

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2138251
BY THE INN ON THE GREEN LIMITED
TO REGISTER A TRADE MARK IN
CLASS 42**

AND

**OPPOSITION No 49886 THERETO BY
HOTEL ON THE GREEN LIMITED,
TRADING AS THE INN ON THE GREEN**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2138251**
by The Inn on the Green Limited to register a
trade mark in Class 42

and

10 **Opposition No 49886 thereto by Hotel on the**
Green Limited, trading as the Inn on the Green

15 **BACKGROUND**

On 8 July 1997, The Inn on the Green Limited, Cookhamdean, Berkshire, applied under
No 2138251 to register as a series of two trade marks THE INN ON THE GREEN and INN
20 ON THE GREEN. The specification of services fell into Class 42 and were as follows:

Restaurant services; café services; provision of food and drink; bar services.

The application was accepted and subsequently published for the purposes of opposition on
25 17 March 1999.

On 17 June 1999, Hotel on the Green Limited filed notice of opposition to this application.
The Grounds of Opposition were, in summary, as follows:

- 30 1. Under the provisions of Section 3(1)(a) - because the trade mark does not meet the
definition of a trade mark as set out in Section 1(1) of the Act.
- 35 2. Under Section 3(1)(c) and (d) - because the trade mark in suit consists exclusively
of signs which serve in trade to designate the geographical origin (or other
characteristics) of the services or which consists exclusively of signs or indications
which have become customary in the current language of the trade.
- 40 3. Under the provisions of Section 5(2)(b) - presumably because the opponent
considers they or others have an earlier trade mark as defined in Section 6 of the Act
(though no details are given).
- 45 4. Under Section 5(4)(a) - again, presumably, because the opponent considers that
they (or others) have an earlier right which could be used to prevent the use of the
trade mark in suit under the provisions of the common law tort of passing off.

The opponent asks for an award of costs in their favour.

The applicant for registration, through its trade mark attorneys, Gallafent & Co, filed a counterstatement. They consider that the trade mark in suit did possess a distinctive character, met the requirements of Section 1(1) and were not excluded from registration by the provisions of Section 3(1). If they were excluded from registration under the provisions of
5 Section 3(1) then their use of the trade mark without the benefit of registration would be sufficient, in their view, to fall within the proviso to Section 3(1) such as to enable the proprietors to secure registration. The Grounds of Opposition under Section 5(2)(b) and Section 5(4)(a) were denied.

10 The applicant for registration refers in their counterstatement to observations filed in respect of the application and the subject of consideration by the Registrar. I am not aware of the content of these and have taken no cognisance of them in reaching the decision in this case.

15 Only the opponent filed evidence in the proceedings but both the applicant and the opponent were offered a hearing. Neither took up the invitation. Therefore acting for the Registrar and after careful study of the Statement of Grounds in support of the opposition, the counterstatement and the evidence filed by the opponents I give this decision.

20 Opponents' evidence

This consists of a Statutory Declaration dated 20 December 1999 by Philip Hibberd, the Managing Director of Hotel on the Green Limited, the opponent in these proceedings.

25 Mr Hibberd states that he is aware of at least 13 Inns or Hotels throughout the United Kingdom (including his own establishment) which trade under the name (The) Inn on the Green. In support of that statement he produces a copy of a Yellow Pages search. This consists of a list of businesses which have the name of either The Inn on the Green or Inn on the Green dispersed throughout England.

30 In addition, correspondence is exhibited to demonstrate that the Inn on the Green located in Bishops Castle, Shropshire, the Inn on the Green located at Ingham, Lincolnshire, the Inn on the Green located in Maidstone, Kent and Inn on the Green, Bude, Cornwall were all using their names prior to the date of application in this case.

35 On the basis of the above, Mr Hibberd expresses the opinion that the phrase The Inn on the Green is commonly used as a trading name for public houses or hotels which offer food and accommodation and which stand close to a village green. Therefore, the term is purely descriptive and is not capable of distinguishing the services of one undertaking from those of another. Mr Hibberd goes on to state that the opponent is the proprietor of a hotel and
40 restaurant situated in Glasgow which trades under the name The Inn on the Green (the hotel being located beside a well known Glasgow green) and that they made first use of the trading name The Inn on the Green in 1984 and have made continued use of the name since then. In support of that he produces a number of articles and advertising material which purport to show use of the name The Inn on the Green by the opponent in the period 1984 to 1999. I
45 will refer to that later in the decision.

DECISION

I deal first with the Ground of Opposition based upon Section 3(1)(a) and Section 1(1) of the Act. These two Sections state as follows:

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3.-(1) The following shall not be registered -

(a) signs which do not satisfy the requirements of section 1(1),

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1.-(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

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A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

In relation to Section 3(1)(a) I note the observations of Aldous L J in *Philips Electronica MB v Remington Consumer Products Ltd* [1999] RPC 809 where he said:

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"The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing those goods from similar goods of another trader. An example of a trade mark which is capable of distinguishing is WELDMESH, whereas WELDED MESH would not be. The former, despite its primary descriptive meaning, has sufficient capricious alteration to enable it to acquire a secondary meaning, thereby demonstrating that it is capable of distinguishing. The latter has no such alteration. Whatever the extent of the use, whether or not it be monopoly use and whether or not there is evidence that the trade and the public associate it with one person, it retains its primary meaning, namely mesh that is welded. It does not have any feature which renders it capable of distinguishing one trader's mesh from other traders' welded mesh."

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It seems to me that those observations can equally be applied to a trade mark, as in this case, in relation to services. The more the trade mark describes the services provided under the trade mark then the less likely it will be that it can distinguish services of one provider from another. In my view, the term THE INN ON THE GREEN (INN ON THE GREEN) does not describe the services provided, (or proposed to be provided), under that trade mark. It cannot be assumed looking at either of those terms that the establishment concerned will provide restaurant services, or café services, or indeed food at all, although one would normally assume that drink and bar services would be available from an establishment by the name of THE INN ON THE GREEN. In my view therefore the term INN ON THE GREEN can function as a trade mark in that it consists of words which taken as a whole can distinguish the services of one provider from those of another. No evidence has been filed which would infer otherwise. The ground of opposition based upon Section 3(1)(a) is therefore dismissed.

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The next grounds of opposition are based upon Sections 3(1)(c) and 3(1)(d). These state:

3.-(1) The following shall not be registered -

- 5 (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,
- 10 (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

15 In considering the matter under these heads I take into account first of all the Trade Mark Registry's guidance set out in the Work Manual at Chapter 6 in relation to the acceptance or otherwise of public house names as trade marks. This states:

PUBLIC HOUSES: NAMES

20 The issue is whether the name is common to the trade not just whether some other business has adopted the same name. Pub names can be trade marks and relative grounds objections should be dealt with in the usual way. In the case of an obscure pub name this means that anyone who claims to be the owner of an earlier unregistered mark will have to oppose to prevent registration. Objection should not usually be

25 taken simply because there are one or two pubs listed on Phonedisc with the same name. Some names are frequently used for public houses e.g. RED LION, WHITE HORSE, PRINCE OF WALES. Dunkling and Wrights "Dictionary of Pub Names" is one source of names common to the trade. If a pub name is common it cannot be a distinctive mark and should be objected to under Section 3(1)(b) and (d) prima facie as

30 being devoid of any distinctive character.

As the opponent has not drawn to my attention any deficiencies in the examination of this application I assume that the Trade Marks Examiner accepted the application for registration in suit for the trade mark THE INN ON THE GREEN (INN ON THE GREEN) having

35 considered the reference material set out in the Work Manual. The opponent has not drawn my attention to entries in either the British Telecommunication Phonedisc or Dunkling & Wrights Dictionary of Pub Names. They have, however, put in evidence that other businesses trade under the name INN ON THE GREEN or THE INN ON THE GREEN. This is the list taken from Yellow Pages and exhibited to Mr Hibberd's statutory declaration. Though the list

40 does not bear a date I am prepared to accept that it is a list of businesses in operation under those names on or before the date of application in this case. I am also prepared to accept that most if not all will be engaged in providing the services of an Inn in terms of bar services. That said, it does not seem to me that the terms INN ON THE GREEN or THE INN ON THE GREEN are so common as to indicate the geographical origin of a service provided

45 under the trade mark or indeed so common as to label it one which is or has become customary in the current language of the trade.

There are countless numbers of "Greens" throughout the length and breadth of the United Kingdom, whether they be in the middle of cities, towns or villages. There are also many Inns, Public Houses and Hotels sitting on or adjacent to these greens. From my own observations very few of these are called INN ON THE GREEN or THE INN ON THE GREEN and this seems to be born out by the relatively small numbers of establishments thrown up by Yellow Pages. In those circumstances it seems to me that the opponent's evidence does not provide me with sufficient material to say that the Trade Mark Examiner was wrong in reaching the view that, prima facie, the trade mark the subject of this application should be accepted for registration. The evidence does not show sufficiently that the trade marks are ones which indicate a geographical location or indeed are used as a matter of course by any establishment serving food and drink and located next to an area of green or common land. In those circumstances the grounds of opposition based upon Sections 3(1)(c) and (d) are dismissed.

The last two grounds of opposition are based upon Section 5(2)(b) and Section 5(4)(a) which state:

"5.-(2) A trade mark shall not be registered if because -

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

5.-(4) 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 of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or"

An earlier trade mark is defined at Section 6 which states:

"6.-(1) In this Act an "earlier trade mark" means -

(a) 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;

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK); or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be

an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

5 (3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry."

10 No details of any earlier trade mark has been brought to my attention and therefore I dismiss summarily the ground of opposition based upon Section 5(2)(b).

15 In respect of the ground of opposition based upon Section 5(4)(a) I bear in mind the decision of Mr Geoffrey Hobbs QC acting as the Appointed Person in WILD CHILD Trade Mark [1998] RPC at page 460 where he said:

"A helpful summary of the elements of an action for passing off can be found in *Halsbury's Laws of England* (4th Edition) Vol. 48 (1995 reissue) at paragraph 105. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] RPC 341 and *Erven Warnink BV v. J Townend & Sons) (Hull) Ltd* [1979] A.C. 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- 25 (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- 30 (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

35 The restatement of the elements of passing off in the form of this classical trinity has been referred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of "passing off", and in particular should not be used to

40 exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

45 Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 18.1 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstance.

The first thing I need to decide is whether the opponent's services provided under the term The Inn On The Green, have acquired a reputation and goodwill such that it could be held that use by the applicant of their trade mark is likely to lead the public to believe that the applicant's services are those of the opponent and whether the opponent is likely to suffer damage as a result.

The evidence by the opponent in support of the claim under Section 5(4) is set out in Exhibit PH6 to Mr Hibberd's statutory declaration. This consists of advertisements in the Glasgow Herald dated 1994, an example of a letterhead which shows the name The Inn On The Green and the address of the business in Glasgow, a review of the Inn On The Green in the Evening Times (presumably a Glasgow newspaper) dated April 13 1988 and a review in something called The Life And Soul Of Glasgow dated 21 October 1999. No evidence of turnover or the

number of customers in the period prior to the date of application are given. In the circumstances, I am unable to determine whether or not the opponent in this case has or had a reputation, local or otherwise, which satisfies the first of the three elements which were set out by the House of Lords. As the first is not satisfied it is not possible to determine whether there is any likelihood of misrepresentation and leading on from that whether damage would be caused. The ground of opposition under Section 5(4)(a) is therefore not made out and the opposition on that ground is dismissed.

The opposition has failed on all of the grounds on which it was based and is therefore dismissed entirely. The applicant is entitled to a contribution towards its costs. I order the opponent to pay to the applicant the sum of £150. This is based on the fact that the applicant was not required to file any evidence and there was no hearing. This sum 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 17th day of October 2000

**M KNIGHT
For the Registrar
the Comptroller General**