

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2167177
IN THE NAME OF ANDREW DAVID RADFORD AND LISA RADFORD**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 49618
IN THE NAME OF ALLIED DOMEQ RETAILING LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No 2167177
in the name of**

5

and

**IN THE MATTER OF opposition thereto under No 49618
in the name of Allied Domecq Retailing Limited**

10

Background

15 On 20 May 1998. Andrew David Radford and Lisa Radford applied to register the trade mark BLUE in Class 42 in respect of the following services:

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

20

On 7 April 1999, Allied Domecq Retailing Limited filed notice of opposition to this application, in which they say that they are the applicants for the following United Kingdom trade mark:

25	Number	Mark	Class	Specification
	2174774	BLUE BAR CAFÉ	42	Restaurant hotel, motel, snack bar and public house services; catering services; room hire services.

30

The grounds of opposition are in summary:

- 35 **1. Under Section 3(1)(b) & (c)** Because the mark applied for consists exclusively of signs or indications which may serve in the trade to designate the kind, quality, quantity, intended purpose or other characteristic of the services in relation to which registration is sought, and so is devoid of any distinctive character.
- 40 **2. Under Section 5(2)(a) & (b)** Because the mark applied for is identical or confusingly similar to the opponent's mark and is to be registered for identical or similar services.
- 45 **3. Under Section 3(6)** Because the applicants do not intend to use the mark in relation to all the services for which registration is sought.

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

Both sides request that costs be awarded in their favour.

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

Opponent's evidence

This consists of three Statutory Declarations. The first is dated 26 January 2000, and comes from Jane Ann Nelson, a solicitor and trade mark attorney employed by Allied Domecq PLC, a position she has held since April 1998.

Ms Nelson refers to searches carried out on the Internet and via the BT on-line telephone directory and Yellow pages to find instances of the use of BLUE and BLUES, particularly in relation to services in the hotel and catering industries. She refers to exhibits JAN1 and JAN2 which contain details of the search results, some of which she lists in her Declaration.

Ms Nelson refers to a Declaration dated 2 June 1999 by Andrew David Radford filed in support of opposition number 49403 (exhibit JAN3), and in particular, to paragraph 12 in which Mr Radford says that he is not aware of a very large number of third parties using the word BLUE as part of their trade marks or trading styles. Ms Nelson gives details of restaurant businesses in the proximity of the applicant's own restaurant, and refers to exhibit JAN4 which consists of an extract of Electronic Yellow Pages containing details of two.

The second Statutory Declaration is dated 3 February 2000, and comes from Richard Edgar Bell, Company Secretary of Punch Retail Limited (which he says was formerly Allied Domecq retailing Limited), a position he has held since May 1999, having previously been Assistant Company Secretary for many years.

Mr Bell refers to his company's development of the concept of a minimalist bar around February 1998, and to the involvement of a company, Portland Design who were engaged to come up with a design and a range of names with appropriate branding. He says that his company selected BLUE BAR CAFÉ as a name because it portrayed a contemporary image, emphasised the importance of food and coffee, the word blue being relevant to the design. He refers to exhibit REB1 which consists of a number of photographs. Mr Bell refers to the opening of a number of establishments under the name.

The final Declaration (filed under Rule 13(10)) is dated 25 July 2000, and comes from Roland Christopher Wilding, a trade mark attorney employed by Castles.

Mr Wilding refers to the Declaration of Jane Nelson, and in particular, to the list of search results in paragraph 2, some of which he contacted, the results of which he lists.

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

Decision

5 Turning first to the grounds under Section 3(1)(b) & (c). Those sections read as follows:

3.(1) The following shall not be registered -

10 (a)

(b) trade marks which are devoid of any distinctive character,

15 (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 rendering of services, or other characteristics of goods or services,

(d)

20 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.

25 I begin by looking at how the law stands. In the *British Sugar Plc v James Robertson & Sons Ltd (TREAT)* trade mark case, (1996) RPC 9, Mr Justice Jacob said:

30 “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 from 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.”

40 The meaning of “devoid of any distinctive character” was addressed by Lord Justice Robert Walker in a recent appeal by Proctor & Gamble Limited in relation to their bottle marks ([1999] RPC 673) who commented as follows:

45 Despite the fairly strong language of s.3(1)(b), “devoid of any distinctive character” - and Mr Morcom emphasised the word “any” - that provision must in my judgement be directed to a visible sign or combination of signs which can by itself readily distinguish one trader’s product - in this case an ordinary, inexpensive household product - from that of another competing trader”.

In the Home Shopping case (unreported) Mr Simon Thorley sitting as the Appointed Person cited with approval the decision in the Proctor & Gamble case, and went on to say:

5 In my judgement, Mr McCall is placing too light a restriction upon Section 3(1)(b) when he suggests that a mere spark of distinctiveness is enough.

10 I am bound, and with respect, agree with the reasoning of Robert Walker LJ. One must have regard to the mark as a whole, and ask whether the combination of signs contained in the trade mark can by itself readily distinguish the products or services of one trader from those of another.

This approach is in accord with the European Court of Justice's judgement in Windsurfing Chiemsee [1999] ETMR 585.

15 There is no evidence of any use of the mark by the applicants so I only have the prima facie case to consider. The basis of the opponent's objection appears to have two strands; an inference that the word conveys an image, emphasised the importance of food and coffee and was relevant to the design, and that the fact that other traders use the word BLUE as, or as part of the name of their establishments.

20 The word BLUE is an ordinary English word with the primary designation of a colour. There are other meanings, for example, a mood, but I do not consider that these can have any more relevance. How the word serves to "emphasise the importance of food and coffee" escapes me. It could be relevant in respect of foods or drinks coloured BLUE but in this case the trade mark has been applied for in respect of services and not goods. Whilst it cannot be disputed that BLUE would be an appropriate way to describe premises decorated with that colour, I do not consider that it says anything about the services themselves. I accept that BLUE may well convey a particular image, for example, sometimes being used to say "cool" or "refreshing", but so what? Many words can create an image and yet could not by any stretch of the imagination be said to be devoid of any distinctive character or to describe a characteristic of the goods or services it is to be used in connection with, and I can see no substance in such arguments in this case.

35 The second part of their objection relies on the premise that if other traders use the word as, or as part of their trading style, that the word describes a characteristic of the goods or services and/or is incapable of distinguishing the applicant's services. This is clearly a fallacious argument. From my own knowledge I am aware that it is not uncommon for licenced premises to share the same name or parts of a name, for example, Rose & Crown, Crown and Sceptre, etc, even within the same town or city. There can be no suggestion that such names are incapable of distinguishing, or that they describe a characteristic of the establishments goods or services. Consumers are, in my view, well used to seeing similarity in respect of the names of licenced premises but they are still capable of distinguishing one from another, although I do accept that with the exception of a number of national chains, most café and bars tend to be frequented by informed local customers.

45 Given that BLUE is an ordinary descriptive word, it is not surprising that traders use it in their trading styles, be it as a description, eg, Blue Parrot, or to convey a desired image, but such

use, at best, points to the attractiveness of the word which does not make it open to objection, and the grounds founded under Section 3(1) (b) and (c) are dismissed accordingly.

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

5(2)- A trade mark shall not be registered if because -

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

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

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

(a) a registered trade mark, international trade mark (United Kingdom) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

The relevant date in these proceedings is the date on which the application under opposition was made, that is, 20 May 1998. The mark relied upon by the opponents has date of application of 13 August 1998, some months later than the opposed application, and as no priority has been claimed it does not constitute an earlier trade mark. Consequently, the ground under Section 5(2)(b) has no basis and is dismissed accordingly.

The final ground relates to Section 3(6) of the Act. That section reads as follows:

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

The opponent's case rests upon the assertion that the applicant does not, and never has had a bona fide intention of using the mark in relation to all of the services applied for.

Section 32(3) of the Act does not require that an applicant be using the trade mark in relation to all, or indeed any of the goods or services for which they seek registration, either at the time the application is made or at any time in the future, only that there is a bona fide intention that it will be so used. In some circumstances the Registrar may raise an objection under Section 3(6) during the ex parte examination of an application, most usually because of the breadth of a claim, but will do so only in the most obvious or serious instances, with less clear cut cases being left to be resolved under the provision of the Act intended to deal with such matters, an outcome envisaged by Laddie J. in the Mercury case (1995 FSR 850).

5 The provisions of Section 46 of the Act indicates that an applicant should have a real and definite intention of putting a mark into use in respect of the goods or services for which it is registered within the five years following registration. This futurity means that unless it can be established that an application covers goods/services which the applicant knows the trade mark will never be used in connection with, there is little likelihood of a finding that they acted in bad faith in making the application. There is no such evidence here.

10 To my mind the specification of services set out in the application is not so wide as to be unlikely to be provided by one and the same undertaking, and are either those that they appear to have been providing, or are sufficiently closely allied for it to be within the realms of possibility that they may provide them in the future. Consequently the ground founded under Section 3(6) fails.

15 The opposition having failed on all grounds, I order that the opponents pay the applicants the sum of £635 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

20 **Dated this 27TH day of June 2001**

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