O-0675-23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3766257

BY

BAR CODE (VAUXHALL) LIMITED

TO REGISTER

FANTAZYA

AS A TRADE MARK IN CLASSES 41 & 43

AND

OPPOSITION THERETO (UNDER NO. 433690)

BY

JAMES EDWARD PERKINS

BACKGROUND

1) On 16 March 2022, Bar Code (Vauxhall) Limited ('the applicant') applied to register the word FANTAZYA, as a trade mark, in respect of the following services:

> **Class 41:** Nightclub services [entertainment]; Entertainment services provided at nightclubs; Night clubs.
>
> **Class 43:** Cocktail lounges; Lounge services (Cocktail -);Cocktail lounge buffets; Cocktail lounge services; Hookah lounge services; Hookah bar services; Shisha bars; Restaurants; Restaurant services; Restaurant and bar services; Restaurant services incorporating licensed bar facilities; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Private members drinking club services; Private members dining club services; Night club services [provision of food];Club services for the provision of food and drink.

2) The application was published in the Trade Marks Journal on 01 April 2022 and notice of opposition was later filed by James Edward Perkins ('the opponent'). The opponent claims that the trade mark application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act').

3) In support of its ground under section 5(2)(b) of the Act, the opponent relies upon the following trade mark registration and certain of the services covered by that registration, as follows:

- **UKTM 3272391 (a series of 4 marks)**

  FANTAZIA
  Fantazia
  

Fantazia

Class 41: Entertainment; arranging, conducting and organisation of live entertainment, parties, raves and festivals; live music events; hire of staging, stage scenery and props; hire of stage lighting; club entertainment; indoor and outdoor musical entertainment; DJ and live act booking and agency services and radio entertainment services; musical, dramatic, radio and television entertainment; entertainment services provided by DJs and music groups; production of live, television and radio performances and of audio, video and cinematographic recordings; production of television and radio programmes; audio and video recording services; provision of music and entertainment facilities in the nature of dance promotions and night-club events; DJ services; organising and conducting concerts, parties, raves, shows, events and spectacles; providing facilities for concerts, parties, raves, shows, events and spectacles; discotheque, nightclub and cabaret services; reservation services for concerts, parties, raves, shows, events and spectacles; publishing and electronic publishing; production and publication of flyers and posters; music publishing and publishing of audio and audio/visual recordings; photography and photography services; arrangement, reservation, information, advisory and consultancy relating to all the aforesaid.

Filing date: 22 November 2017
Date of entry in register: 11 May 2018

4) It is claimed that the respective services are either identical or highly similar and that the respective marks are highly similar such that there exists a likelihood of confusion under Section 5(2)(b).

5) The trade mark relied upon by the opponent is an ‘earlier’ mark, in accordance with section 6 of the Act. As it had not been registered for five years or more at the

filing date of the contested application, it is not subject to the proof of use conditions as per Section 6A of the Act.

6) The applicant filed a counterstatement. The following points are made therein:

- The parties' marks are not the same.
- The contested mark is derived from a Morrocan Arabic word which the applicant states is defined as 'a combination of horse riding and shooting, still practiced in the Maghreb'.
- Although the respective marks may sound similar, they have different meanings and are spelt differently.
- The parties' marks are used for different purposes and have different values.

7) The opponent is represented by Forresters IP LLP. The applicant is without legal representation. Only the opponent filed evidence. This consists of a very brief witness statement and one exhibit thereto from Nathan Chambers, a Chartered Trade Mark Attorney at Forresters IP LLP. It suffices to record here that the purpose of the evidence is to show how the applicant is currently using its mark (in relation to an Arabic nightclub in London). However, for the reasons explained later in this decision, I must assess the matter notionally and objectively and not upon the way that either party is currently making use of their marks. This evidence is, therefore, of no relevance to the matter before me and I will say no more about it. Neither party requested a hearing nor filed written submissions in lieu. I now make this decision after consideration of the papers before me.

DECISION

8) Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. As the provisions of the Act relied upon in these proceedings are derived from an EU Directive, I will, therefore, take account of trade mark case law of the EU courts.

9) Section 5(2)(b) of the Act states:

> "5. - (2) A trade mark shall not be registered if because –
>
> (a)….
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
>
> 5A. Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

10) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well

informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The correct approach

11) In its counterstatement, the applicant states that the parties' marks are 'used for different purposes and have different values'. In the light of this statement, it is necessary for me to explain what the correct approach is that I must take when assessing the similarity between the parties' services.

12) The first point to make is that, as noted earlier, the opponent's mark is not subject to the 'proof of use' requirement. The opponent is therefore entitled to rely upon all of the services covered by its registration in class 41 without having to show that it has actually used its mark in relation to any of them. The second point is that I am required to make the assessment of the likelihood of confusion notionally and objectively based on the opponent's services, as registered, and the applicant's services, as applied for, in accordance with the relevant case law. That assessment requires that I must not take into account the actual way that either party has used their marks in the marketplace or the kinds of services (or goods) that those marks have been used in relation to thus far. Rather, I must consider all of the circumstances in which the mark applied for might be used if it were registered[1]. In this connection, in *Devinlec Développement Innovation Leclerc SA v OHIM,* Case C-171/06P, the CJEU stated:

> "59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks."

[1] As per *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited,* Case C- 533/06, [66]

The actual services currently being provided and/or current marketing strategies being adopted by either party in the marketplace is therefore not relevant to my assessment.

Comparison of services

13) All relevant factors relating to the services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

14) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

15) I also note that in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM* Case T-133/05) ('*Meric*'), the General Court held that:

"29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275,paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42)."

16) The services to be compared are:

Opponent's services	Applicant's services
Class 41: Entertainment; arranging, conducting and organisation of live entertainment, parties, raves and festivals; live music events; hire of staging, stage scenery and props; hire of stage lighting; club entertainment; indoor and outdoor musical entertainment; DJ and live act booking	**Class 41:** Nightclub services [entertainment]; Entertainment services provided at nightclubs; Night clubs. **Class 43:** Cocktail lounges; Lounge services (Cocktail -);Cocktail lounge buffets; Cocktail lounge services; Hookah lounge services; Hookah bar

and agency services and radio entertainment services; musical, dramatic, radio and television entertainment; entertainment services provided by DJs and music groups; production of live, television and radio performances and of audio, video and cinematographic recordings; production of television and radio programmes; audio and video recording services; provision of music and entertainment facilities in the nature of dance promotions and night-club events; DJ services; organising and conducting concerts, parties, raves, shows, events and spectacles; providing facilities for concerts, parties, raves, shows, events and spectacles; discotheque, **nightclub** and cabaret **services**; reservation services for concerts, parties, raves, shows, events and spectacles; publishing and electronic publishing; production and publication of flyers and posters; music publishing and publishing of audio and audio/visual recordings; photography and photography services; arrangement, reservation, information, advisory and consultancy relating to all the aforesaid. (my emphasis)	services; Shisha bars; Restaurants; Restaurant services; Restaurant and bar services; Restaurant services incorporating licensed bar facilities; Providing food and drink for guests in restaurants; Providing food and drink in restaurants and bars; Private members drinking club services; Private members dining club services; Night club services [provision of food];Club services for the provision of food and drink.

17) All of the applicant's services in class 41 fall within the opponent's 'Entertainment' services. They are also self-evidently identical to the opponent's 'nightclub…services'. The applicant's class 41 services are, therefore, notionally and objectively identical to the opponent's services.

18) I now turn to consider the applicant's services in class 43. In doing so, I will group certain services together where it is appropriate to do so[2].

Restaurants; Restaurant services; Restaurant services incorporating licensed bar facilities; Providing food and drink for guests in restaurants; Providing food and drink in restaurants; Private members dining club services.

19) It seems to me that the opponent's strongest case against these services of the applicant is its 'entertainment' and 'nightclub services'. In this connection, I bear in mind the decision of the Appointed Person, Professor Ruth Annand, in *Eat Tokyo* (BL O/449/15). In that case, Professor Annand overturned the Hearing Officer's decision that 'Chinese restaurant services…' were not similar to the applicant's 'nightclub services'. Professor Annand concluded, as follows:

> "53. Based on the evidence on file, the dictionary definitions and my own experience which mirrors that of the Hearing Officer (see paras. 40 – 41 above), I find that there some similarity between Chinese restaurant services but not including any such services relating to alcoholic beverages and nightclub services in Class 41. I accept Mr. Edenborough's contention that the supply of food and drink (albeit non-alcoholic) is important to the provision of the entertainment aspects of nightclub services, for example, dancing, in such a way that customers might think the responsibility for those services lies with the same undertaking. The services might not unusually be provided contemporaneously and through the same supply channels. In my judgment, the type of food or drink served is irrelevant.

[2] As per *Separode Trade Mark* (BL O-399-10)

54. The Hearing Officer found that the respective trade marks were similar to a high degree and that the earlier trade mark TAO figurative had a good degree of inherent distinctiveness. I did not understand the parties to challenge those findings with which, in any event, I agree. 55. Applying the guidance of the Court of Justice of the European Union in the leading cases including Case C-251/91, Sabel BV v. Puma AG [1997] ECR I-6191, Canon, Case C-342/97, Lloyd Schuhfabrik Meyer & Co GmbH v. Klijsen Handel BV [1999] ECR I-3819 and Case C-425/98 Marca Mode CV v. Adidas AG [2000] ECR I-4861, in my judgment there would be a likelihood of confusion in the minds of the public including a likelihood of association with the earlier trade mark, if Asia Five Eight were permitted to register TAO ASIAN BISTRO for use as a trade mark in the United Kingdom in relation to nightclub services in Class 41." (my emphasis)

Taking the above decision into account and my own experience as an average consumer of the relevant services, I find that there to be a low degree of similarity between the opponent's 'entertainment' and 'nightclub services' in class 41 and the applicant's restaurant-type services and private members dining club services in class 43.

Night club services [provision of food]; Club services for the provision of food and drink.

20) There is obviously a high degree of similarity between the applicant's 'Night club services [provision of food]' in class 43 and the opponent's 'Nightclub services' in class 41. The difference between them is that the opponent's services in class 41 cover the entertainment side of nightclubs and the contested services cover the provision of food in nightclubs[3]. The users and trade channels are the same. There

[3] See, again, the decision of Professor Annand in *Eat Tokyo* at [43] – [44] where she said:
"43. Pausing there, no exception was taken to the Hearing Officer's: (a) citation of *Altecnic Ltd's Trade Mark Application* [2002] RPC 639. In that case, the Court of Appeal held that a specification of goods and services must be interpreted in the context of the Class for which they were applied; or (b) determination that the Application in Class 41 covered the entertainment (as opposed to the food and drink) aspects of the provision of nightclub services.
44. It is again worth noting at this point the obvious fact that if Class 41 had encompassed the food and drink side of nightclub services then, of course, identity of services would have been involved."

is clearly overlap in nature and methods of use. The respective services will be provided contemporaneously and there is a complementary relationship in play. The same similarities arise between the opponent's 'nightclub services' in class 41 and the applicant's '*Club services for the provision of food and drink'* because the 'club services…' referred to in the latter cover nightclubs. The respective services are very highly similar.

Bar services; Providing food and drink in bars; Private members drinking club services; Cocktail lounges; Lounge services (Cocktail -); Cocktail lounge buffets; Cocktail lounge services.

21) The applicant's services listed above also share some similarity to the opponent's 'nightclub services' in class 41. The users and trade channels are likely to be the same. They are all likely to be used by friends on a night out to socialise. The respective services may be provided contemporaneously, and the applicant's services may be important for the provision of the opponent's services in such a way that the consumer believes the respective services to be the responsibility of the same undertaking. There is a medium degree of similarity between the respective services.

Hookah lounge services; Hookah bar services; Shisha bars.

22) I understand a hookah lounge/shisha lounge to be a bar that provides drinks and flavoured tobacco for the consumer to smoke within the establishment. There is some similarity between these services and the entertainment aspects of the opponent's 'nightclub services' in class 41. The users and trade channels may be the same or overlap significantly and all may be visited as part of a relaxing social gathering/night out to socialise with friends. The respective services may be provided contemporaneously, and the applicant's services may be important for the provision of the opponent's services in such a way that the consumer believes the respective services to be the responsibility of the same undertaking. There is a medium degree of similarity between the respective services.

Average consumer and the purchasing process

23) It is necessary to determine who the average consumer is for the respective services and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

24) The average consumer of the parties' services is the general public. The level of attention may vary. For example, more care may be taken when choosing a high-end restaurant or a private members drinking/dining club than to a high-street nightclub or bar. However, generally speaking, the level of attention is likely to be at a medium level. I would expect the relevant services to be encountered primarily by visual means on websites, signage on bricks and mortar establishments and flyers/advertisements. However, aural use of the marks is also borne in mind taking into account word-of-mouth recommendations (for example).

Comparison of marks

25) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take account of their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

26) The opponent's earlier registration consists of a series of 4 marks. I will make the comparison between the parties' marks using the opponent's FANTAZIA mark. If the opponent does not succeed on that basis, it would clearly be in no better position as regards any of the other three marks in the series. Accordingly, the marks to be compared are:

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Neither mark lends itself to deconstruction into separate elements. Their respective overall impressions are based solely upon the single word of which they are comprised.

27) Visually, the marks are identical save for the different penultimate letter ('I' in the earlier mark and 'Y' in the later mark). They are patently visually similar to a very high degree.

28) Aurally, both marks will be pronounced as FAN-TAYZ-EE-AH. They are aurally identical.

29) Conceptually, the applicant contends that its mark has a different meaning to the earlier mark. I do not agree that the average consumer is likely to grasp different meanings from the respective marks. There is no evidence before me to support

such a finding (including the information provided by the applicant in its counterstatement as regards the claimed meaning of its mark). In my view, if any concept at all is grasped from either mark it is likely to be the same.

Distinctive character of the earlier mark

30) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

The earlier mark is neither descriptive nor obviously allusive in relation to any of the relevant earlier services. I find it to be possessed of a normal degree of inherent

distinctiveness. There is no evidence before me to indicate that its inherent degree of distinctiveness has been elevated through use.

Likelihood of confusion

31) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V).*

32) Some of the respective services are identical; others are similar to varying degrees (low, medium and very high). The marks are visually very highly similar and aurally identical. If any concept at all is grasped from either mark it is likely to be the same. The earlier mark also has a normal degree of distinctiveness. Weighing all these factors, I find that an average consumer paying a medium degree of attention is likely to mistake one mark for the other when used in relation to the services at issue. I make this finding even where the degree of attention may be higher than medium (as per the examples given in paragraph 24). **The opposition under Section 5(2)(b) of the Act succeeds in full.**

COSTS

33) As the opponent has been successful, he is entitled to a contribution towards his costs. I will make no award for the preparation and filing of the opponent's evidence because it was very thin and of no relevance. Using the guidance in Tribunal Practice Notice 2/2016, I award the opponent costs on the following basis:

Preparing a statement and considering the other side's statement	£200

Official fee (Form TM7)	£100
Total:	**£300**

34) I order Bar Code (Vauxhall) Limited to pay James Edward Perkins the sum of **£300**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12 day of July 2023

Beverley Hedley
For the Registrar,
the Comptroller-General