O-226-04

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2294091
BY GARY HIBBERD, ANTHONY HIBBERD AND JOHN O'DONNELL
(PREVIOUSLY VODKA BAR MANAGEMENT LIMITED)
TO REGISTER A SERIES OF TRADE MARKS IN CLASS 41

AND

IN THE MATTER OF OPPOSITION No. 91867
BY GODSKITCHEN LIMITED

TRADE MARKS ACT 1994

IN THE MATTER OF Application No. 2294091 by Gary Hibberd, Anthony Hibberd and John O'Donnell (previously Vodka Bar Management Limited) to register a series of Trade Marks in Class 41

and

IN THE MATTER OF Opposition No. 91867 by Godskitchen Limited

BACKGROUND

1. On 28 February 2002 Vodka Bar Management Limited applied to register a series of two trade marks, BABUSHKA and BABUSHCA, for "entertainment services; cultural activities; night clubs, discotheques; arranging parties; live entertainment; corporate entertainment". These services are appropriate to and have been applied for in Class 41 of the International system for classifying goods and services. The application is numbered 2294091. The application has since been assigned to Gary Hibberd, Anthony Hibberd and John O'Donnell.

2. On 1 August 2003 Godskitchen Limited filed notice of opposition to this application. The opponents' statement of case contains the following:

> "2. Godskitchen is very well known in the United Kingdom for organising entertainment events which are extremely well publicised particularly in the Midlands of England. I am familiar with the trade marks (registered and unregistered) that are used by Godskitchen and I can say from my own knowledge that Godskitchen have used the very similar trade mark BABOOSHKA in the United Kingdom and elsewhere since 2000, such trade mark having been the subject of an application for Community Trade Mark Number 1770221 filed 24th October 2000 in Classes 9, 25 41 and 42.
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> 3. Godskitchen has accumulated sufficient goodwill in BABOOSHKA, having used the same during the past 3 years to designate live entertainment events and discotheques. In particular, since on or about 30th September 2000, BABOOSHKA events have been held at Godskitchen's "Code" nightclub in Birmingham. Such regular Saturday night BABOOSHKA events play quality "house" music and have attracted leading disc jockeys from many parts of the world. In or about February 2002 a very successful BABOOSHKA event took place at Leeds Town Hall following the last of the Saturday night events at "Code". The BABOOSHKA brand continues to be used as a high-profile house brand at Godskitchen's very well-known regular summer festivals in the Midlands. By way of illustration, two pages of a leaflet describing the BABOOSHKA arena at the "Global Gathering" 2003 summer festival to take

place at the Long Marston Airfield, Stratford-upon-Avon, Warwickshire, on Saturday 26th July 2003 are attached as Exhibit "GT1". I am advised by our legal advisers that common law rights have accumulated in BABOOSHKA (or any similar sounding name) with respect to entertainment, events and discotheques and that such rights may be protected by a civil action for passing off.

4. Godskitchen, in the name of its associated company Godskitchen Worldwide Limited, is presently initiating an application for the trade mark BABOOSHKA in the UK in Classes 9, 25, 41 and 42."

3. It will be noted from the above that reference is made to a Community Trade Mark application and a UK application. However, I do not understand the opponents to rely on either of those applications as the basis for their opposition. In fact the CTM appears to have been withdrawn and it later emerges that the UK application has a later filing date than the application in suit. Rather, the opponents say that on the basis of the above facts the application should be refused under Section 5(4)(a) having regard to the law of passing off.

4. The applicants filed a counterstatement denying the above ground and referring in turn to an existing registration of their own and their use since at least 1994 in respect of bars and public houses at which live entertainment is provided. They ask for an award of costs against the opponents.

5. Only the opponents filed evidence. Neither side has asked to be heard. Written submissions have been received from Saunders & Dolleymore on behalf of the applicants (under cover of a letter dated 13 July 2004) and from Wright Hassall on behalf of the opponents (under cover of a letter dated 28 May 2004). Acting on behalf of the Registrar and with the above material in mind I give this decision.

DECISION

Section 5(4)(a)

6. The Section reads as follows:

"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

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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."

7. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents' goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

8. In *REEF Trade Mark* [2002] RPC 19 Mr Justice Pumfrey observed that:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a *prima facie* case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472. Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the *prima facie* case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

9. It is clear from these observations that the onus is on an opponent to establish his reputation/goodwill. Against that background the opponents here have elected to pursue their case in a somewhat unusual manner. Mr Gary Turner, their Finance Director, has filed a witness statement which in broad terms:

- asserts the opponents' common law rights under the mark BABOOSHKA in relation to live entertainment and partying;

- suggests that the burden falls on the applicants to file evidence to disprove the opponents' use;

- disputes the relevance of evidence submitted by the applicants in their counterstatement which it is suggested relates to use of BABUSHKA in relation to bars and public houses rather than Class 41 services.

10. There are no exhibits attached to Mr Turner's witness statement and hence no evidence of the kind referred to in *REEF* to establish that the opponents enjoy goodwill under the mark BABOOSHKA. The only reference to BABOOSHKA is in the two page attachment to the opponents' statement of case. But even if that document had been formally filed as evidence it would not have advanced the opponents' case not least because it relates to use of the mark in relation to an event in July 2003, over a year after the material date in these proceedings, that is to say the filing date of the application, (see *WILD CHILD* at pages 459 to 460).

11. It seems to me, therefore, that the opponents' case must rest entirely on the proposition that it is for the applicants to disprove their (the opponents) claim. I have not been referred to any authority in support of that proposition. Indeed, I would have been surprised if one had been cited because it runs counter to both the general presumption in legal proceedings that 'he who asserts must prove' and the specific requirement placed on an opponent or plaintiff in an action based on passing off, that goodwill must be distinctly proved (per *Reef*). I might add that in this case the applicants did not admit the opponents' use and denied that they had established any rights in the mark BABOOSHKA. The onus was, therefore, squarely on the opponents to make good their case. They have not done so. It follows that there is no prima facie case for the applicants to seek to rebut. The opposition must, therefore, fall at the first hurdle.

12. The applicants are entitled to an award of costs reflecting their success in the action. I order the opponents to pay the applicants the sum of £700. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of August 2004

M REYNOLDS
For the Registrar
the Comptroller-General