dismiss the opposition and to allow the Applicant's mark to proceed to registration.

John Nolan  
Hearing Officer  
Acting for the Controller  
08 July 2022