

0 TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION No. 2478997
IN THE NAME OF ASIA FIVE EIGHT LLC**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER No. 97463
BY HING KWONG YAM**

**AND IN THE MATTER OF AN APPEAL
TO THE APPOINTED PERSON BY THE OPPONENT
AGAINST THE DECISION OF MR. D. LANDAU
DATED 23 MARCH 2010**

DECISION

Background

1. On 18 January 2008, Asia Five Eight LLC applied to register under number 2478997 the designation TAO ASIAN BISTRO for use as a trade mark in connection with the following services:

Class 41

Nightclub services

Class 43

Preparation of food and drink; catering services; restaurant services; café and cafeteria services; snack-bar services; fast-food restaurant services; take-away services; bar services; wine bar services; cocktail bar services

2. The Application was published in the Trade Marks Journal on 4 April 2008 and opposed by Hing Kwong Yam on 27 June 2008 under section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994.
3. Mr. Yam owns UK Registration number 1575625 for the figurative trade mark below:



The transliteration of the Chinese characters appearing in the mark is "Tao".

4. TAO figurative was registered on 16 June 1995 (effective 16 June 1994) for the following services:

Class 43

Restaurant services; but not including any such services relating to alcoholic beverages

5. As such, it clearly constituted an earlier trade mark within the meaning of section 6(1)(a) of the Act but was subject to the proof of use requirements of section 6A.
6. The Hearing Officer was satisfied that genuine use during the five year period prior to publication of the mark in suit¹ of TAO figurative had been shown, especially in connection with a restaurant at 5 London End, Beaconsfield, Buckinghamshire albeit with Mr. Yam's consent. However, such use justified only a limited specification for the purposes of the opposition based on the earlier trade mark, namely:

Class 43

Chinese restaurant services; but not including any such services relating to alcoholic beverages.

7. For section 5(4)(a), Mr. Yam relied upon earlier unregistered rights in TAO figurative and also the name TAO, which were first used in 1994 in Buckinghamshire for restaurant services.

Hearing Officer's findings

8. Regarding the substance of the opposition, the Hearing Officer held in brief (BL O/093/10):
 - (i) Any reputation in the earlier trade mark TAO figurative was purely local and insufficient to support the opposition under section 5(3).
 - (ii) Goodwill and reputation in the unregistered earlier signs TAO figurative and TAO belonged to the three companies of which Mr. Yam was the sole director and shareholder and to which Mr. Yam had licensed use of the earlier signs. Accordingly, Mr. Yam was not the earlier rights owner and the opposition under section 5(4)(a) failed for want of standing.
 - (iii) The opposition under section 5(2)(b) succeeded in relation to all the services applied for in Class 43.
 - (iv) Nightclub services in Class 41 were dissimilar to Chinese restaurant services; but not including any such services relating to alcoholic beverages in Class 43. Under section 5(2)(b) there could be no likelihood of confusion where services were dissimilar.
 - (v) The Application would be allowed to proceed to registration for nightclub services in Class 41 only.

¹ Section 6A(3).

- (vi) Each party should bear their own costs.

The appeal

9. On 20 April 2010, Mr. Yam filed Notice of appeal to the Appointed Person under section 76 of the Act requesting that the Hearing Officer's decision in relation to the services in Class 41 be reversed, the opposition be allowed to succeed in its entirety and Mr. Yam be awarded the costs of the opposition and this appeal.
10. At the hearing of the appeal, Mr. Michael Edenborough of Queen's Counsel appeared on behalf of Mr. Yam. Ms. Fiona Clark of Counsel appeared on behalf of Asia Five Eight.
11. As I understood them, the grounds of the appeal were as follows:

Under section 5(4)(a)

- (i) The Hearing Officer misinterpreted the evidence in finding that Tao Restaurant Limited (the third and current licensee company) and not Mr. Yam was the owner of the goodwill in the earlier signs. He was the sole director of that company, its sole shareholder and beneficiary. On a proper interpretation of the evidence Mr. Yam was throughout the legal, or alternatively the beneficial owner of the goodwill in the earlier signs. Accordingly, Mr. Yam had standing under section 5(4)(a) and the Hearing Officer should have found that use of the mark in the UK in respect of both the services in Class 43 and the services in Class 41 was liable to be prevented by the law of passing off.
- (ii) Alternatively, the Hearing Officer should have allowed Tao Restaurant Limited to be joined as a party to the opposition. Once joined the ground of opposition under section 5(4)(a) would again have been made out.

Under section 5(2)(b)

- (iii) Restaurant services and nightclub services are similar services in particular because they are complementary. The Hearing Officer wrongly allowed the classification system to lead him to a conclusion that they were dissimilar.
12. In advance of the hearing, I drew the parties' attention to the decision of Pumfrey J. in *Pharmedica GmbH's Trade Mark Application (BETAMAG)* [2000] RPC 536 concerning the Registrar's powers on opposition to order the substitution or joinder of parties.

Goodwill

13. The Hearing Officer was obviously influenced by the following statement appearing in the annual accounts of the second of the three companies (Circle of Tao Limited) of which Mr. Yam was the sole director and shareholder and to which he consecutively licensed the earlier rights:

“Goodwill, being the amount paid in connection with the acquisition of a business in 1999, is being written off evenly over its estimated useful life of five years”.

14. That led the Hearing Officer to conclude (para. 49):

“This is a statement as to the acquisition of the goodwill of the business by Circle of Tao Limited, a statement that is solidified by the amortisation cost. On the basis of the accounts of his own company, Mr. Yam cannot be considered to have been the owner of the goodwill during the period that Circle of Tao Limited was running the business”.
15. The statement appeared in the annual accounts for Circle of Tao Limited for the year ends 1999 – 2003. The statement did not appear in the accounts for 1997 – 1998 which is the year when Circle of Tao Limited was incorporated, started trading and entered into the Management Licence to carry on the business at 5 London End, Beaconsfield (23 October 1997).
16. Instead, the year end accounts for 1999 explain that the company acquired an additional restaurant outlet at Farnham Common in May 1999 and subsequently let it out in July 1999 for a term of a year. Those leasehold premises at Farnham Common are referred to under “Other financial commitments” in the accounts for 1999 – 2003.
17. I believe there is force in Mr. Edenborough’s argument that the goodwill referred to in the accounts as being written off from 1999 – 2003 related to the Farnham Common restaurant acquired in 1999. That was distinct from the restaurant business carried on under the earlier signs at 5 London End, Beaconsfield, which was originally conducted by Circle of Friends Limited (Mr. Yam’s first company licensee) but taken over or continued by Circle of Tao Limited in 1997.
18. Accordingly, the Hearing Officer’s reasoning proceeded at least partially upon an error of fact.
19. However, the London End licensee immediately preceding the Application (2003 to 18 January 2008) was the third of Mr. Yam’s companies, Tao Restaurant Limited.
20. The Hearing Officer noted that there was nothing in the accounts of Tao Restaurant Limited dealing with the acquisition of goodwill. Mr. Edenborough claimed that supported his case. Assignments of goodwill between the three company licensees at London End were unnecessary because Mr. Yam retained the goodwill throughout.
21. Mr. Edenborough relied also on a related party disclosure in Tao Restaurant Limited’s 2005 accounts:

“Included in rent, £45,118 (2004 - £40,190) was paid to Mr H K Yam, the director, for the licence to operate the business”.

That indicated in his submission that the licence covered not only the premises but also the right to operate under the retained goodwill of the restaurant at 5 London End, Beaconsfield. In contrast, Ms. Clark took me to similar statements in the

accounts of Circle of Friends Limited and Circle of Tao Limited which spoke only of rent and a security deposit/management fees being payable to Mr. Yam for the licences obtained by those companies.

22. The Management Licences to carry on the restaurant business at 5 London End, Beaconsfield granted to Mr. Yam's three company licensees were in identical terms. None dealt expressly with the ownership of goodwill. The Hearing Officer considered that certain outward facing clauses, for example, dealing with health and safety and liquor licensing authorities indicated that the goodwill of the business rested with the individual company licensees.
23. On the other hand, the inward facing clauses concerned "a licence to operate the business (as hereinafter defined)", which (emphasis supplied):

"Means the business of a license Chinese restaurant *which the Licensor is entitled to carry on* and which it proposes to licence the Licensee to carry on at the property *under the Name*".
24. Moreover, the provisions on expiry/termination, in particular, for the handover to Mr. Yam of the details of all personnel engaged in the business, appear to be more consistent with a continuum of the goodwill in the restaurant at 5 London End rather than a cessation and building up of new goodwill each time the identity of the company licensee was changed.
25. The Hearing Officer thought it telling that customers' bills from the restaurant contained a reference at the bottom of the bill to Tao Restaurant Limited even though Mr. Yam was additionally named. He also took account of the fact that utility bills were addressed to Tao Restaurant Limited. Unless the utility companies were customers of the restaurant, I fail to see its relevance to ownership of goodwill.
26. Mr. Edenborough argued that it simply made no commercial sense to split the ownership of the registered trade mark from goodwill. Ms. Clark's bottom line was that even if the evidence was equivocal (which she did not accept), the onus was on the opponent under section 5(4)(a) to prove that it had the requisite goodwill.
27. Alternatively, Mr. Edenborough says that Mr. Yam is the beneficial owner of the goodwill in the restaurant but apart from denying any relevance to *Ball v. The Eden Project Limited* [2002] FSR 686 cited by Ms. Clark, developed the point no further. In any event, I believe Ms. Clark accepted that *Ball v. Eden* was of peripheral applicability.

Joinder

28. There can be no doubt that the Registrar has power to order the substitution or joinder of parties on opposition. It lies within his inherent jurisdiction to regulate the procedure before him. That short point of law was raised on appeal and decided by Pumfrey J. in the *BETAMAG* case referred to in paragraph 12 above.
29. Subsequent to the hearing, the Hearing Officer used his case management powers under Rule 62(1)(a) of the Trade Marks Rules 2008 to call for complete copies of the

Management Licences to the three companies and the parties' written submissions thereon. He was obviously aware of the standing issue and an option open to him would have been to invite and entertain submissions on an application for substitution/joinder.

30. Be that as it may, during the appeal hearing Mr. Edenborough put forward an application for Tao Restaurant Limited to be joined as a party to the opposition and the appeal and I heard submissions from him and Ms. Clark for and against allowance of such application. The Appointed Person likewise has power to permit substitution or joinder of parties on opposition (*BETAMAG* and see, for example, *DAAWAT Trade Mark* [2003] RPC 11 and *FirstRung Trade Mark*, BL O/107/10).
31. Following the appeal hearing, I received through the Treasury Solicitor a written application by Tao Restaurant Limited to be joined as Co-Opponent confirming that it was familiar with and stood by the original evidence and pleadings save that, in the alternative, Tao Restaurant Limited was the owner of the goodwill, and was assuming joint and several liability for any costs award that might be made in these proceedings (*BETAMAG*, at page 538).
32. Ms. Clark argued that the *BETAMAG* case was decided before the introduction of The Trade Marks (Relative Grounds) Order 2007 and to permit Tao Restaurant Limited to be joined as Co-Opponent would be contrary to that Order, article 2 of which provided:

“The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right.”
33. Interestingly, the absence of a requirement for *locus standi* on opposition was put forward as reason why the Registrar should not have the power to order substitution or joinder of a party in *BETAMAG* (the opposite of Ms. Clark's argument). Pumfrey J. observed that the requirement for an interest was merely to filter out vexatious or abusive oppositions and fundamentally irrelevant to the nature of opposition proceedings. Equally, I take the view that article 2 of The Trade Marks (Relative Grounds) Order was neither intended nor effective to preclude the Registrar's power to order substitution/joinder of parties on opposition.
34. If it proves necessary (that is, if Mr. Yam's appeal under section 5(2)(b) is unsuccessful), I will order that Tao Restaurant Limited be joined as Co-Opponent to these proceedings for reasons that include:
 - (a) At least collectively, Mr. Yam and Tao Restaurant Limited are proprietors of any goodwill accruing to the restaurant premises at 5 London End, Beaconsfield from 2003 to the date of the Application.
 - (b) Mr. Yam could have called upon Tao Restaurant Limited to assign ownership of any such goodwill to him.

- (c) The nature of the opposition under section 5(4)(a) (including the evidence) would remain unchanged.
 - (d) Any unnecessary duplication of proceedings with attendant expense in time and costs would be avoided. The alternative was for Mr. Yam/Tao Restaurant Limited to pursue the 5(4)(a) claim on invalidity.
 - (e) There was nothing intentional about Mr. Yam bringing the opposition under 5(4)(a) in his name rather than Tao Restaurant Limited's (*CONSEAL Trade Mark*, BL O/197/00).
35. However, as Ms. Clark forcibly argued, joining Tao Restaurant limited as Co-Opponent would not automatically lead to success under section 5(4)(a) of the Act. The Hearing Officer did not substantively decide the opposition under section 5(4)(a). At the appeal hearing, the parties agreed that (if necessary) the appropriate course of action would be for me to remit the case to the Registry so that a decision under section 5(4)(a) could be given at first instance. Ms. Clark indicated that in that event her client might put forward a geographical limitation.

Section 5(2)(b)

36. Article 9 of the Trademark Law Treaty (“TLT”), Done at Geneva on 27 October 1994 provides as follows:

“Classification of Goods and/or Services

(1) [*Indications of Goods and/or Services*] Each registration and any publication effected by an Office which concerns an application or registration and which indicates goods and/or services shall indicate the goods and/or services by their names, grouped according to the classes of the Nice Classification, and each group shall be preceded by the number of the class of that Classification to which that group of goods or services belongs and shall be presented in the order of the classes of the said Classification.

(2) [*Goods or Services in the Same Class or in Different Classes*]

(a) Goods or services may not be considered as being similar to each other on the ground that, in any registration or publication by the Office, they appear in the same class of the Nice Classification.

(b) Goods or services may not be considered as being dissimilar from each other on the ground that, in any registration or publication by the Office, they appear in different classes of the Nice Classification.”

The United Kingdom became a party to the TLT on 1 August 1996.

37. Article 9 of the Singapore Treaty on the Law of Trademarks (Singapore, 2006) provides for classification of goods and/or services in the same terms but the United Kingdom has not become a member of the Singapore Treaty.

38. On 24 September 2010, the Board of Directors of the International Trademark Association (“INTA”) adopted a resolution that classification should not be taken into consideration regarding the likelihood of confusion analysis by trade mark offices and courts.
39. The INTA Resolution noted:
- (a) disparity among jurisdictions as to whether classification is taken into account in the analysis of likelihood of confusion in registration, opposition and infringement proceedings, with some jurisdictions considering the specific goods and services while others looked to classes;
 - (b) attempts in the TLT and Singapore Treaty to harmonise classification and to clarify that classification has no legal significance by (i) requiring contracting parties to conform to the Nice Agreement Concerning the International Classification of Goods and Services, and (ii) providing that goods or services may not be considered as being similar to each other, or dissimilar to each other, on the ground that they appear in the same or different classes; and
 - (c) the continued consideration of classification in confusion analysis by trade mark offices and courts resulted in inconsistency in decisions and uncertainty for trade mark owners.

Nightclub services

40. The Hearing Officer noted in his decision three dictionary definitions of nightclub (para. 74):

“Chambers 21st Century Dictionary:

“entertainment, etc. Derivatives nightclubber noun a patron of a nightclub. nightclubbing noun dancing, drinking and sometimes dining at a nightclub.”

The Penguin English Dictionary:

“...noun a place of entertainment open at night that usu has a disco and a bar floor show, provides music and space for dancing, and usu serves drinks and food nightclubber noun nightclubbing noun.”

Merriam-Webster's Collegiate(R) Dictionary:

“...noun (1894): a place of entertainment open at night usually serving food and liquor and providing music and space for dancing and often having a floor show.””

41. His comments on those definitions and the evidence were as follows (para. 75, emphasis supplied):

“One may need to be wary of dictionary definitions at times but in this case *all three dictionaries concur that food may be served at nightclubs*. The

dictionary definitions conform to my own experience. There are nightclubs that primarily provide loud music, dancing and beverages. Other types of establishment will have music and beverages but also either integrated or discrete dining areas. *The dividing line between some nightclubs and bars of various sorts is very fine and exists more in the word chosen than the services provided. All three types of undertakings could supply beverages, food and musical entertainment, whether that be live, recorded or in the form of karaoke. Asia's evidence at KC5 shows that the restaurant and nightclub flow into each other, as do the pages from Asia's website exhibited at HKY12. This is United States usage and so not necessarily indicative of the position in the United Kingdom. Included in the latter exhibit are pages from the websites of Loc Locos, Sugar Reef, Storm, Zoo and Café de Paris which show that there is no clear demarcation between restaurant services and nightclub services. The printouts exhibited at HKY12 were downloaded on 19 March 2009, I doubt that between 18 January 2008 and 19 March 2009 the pattern of trade suddenly changed.*"

42. The Hearing Officer then instructed himself (para. 76):

"However, this is an issue of similarity of services within the context of the classification system. It is necessary to consider not what night club services encompass generally but what they encompass in the specific parameters of a specification in class 41."

And (at para.77):

"The comparison is to be made between nightclub services and Chinese restaurant services but not including any such services relating to alcoholic beverages, not restaurant services at large. It is necessary to take into account in which class the services are (as per *Altecnic*) and to avoid being misled by the norms of the trade. The nightclub services in class 41 do not encompass any services for providing food and drink, which are in class 43. The services in class 41 only encompass the entertainment part of the nightclub services."

43. Pausing there, no exception was taken to the Hearing Officer's:

- (a) citation of *Altecnic Ltd's Trade Mark Application* [2002] RPC 639. In that case, the Court of Appeal held that a specification of goods and services must be interpreted in the context of the Class for which they were applied; or
- (b) determination that the Application in Class 41 covered the entertainment (as opposed to the food and drink) aspects of the provision of nightclub services.

44. It is again worth noting at this point the obvious fact that if Class 41 had encompassed the food and drink side of nightclub services then, of course, identity of services would have been involved.

45. Repeating his warning to avoid being misled by the norms of the trade, the Hearing Officer continued (paras. 77 – 78):

“77) [...] Taking into account the class in which the services are and the restriction that this applies to them, whatever the norms of the trade, within the parameters of the case law the only possible area in which the respective services could coincide is in relation to complementarity, as the provision of food is out of the equation owing to the class.

78) The concept of the complementary nature of goods and/or services has been dealt with by the GC on a number of occasions. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* the GC stated:

“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).”

Chinese restaurant services but not including any such services relating to alcoholic beverages are not indispensable or important for the provision of nightclub services. They are not complementary.”

46. From that (paras. 76 – 78) he concluded (paras. 79 – 81):

“79) If Asia’s trade mark is registered in class 41 it is not gaining any rights in relation to the supply of food and/or beverages. This divide might appear artificial but it is born of the nature of the classification system and is a real divide. It is not possible to make a comparison with services that are not encompassed by the class.

80) The nature of the nightclub services encompassed by class 41 means that such services are not similar to the services of the earlier registration.

81) Where I have found that the respective services are not similar there cannot be a likelihood of confusion. Consequently, there is no likelihood of confusion in relation to nightclub services.”

Analysis

47. It is settled law that in order to assess the similarity between the services in question all the relevant factors relating to those services must be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (Case C-39/97, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* [1998] ECR I-5507, para. 23). Other factors may also be taken into account, such as the supply channels

for the respective services (Case T-116/06, *Oakley v. OHIM* [2008] ECR II-2455, para. 49). In *British Sugar Plc v. James Robertson Ltd* [1996] RPC 281, Jacob J. indicated that it may be appropriate to ask how the trade classify the services in suit, for instance, whether market research companies, who of course act for industry, put the services in the same or different sectors.

48. The Hearing Officer undertook his assessment of the likelihood of confusion under section 5(2)(b) on the basis of the specification in the Application as a whole (para. 57 – 60). He identified a single reasonably well informed and reasonably circumspect and observant consumer because in his view all of the services would ultimately be purchased by the public at large. He reminded himself that in construing the specification he should take account of how, as a practical matter, the services were regarded in trade. He considered that all of the services could be bought on impulse increasing the possibility of imperfect recollection. Further, since the common identification of the services (nightclubs, restaurants) was by signage visual use of the trade marks in suit was more important than the oral use. His comparison of the marks was likewise conducted in relation to the totality of the services (paras. 61 – 66).
49. Given that collective approach, it was then not open to the Hearing Officer to compare the Class 41 services on a different basis and disregard: (a) apposite dictionary definitions; (b) his own experiences as a member of the general public; and (c) trade practices, all of which would each have given shape and form to the perceptions of the average consumer (Case C-239/05 *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ECR I-1455, paras. 30 – 38, and see the comments of Mr. Geoffrey Hobbs QC sitting as the Appointed Person in *SEPARODE Trade Mark*, BL O/399/10).
50. The sole justification the Hearing Officer gave for excluding factors other than complementarity from his comparison between nightclub services and the services of the earlier registration was that the provision of food and drink lay outside Class 41. As mentioned above, if the supply of food and drink had been covered by Class 41, there would have been identity. Instead, the task before the Hearing Officer was to assess the services' similarity.
51. Further, he proffered no explanation beyond the observation that the Application in Class 41 gave no rights in relation to the supply of food and/or beverages for his determination that the services were non-complementary, which appeared to be contrary to *inter alia* Asia Five Eight's own evidence. There is a suggestion that the supply of *Chinese* food might have been influential but that was neither explored nor made explicit in the decision. It was not only an unlikely pivot but one which failed to take account of Chinese/Chinatown nightclubs.
52. In my judgment, the Hearing Officer used classification to find that the services were dissimilar. In so doing, he elided the two separate questions of: (a) what services were within the Class 41 Application; and (b) what degree of similarity was there between the Class 41 services and the services in the earlier registration. Whilst classification was relevant to first question (*Altechnic*), it was irrelevant to the second question (*Canon*, art. 9 TLT). That was a material error of principle, which entitles me to reconsider the matter afresh.

Section 5(2)(b) – nightclub services in Class 41

53. Based on the evidence on file, the dictionary definitions and my own experience which mirrors that of the Hearing Officer (see paras. 40 – 41 above), I find that there is some similarity between Chinese restaurant services but not including any such services relating to alcoholic beverages and nightclub services in Class 41. I accept Mr. Edenborough's contention that the supply of food and drink (albeit non-alcoholic) is important to the provision of the entertainment aspects of nightclub services, for example, dancing, in such a way that customers might think the responsibility for those services lies with the same undertaking. The services might not unusually be provided contemporaneously and through the same supply channels. In my judgment, the type of food or drink served is irrelevant.
54. The Hearing Officer found that the respective trade marks were similar to a high degree and that the earlier trade mark TAO figurative had a good degree of inherent distinctiveness. I did not understand the parties to challenge those findings with which, in any event, I agree.
55. Applying the guidance of the Court of Justice of the European Union in the leading cases including Case C-251/91, *Sabel BV v. Puma AG* [1997] ECR I-6191, *Canon*, Case C-342/97, *Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsen Handel BV* [1999] ECR I-3819 and Case C-425/98 *Marca Mode CV v. Adidas AG* [2000] ECR I-4861, in my judgment there would be a likelihood of confusion in the minds of the public including a likelihood of association with the earlier trade mark, if Asia Five Eight were permitted to register TAO ASIAN BISTRO for use as a trade mark in the United Kingdom in relation to nightclub services in Class 41.

Conclusion

56. The appeal in relation to section 5(2)(b) is successful. It has therefore become unnecessary for me to deal further with the appeal under section 5(4)(a).
57. The net result is that the Application has been refused in its entirety and Mr. Yam is entitled to an award of costs in respect of the opposition and this appeal.
58. I will order Asia Five Eight to pay Mr. Yam the sum of £2,300 towards his costs of the opposition and a further sum of £900 towards the costs of this appeal to be paid within 28 days of this decision.

Professor Ruth Annand, 4 January 2011

Mr. Michael Edenborough of Queen's Counsel instructed by Scott & York Intellectual Property Ltd. appeared on behalf of Hing Kwong Yam.

Ms. Fiona Clark of Counsel instructed by RGC Jenkins & Co. appeared on behalf of Asia Five Eight LLC.