

O-282-17

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 3053737
IN THE NAME OF MARQUEE ENTERTAINMENT LTD
IN RESPECT OF THE TRADE MARK:**

MARQUEE

AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO 501281 BY ROOF DECK ENTERTAINMENT LLC**

Background and pleadings

1. The trade mark **MARQUEE** is registered under no. 3053737. It stands registered in the name of Marquee Entertainment Ltd (“the proprietor”). It was applied for on 30 April 2014 and entered in the register on 6 March 2015. Although it is registered for a range of goods and services in classes 9, 16, 18, 25, 41 and 43, these proceedings only concern the services in classes 41 and 43 (shown in paragraph 9 below).

2. On 1 August 2016, Roof Deck Entertainment LLC (“the applicant”) filed an application to have this trade mark declared partially invalid under the provisions of sections 47(2)(a) and sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The relevant provisions read as follows:

“47(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b)...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if—

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes—

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered,

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

.....

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

And:

“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)...

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

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.”

3. The applicant relies upon all the services (shown in paragraph 9 below), in the following European Union Trade Mark registration (“EUTM”): No. 10100055 for the trade mark **MARQUEE** which was applied for on 5 July 2011 and entered in the register on 17 May 2012.

4. The trade mark shown above 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 for invalidation was filed, it is not subject to proof of use, as per section 47(2)(2A) of the Act. As a consequence, the applicant is entitled to rely upon all of the services it claims.

5. On 4 October 2016, the proprietor filed a counterstatement in which the basis of the application is denied. As these are the only comments I have from the proprietor, they are reproduced below in full:

“The [proprietor] denied the claims made in the invalidation action that the mark is identical with the earlier mark cited in the action and cover identical goods and services and furthermore denies that it is identical and covers similar goods and services.

Furthermore the [proprietor] contends that the applicant for invalidity is not the rightful proprietor of the MARQUEE trade mark and will be seeking to invalidate the [EUTM] upon which the application for invalidity has been based.”

6. A review of the European Union Intellectual Property Office’s database prior to issuing this decision, indicates that the earlier trade mark upon which the applicant relies is not subject to any cancellation actions.

7. Although neither party filed evidence, the applicant filed written submissions during the course of the evidence rounds. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing.

DECISION

Comparison of trade marks

8. Both parties' trade marks consist of the word MARQUEE presented in block capital letters. Notwithstanding the proprietor's comments to the contrary, they are, self-evidently, identical.

Comparison of services

9. The competing services are as follows:

Applicant's services	Proprietor's services
<p>Class 41 - Nightclub, beach club, entertainment services including parties, special events, dance and music events but not including such services provided in, or in connection with tents.</p> <p>Class 43 - Restaurant, bar services and cocktail lounge but not including any such services provided in, or in connection with tents.</p>	<p>Class 41 - Recording studio services; nightclub services; production of films, television programmes, audio, video and cinematographic recordings; music publishing services; music club services; indoor music venues and indoor concert venues; publication of texts; training services; sporting activities; information, advice and consultancy in relation to the aforementioned.</p> <p>Class 43 - Restaurant services; public house services.</p>

10. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

11. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

12. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated:

“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.”

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

“... 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.”

14. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. 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.”

15. 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 Vedral 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).”

16. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...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”.

17. In its submissions, the applicant argues that some of the competing services are to be regarded as identical; either literally, or on the principles outlined in *Meric*. It does, however, appear to accept that not all of the proprietor’s services are identical to the services upon which it relies. Where I consider it necessary, I have reproduced its submissions in this regard below.

18. In approaching the comparison, I must, as the case law dictates, give the words in the competing specifications their natural meanings in the context in which they appear. I must not give them an overly liberal interpretation nor should I strain the words in the competing specifications unnaturally to produce an overly narrow meaning. As the comparison is between competing services, I must also keep firmly in mind the comments in *Avnet* shown above.

Class 41

19. In its submissions, the applicant states:

“9(b) The applicant’s “entertainment services” is a broad term that encompasses a variety of services in class 41. This includes the proprietor’s “nightclub services; music club services; indoor music venues and indoor concert venues; sporting activities. These services are all provided for the entertainment and enjoyment of customers.”

20. I begin by noting that the applicant’s specifications in both classes includes the following exclusion: “...but not including (any) such services provided in, or in connection with tents.” Given the well-known meaning of the word “MARQUEE” i.e. “a large tent which is used at a fair, garden party, or other outdoor event, usually for eating and drinking in” (collinsdictionary.com refers), this exclusion was, I assume, adopted as a means of overcoming an objection based upon a lack of distinctiveness. However, as it is permissible for the applicant’s services to be provided in, or in connection with anything but tents and as the proprietor’s specification is unlimited, the exclusion has no bearing upon the conclusions that follow.

21. “Nightclub services” appears in both parties’ specifications; it is literally identical.

22. The wording of the applicant’s specification in class 41 is, in my view, ambiguous. The applicant’s submission is that the term “entertainment services” is unlimited. Whilst I understand that submission, I am not certain it is correct. In my view, the more natural reading of its specification in class 41 is of an undertaking seeking protection for entertainment services in the nature of nightclubs and beach clubs which “include” (a word which has no limiting effect) “parties, special events and dance and music events”. If the applicant’s interpretation is correct, I agree that the term “entertainment services” is broad enough to include, inter alia, “music club services”, “indoor music venues and indoor concert venues” and “sporting activities”,

and such services are, as a consequence, to be regarded as identical on the principle outlined in *Meric*.

23. However, does the position change if the applicant's specification is approached in the manner I suggest? In my view, it does not. I reach that conclusion, because "music club services" and "indoor music venues and indoor concert venues" are no more than venues at which music (live or recorded) is played/performed (as is a nightclub i.e. a term that appears in the applicant's specification); such services are identical on the *Meric* principle. As "sporting activities" (in the proprietor's specification) may, for example, be provided as part of a "beach club" entertainment service, they too are to be regarded as identical on the principle outlined in *Meric*.

Information, advice and consultancy in relation to the aforementioned

24. Although the applicant does not comment upon these services, as they specifically relate to the services mentioned above (which I have already found to be identical), they too, in my view, are to be regarded as identical. However, even if not strictly identical, as it is both obvious and well-known that traders in all fields provide information and advice in relation to, for example, the services which they provide, such services are clearly highly similar to the services to which they relate.

25. In its submissions, the applicant states:

"11(b) The applicant's "Nightclub, beach club, entertainment services" and "entertainment services" in particular, are similar to all the of the proprietor's services in class 41.

(c) "Recording studio services" are provided within the broader entertainment sector; a service allowing musicians and other performers to record music and other sounds for the purpose of entertaining the recording artists themselves or providing entertainment to the wider public via the end product produced by that service (i.e. a television programme or recorded music). "Recording

studio services” clearly fall within or are at least complementary or similar in nature to “entertainment services”:

(d)...It is clear that most consumers will perceive a close connection between the applicant’s general entertainment services and the proprietors recording studio services to the extent that they will be led to believe that the same undertaking is responsible for the provision of these services. Therefore, the services covered by the [competing trade marks] show a high degree of similarity.

(e) “production of films, television programmes, audio, video and cinematographic recordings; music publishing services” are also similar to “entertainment services”. These services are provided to customers for the purposes of the creation and dissemination of entertainment goods and services, such as, recorded music and television programmes.

(g) “publication of texts” is at the very least similar to “entertainment services” since it covers the publication of newspapers, books, magazines and other media which are produced to entertain their readers.

(i) “training services” is a broad term that encompasses a variety of services in class 41. For example, “training services” can relate to, amongst other things, hosting and taking part in sporting and music events, and workshops such as cookery classes. Customers attend or take part in these events and workshops for both entertainment purposes and to learn new skills. “training services” is, at the very least, complementary and similar in nature to “entertainment services.”

26. In relation to those services which the applicant appears to accept are not identical, it bases its submissions on the premise that, inter alia, the term “entertainment services” in its specification is unlimited. Although I have expressed my reservations about the correctness of this interpretation, I shall conduct the comparison on the basis the applicant suggests. If the applicant is unable to succeed

on the basis of this broad interpretation, it will be in no better position if I were also to consider the matter on the basis of the narrower construction I mentioned earlier. In comparing services one is, as *Avnet*, explains, looking to determine what is, “the core of the possible meanings attributable to the rather general phrase.”

Recording studio services, production of films, television programmes, audio, video and cinematographic recordings and music publishing services

27. “Entertainment services” will give the average consumer pleasure. Although the result of all of the above services may ultimately give the average consumer pleasure, that is not, in my view, the “core” meaning of these services. Rather, the core meaning of all of the above services relates, in my view, to the technical process which results in the various content being produced or made available. The average consumer of “entertainment services” is a member of the general public, whereas the average consumer of all the above services is, as the applicant suggests, “specialists in these fields” (paragraph 15 refers). The nature, method of use and, in any meaningful sense, the intended purpose of these services are different to “entertainment services”. There is no competitive relationship between the services nor, in my view, are the services complementary in the sense envisaged in the case law. The above listed services are not, in my view, similar to the services upon which the applicant relies.

Publication of texts

28. Many of my comments above also apply here. While the product of these services may entertain, that is not their core meaning. “Publication of texts” is a publishing service not an “entertainment service”. The users are likely to be different as is the nature of the services, their method of use and intended purpose. As above, there is also no competitive or complementary relationship between the competing services. The above listed services are not, in my view, similar to the services upon which the applicant relies.

Training services

29. Although the users of the competing services may be the same and while I accept that one may be entertained whilst being trained, as above, the core meanings of the competing services is, in my view, different. They are neither competitive nor (as the applicant suggests) complementary (at least in the sense outlined in the case law). The above listed services are not, in my view, similar to the services upon which the applicant relies.

Information, advice and consultancy in relation to the aforementioned.

30. As above, the applicant does not comment upon these services. However, as they specifically relate to the services which I have already found not to be similar, by parity of reasoning they too are also to be regarded as not similar.

Class 43

31. “Restaurant services” appears in both parties’ specifications and is literally identical. In relation to the proprietor’s “public house services”, the applicant submits that these services are identical. It states:

“9(d)...A bar is simply a retail business establishment that serves alcoholic beverages. A bar is often referred to as a “pub”, which is the shortened form of the term “public house”, and vice versa.”

32. In my view, the terms “public house” and “bar” are synonyms; the services are, as a consequence, identical.

The proprietor’s services which are not similar to those of the applicant

33. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

34. Even though the competing trade marks are identical, when there is no similarity in the competing services, there can be no likelihood of confusion. Having concluded that the services shown below are not similar to any of the applicant's services, the application for cancellation fails and is dismissed accordingly:

Class 41 - Recording studio services; production of films, television programmes, audio, video and cinematographic recordings; music publishing services; publication of texts; training services; information, advice and consultancy in relation to the aforementioned.

Conclusions under Section 5(1) and 5(2)(a)

35. In order to succeed under section 5(1) of the Act, the trade marks and services must be identical. Earlier in this decision I concluded that the competing trade marks were literally identical and that the services shown below are identical (either literally or on the *Meric* principle) to services in the applicant's specification:

Class 41 - Nightclub services; music club services; indoor music venues and indoor concert venues; sporting activities; information, advice and consultancy in relation to the aforementioned.

Class 43 - Restaurant services; public house services.

36. The application based opposition upon section 5(1) of the Act succeeds in relation to these services.

37. However, even if I wrong and the proprietor's "information, advice and consultancy in relation to the aforementioned services" in class 41 is not to be regarded as identical, it is, in my view, highly similar to the services to which it relates. In those circumstances, I have no hesitation concluding that there is a likelihood of confusion in relation to such services and the opposition based upon section 5(2)(a) of the Act succeeds in relation to these services. In reaching this conclusion, I have not found it necessary to provide an analysis of either the average consumer for the competing services, or the manner in which such an average consumer may select such services. That is because, in my view, it is self-evident that an average consumer of the services I have identified as being identical, will also be an average consumer of "information, advice and consultancy" in relation to such services. As the competing trade marks are identical, it matters not either the manner in which these services are selected nor the degree of care that will be taken during that process.

Overall conclusion

38. As the application has been successful in relation to the services shown below, the registration will, under the provisions of section 47(6) of the Act, be deemed never to have been made:

Class 41 - Nightclub services; music club services; indoor music venues and indoor concert venues; sporting activities; information, advice and consultancy in relation to the aforementioned.

Class 43 - Restaurant services; public house services.

39. The application has, however, failed in relation to:

Class 41 - Recording studio services; production of films, television programmes, audio, video and cinematographic recordings; music publishing services; publication of texts; training services; information, advice and consultancy in relation to the aforementioned.

40. For the avoidance of doubt, the proprietor's trade mark may remain registered for the services shown in paragraph 39 above, as well as for all the goods in classes 9, 16, 18 and 25 i.e. which were not subject to attack.

Costs

41. As both parties have achieved a roughly equal measure of success, both should bear their own costs.

Dated this 19TH day of June 2017

C J BOWEN

For the Registrar

The Comptroller-General