

**O-301-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3316640 BY CARMELLA STANBURY  
TO REGISTER:**

**Garage Bingo**

**AND**

**The Garage Bingo**

**(SERIES OF TWO)**

**AS TRADE MARKS IN CLASSES 41 AND 43**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 60000964 BY:  
PURPLE SAND LIMITED**

## Background & Pleadings

1. On 8 June 2018, Ms Carmella Stanbury (“the applicant”) applied to register the above trade mark series for the following services:

**Class 41:** *Arranging and conducting of entertainment events; Arranging and conducting of entertainment events for charitable fundraising purposes; Arranging and conducting of live entertainment events; Arranging and conducting of live entertainment events for charitable purposes; Arranging and conducting of meetings in the field of entertainment; Arranging and conducting of music concerts; Arranging and presenting of live performances; Arranging, conducting and organisation of concerts; Arranging for students to participate in recreational activities; Arranging group recreational activities; Arranging of competitions for education or entertainment; Arranging of competitions for entertainment purposes; Arranging of concerts; Arranging of cultural events; Arranging of displays for entertainment purposes; Arranging of festivals for entertainment purposes; Arranging of music shows; Arranging of musical entertainment; Arranging of musical events; Arranging of quizzes; Arranging the provision of recreation facilities; Club services [entertainment]; Conducting of entertainment events; Conducting of live entertainment events; Conducting of live sports events; Consultancy services in the field of entertainment; Entertainment services in the nature of arranging social entertainment events; Entertainment services in the nature of competitions; Entertainment services in the nature of contests; Festivals (Organisation of -) for entertainment purposes; Festivals (Organisation of -) for recreational purposes; Funfair services; Live entertainment; Live entertainment production services; Lottery services; Magic show services; Organisation of competitions and awards; Organisation of events for cultural, entertainment and sporting purposes; Party planning.*

**Class 43:** *Catering for the provision of food and drink; Catering of food and drinks; Event facilities and temporary office and meeting facilities; Food and drink catering; Mobile catering; Providing facilities for exhibitions; Providing food and drink; Providing food and drink for guests.*

The application was published for opposition purposes on 6 July 2018.

2. On 5 October 2018, the application was opposed in full by Purple Sand Limited (“the opponent”) under the fast track opposition procedure. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the following trade mark:

United Kingdom Trade Mark (“UKTM”) 2295222:

## THE GARAGE

Filing date: 13 March 2002

Registration date: 31 October 2003

The opponent indicates that it intends to rely upon the following services for which its mark is registered:

***Class 41: Night-club services; discotheque services; the organisation and hosting of musical concerts***

***Class 43: Restaurant services; wine bar services; provision of food and drink***

3. In its Notice of Opposition, the opponent argues that all services for which the applicant seeks registration are identical or similar to those which it relies upon and that, due to the nature of the respective services, the contested mark will be linked to its existing brand.

4. A counterstatement was filed by Ms Adewalie Akinyele, Director of Operations and Business Development for the applicant. The applicant seemingly seeks to rely on a number of factors in her dispute of the opposition, including the parties’ differing locations, target demographics and the way in which their events are advertised or communicated. Ms Akinyele also states that there is only one ‘crossover service’ in the respective specifications.

5. Rules 20(1)-(3) of the Trade Marks Rules (“TMR”) (the provisions of which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads as follows:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

6. The net effect of the above is to require parties to seek leave in order to file evidence in fast track oppositions. No such leave was sought in respect of these proceedings. The only exception to that general position is that a fast track opponent who is relying on an earlier mark that is subject to proof of use must file evidence of use at the time of filing the opposition, which I note the opponent has.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was not requested nor considered necessary in this case and neither party elected to file written submissions in lieu. This decision is taken following a careful reading of all the papers which I will refer to, as necessary.

8. Neither party is legally represented.

### **The correct approach**

9. I note the following lines of defence referred to in the applicant’s counterstatement and intend to address each of them briefly to explain why, as a matter of law, they can have no bearing on the outcome of the opposition:

- “...from evidence provided, not one bingo night has been advertised as ‘Garage Bingo’ or held in their London or Glasgow location(s).”
- “We are not seeking to compete with The Garage as our clientele is different, we have a demographic of 21-45 Y/O, and therefore no competition with them as the majority of The Garage’s events are targeted at the student market.”

- “Most of our locations are usually in central London and are always advertised as secret locations. Event venues are only communicated directly to ticket holders on the week of the event”.

10. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*<sup>3</sup>, the Court of Justice of the European Union (“CJEU”) stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Differences between the services currently provided by the parties are irrelevant to the assessment I am required to make, except to the extent that those differences are apparent from the lists of services they have tendered for the purpose of the registration of their marks. Differences between the parties’ trading styles and communication methods are also irrelevant, again except to the extent that these are apparent from the registered and applied-for marks. My decision as to whether there is a likelihood of confusion must be based on an objective assessment of the relevant factors. Consequently, the applicant’s contention that the opponent has not, thus far, held a ‘bingo night’ at its London or Glasgow venue cannot be taken into account.

11. Moreover, in *Oakley v OHIM*, Case T-116/06, it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties:

“...since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between the two marks... cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors...”

12. Further, marketing strategies are temporal and may change with the passage of time. See for instance, *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, where the CJEU stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

13. In light of the above, it follows that I am required to make the assessment of the likelihood of confusion notionally and objectively solely on the basis of the services (and marks) as they appear on the register. The *actual* part of the market each party may currently target is irrelevant to that assessment.

14. When it comes to the applicant’s comments regarding the parties’ respective locations, the earlier mark is a national trade mark which is protected against confusion anywhere in the UK, and the applicant is seeking a UK-wide trade mark registration. The fact that the parties may currently be trading, at least predominantly, in different parts of the UK, tells me nothing about the likelihood of confusion in the future and can therefore have no bearing on the outcome of the proceedings.

## **Decision**

15. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

“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,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

16. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community 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,

(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.”

17. Given its filing date, the opponent’s trade mark qualifies as an earlier mark under the provisions outlined above. In accordance with section 6A of the Act, it is subject to the proof of use requirements as it had been registered for five years or more on the date that the applicant’s mark was published. The opponent claims to have used its mark to advertise events throughout the UK, stating specifically that it operates a Garage club in London, Glasgow and (until recently) Aberdeen. It claims to have used its mark in respect of all services relied upon (paragraph 2 refers). Alongside its notice of opposition, the opponent filed a statement of truth and supporting evidence to show the use made of its earlier mark.

18. Under section 6A of the Act, the relevant period for proof of use is the five-year period ending on the date that the opposed mark was published. For the purposes of the current opposition, the relevant period is, therefore, 7 July 2013 until 6 July 2018.

### **The opponent’s evidence**

19. The following statements are made in the opponent’s notice of opposition and are supported by a statement of truth:

- The opponent operates a club venue under the name ‘The Garage’ in London and Glasgow and, until recently, it operated a club in Aberdeen.
- It advertises events throughout the UK and has used its brand to run ‘discos and event spaces’, specifically ‘large student venues and gig spaces’.

- Its average annual turnover in Scotland over the last ten years is £3 million, 75% of which relates to nightclub and events and 20% of which relates to live performances<sup>1</sup>.
- The opponent spends approximately £300,000 per year on brand promotion.

20. At exhibits 1.1 to 1.4, the opponent has enclosed what it describes as its 'gig diary for garage Glasgow'. The exhibit is headed 'Garage Live Events 2018' and lists a selection of events with dates from January to December 2018, alongside what appears to be an entry fee, start time and recommended age restriction. The majority of events are apparently either concerts and/or of a musical nature, though I also note reference to several comedy events. Entry fees range from £5.00 to £35.00.

21. The remainder of the exhibits (2.0 to 17.0) comprises a selection of posters and websites advertising various events scheduled to be held at 'the garage'. Only a limited number of the exhibits show which specific venue they relate to. Of those I can make out, all relate to the Glasgow location. A variety of events and celebrations are advertised; Disney Musical Bingo; Cheese & Wine Party and a 'Club Late' event to name a few. There is no indication of where the posters were displayed or how they were distributed. A sample can be seen below:



22. That concludes my summary of the evidence, insofar as I consider it necessary.

<sup>1</sup> The opponent has not clarified what the remaining 5% relates to.

## Proof of use

23. The first issue is to establish whether, or to what extent, the opponent has shown genuine use of the services relied upon. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A- (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services”.

24. Section 100 of the Act also applies, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it”.

25. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch), Arnold J summarised the law relating to genuine use as follows:

“114. ...The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean*

*Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

26. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C., as the Appointed Person, stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

27. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person, stated that:

“22. The burden lies on the registered proprietor to prove use... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is

likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

28. When making an assessment as to whether genuine use of the opponent’s mark has been shown, I begin by considering the way in which the mark has been used. Section 6A(4)(a) of the Act provides for use of trade marks in a form differing in elements which do not alter the distinctive character of the mark as registered. In *Nirvana Trade Mark*, Case BL O/262/06, Richard Arnold Q.C. (as he then was), as the Appointed Person, considered the law in relation to the use of marks in different forms and summarised the test (albeit in relation to the analogous principle when dealing with revocation claims) as follows:

"33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

29. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark

must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (emphasis added)

30. Whilst there is (limited) evidence showing the opponent’s mark presented in the plain word, as registered, in the majority of its exhibits the mark appears in lower case and is presented in a bubble-like font with rounded edges. Above the initial g-a of the word ‘garage’ sits the word ‘the’, displayed in a significantly smaller, but still noticeable, font (than ‘garage’), as shown:

Variant (i)



In some exhibits, the opponent’s mark is displayed as described above but is positioned within the device below:

Variant (ii)



31. In *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, Mr Philip Johnson, as the Appointed Person, found that the use of *dreams* qualified as use of the registered word-only mark DREAMS because the stylisation of the word did not alter the distinctive character of the word mark. I would apply the same approach when considering variant (i). In my view, the stylisation and orientation falls within the parameters of what constitutes notional and fair use of the earlier mark, as registered. Even if I am incorrect in that, I find the variant to satisfy the test laid out by Arnold J, as nothing turns on the adopted stylisation. It has no bearing on the distinctive character of the opponent’s mark, which remains solely in the words of which it is comprised. The use shown in variant (i) is, therefore, acceptable.

32. In variant (ii), the words ‘the garage’ are positioned within what appears to be a two-dimensional representation of a truck with two petrol pumps emerging from either side. It is clear from *Colloseum* that use of a mark in conjunction with other matter constitutes genuine use and I find that applies here. The words of the registered mark are essentially unaltered, save the adopted stylisation which I have found to be acceptable. Although used as part of a composite mark, the words themselves continue to perform the role of indicating trade origin. On that basis, I find the second variant to also be acceptable.

33. I will now consider the sufficiency of the opponent’s evidence. To begin, I should note that, whilst I acknowledge that the majority of the exhibits do not specify which year the advertised event is due to be held in (instead referring only to a day and month), as the fast track application requires that the accompanying evidence of use *must* relate to the relevant period, I am willing to accept that the opponent’s exhibits relate to events held, or at least advertised, during this time. Nevertheless, the opponent’s exhibits are clearly intended to exemplify the nature of the use made of its earlier mark and provide a useful insight. In that respect, the posters and gig diary show that the opponent’s mark has been put to use during the relevant period in relation to a variety of parties and themed events, including those in the field of music and comedy, at least at its Glasgow venue. The brand has generated an average annual turnover in Scotland of £3 million, 75% of which relates to nightclub and events and 20% of which relates to live performances. Though the opponent has indicated that its Aberdeen venue is no longer in operation, it does not specify when this took effect. However, given that it was apparently in operation “until very recently”, it seems reasonable to conclude that a proportion of the annual turnover will relate to the combination of the opponent’s Glasgow and Aberdeen locations. There is no reference to the turnover generated by its London venue. The opponent states that its annual expenditure on brand promotion is £300,000. Although I have not been informed of the size of the market, or indeed of the opponent’s share, to my mind, an annual turnover of £3 million signifies that the promotional efforts of the opponent have been effective in preserving a place in the market and is certainly significant insofar as a genuine use assessment is concerned, particularly so given that it relates only to the

use made of the mark in Scotland. When considered as a whole, I am satisfied that the evidence shows that genuine use has been made of the opponent's mark.

34. I return briefly to the comments made in the applicant's counterstatement, which seem to call into question the *nature* of the use. Ms Akinyele states:

"The opposition statement and evidence provided, the name Garage is representative of the venue as opposed to any brand. All events held by The Garage have had no advertising naming or branding with The Garage included, any visibility of the Garage have only referred to the location of the events."

35. To constitute genuine use, the use must be in accordance with the essential function of a trade mark, which is to guarantee the identity of the origin of the service from those of others. Whilst I agree that the opponent's mark is synonymous to a specific venue (or venues), to my mind, it has been used not only to signify specifically *where* the services are available but is also indicative of their origin insofar as it is representative of the host or organiser of the relevant services, thus satisfying its essential function. On that basis, I hold that genuine use is established and I turn now to consider precisely for which services genuine use has been shown.

### **Fair specification**

36. In terms of devising a fair specification, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Geoffrey Hobbs Q.C., as the Appointed Person, summed up the law as being:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned".

37. Carr J summed up the relevant law in regard to fair specifications in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch). This was a revocation case, but the same principles apply in an opposition:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].”

38. The opponent has put its mark to use as the name of a venue which provides a variety of night-club services. The gig diary shows a substantial number of entertainment-based events scheduled at the venue each month [throughout 2018], many of which refer specifically to music and concerts, and the posters show the mark used in relation to a number of pre-organised social events and celebrations held at the opponent’s venue.

39. The evidence shows that, alongside various mediums of entertainment, consumers are, sometimes, provided a variety of refreshments. Whilst consumers would, in my experience, (at least) expect the provision of drink to be part and parcel of the opponent's *night-club services*, and indeed the evidence references a number of drinks offered at the events, they would not necessarily maintain the same expectation when it comes to the provision of food. That said, food is clearly being offered at a number of the events hosted by the opponent; the posters refer to a 'Cheese and Wine Party', 'Popcorn Day' and 'International Oreo Cookie Day', for example. At some events, it appears the food is offered without charge, therefore it could be argued that this form of use is just a promotional incentive. In that regard, I keep in mind the following guidance of the CJEU.

40. In *Silberquelle GmbH v Maselli-Strickmode GmbH*, Case C-495/07, the CJEU held that:

"17. It is settled case-law that 'genuine use' within the meaning of the Directive must be understood to denote actual use, consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin (Case C-40/01 *Ansul* [2003] ECR I-2439, paragraphs 35 and 36, and Case C-442/07 *Verein Radetzky-Orden* [2008] ECR I-0000, paragraph 13).

18. It follows from that concept of 'genuine use' that the protection that the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings (*Ansul*, paragraph 37, and *Verein Radetzky-Orden*, paragraph 14).

19. As the Commission submitted in its observations to the Court and as the Advocate General stated in points 45 and 55 of his Opinion, it is essential, in the light of the number of marks that are registered and the conflicts that are likely to arise between them, to maintain the rights conferred by a mark for a given class

of goods or services only where that mark has been used on the market for goods or services belonging to that class.

20. For the reasons set out in points 48 and 56 of that Opinion, that condition is not fulfilled where promotional items are handed out as a reward for the purchase of other goods and to encourage the sale of the latter.

21. In such a situation, those items are not distributed in any way with the aim of penetrating the market for goods in the same class. In those circumstances, affixing the mark to those items does not contribute to creating an outlet for those items or to distinguishing, in the interest of the customer, those items from the goods of other undertakings.

22. In the light of the foregoing considerations, the answer to the question referred is that Articles 10(1) and 12(1) of the directive must be interpreted as meaning that, where the proprietor of a mark affixes that mark to items that it gives, free of charge, to purchasers of its goods, it does not make genuine use of that mark in respect of the class covering those items.”

41. On the other hand, in *Antartica Srl v OHIM, The Nasdaq Stock Market, Inc.*, Case C-320/07 P, the CJEU held that:

“29. It is sufficient to note in that respect that, even if part of the services for which the earlier mark is registered are offered by The Nasdaq Stock Market free of charge, that does not of itself mean that that commercial company will not seek, by such use of its trade mark, to create or maintain an outlet for those services in the Community, as against the services of other undertakings.”

42. I note, for completeness, that I cannot be certain that all food provided by the opponent is, indeed, free, though on some posters this is made clear (free popcorn on Popcorn Day, for example). However, given that the services often command an entry fee, it would not seem unreasonable to conclude that the fee is likely to cover the cost incurred by the opponent for the provision of food, where applicable. Overall, I am satisfied that *the provision of food and drink* plays a role in the core business of the opponent and the services it operates under the earlier mark. I would also consider

this consistent with the way the average consumer is likely to fairly describe the available services<sup>2</sup>.

43. When considered alongside the relevant case law, the evidence leads me to conclude that a fair specification for the opponent would read as follows:

*Night-club services; discotheque services; the organisation and hosting of musical concerts; Provision of food and drink*

The above represents the services which the opponent may rely upon for the purpose of the opposition.

### **Section 5(2)(b) - Case law**

44. The following principles are gleaned from the decisions of the courts of the European Union 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 B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles:**

(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, 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

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<sup>2</sup> *Thomas Pink*

picture of them he has kept in his 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;

(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 services

45. The competing services are as follows:

Opponent's services	Applicant's services
<p><b>Class 41:</b> <i>Night-club services; discotheque services; the organisation and hosting of musical concerts</i></p> <p><b>Class 43:</b> <i>Provision of food and drink</i></p>	<p><b>Class 41:</b> <i>Arranging and conducting of entertainment events; Arranging and conducting of entertainment events for charitable fundraising purposes; Arranging and conducting of live entertainment events; Arranging and conducting of live entertainment events for charitable purposes; Arranging and conducting of meetings in the field of entertainment; Arranging and conducting of music concerts; Arranging and presenting of live performances; Arranging, conducting and organisation of concerts; Arranging for students to participate in recreational activities; Arranging group recreational activities; Arranging of competitions for education or entertainment; Arranging of competitions for entertainment purposes; Arranging of concerts; Arranging of cultural events; Arranging of displays for entertainment purposes; Arranging of festivals for entertainment purposes; Arranging of music shows; Arranging of musical entertainment; Arranging of musical events; Arranging of quizzes; Arranging the provision of recreation facilities; Club services [entertainment]; Conducting of entertainment events; Conducting of live entertainment events; Conducting of live sports events; Consultancy services in the field of entertainment; Entertainment</i></p>

	<p><i>services in the nature of arranging social entertainment events; Entertainment services in the nature of competitions; Entertainment services in the nature of contests; Festivals (Organisation of -) for entertainment purposes; Festivals (Organisation of -) for recreational purposes; Funfair services; Live entertainment; Live entertainment production services; Lottery services; Magic show services; Organisation of competitions and awards; Organisation of events for cultural, entertainment and sporting purposes; Party planning.</i></p> <p><b>Class 43:</b> <i>Catering for the provision of food and drink; Catering of food and drinks; Event facilities and temporary office and meeting facilities; Food and drink catering; Mobile catering; Providing facilities for exhibitions; Providing food and drink; Providing food and drink for guests.</i></p>
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46. The following services are listed in each of the competing specifications and are, self-evidently, identical:

*Provision of food and drink / Providing food and drink*

47. In addition to cases of *literal* identity, the General Court (“GC”) specified a further provision as to when goods (though it applies equally to services) can be considered identical in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, where it stated:

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

designated by trade mark application (Case T-388/00 Institut fur 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”.

48. The opponent is relying on *night-club services*, *discotheque services* and *the organisation and hosting of musical concerts*. To my mind, *night-club services*, as a term, allows the opponent a relatively wide scope of protection, as it encapsulates a fairly wide selection of (primarily entertainment-based) services likely to be required in order for it to successfully function as a night-club venue. Applying the *Meric* principle, I consider the following services in the application either to be encompassed by the opponent’s *night-club services* or to, in and of themselves, encompass the opponent’s *the organisation and hosting of musical concerts*. Either way, the services are, consequently, identical:

*Arranging and conducting of entertainment events; Arranging and conducting of entertainment events for charitable fundraising purposes; Arranging and conducting of live entertainment events; Arranging and conducting of live entertainment events for charitable purposes; Arranging and conducting of meetings in the field of entertainment; Arranging and conducting of music concerts; Arranging and presenting of live performances; Arranging, conducting and organisation of concerts; Arranging of concerts; Arranging of cultural events; Arranging of displays for entertainment purposes; Arranging of music shows; Arranging of musical entertainment; Arranging of musical events; Arranging of festivals for entertainment purposes; Club services [entertainment]; Conducting of entertainment events; Conducting of live entertainment events; Consultancy services in the field of entertainment; Entertainment services in the nature of arranging social entertainment events; Live entertainment; Live entertainment production services; Organisation of events for cultural and entertainment purposes<sup>3</sup>; Party planning*

49. The following services in the application are encompassed by the opponent’s *provision of food and drink* and are therefore identical:

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<sup>3</sup> *Organisation of events for cultural, entertainment and sporting purposes* has been separated into ‘*cultural and entertainment*’ and ‘*sporting*’ for the purpose of the services comparison.

*Catering for the provision of food and drink; Catering of food and drinks; Food and drink catering; Mobile catering; Providing food and drink for guests.*

50. When assessing the similarity of the remaining services, I am guided by the relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, which were as follows:

- (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.

51. 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 between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...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”.

52. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"12. ...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."

53. For the purposes of a services comparison, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O/399/10 and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

#### **The applicant's remaining services in class 41**

**Arranging for students to participate in recreational activities; Arranging group recreational activities; Arranging the provision of recreation facilities; Festivals (Organisation of -) for recreational purposes**

54. The above services specify a strictly recreational purpose. To my knowledge, recreation refers to any activity undertaken for enjoyment. To that end, I find a likely correlation between the above services and the class 41 services relied on by the opponent. Both are selected, at least primarily, as entertainment outlets or ways to further personal enjoyment or interest, and they are likely to intersect in their

respective users. There may be a coincidence in the nature of the competing services and certainly the trade channels via which they reach the market. Given the similarity in their purpose and target consumer, the services may prove to be competitive. They are not strictly complementary, though it would not seem unusual for the same entity to provide both. The services are, at least, highly similar.

### **Funfair services**

55. The above shares a degree of purpose with the opponent's *organisation and hosting of musical concerts*, insofar as both are selected predominantly for their entertainment value. Though I accept that funfairs can appeal, at least more consistently, to a younger or family-orientated audience, it still seems likely that there will be a reasonable overlap in the services' users. Whilst there seems to be little opportunity for any tangible similarity in the fundamental nature of the respective services, in my experience, it is not unheard of for musical performances to be provided within a funfair setting. There is a possibility for coincidence in trade channels, albeit a limited one. Given that both are often selected for entertainment purposes, there may be an opportunity for competitiveness. I do not consider the services to be complementary. On balance, I find the services are similar to a fairly low degree.

### **Lottery services; Organisation of competitions and awards**

56. Whilst I accept that there is evidence of some form of competition-based activity or 'giveaways' being provided by the opponent as part of its *night-club services*, this does not reflect their core use. The opponent's services are selected predominantly for entertainment or social purposes, whereas the selection of the above services is often driven primarily by incentives of some degree. The services are likely to coincide fairly significantly in their respective users, though given that age restrictions could play a role on either side, more of a distinction could be created. The nature of the services is, in essence, not similar. The services are unlikely to reach the market via the same trade channels and I see no real opportunity for a competitive or complementary relationship. Weighing all factors, I find the services are not similar.

### **Arranging of quizzes; Entertainment services in the nature of competitions; Entertainment services in the nature of contests**

57. Whilst I apply much of the same reasoning here as I did in the previous comparison, to my knowledge, the above services differ insofar as their purpose is not strictly incentive-driven but will incorporate at least an element of entertainment. With that in mind, there is more of a crossover in the services' respective uses. There could be a coincidence in users and there may be an element of competitiveness in play. Still, there is likely to be minimal similarity in nature and trade channels and the services are not complementary. Here, I find there to be a low degree of similarity between the services.

### **Magic show services**

58. To my mind, there is an apparent correlation in the purpose of the opponent's *night-club services* and *organisation and hosting of musical concerts* and the above services, given that each is predominantly selected as a means of entertainment. There is also likely to be some similarity in the users of the respective services. Whilst there is no strict similarity in the services' nature, night-clubs often offer a variety of entertainment-based events, of which magic shows could potentially be just one. The trade channels are likely to differ, though there may be an opportunity for the services to occupy competitive roles, given the similarity in their purpose. The services are not complementary. Overall, I find the similarity to be of a low to medium degree.

### **Organisation of events for sporting purposes; Conducting of live sports events**

59. Both sporting events and musical concerts can be selected for their recreational benefits or entertainment value, though this is not necessarily always the case and the respective mediums are markedly different. Given the general popularity of both sport and music, there is likely to be a degree of overlap in the users of the respective services, though consumers will not necessarily have an interest in both simultaneously, signifying a potential distinction in users. In my experience, there is unlikely to be any similarity in the nature of the services, aside from what may be a limited coincidence in the format insofar as each is likely to comprise audience

observation of a particular performance (or performances). There is unlikely to be any consistent similarity in trade channels and, although I have found a potential relationship between the services' respective purposes, given their distinct characteristics, there is unlikely to be an opportunity for competitiveness. The services are not complementary. On balance, I am unable to find any similarity between the services.

### **The applicant's remaining services in class 43**

#### **Event facilities and temporary office and meeting facilities; Providing facilities for exhibitions**

60. The services relied upon by the opponent are generally selected by consumers for entertainment or culinary purposes. The above services described as 'facilities' indicates that they will serve a much more functional or practical purpose. Whilst the opponent's services are likely to appeal to the wider general public, the general public are likely to have little interest or input when it comes to sourcing the facilities required to operate an office space or exhibition, which to my knowledge will often be the responsibility of the provider. The respective users are, therefore, not similar. Although limited facilities are likely to be provided to support the successful running of *night-club services* and *the organisation of musical concerts*, I see no real opportunity for coincidence in the nature of the services themselves. The services are unlikely to occupy the same channels of trade and they are not competitive. I do not consider the services to be complementary; they are not indispensable for one another, nor does it seem likely that consumers would expect the same entity to provide both. All things considered, I conclude that the services are not similar.

61. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

"49. ...I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. **If there is no similarity at all, there is no likelihood of confusion to**

**be considered.** If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.” [my emphasis]

62. It follows that the opposition fails at this juncture in respect of the following services, and is dismissed accordingly:

*Event facilities and temporary office and meeting facilities; providing facilities for exhibitions; lottery services; organisation of competitions and awards; organisation of events for sporting purposes and conducting of live sports events.*

### **The average consumer and the nature of the purchasing act**

63. As the case law above indicates, it is necessary for me to determine who the average consumer is for the services at issue. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

64. The average consumer for the services at issue is likely to be a member of the general public. Given the nature of some of the services, it is possible that a minimum age restriction will apply. To my knowledge, and as supported by the opponent’s evidence, the services are considered primarily via traditional advertisements, posters, websites and the like, which suggests that the marks’ visual impact will play the greatest role in the selection process. However, as it would not be unusual for

consumers to also rely somewhat on word-of-mouth recommendations, the marks' aural impact cannot be ignored.

65. Costs associated with the services can vary considerably. Purchases are unlikely to be made on an exceptionally frequent basis, and are instead likely to be purchased either semi-regularly or as an occasional indulgence (at least generally). Irrespective of price, consumers are likely to be alive to a host of factors; for the class 41 services, considerations will include event content, suitability of timing and suitability of location and for the services in class 43, dietary compatibility and reputation of the provider are likely to be considered. Weighing all factors, I find it likely that consumers will apply an average degree of attention to the purchasing process.

### **Comparison of trade marks**

66. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*, Case C-591/12P, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which 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.”

67. It would be wrong, therefore, to artificially dissect the trade 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 they create. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark(s)
THE GARAGE	Garage Bingo AND The Garage Bingo (SERIES OF TWO)

68. The opponent's trade mark is comprised of two dictionary words, specifically THE GARAGE. The overall impression of the mark lies in the unit formed by the combination of the two words, though, given the nature of the word 'THE', consumers are likely to apply more importance to GARAGE.

69. In the contested series marks, 'Bingo' is likely to be viewed as a descriptive or non-distinctive element and, consequently, it will play a lesser role in the marks' overall impression(s). In the first series mark, the overall impression will, therefore, reside predominantly in the word 'Garage' and, in the second series mark, it will reside predominantly in 'The Garage' though, again, more weight is likely to be placed on 'Garage'.

### Visual comparison

70. When considering visual similarity, I keep in mind my conclusions on the marks' overall impressions and the general rule regarding the importance consumers place on the *beginnings* of marks. The opponent's mark and the applicant's first series mark coincide in the word GARAGE/Garage, which represents the second of two words in the opponent's mark and the first of two in the applicant's. In the opponent's mark, 'GARAGE' is preceded by 'THE' and in the applicant's 'Garage' precedes 'Bingo'. Nothing turns on the variation in the respective casing (one being presented in upper case and the other in title case). I find the visual similarity to be of a medium degree.

71. The second series mark begins identically to the opponent's earlier mark. Its first two words 'The Garage' are representative of the opponent's mark in its entirety. Whilst the identical beginning brings the visual similarity between the marks, I would,

again, pitch the visual similarity at a medium degree owing to the third word in the applicant's mark ('Bingo'), which has no counterpart in the opponent's.

### **Aural comparison**

72. The opponent's mark is likely to be articulated in three syllables, specifically THE-GA-RIDGE. The first of the applicant's series marks is likely to be articulated in four syllables, specifically GA-RIDGE-BIN-GO. There is a clear coincidence in the conjoined syllables GA-RIDGE, though they differ in their structural placement within the respective marks. Keeping in mind my findings regarding the marks' overall impressions, I find the aural similarity to be of a medium degree.

73. An additional syllable is present in the second of the applicant's series marks. As a result, the mark is likely to be articulated in five syllables, namely THE-GA-RIDGE-BIN-GO. Three of the five syllables are identical, literally and sequentially, to those in the opponent's mark. On balance, I find the aural similarity to be of a fairly high degree.

### **Conceptual comparison**

74. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

75. Neither party made submissions on the marks' conceptual significance.

76. To my mind, the most likely concept consumers are likely to retrieve from the opponent's mark is either that of a professional establishment offering repairs to vehicles or of a residential building, often an extension to the home, where vehicles are routinely stored. Whilst I accept that 'garage' can refer to a particular style of music, and that this could be seen to have a relationship with the opponent's services, I find it unlikely that consumers will bring this concept to mind, particularly given that it is preceded by 'THE'. Despite the lack of particularisation in the first of the applicant's series marks, consumers are, in my view, likely to consistently assign the same

concept to both series marks as they do to the opponent's earlier marks (either a business establishment or residential building). However, in both series marks, an additional concept completely foreign to the opponent's mark is introduced by the word 'Bingo', which consumers will understand to be a popular casino game. Keeping in mind where I have found the marks' overall impressions likely to lie, I find the conceptual similarity to be of at least a medium degree.

### **Distinctive character of the earlier trade mark**

77. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, 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 Attenberger* [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).”

78. The opponent has not claimed that its mark has earned an enhanced distinctiveness, nor do I find the evidence before me sufficient to support such a finding. Consequently, I have only the inherent distinctiveness of the mark to consider. It is widely accepted, although just a rule of thumb, that words which are invented often possess the highest degree of distinctive character, whilst words which are allusive or suggestive of the goods and/or services relied upon generally possess the lowest.

79. To my mind, the opponent's mark is neither descriptive nor allusive of the contentious services, nor of their characteristics. Though I have noted, above, that 'garage' is a style of music which could be said to share somewhat of a relationship with the opponent's services, I have dismissed the likelihood of consumers assigning it this meaning. Whilst 'GARAGE' could also, theoretically, be indicative of a venue intended to host one or more of the relied upon services, in my experience, a garage (applying its natural meaning) would be a highly unusual choice. Still, the mark is essentially comprised of two well-known, dictionary words with which the average consumer will be extremely familiar. All things considered, I find the earlier mark to possess a medium degree of inherent distinctiveness.

### **Likelihood of confusion**

80. In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion.

81. Earlier in this decision I reached the following conclusions:

- Some of the competing services are identical, some are similar to a high degree, some to a low to medium degree and some to only a low degree<sup>4</sup>;

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<sup>4</sup> For those where no similarity was found, a likelihood of confusion has already been dismissed (paragraph 62 refers)

- The average consumer is a member of the general public, though age restrictions may apply. Visual considerations are likely to dominate the selection process, though aural considerations cannot be discounted;
- An average degree of attention will be paid to the selection of services;
- The opponent's mark shares a medium degree of visual similarity, a medium degree of aural similarity and at least a medium degree of conceptual similarity with the first of the applicant's series marks;
- The opponent's mark shares a medium degree of visual similarity, a fairly high degree of aural similarity and at least a medium degree of conceptual similarity with the second of the applicant's series marks;
- The opponent's trade mark possesses a medium degree of inherent distinctive character.

82. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of the above conclusions. I also keep in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them retained in its mind.

83. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related. As the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*<sup>5</sup>, Mr Iain Purvis Q.C. provided further clarification on the matter. He explained:

“16. 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 recognized 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

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<sup>5</sup> BL O/375/10

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.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

84. In *Kurt Geiger v A-List Corporate Limited*<sup>6</sup>, Mr Purvis, as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

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<sup>6</sup> BL O-075-13

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

85. The common and most distinctive element shared by each of the marks is ‘Garage’ or ‘The Garage’. The ‘Bingo’ element in the applicant’s series marks is likely to be viewed as non-distinctive or descriptive, either of the services themselves or a characteristic of the services. I find this to apply in respect of all services as, even where the services can seemingly have little or no relationship with bingo (as an activity), the consumer will naturally assume that it must play at least a limited role in what is being offered. Still, the ‘Bingo’ element does serve to create an apparent visual distinction and introduces a concept entirely foreign to the earlier marks. To my mind, this is likely to be sufficient in precluding a likelihood of direct confusion; even where the services are identical, consumers familiar with the earlier mark are likely to at least acknowledge that the marks are different on account of the addition of ‘Bingo’, even if they allow the addition little importance when it comes to the identification of origin.

86. That leaves indirect confusion to consider. The shared use of the word ‘Garage’, which I have found to have no immediate relationship with the services at issue, is likely, in my view, to lead consumers to erroneously conclude, wherever similarity in the services is engaged, that the marks originate from the same or at least an economically linked undertaking. Using Mr Purvis’ examples as a guide, I find that consumers are likely to assume that the non-distinctive element added to the earlier mark is consistent with a sub-brand or brand extension. In other words, indirect confusion will occur.

## **Conclusion**

87. Subject to any successful appeal, the application will **proceed to registration** for:

**Class 41:** *Conducting of live sports events; Lottery services; Organisation of competitions and awards; Organisation of events for sporting purposes.*

**Class 43:** *Event facilities and temporary office and meeting facilities; Providing facilities for exhibitions.*

and **will be refused** for:

**Class 41:** *Arranging and conducting of entertainment events; Arranging and conducting of entertainment events for charitable fundraising purposes; Arranging and conducting of live entertainment events; Arranging and conducting of live entertainment events for charitable purposes; Arranging and conducting of meetings in the field of entertainment; Arranging and conducting of music concerts; Arranging and presenting of live performances; Arranging, conducting and organisation of concerts; Arranging for students to participate in recreational activities; Arranging group recreational activities; Arranging of competitions for education or entertainment; Arranging of competitions for entertainment purposes; Arranging of concerts; Arranging of cultural events; Arranging of displays for entertainment purposes; Arranging of festivals for entertainment purposes; Arranging of music shows; Arranging of musical entertainment; Arranging of musical events; Arranging of quizzes; Arranging the provision of recreation facilities; Club services [entertainment]; Conducting of entertainment events; Conducting of live entertainment events; Consultancy services in the field of entertainment; Entertainment services in the nature of arranging social entertainment events; Entertainment services in the nature of competitions; Entertainment services in the nature of contests; Festivals (Organisation of -) for entertainment purposes; Festivals (Organisation of -) for recreational purposes; Funfair services; Live entertainment; Live entertainment production services; Magic show services; Organisation of events for cultural and entertainment purposes; Party planning.*

**Class 43:** *Catering for the provision of food and drink; Catering of food and drinks; Food and drink catering; Mobile catering; Providing food and drink; Providing food and drink for guests.*

## **Costs**

88. Whilst both parties have achieved a measure of success, as the opponent's success is proportionately greater, it is entitled to a contribution toward its costs. As neither party to these proceedings is professionally represented, at the conclusion of the evidence rounds the Tribunal invited both parties to indicate whether they intended to make a request for an award of costs. If so, they were asked to complete a pro-forma providing a breakdown of their actual costs, including accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition. It was made clear to the parties that if the pro-forma was not completed "no costs, other than official fees arising from the action and paid by the successful party... will be awarded". Neither party elected to respond to that invitation. Consequently, costs are awarded to the opponent on the following basis:

Official fee (Form TM7):	£100
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<b>Total:</b>	<b>£100</b>
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**89. I order Carmella Stanbury to pay Purple Sand Limited the sum of £100. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.**

**Dated 31 May 2019**

**Laura Stephens  
For the Registrar**