

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2060355 BY
SOUTH BEACH CAFE, INC TO REGISTER THE
MARK SOUTH BEACH CAFE (AND DEVICE)
IN CLASSES 21 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 46335 BY ST ROSE HEIGHTS DEVELOPMENT LTD**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2060355**
by South Beach Cafe, Inc to register the mark
South Beach Cafe (and device) in Classes 21 and 42

and

10 **IN THE MATTER OF Opposition thereto under**
No 46335 by St Rose Heights Development Ltd

15 **DECISION**

On 7 March 1996 South Beach Cafe, Inc applied to register the following mark for a
specification of goods and services which reads:

20 Class 21 - drinking vessels; mugs
Class 42 - catering services; restaurant services; cafe services.

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The application is numbered 2060355.

On 29 January 1997 St Rose Heights Development Ltd filed notice of opposition to this
application in the following terms:

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"1) The Opponent is the proprietor of the following trade mark registration:

No. 2038085 SOUTH BEACH Classes 30, 32 TMJ 6117/2414

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2) The mark applied for is confusingly similar to the Opponent's trade mark and the
application has been made in respect of goods or services similar to those for which the
Opponent's trade mark is protected. There exists a likelihood of confusion on the part

of the public, which includes the likelihood of association with the Opponent's trade mark. Registration of the mark applied for would offend against the provisions of Section 5(2).

5 3) In view of the circumstances, the Opponent requests that the Registrar refuses the application under the provisions of Section 3(6) of the Trade Marks Act 1994."

The applicants filed a counterstatement denying the above grounds. They also say that the opponents' registered mark is devoid of distinctive character and should not have been
10 registered. However the registration is prima facie valid (Section 72) and I am not asked to consider a counter claim for invalidity.

This is one of two opposition cases involving the same parties, the other being opposition
15 No 46336 to application No 2060358. The grounds of opposition and the evidence are in substance the same but the cases have never been formally consolidated. They were both heard on 16 May 2000. Ms McFarland of Counsel, who appeared for the applicants, dealt with both cases by way of a composite set of submissions (the opponents were not represented at the hearing). In view of the fact that for the most part common issues are involved I
20 propose to adopt my summary of the evidence from the related case for which purpose a copy of my decision on opposition No 46336 is annexed.

It will be apparent that the only point of difference between the cases lies in the form in which the mark SOUTH BEACH CAFE has been applied for. In the related action the words appear
25 in plain block capitals whereas here they are presented in a different typeface and set against a background device of horizontal lines. The two marks are not of course identical so I must consider whether the totality of the mark applied for here leads me to any different view of the matter than the conclusions reached in the annexed decision.

It is a little more apparent from the applicants' exhibits (TNB2 for instance) than it is from the
30 mark as applied for (and shown above) that in use the sign is intended to reflect the art deco style which is a common feature of the cafés. It is nevertheless clear that the distinctive and dominant component of the mark applied for is the words SOUTH BEACH CAFE. That is the element by which the mark will be known and referred to by customers. The typeface and form in which it is presented do not, therefore, affect my overall view of the matter or the
35 conclusion which I have reached and I do not understand the applicants to suggest that significantly different considerations arise. Insofar as the words SOUTH BEACH CAFE are still a dominant part of the mark my views and decision are the same as set out in opposition No 46336 and I therefore adopt the reasoning set out in the annexed copy of my decision in that case.

40 The result is that the application is not open to objection for the Class 21 goods and will be allowed to proceed to registration if within one month of the end of the appeal period for this decision the applicants file a Form TM21 amending their specification by the deletion of the Class 42 services.

45 If the applicants do not file a TM21 restricting the specification the application will be refused in its entirety.

In the circumstances both sides have achieved some success and I do not propose to make any award as to costs. If on the other hand the applicants do not amend their specification then the opposition will have succeeded in its entirety and I will order the applicants to pay the opponents the sum of £635. This sum to be paid within seven days of the expiry of the period
5 allowed for filing a Form TM21 (if no form is filed) or within seven days of the final determination of the case if any appeal against this decision is unsuccessful.

10 Dated this 13 day of June 2000

15 M REYNOLDS
For the Registrar
the Comptroller-General