

O/0419/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3654493  
BY SMASH PATTIES LTD

TO REGISTER:



AS A TRADE MARK IN CLASS 43

AND

IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 430847 BY  
SMASHBURGER IP HOLDER LLC

## BACKGROUND AND PLEADINGS

1. On 11 June 2021, Smash Patties Ltd (“the applicant”) applied to register the trade mark shown on the front cover of this decision in the United Kingdom in respect of the following services:

Class 43

*Take-away fast food services.*

2. On 7 February 2022, the application was opposed by Smashburger IP Holder LLC (“the opponent”). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under section 5(2)(b), the opponent is relying on the following marks:

UKTM No. 3518954 (“the 954 mark”)

**SMASH**

Filing date: 4 August 2020

Registration date: 20 November 2020

Class 43

*Carry-out restaurants; catering; restaurant and bar services; self service restaurants.*

UKTM No. 917576539 (“the 539 mark”)

**SMASH  
BURGER**

Filing date: 11 December 2017

Registration date: 16 April 2018

Class 43

*Carry-out restaurants; catering; restaurant and bar services; self service restaurants.*

UKTM No. 3275845 (“the 845 series”)

**SMASHBURGER**

**SMASHBURGER**

Filing date: 7 December 2017

Registration date: 9 March 2018

Class 43

*Carry-out restaurants; catering; restaurant and bar services; self service restaurants.*

UKTM No. 3275843 (“the 843 series”)

**SMASH  
BURGER**

**SMASH  
BURGER**

Filing date: 7 December 2017

Registration date: 9 March 2018

Class 43

*Carry-out restaurants; catering; restaurant and bar services; self service restaurants.*

4. All these marks qualify as earlier marks under section 6(1) of the Act, by virtue of their earlier application date.

5. The opponent claims that the services are identical or similar and the marks are similar and so there is a likelihood of confusion on the part of the relevant public, which is increased by the enhanced distinctive character of the earlier marks.

6. The opponent also relies on all four of these marks under section 5(3) of the Act. It claims that they have a reputation for the registered services and that use of the contested mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier marks. The similarity between the marks would cause the relevant public to believe that there is an economic connection between them and damage would occur in one or more of the following ways:

- i. the contested mark would ride on the coat-tails of the reputation and/or prestige associated with the earlier marks and derive an unfair advantage from it or exploit the marketing efforts made by the opponent to create and maintain the earlier marks' reputation and image;
- ii. the reputation of the earlier marks would be tarnished because the opponent would not be able to control the manner in which the contested mark is used;
- iii. the presence on the market of such a similar mark would reduce the capacity of the earlier marks to arouse an immediate association with the opponent's services, causing a loss of sales to the opponent.

7. Under section 5(4)(a), the opponent claims to have used the signs **SMASH** and **SMASHBURGER** throughout the UK since June 2011 for the following services:

*Carry-out restaurants; catering; restaurant and bar services; self service restaurants.*

8. The opponent claims to have acquired goodwill under the sign. According to the opponent, use of the contested marks would constitute a misrepresentation to the public that would damage the goodwill in its business. Consequently, use of the contested marks would be contrary to the law of passing off.

9. The applicant filed a defence and counterstatement denying the claims made and stating that it is aware of at least 12 other trade marks registered in Class 43 that include the word "Smash". It claims that this word "*will be readily understood to descriptively refer to burgers that are cooked in the smash method, in which burgers are pressed as part of the cooking process to improve the contact of the meat with the*

*heat source.*<sup>1</sup> Consequently, the applicant submits that the earlier marks all possess a low degree of distinctive character in relation to the specified services. The applicant also submits that the likelihood of confusion is negated by the fact that its services are provided in Wembley, while the opponent's nearest restaurant is in Milton Keynes. The applicant put the opponent to proof of reputation and goodwill.

## **EVIDENCE AND SUBMISSIONS**

10. The opponent filed evidence in the form of a witness statement from Sheryl Anne Molera, Associate General Counsel, IP, Digital and Privacy, and Legal Business at Smashburger IP Holder LLC, dated 5 August 2022. It is accompanied by five exhibits that go to the use made of the mark in the UK, its reputation and goodwill.

11. The applicant filed evidence in the form of a witness statement from Imran Husain, Director of Smash Patties Ltd, dated 29 September 2022. It is accompanied by 11 exhibits.

12. Neither side requested a hearing and both filed written submissions in lieu. The applicant's are dated 6 February 2023 and the opponent's are dated 14 February 2023.

## **REPRESENTATION**

13. The opponent is represented by Bird & Bird LLP, while the applicant is a litigant in person, although it was represented by Virtuoso Legal for the filing of the defence and counterstatement.

## **DECISION**

### **Section 5(2)**

14. Section 5(2) of the Act is as follows:

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<sup>1</sup> Counterstatement, paragraph 2.4.

“A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.”

15. As the earlier marks were registered within the five years before the date on which the application for the contested mark was made, they are not subject to proof of use and the opponent is therefore entitled to rely on all the services for which the marks stand registered.

16. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):<sup>2</sup>

a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

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<sup>2</sup> 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 Trade Marks 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, although the UK has left the EU.

b) the matter must be judged through the eyes of the average consumer of the goods or services in question. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;

c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;

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

i) mere association, in the strict sense that the later mark brings 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; and

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

### **Comparison of services**

17. It is settled case law that I must make my comparison of the services on the basis of all relevant factors. These may include the nature of the services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Services are complementary when

“... there is a close connection between them in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”<sup>3</sup>

18. The services to be compared are shown in the table below. The specifications for the earlier marks are identical.

<b>Earlier services</b>	<b>Contested services</b>
<u>Class 43</u> <i>Carry-out restaurants; catering; restaurant and bar services; self service restaurants.</i>	<u>Class 43</u> <i>Take-away fast food services.</i>

19. The opponent submits that:

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<sup>3</sup> *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.



“It cannot be disputed that the Contested Services are identical to ‘carry-out restaurants’. With regards to the remaining services within the Earlier Registered Marks, it is submitted that they can be considered also identical to the services covered by the Application but, if not, they are at the very least highly similar.”<sup>4</sup>

20. The applicant has made no submissions on the comparison of the services.

21. In construing the terms used in the specifications, I bear in mind the comments of Floyd J (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

“...Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”<sup>5</sup>

22. More recently, Arnold LJ said in *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch):

“...the applicable principles of interpretation are as follows:

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<sup>4</sup> Written submissions in lieu of a hearing, paragraph 8.

<sup>5</sup> Paragraph 12.

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”<sup>6</sup>

23. I consider that the average consumer will understand a restaurant in the opponent’s term to refer to an establishment in which one can “eat in”, as well as, or instead of, taking the food away for consumption elsewhere. A *carry-out restaurant* would, in my view, be understood as a restaurant that also offers a take-away service, which may, or may not, involve fast food. Keeping in mind that I must not interpret terms used for services widely, I consider that the opponent’s and the applicant’s terms are not the same. Nevertheless, I find that there is a significant overlap in terms of users, purpose, method of use and nature of service. It is my view that the services are highly similar.

24. In my view, none of the other services in the opponent’s specification improve the opponent’s position.

### ***Average consumer and the purchasing process***

25. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“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

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<sup>6</sup> Paragraph 56.

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.”<sup>7</sup>

26. The opponent submits that the average consumer is a member of the general public who will purchase the services on a fairly frequent basis. I agree. I also consider that, although the price of the services may vary, in general they are likely to be fairly inexpensive. The opponent submits that the average consumer will pay a relatively low degree of attention during the purchasing process. I accept that there will be occasions where the level of attention paid is low. This could occur when the consumer needs to find something to eat very quickly. On other occasions, the consumer will make a more considered choice, taking account of the range of options on the menu, the ingredients used, the cleanliness of the store and whether the service caters for any dietary requirements that the consumer has. On balance, then, I find that the level of attention paid when purchasing these services will be somewhere between low and medium.

27. During the purchasing process, the average consumer will see the marks in use on signage on the premises. They may also have seen advertisements or reviews on social media, websites and printed publications. The purchasing process will largely be a visual one. However, I cannot ignore the aural element of the marks as the consumer may receive word-of-mouth recommendations.

### ***Distinctive character of the earlier marks***

28. In *Lloyd Schuhfabrik Meyer*, 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

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<sup>7</sup> Paragraph 60.

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 Alternberger* [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).”

29. Registered trade marks possess varying degrees of inherent distinctive character. Marks that are suggestive of, or allude to, a characteristic of the goods or services would sit at the lower end of a spectrum of distinctiveness, while those marks that are invented words with no allusive qualities would sit towards the top.

30. The opponent submits that the earlier marks have no meaning in relation to the services for which they are registered. In such a case, the marks would be expected to have a medium level of inherent distinctiveness.

31. The applicant submits that the level of inherent distinctiveness is low, as the marks would be understood by the average consumer to refer to burgers cooked using the “smash” method. Mr Husain explains that “a ‘*Smash Burger*’ ... describes a ball of mince-meat being smashed on a flat griddle”.<sup>8</sup> He has filed evidence which he says shows that it is a descriptive term. This consists of the following:

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<sup>8</sup> Witness statement, paragraph 4.

- An undated screenshot from amazon.co.uk showing a product described variously as a “grill press”, a “smash burger press” and a “burger smasher for griddle and grill” (Exhibit 1);
- An undated print-out from an unknown website that Mr Husain says belongs to a wholesale food supplier showing a product described as the “original smash burger” (Exhibit 2);
- An article dated 28 May 2018 entitled “The art of the smash burger – of our best burger recipes” from the ourmodernkitchen.com website (Exhibit 3a); and
- An undated print-out from the Tesco website containing a recipe for smash burgers (Exhibit 3b).

32. The only dated material is the 2018 website article, but as only the text has been provided I am not able to make any inferences about the likelihood of this having come to the attention of the consumer in the UK by the relevant date of 11 June 2021. I remind myself that the average consumer is a member of the general public. While there may be a group of consumers who recognise the term as referring, or alluding, to a method of cooking burgers, the evidence does not suggest that this would be a significant group. Consequently, I find that the earlier marks have a medium degree of inherent distinctive character.

33. I now turn to the evidence that the opponent submits shows that the distinctive character of the marks has been enhanced through use. Ms Molera states that the opponent’s first UK store opened in Milton Keynes in May 2016. It was followed by further stores in Bath, Brighton, Newcastle, Glasgow, Wednesbury and Dunfermline.<sup>9</sup> The consolidated financial statements of the opponent’s UK franchisee, A L Ventures Limited, confirm that there were seven stores trading throughout 2019.<sup>10</sup> Turnover for the year ending 30 December 2018 was £5,737,129 and for the year ending 29 December 2019 was £5,366,152.<sup>11</sup> There are no figures for 2020 or the first half of 2021, but the statements do acknowledge the negative impact that the COVID-19 pandemic was having on the business.<sup>12</sup>

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<sup>9</sup> Paragraph 10.

<sup>10</sup> Exhibit SAM-3, page 3.

<sup>11</sup> *Ibid*, page 10.

<sup>12</sup> *Ibid*, page 5.

34. Ms Molera states that the UK franchisee has invested over £500,000 between 2014 and 2021 in marketing and advertising the business.<sup>13</sup> No examples are given.

35. Exhibit SAM5 contains articles referring to Smashburger. Although Ms Molera states that these relate to multiple territories, including the UK, they all appear to be US-focused, although I acknowledge that the poor quality of the reproduction of one of the earlier articles does not allow me to read its contents.<sup>14</sup>

36. I have no figures on the size of the market for *Carry out restaurants*, but I consider it likely to be large. Before the relevant date, the opponent had only seven stores and while they could be found across the UK, the level of turnover is insufficient for me to find that the distinctive character of the earlier marks has been enhanced through use, bearing in mind the lack of examples of advertising and promotional activity.

### ***Comparison of marks***

37. It is clear from *SABEL* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:

“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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.”<sup>15</sup>

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<sup>13</sup> Paragraph 11.

<sup>14</sup> Page 2.

<sup>15</sup> Paragraph 34.

38. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

39. The respective marks are shown below. I have not shown the 843 series. This is because the first of the marks in that series is identical to the 539 mark, while the second is simply the same mark in a different colour. This use in colour does not put the opponent in any better a position.

Earlier marks	Contested mark
<p>The 954 mark:</p> <p>SMASH</p> <p>The 539 mark:</p> <p><b>SMASH BURGER</b></p> <p>The 845 series:</p> <p><b>SMASHBURGER</b></p> <p><b>SMASHBURGER</b></p>	

40. The contested mark is a composite mark consisting of a line drawing representing a burger, below which can be seen the words “SMASH PATTIES YOUR HUNGER”, each word being on a different line, all on a light orange background. The verbal elements of the mark are presented in different ways: “SMASH” appears in a standard sans serif typeface; “PATTIES” is shown in a handwritten style in lower case; “YOUR HUNGER” is in a blocky, sans serif font, with larger letters than the other two words. However, I find this phrase to be suggestive of the services that are sought to be

registered under the sign, as they are services intended to satisfy the consumer's hunger. On the other hand, I found that "SMASH" was not descriptive or allusive and so, despite its smaller size, I consider it will make an equal contribution to the overall impression of the mark as that made by the larger "YOUR HUNGER". The word "PATTIES", being fainter, makes a lesser contribution. In addition, this word, along with the device, are descriptive of, or at least allude to, the type of food the average consumer would expect to be able to buy from the applicant.

41. I have considered the applicant's claims in its counterstatement that the text would be interpreted in two ways: "Smash Your Hunger" and "Smash Patties". In my view, this requires a level of analysis of the mark that would not be carried out by the average consumer paying only a low to medium degree of attention. Rather, it is my view that both "SMASH" and "YOUR HUNGER" have independent distinctive roles within the mark

42. The 954 mark consists solely of the word "SMASH". There are no other elements to contribute to the overall impression of the mark.

43. The 539 mark consists of the word "SMASH", with the word "BURGER" below it. The beginnings and ends of the words are aligned. In the context of the services at issue, "BURGER" alludes to a type of food the consumer would expect to be offered by a carry-out/take-away restaurant. The dominant and distinctive element of this mark is "SMASH".

44. The marks in the 845 series consist of two marks with the words "SMASH" and "BURGER" joined into a single word. The first is black, and the second a muted red. The overall impression of the first mark lies in the juxtaposition of these two words. In the case of the second, the colour also makes a contribution to the impression of the mark, although this is a smaller one than that made by the combination of the words.

45. Before proceeding to compare the visual, aural and conceptual aspects of the marks, I shall deal briefly with the opponent's submissions on the use of the contested mark. Exhibit SAM-4 contains a print-out of the applicant's Facebook page and photographs of its menu and packaging. These show the contested mark without the



words “YOUR HUNGER”. This exhibit can have no bearing on my decision under this ground. It is the contested mark as it appears in the application for registration that I must compare to the opponent’s marks.

*Comparison with the 954 mark*

46. The 954 mark in its entirety is included in the contested mark and I note that it appears at the beginning of the verbal part of that mark. The consumer tends to attach more importance to the beginnings of marks than the ends, as the English speaker reads from left to right, and from top to bottom. That said, the contested mark contains a further three words, the first of which is differently stylised, and a device. Taking the marks as a whole, I find that they are visually similar to a low degree.

47. Turning now to the aural comparison, I find that the 954 mark consists of one syllable, while the contested mark has six. The first of these six syllables is identical to the earlier mark. In my view, the marks are aurally similar to a low degree.

48. The average consumer will understand the word “SMASH” to refer either to the act of hitting something with great force or of breaking something into pieces. The contested mark will bring to the mind of the average consumer the idea of a patty of meat that has been hit with great force. In addition, the mark will also convey the message of a hungry consumer. There is therefore some conceptual similarity but I would pitch it at a relatively low level.

*Comparison with the 539 mark and the 845 series*

49. The addition of the word “BURGER” in the 539 mark points towards a lesser degree of visual and aural similarity than I found for the 954 mark and a greater degree of conceptual similarity. I find the contested mark to be aurally and visually similar to the 539 mark and the 845 series of marks to a very low degree and conceptually similar to a low to medium degree.

### ***Global assessment of the likelihood of confusion***

50. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services or vice versa. I keep 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 they have in their mind.

51. In its counterstatement, the applicant submits that the opponent has not provided any examples of occasions where confusion has occurred and that the most likely reason for this is that no confusion has arisen or is likely to arise. However, absence of evidence of actual confusion has been held by the courts rarely to be significant as that may be a result of a wide variety of different factors: see *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, at [291].

52. The applicant also submits that:

“... the chances of actual confusion in the circumstances between the Applicant’s Mark and the Smash Burger marks are further negated as the Applicant retails directly to consumers locally to its base in Wembley. The Opponent does not operate in London and its nearest restaurant is located in Milton Keynes.”<sup>16</sup>

53. When assessing the likelihood of confusion, I must consider all the circumstances in which the mark applied for might be used if it were registered: see *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06 P, the CJEU stated that:

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<sup>16</sup> Counterstatement, paragraph 2.9.

“As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”<sup>17</sup>

54. A registered trade mark covers the whole of the United Kingdom and either the opponent or the applicant could decide to expand their business into other locations. Consequently, the applicant’s claim that the different geographical areas of operation negates the likelihood of confusion cannot succeed.

55. The applicant also draws my attention to other trade marks containing the word “SMASH” that are registered for services in Class 43.<sup>18</sup> In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court stated that:

“As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS (Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71).”<sup>19</sup>

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<sup>17</sup> Paragraph 59.

<sup>18</sup> Exhibits 5a, 5b, 5c and 5d.

<sup>19</sup> Paragraph 73.

56. This “state of the register” evidence has no bearing on the decision I must make. I note that Exhibits 4a, 4b and 4c contain details of three other companies using the word “SMASH”: these are Smash Burger London, Super Smash – Leicester, and Smash Bros Burgers. However, all three print-outs are undated so there is no evidence that these names were being used on the market at the relevant date. I dismiss this argument.

57. Having dealt with these points, I continue to make my assessment, noting that there are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting 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 recognised 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).”

58. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

“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.”<sup>20</sup>

59. Earlier in my decision, I found that:

- The contested services are highly similar to the opponent’s services;
- The average consumer would be a member of the general public who would be paying a low to medium degree of attention;
- The purchasing process would largely be visual;
- The earlier marks have a medium degree of inherent distinctive character, which has not been shown to have been enhanced through use;
- The contested mark is visually, aurally and conceptually similar to the 954 mark to a low degree; and
- The contested mark is visually and aurally similar to the 539 mark and the 845 series of marks to a very low degree and conceptually similar to between a low and medium degree.

60. I shall make my assessment of the likelihood of confusion on the basis of the 954 mark in the first instance, and return to the other marks if that proves necessary.

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<sup>20</sup> Paragraph 12.

61. Even taking account of the imperfect recollection of the average consumer and the low to medium degree of attention that they are paying, I consider that the differences between the marks are too great for there to be a likelihood of direct confusion. The average consumer is not likely to mistake one for the other, given the additional verbal and figurative elements in the contested mark.

62. I therefore proceed to consider whether there is a likelihood of indirect confusion. As the contested mark is a composite mark, I find it helpful to remind myself of the consideration that Arnold J (as he then was) gave the CJEU judgments in *Medion* and *Bimbo* in *Whyte and Mackay Ltd v Origin Wine UK Ltd & Anor* [2015] EWHC 1271 (Ch):

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks – visually, aurally and conceptually – as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meaning of the

separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

63. Earlier in my decision, I found that “SMASH” had a distinctive significance independent of the contested mark as a whole. I do not consider that any more than a small proportion of consumers would perceive the mark as a whole as having a different meaning to the meaning of its separate components. I found that the view that “SMASH” hangs together both with “Patties” and “YOUR HUNGER” would require the average consumer to subject the mark to relatively detailed analysis. I also found that all the elements other than “SMASH” were suggestive of the contested services, meaning that “SMASH” is the more distinctive element. Taking these factors into account, along with the high degree of similarity between the services, I find that the average consumer is, in my view, likely to believe that the contested mark is another mark of the opponent’s.

64. The opposition succeeds under section 5(2)(b).

### **Section 5(3)**

65. Section 5(3) of the Act is as follows:

“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 and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

66. The conditions of section 5(3) are cumulative. First, the opponent must show that the earlier marks are similar to the application. Secondly, it must satisfy me that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three 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.

67. Earlier in my decision, I found that the earlier marks are similar to the contested mark.

### ***Reputation***

68. In *General Motors Corp v Yplon SA*, Case C-375/97, the CJEU held that:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or services marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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."

69. At this point, I note that the 539 mark is a comparable mark and that paragraph 7 of Part 1 of Schedule 2A of the Act is relevant to these proceedings. The effect of this provision is that I must assess the reputation of the mark in the EU for the period up to IP Completion Day (31 December 2020) and in the UK thereafter. I have been provided with no financial data for sales in any jurisdiction other than the UK. As the first mark in the 843 series is identical to the 539 mark, and is not a comparable mark, I shall assess the reputation of the 954 mark and the 845 and 843 series of marks in the UK, which is the relevant territory.

70. The factors that I must take into account for an assessment of reputation are the same as those that I considered when assessing the opponent's claim that the distinctive character of the marks had been enhanced through use. The evidence fell short of establishing such a claim, and I consider that this is also the case with regards to reputation.

71. The section 5(3) ground is dismissed.

## Section 5(4)(a)

72. Section 5(4)(a) of the Act states that:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met

...”

73. Subsection 4(A) is as follows:

“The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

74. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly,

he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."<sup>21</sup>

### **Relevant date**

75. The relevant date in these proceedings is the date of the commencement of the conduct complained of: see *Maier & Anor v ASOS plc & Anor* [2015] EWCA Civ 270, paragraph 165. That is usually the date of application for the contested mark, i.e. 11 June 2021. However, if the contested mark has been used prior to application, I need to consider what the position was at the date that use first began. The applicant does not claim to have used the contested mark prior to application, and so there is only one date that is relevant.

### **Goodwill**

76. The opponent must show that it had goodwill in a business at the relevant date of 11 June 2021 and that the signs relied upon, **SMASH** and **SMASHBURGER**, are associated with, or distinctive of, that business.

77. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of

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<sup>21</sup> Page 406.

attraction sufficient to bring customers home to the source from which it emanates.”<sup>22</sup>

78. The evidence shows that the opponent trades under the sign **SMASHBURGER**, not **SMASH**. In *Smart Planet Technologies, Inc. v Rajinda Sharma (Recup Trade Mark)*, BL O/304/20, Mr Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After doing so, he concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”<sup>23</sup>

79. Earlier in my decision, I found that the turnover was not particularly large. However, the courts have found that small levels of trade may be sufficient for them to conclude that there would be misrepresentation and damage: see, for example, *Lumos Skincare Ltd v Sweet Squared Ltd & Ors*, [2013] EWCA Civ 590. I also found that the term “SMASHBURGER” was distinctive to a medium degree for the services in relation to which goodwill is claimed (and which are the same as those for which the trade marks are registered). On this basis, I am satisfied that the opponent has acquired protectable goodwill as a result of its trade in *Carry-out restaurants* and that the sign **SMASHBURGER** is distinctive of that goodwill. However, given the limited data I have on the level of the trade, the lack of evidence of how the sign has been promoted, and the fact that the opponent has only seven stores in the UK, I am unable to find that the level of goodwill is any more than modest.

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<sup>22</sup> At [224].

<sup>23</sup> Paragraph 34.

## **Misrepresentation**

80. The relevant test was set out by Morritt LJ in *Neutrogena Corporation & Anor v Golden Limited & Anor* [1996] RPC 473 at [493]:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at page 407 the question on the issue of deception or confusion is:

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants’ [product] in the belief that it is the respondents’ [product].

The same proposition is stated in Halsbury’s Laws of England 4<sup>th</sup> Edition Vol. 48 para. 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd v June Perfect Ltd* (1941) 58 RPC 147 at page 175; and *Re Smith Hayden’s Application* (1945) 63 RPC 97 at page 101.”

81. The services for which registration is sought share a common field of activity and are highly similar to the opponent’s services. The courts have been clear that an important consideration in deciding on the likelihood of misrepresentation is “*whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant*”: see *Annabel’s (Berkeley Square) Ltd v G Schock (t/a Annabel’s Escort Agency)* [1972] RPC 838 at page 844.

82. Under section 5(2)(b), I found that there was only a very low degree of visual and aural similarity between the contested mark and the **SMASHBURGER** sign and a low to medium degree of conceptual similarity.

83. In *W.S. Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPC 18 (PCC), Mr Iain Purvis QC, as a Recorder of the Court, stated that:

“Mr Aikens stressed in his argument the difference between ‘mere wondering’ on the part of a consumer as to a trade connection and an actual assumption of such a connection. In *Phones 4U Ltd v Phone4U.co.uk. Internet Ltd* [2007] RPC 5 at 16-17 Jacob LJ stressed that the former was not sufficient for passing off. He concluded at 17:

‘This of course is a question of degree – there will be some mere wonderers and some assumers – there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former’.”<sup>24</sup>

84. Given the modest level of goodwill, and the low degree of similarity between the sign and the contested mark, it is my view that the public would not assume that there was a connection between the two signs. I consider that they are likely to wonder, but that is not enough for there to be misrepresentation. Even if I were to find misrepresentation, the goodwill is not, in my view, sufficient for there to be substantial damage on the basis of any misrepresentation.

85. The section 5(4)(a) ground is dismissed.

## **OUTCOME**

86. The opposition is successful under section 5(2)(b) of the Act and Application No. 3654493 is refused.

## **COSTS**

87. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice No. 2/2016. I

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<sup>24</sup> Paragraph 54.

therefore award the opponent the sum of £1850. The basis of my calculation is set out below. As only the section 5(2)(b) ground was successful, I have awarded the costs that would have been applicable for this ground.

<i>Preparing a statement and considering the other side's statement:</i>	<i>£350</i>
<i>Preparing evidence:</i>	<i>£1000</i>
<i>Preparing written submissions in lieu of a hearing:</i>	<i>£400</i>
<i>Official fees:</i>	<i>£100</i>
<b><i>TOTAL:</i></b>	<b><i>£1850</i></b>

88. I therefore order Smash Patties Ltd to pay Smashburger IP Holder LLC the sum of £1850. This sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 5<sup>th</sup> day of May 2023**

**Clare Boucher**  
**For the Registrar,**  
**Comptroller-General**