

O-073-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2492023

BY

G1 GROUP PLC

TO REGISTER THE TRADE MARK:

BONHAMS

IN CLASSES 41 AND 43

AND

THE OPPOSITION THERETO

UNDER NO 98965

BY

BONHAMS 1793 LIMITED

Trade Marks Act 1994

**In the matter of application no 2492023
by G1 Group plc
to register the trade mark:
BONHAMS
in classes 41 and 43
and the opposition thereto
under no 98965
by Bonhams 1793 Limited**

1) On 7 July 2008 G1 Group plc (G1) filed an application to register the trade mark **BONHAMS**. The trade mark was published in the *Trade Marks Journal*, for opposition purposes, on 20 February 2009. Since the publication of the trade mark the specification has been amended to read:

nightclub services; discotheque services; dance club services; organisation and hosting of musical events; provision of live entertainment and recorded entertainment; music and entertainment services; promotion of musical events; club entertainment promotion; entertainment event promotion; provision of music and entertainment facilities; organising, conducting and providing facilities for parties; information, advisory and consultancy services relating to all of the aforesaid services;

hotel, motel, restaurant, bar, wine bar, cafe; bistro, brasserie and cafeteria services; cocktail bar services; provision of food and drink; provision of temporary accommodation; banqueting and catering services; organisation and provision of facilities (venues) for conferences, weddings, meetings and events; information, advisory and consultancy services relating to all of the aforesaid services.

The above services are in classes 41 and 43 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 20 April 2009 Bonhams 1793 Limited (1793) filed a notice of opposition to the registration of G1's application. 1793 relies upon sections 5(1), 5(2)(a), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act).

3) Sections 5(1) and 5(2) of the Act state:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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.”

Section 5(3) of the Act states:

“(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

Section 5(4)(a) of the Act states:

“4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented——

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade”.

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he

must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

4) In relation to sections 5(1), 5(2)(a) and 5(3) of the Act, 1793 relies upon United Kingdom trade mark registration 2425593 of the trade mark BONHAMS. The application for registration was filed on 23 June 2006 and the registration process was completed on 29 December 2006. The trade mark is registered for:

electronic publications, downloadable; computer software for the taxonomy and display of catalogues, magazines, bulletins and newsletters concerning fine and decorative art, antique and collectible articles, cars and other valuable property, paintings, drawings, prints, posters, photographs, illustrations and animation art, postage stamps, autographs, manuscripts, sheet music, maps and atlases, and comic books;

paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; books, catalogues, magazines, bulletins and newsletters concerning fine and decorative art, antique and collectible articles, cars and other valuable property; paintings, drawings, prints, posters, photographs, illustrations and animation art; postage stamps; autographs; manuscripts; sheet music; maps and atlases; and comic books;

advertising; business management; business administration; office functions; including auction services; formation, maintenance and exploitation of a register of property (other than real estate); taxation consultation; administrative processing of orders in connection with services featuring books and catalogues concerning fine furniture and decorative art, antique and collectible articles, and other valuable property; auctioneering services; auction advice and consultancy services; valuation services; organisation and conducting of Internet auctions;

insurance; financial affairs; monetary affairs; real estate affairs; including valuation; insurance brokerage and insurance underwriting relating to goods; arranging loans against security; provision of loans; financial guarantees; financial consultancy; estate agency services; financial and real estate services, appraisal services for others for fine furniture, fine and decorative art, jewellery, stamps, coins, books and other valuable property;

warehousing services; bonded warehousing; rental of warehousing; guarded storage of goods; secure storage of goods; rental of storage facilities; packaging of goods; transportation of goods; advisory and consultancy services relating to aforesaid services;

arranging of exhibitions; education and training services; educational and training services relating to the fine arts, antiques, jewellery, watches and horological instruments; collectibles, antiquities, painting, sculpture, ceramics, porcelain, furniture, silver, silverware and to wines; online publications and publishing services.

The above goods and services are in classes 9, 16, 35, 36, 39 and 41 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

5) 1793 claims that all of the goods and services of its earlier registration are identical or similar to the services of the application. Owing to the identity of the respective trade marks, it claims that registration of the application would be contrary to sections 5(1) and/or 5(2)(a) of the Act. It claims that it has a reputation in respect of all of the goods and services of its registration 1793 states that its principal business is auctioneering, which demands the highest of reputations and absolute integrity. It claims that the proposed activities of G1, as per the specification of the application, would erode its business credibility, whilst seeking to gain an unfair advantage of respectability for G1's proposed casino and other activities. (The casino services were removed from the specification after the publication of the application.) 1793 claims that use of the trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of its trade mark. Consequently, registration of G1's trade mark would be contrary to section 5(3) of the Act.

6) 1793 states that it has used the sign BONHAMS since 1793 in relation to auction houses and related and ancillary services. It claims that use of G1's trade mark in relation to all of the services of the application would be liable to be prevented by the law of passing-off. In particular 1793 states that the specification of the application includes: "*organisation/hosting of musical events, concerts, parties, shows, events, seminars, exhibitions and symposiums*". It states that it sponsors, arranges and hosts all of these types of event in the furtherance of its business. (Certain of these services were removed from the specification of the application in the amendment after publication.) 1793 claims that registration of G1's trade mark would be contrary to section 5(4)(a) of the Act.

7) 1793 also claims that it has a well-known trade mark. It gives no details of what this trade mark is nor in relation to what goods and services it has been used and for which it is claimed that it is well-known. Consequently, no more will

be said about this claim. (As 1793 has a registered trade mark the only reason to rely upon a well-known trade mark would be that if it was well-known for goods and/or services which are not included in the specification of the registration.)

8) G1 filed a counterstatement. It accepts that the respective trade marks are identical. It denies that the services of the amended specification are identical or similar to those of the earlier registration, consequently, the grounds of opposition under sections 5(1) and 5(2)(a) of the Act should be dismissed.

9) G1 denies, in relation to section 5(3) of the Act, that 1793 has a reputation in the trade mark BONHAMS other than as an auction house. G1 claims that the services covered by the amended specification are in a completely different commercial field to the goods and services covered by 1793's trade mark. It denies that registration of its trade mark would be contrary to section 5(3) of the Act. G1 puts 1793 to proof that its reputation extends beyond that of an auction house. G1 states that the trade mark BONHAMS has been the name of a public house in Byres Road in Glasgow for a number of years. G1 puts 1793 to proof of instances of confusion between the BONHAMS public house and the activities of 1793 under the name BONHAMS. G1 claims that no one would call to mind the activities of 1793 if they were "presented with a restaurant, bar, night club or a casino named BONHAMS, and that there would be no "unfair advantage of respectability", whatever that may be". G1 denies the grounds of opposition under section 5(4)(a) of the Act.

10) 1793 furnished evidence in the form of two witness statements. G1 furnished written submissions. The second witness statement for 1793 includes submissions.

Evidence of 1793

11) This consists of two witness statements by Steven John Jennings. Mr Jennings is a trade mark attorney with Lewis Silkin LLP. G1 accepts that 1793 has a reputation as an auction house. The first part of Mr Jennings statement deals with this reputation, consequently, it is not necessary to summarise much of this. At exhibit SJ1 is a page downloaded from bonhams.com on 17 February 2010 entitled "About Us". The page only describes the auction activities of 1793. The short cut elements of the page make no reference to other services or goods, although events appears in a shortcut list. Exhibited at SJ3 are copies of reports and financial statements. The principal activity of 1793 is described as that of "auctioneers and valuers". Exhibit SJ4 consists of pages downloaded from the Internet that have references to 1793. Many of the pages emanate from outside the United Kingdom and/or after the date of G1's application. On numerous occasions the same matter appears, pages downloaded from "Hoovers Company In-Depth Records". The pages all relate to 1793 as an auction house, a matter not in dispute.

12) Mr Jennings states that on 9 August 2008 he visited the site which was previously known as BONHAMS. The staff of Atrio, the bar and restaurant standing in the place of BONHAMS, confirmed that they had been in business for some weeks at 192-194 Byers Road. Exhibited at SJ5 is a photograph of Atrio. Mr Jennings states that in August 2008 few people could recall the existence/location of the former public house. Mr Jennings states that he believes that since his visit Atrio has been replaced by the Curry Leaf Indian restaurant, exhibited at SJ6 is a page downloaded from the website thecurryleafglasgow.com. Mr Jennings states that by the time that 1793 became aware of the public house it had already closed, making it impossible to collect evidence of confusion.

13) Mr Jennings states that 1793 “possesses prestigious premises in many locations containing interesting and diverse exhibits of art and culture and is therefore well known for hosting events, whether for third parties or itself. Further a substantial part of the Opponents (sic) business is greatly furthered by its events which tend to be more informal and are often accompanied, (depending upon the time of day) by music, drinks and canapés.”

14) At exhibit SJ7 is a copy of an article from *The Observer* of 14 February 2010 which includes the following:

“At the beginning of this month, the Tories hosted an arts event at the auction house Bonhams and their next soiree is timed to coincide with London Fashion Week.”

At exhibit SJ8 is a page downloaded from bonhams.com. It gives information of a “selling exhibition of David Bailey’s iconic images of the 1960s” that is to take place between 7 March and 7 April 2010. Both of these events occurred after the date of the filing of G1’s application, 7 July 2008.

15) Mr Jennings states that the name BONHAMS is very unusual. He states that the online BT directory lists no individual with that name. In the business directory the only entries for BONHAMS in London and Glasgow relate to 1793. Exhibited at SJ9 are copies of the searches. Mr Jennings states that the trade mark registers of the Intellectual Property Office, the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) and the international register also reflect the uniqueness of 1793’s name, in that only 1793 has registered rights in any class for the name. The only pending application is that of G1, the subject of these proceedings. Exhibited at SJ10 is a copy of the search results from the website of the Intellectual Property Office. Mr Jennings states that Lewis Silkin LLP has been asked by 1793 to take action against various companies that “have attempted to use the Bonhams name without due cause”. He states that the most recent example was a company called Bonhams Overseas Limited, registered at Companies House with number 06846823. Mr Jennings states that the company claimed that its main business was real estate

services and the rental of holiday homes and that it did not conflict with the rights of 1793. The company subsequently provided undertakings to 1793 and has changed its name to Parks Overseas Limited; exhibited at SJ11 is a copy of the record from Companies House which show that the company changed its name on 7 July 2009.

16) Mr Jennings states that the key services of 1793 are centred upon the auction business. He states, however, that in order to maintain the business and maintain its prestige 1793 has hosted events to publicise itself and its connections with industrial, artistic and educational endeavours. Mr Jennings states that he has been informed that 1793 arranges between 40 and 70 events every year. The majority of these are held at the New Bond Street offices of 1793, which also houses a lecture theatre. He states that events have been held at various locations around the United Kingdom: Tattersalls, Treve House Penzance, Penhurst Place, Edinburgh, Bath, The Royal Norfolk Show, The CLA Game Fair, The Goodwood Revival Meeting, Winchester Cathedral, The Great Yorkshire Showground and The Leander Club. Exhibited at SJJ1 are copies of various invitations:

- Invitation to a celebrity charity art auction organised by Coutts to take place at Bonhams, 101 New Bond Street on 5 November (year unknown). A list of supporters is given, which includes 1793.
- An invitation to a private view for a sale in Bury St Edmunds from the directors of 1793 for 9 October 2006.
- An invitation to a private view for a sale in Henley from the directors of 1793 for 13 July 2006.
- An invitation to a private view for summer sales in Edinburgh from the directors of 1793 for 5 June 2006.
- An invitation to a private view of various items for sale from the directors of 1793 for 30 November 2006.
- An invitation to a charity evening preview of a sale in aid of Breast Cancer Haven's Yorkshire appeal in Harrogate from the directors of 1793 for 19 November 2007.
- An invitation to a private view for a sale in Jersey from the directors of 1793 for 24 October 2008 (after the material date and out of the jurisdiction).
- An invitation to a private view for a sale in Newmarket from the directors of 1793 for 18 July 2008 (after the material date).
- An invitation to a private view for a sale in Penzance from the directors of 1793 for 10 September 2008 (after the material date).
- An invitation to a presentation in Dubai (outside the jurisdiction) on 20 November (year not given) from a member of the motoring department of 1793.
- An invitation to an event in aid of the Rochester Cathedral Campaign on 28 September 2006 sponsored by 1793.

- An invitation to a private view for a sale in Edinburgh from the directors of 1793 for 4 December 2006.
- An invitation to a private view for a sale in Bath from the directors of 1793 for 15 June 2006.
- An invitation to a private view of forthcoming sales to take place at The Royal Norfolk Show from the directors of 1793 for 1 July 2010 (after the material date).
- An invitation to a private view of an exhibition from the directors of 1793 at its premises in New Bond Street on 11 January 2010 (after the material date).
- An invitation to a private view for a contemporary art, craft and design fair in Winchester from the directors of 1793 for 26 July 2007.
- An invitation to a private view for a sale in Amsterdam (outside the jurisdiction) from the directors of 1793 for 27 February 2007.
- An invitation from 1793 to a pre-viewing for cars and automobile memorabilia at Goodwood on 31 August 2007.
- An invitation to a preview of a sale at The CLA Game Fair from the directors of 1793 for 23 or 24 July 2010 (after the material date).
- An invitation to a private view of the contents of Great Brompton House from the directors of 1793 for 27 September 2008 (after the material date).
- An advertisement relating to two talks to be given at 1793's premises at New Bond Street in aid of Save a Child for 30 and 31 March 2009 (after the material date). Subsequent to the talks there were to be private views of 1793's Indian and Islamic arts sales.
- An invitation to a private view for a sale at 101 New Bond Street from the directors of 1793 for 30 March 2009 (after the material date).
- An invitation to a private view of The Tony Banks Collection at 101 New Bond Street from the directors of 1793 on 1 May 2007.
- An invitation to a private view of an exhibition at 101 New Bond Street from the directors of 1793 for 5 June 2007.
- An invitation from 1793 for The Art for Freedom auction at 101 New Bond Street on 7 June 2007.
- An invitation to a contemporary art auction at 101 New Bond Street in association with 1793 on 29 June 2010 (after the material date).
- An invitation to a private view of The South African Sale at 101 New Bond Street from 1793 for 17 February 2009 (after the material date).
- An invitation to a private view for a sale in Dubai from the directors of 1793 in Dubai for 10 October 2009 (after the material date and outside the jurisdiction).
- An invitation to a private view for a sale at 101 New Bond Street from 1793 for 23 November 2006.

Material dates

17) In relation to the claim to reputation under section 5(3) of the Act, the material date is the date of the application for registration, ie 7 July 2008.

18) A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07, in which the GC stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.”

The reasoning of the GC, *mutatis mutandis*, is followed in relation to the Act; so TMA must establish a protectable goodwill as of the date of application.

Findings of fact

19) To benefit from the provisions of section 5(3) of the Act the trade mark(s) must be known by a significant part of the public concerned by the products or services covered¹. The Court of Justice of the European Union (CJEU) in *General Motors Corporation v Yplon SA* stated how a party would establish this reputation:

“27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

20) G1 accepts that 1793 has the requisite reputation as an auction house. In its notice of opposition 1793 claims that it has a reputation in respect of all of the goods and services of its earlier registration. This position is anomalous when considered in relation to its claim in relation to section 5(4)(a) of the Act where it

states that its earlier right has been used in relation to “[a]uction houses and related and ancillary services”.

21) 1793 puts forward that its reputation extends beyond that of being an auction house. It claims that it has a reputation in relation to events. The majority of the events are private views to sales. It is common practice to promote goods and services by inviting existing customers and potential customers to view the goods or services prior to their general availability. It is common practice that invitations are sent out, often offering sparkling wine and snacks; numerous high street shops and motor dealers commonly do this. These invitations promote the goods or the services just as a billboard or a television advertisement does. 1793 considers that many of the invitations are from the directors and that this in itself has some form of significance. They are described as the directors of 1793, the invited person knows that it is 1793 behind the invitation; certain of the invitations also have BONHAMS upon them as well as “The Directors of Bonhams”. 1793 has also been sponsor for a few charitable events. Such sponsorship is also about promoting the business of the undertaking. There is nothing to suggest that there is any goodwill or reputation in relation to what are described as “events”; no more than advertising one’s services on a bill board gives a reputation or goodwill in relation to advertising services. The advertisement for two talks to be given at 1793’s premises at New Bond Street in aid of Save a Child for 30 and 31 March 2009 (after the material date) are even linked to private views of 1793’s Indian and Islamic arts sales. This is a promotional tool. The financial reports of 1793 describe its principal activities as being that of auctioneers and valuers and it is in relation to those services that it has a reputation and a goodwill.

22) The specification of 1793’s earlier registration covers a good number of services and goods for which an auction house could have a reputation such as *warehousing services* and *arranging of exhibitions* but there is an absence of evidence to support a reputation in relation to such services. Consequently, the reputation, for the purposes of section 5(3) of the Act, within the parameters of the earlier registration, are:

auction services; auctioneering services; auction advice and consultancy services; valuation services;

appraisal services for others for fine furniture, fine and decorative art, jewellery, stamps, coins, books and other valuable property.

These services reflect the core of the business as indicated in the evidence.

23) The claim to a goodwill in relation to “[a]uction houses and related and ancillary services” is too vague, “related and ancillary services” could cover a multitude of things. Taking into account the parameters of the claim and the

evidence, 1793 has established that it has a goodwill in relation to the business of an auction house.

Sections 5(1) and 5(2)(a) of the Act

Average consumer and nature of purchasing decision

24) The respective trade marks are identical. Consequently, neither the care taken in the purchasing decision nor whether visual or oral use of the trade marks is more important, will have a bearing upon the outcome of the decision; a consumer, whether average or not, cannot distinguish between identical trade marks.

Comparison of services

25) In its statement of grounds 1793 claims that all of the goods and services of its registration are identical or similar to the services of the application. In the second witness statement of Mr Jennings it is submitted that *arranging of exhibitions; education and training services* are identical to certain of the class 41 services of the application and similar to the remaining class 41 services and all of the class 43 services of the application. The submissions include consideration of parts of the specification of the application that had been deleted from the specification 16 months previously. Taking into account the amendment of the specification received on 19 June 2009, 1793 claims that *arranging of exhibitions; education and training services* are identical to *organising, conducting and providing facilities for parties* (and the remainder of the respective services are similar). The consideration of the claims of 1793 will be based on the submission as to which respective services are identical or similar in the second witness statement. 1793 has not put forward in the second witness statement, or on any other occasion, any reasoning for its claim as to the similarity of the services, it has simply made the submission.

26) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of tradeⁱⁱ”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaningⁱⁱⁱ. Consideration should be given as to how the average consumer would view the services^{iv}. The class in which the services are placed may be relevant in determining the nature of the goods^v. In assessing the similarity of services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^{vi}. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* the General Court (GC) explained when goods were complementary:

“82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed^{vii}. Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Services can be considered as identical when the services designated by the earlier trade mark are included in a more general category, designated by the trade mark application^{viii}.

27) It is simply not possible to see how *organising, conducting and providing facilities for parties*, in any context, is identical to *arranging of exhibitions; education and training services*.

28) Within the parameters of the case law, and taking into account the *Avnet* judgment, it is not possible to see how

nightclub services; discotheque services; dance club services; organisation and hosting of musical events; provision of live entertainment and recorded entertainment; music services; promotion of musical events; club entertainment promotion; provision of music facilities; organising, conducting and providing facilities for parties; information, advisory and consultancy services relating to all of the aforesaid services

coincide with *arranging of exhibitions; education and training services* in any meaningful way within the parameters of the case law. **The services of the application rehearsed above are not similar to *arranging of exhibitions; education and training services*.**

29) Exhibitions may be educational or they may be for entertainment or a combination of the two. Consequently, *arranging of exhibitions* will fall within the parameters of *entertainment event promotion, entertainment services* and

provision of entertainment facilities and so the respective services are considered to be identical. The *information, advisory and consultancy services relating to these services* will also fall within the parameters of *arranging of exhibitions* and so the former services are considered identical to the later services. **Consequently, registration of the aforesaid services would be contrary to section 5(1) of the Act.**

30) Exhibitions and education facilities may have catering facilities, this does not mean that *arranging exhibitions or education services* are similar with the latter services, as per the case law. In relation to the provision of such services there could also be janitorial services, security services, window cleaning services, telecommunication services, building services, printing services, retail services etc, etc. A coincidence of possible location and a consumer who could use both services does not equate to a similarity in services. To adopt such an attitude would be to ignore the parameters clearly set out in the case law, it would fly in the face of the *Avnet* judgment. It would also lead to virtually all services being similar, with overlapping consumers and premises. In an airport there is hardly a service that is not provided, this cannot lead to airport services being similar to any service that may be or is provided in an airport. If an undertaking wants protection for non-core services it can apply for registration in relation to them and then, in the normal way, have registrations open for revocation for non-use after five years. If they are “hidden” within other services that do not describe them then a third party cannot remove them for non-use.

31) *Hotel, motel, restaurant, bar, wine bar, cafe; bistro, brasserie and cafeteria services; cocktail bar services; provision of food and drink; provision of temporary accommodation; banqueting and catering services; organisation and provision of facilities (venues) for weddings; information, advisory and consultancy services relating to all of the aforesaid services* are not similar to *arranging of exhibitions; education and training services* in any meaningful way within the parameters of the case law. **The services of the application rehearsed above are not similar to *arranging of exhibitions; education and training services*.**

32) *Organisation and provision of facilities (venues) for conferences, meetings and events* may all be provided in relation to *arranging of exhibitions and education and training services* and so have the same end users. There is no other coincidence within the parameters of the case law; in particular there is no complementarity in the terms of *Boston Scientific Ltd*. **There is a very low degree of similarity between the respective services considered in this paragraph.** The *information, advisory and consultancy services relating to organisation and provision of facilities (venues) for conferences, meetings and events* are inextricably linked to the services to which they relate and so also have a very low degree of similarity to *arranging of exhibitions and education and training services*.

Conclusion in relation to section 5(2)(a) of the Act

33) Likelihood of confusion can only occur where the services are similar. (As the trade marks are identical, if the services are identical, then section 5(1) of the Act applies, the application of which is purely a question of fact.) Consequently, likelihood of confusion can only occur in relation to *organisation and provision of facilities (venues) for conferences, meetings and events and the information, advisory and consultancy services relating to them.*

34) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between services, and vice versa^{ix}. In this case the respective trade marks are identical, so potentially balancing the low degree of similarity between the respective services.

35) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^x. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xi}. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the services for which it has been registered as coming from a particular undertaking, and thus to distinguish those services from those of other undertakings^{xii}. BONHAMS is neither allusive nor descriptive of *arranging of exhibitions and education and training services*. There is no evidence of others, outside the parties in this case, using BONHAMS as a trade mark, indeed “negative evidence” has been filed to indicate that the name is not used by others. It is always difficult, if not impossible, to prove that something is not happening. (The search for the name BONHAMS on the BT website is flawed as no search was made for Bonham, the former being a plural or a possessive form, without the apostrophe, of Bonham. A number of persons will be aware of the surname of Bonham as the deceased drummer of Led Zeppelin, and of his son, who is also a drummer.) 1793 has not established any reputation in relation to its services under consideration here. Taking into account all factors it is considered that BONHAMS enjoys a high degree of inherent distinctiveness in relation to *arranging of exhibitions and education and training services and the information, advisory and consultancy services relating to them.*

36) Owing to the identity of the trade marks and the distinctiveness of the earlier trade mark, despite the low degree of similarity between the respective services, there is a likelihood of confusion in respect of *organisation and provision of facilities (venues) for conferences, meetings and events and the information, advisory and consultancy services relating*

to them and registration in respect of these services would be contrary to section 5(2)(a) of the Act.

Section 5(3) of the Act

37) In *Intel Corporation Inc v CPM United Kingdom Ltd* Case C-252/07 the Court of Justice of the European Union (CJEU) considered Article 4(4)(a) of Directive 2008/95/EC of the European Parliament and the Council of 22 October 2008 (the Directive), which is the basis of section 5(3) of the Act:

“26 Article 4(4)(a) of the Directive establishes, for the benefit of trade marks with a reputation, a wider form of protection than that provided for in Article 4(1). The specific condition of that protection consists of a use of the later mark without due cause which takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark (see, to that effect, in respect of Article 5(2) of the Directive, *Marca Mode*, paragraph 36; *Adidas-Salomon and Adidas Benelux*, paragraph 27, and Case C-102/07 *adidas and adidas Benelux* [2008] ECR I-0000, paragraph 40).

27 The types of injury against which Article 4(4)(a) of the Directive ensures such protection for the benefit of trade marks with a reputation are, first, detriment to the distinctive character of the earlier mark, secondly, detriment to the repute of that mark and, thirdly, unfair advantage taken of the distinctive character or the repute of that mark.

28 Just one of those three types of injury suffices for that provision to apply.

29 As regards, in particular, detriment to the distinctive character of the earlier mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is notably the case when the earlier mark, which used to arouse immediate association with the goods and services for which it is registered, is no longer capable of doing so.

30 The types of injury referred to in Article 4(4)(a) of the Directive, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see, in relation to Article 5(2) of the Directive, *General Motors*, paragraph

23; *Adidas-Salomon and Adidas Benelux*, paragraph 29, and *adidas and adidas Benelux*, paragraph 41).

31 In the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

32 However, the existence of such a link is not sufficient, in itself, to establish that there is one of the types of injury referred to in Article 4(4)(a) of the Directive, which constitute, as was stated in paragraph 26 of this judgment, the specific condition of the protection of trade marks with a reputation laid down by that provision.

37 In order to benefit from the protection introduced by Article 4(4)(a) of the Directive, the proprietor of the earlier mark must adduce proof that the use of the later mark 'would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark'.

38 The proprietor of the earlier trade mark is not required, for that purpose, to demonstrate actual and present injury to its mark for the purposes of Article 4(4)(a) of the Directive. When it is foreseeable that such injury will ensue from the use which the proprietor of the later mark may be led to make of its mark, the proprietor of the earlier mark cannot be required to wait for it actually to occur in order to be able to prohibit that use. The proprietor of the earlier mark must, however, prove that there is a serious risk that such an injury will occur in the future.....

44 As regards the degree of similarity between the conflicting marks, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public. That is particularly the case where those marks are identical.

45 However, the fact that the conflicting marks are identical, and even more so if they are merely similar, is not sufficient for it to be concluded that there is a link between those marks.

46 It is possible that the conflicting marks are registered for goods or services in respect of which the relevant sections of the public do not overlap.

47 The reputation of a trade mark must be assessed in relation to the relevant section of the public as regards the goods or services for which that mark was registered. That may be either the public at large or a more specialised public (see *General Motors*, paragraph 24).

48 It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, although it has a reputation, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.

49 Furthermore, even if the relevant section of the public as regards the goods or services for which the conflicting marks are registered is the same or overlaps to some extent, those goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public.

50 Accordingly, the nature of the goods or services for which the conflicting marks are registered must be taken into consideration for the purposes of assessing whether there is a link between those marks.

51 It must also be pointed out that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered.

52 In such a case, it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered will make a connection between the conflicting marks, even though that public is wholly distinct from the relevant section of the public as regards goods or services for which the earlier mark was registered.

53 For the purposes of assessing where there is a link between the conflicting marks, it may therefore be necessary to take into account the strength of the earlier mark's reputation in order to determine whether that reputation extends beyond the public targeted by that mark.

54 Likewise, the stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind.

55 Accordingly, for the purposes of assessing whether there is a link between the conflicting marks, the degree of the earlier mark's distinctive character must be taken into consideration.

56 In that regard, in so far as the ability of a trade mark to identify the goods or services for which it is registered and used as coming from the proprietor of that mark and, therefore, its distinctive character are all the

stronger if that mark is unique – that is to say, as regards a word mark such as INTEL, if the word of which it consists has not been used by anyone for any goods or services other than by the proprietor of the mark for the goods and services it markets – it must be ascertained whether the earlier mark is unique or essentially unique.

57 Finally, a link between the conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically-linked undertakings (see to that effect, inter alia, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17, and Case C-533/06 *O2 Holdings and O2 (UK)* [2008] ECR I-0000, paragraph 59).

58 However, as is apparent from paragraphs 27 to 31 of the judgment in *Adidas-Salomon and Adidas Benelux*, implementation of the protection introduced by Article 4(4)(a) of the Directive does not require the existence of a likelihood of confusion.

59 The national court asks, in particular, whether the circumstances set out in points (a) to (d) of Question 1 referred for a preliminary ruling are sufficient to establish a link between the conflicting marks.

60 As regards the circumstance referred to in point (d) of that question, the fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark would call the earlier mark to mind is tantamount to the existence of such a link.

61 As regards the circumstances referred to in paragraphs (a) to (c) of that question, as is apparent from paragraph 41 to 58 of this judgment, they do not necessarily imply the existence of a link between the conflicting marks, but they do not exclude one either. It is for the national court to base its analysis on all the facts of the case in the main proceedings.

62 The answer to point (i) of Question 1 and to Question 2 must therefore be that Article 4(4)(a) of the Directive must be interpreted as meaning that whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

63 The fact that for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of

such a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.

64 The fact that:

- the earlier mark has a huge reputation for certain specific types of goods or services, and
- those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
- the earlier mark is unique in respect of any goods or services,

does not necessarily imply that there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.”

38) 1793 has a reputation in respect of:

auction services; auctioneering services; auction advice and consultancy services; valuation services;

appraisal services for others for fine furniture, fine and decorative art, jewellery, stamps, coins, books and other valuable property.

39) In the second witness statement of Mr Jennings, he states that “[i]n particular the Opponent is worried that an association with a casino or private members club is likely to prove highly detrimental to its reputation”. These services had been deleted from the specification of the application 16 months prior to his signing of the witness statement.

40) In considering whether a link would be created it is taken into account that 1793’s trade mark is distinctive, that there is no use of other BONHAMS trade marks, outside of that of G1, and the respective trade marks are identical. This is not a case where the respective publics are in isolated, discrete groups (see paragraph 37 sub-paragraph 48 above). However, this is a case where the services of the application are highly dissimilar (despite the claims of 1793 in relation to its “events”). Owing to the distance between the services for which 1793 has a reputation and the services of the application, the use of G1’s trade mark is unlikely to bring 1793’s use of the trade mark to mind. There is simply no natural connection between, eg, discotheque and motel services and the services for which 1793 has a reputation and no reason that the relevant public for the services of G1 should bring to mind the use of 1793 of its trade mark. **In the absence of the establishment of a link the grounds of opposition under section 5(3) of the Act are dismissed.**

41) Even if a bringing to mind took place and a link was established this would not of itself establish unfair advantage or detriment to the distinctive character or the repute of the earlier trade mark.

42) In *L’Oreal SA and others v Bellure NV and others* the CJEU defined what is meant by unfair advantage:

“41 As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.

50 In the light of the above, the answer to the fifth question is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark’s image.”

1793 has to establish that there would be an advantage and that it would be unfair. It is to be noted that the CJEU refers to the third party seeking to take advantage, ie a conscious decision being made. The question of the unfair aspect was considered by Lloyd LJ in *Whirlpool Corporations and others v Kenwood Limited* [2009] EWCA Civ 753^{xiii}:

“136. I do not consider that Kenwood's design involves anything like a transfer of the image of the KitchenAid mark, or of the characteristics which it projects, to the goods identified by Kenwood's sign (see *L’Oréal v Bellure* paragraph 41). Of course, as a newcomer in a specialist market of which KitchenAid had a monopoly, and being (necessarily) in the basic C-shape of a stand mixer, the kMix would remind relevant average consumers, who are design-aware, of the KitchenAid Artisan. That, however, is a very different phenomenon, in very different commercial circumstances, from the situation considered in *L’Oréal v Bellure*. I find the

Court's judgment instructive, but it does not seem to me to lead to the conclusion in favour of Whirlpool for which Mr Mellor contends. On the contrary, having rejected his radical submission that the word "unfair" could just as well have been left out of the article, it seems to me that the decision points away from, rather than towards, liability under the article on the facts of the present case. It is not sufficient to show (even if Whirlpool could) that Kenwood has obtained an advantage. There must be an added factor of some kind for that advantage to be categorised as unfair. It may be that, in a case in which advantage can be proved, the unfairness of that advantage can be demonstrated by something other than intention, which was what was shown in *L'Oréal v Bellure*. No additional factor has been identified in this case other than intention."

This matter was also considered by Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch):

"160. Thus something more than mere advantage is required. It must be an unfair advantage. Lloyd LJ seems to state that an advantage is rendered unfair if it is intended. He also leaves open the possibility that unintended advantage may have a sufficient quality of unfairness about it to qualify."

(Also see *Datacard Corporation v Eagle Technologies Limited* [2011] EWHC 244 (Pat) at paragraphs 294 and 295.) There is no evidence that G1 sought to take advantage of the reputation of 1793, it is also difficult to see, taking into account the nature of the services of the application, what advantage would gain from 1793's reputation in relation to auction house services.

43) According to the CJEU "the proprietor of the earlier mark must adduce proof that the use of the later mark 'would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark'." There is an absence of clear evidence as to the nature and extent of use of the trade mark by G1 at the material date, so effectively this is a *quia timet* action. (Even if the use in relation to the name of a public house were taken into account, this would not effect the vast majority of the specification.) In such circumstances it is unlikely to be possible to adduce proof of the detriment. In *Mäurer + Wirtz GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-63/07 the GC stated

"40 It is possible, particularly in the case of an opposition based on a mark with an exceptionally high reputation, that the probability of a future, non-hypothetical risk of detriment to the earlier mark or of unfair advantage being taken of it by the mark applied for is so obvious that the opposing party does not need to put forward and prove any other fact to that end. However, it is also possible that the mark applied for does not, at first sight, appear capable of giving rise to one of the risks covered by Article

8(5) of Regulation No 40/94 with respect to the earlier mark with a reputation, even though it is identical with or similar to the earlier mark, in which case the non-hypothetical, future risk of detriment or unfair advantage must be established by other evidence, which it is for the opposing party to put forward and prove (Case T-215/03 *Sigla v OHIM – Elleni Holding (VIPS)* [2007] ECR II-711, paragraph 48).”

The risk must be more than purely hypothetical. Owing to the completely different spheres of activity for which 1793 has a reputation and the services of the application, in the absence of any evidence to support the claim of detriment, there is no prima facie case that there would be detriment. It is not something that can be inferred from the facts presented. The claim in relation to detriment to the distinctive character or repute of 1793’s trade mark, as far as it relates to dilution, is dismissed.

44) In *L’Oreal SA and others v Bellure NV and others* Case C-487/07 the CJEU considered tarnishment:

“40 As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.”

There is nothing inherent in the services of the application that would give rise to tarnishing, whether considered on their own or considered in relation to the services for which 1793 has a reputation and the nature of that reputation. The services to which 1793 specifically referred in its second witness statement had also been removed 16 months prior to the signing of the witness statement.

Section 5(4)(a) of the Act – passing-off

45) In *Harrods v Harrodian School* [1996] RPC 697 Millett LJ stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services”

In the same case he went on to state:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

and

“The name "Harrods" may be universally recognised, but the business with which it is associated in the minds of the public is not all embracing. To be known to everyone is not to be known for everything.”

In *Stringfellow v McCain Foods (G.B.) Ltd.* [1984] RPC 501 Slade L.J. said:

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.”

Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 said that the claimant must prove:

“That he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill attaches.”

46) In *Lego Systems A/S v Lego M Lemelstricht Ltd* [1983] FSR 155 an absence of a common field of activity was overcome by evidence specifically aimed to this point. In this case there is no evidence to show that the distance between the services for which 1793 has a goodwill and the services of G1's application has been overcome so that the public concerned would believe that 1793 was responsible for the services of the application or believe that there would be some relationship between the parties. (The issue of dilution has already been considered within the context of section 5(3) of the Act.)

47) Owing to the distance between the fields of activity, use of the trade marks of G1 would give rise to neither a misrepresentation nor to any possible damage.

48) The grounds of opposition under section 5(4)(a) of the Act are dismissed.

Overall outcome

49) 1793 has failed in relation to the grounds of opposition under sections 5(3) and 5(4)(a) of the Act. Under section 5(1) of the Act it has succeeded in relation to *entertainment event promotion, entertainment services and provision of*

entertainment facilities and the information, advisory and consultancy services relating to them.. Under section 5(2)(a) of the Act it has succeeded in relation to organisation and provision of facilities (venues) for conferences, meetings and events and the information, advisory and consultancy services relating to them. This leaves a specification of:

nightclub services; discotheque services; dance club services; organisation and hosting of musical events; provision of live entertainment and recorded entertainment; music services; promotion of musical events; club entertainment promotion; provision of music facilities; organising, conducting and providing facilities for parties; information, advisory and consultancy services relating to all of the aforesaid services;

hotel, motel, restaurant, bar, wine bar, cafe; bistro, brasserie and cafeteria services; cocktail bar services; provision of food and drink; provision of temporary accommodation; banqueting and catering services; organisation and provision of facilities (venues) for weddings; information, advisory and consultancy services relating to all of the aforesaid services.

Costs

50) G1, having been for the most part successful, is entitled to a contribution towards its costs. In its written submissions G1 requests that the lack of clarity and particularisation in the notice of opposition should be taken into account in the award of costs. There has been a lack of specificity and detail in the pleadings and the arguments of 1793. No cognisance appears, from the contents of the second witness statement, to have been taken of the amendment of the specification of the application. Claims were made to a reputation in respect of all of the goods and services of the earlier registration, claims were made that all of the goods and services of the earlier registration were similar or identical to the services of the application. In relation to the similarity of goods and services there has been assertion but no argument within the parameters of the case law. Equally in relation to sections 5(3) and 5(4)(a) of the Act there has been assertion but neither specific evidence nor argument within the parameters of the case law. However, it is difficult to see how this has put G1 to any greater cost. The evidence has not been clearly focused on the issues in this case; lots of it is repetitive, parts of it are not relevant to the proceedings as they emanate from after the material date and/or from outside the jurisdiction. However, the evidence should not have put G1 to any great trouble. Consequently, it is not considered appropriate to diverge from the scale. Costs are awarded on the following basis:

Preparing a statement and considering 1793's statement:	£400
Considering evidence of 1793	£300
Written submissions	£250
 Total	 £950

Bonhams 1793 Limited is to pay G1 Group plc the sum of £950. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24 day of February 2011

**David Landau
For the Registrar
the Comptroller-General**

ⁱ *General Motors Corporation v Yplon SA* Case C-375/97.

ⁱⁱ *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

ⁱⁱⁱ *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^{iv} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

^v *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^{vi} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^{vii} He considered that the following should be taken into account when assessing the similarity of goods and/or services:

(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.”

^{viii} See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05 paragraph 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

^{ix} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

^x *Sabel BV v Puma AG* Case C-251/95.

^{xi} *Rewe Zentral AG v OHIM (LITE)* Case T-79/00.

^{xii} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97.

^{xiii} The full judgment can be found at the url:

<http://www.bailii.org/ew/cases/EWCA/Civ/2009/753.html>