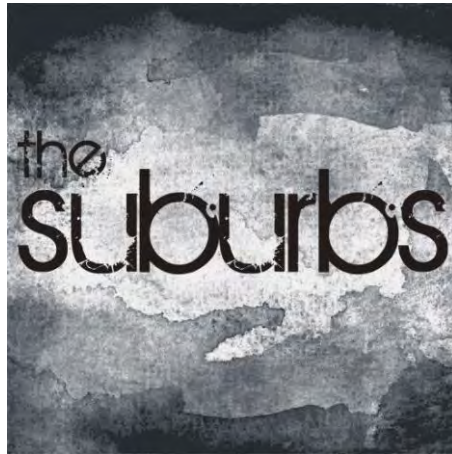


O-016-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3030953  
BY SUBURBAN COCKTAILS LIMITED  
TO REGISTER  
THE TRADE MARK:



IN CLASS 43

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 401857 BY  
THE ALCHEMIST BAR & RESTAURANT LIMITED

## BACKGROUND

1. On 17 November 2013, Suburban Cocktails Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 13 December 2013, for the following services in class 43:

Banqueting services; Bar services; Bars; Bistro services; Brasserie services; Cafe services; Cafés; Cafeteria services; Cafeterias; Canteen services; Canteens; Catering (Food and drink -);Catering for the provision of food and beverages; Catering of food and drinks; Catering services; Catering services for the provision of food; Catering services for the provision of food and drink; Club services for the provision of food and drink; Cocktail lounge services; Coffee shop services; Coffee shops; Consultancy services relating to food; Consultancy services relating to food preparation; Fast food restaurant services; Fast-food restaurants; Food cooking services; Food preparation; Food preparation services; food takeaway service; Guest houses; Guesthouse; Hospitality services [accommodation];Hospitality services [food and drink];Hotel catering services; Hotel information; Hotel reservation services; Hotel reservations; Hotel room booking services; Hotel room reservation services; Hotel-reservation; Lounge services (cocktail-);Mobile catering services; Night club services [provision of food];Provision of food and drink; Provision of food and drink in restaurants; Provision of information relating to bars; Provision of information relating to hotels; Provision of information relating to restaurants; Provision of information relating to the booking of accommodation; Provision of information relating to the preparation of food and drink; Public house services; Pubs; Rental of glassware; Restaurant information services; Restaurant reservation services; Restaurant services; Restaurants; Restaurants (self-service-);Restaurants (Self-service -); Self-service cafeteria services; Self-service restaurants; Services for providing food and drink; Wine bars.

2. Although the application was originally opposed by New World Bar Company Limited, as this company subsequently changed its name to The Alchemist Bar & Restaurant Limited, it is this company I will refer to as the “opponent”. The opponent relies upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Its opposition, which is directed against all of the services in the application, is based upon all of the services (shown below) in UK trade mark registration no. 2523692 for the trade mark: **SUBURBIA** which was applied for on 13 August 2009 and the registration procedure for which was completed on 18 December 2009:

**Class 41**- Entertainment services; live and musical entertainment services; advisory, consultancy and information services relating to all the aforesaid.

**Class 43** - Restaurant services; restaurant services incorporating licensed bar facilities; hotel restaurant services; bar and accommodation services; services for providing food and drink; catering services; temporary accommodation;

restaurant reservation services; provision of information relating to restaurants; self-service restaurants; restaurant services for the provision of fast food; grill restaurants; carvery restaurant services; nightclub and discotheque services; advisory, consultancy and information services relating to all the aforesaid.

In its Notice of opposition, the opponent states:

“5. The distinctive and dominant component of the opponent’s earlier mark is the element “SUBURB-“, which is of greatest significance as it is the first part of the mark. It is the element that consumers will see, speak and hear first...

6. The element “the” of the mark applied for is shown above the “suburbs” element, and in a notably smaller font. For these reasons its importance in the trade mark is diminished, and the element of the mark which has the most impact is “SUBURB-“. Accordingly, the distinctive and dominant components of the respective marks are visually and phonetically identical.

7. The average consumer tends to place greater emphasis on words rather than device elements. The device element of the mark applied for does not distinguish the trade mark from the earlier mark, and the average consumer would not see the device element as having any trade mark significance. The mark applied for would be seen and referred to as “THE SUBURBS”.

8...Suburbia and the suburbs are terms which are interchangeable. The distinctive and dominant elements of the respective marks are therefore conceptually identical.

9...The services covered by the mark applied for are identical or alternatively highly similar to the services in Classes 41 and 43 covered by the opponent’s earlier mark.

11. The services in question include bar and restaurant services. On visiting premises at which these services are supplied, the customer is unlikely to be able to have the chance to make a direct comparison between the marks.”

3. The applicant filed a counterstatement in which the ground of opposition is denied. The applicant states:

“3. It is accepted that the services provided by the applicant in respect of their trade mark are similar to those provided by the opponent in respect of their earlier trade mark.

4. The two trade marks do not look similar. The opponent’s trade mark is a simple word, whilst the applicant’s trade mark is a distinctive logo used on the sign and other branding of the applicant’s one current bar, named “The Suburbs”,

in Chester. Should the applicant open other bars, the same branding would be used to create a distinctive brand.

6...The patrons of the opponent's bars will be aware enough to realise that if they set foot in a bar with the applicant's distinctive branding, there is no connection between the two.

7. The applicant's trade mark is for a bar known to its patrons as "The Suburbs". It is not known as merely "Suburbs". The size of the element "the" is merely for the purposes of the logo design.

8. The opponent's mark is not one that has a "*distinctive character*". It is averred that the public would not instantly think of the opponent's bars when seeing "SUBURBIA".

9. The applicant's trade mark has a distinctive device element that is a key component of its brand. The close proximity of the letters in the logo are distinctive and remove the likelihood of confusion.

10. It is averred that while "the suburbs" is a common phrase used in everyday conversation, "suburbia" is a more technical word that the public will not use as often. The difference in usage means the public will immediately note that the two trade marks are different.

11. The applicant's bar has a distinctive style and is well known in its local area for this. Patrons are aware of its style and the applicant would seek to replicate this style in potential future bar openings. The opponent has provided no evidence of the style of its premises.

15. Further to the above, the opponent has not provided any evidence of confusion amongst the public. It is averred that there has been no confusion and there is little scope for future confusion."

4. Only the opponent filed evidence. Although neither party asked to be heard, the opponent filed written submissions in lieu of attendance at a hearing; I will refer to these submissions, as necessary, below.

### **The opponent's evidence**

5. This consists of a witness statement, dated 26 August 2014, from Dr Duncan Curley; Dr Curley has conducted these proceedings at the opponent's professional representatives, Innovatelegal. Exhibits DC1 and DC2 consist of pages downloaded from the opponent's and applicant's websites on 31 July 2014 (i.e. after the date of the application for registration) showing how the parties use their respective trade marks. Exhibit DC3 consists of a Google® search conducted on 31 July 2014 for the word "suburbia". Dr Curley notes that the search returned 4,160,000 hits which, in his view,

contradict the applicant's submission to the effect that "suburbia is a more technical word that the public will not use as often." Exhibit DC4 consists of an extract obtained from the online version of the Oxford Dictionaries on 31 July 2014 in relation to the word "suburbia". Dr Curley points to the following entry:

"The suburbs or their inhabitants viewed collectively",  
concluding that "the terms SUBURBIA and THE SUBURBS are interchangeable."

## **DECISION**

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

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

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

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

7. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

8. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not been registered for more than five years when the application was published, it is not subject to the proof of use provisions as per section 6A of the Act. As a consequence, the opponent is entitled to rely upon all of the services for which it is registered.

## Section 5(2)(b) – case law

9. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### Comparison of services

10. The competing services are:

<b>Opponent's services</b>	<b>Applicant's services</b>
<p><b>Class 41-</b> Entertainment services; live and musical entertainment services; advisory, consultancy and information services relating to all the aforesaid.</p> <p><b>Class 43 -</b> Restaurant services; restaurant services incorporating licensed bar facilities; hotel restaurant services; bar and accommodation services; services for providing food and drink; catering services; temporary accommodation; restaurant reservation services; provision of information relating to restaurants; self-service restaurants; restaurant services for the provision of fast food; grill restaurants; carvery restaurant services; nightclub and discotheque services; advisory, consultancy and information services relating to all the aforesaid.</p>	<p><b>Class 43 -</b> Banqueting services; Bar services; Bars; Bistro services; Brasserie services; Cafe services; Cafés; Cafeteria services; Cafeterias; Canteen services; Canteens; Catering (Food and drink - );Catering for the provision of food and beverages; Catering of food and drinks; Catering services; Catering services for the provision of food; Catering services for the provision of food and drink; Club services for the provision of food and drink; Cocktail lounge services; Coffee shop services; Coffee shops; Consultancy services relating to food; Consultancy services relating to food preparation; Fast food restaurant services; Fast-food restaurants; Food cooking services; Food preparation; Food preparation services; food takeaway service; Guest houses; Guesthouse; Hospitality services [accommodation];Hospitality services [food and drink];Hotel catering services; Hotel information; Hotel reservation services; Hotel reservations; Hotel room booking services; Hotel room reservation services; Hotel-reservation; Lounge services (cocktail-);Mobile catering services; Night club services [provision of food];Provision of food and drink; Provision of food and drink in restaurants; Provision of information relating to bars; Provision of</p>

	<p>information relating to hotels; Provision of information relating to restaurants; Provision of information relating to the booking of accommodation; Provision of information relating to the preparation of food and drink; Public house services; Pubs; Rental of glassware; Restaurant information services; Restaurant reservation services; Restaurant services; Restaurants; Restaurants (self-service-); Restaurants (Self-service -); Self-service cafeteria services; Self-service restaurants; Services for providing food and drink; Wine bars.</p>
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In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

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

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“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.”



In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) case T-133/05, the General Court (GC) stated:

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

11. I begin by reminding myself that in its counterstatement, the applicant stated:

“3. It is accepted that the services provided by the applicant in respect of their trade mark are similar to those provided by the opponent in respect of their earlier trade mark.”

12. Many of the terms included in the applicant’s specification find exact counterparts in the opponent’s specification in class 43; where that is the case, the competing services are literally identical. However, even where that is not the case, the opponent’s specification in class 43 includes a range of broad terms such as: “restaurant services”, “bar and accommodation services”, “services for providing food and drink”, “catering services” “temporary accommodation” “provision of information relating to restaurants” and “consultancy and information services relating to all the aforesaid”. As one or more of those broad terms will encompass all of the applicant’s services, the services in the applicant’s specification which are not literally identical, are to be regarded as identical on the principles outlined in *Merici*.

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

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

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average”

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


14. The average consumer of the services in class 43 is a member of the general public. As such services are most likely to be selected following a visual inspection of, for example, signage on the high street or from the pages of a magazine or website, visual considerations are likely to dominate the selection process. That said, as, for example, bars, restaurants, hotels etc, are often the subject of oral recommendations, I must also keep aural considerations in mind. The degree of care taken selecting the services at issue is likely to vary considerably. For example, whilst the average consumer is, in my experience, likely to pay a relatively low degree of attention to the selection of a café for an impromptu cup of coffee, they are likely to pay a somewhat higher degree of attention to, for example, the selection of a hotel for a short stay, and an even higher level of attention to the selection of, for example, a venue to host a wedding; I will return to this point when I consider the likelihood of confusion.

**Comparison of trade marks**

15. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

16. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks. The trade marks to be compared are as follows:

Opponent’s trade mark	Applicant’s trade mark
SUBURBIA	

17. The opponent argues that the distinctive and dominant element of its trade mark is the element SUBURB-. However, as its trade mark consists exclusively of a single word presented in upper case (i.e. in which no part of the word is highlighted or emphasised in any way), there are, in my view, no distinctive and dominant components. The overall impression the opponent's trade mark will convey to the average consumer will result from the word as a whole.

18. As to the applicant's trade mark, this consists of the words "the" and "suburbs" both presented in lower case. Although the word "the" appears as the first word in the trade mark, it is in a much smaller font than the word "suburbs" which accompanies it (although the opponent accepts that the applicant's trade mark will "be seen and referred to as THE SUBURBS"). The trade mark also contains a device element (reminiscent of clouds in a stormy sky) against which the words "the suburbs" are set. The applicant argues that this device element is a "key component of its brand" whereas the opponent suggests that the "average consumer would not see the device element as having any trade mark significance." Whilst the device element occupies a significant proportion of the applicant's trade mark, in my view, its positioning as a background leads to it performing very much a supporting role to the words which accompany it; words which are, in my view, likely to play a much more decisive role in the overall impression the applicant's trade mark conveys to the average consumer.

19. Having reached those conclusions, the presence in the competing trade marks of an element which contains the same six letters in the same order and differs only in their respective endings i.e. "IA" as opposed to "s", whilst not forgetting the presence of the word "the" and the background device in the applicant's trade mark, still results, in my view, in a fairly high degree of visual similarity between them. Insofar as the degree of aural similarity is concerned, as the opponent points out, it is well established that when a trade mark consists of a combination of words and figurative elements, it is, most likely, by the word element that the average consumer will refer to the trade mark. As the competing trade marks will, in my view, be articulated as SUBURBIA and the suburbs, respectively, the degree of aural similarity between them is obvious and is, in my view, high. As to the conceptual similarity, the opponent has filed evidence to show the relationship between the words Suburbia and Suburbs; a state of affairs I would have been prepared to accept on the basis of judicial notice. The competing trade marks are, if not conceptually identical, conceptually similar to the highest degree.

### **Distinctive character of the opponent's earlier trade mark**

20. 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 – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade 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 trade 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 - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. Although the opponent has filed evidence showing how it uses its trade mark (exhibit DC1 refers), as it has not provided any evidence of, for example, when it began using its trade mark, the extent to which it has been used and promoted or the actual services upon which it has been used, I have only the inherent characteristics of its trade mark to consider. Although in its submissions, the applicant states that the opponent's trade mark "is not one that has a distinctive character", it has filed no evidence or submissions to explain why it considers that to be case. In view of the comments of the CJEU in Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*, it is clear that it is not permissible for me to regard the opponent's earlier trade mark as having no distinctive character. However, irrespective of the court's decision in the case mentioned above, when considered in the context of the services at issue in these proceedings, I can see no reason why the earlier trade mark upon which the opponent relies is not capable of distinguishing its services from those of other undertakings; it is, in my view, a trade mark possessed of a normal degree of inherent distinctive character.

### **Likelihood of confusion**

21. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the competing services are identical;
- the average consumer is a member of the general public who, whilst selecting the services by predominantly visual means, is also likely, albeit to a lesser extent, to rely upon oral recommendations in relation to some of the services at issue;
- the degree of attention paid to the selection of the services will, depending on the service being selected, vary considerably;
- the competing trade marks are visually similar to a fairly high degree, aurally similar to a high degree and if not conceptually identical, are conceptually similar to the highest degree;

- the opponent's earlier trade mark is possessed of a normal degree of inherent distinctive character.

22. Applying my findings to the matter at hand, I remind myself that the degree of care taken during the selection process is likely to vary. However, I have no hesitation in concluding that even in circumstances where the average consumer exercises a high degree of care, the degree of visual, aural and conceptual similarity I have identified above will, when combined with the fact that identical services are involved, lead to, at the very least, indirect confusion i.e. where the average consumer notices the differences in the competing trade marks, but nonetheless assumes the applicant's services come from an undertaking economically linked to the opponent. I say at least, because in my view, it is equally likely that there will be direct confusion i.e. the average consumer will mistakenly assume that the applicant's trade mark is that of the opponent. As a consequence of the above conclusions, the opposition succeeds in full.

23. In reaching the above conclusion, I have not overlooked the applicant's comments regarding the distinctive style of its premises or that the opponent has not provided any evidence of confusion. In relation to the former, in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated:

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

In relation to the latter, in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J held:

“22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged

infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

In *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch) Warren J commented:

"99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says..."

And in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

24. For the reasons given above, neither of these points assists the applicant. Finally, although it appears that as at July 2014 the applicant was conducting a trade under the words "the suburbs" (exhibit DC2 refers), as the opponent has not provided any evidence (of the type mentioned earlier) of the use it has made of its trade mark, any evidence the applicant may have provided of its use prior to the date of its application, would not have assisted it in any case.

## **Conclusion**

**25. The opposition succeeds and, subject to any successful appeal, the application will be refused.**

## **Costs**

26. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, but bearing in mind that the opponent's evidence has played very little part in these proceedings and its written submissions were just a rehashing of comments contained in its Notice of Opposition, I award costs to the opponent on the following basis:

Preparing a statement and considering  
the applicant's statement: £200

Opposition fee: £100

**Total: £300**

27. I order Suburban Cocktails Limited to pay to The Alchemist Bar & Restaurant Limited the sum of **£300**. 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 13th day of January 2015**

**C J BOWEN  
For the Registrar  
The Comptroller-General**