TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2112584
BY MICHEL HARPER
TO REGISTER THE TRADE MARK
BARMAMBO
IN CLASS 42

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 47405
BY BIG FISH

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IN THE MATTER OF APPLICATION No 2112584
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TO REGISTER A TRADE MARK IN CLASS 42

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 47405
by BIG FISH LIMITED

DECISION

On 10 October 1996, Michel Harper of Onslow Street, Guildford, Surrey, GU1 4SQ applied under the Trade Marks Act 1994 for registration of a series of twelve Trade Marks as shown below:

BAR Mambo
BAR mambo
BARMAMBO
BARMambo
BARmambo
MAMBO BAR
MAMBOBAR
Mambo BAR
MamboBAR
mamboBAR
mambo BAR

In respect of the following services in Class 42:

> "Restaurant services; catering services; bar, cocktail bar and nightclub services; catering for the provision of food and drink; provision of facilities for the consumption of alcoholic and non-alcoholic beverages."

On the 28 August 1997 Big Fish Limited of 2nd Floor, Mardy Chambers, 6 Wind Street, Swansea, SA1 1DH filed notice of opposition to the application. The grounds of opposition are in summary:

> i) The marks applied for, consist entirely of dictionary words BAR and MAMBO which are wholly non-distinctive for a mambo bar and are descriptive of a food and drink

establishment in which mambo music is played. The application therefore offends against Section 3(1)(b), 3(1)(c) & 3(1)(d).

ii) The mark applied for offends against Section 3(6) in that it is made in bad faith and the trade mark is not the applicant's mark.

The opponent further requested that the Registrar refuse application number 2112584 in the exercise of her discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as she did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects.

The applicant filed a counterstatement denying all the grounds of opposition. Both sides asked for costs. Both sides filed evidence in these proceedings, and the matter came to be heard on 31 May 2000 when the applicant was represented by Mr Bubb from Trade Mark Agents Gee & Co, whilst the opponent was not represented but instead submitted observations.

OPPONENT'S EVIDENCE

This takes the form of a statutory declaration, dated 29 December 1997, is by Mr Stephen Entwistle the Managing Director of Big Fish Limited, the opponent. Mr Entwistle has held his position since 31 July 1996.

Mr Entwistle states that his company trades as a restaurant café bar under the trading name CAFÉ MAMBO and has done so since November 1996. He claims that preparations to open the café were made during the period July 1996 - November 1996, which included applying for a liquor licence, preparing advertising and signage using the name CAFÉ MAMBO and fitting out the premises.

At exhibit SE1 are copies of the licensing application (dated 18 September 1996), the advertisement of their application in a local paper (dated 24 September 1996) as well as an invoice relating to the preparation of advertising materials (dated 27 September 1996) and camera ready copies of these materials.

Mr Entwistle also claims to have applied to register as a trade mark the name CAFÉ MAMBO in what he describes as "a distinctive stylised form". He lists the services covered in his application and they are virtually identical with those in the application in suit. At exhibit SE2 is a copy of the stylised form applied for. The date of the application is not provided.

He continues:

> "I have been active in managing pubs, restaurant and bars since 1987. In that time I have become aware of the popularity of 'themed' outlets providing an ambience of particular style and character. Often such outlets are based on a particular identifiable culture, or music."

> "My company's CAFÉ MAMBO concept was to provide a themed restaurant and café bar based upon the well known Latin American mambo music. The word mambo is used

in context as a direct description of the type of music and character patrons can expect to experience in our establishment. Attached hereto marked exhibit SE3 is a copy of page 1014 of Chambers Dictionary (1993 edition) which gives a definition of the word mambo as follows:

> 'A Latin American dance or dance tune of Haitian origin, resembling the rumba.'

Also attached hereto marked exhibit SE4 are copies of two exemplary compact disc cover booklets entitled 'Mambo Kings' and 'Mambo Fever'. Both of these show clearly that mambo is used to describe a particular and distinctive style of music."

Mr Entwistle states that in his opinion "third parties would be likely to wish to use the dictionary word mambo to legitimately describe café bar and restaurant type establishments in which the mambo 'theme' is embodied and mambo music played." He provides a list of ten establishments with the word MAMBO as part of their title. Three are in the UK, the others are in USA, France Spain and Switzerland. The three UK establishments are called "The Mambo Club", "The Mambo Inn" and "Café Mambo". At exhibit SE5 are various pages from the internet which have references to the establishments listed.

Lastly Mr Entwistle states that:

> "In the light of my experience in the trade, and my statement in paragraph 7 above, it is my opinion that the word "mambo" has become customary in the current language and the bona fide and established practice of my company's business in relation to pub, café, bar and restaurant type establishments in which the mambo "theme" is embodied and mambo music played."

APPLICANT'S EVIDENCE

This consists of a statutory declaration, dated 25 June 1998, by Ms Michel Harper, the Managing Director of Harpers Leisure International Ltd, a position she has held since the company's formation in 1990.

Ms Harper states that on 19 December the applicant opened a live music bar and restaurant under the trade mark BAR MAMBO in Guildford. She states that the mark was chosen after a search of the UK Trade Marks Register. The name was chosen after the mark BAR CUBA was abandoned as BAR MAMBO had "a much more general latin theme and not merely indicative of a particular location or culture".

Ms Harper agrees with the opponent that the word MAMBO is descriptive of a particular type of music. She questions as to whether the opponent's preparations date from July 1996, and also claims that there is no evidence that the opponent used the mark prior to the relevant date. She claims to have been unaware of any of the establishments listed in the opponent's evidence and claims that the three UK establishments are the only ones which should be considered. Ms Harper states that in her view the names are distinctive trade marks of these establishments. She also states that it is her belief that "it is extremely unlikely that any bar would ever provide mambo

music 100% of the time".

She further states:

> "I consider the implication contained in paragraph 5 of Mr Entwistle's declaration, namely that the name CAFÉ MAMBO was intended to be merely descriptive of premises dedicated to the playing of mambo music, to be distinctly suspect. I consider that Mr Entwistle selected the name for precisely the same reason that I selected BAR MAMBO, namely because he considered it to be distinctive of restaurant and bar services having a generally Latin American theme. This is bourne out by the fact that Mr Entwistle's company filed Trade Mark Application No 2116249 in classes 35 and 42. Clearly Mr Entwistle would not have filed such a trade mark application unless, at the time, he had considered the trade mark CAFÉ MAMBO to be distinctive of the services concerned."

That concludes my review of the evidence. I now turn to the decision.

DECISION

I shall consider first the ground of opposition under Section 3(1)(b), (c)& (d), which reads:

> *3). 1 The following shall not be registered -*
>
> *(b) trade marks which are devoid of any distinctive character,*
>
> *(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*
>
> *(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.*
>
> *Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.*

I begin by considering the law. In British Sugar Plc v James Robertson and Sons Limited (TREAT) 1996 RPC 281, Mr Justice Jacob said -

> "Next is "Treat" within Section 3(1)(b). What does *devoid of any distinctive* character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word

> inappropriate for the goods concerned (" North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word *inherently* from the old Act but the idea is much the same) devoid of any distinctive character."

I also have regard to the comments of Aldous LJ in the Phillips Electronics NV v Remmington Consumer Products Limited case (1999) RPC 23 in which he stated:

> " The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing."

The decisions above indicate that the correct approach is to start with the premise that a trade mark is capable of distinguishing insofar as it is not incapable. A trade mark which is found to have sufficient inherent distinctive character to be able to distinguish must be capable of distinguishing. A trade mark which does not have any inherent distinctive character may nonetheless acquire distinctiveness through the use made of it, and in doing so it must, by inference, be capable of distinguishing.

To establish an objection under Section 3(1)(d) in inter-partes proceedings requires evidence that the term is in use, although not necessarily showing the mark being used in the course of trade. The wording of sub-section (c) imposes a less stringent test than under sub-section (d) going to whether the mark is sufficiently descriptive of a characteristic of the goods for there to be a reasonable likelihood that it will be required for use by other traders. If the answer to this question is in the affirmative, it follows that the mark must, prima facie, be lacking in the necessary distinctive character to function as a trade mark and be contrary to sub-section (b).

The mark in question is BARMAMBO / MAMBOBAR. which the opponent claims is two basic English words. One BAR is a well known word. A definition from Chambers Dictionary is provided for MAMBO:

> " A Latin American dance or dance tune of Haitian origin, resembling the rumba."

The applicant does not dispute that the word MAMBO is descriptive of a particular type of music.

The opponents have claimed that the mark applied for is used by others in the trade as a description for establishments which play mambo music and offer food and drink. The evidence of this use consists of pages taken from internet sites. There are ten establishments named, of which three are in the UK. Whilst all have the word MAMBO included in them none are BARMAMBO or MAMBOBAR. That a small number of traders may use the word MAMBO as part of a trade mark or trading style does not necessarily make the word "customary in trade", but it can be taken as a pointer towards the aptness of the word for use in connection with such service establishments.

The specification of the application in suit is "Restaurant services; catering services; bar, cocktail bar and nightclub services; catering for the provision of food and drink; provision of facilities for the consumption of alcoholic and non-alcoholic beverages". Such premises are commonly "themed"and/ or may play a particular type of music, e.g. Jazz bar.

In my view the marks applied for BARMAMBO / MAMBOBAR consist exclusively of signs that may serve in trade to designate the kind or quality of the services, and are therefore excluded from registration by Section 3(1)(c) of the Act. For the same reason I consider the marks to be devoid of distinctive character and therefore not acceptable, prima facie, for registration under Section 3(1)(b) of the Act. Consequently the opposition under these two grounds succeed, although I dismiss the ground of opposition under Section 3(1)(d)

Lastly I consider the ground of opposition under Section 3(6) which is as follows:

> *"3 (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."*

In my view the opponents have offered no evidence to support this pleading, therefore I do not consider this ground proven.

The opposition having succeed the opponent is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £835. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23 day of August 2000

George W Salthouse
For the Registrar
The Comptroller General