

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE
MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of an application for the registration of Trade Mark No. 252502 and in the matter of an Opposition thereto.

S&N Star Pizza Limited

Applicant

Four Star Pizza (Ireland) Limited


Opponent

The Application

1. On 4 March 2015 S&N Star Pizza Limited (hereinafter “the Applicant”), of 46 Talbot Street, Dublin, Ireland made application (No. 2015/00449) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register STAR PIZZA as a trade mark in respect of “*Pizza Shop, Pizzeria, Pizza Restaurants, Pizza Takeaway*” in Class 43. Advertisement of the acceptance of the application was published in Journal No. 2281 dated 20 May, 2015.
2. Notice of Opposition to the registration of the mark, pursuant to Section 43 of the Act, was filed on 19 August, 2015 by Four Star Pizza (Ireland) Limited (hereinafter “the Opponent”) of 1C Woodlands Office Park, Bray, Co. Wicklow, Ireland. The Applicant filed a Counter Statement on 30 October, 2015 and evidence was then filed under Rules 20 and 21 of the Trade Mark Rules, 1996 (“the Rules”). The Opponent filed written submissions in lieu of attending at a Hearing, while the Applicant did not file written submissions or seek a Hearing.
3. Acting for the Controller, I decided to uphold the opposition and to refuse to allow the application to proceed to registration. The parties were informed of my decision by way of letter dated 14 July, 2017. 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) of the Rules.

Grounds of the Opposition

4. In its Notice of Opposition, the Opponent identifies itself as the Proprietor of the following Trade Mark:

| | | | |
|------------|---|--|---------------------------------------|
| No. 125253 | <p style="text-align: center;">FOUR STAR PIZZA</p>  | Class 30: Pizzas, sandwiches, food preparations. | Registration Date: 6 February 1987 |
|------------|---|--|---------------------------------------|

6. The Opponent then raises objection to the present application under Sections 8 and 10 of the Act, which I shall summarise as follows:

Section 8(1)(b) – *the mark is devoid of any distinctive character;*

Section 8(1)(c) – *the mark consists exclusively of signs which designate the quality of the services;*

Section 10(2)(b) – *the likelihood of confusion on the part of the public, and the likelihood of association with the Opponent’s earlier FOUR STAR PIZZA (logo) mark;*

Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent’s mark;*

Section 10(4)(a) – *use of mark is prohibited by the law of passing off.*

Counter Statement

7. In its Counter Statement the Applicant denies all the grounds of opposition. The Applicant says it has been successfully trading under the name STAR PIZZA at its Dublin premises since January 2012. It says the Applicant became aware that similar type businesses in Wexford and Limerick have commenced trading using the name and logo “Star Pizza” without having any business association, connection, or having obtained the permission of the Applicant to so trade under the name “STAR PIZZA”. Accordingly, the Applicant sought to have its business name registered as a trade mark in accordance with the Act.
8. While the Applicant accepts the Opponent has a recognised trade mark and an associated reputation in the business of pizza delivery, it strongly denies that if the trade mark at issue was registered, that it would cause confusion in the marketplace. It argues the average observant and discerning consumer would not form the view that the Opponent is responsible for the product and service provided by the Applicant.
9. The Applicant then went on to argue that the mark applied for is clearly distinctive and distinguishable in the public mind from the Opponent’s mark. While it is not usual for Applicant’s to set out their arguments in their Counter Statement, I mention them now as

the Applicant did not attend at a Hearing or lodge written submissions in lieu of attending at a Hearing. The Applicant laid out its case as follows:

- a. While both trade marks contain the word “Star” it is the case that in respect of the Opponent’s mark the word “Star” is only ever used in the context of the two-word combination “Four Star”. The phrase “Four Star” is more than a mere co-location of both words and is sufficiently known as a phrase in its own right and is clearly distinguishable by the average consumer, who is reasonably observant and discerning, from the word “Star” used singularly.
- b. When the phrase “Four Star” is considered as a whole (in accordance with the appropriate test) and assessed against the word “Star”, there is no confusion and both phrases are clearly distinguishable and distinctive from each other.
- c. “Star” is a particularly common word which regularly appears in the logo of a vast array of products. The presence of this word in the Opponent’s phrase “Four Star” does not have any connection, association or significance for the product in which the Opponent trades. Accordingly, the Opponent does not have any grounds to state that the word “Star” is particularly associated in the public mind with its business.
- d. The trade marks are visually different from each other in terms of design, logos, colour and typeface. When the average consumer views the signs, and taking the overall impact of each sign as a whole, they would not believe that they represented the same thing. The average consumer would experience no confusion and would be clearly aware that each sign represented a different and distinct commercial entity.
- e. From an aural perspective both marks are distinct and distinguishable from one another. “Four Star” must be taken as a whole and is clearly aurally distinguishable from the word “Star” when heard on its own.
- f. While it is accepted that the Opponent within the context of pizza delivery offers its own menus, deals, pricing, etc. in the public mind the Opponent would be associated generally with the provision of pizza delivery. Accordingly, there is nothing unique about the product provided by the Opponent that is associated exclusively with its trade mark.

Rule 20 Evidence

10. Evidence filed by the Opponent under Rule 20 consists of a Statutory Declaration, dated 28 July 2016, of Brian Clarke, Director of Marketing for Four Star Pizza, and four exhibits labelled “STAR PIZZA1” to “STAR PIZZA4”.
11. Mr. Clarke says his company is a fast food pizza company which operates throughout Ireland. As of August 2015, there were 31 stores operating under the name FOUR STAR PIZZA. He attaches at Exhibit “STAR PIZZA 1” pictures of the shopfronts of a selection of these stores. He says that every pizza sold in the stores is placed in a box bearing the trade mark FOUR STAR PIZZA and he attaches at Exhibit “STAR PIZZA 2” a picture of the box.
12. He says FOUR STAR PIZZA is one of the leading pizza brands in Ireland and he provides details of turnover and advertising in respect of the brand during the period 2009-2014 as follows:

| Year | Sales Value | Advertising Expenditure |
|--------------|--------------------|--------------------------------|
| 2009 | €15.5 million | €465,000 |
| 2010 | €14 million | €420,000 |
| 2011 | €13 million | €390,000 |
| 2012 | €13 million | €390,000 |
| 2013 | €15.5 million | €465,000 |
| 2014 | €17 million | €510,000 |
| Total | €88 million | €2.64 million |

13. Mr. Clarke states his company’s advertising primarily has been in the form of radio advertisements, billboards and digital advertising. He attaches at Exhibit “STAR PIZZA 3” samples of such advertisements, all of which he says were used prior to March 2015, though none of the materials contain anything to show their date of production or use.
14. Mr. Clarke attached a picture of the frontage of the Applicant’s shop in Dublin at Exhibit “STAR PIZZA 4”. He draws attention to use by the Applicant of the symbol ® in conjunction with the applied for STAR PIZZA mark, which indicates that the mark is a registered trade mark. He says that use of the ® symbol in the absence of trade mark

registration is an offense under the Trade Marks Act, 1996. Furthermore, he notes there is an image of a star between the words STAR and PIZZA, which he says is an obvious attempt to trade on his company's goodwill.

Rule 21 Evidence

15. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration, dated 21 November 2016, of Silviu Cires, Managing Director of S&N Star Pizza Limited, and three accompanying exhibits marked "SC1" to "SC3".
16. Mr. Cires states the Applicant has been successfully trading under the name Star Pizza at its premises in Talbot Street, Dublin since January 2012. It is a very successful business with an annual turnover of €646,600 and employs 14 staff. He attaches at Exhibit "SC1" details of returns made to the Revenue Commissioners between March 2014 and August 2016.
17. He says, because of this success, his company is in the process of acquiring the lease of another commercial premises in order to expand. He says the Applicant is fully entitled to aspire to develop and grow and, accordingly, registering its trade mark is of the utmost importance to the business.
18. Mr. Cires then goes on to address the evidence filed by the Opponent under Rule 20. He compares photographs of the front of his premises (attached at Exhibit "SC2") with those of the Opponent and claims the photographs show the respective party's businesses are completely different and that a reasonable and discerning customer would not mistake one for the other.
19. He also contrasts his business with the Opponent's in terms of his being "Eat In or Take Out" which provides seating for 30 customers, whereas the Opponent's is, as far as he is aware, either take-away or delivery. He also compares his company's menu (a copy of which he attaches at Exhibit "SC3") to that of the Opponent and says that this item also demonstrates the dissimilarity between the party's respective businesses.
20. Mr. Cires states that while he accepts the Opponent has a recognised trade mark and an associated reputation in the pizza delivery business, he strongly denies that the trade mark applied for, if registered, would cause confusion or uncertainty in the public mind, such

that the average observant consumer would form the view that the Opponent is responsible for the product or services provided by the Applicant.

21. He then goes on to compare the respective marks from a visual and verbal perspective, paying particular attention to the word elements “Four Star” in the Opponent’s mark and the “Star” in his company’s mark. He reaches the conclusion that the words themselves are sufficiently dissimilar and that the inherent differences are reinforced by the use of different designs, colours and typefaces. The overall result is that the marks would, in his opinion, create a different impression on the average consumer.

Written Submissions

22. The Opponent chose not to lodge any evidence under Rule 22, but elected to file written submissions in lieu of attending at a hearing. The submissions were filed by Mr. Cliff Kennedy, Trade Mark Attorney of MacLachlan & Donaldson. The Applicant did not elect to file written submissions or to attend at a hearing.

23. In his submission Mr. Kennedy maintains all the grounds of opposition and sets out arguments, including citing legal authorities, to support them. He concentrates primarily on the grounds related to Section 10(2)(b) of the Act, and this is where I shall commence my deliberations.

Section 10(2)(b)

24. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

(2) A trade mark shall not be registered if because –

(a)

(b) it is similar to an earlier trade mark and would 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 of the later trade mark with the earlier trade mark.

25. As is evident from the wording of Section 10(2), the four basic requirements that must be met for an objection under it to succeed are that, (i) there must be “an earlier trade mark”, (ii) the goods or services of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, (iii) the mark applied for must be similar to that earlier trade mark, and, (iv) there must be a resultant likelihood of confusion on the part of the public.
26. The first of these conditions is fulfilled as the Opponent’s Trade Mark Registration No. 125253 was filed at this Office on 6 February, 1987 and by virtue of Section 11(1)(b) of the Act, it is an earlier trade mark as against the present application for the purposes of Section 10.

Comparison of the goods and services

27. There is ample case law to guide competent authorities in their comparison of goods and/or services. In *Canon*¹ the Court of Justice of European Union found that “*In assessing the similarity of the goods, all the relevant factors relating to those goods should be taken into account, including, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary*”. In *monBeBé*² the Court found that “*Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned*”.
28. The Applicant seeks registration of the disputed mark in respect of “*Pizza Shop, Pizzeria, Pizza Restaurants, Pizza Takeaway*” services in Class 43. A fundamental and indispensable element of such services is the sale of pizzas, which is one of the goods for which the Opponent’s earlier mark is registered. The sale of pizzas and the provision of pizza restaurant services are not merely complementary but are in direct competition, whereby consumers seeking a pizza choose either to purchase a ready-made variety from a pizza manufacturer or a made-to-order product from a pizza restaurant or takeaway.
29. The intended purpose of pizza restaurants is to prepare, cook and provide pizzas to order for consumption on or off the premises. The intended purpose of traders of pizzas is to provide consumers with pizzas, which may or may not be cooked. Therefore, the intended purpose is virtually the same. Also, in theory, pizza restaurants constitute one of the

¹ Case C-39/97 *Canon v Metro-Goldwyn-Mayer Inc.* [1998] ECR I-5507 at paragraph 23

² Case T-164/03 *Ampafrance v OHIM – Johnson & Johnson* [2005] ECR II-1401, paragraph 53

possible distribution channels for the pizzas covered by the Opponent's earlier mark. Accordingly, I must find that the services for which the Applicant seeks registration to be very similar to the Opponent's pizza goods. But I will return to this finding later when I am considering the question of the likelihood of confusion.

Similarity of the marks

30. Turning now to the third requirement: the mark applied for must be similar to the earlier mark. In his Statutory Declaration Mr. Cires states that while both marks contain the word "Star", in the Opponent's mark the word is only ever used in the context of the two-word combination "Four Star". The phrase "Four Star" is more than a mere co-location of both words and is sufficiently known as a phrase in its own right, to be clearly distinguishable to the average consumer. When the phrase "Four Star" is considered and assessed against the word "Star" there is no confusion.

31. In his written submissions Mr. Kennedy conducts a comparison from a verbal, visual and conceptual perspective and, not surprisingly, reaches a different conclusion. He argues the respective marks are confusingly similar and refers to several cases from the Court of Justice of the European Union (CJEU) and decisions from the Boards of Appeal of the European Union Intellectual Property Office to support his arguments.

32. 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. 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 seeks registration.

33. The marks at issue (shown below) are not complex, but nonetheless I have undertaken a detailed comparison, bearing in mind the CJEU noted (in *Sabel*³) that the average consumer normally perceives a mark as a whole and does not analyse its various details.



STAR PIZZA

³ *Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*

34. Clearly the marks share some visual similarity as both contain the words “Star” and “Pizza”. The words are in black type in both marks and the fonts used are very similar. The Opponent’s mark contains an additional word – FOUR, and a device consisting of four white stars on a black background with two parallel white lines, one above and the other below the four white stars, given the effect of four stars on a banner. While there are some differences between the respective marks, the Applicant’s mark is fully reproduced in the Opponent’s mark. In my opinion, from a visual perspective, the marks share a medium level of similarity.
35. The aural difference between the marks is also centred on the additional word FOUR in the Opponent’s mark. I find from an aural point of view the marks are far more similar than dissimilar. I would assess the degree of aural similarity as high.
36. Conceptually the Applicant’s mark conveys the message that the pizzas are either star shaped, or more obviously, are of star quality, whereas the Opponent’s mark would instinctively be recognised as conveying the singular message that the pizza is of a very high quality. I find the quality messages are fundamentally the same. In that respect the marks share a high level of conceptual similarity. This being so, when considered in conjunction with what I have already found regarding the verbal and visual similarities, it leads me to conclude the marks share a high degree of overall similarity.

Likelihood of confusion

37. In his Statutory Declaration Mr. Cires accepts the Opponent has a reputation in its mark where he states “...*the Opponent herein has a recognised trade mark and an associated reputation in the business of pizza delivery...*”, but goes on to deny that the registration of the Applicant’s mark “...*would cause confusion or uncertainty in the public mind, such that an average, observant and discerning consumer would form the view that the Opponent is responsible for the product and service provided by the Applicant.*”
38. Mr. Cires also makes numerous points about the differences between the respective parties in terms of their shop-fronts, premises, menus, use of colours, and business models. These things may indeed be different, but they are not relevant to the question at hand. The issue to be determined concerns whether there is similarity between the marks, and if so, would that similarity be likely to result in confusion in the marketplace. That

question must be answered with due regard to how the courts have interpreted the legislation and to the vast body of relevant decisions issued by the courts.

39. It is clear the basic ingredients of an objection under Section 10(2)(b) of the Act – earlier trade mark which is similar to the disputed mark and highly similar goods or services – are present in this case. The issue now rests on whether as a consequence there is a likelihood of confusion on the part of the purchasing public.

37. The kind of confusion that Section 10(2)(b) seeks to avoid is concerned solely with the commercial origin of goods, whereby the average consumer, being familiar with goods sold under the earlier mark and, because of the similarity in the respective marks, attributes to the services offered under the disputed mark the qualities and characteristics that he associates through experience with the goods offered under the earlier mark. The question is whether the average person, who knows of pizzas sold under the Opponent's trade mark FOUR STAR PIZZA (logo) who then encounters the Applicant's pizza restaurant services under the trade mark STAR PIZZA, would assume that the latter services were connected to the former goods and were made available to consumers by the same undertaking or by commercially related undertakings.

38. The principles to be applied in determining an objection under Section 10(2)(b) of the Act are not in dispute. They have been set out in detail in several decisions of the Court of Justice of the European Union (CJEU)⁴ and their applicability in an Irish context has been affirmed by the High Court (by Finlay-Geoghegan J) in *Cofresco Frischaltheprodukte GmbH & Co. KG –v- The Controller of Patents, Designs and Trade Marks and Reynolds Metals Company*⁵. In summary, these principles are:

- (i) The likelihood of confusion must be appreciated globally, having regard to all the relevant factors, including the degree of similarity between the marks and between the goods or services, and the likelihood that the public will make an association between the earlier mark and the mark seeking registration;

⁴ including Case No. C-251/95, *Sabel BV v Puma AG and Rudolf Dassler Sport*, Case No. C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* and Case No. C-342/97, *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel BV*

⁵ Unreported decision dated 14 June, 2007

- (ii) The matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (iii) The similarity between the marks must be determined by reference to the degree of visual, aural and conceptual similarity between them and the importance to be attached to each of these elements must be assessed by reference to the category of goods and the circumstances in which they are marketed;
- (iv) The average consumer normally perceives a mark as a whole and does not analyse its various details;
- (v) 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;
- (vi) The higher the distinctiveness of the earlier mark, whether inherent or acquired through use, the greater the protection granted to it;
- (vii) 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. However, if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

40. Having applied the criteria to the facts of the present case, I find the Opponent's mark has a very low level of inherent distinctiveness in respect of pizzas. The term FOUR STAR PIZZA of itself is, in my opinion, nothing other than laudatory, as it clearly denotes a high-quality pizza. The figurative element does not play an independent role in the mark and does nothing other than reinforce the words FOUR STAR.

41. However, the evidence provided by the Opponent demonstrates the mark has acquired a significant level of distinctiveness through the use made of it. At the relevant date the Opponent had 31 stores in operation across the State, including in all major cities. As such, it is not unreasonable to infer that most Irish pizza consumers would have been

aware of the Opponent. In that sense the Opponent's mark, at the relevant date, had undoubtedly acquired the capacity to identify pizzas that originated with the Opponent, and thus to distinguish them from the pizzas of other undertakings.

42. The overall impression created by the marks in question is that they are very similar. Visually, verbally and conceptually they share an overall high level of similarity. Furthermore, the whole of the Applicant's mark is contained within the Opponent's mark. I have also found the goods and services are very similar in that pizzas are an essential element in the provision of pizza restaurant services.
43. The foregoing would generally lead me to conclude that there would be a likelihood of confusion on behalf of consumers. I have also mentioned that the services of pizza restaurants are similar to pizza goods. However, that finding was based on what I would describe as a theoretical test, rather than a real-life examination, which considers the actual marketplace. The distinction concerns the theory that in the case of certain goods served in restaurants that are bought in (for example, coffee, wine or beer) there could be confusion if the trade mark on those goods was similar to the trade mark of the restaurant. (This is analogous to many a dispute regarding goods being retailed in retail outlets that operate under similar brands to the brand of the goods, particularly in the clothing and footwear arena).
44. However, in this case there is a very important consideration regarding the area of trade under investigation. That is that pizza restaurants make their pizzas fresh and to order. They generally make their own dough, but even if they do not, they always apply the sauce and toppings to create the finished product before baking. In that regard, there can never be a doubt about the origin of the pizza. In my opinion, consumers who avail of the services of pizza restaurants would never think the pizza they ordered originated from anyone other than the restaurant itself. So, while I have already found that, in theory, pizza restaurants may be a distribution channel for (mass-produced) pizza suppliers, the reality of the pizza restaurant business clearly demonstrates that that is not the case.
45. I have found that the marks share a high level of similarity and that the goods and services are very similar. However, neither are identical. I have also found that the pizzas restaurants never buy in branded pizzas, but always produce their own in-house. In light

of this crucial factor I am satisfied that the marks and or goods and services would have to be virtually identical before the average pizza consumer would be likely to be confused. I find that there is just sufficient difference between the marks FOUR STAR PIZZA (logo) and STAR PIZZA to ensure that, in pizza supply and restaurant businesses, that confusion would not arise.

46. Having considered all the evidence, submissions and the relevant case-law and put myself in the shoes of the average consumer of pizza restaurant services, I am satisfied that the use by the Applicant of its STAR PIZZA mark would not cause consumers to believe that its services originated from the proprietor of the FOUR STAR PIZZA (logo) mark or that there was an economic link between the Applicant and the Opponent. Accordingly, I find the application does not offend against Section 10(2)(b) of the Act and I dismiss the opposition.

Section 10(3)

47. Turning now to the Opponent's claim that use of mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's mark. Other than the Opponent making this claim in its Notice of Opposition and Mr. Kennedy repeating it in his written submissions, on the basis that the words STAR PIZZA are an important element in the Opponent's mark, this claim was not particularised. There was no argument as to how the Applicant's use of its STAR PIZZA mark would dilute the distinctive character of the Opponent's mark or how it would tarnish the Opponent's mark, or how it would take unfair advantage of the goodwill attached to the Opponent's mark.

48. In his Statutory Declaration Mr. Clarke did point to the photograph (exhibited at "STAR PIZZA 4") of the front of the Applicant's shop depicting an image of a single white star between the words STAR and PIZZA, which he claims shows an obvious attempt to trade on his company's goodwill. I disagree. I find, if anything, the image of one star positioned between the words STAR and PIZZA just reinforces the concept of a single star and drives home the difference between the Applicant's (single) STAR and the FOUR STARS of the Opponent's mark.

49. It appears the Opponent is suggesting that because the respective marks share a degree of similarity then it must follow that unfair advantage would be taken. While I have found the marks are similar and that the Opponent's mark has acquired a significant degree of distinctiveness through the use made of it, much more is required to refuse an application based on Section 10(3). There must be evidence of a change in the economic behaviour of the average consumer of the goods for which the Opponent's mark is registered that is a direct consequence of the use of the Applicant's mark, or a serious likelihood that such a change will occur in the future. Evidence would have to show that the value attached to the goods sold under the Opponent's earlier trade mark, earned as a result of its reputation, is likely to be reduced by an amount that is more than *de minimis*. No such evidence was advanced and accordingly I must reject the opposition based on Section 10(3) of the Act.

Section 10(4)(a)

50. The Opponent also claimed the application should be refused because its use is liable to be prevented by the law of passing off. This claim also was not particularised and no evidence was advanced to support it. Mr. Kennedy did argue that because of the close links between the respective purposes of the goods/services and the possibility that they might be produced by the same operators or sold together, the goods and services may be linked in the mind of the relevant public. This is a far cry from what is required to reject an application under the law of passing off. The elements necessary to make a finding that the ingredients for a claim to passing off exist are specifically (i) the Opponent must have goodwill and a reputation in its earlier made (ii) there must be misrepresentation by the Applicant (whether or not intentional) leading or likely to lead the public to believe that the goods or services of the Applicant are those of the Opponent and (iii) that the Opponent would suffer damage by reason of the erroneous belief engendered by the Applicant's misrepresentation that the source of the Opponent's goods or services is the same as the source of those offered by the Opponent.

51. I have already found pizza restaurants trade in fresh made-to-order produce, which the Applicant provides under its own brand. The Applicant's restaurant front, signage and its menus all point to a business trading under the brand STAR PIZZA, and which confirms the Applicant's operation is sufficiently removed from that of the Opponent. I am satisfied the Applicant was trading under STAR PIZZA and was not attempting in any way to link

its services with the goods of the Opponent. Nor can I accept the possibility that the Applicant's actions could be deemed to result in unintentional passing off. Furthermore, no evidence whatsoever was advanced to suggest the Applicant was passing off its pizzas as those of the Opponent. Accordingly, the claim based on passing off must be rejected and I dismiss the opposition on this ground.

Sections 8(1)

39. I now turn to the grounds of opposition concerning Section 8(1)(b) and (c) of the Act. In his submission Mr. Kennedy considers these two provisions in tandem; the relevant parts of which read as follows:

8.(1) The following shall not be registered as trade marks:

(a) ...

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.

40. Section 8(1)(b) prohibits the registration of marks that are devoid of distinctive character. Unlike sections 8(1)(c) it does not give any clear definition as to the nature of the objection. It is concerned with the prohibition on registering marks which, while not offending against the specific parameters set out in Sections 8(1)(c), nonetheless still do not fulfil the essential function of a trade mark. That is, they do not identify goods and services of one undertaking from those of another. Therefore, Section 8(1)(b) has separate and independent scope from section 8(1)(c).

Section 8(1)(b)

41. The determination of whether a mark is devoid of distinctive character must be conducted with regard to the goods and services at issue and with regard to the relevant class of person to whom the goods and services are directed. This assessment must be conducted on a global basis without dissecting or examining the different elements that make up a composite mark. The Applicant has sought registration for the STAR PIZZA for the provision of a specific type of restaurant services, namely, “*Pizza Shop, Pizzeria, Pizza Restaurants, Pizza Takeaway*”, but importantly not for pizzas *per se*. While the term contains the word pizza, it does not refer specifically to pizza restaurant services, and as

such, is cannot be deemed to be devoid of any distinctive character in relation to those services. Accordingly, I must reject the opposition insofar as it is grounded on Section 8(1)(b) of the Act.

Section 8(1)(c)

42. A fundamental difference between Section 8(1)(b) and Section 8(1)(c) is that that the former concerns itself with the issue of whether the mark is distinct from, i.e. does not directly refer to, the actual goods or services for which registration is sought, as distinct from the latter which is concerned with the mark making a direct reference to characteristics of the goods or services for which registration is sought. Accordingly, while I have already stated the Applicant has not sought registration for pizzas *per se*, for the purposes of determining these proceedings under Section 8(1)(c) of the Act, I cannot consider the services provided by pizza restaurants in isolation from the pizza products these establishments serve and whether the disputed mark STAR PIZZA is a characteristic of these services and products.
43. While ultimately the assessment must be conducted on a global basis it can be of assistance to examine the different elements that make up a composite mark. The word STAR is readily understood to refer to a celestial body, a geometric shape, or to mean something or someone that is celebrated, distinguished or preeminent. It is used as a merit award symbol, a rating scale or as a mark of excellence. The word PIZZA refers to a well-known item of food. In its totality, the term STAR PIZZA is readily understood to mean a pizza of quality – one that would be rated above the average standard, or a pizza that is star-shaped.
44. Therefore, it does not require any stretch of the imagination to regard one possible meaning of the sign “STAR PIZZA” as a direct reference to the quality of the pizzas offered as part of the Applicant’s pizza restaurant services. Section 8(1)(c) specifically prohibits the registration of marks that refer directly to the quality characteristics of the goods or services. In my opinion STAR PIZZA refers directly to the quality of pizza on offer and I am satisfied the term must remain available for use by all traders in the pizza restaurant business, who may wish to describe one of their offerings as their “Star Pizza”.
45. Equally, the term STAR PIZZA may be taken to be a direct reference to the shape of the pizzas provided by the Applicant’s restaurant. Pizzas are generally round, but do come in

other shapes, particularly squares, or other four-sided figures and are often sold as individual slices in what can be described as triangular-shaped. While star-shaped pizzas are far less prevalent, they are not uncommon and a cursory search of the Internet will return many results. Accordingly, I must arrive at the obvious conclusion that the term STAR PIZZA may be a reference to the shape of the pizzas served in the Applicants establishments, which cannot be allowed to be monopolised by the Applicant.

Decision

46. Section 8(1)(c) prohibits the registration of marks which “*may serve, in trade, to designate the kind, quality ...*” of the goods or services. This must be interpreted to mean that so long as it is possible that the mark directly refers to any of the characteristics listed in Section 8(1)(c), or other characteristics which may be particular to a specific area of trade, irrespective of other possible meanings of the mark, then registration must be refused.

47. I have found the mark STAR PIZZA is not capable of acting as a source indicator for the services for which registration is sought, as it can directly refer to both the quality and shape of pizzas offered by restaurant service providers. Accordingly, I must refuse the application as it offends against the provisions of Section 8(1)(c) of the Act.

Dermot Doyle

Acting for the Controller

20 February 2018