

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2174774
IN THE NAME OF ALLIED DOMECQ RETAILING LIMITED**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 49403 IN THE NAME OF
ANDREW DAVID RADFORD AND LISA RADFORD**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No 2174774
in the name of Allied Domecq Retailing Limited**

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and

**IN THE MATTER OF opposition thereto under No 49403
in the name of Andrew David Radford and Lisa Radford**

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Background

On 13 August 1998, Allied Domecq Retailing Limited applied to register the trade mark BLUE BAR CAFÉ in Class 42 in respect of the following services:

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Restaurant hotel, motel, snack bar and public house services; catering services; room hire services.

On 27 January 1999, Andrew David Radford and Lisa Radford filed notice of opposition to this application, in which they say that they are the applicants for the following United Kingdom trade mark:

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Number	Mark	Class	Specification
2167177	blue	42	Catering services for the provision of food and drink; café; bar and restaurant services; catering; snack-bars; all included in Class 42.

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The grounds of opposition are in summary:

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- 1. Under Section 5(1)** Because the distinctive element BLUE of the applicant's mark is identical to the opponent's mark and is to be registered for identical goods and services.
- 2. Under Section 5(2)(a)** Because the distinctive element BLUE of the applicant's mark is identical to the opponent's mark and is to be registered for similar goods and services.
- 3. Under Section 5(2)(b)** Because the applicants' mark is similar to the opponent's mark and is to be registered for identical or similar goods and services.
- 4. Under Section 5(4)(a)** By virtue of the opponents' extensive use and reputation.

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The applicants filed a Counterstatement in which they deny all of the grounds on which the opposition is based.

Both sides request that costs be awarded in their favour.

Only the opponents filed evidence in these proceedings. The matter came to be heard on 22 January 2001, when the applicants were represented by Mr Mark Hickey of Castles, their
5 trade mark attorneys, and the opponents by Ms Fiona McBride of Garretts, their trade mark attorneys.

Opponent's evidence

10 This consists of a Statutory Declaration dated 2 June 1999, and comes from Andrew Radford, one of the joint opponents in these proceedings, and a co-owner of the BLUE bar and café of Cambridge Street, Edinburgh, a position he has held since July 1997.

15 Mr Radford states that his company first used the trade mark BLUE in April 1997 as part of advertising for the opening of a bar café in July 1997. He mentions that a further establishment is to open in July (1999).

20 He goes on to say that the trade mark application filed by his company covers the primary services that they provide under the mark, and that prior to filing the application a search was carried out to see if any other party was using the mark, with negative results. He refers to the progress of the mark through the Trade Marks Registry, leading to its publication in the Trade Marks Journal on 6 January 1999.

25 Mr Radford gives details of the turnover, which for July 1997 to June 1998 amounted to £760,861.83, the rest of the figures given being after the relevant date. He says that a total of £11,300 has been spent in advertising the mark.

30 Mr Radford makes reference to the mark which is the subject of these proceeding, and recounts the Registrar's response to observations filed by his company, denying that these were rejected, and also that the mark BLUE is not distinctive, a view which he says is supported by exhibit BLU1. The exhibit consists of a copy of the report of an ex-parte hearing at which the Registrar's Hearing Officer said that he agreed that the colour (BLUE) did not describe a service. Mr Radford refutes the claim made by the applicants that a large
35 number of people use the element BLUE on its own, or as an element of their trade mark or trading styles in relation to the services of the opposed application, saying that in his experience this is not the case and that the applicants have not produced any evidence to support the assertion.

40 Mr Radford refers to the applicant's claim that the addition of the generic term CAFÉ and BAR to the word BLUE renders the word more distinctive and points to exhibit BLU2 which shows there to be some 500 trade marks incorporating the words CAFÉ and/or BAR applied for or registered in Class 42 .

45 Mr Radford says that the marks BLUE and BLUE BAR CAFÉ are identical in relation to the distinctive element, namely the word BLUE. He says that his company is known by the word BLUE and suggests that this will also be the case for the applicants. Mr Radford states that the opponents have used the trade mark and built up a reputation such that he believes the

public would be confused and misled into believing an association exists. He refers to other opposition proceedings in which the parties are involved (where the roles are reversed) noting the applicant's (opponents in that case) assertions relating to the identity of the respective marks and services, and the likelihood of confusion. He concludes his Declaration by saying why he believes confusion will arise.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

Turning first to the ground under Section 5(1) of the Act. That section reads:

5.-(1) 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 is identical with the goods or services for which the earlier trade mark is protected.

The opponent's objection is that BLUE is the distinctive element of the applicant's mark, and as this element is identical to their mark the application is open to objection under Section 5(1). That section applies to an earlier mark which is identical as a whole. Any objection based on only part of the mark properly falls to be considered under Section 5(2), and consequently, this ground must fail.

Going to the ground under Section 5(2) of the Act. That section reads as follows:

5(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.

The term "earlier trade mark" is itself defined in Section 6 as follows:

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

(a) a registered trade mark, international trade mark (United Kingdom) 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,

The mark cited in the grounds of opposition has an earlier application date and constitutes an earlier mark.

In my consideration of a likelihood of confusion or deception I take into account the guidance

provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 2, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

5 a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;

10 (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, paragraph 23, 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 10 his mind; *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27;

15 (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, paragraph 23; 15 (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;

20 (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17;

25 (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*, paragraph 24;

30 (g) mere association, in the sense that the later mark brings the earlier mark to 30 mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;

35 (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the 35 strict sense; *Marca Mode CV v Adidas AG*, paragraph 41;

40 (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

45 The marks have an obvious visual and aural similarity; the word BLUE. This an ordinary English word that consumers will be very familiar with, and I would say have little difficulty in remembering by reference to it being a colour and it could well be that it is this conceptual similarity that is the feature that sticks in the mind of the consumer. The applicant's mark also

has the words BAR CAFÉ which is nothing more than a statement of the services that it is to be used in connection with. These words add little in the way of distinctiveness but nonetheless have an impact on the visual similarity of the marks, although in my experience it is not uncommon for names incorporating a description of the type of services (bar, café etc) to be referred to by the distinctive element alone (in this case is BLUE) and they are likely to make little difference to the aural similarity in actual use. Even if this were not the case, the opponent's services encompass bar and/or café services and are just as likely to be referred to as the BLUE - Café, BLUE - Bar, etc.

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The services covered by the respective marks are identical, and notionally will be provided to the same consumers. They are likely to be chosen by visual selection, the sign outside, or by word of mouth recommendation, so I would say that it does not matter whether the similarity is aural or visual. Although an ordinary word in common usage it has no relevance for the services it is intended to be used in connection with, and as such is a distinctive mark. The opponents say that they have used the mark for some 20 months prior to the relevant date but give little beyond turnover and advertising expenditure which I would say is not on a scale that would have established much in the way of a reputation, or that would raise its distinctiveness above a level based on an assumption of normal and fair use.

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From my own knowledge I am aware that it is not uncommon for licenced premises to share the same name or parts of a name, for example, Rose & Crown, Crown and Sceptre, etc, even within the same town or city, and there can be no suggestion that such names are likely to be confused simply because they have an element in common. Perhaps with the exception of localities which attract a high proportion of transient custom, such as tourist resorts, city centres, etc, most cafés and bars tend to be frequented by informed local customers, well used to seeing similarity in respect of the names of licenced premises and well able to distinguish one from another. There are, however, chains of bar/restaurants trading under the same name throughout the country and this may well have established the concept of national branding in the mind of the consumer to the extent that a person visiting a different locality, on seeing a name that they are familiar with at home may assume that they are one and the same trader.

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Taking all factors into account, in particular, the overlap in respect of the marks, goods, consumer and market, I come to the view the likelihood of confusion between BLUE and BLUE BAR CAFÉ to be real and definite, and consequently, the ground founded under Section 5(2)(b) succeeds.

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Although my decision above effectively decides the matter, I will for completeness go on to look at the ground under Section 5(4)(a). That section reads as follows:

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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 -

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(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

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.

5 Mr Geoffrey Hobbs QC sitting as the Appointed Person in the Wild Child (1998 RPC 455) set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- 10 (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) 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
- 15 (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

20 The opponents claim use of their mark dating from April 1997 as part of the advertising for the opening, with actual use in the course of trade starting some three months later. The length of use is not that long, nor the amount of turnover that significant and beyond bald figures there is nothing in the evidence to establish the dates of use claimed, or that gives an idea of how and to what extent the mark may have been used or promoted. Consequently I am unable to infer that the use has resulted in a reputation or goodwill in respect of the mark, such that the public is likely to believe the applicant's bar/café to be that of the opponents, or

25 that the opponents will suffer any damage. The ground under Section 5(4)(a) fails accordingly.

The opposition having been successful, I order that the applicants pay the opponents the sum of £ 735 as a contribution towards their costs. 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

30 appeal against this decision is unsuccessful

Dated this 02 day of July 2001

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40 **Mike Foley**
for the Registrar
The Comptroller General