

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2394319
IN THE NAME OF TERRY MILLER AND LINDA MILLER**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER No. 93911
BY UMG RECORDINGS INC**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE OPPONENT
AGAINST THE DECISION OF MR. OLIVER MORRIS
DATED 22 DECEMBER 2009**

DECISION

Introduction

1. This is an appeal from a decision of Mr. Oliver Morris, the Hearing Officer acting for the Registrar, dated 22 December 2009, BL O/395/09, in which he allowed an opposition brought by UMG Recordings Inc. against Application number 2394319 in the name of Terry Miller and Linda Miller but only in relation to bar services.
2. On 15 June 2006, Mr. and Mrs. Miller applied to register the designation represented below for use as a trade mark in the United Kingdom:

ROCKAFELLA

3. Registration was requested in respect of the following goods and services:

Class 29
Prepared meals to include meat, fish, poultry, game and vegetables and snacks

Class 30
Pizzas and pastas and prepared desserts

Class 43
Restaurant, bar and catering services.
4. On 14 November 2005, UMG filed Notice of opposition against registration of the Application under section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994.
5. Under section 5(2)(b) and 5(3), UMG relied upon its earlier Community Trade Mark number 004650917, ROC-A-FELLA, registered for the following goods and services:

Class 9

Pre-recorded audio tapes, discs and cassettes, video tapes, digital audio and audio video tapes and discs, CDs, DVDs, laser discs, and phonograph records featuring music and entertainment; theatrical or musical sound and video recordings; motion picture films about the music and entertainment industries; virtual reality software; downloadable ring tones, music, mp3s, graphics, games, images and videos for wireless communication devices; and computer and video game equipment containing memory devices, namely, computer and video game software, tapes, cartridges, cassettes, joysticks and remote control units.

Class 41

Production and distribution of television and radio programs; production, distribution and publishing of music; fan clubs; radio entertainment production and distribution; audio recording production; record production; videotape production; entertainment in the nature of ongoing television programs in the field of music and entertainment; entertainment, namely a continuing music and entertainment show distributed over television, satellite, audio, and video media; entertainment in the nature of live concerts and performances by musical artists and groups; entertainment services, namely personal appearances by musical groups, musical artists and celebrities; educational and entertainment services, namely, production and presentation of television shows, sports events, fashion shows, game shows, music shows, award shows and comedy shows before live audiences which are all broadcast live or taped for later broadcast; entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials; entertainment services, namely, providing on-line reviews of music, musical artists and music videos; entertainment services, namely, providing pre-recorded music, information in the field of music, and commentary and articles about music, all on-line via a global computer network; entertainment services namely live, televised and movie appearances by a professional entertainer; conducting entertainment exhibitions in the nature of music festivals; organizing exhibitions for the promotion of music and the arts.

6. For the purposes of section 5(4)(a), UMG relied upon its earlier unregistered rights in the signs ROC-A-FELLA and ROCAFELLA.
7. Since neither side requested an oral hearing, the Hearing Officer decided the opposition on the papers before him. No written submissions were filed. However, the Hearing Officer took into consideration the parties' submissions/observations made in the evidence and statements of case.

The Hearing Officer's decision

8. The Hearing Officer's findings were in brief:

Section 5(2)(b)

- (i) The goods and services applied for were aimed at the general public with the exception of catering services which could be offered to the general public and businesses. Food and bar services were relatively casual purchases; restaurant and catering services more considered.

- (ii) UMG's entertainment services and Class 9 goods, for example, CDs were also aimed at the general public and were neither casual nor highly considered purchases. A reasonable degree of care and attention would be expended. On the other hand, UMG's production services were aimed at musicians, groups or others in the music field and their purchase was a highly considered one.
- (iii) UMG's best case resided with: "Entertainment in the nature of live concerts and performances by musical artists and groups" in Class 41.
- (iv) No evidence was adduced to support UMG's contention that restaurant services and live musical performances were commonly offered together at the same establishments. Whilst, the Hearing Officer accepted that live music might be provided in a restaurant this was the exception rather than the norm. There was no similarity between restaurant services and live musical performances or with any of the food products applied for in Classes 29 and 30.
- (v) The Hearing Officer was prepared to accept as a notorious fact that bars routinely and regularly offer live musical performances and that in any live music venue there was likely to be a bar service. The trade channels overlapped and a common end user could encounter both services in the same establishment. The respective services were therefore similar but because of their different natures any such similarity was at the lower end of the spectrum.
- (vi) The Millers had conceded that the food served at musical events would be in the nature of catered for food, the type provided under their catering service. Moreover in the circumstance of catering services being used by the actual end user (as opposed to the event organiser) there was a link to the same end user. There was a degree of similarity in terms of channels of trade and end users. However because the nature and intended purpose of the respective services was different, any similarity between those services was very low.
- (vii) Only "bar and catering services" in the Application bore any degree of similarity to UMG's goods/services. The opposition failed in relation to the Millers' restaurant services and food products in Classes 29 and 30.
- (viii) The respective marks were aurally identical. Visually the actual text of the marks was virtually the same (the only difference being the K and unremarkable stylisation in the Millers' mark) although the hyphens in UMG's mark created a degree of visual difference. Conceptually, both marks suggested the name of the famous Rockefeller family of New York. Overall, there was a very high degree of similarity between the marks.
- (ix) UMG's ROC-A-FELLA mark comprised an unusual word and was striking and fanciful. It was possessed of high distinctive character. However, there was no relevant evidence of factual distinctiveness.

- (x) Regarding bar services, bearing in mind the concept of imperfect recollection there was little to distinguish between the marks, which might be recalled as the same. The earlier mark was highly distinctive but the Hearing Officer had found that there was only a low degree of similarity between bar services and live music entertainment services. Nevertheless under the interdependence principle, a low degree of similarity between the services could be offset by a high degree of similarity between the marks:

“In this instance [i.e. bar services], I believe that the factors would combine to create a likelihood of confusion. If an average consumer encountered a venue offering live music under the name ROC-A-FELLA then a subsequently encountered bar service (which the average consumer will be aware of often provides live music) called ROCKAFELLA (or vice versa) is likely to lead to the belief that the undertakings offering the services were linked in some way perhaps indicative of an extension into bar services (such as pubs) which also focus on music.”

- (xi) The Hearing Officer had found any similarity between catering services and live music entertainment services to be very low:

“Whilst, as above [c.f. bar services], there is little to distinguish between the marks themselves and that the earlier mark is high in distinctiveness, I struggle to see why an average consumer who has encountered the ROC-A-FELLA live music service would presume that a subsequently encountered catering service called ROCKAFELLA (or vice versa) was being offered by the same undertaking. The argument put forward (by UMG) that a catering service offered together (under the Millers’ mark) in the same venue as ROC-A-FELLA live music services presupposes that UMG actually employ the Millers to provide their catering service in their venue; confusion on such a hypothetical circumstance seems too remote to consider and the sequentially encountered test as outlined above is instead preferred. There is no likelihood of confusion”.

Section 5(4)(a)

- (xii) Any goodwill UMG had accrued in the United Kingdom to the earlier signs ROC-A-FELLA and ROCAFELLA related to its production/distribution business (i.e., the record label function). There was insufficient evidence of goodwill in relation to the claimed entertainment services including films:

“Although a common field of activity is not required under passing-off, it is an important factor. In short, I do not see why anyone would believe that the ROC-A-FELLA recording company is now providing a restaurant, bar or catering service (or food products). UMG refers to celebrities opening restaurants and bars. This, though, is an exception rather than the rule and, in any event, ROC-A-FELLA is not a celebrity, its artists are those with celebrity status. This ground of opposition fails.”

Section 5(3)

- (xiii) The evidence failed to establish that the earlier ROC-A-FELLA mark possessed reputation in relation to any of the goods or entertainment services for which it was registered. The evidence also failed to establish reputation in ROC-A-FELLA amongst a significant proportion of average consumers for record label services (admittedly a much narrower group) and even if the Hearing Officer was wrong in that finding there would be no requisite link or taking of unfair advantage essentially because the Millers' goods and services were so diverse.

Conclusions

- (xiv) The opposition succeeded under section 5(2)(b) in relation to bar services but failed in respect of the remaining goods and services in the Application. The Hearing Officer would order UMG to pay the Millers the sum of £400 towards their costs of the opposition.

The appeal

9. On 19 January 2010, UMG filed Notice of appeal to the Appointed Person under section 76 of the Act. The appeal was limited to the Hearing Officer's findings under section 5(2)(b) and 5(4)(a), and then only in so far as they related to the Millers' "restaurant and catering services" in Class 43. UMG did not challenge the Hearing Officer's dismissal of the opposition under section 5(3) or against the Miller's food products in Classes 29 and 30. There was no cross appeal against the Hearing Officer's refusal of the Application for bar services.
10. The appeal was set down for hearing before me on 16 September 2010, when UMG was represented by Mr. Simon Malynicz of Counsel instructed by Forresters. No-one attended on that day for the Millers.

Preliminary issue

11. At the commencement of the hearing, Mr. Malynicz expressed his concern that the Millers might not have received due notice of the appeal hearing. The reasons for his concern and my subsequent investigations caused me to issue a Request for information and case management directions pursuant to rule 62 of the Trade Marks Rules 2008.
12. *Inter alia*, the Millers were sent copies of the appeal documents, Mr. Malynicz's skeleton argument and the transcript of the part-hearing on 16 September 2010 and were requested to inform me whether they wished to be heard orally or in writing in connection with the substance of UMG's appeal.
13. In due course, the Millers responded through their agent that having seen the appeal papers, they did not wish to make any submissions and were content for the matter to proceed to determination by the Appointed Person without any further input from them.

Standard of review

14. An appeal to the Appointed Person is by way of review and in cases such as the present where the Hearing Officer made a multi-factorial comparison but did not hear any oral evidence the approach stated by Robert Walker L.J. in *REEF Trade Mark* [2003] RPC 101 at 109 – 110 applies:

“In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.”

15. Neither surprise at a hearing officer’s conclusion nor a belief that he has reached the wrong decision suffice to justify interference (*REEF* at 112, *BUD and BUDWEISER BUDBR □ U Trade Marks* [[2003] RPC 477 at 483 and 489, *Digipos Store Solutions Group Ltd v. Digi International Inc* [2008] RPC 591 at 598).

Grounds of appeal

16. UMG contended that the Hearing Officer made four critical errors, which were conveniently set out at paragraph 4 of Mr. Malynicz’s skeleton argument:

- “4.1 First, he ignored the range of contexts in which restaurant and catering services are provided, instead confining himself only to the paradigm case of meals served to paying customers on premises dedicated to the purpose. In particular he failed to take account of music events and festivals where restaurant services are also provided.
- 4.2 Secondly, even in the paradigm case of a restaurant establishment dedicated to the purpose, he failed to take into account that it is commonplace for music to be provided, e.g., the dinner jazz scenario.
- 4.3 Thirdly, there was no principled basis for his distinctions between restaurant services which he regarded as dissimilar, and catering services, which he regarded as having “very low” similarity, and bar services, which he regarded as having similarity at the “low end of the spectrum”.
- 4.4 Finally, he was wrong to ignore the risk of misrepresentation under section 5(4)(a) in the light of the well known trend of celebrity-owned eateries.”

Restaurant services

17. The crux of Mr. Malynicz’s argument was that the Hearing Officer took too restrictive a view of the meaning of restaurant services and the contexts in which restaurant services were provided.
18. That was compounded by the fact that the Hearing Officer focussed on: “entertainment in the nature of live concerts and performances by musical artists and groups” as providing UMG’s best case under section 5(2)(b), which meant that the

Hearing Officer failed to consider music events and festivals such as Glyndebourne and Glastonbury.

19. If the Hearing Officer had looked instead at the whole of UMG's Class 41 services particularly: "production and presentation of ... sports events, fashion shows, game shows, music shows ... [before live audiences which are all broadcast live or taped for later broadcast]"; and "conducting entertainment exhibitions in the nature of music festivals; organizing exhibitions for the promotion of music and the arts" then events like football matches and Glastonbury where food was provided would have been taken into account.
20. Moreover, even assuming restaurant services in the classic sense, the Hearing Officer failed to take into account dinner-jazz, i.e., restaurants providing also live musical entertainment.
21. Mr. Malynicz fastened upon the Hearing Officer's finding that a restaurant was an *establishment* where food was prepared and served to paying customers as indicating that the Hearing Officer had only in mind restaurant services in the classic sense of fine dining.
22. However, the Hearing Officer expressly noted (paragraph 27) that:

"... the Millers' apparent focus on their exact form of service (fine dining restaurant services) against UMG's primary field of activity (as a record label) is not the test to be applied. The test is, instead, a notional one based on the use (by both parties) of its respective mark in all the circumstances in which it might be used for the goods and services for which it is applied for or registered."
23. Furthermore, he clearly took on board UMG's arguments relating to live musical events which were mentioned at several points in his decision, for example:

"40. UMG's service could cover differing circumstances. For example, the service could be offered by individual musical artists/groups or their promoters who tour different venues or, perhaps, offer their services to weddings and other functions. Alternatively, a particular venue could also offer entertainment in the nature of live concerts or performances. It would most likely select different musical artists or groups to perform at the venue. The service would, effectively, be offered under the name of the venue.

41. UMG argues that there is a good deal of overlap between the services. It states in evidence that food and drink is often provided at music venues and concerts ..."
24. Mr. Malynicz acknowledged that the Hearing Officer was following UMG's arguments (in its evidence/submissions) in considering that UMG's best case lay with: "entertainment in the nature of live concerts and performances by musical artists and groups."

25. Nonetheless, the Hearing Officer stated: “I can see no closer term that would improve [UMG’s] case” indicating that he had in fact reviewed UMG’s entire specification.
26. In any event, “entertainment in the nature of live concerts and performances by musical artists and groups” (i.e., the best case service) covered music events and festivals such as Glyndebourne and Glastonbury relied on by Mr. Malynicz and it seems clear to me from the decision that the Hearing Officer had such occasions in mind.
27. It is true that no mention was made by the Hearing Officer of football matches. However, I do not believe that supports UMG’s contention that the Hearing Officer materially erred in principle in relation to restaurant services. The reason for the Hearing Officer’s finding that there was no similarity between, on the one hand “entertainment in the nature of live concerts and performances by musical artists and groups”, and on the other hand “restaurant services”, was that there was *no evidence* to support UMG’s assertion that the respective services were supplied through the same trade channels.
28. Contrary to Mr. Malynicz’s submission, I find that the Hearing Officer did consider the dinner-jazz scenario (although he referred to it as a “dinner concert”) but again in the absence of any supporting evidence thought this the exception rather than the norm.
29. Failing such evidence, the Hearing Officer refused to accept as a notorious fact that the trade channels of restaurant services and live entertainment overlapped. He said:

“Overall, I have found only one relevant factor (the end user) where there could be any similarity but I have also found that this is a superficial factor when it comes to general public targeted services. As such, I cannot find that these services are similar.”
30. In the circumstances, that was a finding he was entitled to make. I was not persuaded that the Hearing Officer fell into error in relation to restaurant services such that I should interfere with his decision on appeal.

Section 5(4)(a)

31. Mr. Malynicz accepted that his case in relation to restaurant services was narrower than under section 5(2)(b) because UMG was known as a record label business. However, he wished to make a cross-over point about celebrity-owned eateries.
32. Again, that point was raised below and considered by the Hearing Officer and UMG was merely asking me to revisit it on appeal:

“64. Although a common field of activity is not required under passing-off, it is still an important factor. In short, I do not see why anyone would believe that the ROC-A-FELLA record company is now providing a restaurant, bar or catering service (or food products). UMG refers to celebrities opening restaurants and bars. This, though is an exception rather than the rule and, in

any event, ROC-A-FELLA is not a celebrity, its artists are those with celebrity status. This ground of opposition fails.”

Catering services

33. Mr. Malynicz said he could see no logical distinction between the Hearing Officer’s conclusions under section 5(2)(b) in relation to, on the one hand, bar services and, on the other hand, catering services. In my judgment, there is justification in that criticism. An examining authority is under an obligation to state reasons for refusing to register a trade mark in relation to each of the services for which registration is sought although it may employ general reasoning where, because the same basis for refusal applies, it treats categories of services collectively (Case C-239/05, *BVBA Management Training en Consultancy v. Benelux-Merkenbureau* [2007] ECR I-1455, paras. 30 – 38, *SEPARODE Trade Mark*, BL O/399/10). It seems to me that in the instance of catering services the Hearing Officer did neither.
34. Regarding bar services, the Hearing Officer accepted as a notorious fact that the trade channels for the supply of live musical entertainment and bar services overlapped, which meant that the services were similar to a degree but given the differences in nature etc., any such similarity was at the lower end of the spectrum. There was a very high degree of similarity between the marks and the earlier trade mark was possessed of a high degree of distinctive character. Bearing in mind imperfect recollection and the principle of interdependence of factors in the global assessment of likelihood of confusion, there was a likelihood of confusion if ROCKAFELLA were to be registered and used for bar services.
35. As for catering services, in view of the Millers’ concession, the Hearing Officer held that the trade channels for the supply of live musical entertainment and catering services likewise overlapped. However, due to the different nature and intended purpose of the respective services, the similarity between them was very low. Again, there was a very high degree of similarity between the marks and the earlier trade mark was highly distinctive. However, in this instance (presumably again taking into account imperfect recollection and interdependence of factors) there was no likelihood of confusion.
36. The overlapping average consumer in both instances (i.e., live musical entertainment and bar services, and live musical entertainment and catering services) was the same general public. For bar services, the Hearing Officer thought that the purchase might be less considered, which could increase the risk of imperfect recollection. However, even if that were true, since the marks were virtually identical, imperfect recollection had little role to play.
37. The only reason given by the Hearing Officer for treating bar and catering services differently was that applying a subsequently or sequentially encountered test there was no likelihood of confusion. The argument that services bearing the respective trade marks might be encountered concurrently presupposed that UMG employed the Millers to provide catering services in their venue, which was hypothetical.
38. Firstly, I agree with Mr. Malynicz that it is not the law that a subsequently or sequentially encountered test must be applied. Secondly, even applying a

subsequently or sequentially encountered test, the Hearing Officer did not allow for (as conceded by the Millers) live musical entertainment and catering services being offered and encountered together on subsequent or sequential occasions. Thirdly, the Hearing Officer's hypothetical example assumed that UMG was responsible for the entire event (whatever that was), which in my view would not always or necessarily be the case.

39. In my judgment, the Hearing Officer should have treated bar and catering services on a collective basis and determined that the scope of protection for the earlier ROC-A-FELLA trade mark was against both services the same. As previously mentioned, the Hearing Officer's decision in relation to bar services was not the subject of challenge on appeal.

Conclusion

40. In the result, the appeal failed in relation to restaurant services but succeeded in respect of catering services.
41. It seems to me that both in the opposition and on appeal the parties have reached a score draw. I will therefore order that each party bear its own costs in connection with the opposition and this appeal.

Professor Ruth Annand, 31 January 2011

Mr. Simon Malynicz of Counsel instructed by Forresters appeared on behalf of UMG Recordings Inc.

Terry Miller and Linda Miller did not appear and were not represented.