

O-025-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2358381  
BY GUSTO UK LIMITED  
TO REGISTER THE TRADE MARK:**



**IN CLASS 43**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 92704  
BY SIR TERENCE ORBY CONRAN  
BASED UPON THE EARLIER TRADE MARK:**

**MEZZO**

## Trade Marks Act 1994

In the matter of application no 2358381  
by Gusto UK Limited  
to register the trade mark:



in class 43 and the opposition thereto  
under no 92704  
by Sir Terence Orby Conran

### BACKGROUND

1) On 16 March 2004 Gusto UK Limited, which I will refer to as Gusto, applied to register the trade mark:



The application was published for opposition purposes in the “Trade Marks Journal” on 7 May 2004 with the following specification:

*coffee shop and restaurant services.*

The above services are in class 43 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 6 August 2004 Sir Terence Orby Conran filed a notice of opposition against the application. Sir Terence is the owner of United Kingdom trade mark registration no 1579741 of the trade mark **MEZZO**. It is registered for the following services:

*planning, design and interior design, all of restaurants, cafes, cafeterias, bistros, wine bars, food bars, snack bars, canteens, hotels, motels, public houses and catering establishments; catering services; restaurant, cafe, cafeteria, bistro, wine bar, food bar, snack bar, canteen, hotel, motel, public house and catering establishment*

*services; advisory, consultancy and information services, all relating to all the aforesaid services; all included in Class 42.*

The above services are in class 42 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

The trade mark application was filed on 26 July 1994 and was registered on 7 June 1996. As it had been registered for five years or more at the date of the publication of Gusto's trade mark, Sir Terence had to state upon which services the trade mark had been used (as per rule 13(2)(e) of the Trade Marks Rules 2000 (as amended by The Trade Marks (Amendment) Rules 2004). He stated that it had been used for the following services:

*catering services, restaurant, cafeteria, bistro, wine bar, food bar, snack bar and catering establishment services.*

Sir Terence claims that his trade mark and that of Gusto are similar and that the services that they encompass are similar or identical. Consequently, there is a likelihood of confusion and registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) Gusto filed a counterstatement. Gusto claims that the trade marks are not similar and that the services encompassed by them are neither similar nor identical. It states that its trade mark also includes the words COFFEE BAR, further differentiating it from the trade mark of Sir Terence. Gusto does not consider that there is any likelihood of confusion. Gusto did not accept the statement of use supplied by Sir Terence. However, it stated that it did not require Sir Terence to provide proof of use of his trade mark in relation to the services listed by him, as per rule 13(C)(1)(b) of the Rules. (As the grounds of opposition were amended, Gusto furnished two counterstatements and in both it stated that it did not require Sir Terence to provide proof of use.)

4) Both sides furnished evidence.

5) The sides were advised that they had a right to a hearing and that if neither side requested a hearing, a decision would be made from the papers and any written submissions that were received. Sir Terence Conran stated that he did not want a hearing and furnished written submissions. Gusto made no response. Consequently, this decision is made from the evidence and written submissions before me.

## **EVIDENCE**

### **Opponent's evidence**

6) This consists of a witness statement by Tracy Ann Williams Arch. Ms Arch is a trade mark attorney acting for Sir Terence. In a covering letter with the evidence it is stated that although Sir Terence is not required to provide any proof of use, because Gusto have not requested him so to do, he has given a few examples of such use as exhibits to Ms Arch's witness statement.

7) Ms Arch states that it is her understanding that the trade mark MEZZO has been used by Sir Terence since the first half of the 1990s and that the trade mark was in use during the five year period ending with the date of the publication of Gusto's trade mark. She exhibits at TAWA1 menus which were used in this period at an establishment operating at 100, Wardour Street, London W1. Ms Arch exhibits at TAWA2 copies of a restaurant review and articles which have been obtained via the Internet. She notes that two of the references are dated 31 December 2001 and December 2003. The menus exhibited show use of MEZZO. The article dated 31 December 2001 includes the following:

“None of London's most high-profile restaurants of the past decade – Quaglinos, Mezzo, Nobu, The Atlantic or Harvey Nichols Vth Floor.....”

The article from December 2003 is a restaurant review of MEZZO by Tracy Yam. The article refers to Conran (just the surname). Pages downloaded from the “View London” website on 14 March 2005 contain a review of MEZZO at 100, Wardour Street (there is another reference to Conran). The final part of exhibit TAAW2 are pages relating to modern British restaurants in London; this includes a short guide to MEZZO. The restaurant is referred to as being part of “Terrance (sic) Conran's culinary empire”.

### **Gusto's evidence**

8) This consists of a witness statement by Christina Di Georgi. Ms Di Georgi is a director of Gusto. She states that Sir Terence's restaurant now operates under the name Meza rather than MEZZO.

9) Ms Di Georgi states that Gusto started trading in 1968, having been set up by her father. It traded in Italian food and wine. In 1976 it opened its first restaurant, Don Vitos, in Pilgrim Street in Newcastle-upon-Tyne. Subsequently a further three restaurants have been opened under the names Paradiso, Popolo and Seco. Ms Di Georgi states that INTERMEZZO began trading in 2001.

10) Ms Di Georgi states that INTERMEZZO is situated as a link to the Tyneside Theatre. It has a capacity of thirty five people. It has the shape and style of a railway carriage. There is no hot food provision. Ms Di Georgi states that coffee sales make up fifty five per cent of its turnover, around thirty three per cent is made up of cocktails/spirits/ wine sales and between twelve and thirteen per cent is made up of food sales (mainly sandwiches). There are also some cold, salad based products sold. Ms Di Georgi states that this is a very different mix from the supplied by Sir Terence.

Ms Di Georgi exhibits at CDG1 a copy of the INTERMEZZO coffee bar cocktail menu and at CDG2 the INTERMEZZO coffee bar menu along with a selection menu and a selection of the daily specials list. At CDG3 she exhibits copies of restaurant reviews and articles that have been published about INTERMEZZO. These are from “Essential Newcastle and Gateshead”, “Metro Life” for 26 September 2001, “Essential Newcastle” for November 2003, a piece without provenance, two pieces from “Newcastle Inside + Out The Inside Edge” and a duplication of the “Metro Life” article.

11) Ms Di Georgi states that she does not consider that the trade marks are similar and states that quite clearly the services are not similar.

## **DECISION**

### **Likelihood of confusion – section 5(2)(b) of the Act**

12) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

13) Sir Terence’s registration is an earlier trade mark within the terms of section 6(1)(a) of the Act.

14) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

### **Comparison of services**

15) Gusto has not requested proof of use of the services upon which Sir Terence has claimed that the trade mark has been used:

*catering services, restaurant, cafeteria, bistro, wine bar, food bar, snack bar and catering establishment services.*

Ms Di Georgi does not consider that the above services are similar to:

*coffee shop and restaurant services.*

Gusto does not appear to understand the considerations that need to be made in relation to deciding if services are similar or identical. It is not a matter of the differences that exist between the restaurant services supplied by the two sides that is to be considered but the comparison of the services as defined by the specifications. In *Daimlerchrysler AG v Office for Harmonization In the Internal Market (Trade Marks and Designs)* [2003] ETMR 61 the Court of First Instance (CFI) stated:

“46 However, contrary to what the Office argues, the Court finds that a sign's descriptiveness must be assessed individually by reference to each of the categories of goods or service listed in the application for registration. For the purposes of assessing a sign's descriptiveness in respect of a particular category of goods or service, whether the applicant for the trade mark in question is contemplating using or is actually using a particular marketing concept involving goods and services in other categories in addition to the goods and services within that category is immaterial. Whether or not there is a marketing concept is of no consequence to the right conferred by the Community trade mark. Furthermore, since a marketing concept is purely a matter of choice for the undertaking concerned, it may change after a sign has been registered as a Community trade mark and it cannot therefore have any bearing on the assessment of the sign's registrability.”

In *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 147/03 the CFI held:

“104 Consideration of the objective circumstances in which the goods covered by the marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.....

107 It follows that by taking into consideration in the assessment of the likelihood of confusion between the marks the particular circumstances in which the goods covered by the earlier mark are marketed, the temporal effect of which is bound to be limited and necessarily dependent solely on the business strategy of the proprietor of the mark, the Board of Appeal erred in law.”

Geoffrey Hobbs QC, sitting as the appointed person, in *Croom's Trade Mark Application* [2005] RPC 2, stated:

“31 When assessing the objections to registration in the present case, it is necessary to assume normal and fair use of the marks for which registered trade mark protection has been claimed. The context and manner in which the

marks have actually been used by the applicant and the opponent in relation to goods of the kind specified may be treated as illustrative (not definitive) of the normal and fair use that must be taken into account. However, the protection claimed by the opponent independently of registration ( *i.e.* under s.5(4)(a) of the Act) must relate to the actual and anticipated use of the rival marks.”

There can be doubt that the services of the application are encompassed by those of the earlier registration. **Consequently, the respective services are identical.** (The reason that the services are in different classes is that from 1 January 2002 services for providing foods and drink moved from class 42 to class 43 (a new class).

### Comparison of trade marks

16) The trade marks to be compared are:

**Earlier registration:**

**MEZZO**

**Gusto’s application:**



17) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* ). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). “The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public” (Judgment of the Court of First Instance (CFI) in *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02 [2005] ETMR 22).

18) The services of the application are used by everyone and so the average consumer is the public at large. The degree of attention paid to the supply of such services can be variable; one might just be popping in somewhere that is convenient or one might be carefully considering where to go out to dine. I have to consider both scenarios and all those in between. Consequently, it could well be that the public at large will not make a particularly careful and educated decision in deciding to avail itself of the services of either side. This would give a greater likelihood of imperfect recollection.

19) In *José Alejandro SL v Office for Harmonization in the Internal Market (Trade Marks and Designs), Anheuser-Busch Inc Intervening* (Case T-129/01) [2004] ETMR 15 the CFI stated:

“The Court notes that the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark.”

This is a view that the CFI has also upheld in *Koubi v OHIM – Flabesa (CONFORFLEX)* Case T-10/03, paragraph 60 and *Grupo El Prado Cervera v OHIM – Debuschewitz (CHUFAFIT)* Case T-117/02, paragraph 51. Gusto has referred to the presence of the words COFFEE BAR in its trade mark. In relation to the services COFFEE BAR is descriptive, it will not be considered by the average consumer to have trade mark significance. I consider that the background and graphic elements of Gusto’s trade mark are not the distinctive and dominant elements of the trade mark. I have no doubt that the distinctive and dominant element of Gusto’s trade mark is the word INTERMEZZO. It is how the establishment is referred to in the press articles.

20) An intermezzo is a short piece of instrumental music which is performed between the acts or scenes of an opera or drama., it also is used to describe an instrumental piece between two longer movements and is another name for an interlude. Mezzo is term in music meaning moderately quiet. It is also often used as a shortened form for mezzo soprano, a female singer whose voice is between that of soprano and contralto. In considering whether there is a conceptual similarity, dissimilarity or a neutral position, I have to take into account the perception of the average consumer of the services. In my experience the majority of people do not have a knowledge of musical terminology. There will be those who are interested in what is commonly referred to as classical music who will be likely to have heard the terms and, hopefully, know what they refer to. I consider that the average consumer will not have an interest in classical music and will not know what the terms mean. I doubt that even those who know the Leslie Howard and Ingrid Bergman film “Intermezzo” will have a knowledge of the musical meaning or of its meaning as an interlude. (It is very likely that Gusto, owing to its Italian traditions, would know of the meaning and may well have chosen it because of the meaning; the premises being located close to a place where performances occur. However, this does not represent the perception or knowledge of the average consumer; for the services in the specification the average consumer could be visiting all sorts of types of establishment throughout the United Kingdom.) There well may be some who know that both terms relate to music but not know their specific meanings. For those people there would be a conceptual association between the trade marks, both relating to music. However, I am not convinced that for the average consumer that the words will have any meaning; they will just be foreign sounding words. (I include in this absence of knowledge, the meaning of intermezzo as an interlude as well as its musical meaning.) In *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 147/03 the CFI stated:

“98 It is true that, according to case-law, a conceptual difference between the marks at issue may be such as to counteract to a large extent the visual and aural similarities between those signs (*BASS*, cited in paragraph 60 above,



paragraph 54). However, for there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately.”

In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-135/04 a similar position was taken:

“78. The Court cannot uphold the applicant’s argument that the earlier mark refers to the concept of an autobus, and there is no need to take a view on OHIM’s argument that a like reference characterises both signs. It is common ground that the services concerned have no link whatsoever with public transport. Even if it is indeed the case that the conceptual analysis of a sign is not invalidated by the fact that the meaning of that sign bears no relation to the services concerned, the fact remains that that meaning must be clear, so that the relevant public are capable of grasping it immediately (see, to that effect, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel*(BASS) [2003] ECR II-4335, paragraph 54). In the circumstances, in view of the nature of the services in question, the relevant public will not spontaneously associate the word ‘bus’ with a means of public transport.”

In the circumstances of this case, and on the basis of the evidence before me, I cannot find that the trade marks are either conceptually similar or dissimilar, as far as the average consumer is concerned. The position is, in my view, a neutral one; for the average consumer the words MEZZO and INTERMEZZO will have no meaning. By a neutral position I mean that a conceptual comparison of the trade marks neither assists Sir Terence nor Gusto.

21) The point of convergence of the two trade marks is the word MEZZO. In the case of Sir Terence’s trade mark there is nothing else. Gusto’s trade mark includes a graphical element and the words COFFEE BAR. As I have indicated earlier the distinctive and dominant element of Gusto’s trade mark is INTERMEZZO. I am of the view that the dominant part of INTERMEZZO both to the eye and to the ear is the word MEZZO; it is in my view a very strong element. In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-135/04 the CFI stated:

“59. It should be noted in this connection that the fact that one component of the signs at issue is identical does not lead to the conclusion that the signs are similar unless it constitutes the dominant element in the overall impression created by each of those signs, such that all the other components are insignificant (*MATRATZEN*, paragraph 33).”

Geoffrey Hobbs QC, sitting as the appointed person, stated in *Torremar* [2003] RPC 4:

“At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in

the context of the marks as a whole, as origin specific (see, for example, *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713) or origin neutral (see, for example, *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283).”

In considering the respective trade marks I need to consider the effects of the differences as well as the similarities (see *Croom’s Trade Mark Application* [2005] RPC2).

22) Section 5(2)(b) of the Act, for a likelihood of confusion to be considered, requires that trade marks are similar. It is not a matter of whether they have similarities but whether they are similar; it will be a rare case where an opposition has been brought where there are no similarities. Without a decision that the trade marks are similar the case must fail. The global appreciation can only come into play when it has been decided that the trade marks are similar/identical and the goods/services are similar/identical. As the ECJ stated in *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM)* C-106/03 P [2005] ETMR 23:

“53 After making a comparative study, at paragraphs 48 to 59 of the judgment under appeal, of the two marks in the visual, aural and conceptual senses, the Court of First Instance concluded, as stated at paragraph 65 of the judgment, that the marks could in no way be regarded as identical or similar for the purposes of Article 8(1)(b) of Regulation No 40/94.

54 Having found that there was no similarity between the earlier mark and the mark applied for, the Court of First Instance correctly concluded that there was no likelihood of confusion, whatever the reputation of the earlier mark and regardless of the degree of identity or similarity of the goods or services concerned.”

It is difficult to make a purely a priori judgement as to whether signs are similar. In practical terms part of the judgement will be a posteriori; taking into account all the relevant factors in relation to a global appreciation, is there a possibility of likelihood of confusion? If there is such a possibility, then the trade marks are similar for the purposes of section 5(2)(b) of the Act. If there is not, they are not. This is not to state that a finding of confusion will be an automatic sequitur where the trade marks are similar; merely that, subject to there being similarity/identity of the goods/services, the global appreciation can take place and a decision as to confusion can be made on the basis of that global appreciation. Having decided that trade marks are similar it will also be necessary to consider the degree of similarity.

23) The sequitur of my findings in relation to the conceptual meanings of MEZZO and INTERMEZZO is that for the average consumer of the services that the terms will be effectively invented words. Consequently, the average consumer will have no conceptual hook upon which to hang his recollection of the trade marks. Taking this into account, and the nature of the services, I consider that the average consumer will be likely to be prey to imperfect recollection (he or she seldom has the opportunity to compare trade marks directly).

23) In this case, considering the trade marks in their entirety, the distinctive and dominant elements of the trade marks, the nature of the services and the average consumer, I find that the trade marks enjoy a degree of visual and phonetic similarity and, overall, are similar. I consider that the degree of similarity is not at the top end of the scale but lies a little way above the bottom end of the scale.

## Conclusion

24) In coming to a conclusion I have taken into account the submissions of Sir Terence which comment on, inter alia, the distinctiveness of his trade mark and the similarity of the trade marks.

25) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case the services are identical. This helps compensate for the limited degree of similarity of the trade marks. It is necessary to consider the distinctive character of the earlier trade mark, the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (CFI Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). 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, the judgment of 4 May 1999 of the ECJ in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585). MEZZO does not describe a characteristic of the services that Sir Terence supplies; it does not allude to them. I consider that a strong and robust trade mark for the relevant services and will have a greater capacity to distinguish the services of Sir Terence. So this assists the case of Sir Terence. **Taking into account the average consumer and his or her perception and the nature of the services, I find that the average consumer will believe that the services come from the same undertaking or an economically linked undertaking (see *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). There is a likelihood of confusion and the application should be refused in its entirety.**

## **COSTS**

26) Sir Terence Orby Conran having been successful is entitled to a contribution towards his costs. I order Gusto UK Limited to pay Sir Terence Orby Conran the sum of £800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 20 day of January 2006**

**David Landau  
For the Registrar  
the Comptroller-General**