

O-065-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2328464  
BY HARLEQUIN LEISURE GROUP LIMITED  
TO REGISTER THE TRADE MARK:**

**ASHOKA KARAOKE**

**IN CLASSES 41 AND 43**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 92246  
BY  
SPICEWELL LIMITED**

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ASHOKA KARAOKE  
in classes 41 and 43 and the opposition thereto  
under no 92246  
by Spicewell Limited**

### **BACKGROUND**

1) On 4 April 2003 Harlequin Leisure Group Limited, which I will refer to as Harlequin, filed an application for the registration of the trade marks:

**ASHOKA KARAOKE  
ASHOKAKARAOKE  
KARAOKE ASHOKA  
ASHOKARAOKE**

The application form stated that the application was for a series of two trade marks. However, the application was recorded by the Trade Marks Registry on 8 April 2003 as being for a series of four trade marks. During the examination process Harlequin deleted what the Trade Marks Registry considered the three lower trade marks. The trade mark **ASHOKA KARAOKE** (the trade mark) was published for opposition purposes in the "Trade Marks Journal" on 17 October 2003 with the following specification:

*entertainment services; arranging, organising, hosting and conducting events and competitions for entertainment purposes; musical entertainment services; arranging, organising, hosting and conducting musical events and competitions; karaoke services; arranging, organising, hosting and conducting karaoke events and competitions; arranging, organising, hosting and conducting singing competitions; providing karaoke facilities; arranging, organising, hosting and conducting parties and functions; organising recreational activities; information, advisory and consultancy services relating to the aforementioned services;*

*services for providing food and drink; temporary accommodation, restaurant, bistro, brasserie, cafeteria, snack bar, canteen, coffee shop and tea shop services; bar, wine bar, and public house services; hotel services; preparation of foodstuffs and meals for consumption off the premises; information, advisory and consultancy services relating to the aforementioned services.*

The above services are in classes 41 and 43 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 19 January 2004 Spicewell Limited, which I will refer to as Spicewell, filed a notice of opposition to the registration of the application.

3) Spicewell's grounds of opposition are:

- The application was made for a series of two trade marks. It appears that the Trade Marks Registry captured them as a series of four trade marks in error. Spicewell claims that the trade mark, therefore, should have been published as:

ASHOKA KARAOKE  
ASHOKAKARAOKE

The trade mark as published is flawed in that Harlequin was not using the trade mark, nor had a bona fide intention to use the trade mark, as published as at 4 April 2003 when the application for a series of two trade marks was lodged. In the alternative, Harlequin did not request the amendment of the trade mark application (or did not request amendment in the prescribed manner) and the trade mark application was amended in a way that is outwith the scope of section 39(2) of the Trade Marks Act 1994 (the Act) and without any publication of the representation of the trade mark as provided for in section 39(3) of the Act.

Consequently, registration of the trade mark would be contrary to sections 32, 39(2) and (3) and 3(6) of the Act and rule 17 of the Trade Marks Rules 2000 (the Rules) and should be refused.

- Harlequin seeks registration of the trade mark for a very broad range of services. In respect of the following services:

*entertainment services; musical entertainment services; arranging, organising, hosting and conducting musical events and competitions; arranging, organising, hosting and conducting events and competitions for entertainment purpose; arranging, organising, hosting and conducting parties and functions; organising recreational activities;*

*temporary accommodation, preparation of foodstuffs and meals for consumption off the premises.*

registration of the trade mark would be contrary to section 3(3)(b) of the Act as the trade mark is of such a nature as to deceive the public if the services provided do not include karaoke services.

- The word karaoke is devoid of any distinctive character for karaoke services or arranging, organising, hosting and conducting karaoke events and competitions or providing karaoke facilities. It is also devoid of any distinctive character for other services which are specifically related to karaoke (bar, public houses or restaurant services which are related to karaoke). The word Ashoka is the name of an

ancient Indian king who is one of the most important figures in ancient Indian history. Ashoka is a common forename for Indian boys. As a result, it is a common name which is given to restaurants, in particular those selling what is generally described as Indian food. Ashoka is therefore devoid of any distinctive character for services in class 43. Consequently, it is submitted that ASHOKA KARAOKE is devoid of any distinctive character for:

*services for providing food and drink; restaurant, bistro, brasserie, cafeteria, snack bar, canteen, coffee shop and tea shop services; bar, wine bar, and public house services; hotel services; preparation of foodstuffs and meals for consumption off the premises; and any services relating to the aforesaid services*

and registration should be refused under section 3(1)(b) of the Act.

- ASHOKA KARAOKE, taking into account the above comments, consists exclusively of signs of indications which may serve in trade to designate the kind, intended purpose, or other characteristics of the services for which registration is sought and registration should be refused under section 3(1)(c) of the Act.
- Harlequin has a co-pending application under number 2327027 which was filed on 19 March 2003 as a series of six trade marks. This application seeks registration in classes 41 and 43 of trade marks including CURRY KARAOKE and KARAOKE CURRY. Harlequin seeks to monopolise the terms CURRY KARAOKE, KARAOKE CURRY and ASHOKA KARAOKE and had initially sought to monopolise the term:

ASHOKA KARAOKE  
ASHOKAKARAOKE

in relation to, inter alia, karaoke services; arranging, organising, hosting and conducting karaoke events and competitions; providing karaoke facilities; restaurant, bistro, brasserie, cafeteria, snack bar, canteen, bar, wine bar services etc (sic). It is clear that others have been providing karaoke services in conjunction with Indian food (including curry) since at least August 2002 in Glasgow. The trade mark application has accordingly been made in bad faith and should not be registered, having regard to section 3(6) of the Act.

- Spicewell seeks the refusal of the application and an award of costs.

4) Harlequin filed a counterstatement. It states the following:

- It applied for a series of four trade marks of which three were deleted. It has always had an intention to use the trade mark ASHOKA KARAOKE. It denies that registration of the trade mark would be contrary to sections 32, 39(2) and (3) or 3(6) of the Act or rule 17 of the Rules.

- Harlequin denies that the incorporation of the word karaoke means that the trade mark is of such a nature that it will deceive the public. Consequently, the ground of opposition under section 3(3)(b) of the Act is denied.
- The trade mark ASHOKA KARAOKE is distinctive for the services involved. It is denied that the application should be refused under section 3(1)(b) of the Act.
- Registration of the trade mark would not be contrary to section 3(1)(c) of the Act. The trade mark ASHOKA KARAOKE does not consist exclusively of sounds or indications which may serve in trade to designate the kind, intended purpose or other characteristic of the services.
- Harlequin admits that it has a co-pending application under number 2327027. It does not understand the relevance of this application to this case. Harlequin states that the whole point of applying to register a trade mark is to seek the granting of a statutory monopoly.
- Harlequin denies that the application was made in bad faith. The relevance of others providing karaoke services in conjunction with Indian food since at least August 2003 does not appear relevant, if it is proved that this is the case.
- Harlequin seeks the rejection of the opposition and the registration of the application. It also seeks an award of costs.

5) Only Spicewell furnished evidence.

6) The matter came to be heard on 21 February 2005. Spicewell was represented by Mr Hume of Fitzpatrick's. Harlequin was not represented, it did furnish written submissions.

## **EVIDENCE**

### **Statutory declaration of Alasdair Hume**

7) Mr Hume is a trade mark attorney. Mr Hume exhibits a copy of the registrar's file for the application. This shows that the application form indicated that the application was for a series of two trade marks. The application was captured by the Trade Marks Registry as being for a series of four trade marks. On 8 April 2003 the Trade Marks Registry sent a letter to the agents for Harlequin acknowledging receipt of the application and requesting payment of the application fee. The letter identified the application as being made for a series of four trade marks. The Marksman search report shows three earlier trade mark registrations as being identified, all in the name of Harlequin. All of these registrations include the word ASHOKA. Registration no 2043085A is for the trade mark ASHOKA word only and is for:

*restaurant, café, bar and catering services; preparation of food and drink; all being provided in Scotland.*

The examination report, dated 3 July 2003, again refers to a series of four trade marks. The only objection in the examination report relates to the application for a series. It advises that the objection would be overcome by dividing the application into four or by deleting three of the trade marks. A letter from the examiner, dated 18 September 2003, states that, as a result of a telephone call the previous day, the application will proceed with the first trade mark only. The trade mark is identified in the letter as being ASHOKA KARAOKE. The examiner has struck through what have been perceived as the other three trade marks. Mr Hume makes various submissions in relation to this matter. As this is not evidence of fact, I will say no more about these comments.

8) Mr Hume exhibits a copy of an extract from “The Penguin Dictionary of Religions” (second edition). This identifies Ashoka as an Indian emperor who reigned from c269-232 BCE who turned to Buddhist teachings and became a committed supporter of the Buddhist Sangha. A dictionary definition for karaoke is given which advises that the term refers to the practice of amateur performers singing pop songs to the accompaniment of recorded music.

9) The following matter is exhibited:

- Extract dated 19 January 2004 from records of Companies House for Ashoka Restaurant Limited in Northern Ireland. Extract from Northern Ireland “Yellow Pages” of 1999/2000 which shows an entry, under Indian restaurants, for Ashoka Restaurant in Belfast.
- Extract for theashokarestaurant.co.uk domain name. An extract from this website for the Ashoka restaurant. The domain name was applied for on 12 April 2000. The copy of the pages from the website states:

“Bringing over 35 years of experience in Indian gourmet cuisine. The Ashoka represents the culmination of a 35- year ambition – to serve really authentic Indian Food to our clientele who appreciate the genuine article”.

The pages from the website are dated 19 January 2004. The pages show that the restaurant is in Sheffield. The pages have a copyright date of 2003.

- Extract for the ashokamanchester.co.uk domain name. The domain name was applied for on 9 August 2001. Details from the records of Companies House which show that Ashoka Restaurant (Manchester) Ltd was incorporated on 11 September 2003.
- Extract for ashoka-restaurant.co.uk domain name. The domain name was applied for on 21 January 2000. Copies of two pages from the website for the restaurant which is situated in Hove. Included on the pages are the following:

“Our quality & service has earned a reputation that has made us the envy of our competitors and leaders in our field for almost 25 years..... 1995

was the year The Ashoka was voted Best Restaurant in the south of England by the Mirror, Patak's and most importantly the customers."

- Extract for ashokatandoori.co.uk domain name, applied for on 25 November 1999.
- Extract for ashoka-tandoori.co.uk, applied for on 17 January 2000.
- Details from the records of Ashoka Indian Cuisine Limited of Leicester. The company was incorporated on 24 February 2000.
- Two pages from the ashoka-indiancuisine.co.uk website. These are dated 5 August 2004. The restaurant is in Rosendale and is called Ashoka. The website states that the restaurant was opened in 2002.

10) Mr Hume exhibits details of Harlequin's registrations for the trade mark ASHOKA and



(trade mark registration nos 2043085A and B) which have the same specification:

*restaurant, café, bar and catering services; preparation of food and drink; all being provided in Scotland.*

Both registrations proceeded upon the basis of consent from the owner of registration nos 1524028/9. Also exhibited is a printout for trade mark application number 2327027 made by Harlequin for a series of trade marks: THE CURRY KARAOKE CLUB, CURRY KARAOKE CLUB, THE KARAOKE CURRY CLUB, KARAOKE CURRY CLUB, KARAOKE CURRY, CURRY KARAOKE.

#### **Statutory declaration of Siroos Bavarsagh**

11) Mr Bavarsagh is managing director of Spicewell. Spicewell operates the Ashoka restaurant in Glasgow. Since August 1998 Mr Bavarsagh has been involved in the running of the restaurant. The restaurant has two entrances. On the basement level is an à la carte restaurant. On the ground level there is a buffet restaurant, the two restaurants share the same kitchen. The buffet restaurant was refurbished from November 2002 to allow for the provision of "curry karaoke services". A couple of trial curry karaoke nights were tried at the end of 2002. Owing to delays in the building work the curry karaoke services started operation in mid-April 2003. Mr Bavarsagh exhibits a flyer for curry karaoke in the Ashoka and four advertisements from newspapers for karaoke nights

at the Ashoka. Two of the advertisements are from “TimesOut” of 24 April and 1 May 2003, the other two are from “Evening Times” of 8 and 22 May 2003. All these publications appear to be for Glasgow. None of the advertisements use the phrase curry karaoke.

12) Mr Bavarsagh states that he is not the first person to provide curry karaoke services in the Glasgow area. The term is used, he states, as a generic expression to describe karaoke held at an Indian restaurant where the food is mainly curries. In Glasgow the Panjae Restaurant has been providing curry karaoke services from August 2002. Mr Bavarsagh exhibits a flyer from the restaurant that refers to karaoke being presented there. There is no reference to curry karaoke on the flyer.

13) Mr Bavarsagh states that the provision of karaoke in combination with restaurant services is not new. It had been piloted three or four years earlier in Chinese restaurants; the Shanghai Shuffle in Glasgow is, according to Mr Bavarsagh, the longest established restaurant supplying karaoke services.

14) Mr Bavarsagh states that the reason for pursuing this opposition is to ensure that he can continue to use the terms karaoke and curry karaoke in combination with the restaurant and entertainment services at his Ashoka restaurant.

15) Mr Bavarsagh states that Harlequin provides restaurant services in Glasgow under the Ashoka name in combination with the location eg Ashoka West End, Ashoka Ashton Lane. Harlequin also provides entertainment services in combination with Indian food under the name of Harlequin Curry Karaoke Club. Mr Bavarsagh exhibits advertisements from the “Daily Mail” of 21 November 2003 and “Metro” of 23 January 2004 showing this use. Mr Bavarsagh states that use of the trade mark in relation to karaoke services would undoubtedly lead to confusion with the curry karaoke services which he has been providing since April 2003 and for which the first trial events took place at the end of 2002.

## **DECISION**

### **The series issue**

16) Spicewell claims that registration of the trade mark would be contrary to sections 32, 39(2) and (3) and 3(6) of the Act and rule 17 of the Trade Marks Rules 2000 (the Rules) as a result of the issues it has raised in respect of the original application for a series of trade marks. Section 32 of the Act states:

“32. - (1) An application for registration of a trade mark shall be made to the registrar.

(2) The application shall contain-

(a) a request for registration of a trade mark,

(b) the name and address of the applicant,

(c) a statement of the goods or services in relation to which it is sought to register the trade mark, and

(d) a representation of the trade mark.

(3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used.

(4) The application shall be subject to the payment of the application fee and such class fees as may be appropriate.”

Section 39 of the Act states:

“39. - (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

If the application has been published, the withdrawal or restriction shall also be published.

(2) In other respects, an application may be amended, at the request of the applicant, only by correcting-

(a) the name or address of the applicant,

(b) errors of wording or of copying, or

(c) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

(3) Provision shall be made by rules for the publication of any amendment which affects the representation of the trade mark, or the goods or services covered by the application, and for the making of objections by any person claiming to be affected by it.”

Section 3(6) of the Act states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

Rule 17 states:

“A request for an amendment of an application to correct an error or to change the name or address of the applicant or in respect of any amendment requested after publication of the application shall be made on Form TM21.”

Section 41 of the Act and rule 21 deal with series of trade marks:

“41. - (1) Provision may be made by rules as to-

(a) the division of an application for the registration of a trade mark into several applications;

(b) the merging of separate applications or registrations;

(c) the registration of a series of trade marks.

(2) A series of trade marks means a number of trade marks which 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.

(3) Rules under this section may include provision as to-

(a) the circumstances in which, and conditions subject to which, division, merger or registration of a series is permitted, and

(b) the purposes for which an application to which the rules apply is to be treated as a single application and those for which it is to be treated as a number of separate applications.”

“21. - (1) The proprietor of a series of trade marks may apply to the registrar on Form TM3 for their registration as a series in a single registration and there shall be included in such application a representation of each mark claimed to be in the series; and the registrar shall, if satisfied that the marks constitute a series, accept the application.

(2) At any time before preparations of publication of the application have been completed by the Office, the applicant under paragraph (1) above may request on Form TM12 the division of the application into separate applications in respect of one or more marks in that series and the registrar shall, if she is satisfied that the division requested conforms with section 41(2), divide the application accordingly.

(3) At any time the applicant for registration of a series of trade marks or the proprietor of a registered series of trade marks may request the deletion of a mark in that series, and the registrar shall delete the mark accordingly.

(4) The division of an application into one or more applications under paragraph (2) above shall be subject to the payment of a divisional fee and such application and class fees as are appropriate.”

17) In its written submissions Harlequin states:

“In Box 5 there was a typographical error. This was discussed with the receiving division of the Registry at the time who confirmed that the application was in respect of a series of four Marks.”

No evidence has been put in by Harlequin in relation to this claim. It would have been simple enough for it so to do. It cannot now try and introduce evidence by way of submission. The statement is not greatly helpful anyway. It is not for the Registry to confirm whether the application is for two or four trade marks. It is for the applicant to do this. It is to be noted that at no time was the number two corrected to read the number four. I add, for the sake of completeness, that there is no documentary evidence of this claim in the application file; a copy of which was filed by Spicewell. Consequently, the submissions of Harlequin will not affect my deliberations.

18) The evidence from the application file shows that from 8 April 2003 the Registry treated the application as being for a series of four trade marks. There is nothing to indicate if any contrary view was taken from the date of filing, on 4 April 2003; 5 April and 6 April 2003 were a Saturday and Sunday. I consider that taking into account the time frame that the Registry considered the application to be for a series of four. It was recorded as such and so at all times was recorded as a series of four trade marks upon the Registry’s database. It strikes me that this was the natural way of reading the application. There is no indication in the presentation of the trade marks that they should be grouped together in any manner. Spicewell has argued that the application should be read as being for a series of two trade marks, being:

ASHOKA KARAOKE  
ASHOKAKARAOKE

and

KARAOKE ASHOKA  
ASHOKAKARAOKE

However, there is nothing to suggest that such a reading would be correct. If the application was for a series of two trade marks, potentially all sequential combinations could be appropriate eg:

ASHOKA KARAOKE

and

ASHOKAKARAOKE  
KARAOKE ASHOKA  
ASHOKARAOKE

This is not necessarily to decry Spicewell's fundamental point as to the application being for a series of two, however, its view of what a series of two trade marks might be is not the only one.

19) At no time did Harlequin query the Registry's references to a series of four trade marks, from the letter of 8 April 2003 onwards. As I have indicated above, Harlequin has put in no evidence in relation to this matter; although it has made submissions about it. I have little doubt from the nature of the trade marks, from their spacing, from the reaction of the Registry and Harlequin's reaction to the Registry, that it was intended to make an application for a series of four trade marks. For third parties, accessing the Registry's database, it has always been an application for a series of four trade marks. In *Sieckmann v Deutsches Patent- Und Markenamt* Case C-273/00 [2003] RPC 38 the European Court of Justice stated:

“On the one hand, the competent authorities must know with clarity and precision the nature of the signs of which a mark consists in order to be able to fulfil their obligations in relation to the prior examination of registration applications and to the publication and maintenance of an appropriate and precise register of trade marks.

On the other hand, economic operators must, with clarity and precision, be able to find out about registrations or applications for registration made by their current or potential competitors and thus to receive relevant information about the rights of third parties.

If the users of that register are to be able to determine the precise nature of a mark on the basis of its registration, its graphic representation in the register must be self-contained, easily accessible and intelligible.

Furthermore, in order to fulfil its role as a registered trade mark a sign must always be perceived unambiguously and in the same way so that the mark is guaranteed as an indication of origin. In the light of the duration of a mark's registration and the fact that, as the Directive provides, it can be renewed for varying periods, the representation must be durable.

Finally, the object of the representation is specifically to avoid any element of subjectivity in the process of identifying and perceiving the sign. Consequently, the means of graphic representation must be unequivocal and objective.

In the light of the foregoing observations, the answer to the first question must be that Article 2 of the Directive must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually,

provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.”

This case was, of course, not dealing with a series issue; a concept that is alien to the European mainland. However, I consider it is appropriate to consider the judgment in the current case. I am of the view that the nature of the trade mark has been known with clarity and precision and that it will have been perceived at all times unambiguously; despite the claims of Spicewell as to how it considers the series of trade marks would have been perceived. In considering what could be potentially amended I bear in mind the approval of the comments of Mr Simon Thorley QC, sitting as the appointed person, in *Swizzels Matlow Ltd's Application* [1999] RPC 879 by Mummery LJ in *Société des Produits Nestlé SA v Mars UK Limited* [2005] RPC 5:

“Section 39 is, in my judgment, intended to restrict the ability of an applicant during the course of prosecution to change the application in any significant way so as to retain the priority date of the application and yet achieve registration of a mark of a different character. I do not believe that the amendment sought to limit the diameter and depth of the tablet is an amendment which is permissible under the Act. I therefore refuse to allow the amendment.”

I do not consider that treating the application as being one for a series of four trade marks, in this case, and deciding which four trade marks they were, was changing the application in any significant way.

20) Taking the above into account, I consider that the putting of the figure two in box 5 of the application form was an obvious mistake. I also consider that owing to the obvious nature of what the application was for that a correction of it would not affect the identity of the trade marks. In my view it is the sort of mistake that can be rectified under section 39 of the Act. However, I am then left with the issue as to the absence of evidence of a request to amend the application. Can tacit and constant acceptance of the Registry's view of the application be considered to be a de facto request for amendment? In this case, one also faces the circumstance that the Registry has accepted the application as being for a series of four trade marks from, it would appear, the beginning and so there was no reason for Harlequin to request a correction of the error, indeed there is no reason that Harlequin should have necessarily been aware of the error.

21) This case does raise issues as to how series of trade marks should be delineated upon the application form to make sure that there is no ambiguity as to what exactly forms each trade mark of the series. However, in this case I do not consider that there has been any real ambiguity. To reject the application on the basis that it was for a series of two trade marks rather than four would in my view be exceptionally captious. I consider that a balance has to be achieved between an extremely purist line in relation to procedural punctiliousness and obvious, and I use that word deliberately, intent and effect. **Consequently, I reject the opposition based upon the series issue; in all aspects. I cannot see, for instance, how such an obvious error can be the foundation of a claim**

**to bad faith.** (If I were to take a captious approach, I consider that the worst that could happen to the application is that the date of application would be amended to the date that the application was recorded upon the Registry's data base as a series of four trade marks, 8 April 2003.)

### **Bad faith – section 3(6) of the Act**

22) The bad faith claim is not restricted to the series issue. The two leading authorities in relation to bad faith are *Gromax Plasticulture Limited v. Don and Low Nonwovens Ltd* [1999] RPC 167 and *Harrison v Teton Valley Trading Co* [2004] EWCA Civ 1028. In *Gromax* Lindsay J stated:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes some dealings which fall short of the standard of acceptable commercial behaviour observed by reasonable and experienced men in the particular field being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

Sir William Aldous in *Harrison* commented:

“33. The judge applied the statement of Lindsay J in *Gromax* which is cited above in paragraph 18. He was right to do so. The words "bad faith" are not apt for definition. They have to be applied to the relevant facts of each case. The test is the combined test and the standard must be that of acceptable commercial behaviour observed by reasonable and experienced persons in the particular commercial area being examined. I stress "acceptable commercial behaviour" to exclude behaviour that may have become prevalent, but which would not upon examination be deemed to be acceptable.”

23) Spicewell states that Harlequin is trying to monopolise the words in its trade mark, although it defines this as:

ASHOKA KARAOKE  
ASHOKAKARAOKE

Harlequin responds that it is seeking a monopoly, that is why it is applying for a trade mark and trade marks grant statutory monopolies. Spicewell states that others have been supplying karaoke services in conjunction with Indian food in Glasgow. It also refers to another application made by Harlequin in relation to CURRY KARAOKE and KARAOKE CURRY. I do not see that the other trade mark application has any real bearing upon this case. It made that application and that application has now fallen, for whatever reason. The argument in relation to that earlier trade mark firstly conflates an

application for what may be a descriptive trade mark with an act of bad faith. It then goes on to state, effectively, that this represents a pattern of behaviour that can be defined as bad faith and which the current application forms a part of. I cannot see that applying for a trade mark that may be descriptive and for which registration may be refused on the basis of the need to leave free is an act of bad faith. Neither do I see that the two applications in tandem represent a pattern of behaviour that can be described as bad faith. They represent to me perfectly normal and acceptable commercial behaviour in relation to trade marks. The evidence suggests that the real concern is that Spicewell uses karaoke in relation to its Ashoka restaurant and so is concerned that it may face an infringement action. All trade mark registrations have the potential to engender infringement actions. Businesses are encouraged to apply to register their trade marks in order to protect their rights. I cannot see that there is anything in Harlequin's action that represents anything other than prudent, acceptable business behaviour; especially, as Mr Bavarsagh states in his declaration that Harlequin runs various restaurants in Glasgow using the name Ashoka. If Spicewell considers that it has prior rights to use of the words Ashoka and Karaoke in combination it could have included a ground of opposition under section 5(4)(a) of the Act, it has not. As the European Court of Justice stated in *Nichols plc v Registrar of Trade Marks* Case C-404/02 [2005] ETMR 21

“31 The registration of a trade mark constituted by a surname cannot be refused in order to ensure that no advantage is afforded to the first applicant since Directive 89/104 contains no provision to that effect, regardless, moreover, of the category to which the trade mark whose registration is sought belongs.”

I consider that this principle generally must hold good – put bluntly it is a first past the post system unless a third party can raise a successful stewards' enquiry through opposition, invalidation or observation.

24) It appeared from Mr Hume's submissions and his skeleton argument that he was also running an argument that the application was made in bad faith owing to the breadth of the specification. This is not a ground of opposition that is in the statement of grounds and so is not something that can be considered. If it had been part of the grounds there is no evidence to support the claim that Harlequin did not at the date of application have a bona fide intention to use the trade mark for the services of the application. In the absence of any evidence, all there is is speculation and conjecture which does not represent a basis for a claim of bad faith. The comments of Neuberger J in *Knoll AG's Trade Mark* [2003] RPC 10 are also to be noted:

“All I would say is that the fact that there is no equivalent of s.32(3) of the 1994 Act in the Directive means that this Court should be reluctant, rather than eager, to find in favour of the sort of argument raised by the claimant here.”

**25) I do not consider that the application by Harlequin can be viewed as representing an act of bad faith.**

### **Section 3(1)(c) of the Act**

26) Section 3(1)(c) of the Act refuses registration to:

“trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,”

On my asking Mr Hume what characteristic the trade mark represented, he did not press this ground of opposition. I can see no basis for any objection under section 3(1)(c) of the Act, or at least not on the evidence before me. **This ground of opposition is dismissed.**

### **Section 3(1)(b) of the Act**

27) Section 3(1)(b) of the Act refuses registration to trade marks which are devoid of any distinctive character. In *Linde AG v. Deutsches Patent- und Markenamt* Joined Cases C-53/01 to C-55/01 [2003] RPC 45 the European Court of Justice stated:

“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, para.[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] E.C.R. I-4657, para.[31], and Philips, para.[63]).”

“47 As para.[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.”

In *SAT.1 SatellitenFernsehen GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-329/02 P [2005] ETMR 20 the European Court of Justice stated:

“23 First, the essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from

others which have another origin (see, in particular, Case 102/77 Hoffmann-La Roche [1978] E.C.R. 1139, [7], and Case C-299/99 Philips [2002] E.C.R. I-5475, [30]). Article 7(1)(b) of the regulation is thus intended to preclude registration of trade marks which are devoid of distinctive character which alone renders them capable of fulfilling that essential function.”

“26 As regards the registration as trade marks of colours per se, not spatially delimited, the Court has already ruled, in *Libertel*, [60], that the public interest underlying Art.3(1)(b) of the First Council Directive 89/104 of 21 December 1988 to approximate the laws of the Member States relating to trade marks ( [1989] O.J. L40/1), a provision which is identical to Art.7(1)(b) of the regulation, is aimed at the need not to restrict unduly the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought.

27 Furthermore, in view of the extent of the protection afforded to a trade mark by the regulation, the public interest underlying Art.7(1)(b) of the regulation is, manifestly, indissociable from the essential function of a trade mark, as observed in [23] above.

28 Finally, as regards a trade mark comprising words or a word and a digit, such as that which forms the subject-matter of the dispute, the distinctiveness of each of those terms or elements, taken separately, may be assessed, in part, but must, in any event, depend on an appraisal of the whole which they comprise. Indeed, the mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that their combination cannot present a distinctive character (see, by analogy, Case C-265/00 *Campina Melkunie* [2004] ECR I-0000, paragraphs 40 and 41, and C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-0000, paragraphs 99 and 100).”

“41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.

42 Where a trade mark which does not fall foul of the ground of refusal laid down in Article 7(1)(c) of the regulation is none the less devoid of distinctive character within the meaning of Article 7(1)(b) thereof, the Office must also set out the reasons why it considers that that trade mark is devoid of distinctive character.”

28) I do not consider that there is any doubt that KARAOKE is devoid of any distinctive character in relation to services that do or could include karaoke. What is the combined effect of its combination with ASHOKA? It is necessary to consider the word ASHOKA in relation to the services of the application. I do not see that the fact that ASHOKA was

the name of an ancient Indian king has any relevance in relation to the services under consideration. The only realistic basis for Spicewell's attack, in my view, is in relation to Indian restaurant services. The only potentially relevant evidence relates to the use of ASHOKA by other Indian restaurants; we know from Spicewell's evidence that it uses the name ASHOKA and so does Harlequin. The actual evidence demonstrates, at best, excluding the use by Spicewell and Harlequin, that the word ASHOKA was used prior to the date of application by Indian restaurants in Belfast, Hove, Leicester and Rosendale. The evidence relating to the restaurant in Sheffield does not show that it was using ASHOKA prior to the date of application, the evidence shows that it is bringing thirty five years of experience in Indian gourmet cuisine and that it represents a culmination of a thirty five year ambition, not that it has been using the name ASHOKA for thirty five years or even before the date of application. The evidence relating to domain names, where there is no further supporting evidence, tells me nothing about the actual trade. Mr Hume intimated that there could be other restaurants but that his research was limited. I can only consider the evidence before me. Spicewell has also made reference to Harlequin's earlier trade mark registrations. I have to consider the trade mark before me based upon the evidence before me and in relation to the material date. The existence of earlier registrations of Harlequin cannot influence me as to the registrability or otherwise of the trade mark of this application for restaurant related services. I cannot presume that the current application is registrable on the basis that there is a presumption of validity in relation to the earlier registrations. (I do not consider that the limitation of the specification to Scotland has any bearing upon this issue either.)

29) The *Nichols* case established, in the context of surnames, that a decision could not be made to the distinctiveness of a trade mark upon the basis of counting the number of times it occurs in a telephone directory. In that case the European Court of Justice stated:

“27 The distinctive character of a trade mark, in whatever category, must be the subject of a specific assessment.”

I have to consider the trade mark as a whole, however, in order to do this I also need to consider the separate elements and of key importance in this case is, in my view, the word ASHOKA. The issue of analysing the separate elements in order to reach a conclusion as to the whole was dealt with by the European Court of Justice in *Procter & Gamble Company v OHIM*, Joined Cases C-468/01 P to C-472/01 P [2004] ETMR 88:

“44 As the Court has consistently held, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see *SABEL*, paragraph 23, and *Lloyd Schuhfabrik Meyer*, paragraph 25). Thus, in order to assess whether or not a trade mark has any distinctive character, the overall impression given by it must be considered (see *SABEL*, paragraph 23, and, in relation to a word mark, *DKV v OHIM*, paragraph 24).

45 That does not mean, however, that the competent authority, responsible for ascertaining whether the trade mark for which registration is sought - in this instance the graphic representation of a combination of the shape of a washing

machine or dishwasher tablet and the arrangement of its colours - is capable of being perceived by the public as an indication of origin, may not first examine each of the individual features of the get-up of that mark in turn. It may be useful, in the course of the competent authority's overall assessment, to examine each of the components of which the trade mark concerned is composed.”

30) Does the use by five other Indian restaurants of the word ASHOKA amount to the word, on its own, being devoid of any distinctive character for the services under attack at the date of application, the word ASHOKA being unable to act as an indicator of origin? I do not consider that the word ASHOKA is caught by the public interest bar under section 3(1)(b), which as the European Court of Justice pointed out in *SAT.I* is not the same as under section 3(1)(c). I cannot see that rights in ASHOKA would unduly restrict the availability of others to offer restaurant services under a normal sign. It could potentially just restrict the choice of trade mark, which is what all trade mark registrations do; going back to Harlequin’s admission that it is seeking a monopoly. The question, in my view, is to whether the word ASHOKA is commonly enough used by others in relation to Indian restaurant services to stop it acting as an indicator of origin. As I have indicated I have to consider the position at the date of application, so again the position of the earlier registrations tells me nothing – the situation could have changed. Does the existence of five other Indian restaurants mean that in the United Kingdom that the word ASHOKA for the relevant services is devoid of any distinctive character? The existence of five other restaurants in geographically distant places does not suggest that ASHOKA is a commonly used designation for Indian restaurants; although Harlequin’s use is not unique. However, a trade mark does not have to be unique. It is a moot point to decide when the use by others in trade of a sign deprives of it any distinctive character. For certain pub names, the answer is going to be obvious. It seems to me that the claim to the non-distinctive nature of ASHOKA in relation to restaurant services is occupying an area between a potential relative objection and an absolute one. The former, of course, could well be blocked by earlier use and is not the subject of the opposition. In the end, and after a good deal of consideration, I have come to the conclusion that the limited use by others in the same business, Indian restaurants, of ASHOKA does not mean that when used by Harlequin that it would be devoid of any descriptive character, that it could not act as an indication of origin of Indian restaurant services from Harlequin. In reaching this conclusion I take into account that for the average customer in the United Kingdom for Indian restaurant services, the public at large, ASHOKA would mean nothing other than the indication of the business. The small number of restaurants over a wide geographical spread means that it is unlikely that the average consumer, who is anyone who eats Indian food, would see ASHOKA as indicating anything other than origin. I consider that the European Court of Justice’s finding in *Nichols* in relation to Article 6(1)(a) of First Council Directive 89/104 of December 21, 1988 must also apply in relation to Article 6(2) and so in coming to this conclusion I have not been influenced by other undertakings being able to look to Article 6(2) (implemented by section 11(3) of the Act) for protection. On the basis that I do not consider that ASHOKA on its own is devoid of any distinctive character, I cannot see that the trade mark as whole can be devoid of any distinctive character. **The ground of opposition under section 3(1)(b) of the Act is dismissed.**

### **Deceptiveness – section 3(3)(b) of the Act**

31) Under section 3(3)(b) of the Act a trade mark shall not be registered if it is “of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service)”. In *Miguel Torres SA v Cantine Mezzacorona SCARL* [2004] RPC 25 Neuberger J stated:

“It seems to me clear that s.3(3)(b) is, as a matter of ordinary language, plainly concerned with actual or likely deception.”

Taking into account the nature of the services, the likely expectation of the average consumer for the services and the nature of the trade mark is there likely to be deception, will the reasonable expectations of the average consumer for the services be thwarted? Spicewell under this ground of opposition has only attacked the following services:

*entertainment services; musical entertainment services; arranging, organising, hosting and conducting musical events and competitions; arranging, organising, hosting and conducting events and competitions for entertainment purpose; arranging, organising, hosting and conducting parties and functions; organising recreational activities;*

*temporary accommodation, preparation of foodstuffs and meals for consumption off the premises.*

If the trade mark was used in relation to the class 41 services listed above, it seems to me that the average consumer of the services would at first blush assume that the services involved karaoke. However, taking into account the nature of the services, that the average consumer is deemed to be reasonably well informed and reasonably circumspect and observant (see *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] F.S.R. 77), that misapprehension is unlikely, in my view, to survive further enquiry and certainly not the purchasing process. I, therefore, consider that there will be no deception in relation to the class 41 services under attack under this ground of opposition.

32) In relation to the class 43 services I cannot envisage how or why the average consumer, would consider that the services would involve the use of karaoke. Indeed, it is very difficult to imagine such services involving karaoke. I do not consider that it is likely that there would be deception in relation to the class 43 services listed above.

33) In relation to all of the services under attack, I am of the view that the average consumer is likely to be the general public at large.

**34) The ground of opposition under section 3(3)(b) of the Act is dismissed.**

## **Conclusion**

35) Mr Bavarsagh makes statements in his declaration which, in my view, indicate the true nature of this opposition. He states that use of the trade mark in relation to karaoke services would undoubtedly lead to confusion with the curry karaoke services which he has been providing since April 2003 and for which the first trial events took place at the end of 2002. He goes on to state that the reason for pursuing this opposition is to ensure that he can continue to use the terms karaoke and curry karaoke in combination with the restaurant and entertainment services at his Ashoka restaurant. It strikes me that this case was brought because of concern about relative grounds, not absolute grounds; which has given rise to the fundamental flaws in the opposition. I have, of course, only considered the case upon the basis of the absolute grounds raised; the motivation of Spicewell is not something that has influenced my decision.

## **COSTS**

36) Harlequin Leisure Group Limited has been successful in this opposition and so is entitled to a contribution towards its costs. Mr Hume made various submissions in relation to costs. I consider that there is nothing in the conduct of this case that should give rise to a variation from the standard scale of costs. I order Spicewell Limited to pay Harlequin Leisure Group Limited the sum of £500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 14th day of March 2005**

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