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THE PATENT OFFICE

Harmsworth House,
13-15 Bouverie Street,
London, EC4Y 8DP

Tuesday, 30th January, 2001

Before:

MR. G. HOBBS Q.C.

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In the Matter of the TRADE MARKS ACT 1994

and

In the Matter of Trade Mark Application No. 2,112,584 in
the name of MICHEL HARPER to
register a trade mark in Class 42

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Appeal of Applicant to the Appointed Person from
the Decision of Mr. G.W. Salthouse, acting on behalf
of the Registrar, dated 23rd August 2000.

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(Transcript of the Shorthand Notes of Marten Walsh Cherer
Ltd., Midway House, 27-29 Cursitor Street, London, EC4A 1LT.
Telephone No: 02074055010. Fax No: 02074055026.)

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DR. PETER COLLEY (instructed by Messrs. Gee & Co.)
appeared on behalf of the Applicant.

THE OPPONENT was not present and was not represented.

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D E C I S I O N
(As Approved)

D E C I S I O N

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MR. HOBBS: On 10th October 1996 Michel Harper applied to register a series of 12 marks for use as trade marks in relation to "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" in Class 42. The first six marks in the series consisted of the words BAR MAMBO, represented in slightly different forms of letterpress. The second six marks in the series consisted of the words MAMBO BAR, also represented in slightly different forms of letterpress.

In accordance with the provisions of section 41(2) of the Trade Marks Act 1994, the marks in the series of 12 were put forward for registration on the basis that they resembled each other as to their material particulars and differed only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark for which protection was requested.

Subsequently, on 28th August 1997, Big Fish Limited filed notice of opposition to the application. For present purposes I need only mention that objections to registration were raised under sections 3(1)(b) and 3(1)(c) of the Act, on the basis that the marks in suit consisted entirely of the dictionary words "Bar" and "Mambo" which, taken together, were said to be wholly non-distinctive for a mambo bar and

1 descriptive of a food and drink establishment at which mambo
2 music is played.

3 The evidence in support of the opposition consisted of
4 a statutory declaration of Stephen Entwistle dated 29th
5 December 1997. His evidence confirmed by reference to a
6 dictionary entry and other materials that the word "Mambo"
7 was generally liable to be used and understood as a
8 description of a type of Latin American music or of a Latin
9 American dance style. He also referred to the existence of a
10 trend for operating themed pubs, restaurants and bars under
11 names indicative of the type of music and ambience that
12 patrons could expect to enjoy at such premises. In that
13 connection he gave evidence of the existence of an
14 establishment in Swansea operated by his company under the
15 name CAFE MAMBO; an establishment in Taunton also operated
16 under the name CAFE MAMBO; an establishment operated in South
17 London under the name THE MAMBO INN; and an establishment in
18 Edinburgh operated under the name THE MAMBO CLUB. He
19 maintained that use of the word MAMBO, in combination with
20 the word BAR in relation to Class 42 services of the kind
21 specified in the application would simply be understood
22 descriptively as indicating the nature and character of the
23 themed services with reference to which the words were used.

24 The applicant for registration indicated in a statutory
25 declaration dated 25th June 1998 that he had adopted the
26 words BAR and MAMBO for use in combination to denote that his

1 services had a Latin theme to them. He none the less
2 maintained that the marks in suit would be understood in a
3 distinctive sense and not merely descriptively when used in
4 relation to the specified services. The application was not
5 supported by any evidence that the marks had acquired a
6 distinctive character through use in the United Kingdom prior
7 to 10th October 1996.

8 The opposition proceeded to a hearing before Mr. G.W.
9 Salthouse, acting on behalf of the Registrar of Trade Marks,
10 on 31st May 2000. In a written decision issued on 23rd
11 August 2000, Mr. Salthouse upheld the objections to
12 registration under section 3(1)(b) and section 3(1)(c) of the
13 Act and ordered the applicant to pay the opponent £835 as a
14 contribution towards its costs of the opposition. In essence
15 he held that the marks in suit were apt to do no more than
16 indicate a class or category of themed services and were, for
17 that reason, unregistrable in the absence of distinctiveness
18 acquired through use.

19 The applicant gave notice of appeal to an Appointed
20 Person under section 76 of the Act. In his grounds of appeal
21 he referred to the fact that the second six marks in the
22 series, i.e. those in which the word MAMBO preceded the word
23 BAR, had been, or were about to be, deleted from the relevant
24 application for registration. He maintained that the
25 remaining marks, i.e. those in which the word BAR preceded
26 the word MAMBO, were sufficiently distinctive of the services

1 of interest to him to be registrable under the Act.

2 In argument before me it was submitted that there was a
3 spark of distinctiveness in placing the word BAR before the
4 word MAMBO. It was also submitted that the marks in suit
5 were, at worst, allusive without being descriptive to the
6 point at which registration ought to be refused.

7 Whilst I agree that it is somewhat ungrammatical to put
8 the word BAR in front of the word MAMBO, I do not think that
9 the inversion of the words would, in modern English usage, be
10 understood to any significant extent differently from the
11 words MAMBO BAR.

12 In relation to the question whether the words BAR and
13 MAMBO in combination are too descriptive to be registrable in
14 relation to the services of interest to the applicant, I must
15 say that this is a matter of impression and, moreover, a
16 matter of impression on which not everyone would necessarily
17 agree.

18 I recognise that there is a difference of degree
19 between descriptiveness and allusion. However, I do think
20 that the descriptive qualities of the words BAR and MAMBO are
21 not lost in combination. It seems to me that their meaning
22 and significance in combination is not so oblique as to imbue
23 them with the distinctive character which is an essential
24 prerequisite for registration under the Act.

25 On balance I consider that the Hearing Officer was
26 right to arrive at the decision he did. For these reasons,

