

TRADE MARKS ACT 1994

IN THE MATTER OF

OPPOSITION No. 51067

IN THE NAME OF ROBIN LEVY

TO APPLICATION No. 2204534

TO REGISTER A SERIES OF 2 TRADE MARKS

IN THE NAME OF PEMBERTONS GROUP PLC

DECISION

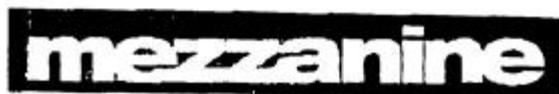
1. On 30th July 1999 Pembertons Group PLC (*“the Applicant”*) applied to register 2 marks in series for use in relation to the following services specified in Classes 41 and 42:

Class 41: Nightclub services; disc jockey services; audio and audio visual entertainment services.

Class 42: Catering for the provision of food; restaurant services.

The marks in the series were as follows:

MEZZANINE



mezzanine

They were put forward for registration in series on the basis that they “*resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark*”: see Section 41(2) of the Trade Marks Act 1994.

2. On 9th June 2000 the application for registration was opposed by Mr. Robin Levy (“*the Opponent*”). He contended that registration should be refused on the ground that the ordinary meaning and significance of the word **MEZZANINE** rendered it ineligible for registration in relation to the specified services under sub-paragraphs (b), (c) and (d) of Section 3(1) of the 1994 Act. In the pleadings it was asserted by the Opponent and admitted by the Applicant that:

The trade marks applied for each comprise a common and readily understood word in the English language being descriptive of, and used to identify, ‘a particular level within a building i.e. a low storey within a building and located between two others, usually between the ground and first floors’.

3. A witness statement of David Gill with 4 exhibits dated 18th May 2001 was filed in support of the opposition. Exhibit 1 consisted of photocopies of English dictionary entries for the word **MEZZANINE**. These confirmed that the word normally refers to an intermediate floor or storey of a building, especially one which is situated between the ground and first floor. Exhibit 2 was an investigator’s report dated 29th January 2001 which identified various instances of the word **MEZZANINE** being used in relation to restaurant and bar facilities; the facilities generally appear to have been located above

ground floor level in the premises where they were situated. Exhibits 3 and 4 contained further material relating to such instances.

4. The Applicant filed no evidence in support of its application. The opposition thus proceeded on the basis: (1) that the word **MEZZANINE** was not shown to have acquired a distinctive character through use in the United Kingdom prior to the date of the application for registration, see the proviso to Section 3(1); and (2) that neither of the marks in the series was said to be significantly more or significantly less distinctive than the other; they were both liable to be regarded as equally acceptable or equally unacceptable in terms of the requirement for distinctiveness as a condition of registration, see Section 41(2).

5. For the reasons given in a written decision issued by Mr. M Reynolds on behalf of the Registrar of Trade Marks on 14th January 2002, the opposition was upheld under Sections 3(1) (c) and 3(1)(d) of the Act in relation to the services specified in Class 42, but rejected in relation to the services specified in Class 41.

6. The Hearing Officer's reasons for refusing the application in Class 42, but accepting it in Class 41 were summarised in the following paragraphs of his decision:

28. I do not accept Mr. Gill's submission that **MEZZANINE** is open to objection in respect of a wide range of services in the entertainment field. The entertainment field can cover a very wide range of activities (most would be in Class 41) but I doubt that term would normally be taken to include restaurant services. Having carefully considered the evidence I accept that the term is widely use in relation to a range of eating and drinking establishments (restaurants, bars, cafes, brasseries, refreshment areas etc). I have hesitated in deciding whether usage extends to catering services. But I note examples in the evidence such as

‘catering and refreshments can be bought to your tables’ (the Broadway web-site), catering on the mezzanine level (Tourist Information Service Guide to Gatwick Airport).

29. I can find no evidence that the word **MEZZANINE** has any currency in relation to the applicants’ Class 41 services. That is not to say that such services could not or would not be found or offered on a mezzanine floor. But in terms of the test under Section 3(1) the word has not been shown to signify a characteristic of such services; has not been shown to be customary in the language of the trade for such services; and is not otherwise devoid of distinctive character for such services. I conclude that the opposition succeeds in relation to the Class 42 services only.

The application in Class 41 was thus regarded as unobjectionable under Sections 3(1)(b), 3(1)(c) and 3(1)(d).

7. In his assessment of the Opponent’s evidence relating to public use of the word **MEZZANINE** the Hearing Officer identified three modes of expression:

20. The opponent’s evidence taken as a whole shows use of **MEZZANINE** in a number of ways. For convenience I would group them as follows:

(i) use which appears to be as the name of a restaurant or similar establishment. The two instances are The Mezzanine in Wolverhampton (in DAG2) and Mezzanine in South East London (one of the entries in ‘Other restaurants in South East London’ in DAG 3). I infer that in each case it is the name of the restaurant because each entry in the listings gives a name and address. One of them I gather is the applicants’ premises.

(ii) a more numerous group where the reference to mezzanine is purely and identifiably descriptive usage to indicate the location of a restaurant within a building e.g. ‘Quaglino’s on the mezzanine level’ and ‘The Piano Bar with its mezzanine level.....’.

(iii) a further and by no means small number where references are to The Mezzanine or Mezzanine restaurant

where the nature of the usage can only be determined from the context in which it is used but which despite the ambivalent nature of the reference appears to be intended as descriptive use. Examples are the Broadway cinema/cafebars' Mezzanine (DAG3) - where sometimes the word is presented in upper case and sometimes lower case - and the mezzanine restaurant (DAG4).”

21. It is the second and third categories which make up most of the entries and which are most relevant for present purposes

8. With reference to the second category he said:

I do not think anyone would regard the sort of use shown in the second category to be anything other than locational information or, at least, I doubt it could be inferred that such use was making any statement as to the characteristics of the services on offer such as might give rise to an objection under Section 3(1)(c).

9. He considered the third category to be relevant as showing that the word **MEZZANINE** could be used to identify an amenity or facility that customers might find attractive:

22. The third category does cause me to pause for thought as to the nature and effect of such use. By way of example at the hearing I suggested that ‘rooftop’ or ‘riverside’ would be seen as descriptive usage because they would be likely to be seen as desirable characteristics of restaurants. A rooftop or riverside setting would form part of the ambiance which would attract customers to such a restaurant and in turn would be a characteristic that restaurant owners would be likely to use in advertising. On the other hand the fact that a restaurant was on the third floor, say, does not seem to me to make ‘third floor’ a characteristic of restaurant services. It has no obvious attractive force as a designator in its own right. Where then does **MEZZANINE** stand?

23. A not insignificant number of organisations come within the third of the above categories. In other words it is

relatively common practice to refer to mezzanine restaurants. From the context, and for reasons which I will comment on, I consider that this use is not simply to do with identifying the location of the restaurants. It seems that the location of a restaurant on a mezzanine floor has certain attractions in its own right largely because mezzanines often overlook other areas or at least offer a slightly elevated site. Thus Quaglino's has a mezzanine dining area 'overlooking the theatre of the restaurant', the brasserie Bonheur's web-site photographs shows its mezzanine overlooking a downstairs bar and dining area, similarly the web-site photograph of the AKA bar. The mezzanine restaurant of Tylers Lock on the Water is also promoted as offering attractive views of the garden, the canal and the Malverns. I conclude, therefore, that MEZZANINE consists exclusively of a sign which may serve in trade to designate a characteristic of certain services and is accordingly open to objection under Section 3(1)(c)...

10. He went on to say (paragraph 25) that

... given the common occurrence of references to mezzanine restaurants, even if I am wrong in drawing the inference I have as to why the existence of a mezzanine area may be a desirable characteristic of (particularly) restaurant services, it is nevertheless a term that is customary in the language of the trade. Accordingly it is open to objection also, or in the alternative, under Section 3(1)(d).

He did not find it necessary to decide whether the application in Class 42 was also objectionable under Section 3(1)(b).

11. The Opponent appealed to an Appointed Person under Section 76 of the Act. In substance he contended that the Hearing Officer had erred by determining the issues of distinctiveness, descriptiveness and customary usage on a basis which permitted registration of the designation **MEZZANINE** for the services specified in Class 41, even though (as recognised in paragraph 29 of his decision) it was not correct to say "*that such services could not or would not be found or offered on a mezzanine floor*".

12. The Opponent told me that he had brought the appeal because he was concerned about the effect that the application for registration in Class 41 might have upon his use of the designation **MEZZANINE** in relation to nightclub and musical entertainment services provided at mezzanine floor level in licensed premises in Southend-on-Sea, Essex.

13. The Applicant did not cross-appeal against the rejection of its application for registration in Class 42.

14. At the conclusion of the hearing before me it was agreed that I would defer my decision for an initial period of 2 months to allow time for the parties to explore the possibility of settlement. Through inadvertence on my part, that period has extended well beyond the 2 months initially envisaged. My present understanding is that there is no agreement or prospect of any agreement between the parties and therefore no reason to hold back my decision on the appeal.

Analysis

15. The applicability of any one of the absolute grounds for refusal listed in Section 3 of the Act is sufficient to prevent an application from proceeding to registration: Case C-104/00P DKV Deutsche Krankenversicherung AG v. OHIM (COMPANYLINE) [2003] ETMR 20, p.241 at paragraph 29.

16. The designation in issue must be assessed for distinctiveness in relation to the particular services in issue: Case C-517/99 Merz & Krell GmbH & Co [2001] ETMR

105, paragraphs 29 and 30; Case C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd [2003] RPC 2, p.14 at paragraph 59.

17. Each of the grounds for refusal listed in Section 3(1) of the Act is independent of the others and calls for separate consideration: Cases C-53/01 to C-55/01 Linde AG, Winward Industries Inc, Rado Uhren AG [2003] RPC 45, p. 803 at paragraph 67.

18. Section 3(1)(b) provides for refusal of registration on the ground that the sign in question lacks distinctiveness. There is no obligation when determining whether a sign is objectionable under Section 3(1)(b) to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness: COMPANYLINE (above), paragraph 20. The focus of the relevant inquiry is indicated in paragraphs 40, 41 and 47 of the Judgment of the ECJ in Linde AG and others (above):

“40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court’s case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

...

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

19. Section 3(1)(c) provides for refusal of registration on the ground that the sign in question is simply descriptive. The focus of the relevant inquiry is indicated in paragraphs 63 and 73 to 75 of the Judgment of the ECJ in Linde AG and others (above):

“63. As regards the first limb of the second question, it must be observed that, according to Article 3(1)(c) of the Directive, descriptive trade marks, that is to say, those which consist exclusively of signs or indications which may serve, in trade, to designate the characteristics of the goods or services for which registration is sought, are not to be registered.

...

73. According to the Court’s case-law, Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, to that effect, *Windsurfing Chiemsee*, paragraph 25).

74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3), any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.

75. The competent authority called upon to apply Article 3(1)(c) of the Directive to such trade marks must determine, by reference to the goods or services for which registration is sought, in the light of a concrete consideration of all the relevant aspects of the application, and in particular the

public interest referred to above, whether the ground for refusing registration in that provision applies to the case at hand. ...”

20. The objection is plainly applicable to signs and indications which consist only of wording “*which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought*” and which may therefore be viewed as a normal way of referring to the goods or services or of representing their essential characteristics in common parlance: Case C-383/99P Procter & Gamble v. OHIM (BABY-DRY) [2001] ECR I-6251, paragraphs 39 and 42.

21. It is also applicable to signs and indications which could be used for such purposes; so if at least one of the possible meanings of a mark that has been presented for registration designates a characteristic of the specified goods or services, it will for that reason be caught by the exclusion from registration contained in Section 3(1)(c) unless it can be found to have acquired a distinctive character through use: Cases C-191/01P OHIM v. Wm Wrigley Jr. Company (DOUBLEMINT) [2004] ETMR 9, p. 121 at paragraph 32.

22. There is descriptiveness for the purposes of Section 3(1)(c) if the mark in question “*may serve in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering services, **or other characteristics of goods or services.***” The wording in ordinary italics is taken with slight variation from paragraph B2 of Article 6 quinquies of the Paris Convention of 20th March 1883 (last revised at Stockholm in 1967). The words in bold italics were added by the

Community legislature and are evidently intended to ensure that the wording derived from the Paris Convention is regarded as illustrative and not exhaustive of the bases on which descriptiveness can be held to disqualify a mark from registration. Consistently with that approach, it appears to be necessary to interpret the word “*characteristics*” in the expression “*or any other characteristics*” as applicable not only to what a trader may be willing to supply, but also to when, where, why and how it may be supplied. Such matters - and suitable ways of designating them - are liable to vary according to the context or manner in which goods or services of the kind specified for registration may actually be provided by traders in the relevant line of business. I think it follows that a mark can be objectionable under Section 3(1)(c) without being descriptive in every context or manner in which it could be used with reference to goods or services of the kind specified in an application for registration.

23. Section 3(1)(d) provides for refusal of registration on the ground that the sign in question is customary in the current language or in the bona fide and established practices of the trade to designate goods or services of the kind for which registration is requested, whether or not it actually describes the properties or characteristics of such goods or services: Case C-517/99 Merz & Krell GmbH & Co [2001] ECR I-6959.

24. Paragraphs 57 to 59 of the Judgment of the ECJ in Case C-104/01 Libertel Groep BV v. Benelux-Merkenbureau [2003] ETMR 63, p.807 emphasise that a stringent and full examination is required in order to prevent trade marks from being improperly registered and indicate that the grounds for refusal of registration under Section 3(1) should be applied without regard to the lines of defence that might, if an application for registration is accepted, be open to a person subsequently accused of infringement. Paragraphs 55 to

57 of the Judgment of the CFI in Case T-295/01 Nordmilch eG v. OHIM (OLDENBERGER) 15th October 2003 and paragraphs 47 to 54 of the Opinion delivered by Advocate General Ruiz-Jarabo Colomer on 15th January 2004 in Case C-404/02 Nichols Plc v. Registrar of Trade Marks support that approach.

Assessment

25. The specification of the application for registration in Classes 41 and 42 covers the trading activities of establishments where customers may eat, drink, dance, enjoy disc jockey services or experience audio and audio visual entertainment.

26. Is the location of such an establishment a characteristic of the services provided by the proprietor of that particular establishment? According to the approach identified in paragraph 22 above, I think it is. I am therefore required by Section 3(1)(c) to regard it as an attribute that is fully and freely describable by means of signs or indications that do not possess a distinctive character.

27. Does the concept of location include, for this purpose, the location of an establishment within a building or complex of buildings? I think it does. The physical setting in which services are provided is, in terms of consumer perception, part of the package on offer. I see no reason to exclude descriptiveness as to services-in-situ from the scope of Section 3(1)(c).

28. In keeping with the case law of the ECJ it is sufficient for the purposes of Section 3(1)(c) to find that a sign or indication may serve to designate the location of an establishment at which services of the kind specified are provided. I do not accept that

there is any necessity for the particular aspect of location designated by the sign or indication to be a commercially attractive or desirable attribute. I part company with the reasoning in paragraphs 20 to 23 of the Hearing Officer's decision on this point.

29. It remains to be considered how likely it is that the mark put forward for registration in the present case may serve in trade to designate an aspect of the location of an establishment at which services of the kind specified are provided.

30. The propensity to be used and understood in that way is clearly recognisable in words such as 'basement', 'ground floor', 'balcony', 'terrace', 'patio', 'rooftop' and 'riverside'. The Hearing Officer considered that the same was true of the word **MEZZANINE** in relation to the services specified in Class 42. I agree with him on that point. However, it seems to me that the propensity of the word **MEZZANINE** to designate an aspect of location is as real in the case of an establishment which provides "*nightclub services*" "*disc jockey services*" or "*audio and audio visual entertainment services*" in Class 41 as it is in the case of an establishment which provides "*catering for the provision of food*" or "*restaurant services*" in Class 42. Such is the consequence of: (1) the word **MEZZANINE** being a plain way of referring to an intermediate floor or storey of a building, especially one which is situated between the ground and first floor; and (2) the far from unlikely prospect of services of the kind specified being provided by establishments located at mezzanine floor level in a building or complex of buildings.

31. For these reasons I consider that the application for registration should have been refused under Section 3(1)(c) in relation to the services specified in Classes 41 and 42.

32. In relation to the objection under Section 3(1)(d) I note that the evidence on file does not establish that the designation “mezzanine” is common to the trade in services of the kind specified in Class 41. I therefore reject that objection in relation to the application in Class 41.

33. I do not think that the present case is one in which an objection to registration under Section 3(1)(b) adds anything to an objection under Section 3(1)(c). Having upheld the objection under Section 3(1)(c), I propose to make no separate finding in relation to the objection under Section 3(1)(b).

Conclusion

34. The appeal is allowed. The application for registration in Class 41 is refused. I direct the Applicant to pay the Opponent £350 within 21 days of the date of this decision as a contribution towards his costs of pursuing the objection to registration in Class 41 before the Registrar and before me on appeal.

Geoffrey Hobbs Q.C.

16th February 2004

Mr. J. Reddington of Messrs Jones Day appeared on behalf of the Applicant.

The Opponent appeared in person.

The Registrar was not represented.