

O/079/21

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3298814
BY CAVIAR HOLDINGS INC.**

**TO REGISTER THE FOLLOWING MARKS AS A SERIES IN CLASSES
9, 14, 16, 18, 25, 32, 35, 38, 41 & 43:**

MARQUEE

marquee

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 413287 BY
ROOF DECK ENTERTAINMENT LLC**

BACKGROUND AND PLEADINGS

1. Caviar Holdings Inc (“the applicant”) applied to register the series of trade marks shown on the front page of this decision in the United Kingdom on 22 March 2018. The application was accepted and published on 15 June 2018 in respect of goods and services in Classes 9, 14, 16, 18, 25, 32, 35, 38, 41 and 43. A full specification can be found in the Annex to this decision. Throughout this decision, I shall refer to the first mark in the series as “the plain word mark” and the second as “the stylised word mark” where it is relevant to distinguish between them.

2. On 2 August 2018, the application was partially opposed by Roof Deck Entertainment LLC (“the opponent”). The partial opposition is based on sections 5(1) and 5(2)(a) and (b) of the Trade Marks Act 1994 (“the Act”) and concerns the following goods and services:

Class 32

Beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages.

Class 35

Management and operation of restaurants, clubs, bars, recreational facilities for others; retail services, on-line retail services and electronic shopping services all in connection with beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices; information, consultancy and advisory services in relation to all the aforesaid services.

Class 41

Entertainment, sporting and cultural activities; organising of entertainment and social events; entertainment services provided at nightclubs; nightclub and discotheque services; provision of live entertainment; live entertainment services; musical entertainment services; arranging of musical entertainment; services providing entertainment in the form of live musical performances; organising of exhibitions and show for entertainment purposes; production, presentation, distribution, syndication, and/or rental of television and radio programmes and/or films and sound video recordings; entertainment services relating to competitions; provision of entertainer,

amusement, leisure and recreation facilities, services and amenities; organisation of parties and events; club entertainment services; organisation of recreational activities, quizzes, games and competitions; art gallery services; art exhibition services; reservation services for show tickets; provision and production of information relating to entertainment and music; cabaret, theatre, casino and gaming (primarily for entertainment) services; providing non-downloadable audio, visual and audio visual recordings via the Internet; publishing and providing printed publications and electronic publications; providing online electronic publications; information, consultancy and advisory services in relation to all the aforesaid services.

Class 43

Services for providing food and drink; preparation of food and drink; restaurant services for the provision of fast food; self-service restaurants; takeaway, café, cafeteria, canteen, coffee shop and snack-bar services; wine bar services; catering services for the provision of food and drink; club services for the provision of food and drink; night club services (provision of food); information, consultancy and advisory services in relation to all the aforesaid services.

3. The opponent is relying on EU Trade Mark (EUTM) No. 15626096, which has an application date of 8 July 2016 and a registration date of 7 November 2016.¹ It is shown below:



The EUTM is registered for the following services, all of which the opponent is relying upon:

Class 41

Night clubs; beach clubs; entertainment services including parties, special events, dance and music events.

¹ Although the UK has left the EU and the transition period has now expired, EUTMs and International Marks which have designated the EU for protection are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SI 2019 No. 269, Schedule 5. Further information is provided in Tribunal Practice Notice 2/2020.

Class 43

Restaurants; bar services; cocktail lounge services; hotels; temporary accommodation; cafes; catering services; public house services; wine bars; take-away services, booking and reservation services for restaurants.

4. The opponent claims that the marks are identical or at least visually “closely” similar and otherwise identical, and that the goods and services covered by the marks are identical and highly similar. As a result of these similarities, submits the opponent, there is a likelihood of confusion (including a likelihood of association) on the part of the public in the UK.

5. On 8 October 2018, the applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of use of the earlier mark. It admits that this mark is not caught by the provisions of section 6A of the Act, as it completed its registration procedure within the five years prior to the application date of the contested mark. Rather, it states that the request is based on

“... recent case law that shows that the owner of a trade mark refiling the same mark in order to evade the requirements to use the mark should expect to be deemed to be acting in bad faith and required to prove actual use of the mark, even if less than five years has passed since the registration of the mark.”

6. The applicant states that it has filed an application for invalidity of the earlier mark before the European Intellectual Property Office (EUIPO) on these grounds and on the basis that the applicant has an earlier right under section 5(4)(a) of the Act.

7. Neither party filed evidence, although the opponent filed written submissions on 13 May 2020. Neither party requested a hearing or made submissions in lieu. I have taken my decision following a careful consideration of the papers.

8. In these proceedings, the opponent was represented by Taylor Wessing LLP and the applicant by Trade Mark Owners Association Limited.

DECISION

9. Although the UK has left the European Union, section 6(3)(a) of the European (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 Act relied on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the EU courts.

Section 5(1)

10. Section 5(1) of the Act is as follows:

“A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

11. An “earlier trade mark” is defined in section 6(1) of the Act as:

“(a) a registered trade mark, international trade mark (UK), a European Union trade mark or international trade mark (EC) 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 European Union trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired,

(ba) a registered trade mark or international trade mark (UK) which –

(i) has been converted from a European Union trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, 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 or the WTO agreement as a well known trade mark.”²

12. The registration upon which the opponent relies qualifies as an earlier trade mark under the above provision. The opponent is relying upon all the services for which this earlier mark is registered. As the mark was registered within the five years before the application date of the contested mark, it is not subject to proof of use.

13. I have noted that the applicant makes its request for proof of use on the basis of a claim that the opponent has acted in bad faith in applying for the earlier mark. The appropriate way to pursue such claims would be to file an application for invalidation of the earlier mark at the EUIPO, and the applicant has done so. For the purposes of these proceedings, the opponent is entitled to rely on all the services for which the mark stands registered.

14. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (CJEU) held that:

“... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”³

² As the proceedings were begun before the end of the transition period following the UK’s departure from the EU, the applicable law is as it was before the changes made by the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, SI 2019 No. 269.

³ Paragraph 54.

15. The earlier mark is the word “MARQUEE” presented in capital letters. The majority of the letters appear in a standard font, but the way that “Q” is shown is unusual, with the tail of the letter appearing as a diamond at the 180° point of the circle. The whole word is underlined. I recall that a plain word mark covers use of that mark in any standard font or capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17. Even so, I consider that the font used in the earlier mark is not standard and the differences would not go unnoticed by the average consumer.

16. The opposition under section 5(1) fails.

Section 5(2)

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

(2) 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.”

18. As I found that the marks were not identical, the opposition under section 5(2)(a) also fails, so I shall move on to consider the section 5(2)(b) ground.

19. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the 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 Office for Harmonisation in the Internal Market (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):

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

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 goods and services

20. When comparing the goods and services, all relevant factors should be taken into account, per *Canon*:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary.”⁴

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity

⁴ Paragraph 23.

between goods or services. The General Court (GC) clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06:

“... 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.”⁵

22. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as “complementary” and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chickens* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC, sitting as the Appointed Person, noted in *Sandra Amalia Mary Elliot v LRC Holdings (LUV/LOVE Trade marks)*, BL O-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

And

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

23. Guidance was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281. At [296], he identified the following relevant factors:

⁵ Paragraph 82.

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

24. The goods and services to be compared are shown in the table below:

Earlier services	Contested goods/services
<p><u>Class 41</u> <i>Night clubs; beach clubs; entertainment services including parties, special events, dance and music events.</i></p> <p><u>Class 43</u> <i>Restaurants; bar services; cocktail lounge services; hotels; temporary accommodation; cafes; catering services; public house services; wine bars; take-away services, booking and reservation services for restaurants.</i></p>	<p><u>Class 32</u> <i>Beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages.</i></p> <p><u>Class 35</u> <i>Management and operation of restaurants, clubs, bars, recreational facilities for others; retail services, on-line retail services and electronic shopping services all in connection with beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit</i></p>

Earlier services	Contested goods/services
	<p><i>juices; information, consultancy and advisory services in relation to all the aforesaid services.</i></p> <p><u><i>Class 41</i></u> <i>Entertainment, sporting and cultural activities; organising of entertainment and social events; entertainment services provided at nightclubs; nightclub and discotheque services; provision of live entertainment; live entertainment services; musical entertainment services; arranging of musical entertainment; services providing entertainment in the form of live musical performances; organising of exhibitions and show for entertainment purposes; production, presentation, distribution, syndication, and/or rental of television and radio programmes and/or films and sound video recordings; entertainment services relating to competitions; provision of entertainer, amusement, leisure and recreation facilities, services and amenities; organisation of parties and events; club entertainment services; organisation of recreational activities, quizzes, games and competitions; art gallery services; art exhibition services; reservation services for show tickets; provision and production of information relating to entertainment and music; cabaret, theatre, casino and gaming (primarily for entertainment) services; providing non-downloadable audio, visual and audio visual recordings via the Internet; publishing and providing printed publications and electronic publications; providing online electronic publications; information, consultancy and</i></p>

Earlier services	Contested goods/services
	<p data-bbox="770 248 1394 331"><i>advisory services in relation to all the aforesaid services.</i></p> <p data-bbox="770 398 895 432"><u>Class 43</u></p> <p data-bbox="770 450 1394 981"><i>Services for providing food and drink; preparation of food and drink; restaurant services for the provision of fast food; self-service restaurants; takeaway, café, cafeteria, canteen, coffee shop and snack-bar services; wine bar services; catering services for the provision of food and drink; club services for the provision of food and drink; night club services (provision of food); information, consultancy and advisory services in relation to all the aforesaid services.</i></p>

25. My interpretation of these terms will be guided by the following case law. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... 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."

26. In *Sky Plc & Ors v Skykick UK Ltd & Anor* [2020] EWHC 990 (Ch), Arnold LJ set out the following summary of the correct approach to interpreting broad and/or vague terms:

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

(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.”⁶

27. I also bear in mind the decision Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *SEPARODE Trade Mark*, BL O-399-10, where he said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”⁷

28. Finally, I note that in *Gérard Meric v OHIM*, Case T-133/05, the GC stated that:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

⁶ Paragraph 56.

⁷ Paragraph 5.

designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”⁸

Beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages

29. These are all drinks that would be consumed for the purpose of quenching the drinker’s thirst, although in the case of *Beers* the consumer may also wish to become intoxicated.

30. I shall consider *Beers* first. The opponent’s earlier services include *Bar services* and *public house services*. These establishments are places where the consumer would go to enjoy drinks and company. The physical nature of goods and services is clearly different, but the trade channels overlap and the users are the same. There is also some complementarity, as the drinks are indispensable for the provision of bar and café services. The average consumer may assume a connection between the undertakings supplying the goods and services, particularly in the case of beer sold through public houses. In *Group Lottus Corp., SL v OHIM*, Case T-161/07, the GC held that in view of the complementarity, target audience and overlapping points of sale, there was a “lesser” [low] degree of similarity between beers and bar, nightclub and cocktail bar services. I find that there is a low degree of similarity between the contested *Beers* and the opponent’s *Bar services* and *public house services*.

31. I see no reason why the same reasoning should not apply to the applicant’s remaining goods in Class 32 and so I find that *Mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages* are similar to a low degree to the opponent’s *Bar services, cocktail lounge services and cafes*.

⁸ Paragraph 29.

Management and operation of restaurants, clubs, bars, recreational facilities for others; information, consultancy and advisory services in relation to all the aforesaid services

32. These are services that will be supplied to professional customers who wish to offer restaurants, clubs, bars or recreational facilities to their customers, but want the day-to-day running of the services to be the responsibility of another undertaking. They may involve the supply of front-of-house, catering and administrative staff, office services and other administrative functions. The nature of the service, users and purpose are different from those of the opponent's Class 41 and 43 services, which will be used by the general public seeking a meal, a drink or entertainment. They are not in competition and are likely to be provided by different undertakings. In my view, the services are dissimilar.

Retail services, on-line retail services and electronic shopping services all in connection with beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices; information, consultancy and advisory services in relation to all the aforesaid services

33. These services have the same users as the opponent's *Bar services*, and their overlapping purposes. Both provide beverages to the consumer seeking to quench their thirst. The consumer has a choice between going to a bar or a shop selling the drinks, and so there is a degree of competition between the services. I find them to be similar to a low degree.

Entertainment; organising of entertainment and social events; entertainment services provided at nightclubs; provision of live entertainment; live entertainment services; musical entertainment services; arranging of musical entertainment; services providing entertainment in the form of live musical performances; organising of exhibitions and show for entertainment purposes; entertainment services relating to competitions; organisation of parties and events; club entertainment services

34. The opponent's specification includes the term *Entertainment services including parties, special events, dance and music events*. In my view, the average consumer

would assume that parties, special events, dance and music events would not be the only ones covered by such a term, although they may be the most important ones. Consequently, I construe this term to refer to *Entertainment services* broadly. The contested services listed above are all self-evidently identical to *Entertainment services*.

Sporting activities

35. I shall compare the applicant's *Sporting activities* to the opponent's *Beach clubs*. The opponent has not provided a definition of this term, but I understand it to mean clubs that provide a range of recreational activities at a seaside location and it is my view that these activities would include sports, either in the sea or on the beach itself. On the *Meric* principle, they are identical.

Cultural activities

36. *Entertainment services* could include *cultural activities* and so I find that they are identical on the *Meric* principle. If they are not identical, then they are highly similar.

Nightclub and discotheque services

37. *Nightclub ... services* are self-evidently identical to the opponent's *nightclubs*. The average consumer would, in my view, expect the services provided by *nightclubs* to include *discotheque services* and so these are identical under *Meric*.

Production, presentation, distribution, syndication, and/or rental of television and radio programmes and/or films and sound video recordings; providing non-downloadable audio, visual and audio visual recordings via the Internet

38. I turn now to the applicant's *production, presentation, distribution, syndication ... of television and radio programmes and/or films and sound video recordings*. While the programmes, films and recordings would be likely to be used for the purposes of entertaining the viewers or listeners, to my mind the core meaning of this term (in its entirety) should be understood to mean more technical services that are supplied to

broadcasters or other content providers. The users will therefore be different from those of the opponent's *Entertainment services including parties, special events, dance and music events*, as will the nature of the service, trade channels and purpose. They are not in competition and neither do I find them to be complementary. In my view, they are dissimilar.

39. The applicant's *Rental of television and radio programmes and/or films and sound video recordings; providing non-downloadable audio, visual and audio visual recordings via the Internet* have the same users as the opponent's *Entertainment services* and overlapping purposes. The trade channels will be different, but there is a degree of competition. I find the services to be similar to a medium degree.

Provision of entertainer, amusement, leisure and recreation facilities, services and amenities

40. The applicant's *Provision of entertainer, amusement, leisure and recreation facilities, services and amenities* is included in the opponent's broader *Entertainment services*. I find them to be identical under the *Meric* principle.

Organisation of recreational activities, quizzes, games and competitions

41. These are also covered by the opponent's *Entertainment services* so under *Meric* I find them to be identical.

Art gallery services; art exhibition services

42. These services involve the presentation of collections and exhibitions for the public to view paintings, photographs, sculpture, installations and other forms of visual art. The users are the general public and they will use those services for their entertainment, enjoyment and education. There is therefore an overlap in purpose and users with the opponent's *Entertainment services*. The trade channels will be different. There is a degree of competition as the user will choose how to spend their leisure time and budget. I find them to be similar to a medium degree.

Reservation services for show tickets

43. These services enable the user to obtain tickets for shows and would be delivered online or through a physical box office or ticket agency. There will be an overlap in users and the purpose, nature of service and trade channels are similar to those of the opponent's *Booking and reservation services for restaurants*. They are not in competition or complementary. I find the services to be similar to a medium degree.

Provision and production of information relating to entertainment and music

44. These services would be used by members of the public who want to find out what events are going to take place, background information on, for instance, performers and composers, career advice – in short, any information relating to entertainment and music. The users will be the same as those for *Entertainment services* and there will be an overlap in the nature of service and trade channels, as the information may be provided through an entertainment event, although it is more likely that print, online channels or broadcast media would be used. The services are complementary, but not in competition. Overall, I find them to be similar to a medium degree.

Cabaret, theatre, casino and gaming (primarily for entertainment) services

45. These services would be included in the opponent's *Entertainment services* and so are identical under *Meric*.

Publishing and providing printed publications and electronic publications; providing online electronic publications

46. The purpose of these services is to provide information to the user, although they may also seek to be entertained. The users are the same, but the services do not share trade channels with those for which the opponent's mark is registered and are neither in competition nor complementary. I find them to be dissimilar to the opponent's services.

Services for providing food and drink; preparation of food and drink; restaurant services for the provision of fast food; self-service restaurants; takeaway, café, cafeteria, canteen, coffee shop and snack-bar services; wine bar services; catering services for the provision of food and drink; club services for the provision of food and drink; night club services (provision of food); information, consultancy and advisory services in relation to all the aforesaid services

47. These services are all encompassed by the opponent's *catering services* and *bar services*. Under the *Meric* principle, I find them to be identical.

Conclusion

48. I found the applicant's goods and services to be either identical or similar, except for the following:

Class 35

Management and operation of restaurants, clubs, bars, recreational facilities for others; information, consultancy and advisory services in relation to all the aforesaid services.

Class 41

Production, presentation, distribution and/or syndication of television and radio programmes and/or films and sound video recordings; publishing and providing printed publications and electronic publications; providing online electronic publications; information, consultancy and advisory services in relation to all the aforesaid services.

49. Where the services are dissimilar, there is no likelihood of confusion to be considered: see *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA. The opposition fails with respect to the services listed above.

Average Consumer and the Purchasing Process

50. In *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J 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 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.”⁹

51. For the purposes of identifying the average consumer and the degree of attention they will be paying during the purchasing process, I have divided the goods and services into the following groups: entertainment services; restaurants, catering and bars; and drinks and the retailing of drinks.

52. For all the goods and services, the average consumer is a member of the general public, although in the case of bars, casinos and beer they will also be an adult.

53. Entertainment services range in price from expensive tickets to high-profile rock concerts to lower cost entry tickets to venues such as night clubs. Whatever the cost, the consumer will be paying sufficient attention to decide whether they are likely to enjoy that particular service. They will, in my view, be paying a medium degree of attention. While they may hear the services advertised on the radio or by word-of-mouth recommendation, they are more likely to see adverts in the street, on television or in printed publications or use the Internet to help them decide. The visual element would therefore carry more weight.

54. Restaurants, catering and bar services also vary greatly in price. The average consumer will be paying sufficient attention to assess whether the food and/or

⁹ Paragraph 60.

beverages on offer suit their palate and dietary requirements, whether the ambience of the restaurant or bar pleases them, and whether the services are within their budget. These factors suggest to me that they will be paying a medium degree of attention. When choosing a service, they will see signage on the street, advertisements in printed publications, on television or online, so the visual element will have a significant role to play. However, in my view the aural element will also be important, as these are services that are likely to be recommended by word-of-mouth.

55. Beer is sold through a variety of trade channels, including retail outlets such as supermarkets and off-licences and their online equivalents. Here the consumer would generally select the goods themselves from the shelf or the website and would see the mark on the product. Where beer is bought in a public house or bar, the consumer will also see the mark on dispensers at the bar, on bottles, or on a drinks menu. The visual element will therefore play a significant role in both these scenarios. In a bar, though, as the beer will be ordered from a member of staff, the aural element will also be relevant, although to a lesser degree than the visual. The cost of the goods is relatively low, but the average consumer will still want to ensure that they are choosing the correct size, type, strength and flavour of the beer. In my view, they will pay a medium degree of attention.

56. With the exception of *syrups and other preparations for making beverages*, which will be sold through supermarkets and food shops, the remaining Class 32 goods share the same trade channels as beer. In my view, the same considerations apply. Although it is possible that the average consumer will be paying a slightly lower degree of attention than with beer, as they do not have to consider the strength of the products, the fact that they are going to put the goods into their bodies leads me to find that this will not be at the lowest level. The visual element will play the largest part, although the aural element is also relevant.

57. When choosing a retailer of drinks, the average consumer would see the mark in printed publications, online or in the street and the visual element is therefore the most important. However, I do not discount aural considerations, as there may be a role for word-of-mouth recommendations. The degree of attention they pay is likely to depend on whether the purchase is a planned one or a more impromptu decision. Overall, I

consider that the average consumer would pay no more than a medium degree of attention.



Comparison of marks

58. 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.”¹⁰

59. 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.

60. The respective marks are shown below:

Earlier mark	Contested series of marks
 The image shows the word "MARQUEE" in a tall, condensed, sans-serif font. A horizontal line is drawn underneath the letters.	 The image shows two versions of the word "MARQUEE". The top version is in a bold, all-caps, sans-serif font. The bottom version is in a bold, lowercase, sans-serif font.

¹⁰ Paragraph 34.

61. Earlier in my decision, in paragraph 15, I compared the marks for the purposes of the section 5(1) ground. There I was required to consider whether the marks were identical. I found that they were not.

62. The overall impression of both marks, to my mind, is the word MARQUEE. The fonts used in the earlier mark and the stylised contested mark do not, in my view, detract from that impression.

63. The fonts used, and the underlining in the earlier mark, are the only visual differences between them. I find them to be highly visually similar. They are, though, aurally identical.

64. The average consumer will understand the word “MARQUEE” to mean a large tent, often used for special events such as weddings or garden parties. Both marks convey an identical concept.

Distinctive character of the earlier mark

65. 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 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).”

66. The opponent has filed no evidence, so I have only the inherent distinctiveness to consider. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

67. The word MARQUEE is a dictionary word with the meaning that I have identified in paragraph 64 above. Some of the opponent’s services may be provided in marquees at the type of event I have already outlined. This is unlikely to be the case for *night clubs* and *booking and reservation services for restaurants* and so the inherent distinctiveness of the mark will be at a medium level. It will be lower in the case of *Entertainment services including parties, special events, dance and music events* and *catering services*.

Conclusions on likelihood of confusion

68. 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. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services or vice versa. It is necessary for me to take account of the distinctive character of the opponent’s mark, the average consumer and the nature of the purchasing process for the contested goods and services. In doing so, I must be aware 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.

69. 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:

“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.’”¹¹

70. Earlier in my decision I found that the marks were visually highly similar and aurally and conceptually identical. Indeed, the only visual differences are those of typeface and the underlining in the earlier mark. If the average consumer were to compare the marks side-by-side, they would notice the difference, but it is settled case-law that opportunities for such a comparison rarely occur. It is my view that the average consumer will recall the word “MARQUEE”, not the variations of presentation that occur in the marks in issue.

71. The interdependency principle comes into play here. Even where the goods and services are similar to only a low degree, the high degree of similarity between the marks leads me to find that the average consumer is likely to be directly confused and mistake one mark for the other.

¹¹ Paragraph 16.

72. The partial opposition succeeds under section 5(2)(b) with respect to all the contested goods in Class 32, all the contested services in Class 43, and the following services in Classes 35 and 41:

Class 35

Retail services, on-line retail services and electronic shopping services all in connection with beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices; information, consultancy and advisory services in relation to all the aforesaid services.

Class 41

Entertainment, sporting and cultural activities; organising of entertainment and social events; entertainment services provided at nightclubs; nightclub and discotheque services; provision of live entertainment services; musical entertainment services; arranging of musical entertainment; services providing entertainment in the form of live musical performances; organising of exhibitions and show for entertainment purposes; rental of television and radio programmes and/or films and sound video recordings; entertainment services relating to competitions; provision of entertainer, amusement, leisure and recreation facilities, services and amenities; organisation of parties and events; club entertainment services; organisation of recreational activities, quizzes, games and competitions; art gallery services; art exhibition services; reservation services for show tickets; provision and production of information relating to entertainment and music; cabaret, theatre, casino and gaming (primarily for entertainment) services; providing non-downloadable audio, visual and audio visual recordings via the Internet; information, consultancy and advisory services in relation to all the aforesaid services.

Outcome

73. The partial opposition has been partially successful and the application may, subject to the outcome of Opposition No. 413728 against the same application, proceed to registration with respect to the following goods and services:

Class 9

Apparatus for recording, transmission or reproduction of sound and/or images; compact discs, DVDs and other digital recording media; magnetic data carriers; magnetic and/or smart cards; scanners; readers for magnetic data carriers, cameras; records, discs, laser discs, digital versatile discs, videos, tapes, cassettes, cartridges, cards and other carriers bearing or for use in bearing sound, video, data or digital recordings; computer hardware and software; computer software supplied over the Internet; music, images, recordings and publications (downloadable) provided on-line from databases or the Internet; sound recordings in the form of phonograph records, discs and tapes; video recordings in the form of discs and tapes; discs and tapes, all for recording sound and/or vision; cassettes and cartridges all for use with or containing video and sound recordings; cinematographic films; sunglasses; eyewear; eyeglass cases, chains and cords; audio and video recordings; eBooks; binoculars; computer accessories; radios; portable music players; headphones; telephones; batteries.

Class 14

Jewellery, imitation jewellery; chronometric and horological instruments; watches; cases for watches; clocks; key rings and key chains; cufflinks; tie pins; medallions; ornaments [jewellery]; badges of precious metals; key fobs; parts and fittings for the aforesaid goods.

Class 16

Paper and cardboard; printed matter; printed publications; books, novels, booklets, magazines, pamphlets; souvenir event programs; tickets; laminated tickets and VIP tickets; photographs; instructional and teaching material (except apparatus); artists' materials; stationery, writing materials, writing paper, envelopes, notebooks, postcards, diaries, note cards; greeting cards, trading cards; posters; pictures; book covers; book marks, book ends, calendars, diaries, gift wrapping paper, paperweights; paper party decorations, including paper napkins, paper doilies, paper place mats, crepe paper, invitations, paper table cloths; printed patterns; paper patterns; photographic or art mounts; prints; engravings.

Class 18

Articles made of leather or of imitation leather, namely attaché cases and brief cases; rucksacks; backpacks; bags, cases; wallets; purses; coin purse; business card cases; card wallets; carryalls; key holders; luggage; umbrellas and parasols; sports bags and holdalls; parts, fittings and accessories for all the aforesaid goods.

Class 25

Clothing, footwear, headgear.

Class 35

Advertising; business management; business administration; business analysis, research and information services; management and operation of restaurants, clubs, bars, recreational facilities for others; retail services, on-line retail services and electronic shopping services all in connection with apparatus for recording, transmission or reproduction of sound and/or images, compact discs, DVDs and other digital recording media, magnetic data carriers, magnetic and/or smart cards, scanners, readers for magnetic data carriers, cameras, records, discs, laser discs, digital versatile discs, videos, tapes, cassettes, cartridges, cards and other carriers bearing or for use in bearing sound, video, data or digital recordings, computer hardware and software, sunglasses, eyewear, eyeglass cases, chains and cords, audio and video recordings, eBooks, binoculars, computer accessories, radios, portable music players, headphones, telephones, batteries, printed publications, books, novels, booklets, magazines, pamphlets, souvenir event programs, tickets, laminated tickets and VIP tickets, photographs, stationery, writing materials, writing paper, envelopes, notebooks, postcards, diaries, note cards, greeting cards, trading cards, posters, pictures, book covers, book marks, book ends, calendars, diaries, gift wrapping paper, paperweights, paper party decorations, photographic or art mounts, prints, engravings, jewellery, imitation jewellery, watches, cases for watches, clocks, key rings and key chains, cufflinks, tie pins, medallions, ornament badges of precious metals, rucksacks, backpacks, bags, cases, wallets, purses, business card cases, card wallets, carryalls, key holders, key fobs, luggage, umbrellas and parasols,

badges, sport bags and holdalls, clothing, footwear, headgear; information, consultancy and advisory services in relation to all the aforesaid services.

Class 38

Telecommunication services; electronic messaging services; provision of wireless internet access services; video, audio and television streaming services; telecommunication services, namely, electronic transmission of streamed and downloadable audio, video, photograph and game files via computer and electronic communications networks; providing on-line facilities, via a global computer network and other computer and electronic communication networks, to enable users to access multimedia content; instant messaging services; providing on-line chat rooms and bulletin boards for the transmission of messages among computer users; provision of information, consultancy and advisory services in relation to all the aforesaid services.

Class 41

Production, presentation, distribution, and/or syndication of television and radio programmes and/or films and sound video recordings; publishing and providing printed publications and electronic publications; providing online electronic publications; information, consultancy and advisory services in relation to all of the aforesaid services.

COSTS

74. Both parties have had a degree of success, with the greater part going to the opponent which is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016 and adjusted to take account of the relative degree of success.

<i>Preparing a statement and considering the other side's statement:</i>	<i>£180</i>
<i>Filing written submissions:</i>	<i>£260</i>
<i>Official fee:</i>	<i>£100</i>

TOTAL:

£540

75. I therefore order Caviar Holdings Inc to pay Roof Deck Entertainment LLC the sum of £540. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 4th day of February 2021

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

Annex

Goods and services applied for

Class 9

Apparatus for recording, transmission or reproduction of sound and/or images; compact discs, DVDs and other digital recording media; magnetic data carriers; magnetic and/or smart cards; scanners; readers for magnetic data carriers, cameras; records, discs, laser discs, digital versatile discs, videos, tapes, cassettes, cartridges, cards and other carriers bearing or for use in bearing sound, video, data or digital recordings; computer hardware and software; computer software supplied over the Internet; music, images, recordings and publications (downloadable) provided on-line from databases or the Internet; sound recordings in the form of phonograph records, discs and tapes; video recordings in the form of discs and tapes; discs and tapes, all for recording sound and/or vision; cassettes and cartridges all for use with or containing video and sound recordings; cinematographic films; sunglasses; eyewear; eyeglass cases, chains and cords; audio and video recordings; eBooks; binoculars; computer accessories; radios; portable music players; headphones; telephones; batteries.

Class 14

Jewellery, imitation jewellery; chronometric and horological instruments; watches; cases for watches; clocks; key rings and key chains; cufflinks; tie pins; medallions; ornaments [jewellery]; badges of precious metals; key fobs; parts and fittings for the aforesaid goods.

Class 16

Paper and cardboard; printed matter; printed publications; books, novels, booklets, magazines, pamphlets; souvenir event programs; tickets; laminated tickets and VIP tickets; photographs; instructional and teaching material (except apparatus); artists' materials; stationery, writing materials, writing paper, envelopes, notebooks, postcards, diaries, note cards; greeting cards, trading cards; posters; pictures; book covers; book marks, book ends, calendars, diaries, gift wrapping paper, paperweights; paper party decorations, including paper napkins, paper doilies, paper place mats,

crepe paper, invitations, paper table cloths; printed patterns; paper patterns; photographic or art mounts; prints; engravings.

Class 18

Articles made of leather or of imitation leather, namely attaché cases and brief cases; rucksacks; backpacks; bags, cases; wallets; purses; coin purse; business card cases; card wallets; carryalls; key holders; luggage; umbrellas and parasols; sports bags and holdalls; parts, fittings and accessories for all the aforesaid goods.

Class 25

Clothing, footwear, headgear.

Class 32

Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 35

Advertising; business management; business administration; business analysis, research and information services; management and operation of restaurants, clubs, bars, recreational facilities for others; retail services, on-line retail services and electronic shopping services all in connection with apparatus for recording, transmission or reproduction of sound and/or images, compact discs, DVDs and other digital recording media, magnetic data carriers, magnetic and/or smart cards, scanners, readers for magnetic data carriers, cameras, records, discs, laser discs, digital versatile discs, videos, tapes, cassettes, cartridges, cards and other carriers bearing or for use in bearing sound, video, data or digital recordings, computer hardware and software, sunglasses, eyewear, eyeglass cases, chains and cords, audio and video recordings, eBooks, binoculars, computer accessories, radios, portable music players, headphones, telephones, batteries, printed publications, books, novels, booklets, magazines, pamphlets, souvenir event programs, tickets, laminated tickets and VIP tickets, photographs, stationery, writing materials, writing paper, envelopes, notebooks, postcards, diaries, note cards, greeting cards, trading cards, posters, pictures, book covers, book marks, book ends, calendars, diaries, gift wrapping paper, paperweights, paper party decorations, photographic or art mounts,

prints, engravings, jewellery, imitation jewellery, watches, cases for watches, clocks, key rings and key chains, cufflinks, tie pins, medallions, ornament badges of precious metals, rucksacks, backpacks, bags, cases, wallets, purses, business card cases, card wallets, carryalls, key holders, key fobs, luggage, umbrellas and parasols, badges, sport bags and holdalls, clothing, footwear, headgear, beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices; information, consultancy and advisory services in relation to all the aforesaid services.

Class 38

Telecommunication services; electronic messaging services; provision of wireless internet access services; video, audio and television streaming services; telecommunication services, namely, electronic transmission of streamed and downloadable audio, video, photograph and game files via computer and electronic communications networks; providing on-line facilities, via a global computer network and other computer and electronic communication networks, to enable users to access multimedia content; instant messaging services; providing on-line chat rooms and bulletin boards for the transmission of messages among computer users; provision of information, consultancy and advisory services in relation to all the aforesaid services.

Class 41

Entertainment; sporting and cultural activities; organising of entertainment and social events; entertainment services provided at nightclubs; nightclub and discotheque services; provision of live entertainment; live entertainment services; musical entertainment services; arranging of musical entertainment; services providing entertainment in the form of live musical performances; organising of exhibitions and shows for entertainment purposes; production, presentation, distribution, syndication, and/or rental of television and radio programmes and/or films and sound video recordings; entertainment services relating to competitions; provision of entertainer, amusement, leisure and recreation facilities, services and amenities; organisation of parties and events; club entertainment services; art exhibition services; reservation services for show tickets; provision and production of information relating to entertainment and music; cabaret, theatre, casino and gaming (primarily for entertainment) services; providing non-downloadable audio, visual and audio visual recordings via the Internet; publishing and providing printed publications and electronic

publications; providing online electronic publications; information, consultancy and advisory services in relation to all of the aforesaid services.

Class 43

Services for providing food and drink; preparation of food and drink; restaurant services for the provision of fast food; self-service restaurants; takeaway, cafe, cafeteria, canteen, coffee shop and snack-bar services; wine bar services; catering services for the provision of food and drink; club services for the provision of food and drink; night club services (provision of food); information, consultancy and advisory services in relation to all the aforesaid services.