

O/034/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
No.2550854  
BY NATIONWIDE CHRISTIAN TRUST  
TO REGISTER THE TRADE MARK  
LIVING OASIS  
IN CLASSES 9, 16, 35, 41, 43 & 45**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 101742 BY  
PRINCESS AMERICANA, SARL**

## **BACKGROUND**

1) On 18 June 2010 Nationwide Christian Trust (hereinafter the applicant), applied to register the mark LIVING OASIS in respect of the following goods and services:

In Class 9: Electronic publications; downloadable electronic publications; data recorded in electronic, optical or magnetic form; apparatus and instruments for the recording, transmission, reception, processing and/or production of sound, images and/or data; publications and data in electronic, optical, magnetic or other transmittable or recordable form supplied on-line from data-bases or recorded on data carriers; magnetic data carriers; recording discs; audio, video and audio-visual recordings; CDs, CD ROMs, DVDs, DVD ROMs, compact discs, recording discs, tapes, cassettes and other media for the recording of, or bearing pre-recorded, software and/or electronic data or other material; computer software, computer hardware and computer programs.

In Class 16: Paper; paper articles; printed matter; printed publications; books; notebooks; magazines; newspapers; journals; periodical publications; booklets; calendars; wall planners; maps; albums; stationery; postcards and greeting cards; photographs; pictures; posters; artists' materials; gift vouchers; book tokens; office requisites; instructional and teaching materials; writing instruments and drawing instruments; pen and pencil cases.

In Class 35: Retail bookseller services; retail services connected with the sale of music, books and other printed matter and publications; the bringing together, for the benefit of others, of a variety of music, books and other printed matter and printed publications enabling customers to conveniently view, sample and purchase those goods in a retail outlet; the bringing together, for the benefit of others, of a variety of music, books and other printed matter and printed publications enabling customers to conveniently view, sample and purchase those goods from an Internet web site or by means of telecommunications; the provision of information and advice to prospective purchasers of goods including such services provided on-line from a database, via the Internet or any other communications network; advertising and promotional services; incentive and loyalty schemes; the organisation and management of promotional and incentive schemes; information, advice and business assistance, all relating to the aforesaid services.

In Class 41: Educational services; provision of instructional, training and teaching services; entertainment services; entertainment services relating to competitions, quizzes and sport; cultural activities; organising of events, exhibitions and shows for entertainment purposes; educational and entertainment services for children; arranging and conducting of seminars, symposiums and conferences; information, advisory and consultancy services relating to all the aforesaid services, including such services provided on-line from computer databases and/or intranets and/or extranets and/or the Internet.


In Class 43: Cafeteria and coffee shop services; services for the provision of food, refreshments and drink; restaurant, bar and catering services, rental of meeting rooms.

In Class 45: Organisation of religious meetings; provision of information on religion.

2) The application was examined and accepted, and subsequently published for opposition purposes on 30 July 2010 in Trade Marks Journal No.6846.

3) On 1 November 2010, Princess Americana Sarl (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade marks:

Number	Mark	Filing and Registration Date	Class	Services relied upon
CTM 5334933		25.09.2006 / 06.09.2010	41	Entertainment, leisure and recreation; sporting and cultural activities.
			43	Hotel services.
CTM 6452478	OASIS SENS	20.11.2007 / 27.11.2008	43	Hotel services; bars, restaurants and cafeterias.

b) The opponent states that its mark 5334933 is similar to the mark in suit because both marks have a similar dominant element in the word OASIS, the word "living" in the applicant's mark is described as non-distinctive, but with no explanation as to why, and that the following services are similar to those of its mark:

In Class 41: Entertainment services; entertainment services relating to competitions, quizzes and sport; cultural activities; organising of events, exhibitions and shows for entertainment purposes; entertainment services for children; arranging and conducting of seminars, symposiums and conferences; information, advisory and consultancy services relating to all the aforesaid services, including such services provided on-line from computer databases and/or intranets and/or extranets and/or the Internet.

In Class 43: Cafeteria and coffee shop services; services for the provision of food, refreshments and drink; restaurant, bar and catering services, rental of meeting rooms.

c) Specifically it states that:

““Hotel services” are identical to or similar to “Cafeteria and coffee shop services; services for the provision of food, refreshments and drink; restaurant, bar and catering services, rental of meeting rooms” because the services provided by hotels can include the provision of such services in addition to the provision of somewhere to sleep.”

d) The opponent contends that the mark in suit offends against Section 5(2)(b), 5(3) and 5(4)(a).

e) With regard to its trade mark 6452478 the opponent states once again that the marks are similar as both marks have the same dominant element in the word OASIS, the word “living” in the applicant’s mark is described as non-distinctive, but with no explanation as to why, and that its services are identical or similar to the Class 43 services of the applicant. The opponent states that the application offends against Section 5(2)(b), 5(3) and 5(4)(a).

4) On 13 June 2011, the applicant filed a counterstatement which denied the opponent’s claims. It states that the word OASIS is commonly used in advertising hotels, bars and restaurants to UK consumers. It claims that the term is not unique to any single entity in the UK, and provides copies from various websites to show that such use occurs. The applicant accepts that its following services in Class 41 are identical to the opponent’s Class 41 services: “Entertainment services; entertainment services relating to competitions, quizzes and sport; cultural activities; entertainment services for children.” However, it denies that the following services in Class 41 are similar to the opponent’s services: “Organising of events, exhibitions and shows for entertainment purposes; arranging and conducting of seminars, symposiums and conferences; information, advisory and consultancy services relating to all the aforesaid services, including such services provided on-line from computer databases and/or intranets and/or extranets and/or the Internet.”

5) The applicant accepts that both parties Class 43 services have the following identical services: “bars, restaurants and cafeterias”. However, it denies that any of its class 43 services are similar to “hotel services”.

6) Neither side filed evidence. Neither party wished to be heard. Only the opponent filed written submissions which I shall take into account as and when required in my decision.

## DECISION

7) The grounds of opposition under Section 5(3) and 5(4)(a) were dropped as no evidence was filed. Therefore, the only ground of opposition is under Section 5(2)(b) of the Act which reads:

“5.-(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.”

8) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

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

9) The opponent is relying upon its trade marks listed in paragraph 3 which are clearly earlier trade marks. They were registered on 27 November 2008 (6452478), and 6 September 2010 (5334933). Given the interplay between the dates on which the opponent’s registrations completed their registration procedure and the date on which the applicant’s application was published (30 July 2010) neither of the opponent’s registrations are subject to proof of use.

10) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

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

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

11) In essence the test under section 5(2)(b) is whether there are similarities in marks and services which would combine to create a likelihood of confusion. In my

consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the services, the category of services in question and how they are marketed. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the services in their specifications.

12) In the instant case the opponent has not provided evidence regarding use of its marks. It cannot therefore benefit from an enhanced reputation. However, despite the applicant's views set out in paragraph 4 above, to my mind, the opponent's marks have a reasonable degree of inherent distinctiveness.

13) I shall now consider the services of the two parties. In carrying out the comparison I will take into account *British Sugar Plc v James Robertson & Sons Ltd* (TREAT) RPC 281. This identified the following as elements to be considered, uses, users, nature, trade channels, where the items are to be found and whether they are in competition. This approach was commented on and endorsed in *Canon*. For ease of reference, I set out only the relevant services of both parties below:

Opponent's specification	Applicants' specification
5334933: Class 41 Entertainment, leisure and recreation; sporting and cultural activities	In Class 41: Entertainment services; entertainment services relating to competitions, quizzes and sport; cultural activities; organising of events, exhibitions and shows for entertainment purposes; entertainment services for children; arranging and conducting of seminars, symposiums and conferences; information, advisory and consultancy services relating to all the aforesaid services, including such services provided on-line from computer databases and/or intranets and/or extranets and/or the Internet.
5334933: Class 43 Hotel services.  6452478: Class 43 Hotel services; bars, restaurants and cafeterias.	In Class 43: Cafeteria and coffee shop services; services for the provision of food, refreshments and drink; restaurant, bar and catering services, rental of meeting rooms.

14) The applicant has already accepted, in its counterstatement, that the following of its services are similar to those of the opponent:

In Class 41: Entertainment services; entertainment services relating to competitions, quizzes and sport; cultural activities; entertainment services for children;

In Class 43: Bars; restaurants and cafeterias.

15) To my mind the applicant's Class 41 activities break down into two distinct aspects; the provision of entertainment and cultural activities (including seminars etc); and advice and consultancy services. To my mind the opponent's specification is based clearly around entertainment and cultural activities. Therefore, in addition to the admission by the applicant at paragraph 14 above I also find that the applicant services of "organising of events, exhibitions and shows for entertainment purposes; arranging and conducting of seminars, symposiums and conferences" are identical or very similar to the services of the opponent. In my view the following services in Class 41 "information, advisory and consultancy services relating to all the aforesaid services, including such services provided on-line from computer databases and/or intranets and/or extranets and/or the Internet" all fall into the second category I identify and summarise as "advice and consultancy services". To my mind these are distinct and different from entertainment and cultural services, as the users are likely to be businesses or educational establishments and not the general public, the uses are different and they are not in competition with each other.


16) Moving onto the class 43 services I again believe that the applicant is partially correct in its admission but does not go far enough. Clearly each side's specification includes the words "bars", "restaurants" and "cafeteria". However, quite how "coffee shop services", "catering services" and "services for the provision of food, refreshments and drink" are not also identical to "bars, restaurants and cafeterias" is mystifying as to my mind they are quite clearly identical. Lastly, while "rental of meeting rooms" is not identical to "hotel services" in my view they are highly similar.

17) I must also consider whether the opponent's "hotel services" in Class 43 is similar to the whole of the applicant's class 43 services. I agree with the opponent that the services contained within the applicant's class 43 specification are the kinds of services that one would expect a hotel to provide. I therefore find that the class 43 specifications of both parties are similar.

18) As the case law in paragraph 10 above indicates I must determine the average consumer for the services of the parties. I must then determine the manner in which these services are likely to be selected by the said average consumer. Both parties' services are set out at paragraph 13 above. Such services will be purchased by members of the public, either for themselves or for family members. They will also be purchased by businesses and public sector departments. Most of these services will not be purchased or selected without considerable care, although cafeterias and coffee shops are less likely to be so carefully considered.



19) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicants' Trade Mark	Opponent's Trade Marks
LIVING OASIS	5334933 
	6452478 OASIS SENS

20) In its submissions the opponent contends:

“1. The word OASIS is [a] non-descriptive word which is clearly capable of distinguishing the services of one undertaking from another.

2. The word OASIS is so dominant in European Community Trade Mark Registration No 5334933 that the average consumer would see the mark as being simply OASIS and would recall the OASIS element and not the device element. The overall impression given by the mark is that of the word OASIS.

3. The word OASIS forms the prefix [of] European Community Trade Mark Registration No 6452478. We submit that the average consumer would pay more attention to the prefix of the mark and would see the mark as being the word OASIS.

4. An oasis is a fertile or green spot in a desert or wasteland, made so by the presence of water. The addition of the word LIVING is simply a descriptive word which would be seen as defining the type of attribute of an oasis.

5. The consumers of the services are the public at large and are not necessarily circumspect. The consumers would not pay particular attention to any differences in the marks. In any event, any differences in the marks are offset by a high degree of identity between the services. Accordingly, it is submitted that the marks are similar.”

21) I shall first consider the mark in suit to the opponent's mark 5334933. Visually there is obviously a similarity in that they both contain the word OASIS, but there are also significant differences. The applicant's mark consists of two words, LIVING OASIS, whereas the opponent's mark has a large device element, suggestive of a bird's eye view of the fronds of palm trees usually found at an oasis and the word OASIS. I do not agree with the opponent's view that the average consumer would automatically ignore

the device element in its mark. It is a substantial device element and is above the word element and is therefore the first thing that is viewed. Similarly I do not accept that the average consumer would ignore the first part of the mark in suit. The word "LIVING" can be said to be descriptive of the word OASIS if that word is describing a fertile patch in a desert. But the term OASIS also means a place of peace, safety, happiness or tranquillity. When the mark in suit is used upon the services in Class 41 and 43 it is far more likely that it is the latter connotation that the average consumer will apply, in which case the term LIVING will not be dismissed as simply stating the obvious. If a traditional oasis is not alive it is not an oasis it is desert. To my mind it is significant that the additional and different word comes at the beginning of the mark, as it is accepted that the beginnings of marks are given more attention by consumers.

22) There is an obvious aural similarity given that the opponent's mark has only a single word and that also is in the mark in suit. Again though there is a significant difference in that the first part of the mark in suit to be articulated is different from that of the opponent's mark and makes it significantly longer.

23) Conceptually, they share an image of a traditional oasis in the middle of a desert or a place of peace etc.

24) I do not accept the opponent's view that the average consumer is not circumspect and would not pay attention to differences in the marks. I have set out my views at paragraph 18 above.

25) Taken overall, although there is a single common element, the word OASIS, there are a number of differences between the marks which I believe outweigh the similarity.

26) When determining whether there is a likelihood of confusion I have to take a number of factors into consideration. There is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. I must consider the distinctive nature of the opponent's trade mark, the average consumer for the services, the nature of the purchasing process and the issue of imperfect recollection. I must also take into account that these services will not be chosen without care. In the instant case the opponent's mark is inherently distinctive and the services are largely identical. To my mind, although the services are mostly identical, the differences in the trade marks far outweighs any common aspect of the mark to the extent that there is no likelihood of confusion on the part of the public, or a likelihood of association with the earlier trade mark. The ground of opposition under Section 5(2)(b) in relation to CTM 5334933 fails.

27) I now turn to consider the mark in suit to the opponent's mark 6452478. Many of the same considerations apply. The opponent's mark consists of two words OASIS SENS. No explanation is provided as to what the second word means. To my mind it will be incomprehensible to the average consumer, who will therefore assume that it is an integral part of the opponent's trade mark. Visually, conceptually and aurally the opponent's mark 6452478 is even further away from the mark in suit than the

opponent's first mark. My conclusion is therefore predictable in that the ground of opposition under Section 5(2)(b) in relation to CTM 6452478 also fails.

### **COSTS**

28) The applicant has been successful and is therefore entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £300. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 31<sup>st</sup> day of January 2012**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**