

O-096-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3048027

BY

MODE IP LIMITED

TO REGISTER THE TRADE MARK

MODE

IN CLASS 43

AND

THE OPPOSITION THERETO

UNDER NO 600000130

BY

PROMENADE HOTEL (ST ANNES) LIMITED

BACKGROUND

1. On 21 March 2014, Mode IP Limited (the applicant) applied to register the trade mark: **MODE** in class 43 of the Nice Classification system.¹ The specification stands as follows:

Class 43

Nightclub services; restaurant services

2. The application was published on 2 May 2014, following which Promenade Hotel (St Annes) Limited (the opponent) filed notice of opposition against the application under the fast track opposition procedure.

3. The opposition was brought under sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (the Act). The opponent relies upon UK trade mark 2550938, shown below:

Mark details and relevant dates	Services relied on
<p>Series of two marks:</p> <p>MODE mode</p> <p>Filing date: 21 June 2010</p> <p>Date of entry in the Register: 24 September 2010</p>	<p>Class 43</p> <p>Services for providing temporary accommodation; hotel and resort services; hotels; motels; food and drink; restaurants, bar and cocktail lounge services; providing conference, convention, seminar, exhibition and meeting facilities; providing banquet and social function facilities for special occasions; catering for the provision of food and beverages; booking of accommodation; booking of accommodation online from a computer database or the Internet; information and advisory services relating to the aforesaid.</p>

4. On 18 December 2014, the applicant filed a counterstatement, denying the grounds of opposition.

5. Rules 20(1)-(3) of the Rules (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

7. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions.

8. No leave was sought in respect of these proceedings.

9. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken.

10. A hearing was neither requested nor considered necessary and neither party filed written submissions.

11. I give this decision following a review of all of the material before me.

DECISION

12. The opposition is brought under sections 5(1) and 5(2)(a) of the Act which read as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected.

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

14. The opponent’s mark is an earlier mark which had not been registered for five years at the date of publication of the application. Consequently, the proof of use requirements set out in s.6A of the Act does not apply.² Accordingly, the opponent is entitled to rely on its full specification as registered for its earlier mark in these proceedings.

Comparison of marks

15. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where,

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

16. Both parties’ marks consist of the four letter word MODE. The applicant’s is presented in block capitals with no additional stylisation. The opponent’s earlier registration is for a series of two marks, the first being MODE in upper case and the second being ‘mode’ in lower case, neither has any additional stylisation.

17. Clearly, the mark applied for and the first mark in the opponent’s series are identical marks. Furthermore, in accordance with the principles outlined in *Sadas*, the second of the opponent’s series marks can also be considered identical as the difference between a word in upper case and the same word in lower case is so insignificant that it may go unnoticed by an average consumer.

Comparison of services

18. The services to be compared are as follows:

The opponent’s services	The applicant’s services
Class 43 Services for providing temporary accommodation; hotel and resort services; hotels; motels; food and drink; restaurants, bar and cocktail lounge services; providing conference, convention, seminar, exhibition and meeting facilities; providing banquet and social function facilities for special occasions; catering for the provision of food and beverages; booking of accommodation; booking of accommodation online from a computer database or the Internet; information and advisory services relating to the aforesaid.	Class 43 Nightclub services; restaurant services

19. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

20. With regard to interpreting terms in specifications, I will bear in mind the guidance provided in *Treat*:

In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning.”

21. And in *YouView TV Ltd v Total Ltd* when³ Floyd J said:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

22. Further, in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267, Neuberger J stated:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor."

23. With regard to specifications for services Jacob J stated in *Avnet Incorporated v Isoact Limited*:⁴

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

24. Factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

- (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 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;

³ [2012] EWHC 3158 (Ch) at [12]

⁴ [1998] F.S.R. 16

(f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

25. And the comments of the CJEU in *Canon* in which it 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.”

26. I also bear in mind the decision in *El Corte Inglés v OHIM Case T-420/03*, in which the court commented:

“96...goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (*Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

27. The applicant’s specification includes restaurant services, as does the opponent’s specification, these are clearly identical.

28. The remaining term in the application is ‘Nightclub services’. It is my understanding that a nightclub would include a bar or cocktail bar/lounge in conjunction with a form of entertainment such as a disco, DJ, live music or perhaps a cabaret. In accordance with the decision in *Meric* this results in a finding that the applicant’s nightclub services are identical to the opponent’s bar and cocktail lounge services.

29. However, in case I am found to be wrong in this, the opponent has also opposed the application under s. 5(2)(a) which prohibits the registration of identical trade marks/ for goods or services similar to those for which the earlier trade mark is protected. With regard to the services at issue, both are used by members of the general public for the same purposes, inter alia, entertainment, relaxation and socialising. The services are complementary to the extent that, in my view, it would be unusual to find a nightclub which did not include a bar or cocktail bar and furthermore these services may also be in competition. Taking all of these factors into account these services are at least highly similar.

Overall conclusion

30. Having found the parties’ marks to be identical and the services to be identical in respect of restaurant services and at least highly similar with regard to the applicant’s nightclub services, **I find the opposition succeeds under section 5(2)(a) of the Act.**

COSTS

31. The opposition having succeeded, the opponent is entitled to a contribution towards its costs. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£100
Total:	£300

32. I order Mode IP Limited to pay Promenade Hotel (St Annes) Limited the sum of £300. 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 2nd day of March 2015

**Ms Al Skilton
For the Registrar,
The Comptroller General**