

O-032-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 3105102
BY THE WILLOW TEA ROOMS TRUST**

FOR THE TRADE MARK

THE WILLOW TEA ROOMS

AND

**THE OPPOSITION THERETO UNDER NUMBER 405148 BY
ANNE MULHERN**

Background

1. The Willow Tea Rooms Trust (“the applicant”) applied for the trade mark THE WILLOW TEA ROOMS on 22 April 2015 in classes 35, 41, 42 and 43.

2. The application was accepted and published in the *Trade Marks Journal* for opposition purposes on 26 June 2015. Anne Mulhern opposes the trade mark application under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act (“the Act”). For sections 5(2)(b) and 5(3), Ms Mulhern relies upon two earlier trade mark registrations which she owns, as follows:

(i) 1276805 (series of 2 marks)

WILLOW WILLOW

Class 42: *Restaurant, tea room, catering and cafe services; all included in Class 42; but not including any of the aforesaid services relating to the provision of alcoholic drinks.*

Filing date: 1 October 1986; date registration procedure completed: 12 July 1991

(ii) 2251332A (series of 8 marks):

THE WILLOW
TEA ROOMS

THE WILLOW TEA ROOMS

THE WILLOW
TEA ROOM

THE WILLOW TEA ROOM

THE WILLOW
TEAROOMS

THE WILLOW TEAROOMS

THE WILLOW
TEAROOM

THE WILLOW TEAROOM

Goods and services in classes 9, 11, 16, 20, 21, 24, 30 and 43. Filing date: 3 November 2000; date registration procedure completed: 8 March 2002.

3. Ms Mulhern's claim under section 5(2)(b) is that there exists a likelihood of confusion owing to the similarities/identity between the marks and the goods/services. Under section 5(3) of the Act, Ms Mulhern claims that the earlier marks have a reputation in certain goods and services such that use of the application without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier marks.

4. Ms Mulhern's claim under section 5(4)(a) of the Act is based upon the signs 'The Willow Tea Rooms' and 'Willow', since 1983, 'throughout the UK', in relation to:

The preparation and provision of food and drink; hospitality services; organization and conducting of events and exhibitions, including for advertising and commercial purposes; organization and conducting of events and exhibitions, including for cultural and educational purposes; entertainment; education; training; and the provision of accommodation, including facilities for exhibitions, parties and weddings.

Ms Mulhern claims that her services are particularly popular with tourists, who visit from far and wide, including throughout the UK. She claims that the use of the application would constitute a misrepresentation and damage to her goodwill. Use of the trade mark covered by the application is therefore liable to be prevented under the law of passing off.

5. Ms Mulhern's two trade mark registrations had been registered for more than five years on the date on which the opposed application was published. They are therefore subject to proof of genuine use under section 6A of the Act, provided the applicant requests that her claim to have made genuine use of her marks is made good. The applicant has made such a request in its counterstatement. Furthermore, it denies all the grounds and makes the following points:

“It is accepted by the Applicant that a business has been carried on at 217 Sauchiehall Street, Glasgow under the name “The Willow Tea Rooms”. However:

(a) such business has since June 2001 been carried on by a company, Willow Tearooms Limited, not by the Opponent as proprietor of any trade mark;

(b) it is queried whether there has been use of any or all of the stylised forms of such name as set out in relation to UK trade mark registration No. 2251332A; and

(c) no use will have been made of the trademark “Willow” being the registered form of trademark under No. 1276805 as it is understood the operation of any business will only ever have used the word “Willow” in conjunction with the overall words “The Willow Tea Rooms” (which is a separate trade mark).”

6. The applicant claims that it has established goodwill as the owner of the building at 217 Sauchiehall Street:

The building at 217 Sauchiehall Street, Glasgow was originally built as a three-storey tenement over a shop. It was acquired in 1901 by Miss Cranston who commissioned Charles Rennie Mackintosh in 1903 to change it into one of her tearooms. Miss Cranston's tearoom lasted until 1919, when she retired and the building was taken over by another restaurateur. In 1927 it was absorbed into the adjacent building at 215 Sauchiehall Street by Daly's department store. Daly's vacated the building in 1977 and in 1978 the Arrowcroft Group bought the entire urban block and carried out a redevelopment of individual units. The building was leased by Henderson Jewellers and it is believed the company called Willow Tearooms Limited occupied part of the building (initially to provide refreshments to customers of the jewellers and subsequently as a separate business). It is not known if this was on its own account or on behalf of Henderson Jewellers and the Opponent is requested to provide evidence of this (and the basis upon which it occupied the building) given the claim by the Opponent to have established goodwill through trading under the name. In 2013, it is believed Willow Tearooms Limited took on the main lease after the jewellers closed.

In 2014 ownership of the building known as The Willow Tea Rooms transferred to the Willow Tearooms Trust, the Applicant.

Throughout this time the building, and not the business carried on in it, has been known as the Willow Tea Rooms. In particular, it is noted that even when the building was originally designed, although it was then known and continues to be known as the Willow Tea Rooms, the tearoom business carried on in it was known as Miss Cranston's and the name the Willow Tea Rooms was associated with the building (and its proprietor) and not the business carried on in it. Indeed, as part of grant funding Historic Scotland require that the building be called and have signage stating it is "The Willow Tea Rooms".

It is acknowledged that there is a company called Willow Tearooms Limited which has occupied the building. The difference between the goodwill in the building and the tearoom business is emphasised by the fact that Willow Tearooms Limited is the registered proprietor of the UK trade mark No 2155771D MISS CRANSTON for, *inter alia*, catering services.

If, which is denied, any goodwill in the name "Willow Tearooms" has been built up which could be relevant to the Application, which is not associated with the building, this can only have been created by Willow Tearooms Limited. Willow Tearooms Limited is not the Opponent and any significant reputation for any goods or services (if it exists) will have been built up by Willow Tearooms Limited and not by the Opponent. Use by Willow Tearooms Limited is not use by the Opponent and Willow Tearooms Limited has not opposed the Application.

7. Both parties are professionally represented and have filed evidence. Ms Mulhern also filed submissions during the evidence rounds. Although neither party has chosen to be heard, both parties have filed written submissions in lieu of attending a hearing. I make this decision after carefully considering all of the papers filed.

Evidence

Anne Mulhern's evidence

8. Ms Mulhern's first witness statement is dated 17 May 2016. She begins by stating:

"1. I am the owner of a tea room business trading under the trade mark THE WILLOW TEA ROOMS, and the sole director of Willow Tearooms Limited, with a registered office address of 217 Sauchiehall Street, Glasgow, G2 3EX, United Kingdom."

9. Ms Mulhern states that THE WILLOW TEA ROOMS was first used in the UK by her on 1 December 1983, when she opened her first tea room at 217 Sauchiehall Street, Glasgow. The tea room initially operated from the “Room de Luxe”, which was the original “Ladies Room” on the first floor of 217 Sauchiehall Street. Ms Mulhern explains that the Room de Luxe is exquisitely decorated in “true Mackintosh style” (a reference to the architect Charles Rennie Mackintosh). In 1996, her tea room expanded onto the mezzanine level at 217 Sauchiehall Street, and in 1997 she opened her second THE WILLOW TEA ROOMS tea room at 97 Buchanan Street, Glasgow. From 2008 to 2013, the tea room operated at the Scotland Street School Museum, in Glasgow. Ms Mulhern states that since she was the first to use the mark THE WILLOW TEA ROOMS in relation to her tea rooms and is the sole director of Willow Tearooms Limited, it is ‘obvious’ that she is the owner of the mark THE WILLOW TEA ROOMS, “and of all of the goodwill and reputation in that mark, generated over the past 33 years of use at my tea rooms.”

10. Ms Mulhern states that 217 Sauchiehall Street was ‘badged’ as “Miss Cranston’s Lunch & Tea Rooms” from 1903 to 1919. In 1919, the building became “The Kensington”, and in 1927 it became part of Daly’s Department Store. When Henderson the Jewellers took over the ownership of the building in 1979, it was named “Henderson the Jewellers”. Ms Mulhern states that it was not until 1 December 1983, when she opened THE WILLOW TEA ROOMS, that the first use of the mark THE WILLOW TEA ROOMS occurred in respect of the tea room business carried out therein, which was entirely independent of Henderson the Jewellers. Exhibit AM01 contains copies of two photographs of the exterior of the building at 217 Sauchiehall Street. The first shows the building when Miss Cranston’s tea room was originally opened in around 1903. Ms Mulhern states that there is no evidence in this photograph of the mark THE WILLOW TEA ROOMS in use at that time, nor is the building badged THE WILLOW TEA ROOMS. Looking at the exhibit I cannot see any signage in the photograph (including “Miss Cranston’s Lunch & Tea Rooms”). The second photograph was taken in the late 1980s, when the building was leased or owned by Henderson the Jewellers, and these words appear on the façade.

11. Ms Mulhern states that the building at 217 Sauchiehall Street is not and never has been known as THE WILLOW TEA ROOMS and the fact that ownership of the building passed to the applicant is irrelevant. Ms Mulhern states that, in November 2000, she decided to protect all of the goodwill and reputation acquired in the mark THE WILLOW TEA ROOMS through the use which she had made of the mark at each of her tea rooms, hence the filing (and registration) of earlier mark 2251332A.

12. The approximate annual turnover for goods and services provided under the mark is stated to be:

2009	£900,000
2010	£923,000
2011	£866,000
2012	£865,000
2013	£915,000

These figures are not broken down as to class or types of goods or services, although I note that Ms Mulhern states that the mark THE WILLOW TEA ROOMS has been extensively used in the UK in relation to the primary services of the provision of food and drink, since 1 December 1983, at the Sauchiehall Street tea room and, since 1997, at the Buchanan Street tea room. Ms Mulhern estimates that 70% of customers to her tea rooms come from outside Glasgow (including all over the UK). The majority of the large number of groups which she caters for come from outside of the UK. Ms Mulhern supports her estimation by filing Exhibit AM02, which is a schedule of bookings from the 2014 and 2015 diaries, although she notes that the vast majority of customers do not book in advance, but simply arrive on the day. Ms Mulhern states that, given the connection with Charles Rennie Mackintosh of 217 Sauchiehall Street, her tea rooms are popular visitor attractions and have been used as venues for numerous exhibitions, educational services, talks and tours. These include exhibitions by Glaswegian artists Tom Gardner and Archie Forrest in 2012 and 2013. The other exhibitions mentioned by Ms Mulhern are undated, as are the talks to which she refers.

13. Ms Mulhern states that her need to advertise THE WILLOW TEA ROOMS is minimal, but she does undertake some paid advertising. This is primarily in a magazine called FOODIES; also, in relation to the Dynasty Ball; in the Glasgow 'Dinearound' 2012 publication; in the Entertainment Awards brochure; the No 1 Magazine; and the Scottish Field publication. Exhibit AM03 comprises an example of the advertising associated with the Dynasty Ball. It is not possible to date the advertisement. The average annual advertising expenditure in the last eight years for goods and services provided under the mark THE WILLOW TEA ROOMS is approximately £3000. These figures include the costs of web hosting, domain name registrations, website maintenance, and subscriptions to Glasgow's Leading Attractions, Glasgow Mackintosh and Visit Scotland Guides. Ms Mulhern states that her tea rooms have featured in the BBC's "Great British Railway Journeys" television programme, which she states is frequently repeated on BBC2. Exhibit AM04 includes a copy of an article dated 15 June 2015 in the Evening Times. Ms Mulhern states that the article refers to the Sauchiehall Street and Buchanan Street tea rooms, and also to a pop-up tea room operated on the shores of Loch Lomond for the summer season of 2015 (6 months) under the name THE WILLOW TEA ROOMS. I note that the pop-up tea room does not appear to have been called THE WILLOW TEA ROOM, but the article does refer to Ms Mulhern's business under that name:

"The two passions of businesswoman Anne Mulhern came together more than 30 years ago when she opened the Willow Tea Rooms in Sauchiehall Street, Glasgow, painstakingly recreating the dazzling Room de Luxe run by Kate Cranston at the start of the 20th century.

Now she has opened a pop-up tea room, Mackintosh on the Loch, at Loch Lomond shores, tapping into the artist's great love of nature and the nation's enthusiasm for drinking tea."

14. Another article contained in Exhibit AM04 is from the July 2015 edition of the Scottish paper The Sunday Herald. It appears to be a personal interview with Ms Mulhern in which she talks about her love of the style of Charles Rennie Mackintosh as inspiration for the décor in her own home. The article includes the following:

“I took redundancy from the Wills cigarette factory and when I started looking at what I wanted to do for a job, I approached Henderson The Jewellers about coming in to have a Mackintosh tea room in Sauchiehall Street.

...

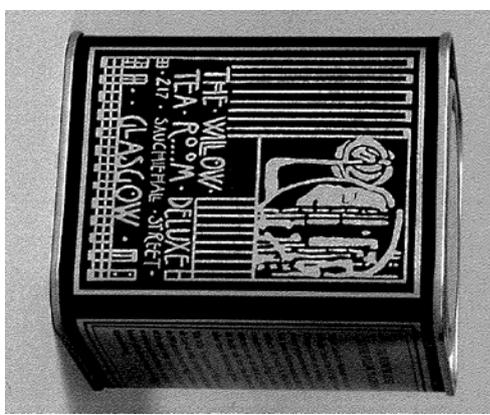
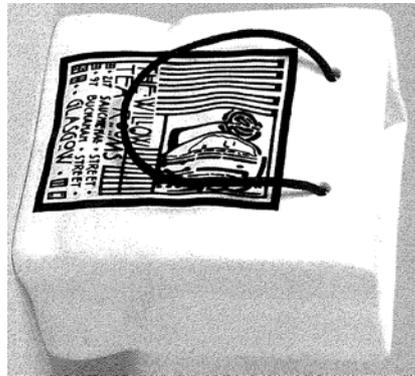
I had the Willow Tea Rooms on Sauchiehall Street tea rooms first then I got the property on Buchanan Street and we were looking to furnish that”.

15. The end of the article includes the following:

“Willow Tea Rooms has a pop-up tea room at Loch Lomond Shores until the end of October 2015 www.willowtearooms.co.uk/loch-lomond-shores.”

16. Ms Mulhern states that THE WILLOW TEA ROOMS are the only Scottish tea rooms to feature in the Sunday Times Top 20 best spots for tea in the United Kingdom. Exhibit AM05 comprises a copy of a feature on the website ‘glasgowsleadingattractions.co.uk’ about THE WILLOW TEA ROOMS. This was printed in June 2016. Ms Mulhern states that THE WILLOW TEA ROOMS are members of the Association of Visitor Attractions and features on the Association’s website. The tea rooms also feature on the websites of Visit Scotland and the Glasgow City Marketing Bureau, and in the Visit Scotland Glasgow & Clyde Valley brochure.

17. Exhibit AM06 contains a list of goods in relation to which THE WILLOW TEA ROOMS has and continues to be used: tea cosies, ceramic bag ornaments, tea towels, oven gloves, mugs, cards and postcards, wrapping paper, tea caddies, aprons, tea trays and bags. The mark either appears on the label or on the item itself, according to the list. Exhibit AM07 comprises photographs which are said to show images of the goods. The reproductions in this exhibit are of poor resolution and some are impossible to make out. If any of them represent cards or wrapping paper, they have not been identified, but these do appear on the list. The better photographic examples are shown here:





18. Ms Mulhern states that THE WILLOW TEA ROOMS branded goods are also sold at third party outlets, such as museums in Glasgow, the University of Glasgow and Visit Scotland venues across Scotland, various art galleries in Glasgow, and Mackintosh-related buildings in Glasgow, and one in England (in Northampton). Ms Mulhern states that she also sells the goods via her online shop under the mark THE WILLOW TEA ROOMS.

19. Ms Mulhern also gives details of catering student sponsorship and charitable fundraising, although none of these services are relied upon under any of the three grounds of opposition, and no dates are given.

20. Ms Mulhern states that since the applicant has terminated her lease at 217 Sauchiehall Street, she is moving that tea room to alternative premises in the same street, but will continue to trade under the mark THE WILLOW TEA ROOMS from the new premises. According to Ms Mulhern, she is aware of many instances of confusion between her business and the applicant, typically on a daily basis. Exhibit AM08 comprises a copy of an email that she received, by mistake, from the applicant's solicitors, which was intended for the applicant.

The applicant's evidence

21. Stewart Brown is a trustee of the applicant. His witness statement is dated 12 July 2016.

22. Mr Brown explains that he is an architect and founding partner of the Edinburgh architectural and archaeological firm of Simpson & Brown; he is a Board Member of The Friends of The National Galleries of Scotland, and he has also, in the past, been

Chairman of the Traverse Theatre, Edinburgh; Trustee of the Mansfield Traquair Trust, Edinburgh; and a Trustee of Scotland's Churches and Trust and the Scottish Churches Architectural Heritage Trust.

23. Mr Brown states:

"2. The Applicant was established in 2014 as a charity with the aim of acquiring The Willow Tea Rooms at 217 Sauchiehall Street, Glasgow. Its formal objective is to restore the building to Charles Rennie Mackintosh's 1903 design whilst ensuring its preservation for subsequent generations. The Applicant acquired ownership of the building at 217 Sauchiehall Street, Glasgow in 2014. The reason that such building was acquired by the Applicant is its connection with Charles Rennie Mackintosh, who was commissioned by the tenant of the building, Miss Cranston, in 1903 to convert the building into a suite of tea rooms.

3. Charles Rennie Mackintosh designed not only the exterior of the building, but also its internal decoration and furnishings. As the building was in Sauchiehall Street, which was named after the Gaelic for "Alley of the Willows" Mackintosh took that as his theme for the design and, as Miss Cranston operated the suite of tea rooms in the building (under the name "Miss Cranston's Tea Rooms") the building was known and referred to as "The Willow Tea Rooms".

4. It is argued by the Opponent that the building was not known as "The Willow Tea Rooms" until 1 December 1983 when the Opponent opened a business under that name in the building. That is not correct. The building at 217 Sauchiehall Street, Glasgow has been known as "The Willow Tea Rooms" since Charles Rennie Mackintosh re-designed it in 1903.

...

9. The Applicant terminated the lease of the Opponent's company at 217 Sauchiehall Street to allow a major refurbishment of the building, which will

take place over a two-year period. The intention is to restore the building to its original condition. The Charles Rennie Mackintosh Society (an independent, non-profit making charity, which was established in 1973 to promote and encourage awareness of Charles Rennie Mackintosh) has agreed to be based at the building.”

24. Mr Brown exhibits extracts from six publications¹:

(i) Dekorative Kunst design magazine, 12 April 1905, published in German. There is a photograph within the magazine article which shows the façade of the building, but no signs. The photograph is labelled “Willow Tea House unterer teil der fassade”. A translation of the article is provided (which may have been made around the time of the article itself):

“To-day any visitor to Glasgow can rest body and soul in Miss Cranston’s tea rooms, which have been decorated with the utmost discrimination, and for a few pence, drink tea, have breakfast and dream that he is in fairy land: and the wizard whom the good fairy summoned to create this world was C.R.M.”

The article goes on to describe the works undertaken at the ‘Willow’. The architect mounted willow and swallow symbols at the two corners: “The willow motif for the tea room was inspired by the name of the street in which it stood, and C.R.M. maintained this emblem throughout the building.”

(ii) a publication from 1952 called ‘Charles Rennie Mackintosh and the Modern Movement, by Thomas Howarth. A chapter entitled ‘The Glasgow Tea-Rooms’ contains a section called ‘The Willow Tea-Rooms, 1903-4’. The writer refers to the building as ‘*The Willow*’ and explains that the inspiration for the décor came from the name Sauchiehall, old Scots for street of the willows. The article refers to the Willow pattern tea service used in the Room de Luxe. The writer explains, at the end of his article, that Miss Cranston sold the

¹ Exhibit WT01

Willow Tea-Rooms to Messrs Smith, restaurateurs in 1919, who renamed the premises as *The Kensington*.

(iii) a publication from 1968 called 'Charles Rennie Mackintosh', by Robert McLeod. There is a photograph of the façade of 'The Willow Tea-rooms', but no signage appears on the building. The author refers to Ms Cranston's collaboration with Mackintosh as the 'Willow tea-rooms' and describes the interior as having been detailed as an elaborate play on the willow-tree form.

(iv) a publication from 1977 called 'Charles Rennie Mackintosh as a designer of chairs', by Fillipo Alison, originally published in Italian. There are references to chairs for the Willow Tearooms in 1904.

(v) a publication from 1978 called 'Mackintosh Architecture, published by Academy Editions, London, edited by Jackie Cooper. There is a chapter called 'The Willow Tea Rooms'. This publication refers to the *Dekorative Kunst* magazine article, as does publication number (ii), as containing an article on the 'Willow Tea Rooms'.

(vi) from 1978, the front page of what appear to be drawings (although these are not shown) for 'The Willow Tea Rooms' in Sauchiehall Street.

25. It is Mr Brown's contention that "the goodwill in the name 'The Willow Tea Rooms' "is associated with the building itself and not the business carried on there." He says:

"[13] The Opposition is not about the right of the Opponent in terms of the registered trade mark no 2251332A, but about goodwill outside the scope of that registered mark which arises from the building itself and it is *that* goodwill which it is sought to protect through the Application."

Mr Brown exhibits screenshots from various websites², including Ms Mulhern's website, willowtearooms.co.uk, which he states make reference to 'The Willow Tea Rooms' in a context which clearly refers to the building and not the business carried on inside the building. A page from a taxi tours website refers to the Willow Tearooms, Sauchiehall Street. This was, presumably, printed at the time of Mr Brown's statement.

26. James Macauley is also a trustee of the applicant. His witness statement is dated 15 July 2016. It largely resembles that of Mr Brown in terms of wording and content (although it refers to the publications, they are not exhibited to Mr Macauley's statement). Mr Macauley was formerly a senior lecturer at the Mackintosh School of Architecture in Glasgow and he is an Honorary Research Fellow at the University of Glasgow. He was formerly a Chairman of the Society of Architectural Historians of Great Britain and the Architectural Heritage Society of Scotland. Mr Macauley is a trustee of the Glasgow Art Club, Medieval Glasgow Trust, the Dalrymple Donaldson Fund and the Chairman of the Society of Friends of Glasgow Cathedral. He has written books on architecture and design, including the Gothic Revival, 1745-1845; The Classical Country House in Scotland, 1660-1800; Hill House; and Glasgow School of Art, Charles Rennie Mackintosh. Mr Macauley states that he is considered to be an authority on the works and life of Charles Rennie Mackintosh.

27. Mr Macauley says:

"It is my view that the goodwill in the name "The Willow Tea Rooms" is associated with the building, not the business in it. Otherwise, it would not have been referred to as "The Willow Tea Rooms" from its first design by Mackintosh when the business operated from it was very clearly known as "Miss Cranston's Tea Rooms". If the Opposition is successful, implying that the building which has been known since 1903 as "The Willow Tea Rooms" cannot be called that, this will cause total and utter confusion in the minds not only of admirers of the works of Charles Rennie Mackintosh, but to the

² Exhibit WT02.

general members of the public in Glasgow and the surrounding area who have always known the building by that name.”

28. The applicant has also filed a witness statement by Scott McEwan, who was working for the applicant’s solicitors when the mistaken identity emails (referred to my Ms Mulhern) were sent. Mr McEwan explains how the mistake came about. I will not summarise his evidence because the mistake made in dealing with parties located in the same building is of limited assistance to my determination of the issues in these proceedings.

Ms Mulhern’s evidence in reply

29. Ms Mulhern’s second witness statement is dated 23 September 2016; it contains submissions and criticisms of the publications relied upon by the applicant, and some factual content. Ms Mulhern considers neither Mr Macauley’s nor Mr Brown’s evidence to be independent, because they are trustees of the applicant. She considers that their statements represent their own opinions rather than credible evidence that the building at 217 Sauchiehall Street is known as the Willow Tea Rooms building. She says:

“[7.] In his Statement, Mr Macauley notes that Miss Cranston operated a suite of tea rooms at 217 Sauchiehall Street under the name “Miss Cranston’s Tea Rooms”, which is correct. However, Mr Macauley’s statement that “...the building was therefore known and referred to as the Willow Tea Rooms” is a *non sequitur*, is factually incorrect and is not supported by any evidence whatsoever.

...

19. Mr Brown states on one hand that Miss Cranston’s tea room business operated from the building at 217 Sauchiehall Street as “Miss Cranston’s Tea Rooms”, and then goes on to states [sic], completely without foundation, that the building was somehow known as THE WILLOW TEA ROOMS. There is no evidence to support this statement. Further, it would make no commercial sense for Miss Cranston to open and operate a tea room business under the

name “Miss Cranston’s Tea Rooms” in a building allegedly called “The Willow Tea Rooms”. Had the building been known as “The Willow Tea Rooms”, surely the logical conclusion is that Miss Cranston would have named her business “The Willow Tea Rooms”. The evidence shows that she did not. I understand why the Trust wished to acquire the building at 217 Sauchiehall Street, given its connections with Charles Rennie Mackintosh, but there is no reason whatsoever for the Trust to be allowed to hijack my trade mark THE WILLOW TEA ROOMS to give the building a name, nor for it to allege that my trade mark, which I have worked long and hard to develop is somehow associated with the building that houses one branch of my THE WILLOW TEA ROOMS tea rooms, and not my tea room business.”

30. Ms Mulhern states that she has relocated her tea rooms under the mark THE WILLOW TEA ROOMS to 119 Sauchiehall Street; therefore, the mark continues to be in use, despite the fact that the applicant has terminated her lease at 217 Sauchiehall Street.

Decision

Proof of use

31. Section 6A of the Act states:

“(1) This section applies where—

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if—

(a) within the period of five years ending with the date of publication of the application 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) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) 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, and

(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.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) 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.

(7) Nothing in this section affects—

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

32. The enquiry under section 6A of the Act is identical to that set out under section 46, the part of the Act which deals with the issue of revocation on the grounds of non-use, because both sections 6A and 46 relate to genuine use of a mark. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

[218] ...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-*

Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky' [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

33. The onus is on Ms Mulhern to show use because Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

34. There is no use of registration 1276805 (‘Willow’) as a mark by itself. Ms Mulhern makes no reference to it in her evidence, nor is any reference made to this mark in any of the submissions filed on her behalf. The whole thrust of Ms Mulhern’s

case is directed to use of THE WILLOW TEA ROOMS. The addition of TEA ROOMS arguably means that the mark differs in elements which alter the distinctive character of the mark in the form in which it was registered. However, I find that I do not need to decide the point, because 1276805 is registered for services which are encompassed by the other earlier mark relied upon, the stylised series of 8 marks for THE WILLOW TEA ROOMS.

35. Use of the mark must be by the proprietor or with his consent. The applicant takes a point that it is a company called Willow Tea Rooms Limited and not Ms Mulhern who has used the mark. That may become relevant in an assessment as to ownership of goodwill. However, given that Ms Mulhern owns the registration, is the sole director of the company, and has given evidence herself to this effect, it is clear to me that if genuine use is shown, such use has been with Ms Mulhern's consent.

36. The applicant concedes that a business has been carried out at 217 Sauchiehall Street, but does not say of what that business consists. The applicant queries whether there has been use of any or all of the stylised forms registered as a series of marks. I will come on to consider the form of the marks as registered and used, but will firstly assess the use of THE WILLOW TEA ROOMS in relation to the goods and services which are registered under number 2251332A. The relevant period for proof of use is the five year period ending on the date on which the opposed application was published; i.e. 27 June 2010 to 26 June 2015.

37. In *Plymouth Life Centre*, O/236/13 Mr Daniel Alexander QC, sitting as the appointed person, observed that:

“20. Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time to review the material that it has to prove use of it.

...

The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is

likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

38. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller-General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There

can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

39. It is important to remember that an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself³.

40. I am satisfied that the evidence shows that tea room services have been provided in the relevant period, as supported by the turnover figures, the schedule of table bookings, the featuring of the tea rooms on BBC2, the article in the Evening Times, the inclusion in the list of the Sunday Times Top 20 best spots for tea, and the applicant’s own evidence referring to the inclusion of a visit to THE WILLOW TEA ROOMS on a taxi tour of Glasgow. I need to decide whether the use shown entitles Ms Mulhern to rely upon the full scope, or only some, of the services in class 43 for which the series of marks is registered. The services for which the mark is registered in class 43 are:

Catering services for the provision of food and beverages; preparation of food and beverages; tea-room, coffee shop, cafe, brasserie, bistro, restaurant, cafebar, bar, hotel and catering services; hospitality services; information, advice and assistance relating to the aforesaid services.

³ Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (“OHIM”) General Court (“GC”).

41. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, stated:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

42. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply

because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

43. There is no evidence of catering services or the provision of alcohol. Bearing the above guidance in mind, I find that Ms Mulhern is entitled to rely upon the following services in class 43 for the ground under section 5(2)(b) of the Act:

Tea-room, coffee shop, café and restaurant services; information, advice and assistance relating to the aforesaid services.

44. The evidence in relation to the class 43 services represents the high point of Ms Mulhern's case. There is little evidence of use in relation to goods. There is no use shown in relation to the goods registered in class 30:

Tea; coffee; cocoa; drinking chocolate; sugar; flour and preparations made from cereals; bread; pastry and confectionery; homebaking; shortbread; tablet; sauces; ice cream.

It is not enough to rely upon use on the class 43 services to cover the goods in class 30⁴ (not that any such claim or submission has been made). Nor is any evidence provided in relation to the goods registered in classes 9, 11 or 20:

Class 9: Audio and video recordings on disc, tape, video, cassette, CDs, CD ROM's and other recording media; computer software; electronic publications; publication supplied on-line from a database or from facilities provided on the Internet or another network (including websites).

Class 11: Lighting apparatus; lighting installations; lamps; lamp bases; cooking appliances; cooking installations.

Class 20: Furniture; mirrors; picture frames; chairs; tables; sideboards; serving tables; cushions; curtains; hat stands; coat stands; umbrella stands; shelves; dining room furniture; kitchen furniture; blinds; picture frames.

45. The goods registered in the other classes (16, 21 and 24) are as follows:

Class 16: Printed material; postcards; photographs; cards; greeting cards; calendars; posters; art prints; framed art prints; graphic prints; graphic reproductions; pictures; paintings; story boards; wall charts; maps; printed publications; books; picture books; albums; bookmarks; periodical publications; magazines; stamps; catalogues; paper bags; stationery; notebooks; diaries; writing and drawing instruments and materials; pens; pencils; playing cards; paper weights; matchbooks; paper knives; menus; placemats; placecards; paper table linen; paper table mats; paper table cloths; paper doilies; paper napkins.

Class 21: Household and kitchen utensils and containers; unworked or semi worked glass; glassware; porcelain; earthenware; ceramics; crockery; teapots; teacups; tea saucers; tea plates; teaspoons; tea services; tea caddies; tea strainers; tea glasses; jugs; sugar bowls; coffee pots; cafetieres;

⁴ Mr Iain Purvis, sitting as the Appointed Person, in *Happy Sandwiches*, BL O/ O/181/14.

coffee percolators; coffee cups; coffee saucers; coffee spoons; coffee services; Irish coffee glasses; cups; mugs; china mugs; drinking glasses; dishes; plates; bowls; cruets; cutlery; coasters; candlesticks; cooking utensils; cake stands; food containers; china bags; china bags for holding tea; soapdishes; trays; spoon rests; vases.

Class 24: Textiles and textile goods; table linen; tablecloths; table mats; table napkins; table runners; cloth bags; tea towels; dish towels; hand towels; face towels; cushion covers; wall hangings.

46. I summarised the evidence in relation to goods at paragraphs 17 and 18 of this decision. There is a distinct lack of evidence to support the statement of use made in respect of the goods registered in classes 16, 21 and 24. Ms Mulhern refers to an online shop, but there are no exhibits to support this and no examples of how the mark may appear on such a website, or in relation to the goods as opposed to a retail service. To add to the problems, the exhibits, intended to show use of THE WILLOW TEA ROOMS on the goods, are poorly reproduced. Ms Mulhern states that the branded goods are also sold at third party outlets, such as tourist locations and museums in Scotland (and one in England). The goods are all decorated in Mackintosh style, and I do not doubt that tourist locations and museum shops would sell such goods. I am prepared to accept that there is use in relation to the goods listed in Exhibit AM06, described in paragraph 17 of this decision. However, the scope of such use is much narrower than the goods for which Ms Mulhern has a trade mark registration. The narrow scope of use means that a fair specification will lean more towards specific goods rather than categories of goods. If use has been made on more goods than those listed, there is no evidence of it. Applying the guidance cited above, I find that Ms Mulhern may rely upon the following goods for the opposition for the ground under section 5(2)(b) of the Act:

Class 16: Postcards, cards, greetings cards, wrapping paper.

Class 21: Ceramics, tea caddies, trays, mugs.

Class 24: Cloth bags; tea towels.

47. Although the evidence shows use on aprons, these are proper to class 25, which does not form part of the registration. Aprons cannot be relied upon for the section 5(2)(b) ground. Oven gloves and tea cosies, which are proper to class 21, are also shown in the evidence but, although Ms Mulhern's registration covers some goods in class 21, none of the terms in her registered specification cover either oven gloves or tea cosies. Consequently, these terms cannot be relied upon for the section 5(2)(b) ground.

48. The evidence shows use on cloth bags and PVC bags. These items are proper to class 18, which is not covered by the registration. I note, however, that Ms Mulhern's list of goods registered in class 24 covers 'cloth bags'. Classification is an administrative process which should not affect the owner's rights provided that the owner has accurately described the goods and has not limited them by adding a "falling in this class" type of limitation, which is not an issue here. Provided that 'cloth bags' accurately describes the product shown in the evidence, it does not mean that because the registrar accepted the term in class 24 instead of class 18 that Ms Mulhern cannot rely upon those goods. 2251332A is a national registration and, so far as UK marks are concerned, the registrar's classification decision is final (section 34(2)). Therefore, I will take the description 'cloth bags' and give it its normal and natural meaning unhampered by classification.

49. The last issue to be considered is the form of the series of marks as registered and as used. The series of marks comprising registration number 2251332A is:

THE WILLOW
TEA ROOMS

THE WILLOW TEA ROOMS

THE WILLOW
TEA ROOM

THE WILLOW TEA ROOM

THE WILLOW
TEAROOMS

THE WILLOW TEAROOMS

THE WILLOW
TEAROOM

THE WILLOW TEAROOM

50. The slight difference between the two sets of four marks is that the words ‘tea’ and ‘rooms’ are coalesced in the second set of four marks. I note that in *Comic Enterprises Ltd v. Twentieth Century Fox Film Corporation*⁵, Kitchin LJ stated, at paragraph 66:

“An application for the registration of a series of trade marks is an application to register a bundle of trade marks under a single reference number. Each of the marks in the series must satisfy the requirements of the 1994 Act. If the application is accepted and any opposition proceedings have been resolved in favour of the applicant, then the series of marks will be registered, but it will

⁵ [2016] EWCA Civ 455

remain what it always was, namely a bundle of different marks, albeit now registered under the same reference number.

51. My task is to assess whether the use shown satisfies the requirements of section 6A(4) of the Act, in respect of any or all of the marks registered as a series of eight. The applicant says that it does not.

52. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

53. Although this case was decided before the judgment of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered.

54. In *Hypen GmbH v EU IPO*, Case T-146/15, the General Court ("GC") held that use of the mark shown on the left below constituted use of the registered mark shown on the right. The court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered.



55. The court set out the following approach to the assessment of whether additional components are likely to alter the form of the registered mark to a material extent.

“28. ..a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, *ATLAS TRANSPORT*, T-482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, *Maestro de Oliva*, T-4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, *Borrajo Canelo v OHIM — Tecnoazúcar (PALMA MULATA)*, T-381/12, not published, EU:T:2014:119, paragraph 30).

29 For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, *Klement v OHIM — Bullerjan (Form of an oven)*, T-317/14, not published, EU:T:2015:689, paragraph 33).

30 It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, *Sabores de Navarra v OHIM — Frutas Solano (KIT, EL SABOR DE*

NAVARRA), T-46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31 It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, *Fruit of the Loom v OHIM — Blueshore Management (FRUIT)*, T-514/10, not published, EU:T:2012:316, paragraph 38).”

56. These findings indicate that the relative distinctiveness of the registered mark and the components added to (or omitted from) it in use are relevant factors to take into account in the required assessment. In this instance the addition of a circle around the registered mark was not sufficient to alter the distinctive character of the registered mark.

57. The marks appearing on the goods, shown in paragraph 17 of this decision (except for the plate), are either the same as, or closely resemble, the second mark in the series. The distinctive character of the mark lies firstly in the words, and secondly in their stylisation (in the style of Mackintosh), most noticeably the way in which the word ‘Rooms’ appears. Where there is any difference, such as the presentation of the LL (in Willow) or the cross-bars on the letters (e.g. H and E), these do not alter the distinctive character of the mark in the form in which it was registered. I say this because (a) none of the slight alterations mean that the words, which are the same, appear any different to the words in the registered mark; (b) the relative position of the different components within the arrangement of the trade mark do not appear different; and (c) because the mark is distinctive, minor stylistic alterations have less of an effect on the distinctive character of the mark and its perception as an indication of the origin of the goods and services. One would have to analyse the marks very closely indeed to spot the difference; something which the average consumer does not do.

58. The evidence relating to the class 43 services appears in plain script because it is mostly evidence of press narrative referring to the name of the tea rooms or is within Ms Mulhern's statement. However, considering the goods are sold within the tea rooms, as merchandise, it is a reasonable assumption that the way in which the mark appears on the goods replicates the form of use in relation to the class 43 services. Even if I considered the used mark to be just the words WILLOW TEA ROOMS, the stylisation of the words in the marks registered under 2251332A is not sufficiently distinctive that its absence from the used mark alters its distinctive character, which is overwhelmingly concentrated in the words.

59. I find that Ms Mulhern may rely upon earlier mark 2251332A in respect of the following goods and services:

Class 16: *Postcards, cards, greetings cards, wrapping paper.*

Class 21: *Ceramics, tea caddies, trays, mugs.*

Class 24: *Cloth bags; tea towels.*

Class 43: *Tea-room, coffee shop, café and restaurant services; information, advice and assistance relating to the aforesaid services.*

Section 5(2)(b) of the Act

60. 5(2)(b) of the Act states:

“(2) A trade mark shall not be registered if because –

(a) ...

(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.”

61. 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

62. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“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.”

63. ‘Complementary’ was defined by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“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...”.

64. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

65. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... 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."

66. The goods and services to be compared are:

Earlier mark	Application
<p>Class 16: <i>Postcards, cards, greetings cards, wrapping paper.</i></p> <p>Class 21: <i>Ceramics, tea caddies, trays, mugs.</i></p> <p>Class 24: <i>Cloth bags; tea towels.</i></p> <p>Class 43: <i>Tea-room, coffee shop, café and restaurant services; information, advice and assistance relating to the aforesaid services.</i></p>	<p>Class 35: <i>Organisation of commercial exhibitions; business research services; all relating to architecture, design and urban studies; promotional services relating to cultural events and activities.</i></p> <p>Class 41: <i>Organisation, arrangement and conducting of courses, seminars, conferences, workshops, conventions, events and exhibitions for commercial or advertising purposes; organisation of exhibitions for cultural and educational purposes; provision of museum and gallery services; arranging and conducting of conferences, congresses, seminars, symposia, workshops, events and exhibitions; provision of training services in relation to design and architecture; corporate hospitality services; publication of education materials; library services; all relating to architecture, design and urban studies.</i></p> <p>Class 42: <i>Architectural services; building and interior design services; industrial design services; graphic arts design services; product design services.</i></p> <p>Class 43: <i>Providing facilities for exhibitions; rental of accommodation for conference and events; provision of facilities for parties, banquets and weddings; rental of chairs and tables; rental of meeting rooms.</i></p>

67. None of Ms Mulhern's goods in classes 21 and 24 are similar to any of the applicant's services.

68. There is no similarity between the earlier goods and services and the applicant's services in classes 35, 41 and 42, with the exception of corporate hospitality services in class 41, which I deal with below. No submissions have been made by Ms Mulhern as to where similarity may lie, and why.

69. The applicant's class 43 services are *providing facilities for exhibitions; rental of accommodation for conference and events; provision of facilities for parties, banquets and weddings; rental of chairs and tables; rental of meeting rooms*. Applying the authorities cited above, none of Ms Mulhern's goods or services are similar to the applicant's *rental of accommodation for conference and events; rental of chairs and tables; rental of meeting rooms*. There is some similarity between the applicant's *provision of facilities for parties, banquets and weddings* in class 43, *corporate hospitality services* in class 41 and Ms Mulhern's *restaurant services*. It is common to hold such events in restaurants, so the channels of trade coincide, as do users and methods of use in making a booking. Nature and purpose are also similar in that both parties' services provide a venue at which people may assemble to eat and drink. These services are similar to a good degree.

70. There is a low level of similarity between Ms Mulhern's class 43 services and the applicant's *providing facilities for exhibitions*. The premises at which an exhibition is held is likely to include café/restaurant facilities. The applicant's services are aimed at providing facilities for those wishing to put on an exhibition, and their choice of facility provider or venue may be influenced by the café/restaurant services. There is an element of complementarity and shared channels of trade.

The average consumer and the purchasing process

71. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention

is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

72. The average consumer for Ms Mulhern's goods and services is the general public, who are likely to pay an average degree of attention to the class 43 services. The purchasing process will be overwhelmingly visual. The average consumer for e.g. the applicant's museum and gallery services, library services and facilities for parties, banquets and weddings will be the general public. The average consumer for the applicant's other services will be businesses and academics. The level of attention paid by both sets of consumers is likely to range from reasonable to a good level of attention, depending on the expense involved and the importance of the purchase. For example, time, money and energy are involved in choosing corporate hospitality services because the purchaser wishes to make a good impression on those receiving hospitality; but less attention will be paid in selecting restaurant services. Owing to the prevalence of websites for modern service providers, the purchasing process is likely to be visual as websites will be consulted. I do not discount the possibility, though, that there may be an aural element to the purchasing process.

Comparison of marks

73. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

74. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

75. Bearing in mind that I found the second mark in the series to be an acceptable variant under section 6A(4) of the Act, the comparison is to be made between the following:

Earlier mark	Application
THE WILLOW TEA ROOMS	THE WILLOW TEA ROOMS

76. Both marks share identical distinctive and dominant elements: the words THE WILLOW TEA ROOMS. They are aurally and conceptually identical. The application has been made in block capitals, which covers use in other fonts. However, notional and fair use of the later mark would not extend to the particular style of the letters in the earlier mark. The marks are clearly highly similar to look at, comprising identical words, in the same order, with no additional word or device elements. The marks are virtually identical.

Distinctive character of the earlier marks

77. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁶ the CJEU stated that:

“22. 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

⁶ Case C-342/97

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, judgment 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).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

78. The evidence could have been better marshalled to have enabled me to take a view as to whether the distinctive character of the mark has been enhanced by the use that has been made of it. I find that Ms Mulhern’s trade mark is inherently distinctive to a reasonably high degree. The mark does not describe any aspect of the goods or services. It is the only Scottish tea room to feature in the Sunday Times Top 20 best spots for tea in the UK. Ms Mulhern’s evidence is that 70% of her customers come from outside of Glasgow and the majority of the larger groups from outside of the UK. This is suggestive of (at least) a UK tourist attraction, rather than a merely local business. In respect of tearoom, coffee shop and café services, the mark is highly distinctive.

Likelihood of confusion

79. A lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). However, where there is no similarity between goods or services, neither similarity between the marks nor a high

degree of distinctive character in the earlier mark will help Ms Mulhern's case. The CJEU said in *Waterford Wedgwood plc v OHIM*, Case C-398/07:

“35 It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in *Canon*. However, it cannot be alleged that the Court of First Instance did not take into account the distinctiveness of the earlier trade mark when carrying out that assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

80. Consequently, there is no likelihood of confusion in respect of the following services in the application, for which the section 5(2)(b) ground fails:

Class 35: Organisation of commercial exhibitions; business research services; all relating to architecture, design and urban studies; promotional services relating to cultural events and activities.

Class 41: Organisation, arrangement and conducting of courses, seminars, conferences, workshops, conventions, events and exhibitions for commercial or advertising purposes; organisation of exhibitions for cultural and educational purposes; provision of museum and gallery services; arranging and conducting of conferences, congresses, seminars, symposia, workshops, events and exhibitions; provision of training services in relation to design and architecture; publication of education materials; library services; all relating to architecture, design and urban studies.

Class 42: *Architectural services; building and interior design services; industrial design services; graphic arts design services; product design services.*

Class 43: *Rental of accommodation for conference and events; rental of chairs and tables; rental of meeting rooms.*

81. The marks are very similar and Ms Mulhern's mark is high in distinctive character. The conceptual hook for the memory is identical. Notwithstanding an above average level of attention on the part of the average consumer and a lower level of similarity between Ms Mulhern's services and *providing facilities for exhibitions*, I find that there is a likelihood of direct confusion in relation to *corporate hospitality services* (Class 41) and *providing facilities for exhibitions; provision of facilities for parties, banquets and weddings* (Class 43). The opposition under section 5(2)(b) succeeds against these services.

Section 5(4)(a) of the Act

82. Section 5(4)(a) states:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

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

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark."

83. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based

on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.”

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

84. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have

acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

Goodwill

85. Ms Mulhern needs to show that she had goodwill at the relevant date, sufficient to have been able to have prevented the applicant, at that date, from using its mark under the law of passing-off. The applicant has made some statements and submissions about goodwill; namely that it is the building at 217 Sauchiehall Street which has goodwill associated with the sign; and that if there is any goodwill associated with the tea room business, it is owned by Willow Tearooms Limited and not by Ms Mulhern.

86. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margerine Ltd* [1901] AC 217 at 223 (my emphasis):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates.”

In the same case, Lord Lindley said:

“Goodwill regarded as property has no meaning except in connection with some trade, business, or calling. In that connection I understand the word to include whatever adds value to a business by reason of situation, name and reputation, connection, introduction to old customers, and agreed absence from competition, or any of these things, and there may be others which do not occur to me. In this wide sense, goodwill is inseparable from the business to which it adds value, and, in my opinion, exists where the business is carried on. Such business may be carried on in one place or country or in several,

and if in several there may be several businesses, each having a goodwill of its own.”

87. Therefore, goodwill is generated by trade, or custom, and is capable of being owned. It is a type of property and passing off is a wrongful invasion of it. The applicant’s position is that the building itself has goodwill. It seems to me that the building might have a reputation amongst those who know of its heritage, but that is different to goodwill. That there is a difference between goodwill and reputation was explained by Professor Christopher Wadlow, in *The Law of Passing-Off: Unfair Competition by Misrepresentation*, 5th Edition:

“Goodwill as a form of legal property is also to be distinguished from mere reputation, which is primarily a matter of fact. In so far as reputation may be a legally protected interest, it is a non-proprietary one. It is true that the two are very closely related, and a business with goodwill (at least in the sense in which the term is used in passing-off) can hardly fail to have a reputation in some sense. The converse, however, is not true, and the existence of a reputation associated with a person, product, name or mark does not necessarily imply the existence of goodwill:

“[T]hat, as it seems to me, is to confuse goodwill, which cannot exist in a vacuum, with mere reputation which may, no doubt, and frequently does, exist without any supporting local business, but which does not by itself constitute a property which the law protects.” [Oliver LJ in *Anheuser-Busch v Budejovicky Budvar* [1984] FSR 413]”

...

Though most formulations of passing-off at the highest level have defined the tort in terms of the invasion (by misrepresentation) of a property right in the claimant’s *goodwill*, others have identified the claimant’s business *reputation* as the right or interest protected. In the majority of cases, the precise formulation of the tort in terms of business, goodwill or reputation need not affect the final outcome. In others, however, the distinction between goodwill,

as a form of legal property properly so called, and reputation, as a non-proprietary protected interest at most, is crucial.”

88. Reputation can exist without a supporting business, but goodwill can only exist via business or trade: in *Star Industrial Co Ltd v Yap Kwee Kor* [1976] FSR 256, at 269, Lord Diplock explained that “[g]oodwill, as the subject of proprietary rights, is incapable of subsisting by itself”, having “no independent existence apart from the business to which it is attached”. In BL O/196/14 (‘Just Cool By Awdis’), Mr Iain Purvis Q.C., sitting as the Appointed Person, observed:

“31. So far as passing off is concerned, goodwill must be associated with a ‘business’ or something akin to a business. The important thing about sales figures is that they provide concrete evidence both of the existence of a real business and of the scale of that business. I accept that it may be possible to generate goodwill in a business even before sales are actually made, but it is likely to be transient and weak (even in the fashion industry). Goodwill is the ‘attractive force that brings in custom’. If there is no custom because there is nothing to buy, it will soon wither and die.”

89. A building *per se* cannot have goodwill because goodwill can only exist if there is something to buy, to generate custom, as observed by Dillon LJ in *Lonrho Plc v Fayed (no. 5)* [1993] 1 W.L.R. 1489 (my emphasis):

“To prove loss of orders and loss of trade is another matter that is recognisable pecuniary damage. Such loss of orders, for example, would involve injury to the goodwill of a business which may be one of the most important assets of the business. But goodwill in that sense must have the meaning put on that word in *Trego v Hunt* ... see especially, per Lord Herschell..., and per Lord Macnaghten It cannot mean some airy-fairy general reputation in the business or commercial community which is unrelated to the buying and selling or dealing with customers which is the essence of the business of any trading company.”

90. This is illustrated by the following passage in *Wadlow*, at paragraph 3-18 (my emphasis):

“Although the goodwill of a business falls to be considered as a whole, there is one important component which is irrelevant for the purposes of passing-off. This is the goodwill which attaches to the premises in which the business is carried on, rather than to the proprietor of the business. It has been said that in its original sense goodwill was always appurtenant to land and that the concept of personal goodwill was a later development.

“It is quite plain that the goodwill of a public house passes with the public house. In such a case the goodwill is the mere habit of the customers resorting to the house. It is not what is called a personal goodwill.”[per Jessel MR in *Re Kitchin Ex p. Punnett (1880) 16 Ch D. 226 CA.*]

“A division of the elements of goodwill was referred to during the argument and appears in Mr Merlin’s book as the ‘cat, rat and dog’ basis. The cat prefers the old home ... though the person who has kept the house leaves. The cat represents that part of the customers who continue to go to the old shop, though the old shopkeeper has gone; the probability of their custom may be regarded as an additional value given to the premises by the tenant’s trading. The dog represents that part of the customers who follow the person rather than the place; these the tenant may take away with him if he does not go too far. There remains a class of customer who may neither follow the place nor the person, but drift away elsewhere. They are neither a benefit to the landlord nor the tenant, and have been called ‘the rat’ for no particular reason except to keep the epigram in the animal kingdom. I believe my brother Maugham has introduced the rabbit, but I will leave him to explain the position of the rabbit. It is obvious that the division of the customers into ‘cat, rat and dog’ must vary enormously in different cases and different circumstances.”[per Scrutton LJ in *Whiteman Smith Motor Co v Chaplin [1934] 2 K.B. 35, 42 CA.*]

Passing-off is concerned with “dog” goodwill, because it is the dog in this example that is loyal to the person carrying on the business. In modern conditions, trade, and consequently goodwill, need not be associated with specific premises at all. “Cat” goodwill is irrelevant to passing-off. Customers represented by the cat do business with the claimant only because of the location of his premises. They are therefore unlikely to be wooed to another location by a misrepresentation that the person trading there is connected with the claimant.”

91. For goodwill to attach to premises, there must be a business being carried on at that premises (as in the public house, rather than the landlord example). Goodwill cannot exist in a vacuum, must be the result of custom, and is not to be equated with some general reputation unrelated to buying and selling or dealing with customers. Although the authorities are English, there is no suggestion that the position is any different in Scots law, nor has the applicant made any submissions to that effect.

92. In its counterstatement, the applicant refers to Ms Mulhern’s business causing confusion with the goodwill which has been established by the owners of the building at 217 Sauchiehall Street, Glasgow which is owned by the applicant. The applicant cannot lay claim to goodwill on the basis of the architectural reputation of the building on its own and there is no evidence that the applicant has been using its mark. The relevant date in relation to the section 5(4)(a) ground is, therefore the date of application of the opposed mark, 22 April 2015. Furthermore, on the applicant’s own evidence, the tearoom business which was first operated in the building at the start of the 20th century was called Miss Cranston’s Tea Rooms. I agree with Ms Mulhern that it is a complete non-sequitur to then assert that the building was therefore known and referred to as the Willow Tea Rooms. According to the evidence, the publications which refer to it as that are decades-old academic publications, and the two witnesses for the applicant are both trustees of the applicant, with strong academic pedigrees in architectural history. In relation to the more recent references to The Willow Tea Rooms, for the last 32 years a tearoom business has operated in the building called The Willow Tea Rooms. If the building is ‘known and referred to’

in this way, that appears to be likely to be the result of the name of the business which has been carried on inside for the last three decades.

93. The second question which the applicant has raised over possession of goodwill relates to Ms Mulhern's *locus standi*. *Wadlow's* says at 3-136:

“ ...in the absence of agreement, ownership of goodwill is ultimately a question of fact to be decided in the light of all the relevant circumstances, and that arbitrary presumptions or rules of thumb (including some canvassed in previous editions of the present work) provide illusory assistance and are best avoided.

...

All that is necessary for a mark to be capable of being protected is that the public should rely on the mark as denoting that the quality or character of the goods so marked is the responsibility of some one trader [*Powell v Birmingham Vinegar Brewery Co* [1897] A.C. 710; 14 RPC 721 HL]. The public need not be able to identify him by name, and they need not even know the capacity in which he stands in relation to the goods.

94. The applicant's challenge to ownership of goodwill is explained in the counterstatement, in which it states that:

“It is accepted by the Applicant that a business has been carried on at 217 Sauchiehall Street, Glasgow under the name “The Willow Tea Rooms”. However:

(a) such business has since June 2001 been carried on by a company, Willow Tearooms Limited, not by the Opponent as proprietor of any trade mark;

...

It is acknowledged that there is a company called Willow Tearooms Limited which has occupied the building...if, which is denied, any goodwill has been built up which could be relevant to the Application, which is not associated with the building, this can only have been created by Willow Tearooms Limited. Willow Tearooms Limited is not the Opponent and any significant reputation for any goods or services (if it exists) will have been built up by Willow Tearooms Limited and not by the Opponent.”

95. Ms Mulhern explains, in her evidence:

“I am the owner of a tea room business trading under the trade mark THE WILLOW TEA ROOMS, and the sole director of Willow Tearooms Limited, with a registered office address of 217 Sauchiehall Street, Glasgow, G2 3EX, United Kingdom.”

She states that THE WILLOW TEA ROOMS was first used in the UK by her on 1 December 1983, when she opened her first tea room at 217 Sauchiehall Street, Glasgow. The position appears to be that Ms Mulhern started trading under the sign THE WILLOW TEA ROOMS in 1983 as a sole trader. The implication is that she later, in 2001, incorporated her trading style, as the sole director and controlling mind, seamlessly continuing the business as it always had been known since 1983. Ms Mulhern may have transferred her goodwill to her new company. There is, however, no explicit statement that the business is owned by the limited company; in fact, Ms Mulhern states the reverse: she says that she is the owner of the tea room business and that she is sole director of Willow Tearooms Limited. The two do not necessarily go together. (She is also the owner of the earlier marks relied upon under sections 5(2)(b) and 5(3) of the Act.) By the time the opposed application was filed, that business had been operating under the sign for 32 years, with Ms Mulhern at the helm (and only Ms Mulhern). She is identified as the owner and public face of the business in *The Sunday Herald* and in the *Evening Times*.

96. These factual circumstances are all relevant in deciding whether Ms Mulhern is entitled to bring the action for passing off. She has twice answered the challenge in two sets of evidence, asserting that she owns the business and the goodwill. Ms

Mulhern has not requested that the limited company be joined to the proceedings as a joint opponent. In *Tao Asian Bistro*⁷, Mr Yam was the sole director of three companies which the Hearing Officer had found owned the goodwill in the earlier sins relied upon by Mr Yam in his opposition. Professor Ruth Annand, sitting as the Appointed Person, stated:

“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).”

97. There are similarities between *Tao Asian Bistro* and the present case; although not in respect of point (e), as Ms Mulhern clearly believes she owns the goodwill and therefore did intend to bring the opposition in her own name. There was no hearing in the present case at which the ownership issue could have been debated, and no

⁷ BL O/004/11.

request to join Ms Mulhern's company, which may have occurred had there been a hearing. I find points (a) to (d) of assistance. Even if I were to find that Ms Mulhern is not entitled to bring the opposition, I would have permitted the joining of her company, if it had been requested. Willow Tearooms Limited could have assigned the goodwill to Ms Mulhern, if it had been necessary. The nature of the opposition under section 5(4)(a), including the evidence, would remain unchanged; avoiding a duplication of proceedings (Willow Tearooms Limited having to pursue the 5(4)(a) claim on invalidity). As it is, in all the circumstances identified in paragraph 95, I find that Ms Mulhern is entitled to bring proceedings, and if I am wrong about that, I would have permitted a request for joinder on the same principles as *Tao Asian Bistro*.

Misrepresentation

98. Under section 5(2)(b) of the Act, I carried out an assessment of the similarity of goods and services according to the parameters set by the established authorities. Without similarity of goods or services, there can be no likelihood of confusion within the meaning of section 5(2)(b). There are no such restrictions in deciding whether a passing off claim will succeed. Nevertheless, the distance between the goods and services is a factor which must be taken into account. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the

Advocaat case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

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

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion

and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

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

In the same case Stephenson L.J. said at page 547:

‘...in a case such as the present the burden of satisfying Lord Diplock’s requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader’s name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents’ property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.’ ”

99. For the reasons given under section 5(2)(b), the opposition also succeeds under section 5(4)(a) in respect of *corporate hospitality services; providing facilities for exhibitions; provision of facilities for parties, banquets and weddings*. These services and Ms Mulhern’s services are in a common field of activity.

100. Of relevance is the extent of the goodwill relied upon. As I have already commented, Ms Mulhern’s evidence could have been better marshalled. The

turnover figures are healthy, although not exceptional. There is no breakdown as to the proportion of turnover which can be attributed to the tearoom service as opposed to the goods, but Ms Mulhern's evidence indicates that the tearoom service is responsible for the lion's share of her turnover. It is the only Scottish tea room to feature in the Sunday Times Top 20 best spots for tea in the UK. Her unchallenged evidence is that 70% of her customers come from outside of Glasgow and the majority of the larger groups from outside of the UK. This is strongly suggestive of a tourist attraction, rather than a merely local business. The applicant's own evidence supports this since The Willow Tea Rooms features on a Glaswegian taxi firm's website offering a 'Charles Rennie Mackintosh' guided tour in Glasgow.

101. Ms Mulhern gives evidence that the tearooms have been used for 'numerous exhibitions, educational services, talks and tours'. There are no exhibits to support her statement, so it is difficult to gauge the extent of such activity. However, I note that the article in the *Evening Times* says:

"The two passions of businesswoman Anne Mulhern came together more than 30 years ago when she opened the Willow Tea Rooms in Sauchiehall Street, Glasgow, painstakingly recreating the dazzling Room de Luxe run by Kate Cranston at the start of the 20th century.

This suggests that one of the reasons for so many non-Glaswegian visitors, and the taxi guided tour, is because the décor of the tearooms is faithful to the style of Mackintosh. The location of the other The Willow Tea Rooms tearoom, 97 Buchanan Street, is also a Mackintosh building⁸. The sign relied upon is therefore known for the tearoom business and for its association with Mackintosh, which appears to be one of the reasons for its popularity with tourists.

102. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

⁸ The evidence does not show whether the third location, the Scotland Street School Museum, from 2008 to 2013, is also a Mackintosh building.

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in *Halsbury's Laws of England 4th Edition Vol.48 para 148* . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175 ; and Re Smith Hayden's Application (1945) 63 R.P.C. 97 at page 101.*”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

103. *Morrison L.J.* also stated that:

“This is the proposition clearly expressed by the judge in the first passage from his judgment which I quoted earlier. There he explained that the test was whether a substantial number of the plaintiff's customers or potential customers had been deceived for there to be a real effect on the plaintiff's trade or goodwill.”

104. The tone of the applicant's evidence is that 217 Sauchiehall Street is almost a shrine to Mackintosh. the reputation of The Willow Tea Rooms mixes the function of a tea room business with cultural activities and events. This means that the opponent's customers and potential customers have come to expect cultural activities and events offered under the name The Willow Tea Rooms to include the provision of food and drink by the opponent's business. Consequently, use of the applicant's mark to offer services relating to cultural events and activities which have no connection with the opponent, would be deceptive. I therefore find that there would be misrepresentation if the applicant's mark were to be used in relation to the following services:

Class 35: Organisation of commercial exhibitions; promotional services relating to cultural events and activities.

Class 41: Organisation of exhibitions for cultural and educational purposes; provision of museum and gallery services; arranging and conducting of conferences, congresses, seminars, symposia, workshops, events and exhibitions; corporate hospitality services; all relating to architecture, design and urban studies.

Class 43: Providing facilities for exhibitions; rental of accommodation for conference and events; provision of facilities for parties, banquets and weddings; rental of chairs and tables; rental of meeting rooms.

105. The applicant seeks a national right, which would include Glasgow, the location of Ms Mulhern's business. Furthermore, it is clear from the applicant's evidence that not only does it also intend to use its mark in Glasgow, it intends to occupy the very building from which Ms Mulhern has operated her tearoom business for over 30 years, under a sign which is virtually identical. There are no significant differences between the signs to which Ms Mulhern's customers can point and conclude that the differences indicate different traders. A substantial number of her potential customers will believe that the applicant's services are Ms Mulhern's. Damage can also go further than diversion of sales, as per *Ewing v Buttercup Margarine Company Limited* [1917] 2 Ch. 1 (COA), in which Warrington LJ stated that:

“To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me.”

There is a likelihood of damage to Ms Mulhern’s goodwill not only in loss of sales but also through loss of control over the reputation associated with The Willow Tea Rooms.

Section 5(4)(a) outcome

106. The applicant is liable to be prevented from use of the application under the law of passing-off and so the section 5(4)(a) ground succeeds in relation to:

Class 35: Organisation of commercial exhibitions; promotional services relating to cultural events and activities.

Class 41: Organisation, arrangement and conducting of courses, seminars, conferences, workshops, conventions, events and exhibitions for commercial or advertising purposes; organisation of exhibitions for cultural and educational purposes; organisation of exhibitions for cultural and educational purposes; provision of museum and gallery services; arranging and conducting of conferences, congresses, seminars, symposia, workshops, events and exhibitions; corporate hospitality services; all relating to architecture, design and urban studies.

Class 43: Providing facilities for exhibitions; rental of accommodation for conference and events; provision of facilities for parties, banquets and weddings; rental of chairs and tables; rental of meeting rooms.

107. The section 5(4)(a) ground fails in respect of:

Class 35: *Business research services; all relating to architecture, design and urban studies.*

Class 41: *Provision of training services in relation to design and architecture; publication of education materials; library services; all relating to architecture, design and urban studies.*

Class 42: *Architectural services; building and interior design services; industrial design services; graphic arts design services; product design services.*

Section 5(3) of the Act

108. Section 5(3) states:

“(3) A trade mark which-

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

109. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in

such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

110. The conditions of section 5(3) are cumulative. Firstly, Ms Mulhern must show that her earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

111. The first condition is reputation. The CJEU gave guidance in relation to assessing reputation in *General Motors*:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

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

112. When I assessed the distinctive character of the earlier mark under section 5(2)(b) of the Act, I said that the evidence was sufficient to find that the mark’s inherent distinctive character had been enhanced through its use. For the reasons I gave earlier, I find that the evidence is sufficient to support a claim to a *Chevy* standard of reputation, but only in relation to *tea-room, coffee shop and café* services. The evidence shows that the nature of the mark’s reputation is that it is also associated with the designs of Charles Rennie Mackintosh. It is this reputation which helps to bring in the tourists.

113. The second requirement is that the relevant public will make a link between the marks. I have already found that the marks are highly similar and that Ms Mulhern’s mark is highly distinctive inherently and through use. The relevant public will overlap for those services for which I found that the section 5(4)(a) ground succeeds, but not for others which are aimed at a more specialist public: *business research services, training in design and architecture; publication of education materials; all relating to architecture, design and urban studies; architectural services; building and interior design services; industrial design services; graphic arts design services and product design*, with the exception of library services which are also aimed at the general public. I find that the relevant public will make a link between the marks in respect of

the following services in the application which are similar and/or are in Ms Mulhern's favour following *Intel*:

Class 35: Organisation of commercial exhibitions; promotional services relating to cultural events and activities.

Class 41: Organisation, arrangement and conducting of courses, seminars, conferences, workshops, conventions, events and exhibitions for commercial or advertising purposes; organisation of exhibitions for cultural and educational purposes; organisation of exhibitions for cultural and educational purposes; provision of museum and gallery services; arranging and conducting of conferences, congresses, seminars, symposia, workshops, events and exhibitions; corporate hospitality services; all relating to architecture, design and urban studies.

Class 43: Providing facilities for exhibitions; rental of accommodation for conference and events; provision of facilities for parties, banquets and weddings; rental of chairs and tables; rental of meeting rooms.

114. Library services are far removed from Ms Mulhern's services. Whilst a reputation for tearoom services associated with Mackintosh will cause a link with exhibition-related services offered under virtually identical and highly distinctive marks, this is unlikely to extend to library services.

115. In relation to the services for which there will be a link, to be successful under section 5(3), Ms Mulhern needs to show that there exists one or more of the three types of damage. I will begin with unfair advantage, which was described by the CJEU in *L'Oréal v Bellure*:

"41. As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of

the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.

....

115. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

116. There is some debate as to whether the judgment of the CJEU in *L'Oreal v Bellure* means that an advantage gained by the user of a junior mark is only unfair if there is an intention to take advantage of the senior mark, or some other factor is present which makes the advantage unfair. The English Court of Appeal has considered this matter three times. Firstly, in *L'Oreal v Bellure* [2010] RPC 23 when that case returned to the national court for determination. Secondly, in *Whirlpool v Kenwood* [2010] RPC 2: see paragraph 136. Thirdly, in *Specsavers v Asda Stores Limited*¹ [2012] EWCA Civ 24: see paragraph 127. On each occasion the court appears to have interpreted *L'Oreal v Bellure* as meaning that unfair advantage requires something more than an advantage gained without due cause. However, the absence of due cause appears to be closely linked to the existence of unfair advantage. See paragraph 36 of the opinion of Advocate General Kokott in Case C-65/12 *Leidseplein Beheer and Vries v Red Bull*. I say more about due cause below.

117. Trade marks are not only indicators of origin, but are also communication tools which send out messages. In the case of the earlier mark, the message sent out is that the services are allied to the heritage and style of Charles Rennie Mackintosh. If the applicant's services were to be provided in connection with the subject matter of Mackintosh, that image will be transferred to the applicant's mark. The applicant's

mark will call to mind the earlier mark and will therefore appear instantly familiar to the public concerned, thereby making it easier for the applicant to establish its mark and to sell its services without the usual marketing expenditure⁹. Although the applicant may not consider that it applied for the mark with the intention of taking advantage of the reputation built up by Ms Mulhern over 30-plus years in The Willow Tea Rooms, it knew of that reputation. It purposefully bought the building in which the business with the reputation in the mark was operating and applied for a mark which is virtually identical. The effect of its actions amounts to taking unfair advantage.

118. Due cause is a defence. The applicant has not pleaded due cause. Even if it had, it would have failed. In *Leidseplein Beheer BV v Red Bull*, Case C-65/12, the CJEU held (my emphasis):

“43. In a system for the protection of marks such as that adopted, on the basis of Directive 89/104, by the Benelux Convention, however, the interests of a third party in using, in the course of trade, a sign similar to a mark with a reputation must be considered, in the context of Article 5(2) of that directive, in the light of the possibility for the user of that sign to claim ‘due cause’.

44. Where the proprietor of the mark with a reputation has demonstrated the existence of one of the forms of injury referred to in Article 5(2) of Directive 89/104 and, in particular, has shown that unfair advantage has been taken of the distinctive character or the repute of that mark, the onus is on the third party using a sign similar to the mark with a reputation to establish that he has due cause for using such a sign (see, by analogy, Case C-252/07 *Intel Corporation* [2008] ECR I-8823, paragraph 39).

45. It follows that the concept of ‘due cause’ may not only include objectively overriding reasons but may also relate to the subjective interests of a third party using a sign which is identical or similar to the mark with a reputation.

⁹ For the services for which there is a likelihood of confusion, there will be automatic unfair advantage because there will be increased sales for the applicant, owing to confusion with the earlier mark.

46. Thus, the concept of ‘due cause’ is intended, not to resolve a conflict between a mark with a reputation and a similar sign which was being used before that trade mark was filed or to restrict the rights which the proprietor of that mark is recognised as having, but to strike a balance between the interests in question by taking account, in the specific context of Article 5(2) of Directive 89/104 and in the light of the enhanced protection enjoyed by that mark, of the interests of the third party using that sign. In so doing, the claim by a third party that there is due cause for using a sign which is similar to a mark with a reputation cannot lead to the recognition, for the benefit of that third party, of the rights connected with a registered mark, but rather obliges the proprietor of the mark with a reputation to tolerate the use of the similar sign.

...

60. Consequently, it follows from all of the foregoing considerations that the answer to the question referred is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the proprietor of a trade mark with a reputation may be obliged, pursuant to the concept of ‘due cause’ within the meaning of that provision, to tolerate the use by a third party of a sign similar to that mark in relation to a product which is identical to that for which that mark was registered, if it is demonstrated that that sign was being used before that mark was filed and that the use of that sign in relation to the identical product is in good faith. In order to determine whether that is so, the national court must take account, in particular, of:

- how that sign has been accepted by, and what its reputation is with, the relevant public;
- the degree of proximity between the goods and services for which that sign was originally used and the product for which the mark with a reputation was registered; and
- the economic and commercial significance of the use for that product of the sign which is similar to that mark.”

119. Of course, the applicant has not used its sign. It could not rely on due cause, even if it had been pleaded. There is no automatic right to a mark as a result of heritage-related connections. Trade marks are commercial communication tools which are bought and sold and which may, or may not, belong to the entities which originally used them¹⁰. The applicant now owns the building itself, in order to preserve the heritage of Mackintosh. However, even if the building itself was known as The Willow Tea Rooms at some point in the distant past, that does not give the applicant a right, as Ms Mulhern puts it, to hijack the mark of a business that has been operating successfully under that mark for over 30 years.

Section 5(3) outcome

120. The opposition succeeds under section 5(3) in relation to:

Class 35: Organisation of commercial exhibitions; promotional services relating to cultural events and activities.

Class 41: Organisation, arrangement and conducting of courses, seminars, conferences, workshops, conventions, events and exhibitions for commercial or advertising purposes; organisation of exhibitions for cultural and educational purposes; organisation of exhibitions for cultural and educational purposes; provision of museum and gallery services; arranging and conducting of conferences, congresses, seminars, symposia, workshops, events and exhibitions; corporate hospitality services; all relating to architecture, design and urban studies.

Class 43: Providing facilities for exhibitions; rental of accommodation for conference and events; provision of facilities for parties, banquets and weddings; rental of chairs and tables; rental of meeting rooms.

121. The opposition under section 5(3) fails in relation to:

¹⁰ An example being that of Elizabeth Emmanuel, *Case C-259/04 Emmanuel v Continental Shelf 128 Ltd.*

Class 35: *Business research services; all relating to architecture, design and urban studies.*

Class 41: *Provision of training services in relation to design and architecture; publication of education materials; library services; all relating to architecture, design and urban studies.*

Class 42: *Architectural services; building and interior design services; industrial design services; graphic arts design services; product design services.*

Overall outcome

122. The opposition partially succeeds. The application is refused for the following services:

Class 35: *Organisation of commercial exhibitions; promotional services relating to cultural events and activities.*

Class 41: *Organisation, arrangement and conducting of courses, seminars, conferences, workshops, conventions, events and exhibitions for commercial or advertising purposes; organisation of exhibitions for cultural and educational purposes; organisation of exhibitions for cultural and educational purposes; provision of museum and gallery services; arranging and conducting of conferences, congresses, seminars, symposia, workshops, events and exhibitions; corporate hospitality services; all relating to architecture, design and urban studies.*

Class 43: *Providing facilities for exhibitions; rental of accommodation for conference and events; provision of facilities for parties, banquets and weddings; rental of chairs and tables; rental of meeting rooms.*

123. The application may proceed to registration for the following services:

Class 35: *Business research services; all relating to architecture, design and urban studies.*

Class 41: *Provision of training services in relation to design and architecture; publication of education materials; library services; all relating to architecture, design and urban studies.*

Class 42: *Architectural services; building and interior design services; industrial design services; graphic arts design services; product design services.*

Costs

125. Ms Mulhern has successfully opposed approximately two-thirds of the application. She is entitled to a contribution towards her costs from the published scale¹¹, reflecting the proportion of her partial success. The breakdown of the award of costs is:

Official fee	£200
Filing the opposition and considering the counterstatement	£300
Evidence and submissions	£800
Reduced by approx. one third, the total is	£870

¹¹ Tribunal Practice Notice 4/2007.

126. I order The Willow Tea Rooms Trust to pay Anne Mulhern the sum of £870 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 27th day of January 2017

A handwritten signature in black ink, appearing to be 'JP' followed by a large, stylized flourish.

**Judi Pike
For the Registrar,
the Comptroller-General**