

O-019-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2234317
BY PARKVIEW INTERNATIONAL LONDON PLC
TO REGISTER THE TRADE MARK:**

BATTERSEA POWER STATION

IN

CLASSES 35, 39, 41, 42

AND

**THE OPPOSITION THERETO
UNDER NO 90312**

BY

**POWER STATION LIMITED
BASED UPON THE EARLIER TRADE MARK:**

POWERSTATION
CAFÉ

Trade Marks Act 1994

**In the matter of application no 2234317
by Parkview International London plc
to register the trade mark:
BATTERSEA POWER STATION
in classes 35, 39, 41 and 42
and
the opposition thereto
under no 90312
by Power Station Limited**

BACKGROUND

1) On 31 May 2000 Parkview International London plc, which I will refer to as Parkview, applied to register the trade mark **BATTERSEA POWER STATION**. The application was published for opposition purposes in the "Trade Marks Journal" on 16 January 2002. The application is for a range of services in classes 35, 39, 41 and 42 of the International Classification of Goods and Services. However, this opposition only relates to the following services in class 42:

provision of food, drink and temporary accommodation... restaurant; bar, café and fast food services; catering services; food, drink and hotel management services...outlets for provision of food, drink...

(Hereafter referred to as the services.)

2) On 12 April 2002 Power Station Limited, which I will refer to as PSL, filed a notice of opposition to the application. PSL states that it is the owner of United Kingdom trade mark registration no 2234012 for:



The trade mark is registered for the following services in class 42 of the International Classification of Goods and Services:

providing of food and drink, but not including any such services provided at a power station.

PSL states that the trade mark of the application is similar to its trade mark and that the respective services are identical. Consequently, there is a likelihood of confusion and registration of the application in respect of the services under attack would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) PSL claims that it has used its trade mark extensively from 2000 in relation to the services for which it is registered and has become well-known to the public. PSL claims that use of the

trade mark by Parkview is liable to be prevented by the law of passing-off and so registration of the application in respect of the services would be contrary to section 5(4)(a) of the Act. PSL states that services branded with its trade mark are provided by it from its premises in Bankside in London, adjacent to the Bankside Power Station, home of the Tate Modern International Art Gallery. PSL states that the Bankside Power Station is a well-known land mark and the public are likely to link the services for which its trade mark is registered with those of the application.

4) PSL states that Parkview does not operate as a power station and so should not be allowed to register the words power station simply by reference to a location. PSL states that if the location is removed then the trade mark of Parkview would simply be for the words power station.

5) PSL states that Parkview also made an application for the trade marks THE POWER STATION AT BATTERSEA and THE POWER STATION @ BATTERSEA (application no 2234324). PSL's registration was cited against the application and following a hearing Parkview agreed to remove certain services from class 42 to overcome the conflict. PSL states that Parkview agreed to remove the services relating to food and drink and as a result it is no longer opposing that application. PSL states that the application is highly similar to application no 2234324 and in being allowed to continue without amendment clearly evades the Patent Office's instructions in relation to application no 2234324.

6) Parkview filed a counterstatement. It does not admit that the respective trade marks are similar. However, it does admit that the services of PSL's registration are identical to some of the services of the application (although it does not state which ones). Parkview states that it is to be noted that PSL's registration specifically excludes services that are provided at a power station. Parkview states that it is the owner of the premises known as Battersea Power Station and that the applicant intends to provide its services there. Parkview does not admit that there is a likelihood of confusion.

7) Parkview denies that its application should be refused under the provisions of section 5(4)(a) of the Act. It states that PSL states that its services are provided from a location adjacent to the Bankside Power Station, which it claims to be a well-known landmark. Battersea Power Station is also a well-known land mark in London and as a result confusion on the part of the public is even less likely to arise.

8) Parkview admits that it does not operate as a power station, although it intends to offer its services from premises which were previously used as a power station.

9) Parkview admits that it made application no 2234324, now a registration. It admits that PSL's trade mark was cited against it and, further to a hearing, certain services in class 42 were deleted. Parkview denies that PSL opposed the application. Parkview does not admit that the trade mark the subject of this application is highly similar to those of 2234324. Parkview also denies that there has been any evasion of the Patent Office's instructions, since no instruction was issued to it.

10) Both sides filed evidence and both seek an award of costs.

11) After the completion of the evidence rounds both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised

that they retained their rights to a hearing. Neither side requested a hearing. Both sides filed submissions.

Evidence of PSL

12) This consists of a statutory declaration by Susie Wong MBE. Ms Wong is a director of PSL.

13) PSL was incorporated on 29 September 1998. It acquired premises at 60-62 Hopton Street, Bankside, London on 30 November 1999. Ms Wong states that PSL traded from these premises from the date. She exhibits pictures of a sign pointing to “Powerstation Cafe • Gallery” and of PSL’s trade mark etched into the window of its premises. She exhibits various materials relating to the café. None of these bear dates nor are any dates ascribed to them. The undertaking is also referred to as Powerstation Café Gallery, no doubt because “It shares its space with a gallery for exhibitions of modern Oriental and European Art, shows and functions” (from part of the publicity). Ms Wong states that the undertaking has attracted various authors, artists, musicians and personalities to its functions, including Rolf Harris, John Pilger, Magnus Magnusson and Michael Lynch. The following turnover figures are given:

Year ending September 2000	£14,988
Year ending September 2001	£43,822
Year ending September 2002	£63,000

The relevant date for this case can be no later than the date of application (see below), 31 May 2000. Consequently, the figures for 2001 and 2002 cannot assist PSL. There is also no indication as to how much of the turnover for the year ending September 2000 accrued from before 31 May 2000. Therefore, the turnover figure for 2000 could have all, or for the most part, come from after 31 May 2000, and so cannot assist PSL.

14) Ms Wong produces documentation to show that the freehold of the Battersea Power Station site is owned by Halcyon Estate Limited, a British Virgin Islands Company. She also exhibits a copy of the Directors’ Report and Financial Statements for the year ended 31 March 2001 for Parkview. Ms Wong points out that the report states that Parkview does not own any land or buildings. She states that, consequently, she believes that Parkview is not the proprietor of the premises known as Battersea Power Station.

15) Ms Wong states that she has received several telephone calls from people unsure as to whether the business conducted under PSL’s trade mark is also carried on at Battersea Power Station. She does not state when these telephone calls took place, from whom they were or in what context were they made.

16) Ms Wong states that PSL did not oppose the application for THE POWER STATION AT BATTERSEA and THE POWER STATION @ BATTERSEA as reference to food and drink was deleted from its application. She exhibits a copy of a page from the “London Business & Services Central” telephone directory for part of the letter P section. There are two references to Power Station. One being that for PSL and the other being for Power Station Youth Centre.

Evidence of Parkview

17) This consists of a statutory declaration made by Andrew Biggs. Mr Biggs is the corporate affairs director of Parkview. Much of Mr Biggs' declaration is submission and/or a critique of the evidence of Ms Wong. As such it is not evidence of fact and so I will say no more about those elements of his evidence here. Although I bear Mr Biggs' comments in mind in reaching my decision.

18) Mr Biggs states that Halcyon Estates Limited does own the freehold of the Battersea Power Station site. However, Halcyon and Parkview are associated companies as they are both wholly owned, ultimately, by the Hwang family. Parkview has been appointed by Halcyon as the project co-ordinator for the development of Battersea Power Station and acts as the agent for Halcyon in that capacity. Documentation is furnished in support of this statement.

19) The final evidence of fact supplied by Mr Biggs is that the Battersea Power Station site is derelict and has been so for many years.

Evidence of PSL in reply

20) This consists of a further statutory declaration by Ms Wong. Ms Wong's declaration includes little factual evidence. She does state that PSL has been using its trade mark since September 1998.

DECISION

Likelihood of confusion – section 5(2)(b) of the Act

21) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

The term ‘earlier trade mark’ is defined in section 6(1) of the Act as follows:

“a registered trade mark, international trade mark (UK) or Community trade mark 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.”

PSL's trade mark is an earlier trade mark within the terms of section 6(1) of the Act.

22) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 and *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

Comparison of services

23) Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 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 particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

I will give the words in the specifications their natural meaning. I also bear in mind the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* where he stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

I firmly bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“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.”

24) The services of the earlier registration are: *providing of food and drink, but not including any such services provided at a power station*. I do not consider that in the comparison of services anything turns upon the exclusion in the specification. The services that PSL is attacking are:

provision of food, drink and temporary accommodation... restaurant; bar, café and fast food services; catering services; food, drink and hotel management services...outlets for provision of food, drink...

In its written submissions PSL states that it “opposes the retention of the wording concerning the provision of food and drink, restaurant, bar, café, fast food and catering services from the application in class 42”. It would appear from this that it has honed down the breadth of its opposition. Unfortunately, it has not made this clear and unambiguous, in so far as this relates to the original parameters of the opposition. I do not know if this wording is general and covers such things as outlets for provision of food and drink. There has been no amendment to the grounds of opposition to clarify the matter. I consider that the only elements that I can consider safely excluded are those relating to temporary accommodation and hotel management services.

25) The specification of the earlier registration encompasses the whole spectrum of services providing food and drink and so will encompass *provision of food, drink ... restaurant; bar, café and fast food services; catering services; ...outlets for provision of food, drink*; so these elements of the specification of the application are identical to the services of the earlier

registration. Taking into account the contents of paragraph 24, this leaves only *food and drink management services* of the contested services to be considered. I am of the view that these terms, given their normal meaning, would encompass the running of such things as restaurants and bars for others. The sort of activity that happens when an undertaking contracts out its catering facilities. In this context I consider that if such services are not identical to those of the earlier registration they are so close that it makes no practical difference.

Comparison of trade marks

26) The trade marks to be compared are:

Earlier registration:

POWERSTATION
CAFÉ

Application:

BATTERSEA POWER STATION

The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* page 224). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG* page 224). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* page 84, paragraph 27).

27) Both trade marks include the words POWER STATION. PSL has put forward the argument that if BATTERSEA was removed from the trade mark of Parkview, the trade marks would be virtually identical, taking into account the services in question. This is true. However, the trade marks have to be compared in their entirety. I have to consider BATTERSEA POWER STATION as a whole. This is not a matter of a mere geographical location being before the words POWER STATION. BATTERSEA POWER STATION has its own meaning owing to having been such a well-known building; so well-known that it is mentioned in “Collins English Dictionary” (5th Ed 2000):

“BATTERSEA n. a district in London, in Wandsworth: noted for its dogs' home, power station (being developed into a leisure centre), and park.”

The BATTERSEA element of the trade mark is not just a geographical element, it forms part of an entity with its own specific conceptual associations. The Court of First Instance in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH* Case T-292/01 commented upon the effect of conceptual differences:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public,

a clear and specific meaning so that the public is capable of grasping it immediately.”

The earlier registration brings to mind no specific location. PSL argues that the position in relation to the conflict between THE POWER STATION AT BATTERSEA and THE POWER STATION @ BATTERSEA and its trade mark support its case. I consider that the very opposite is the case. Instead of referring to a famous building with all its conceptual associations these earlier trade marks refer to THE POWER STATION in the geographical location of Battersea. These trade marks do not bring to mind BATTERSEA POWER STATION. One could readily imagine that in this context that these trade marks would be seen as just referring to a POWER STATION CAFÉ which is in Battersea. The conceptual associations and effects of the various trade marks of Parkview are very different. The trade mark of the application is no more likely to be divided up or hacked away at than Buckingham Palace or Westminster Abbey. There are similarities between the respective trade marks but this does not make them similar. Mr Hobbs QC, sitting as the appointed person, in *Torreomar* [2003] RPC 4 stated:

“At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in the context of the marks as a whole, as origin specific (see, for example, *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713) or origin neutral (see, for example, *The European Ltd v The Economist Newspaper Ltd* [1988] FSR 283).”

In this case, because of the conceptual association of Parkview’s trade mark, I do not consider that the respective trade marks are distinctively similar. In drawing this conclusion I have born in mind the public seldom have the opportunity to compare trade marks directly and so are subject to the vagaries of imperfect recollection. However, the fame of BATTERSEA POWER STATION is such that it will, in my view, inevitably be remembered as a whole and not BE confused with the trade mark of PSL. I take into account that the decision to purchase the respective services of the two sides might not be a very careful and educated one. All the arguments of PSL founder and are broken upon the rocks of the fame of BATTERSEA POWER STATION. (A matter that is not affected by who owns this premises of this former power station; in the context of these proceedings it does not matter whether Parkview owns the freehold or not.)

Conclusion

28) For me to find that there is a likelihood of confusion the respective signs have to be similar. This is what the Directive states and it is what is pointed out in *Sabel*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

Without similarity there cannot be confusion. **The objection under section 5(2)(b) must fail.**

29) The contested services are identical or nearly identical. However, as the respective trade marks are not similar the interdependency principle for goods and signs cannot assist PSL (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). I also do not need to consider the distinctiveness of the earlier trade mark. However, for the sake of completeness I will comment upon this matter. There is a greater likelihood of confusion where the earlier trade mark has a particularly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgement of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49). In this case clearly the CAFÉ element of the earlier registration is non-distinctive. However, as a whole the trade mark makes no reference or even allusion to the services. I am of the view that the earlier trade mark has a greater capacity to identify the services for which it is registered. The evidence of PSL cannot support any claim to a reputation at the relevant date and so this element of the global appreciation of the issues cannot assist it.

30) Parkview made various comments about the fact that the specification of the registration of PSL excludes services provided at power stations. Parkview's application is not restricted to providing services at a power station. Even if it was this would not assist it. Identical services are included in the respective specifications, this is not affected by the exclusion. The exclusion is not a disclaimer and so does not have the effect of section 13 of the Act (see *Paco/Paco Life in Colour Trade Marks* [2000] RPC 451).

31) PSL has made comments about instances of confusion. I must admit to being confused about this aspect of its evidence, which as I have noted is undocumented and lacking in detail. How can there be instances of confusion with a business that at the moment does not exist? The confused persons have not used and could not have used the business of one side thinking it is the business of the other. Perhaps what PSL is trying to show is that its name would be identified with BATTERSEA POWER STATION. As I have indicated above, in my consideration of the similarity of the trade marks, I do not consider this a runner. PSL also exhibits pages from the London telephone directory to show that only two undertakings are listed which begin with the words Power Station. I am afraid that all I can respond to this is so what? It tells me nothing about the likelihood of confusion. Even if there was theoretical relevance in this line of argument, the evidence would not assist PSL. PSL's evidence does not deal with the possibility of there being other establishments using the words power station as the ends of their names and/or undertakings outside Central London. Anyway this whole aspect of the argument of PSL is rather futile as it does not address the fame of one particular building and the effect that that fame has.

Passing-off – section 5(4)(a) of the Act

32) Section 5(4)(a) of the Act states that a trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in

the course of trade. In this case the rule of law relied upon by PSL is the law of passing-off. **As the specification of the earlier registration encompasses identical services I cannot see how PSL could be any better off under this provision than under section 5(2)(b).**

33) However, even if this were not the case I do not consider that PSL could benefit from the provisions of section 5(4)(a) of the Act. To succeed under this head PSL has to establish, inter alia, that at the relevant date it enjoyed a goodwill for its business. It is well established that the relevant date for passing-off is the date of the behaviour complained of (see *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2003] EWCA Civ 1132). Section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 of December 21, 1998 which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark”.

The relevant date cannot, therefore, be later than the date of the application for registration. As there is no evidence of use of Parkview’s trade mark the behaviour complained of will have to be the date of the application for registration, 31 May 2000.

34) Pumfrey J in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 stated:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX) (1946) 63 RPC 97* As qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

There is no clear evidence as to what the position of the business was as of 31 May 2000. Indeed the position was made even more unclear by the second declaration of Ms Wong. In that declaration she states that PSL’s trade mark was used in trade from September 1998. Why are there no turnover figures for the year ending September 1999? She states in her first declaration that PSL acquired its premises from 30 November 1999, where was it trading from September 1998 until that date? There is a complete absence of evidence of promotion prior to the relevant date. Ms Wong comments upon what has happened after the relevant date but the evidence must be directed to the relevant date. There is no evidence from the public or the trade. The evidence to establish goodwill at the relevant date is, in my view, completely inadequate and goes nowhere near satisfying the criteria set out by Pumfrey J. **Consequently, the ground of opposition under section 5(4)(a) is dismissed.**

Costs

35) Parkview International London plc has been successful in this opposition and so is entitled to a contribution towards its costs. I order Power Station Limited to pay Parkview International London plc the sum of £975 . 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 23rd day of January 2004

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