

O-219-18

TRADE MARKS ACT 1994

IN THE MATTER OF TWO APPLICATIONS
BY SELFRIDGES RETAIL LIMITED
TO REGISTER No 3007433:

HARRY GORDON'S BAR

AND No 3007434:

HARRY GORDONS

IN CLASSES IN CLASSES 29, 30, 32, 33 AND 43:

AND OPPOSITIONS THERETO UNDER NOS 401264 AND 400905
BY HARRY'S NEW YORK BAR SA

BACKGROUND

1. On 24 May 2013, Selfridges Retail Limited (the applicant) applied to register the above trade marks in the following classes:¹

Class 29

Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs; Milk and milk products; Edible oils and fats.

Class 30

Coffee, tea, cocoa and artificial coffee; Rice; Tapioca and sago; Flour and preparations made from cereals; Bread, pastry and confectionery; Ices; Sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces (condiments); Spices; Ice.

Class 32

Beers; Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices; Syrups and other preparations for making beverages.

Class 33

Alcoholic beverages (except beers).

Class 43

Services for providing food and drink; Temporary accommodation.

2. The applications were published on 21 June 2013 (3007433) and 23 August 2013 (3007434), following which Harry's New York Bar SA (the opponent) filed notices of opposition against all of the goods and services in both applications.

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).*

3. The opponent bases its case on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). Under sections 5(2)(b) and 5(3) the opponent relies upon the following UK trade mark:²

Mark details and relevant dates	Services relied upon
<p>Mark: 3199892</p> <p style="text-align: center;">HARRY'S BAR</p> <p>Filed: 30 September 2003 Registered: 29 September 2017</p>	<p>Class 43 Cafes, cafeterias, bars, restaurants, self-service restaurants, snack bars.</p>

4. The mark relied on by the opponent is subject to cancellation proceedings (under number 501964). The cancellation applicants in that case are not a party to these proceedings. I will return to the effect that this may have on the earlier mark, if any, at the end of this decision.

5. With regard to the opposition under section 5(2)(b) the opponent states:

“7. The mark applied for features the name 'Harry' which is similar [to]...3378031 HARRY'S BAR because it features the name 'Harry'. Consequently the mark applied for is phonetically and conceptually similar to the earlier marks. It is also visually similar because the name 'Harry' features as a prefix in the mark applied for and constitutes the major and most dominant component of the cited earlier marks.

8. In addition or in the alternative, the Opponent's marks have a substantial reputation following use Since 1911, in the European Union which grants the cited earlier mark...an enhanced distinctive character and increases the likelihood of confusion, especially taking into account that the goods and services at issue appear to be identical.”

² The opponent initially relied upon three European Trade Marks in addition to its UK mark but these were subsequently removed from the pleadings.

6. With regard to the opposition under section 5(3) the opponent submits the following:

“10. The earlier [mark has] a reputation in respect to "bars" and "restaurants since first use of the earlier mark in 1911. This reputation extends to a wide area of the European Union including Paris. Hanover, Frankfurt, Cologne and Berlin.

11. Use of the Opponent's marks extends to prestigious establishments such as The Sheraton Hannover Hotel, The Lindner Hotel in Frankfurt, The Dorint Hotel in Cologne and The Grand Hotel in Berlin which are the sort of establishments that are frequented by the same sorts of people who would frequent Selfridges in Oxford Street. Consequently use of the mark in a prestigious establishment such as an Oxford Street retail outlet would either take advantage of, or be detrimental to, the distinctive character or repute of the earlier mark in that well-travelled consumers used to travelling around the European Union would assume a connection, especially if the Applicant's bar has a style or theme reminiscent of the earlier part of the twentieth century and the music of that period.

12. Use of the mark by the Applicant would create a link to the Opponent's well-known bars which are often found in prestigious establishments thereby immediately creating in the mind of the consumer an association with the particular genre or period for which the Opponent's bars are famed, without necessarily the time and effort or need to promote and market the Applicant's bar. The Applicant's bar would ride on the coat tails of the existing reputation generally associated with the early twentieth century and the music of that age at least among a certain section of the consumers.”

7. For the purposes of its opposition under section 5(4)(a) of the Act, the opponent relies upon HARRY'S, HARRY'S BAR and HARRY'S NEW YORK BAR which it claims were first used in Paris in 1911. It submits:

“15...use of the mark applied for would constitute a misrepresentation causing damage to the goodwill of the bars and restaurants under the earlier common law mark...”

16. The Opponent submits that it has goodwill in the United Kingdom by virtue of the reputation of its bars and restaurants among Britons and in particular London residents who attend its bars in Paris, Berlin, Hannover, Frankfurt and Cologne etc. In particular the Opponent has a goodwill among well-travelled persons who are inclined to frequent bars themed on jazz and the early period of the twentieth century.”

8. The applicant filed counterstatements in which it denies the opponent’s claims under all of the pleaded grounds. With regard to the opponent’s 5(2)(b) claim, the applicant denies that there is sufficient similarity between the parties’ marks to give rise to a likelihood of confusion.

9. The applicant denies the opponent’s claim under section 5(3) of the Act and states that the opponent does not have the necessary reputation.

10. With regard to the claim under section 5(4)(a) the applicant denies the date of first use of the opponent’s sign and further denies that there has been use in the course of trade by the opponent in the United Kingdom.

11. Both sides filed evidence and skeleton arguments. The applicant also filed submissions, dated 23 February 2017. A hearing subsequently took place before me, by video conference. The opponent was represented by Mr Rowland Buehrlen of Beck Greener. The applicant was represented by Mr Philip Harris of Counsel, instructed by Lane IP. Both sides seek an award of costs.

EVIDENCE

Opponent's evidence

Witness statement of Isabelle MacElhone and exhibit IM1

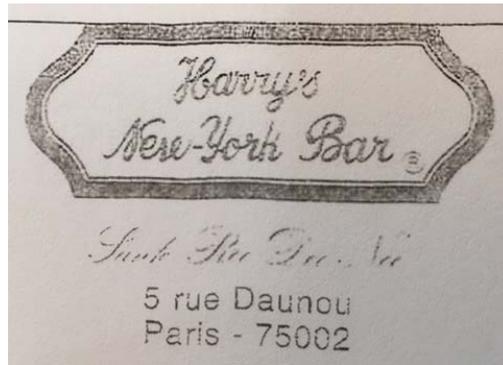
12. Ms MacElhone is a director of the opponent, a position she has held since 1998. Her witness statement is dated 25 October 2016. Her evidence provides the history of Harry's New York Bar in Paris and a number of press reviews and articles referring to that bar. The evidence is presented as one exhibit made up of 103 pages.

13. Turnover figures are provided at page 9 of the exhibit and are described as:

"The turnover for goods and services offered under/with Community trademark HARRY'S covering classes 25, 33 and 42 over the considered period of time inside the European Community is established as follows:"

Year	Beverages	Restauration	Harry's Products
2003	825 543	28 207	11 913
2004	927 688	31 912	9 186
2005	841 071	33 528	11 279
2006	967 816	41 004	12 553
2007	1 046 481	62 163	12 433
2008	1 034 393	57 758	11 454
2009	1 033 663	60 597	7 904
2010	1 094 131	70 934	7 347

14. A single invoice is provided at page 11. Page 12 of the exhibit is a translation of the same. It is dated, 'Paris, September 30, 2011' and is addressed to 7 Rue Caumartin 75009 Paris. The invoice is for 'Food and Consumption' totaling €261. The following is shown at the top of the page:



15. A number of articles are provided from the opponent's centenary year in 2011. The first is from the Times³ and is dated 24 November 2011. It is titled, *'After a century dedicated to drinking, they're still wild about Harry's in Paris'* and was written by Adam Sage, Paris. It reads:

"Drinkers have a cast-iron excuse for a tiple today: it is 100 years since the opening of Harry's Bar in Paris.

The man they will be toasting is a barman from Dundee, Harry MacElhone. Celebrating with the French will be expatriate Americans partly because Harry's New York Bar (to give its full name), has been graced by the likes of Humphrey Bogart, Gene Kelly, Jean-Paul Sartre and Coco Chanel..."

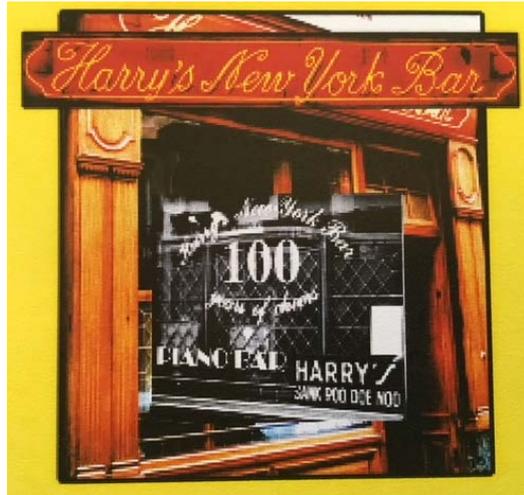
16. Another, from BBC News⁴ is dated 25 November 2011. It is titled, *'A century of Harry's Bar in Paris'*, the first line reads: *"For Harry's New York Bar, it was the bash of the century."*

17. Two sections of the exhibit are pages from a book titled, *'Harry's ABC of Mixing Cocktails'*⁵ written by Harry MacElhone. The first of these shows the front of the opponent's bar on the front cover:

³ *Ibid*, page 2.

⁴ *Ibid*, pages 57 to 61.

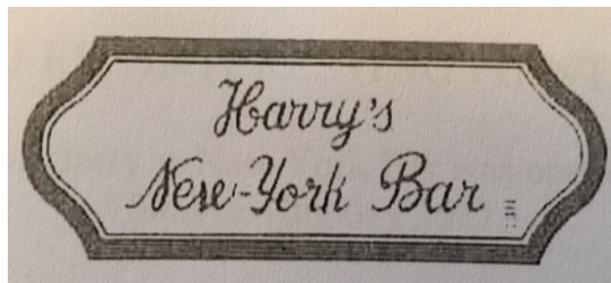
⁵ See exhibit IM1, page 3 and pages 71 to 103



18. Ms MacElhone says of this exhibit:

“The opponent has engaged a London based printing house called Souvenir Press Publishing which publishes since the 1970ies the famous cocktail book Harry’s ABC of Mixing Cocktails.”

19. The exhibit includes a copy of a menu from the opponent’s bar,⁶ the front and back covers of which show the following:



20. The last two pages inside the menu include a page headed, ‘Harry’s shop’ and ‘Un open bar au Harry’s’.

21. A number of the articles provided in evidence show the opponent’s bar positioned in bar rankings, for example:

⁶ *Ibid*, pages 28 to 37

- An undated page taken from www.drinksint.com which lists Harry's New York Bar number 9 in 'The World's 50 Best Bars'.⁷
- A page from 4bars.com.au, dated 22 June 2010, titled, 'Bartender Magazine's World Top 20 Bars: Classic Bars. 'Harry's New York Bar, Paris is number one on the list.'⁸

22. Examples are provided of the opponent's bar listed in city and travel guides and articles. For example:

- A page taken from www.elegant-lifestyle.com which is titled, 'Best 100 City Guide: Paris entertainment. Harry's New York Bar is listed at number 86.
- A listing in the Smarter Paris city guide, www.smarterparis.com, which is undated.⁹ It refers to the opponent's business as Harry's Bar, with no reference to 'Harry's New York Bar'.
- A page titled, 'Paris Travel Blog, Parisian Bars' taken from www.nileguide.com, dated 27 April 2010, lists Harry's New York Bar as one of the best destinations in town.¹⁰
- www.cityvox.co.uk - Le Harry's New York Bar, 'An American in Paris', the listing which includes the address, description and opening hours.¹¹ Three comments are shown below the article, the first two are in French. The third is in English but states 'automatically translated by Google translate' below the article.

23. The evidence includes a number of instances of the opponent's bar referred to in articles more generally about Paris. For example:

⁷ See exhibit IM1, page 38

⁸ See exhibit IM1, page 16

⁹ See exhibit IM1, pages 64 and 65.

¹⁰ See exhibit IM1, page 41.

¹¹ See exhibit IM1, page 8

- Huffington Post France, from www.huffingtonpost.com, dated 5 November 2008,¹² titled 'Obama's Big Bang in France'. The article is about the US election of Barack Obama and concludes:

"My friend Ralph and I went on the restaurant and bar circuit, stopping first at Harry's New York Bar, which is an institution in Paris, especially on election night."

- Telegraph article printed from www.telegraph.co.uk/travel/destinations, dated 30 October 2011, titled, 'It's always midnight in Paris'.¹³ The article includes advice about museums, hotels, restaurants and bars and includes:

"So I stick to the choicest spots: Harry's New York Bar, where people quaff whisky and water at 2pm..."

24. A number of bar reviews are provided, for example:

- www.cocktailia.com, Harry's New York Bar, Paris, France, 27 September 2008.¹⁴

"No trip to Paris is complete without stopping by a couple of their world-famous bars and Harry's New York Bar was the first one on our list.

Advertised as the Oldest Cocktail Bar in Europe, this bar originally opened in 1911 as just 'New York Bar'. In 1923 it was bought by Harry MacElhone who added his first name..."

- www.worldsbestbars.com, Harry's New York Bar, the page is not dated:¹⁵

¹² See exhibit IM1 – page 26

¹³ See exhibit IM1, page 42

¹⁴ See exhibit IM1, page 6

¹⁵ See exhibit IM1, page 18

“Don’t let the name put you off – this is the legendary Parisian landmark. One of the most famous bars in the world, birthplace of the brilliant Bloody Mary.”

- New York Times, taken from, www.nytimes.com, dated 3 January 1988. ‘American Oasis at Harry’s Bar’, by C Sulzberger.¹⁶

“In the first weeks after the liberation of Paris in 1944 an odd game of hide and seek involved the more intellectual G.I.s on leave there and Jean-Paul Sartre. Highly literate soldiers made a practice of visiting the Café Deux Magots on the Left Bank of the Seine in search of Sartre, who was an habitue. But for the most part they never found him. He and his companion, Simone de Beauvoir, were on the Right Bank at Harry’s New York Bar, hoping to observe G.I. Joe in his native habitat.”

Applicant’s evidence

Witness statement of Robert Neil White exhibits RNW1-RNW3

25. Mr White is a senior associate at the offices of applicant’s instructing trade mark attorney. His statement is dated 23 February 2017. His evidence comprises photographs of the inside and outside of the opponent’s bar in Paris and an article from www.atlasobscura.com.

Witness statement of Sarah Helmsley and exhibits E1-E16

26. Ms Helmsley is the Director of Legal and Company Secretary of the applicant. She has held these positions since December 2015 and 19 August 2013, respectively. Ms Helmsley’s statement is dated 21 February 2017. Her evidence relates to the history of Selfridges (in which the applicant’s bar is located):

“12. Prior to the conception of 'HARRY GORDON'S BAR' in May 2013, my company had a bar in the Wonderoom of its Oxford Street store. Upon its closure, Selfridges had to consider where to introduce its new in-store bar

¹⁶ See exhibit IM1, pages 49 and 50.

and also what to call it. At the same time ITV had approached my company for assistance and information about Harry Gordon Selfridge in order to develop its idea for the TV series, Mr Selfridge. This involved examining the Selfridges' archive, which notably led to the discovery of a portrait of Harry Gordon Selfridge, with a copy of that portrait taken and placed in 'HARRY GORDON'S BAR'¹⁷

27 The TV show was set in the 1910s and first broadcast on 6 January 2013 in the United Kingdom. The opening episode from season two of Mr Selfridge reached 4.9 million viewers (15.3% share of total viewing between 9pm and 10pm). The opening episode from season three of Mr Selfridge reached 3.8 million viewers.¹⁸

28. Ms Helmsley concludes:

“14. The culmination of my company's plans for a new bar and the assistance provided to ITV - particularly in light of the popularity of the ITV series within the United Kingdom – coincided and so it seemed only logical to name the new in-store bar after Selfridges' founder, Harry Gordon Selfridge.”

29. The applicant's website describes its bar as 'named after our founder Harry Gordon Selfridge'.¹⁹ The bar menu includes an introductory paragraph about Harry Gordon Selfridge.²⁰

30. Ms Helmsley states that it is apparent that the relationship between Harry Gordon Selfridge and 'HARRY GORDONS BAR' 'has been understood by the public in the United Kingdom.'

31. In support of this she provides an extract from whatpub.com (a UK pub review website) which describes the bar as, '*named after the founder of Selfridges, one Harry Gordon Selfridge*'.²¹

¹⁷ See exhibit E10.

¹⁸ See exhibit E11, 'Mr Selfridge loses out to Last Tango in Halifax, 26 January 2015, The Guardian.

¹⁹ See exhibit E13, undated.

²⁰ See exhibit E14.

²¹ See exhibit E15.

32. An extract from Difford's Guide,²² which Ms Helmsley describes as 'one of the largest and most-visited drinks-related websites based in the United Kingdom', describes the bar in the following terms:

"Take the escalator down to the lower ground floor of Selfridges to find its spanking new drinks department, with a bar nestled in the middle. Named after Mr Harry Gordon Selfridge himself..."

Opponent's evidence in reply

Second witness statement of Isabelle MacElhone and exhibit IM2-IM7

33. Ms MacElhone's second statement is dated 26 May 2017. In this statement, Ms MacElhone addresses the nature of both parties' businesses and provides further detail concerning the university insignia and memorabilia which is displayed on the walls of the opponent's bar.

DECISION

34. I will deal first with the opposition under section 5(2)(b) of the Act, which 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

²² See exhibit E16.

35. 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.”

36. The opponent's earlier mark is not subject to proof of use because, at the date on which the application was published, it had not been registered for five years.²³

Section 5(2)(b) case law

37. The following principles are gleaned from the decisions of the EU courts in *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.

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

²³ 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.

(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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing act

38. In accordance with the above cited case law, I must determine who the average consumer is for the goods and services at issue and also identify the manner in which they will be selected in the course of trade.

39. 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*²⁴, 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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

40. The average consumer for all of the goods and services is a member of the general public.²⁵ The respective goods and services are made available through a variety of trade channels. They may be bought in a supermarket, convenience store or off-licence, where the selection is likely to be made by the consumer from a shelf. They may also be bought from a website or mail-order catalogue, where the consumer will also select the goods visually. With regard to the goods in classes 32 and 33 in

²⁴ [2014] EWHC 439 (Ch)

²⁵ For goods where the alcohol content exceeds 0.5% ABV the average consumer will be over 18 years of age.

particular, they may also be sold through bars, restaurants, clubs and public houses, where the goods may be requested orally, from a member of staff. However, in considering this point, I bear in mind the comments of the Court of First Instance (now the General Court) in *Simonds Farsons Cisk plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*²⁶ when it said:

“In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant’s goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.”

41. Consequently, even though the purchase of the goods in a bar or restaurant (and so on) may involve an aural element, the selection will be made, primarily, from the display of goods e.g. on shelves, in fridges and on optics at the back of the bar. Accordingly, the purchase of such goods is primarily visual, though I do not discount an aural element.

42. The level of attention paid to the purchase will vary depending on the nature of the goods and services. As a general rule most of the respective goods and services here are fairly low-value, reasonably frequent purchases. However, the parties’ specifications would also include such goods as single malt whisky, vintage wines and champagne and services such as exclusive restaurants which are likely to be more expensive may give rise to a higher level of attention being paid. I note that in its statement of grounds the opponent makes reference to its ‘prestigious establishments’ which are the same sort of establishments frequented by the same sorts of people who would visit Selfridges, namely, well-travelled consumers. The applicant concludes

²⁶ T-3/04

from this that as a consequence, ‘these consumers are likely to be of above-average knowledge, circumspection and perspicacity’. I disagree. Both parties’ specifications include goods and services across the full range of cost and exclusivity and I find that, allowing for the full range of possible goods and services, the level of attention paid to the purchase will be no more than average.

Comparison of goods and services

43. The goods and services to be compared are as follows:

The opponent’s services	The applicant’s goods and services
<p>Class 43 Cafes, cafeterias, bars, restaurants, self-service restaurants, snack bars.</p>	<p>Class 29 Meat, fish, poultry and game; Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; Jellies, jams, compotes; Eggs; Milk and milk products; Edible oils and fats.</p> <p>Class 30 Coffee, tea, cocoa and artificial coffee; Rice; Tapioca and sago; Flour and preparations made from cereals; Bread, pastry and confectionery; Ices; Sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces (condiments); Spices; Ice.</p> <p>Class 32 Beers; Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices; Syrups and other preparations for making beverages.</p> <p>Class 33 Alcoholic beverages (except beers).</p>

	<p>Class 43 Services for providing food and drink; Temporary accommodation.</p>
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44. In *Gérard Meric v Office for Harmonisation in the Internal Market*,²⁷ the General Court (GC) stated 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 trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

The applicant’s services in class 43

45. It is clear from the parties’ evidence and submissions (both on paper and at the hearing) that the parties’ main areas of interest in this opposition are their services in class 43, namely the bar, restaurant and café services. The parties agree that the opponent’s cafes, cafeterias, bars, restaurants, self-service restaurants and snack bars in its specification are identical to the applicant’s services for providing food and drink in class 43. I will make the necessary assessments under the pleaded 5(2)(b) ground based on these services, but will return to the remaining goods and services later, if necessary.

Comparison of marks

46. 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

²⁷ Case T- 133/05

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.”

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

Opponent's mark	Applicant's marks
HARRY'S BAR	HARRY GORDON'S HARRY GORDON'S BAR

48. The opponent's mark comprises 'HARRY'S' followed by the word 'BAR'. Since 'BAR' will be seen as describing the nature of the services, it is 'HARRY'S' which plays the greater role in the overall impression of the mark.

49. The opponent's first mark consists of two names: HARRY and GORDON'S. Neither name is presented in a way which makes it stand out more than the other (beyond HARRY being the first part of the mark). The possessive 'S' at the end of GORDON means that the average consumer will see the mark as referring to one individual. The overall impression rests in the mark as a whole.

50. In the second mark the same two names, HARRY and GORDON'S are followed by the word BAR. In the context of most of the opponent's goods and services BAR simply describes the nature of the undertaking providing the goods and services.

Therefore it is the two names HARRY and GORDON'S which play the greater role in the overall impression created by the mark.

51. The opponent submits that the respective marks are visually and aurally similar:

*“9. The only differences between the marks applied for and the cited earlier British trade mark registration is the presence of the name **GORDONS** or **GORDON'S** which the Opponent submits does not significantly detract from the similarities of the marks, especially taking into account the similarities in question reproduce the totality or near totality of the cited earlier British trade mark registration.”*

52. The applicant contends that the visual and aural differences are plain and will be immediately noted by the average consumer.

53. The fact that all of the marks at issue in this case have as their first word the name HARRY, means that there is an inevitable degree of visual and aural similarity. The first of the applicant's marks is HARRY GORDON'S BAR, the first and last words of which represent the entirety of the opponent's mark HARRY'S BAR. The addition of GORDON'S in the middle of the mark is the only point of difference. I find these marks to visually and aurally similar to a slightly higher than medium degree.

54. The applicant's second mark is HARRY GORDON'S. It shares the first word with the opponent's mark HARRY'S BAR. Both marks are two words long with the second word being different. One being a name and the other describing the type of undertaking. I find these marks to be visually and aurally similar to a medium degree.

55. With regard to conceptual similarity, the opponent submits that:

*“6. ...the marks applied for are conceptually similar to the earlier cited British Trade Mark Registration No. UK00003199892 **HARRY'S BAR**. The marks applied for feature the name **HARRY** which in the eye of the consumer would conceptually identify an individual. Furthermore, and in addition, the earlier mark features the word **BAR** indicating an establishment where food*

*and drink would be provided, which is conceptually identical to the use of the same word **BAR** in British Trade Mark Application No. UK00003007433 **HARRY GORDON'S BAR**. While it is admitted that both opposed applications feature the name **GORDONS** and **GORDON'S**, this in no way detracts from the conceptual message of identifying a name. Therefore, the marks applied for are conceptually similar and possibly conceptually identical to the cited earlier mark.”*

56. The applicant submits in its skeleton argument:

“...the Opponent’s trade mark will be seen as merely a common male forename identifying a bar, whereas the Applicant’s trade mark will be seen as the same male forename followed by a second term which will be seen either as two successive forenames of (by those unaware of the origin of the name) or as a forename/surname combination. Indeed, Ms MacElhone acknowledges that the mark will normally be seen as a full name, in Paragraph 4 of her 2nd witness statement. In either case HARRY GORDON’S refers to a specific individual or, in the second variant, a specific individual’s bar, whereas the element HARRY does not. Overall, the marks are conceptually dissimilar.”

57. I do not agree with the opponent that the parties’ marks are ‘possibly’ conceptually identical, nor do I agree with the applicant that there is no conceptual similarity. This is because there is a clear point of similarity with the shared forename HARRY, but there are also obvious differences, namely, the inclusion of GORDON’S in the applications.

58. At paragraph 4 of her second witness statement Ms MacElhone (for the opponent) states:

“...Mr Selfridge might be well known in the United Kingdom as the founder of Selfridges, but he is certainly not well known as simply Harry Gordon. Indeed, the name Harry Gordon would normally indicate somebody’s surname being Gordon and Christian name Harry.”

59. I agree that for consumers who are not aware that the names HARRY GORDON refer to the first two names of the founder of Selfridges, the two names are most likely to be considered to refer to a first name and surname. In either case, the conceptual impression that the average consumer will take from the two names will be that of a specific individual, namely, a HARRY whose surname is GORDON or the particular individual, Harry Gordon Selfridge. The conceptual similarity between HARRY'S BAR and HARRY GORDON's is low. One refers to a bar owned or operated by someone with the forename Harry. The other refers to a specific individual called HARRY GORDON. The possessive 'S' at the end of GORDON indicating that the particular undertaking is owned or operated by him.

60. With regard to the applicant's HARRY GORDON'S BAR application. The conceptual similarity with HARRY'S BAR is still at the lower end of the scale. In the case of the contested mark, BAR simply describes the nature of the service. The same is true of the earlier mark insofar as services in class 43 are relied upon. One bar belongs to a specific HARRY, whose surname is GORDON (or for some consumers, refers to a bar with a connection to Harry Gordon Selfridge), the other refers to a bar owned or operated by someone with the forename Harry.

Distinctive character of the earlier mark

61. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been used as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.²⁸

62. The opponent submits that its mark has an enhanced distinctive character, which is shown in its evidence filed in support of the other grounds relied on in this case.

²⁸ *Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.*

63. The applicant makes two points in this regard. Firstly, it submits that the opponent's evidence relates, for the most part, to a single bar in Paris which is actually called 'HARRY'S NEW YORK BAR', not 'HARRY'S BAR'. The applicant draws my attention to the opponent's turnover figures²⁹ and a copy of the opponent's bar menu³⁰ in support of this point.

64. Secondly, the applicant submits that the opponent cannot rely on distinctive character acquired in France in support of a UK national mark under section 5(2)(b). In support of this second point it relies on the comments of Mr Iain Purvis, sitting as the Appointed Person in *CCB INTERNATIONAL*,³¹ in which he stated the following at paragraph 33 of that decision:

"The 'reputation' being considered by the CJEU in *Pago* was the condition provided by the Regulation before a mark could claim the extended protection provided by Article 9(1)(c) (that is to say the right to prohibit use of signs even where there is no confusion). We are not concerned in this case with any such condition. We are concerned with s5(2) of the Trade Marks Act 1994, and the single question whether there would be a likelihood of confusion between the marks amongst average consumers of the goods or services in question in the United Kingdom. The 'reputation' of the earlier mark may be taken into account as a factor which may increase its distinctive character and therefore increase the risk of confusion – see *Sabel v Puma* [1998] RPC 199. However, since the only question to be asked is whether there is a likelihood of confusion amongst consumers in the United Kingdom, a reputation (and therefore enhanced distinctive character) amongst consumers outside the United Kingdom will by definition be entirely irrelevant."

65. Considering the opponent's evidence as a whole, it is clear that the opponent operates a bar in Paris. The bar opened in 1911 and was originally called 'New York Bar'. The name 'Harry's' was added to create 'Harry's New York Bar' in the 1920's

²⁹ *Exhibit IM1, page 9.*

³⁰ *Exhibit IM1, page 28.*

³¹ *O-281-14.*

when Harry MacElhone became the owner. The front of the bar shows the words 'Harry's New York Bar' in neon lettering. The bar menu has Harry's New York Bar on its front and back covers. There are two examples within the menu of the use of Harry's solus, but this is in the context of a menu that clearly establishes, on the front cover, that the consumer is in Harry's New York Bar'. The only invoice provided by the opponent has 'Harry's New York Bar' at the top and relates to a restaurant bill for the opponent's bar in Paris. The bar listings and rankings provided in evidence refer to the opponent's bar as 'Harry's New York Bar', located in Paris, with one exception (a single listing on the Smarter Paris website lists the bar as Harry's Bar). Newspaper articles and press reports occasionally refer to the bar as 'Harry's' but elsewhere in those articles it is made clear that the bar's name is 'Harry's New York Bar', the implication being that 'Harry's' is used as a convenient shorthand for the longer name of the bar, once its identity has been established.

66. With regard to the turnover figures, the opponent describes them as turnover for goods and services offered under/with Community trademark HARRY'S covering classes 25, 33 and 42 over the considered period of time inside the European Community. The opponent is not relying on the mark to which these figures relate, nor is it relying on a mark registered in classes, 25, 33 or 42. Under the 5(2)(b) ground the opponent relies upon the UK trade mark HARRY'S BAR in class 43.

67. At the hearing there was some discussion regarding the opponent's evidence relating to the book, 'Harry's ABC of Mixing Cocktails'. The opponent suggested that 'Harry's' referred to the bar, while the applicant submitted that as the author is Harry MacElhone the consumer would see Harry as referring to that individual rather than the bar. I find favour with the applicant's submission. It is clear from the evidence that the opponent is proud of its heritage and the link to Harry MacElhone. There is a line drawing of him in the menu and another in the earlier version of the book. Later versions of the book show a photograph of the bar on the cover, in which the neon sign 'Harry's New York Bar' can clearly be seen. In this context the 'Harry' referred to on the front cover of the book is likely to be seen as the man behind the bar, rather than a reference to the name of the bar.

68. The opponent's evidence does not show that the opponent operates or promotes its business under the mark HARRY'S BAR, rather, it shows use of HARRY'S NEW YORK BAR. Furthermore, even if it did, and the scale of the use was sufficient for a finding of enhanced distinctive character (and I clearly do not find that to be the case), the entirety of its use has taken place in Paris. I pause here to note that the opponent makes reference to other bars that it operates in Berlin, Hanover, Frankfurt and Cologne,³² however, none of the evidence filed by the opponent makes any reference to those businesses, meaning that I cannot take them into account in this decision.

69. Where the question to be answered is whether there is a likelihood of confusion amongst UK consumers, enhanced distinctive character outside the UK is entirely irrelevant (as per Mr Purvis in CCB International). In conclusion, for the reasons provided above, the opponent's mark HARRY'S BAR does not benefit from enhanced distinctiveness as a result of the use which has been made of its mark in relation to the services on which it relies.

70. In terms of inherent distinctiveness of the earlier mark I take account of the fact that the second part of the mark, 'BAR' is low in distinctiveness for most of the services for which it is registered. The first part of the mark, the name 'HARRY'S' is not descriptive of the services but indicates the owner or operator of the bar. Whilst names are, in most cases, perfectly acceptable as trade marks, they often do not result in the most distinctive of marks, although, this, of course, depends on the name itself. I have no evidence on the point, from either party but would consider, on my own understanding that HARRY is a reasonably common and well-known forename. In combination, the earlier mark 'HARRY'S BAR' is inherently distinctive to a lower than average degree.

Likelihood of confusion

71. The factors assessed so far have a degree of interdependency³³ and a global assessment of them must be made when determining whether a likelihood of

³² See paragraph 18 of the opponent's skeleton argument.

³³ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*, C-39/97, paragraph 17

confusion exists.³⁴ It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

72. The applicant states that this is a classic ‘forename/full name’ case and concludes that the fact its own mark may be seen as two forenames or a full name ‘makes no difference’. The opponent submits that HARRY is a dominant independent element in both parties’ marks.

73. With regard to the opponent’s submission, the applicant relies the judgment of Mr Justice Arnold in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*,³⁵ in particular the second point, at paragraph 20. In that case Mr Justice Arnold set out further guidance in relation to the assessment of composite marks (further to the guidance he gave in *Aveda Corp v Dabur India Ltd* [2013] EWHC 589 (Ch), [2013] ETMR 33 at [19]-[38] where he reviewed *Medion v Thomson* and six subsequent cases) to reflect the judgment of the CJEU in Case C-591/12 P *Bimbo SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:305]. Mr Justice Arnold stated:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks - visually, aurally and conceptually - as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has

³⁴ *Sabel BV v. Puma AG, C-251/95, paragraph 22*

³⁵ [2015] EWHC 1271 (Ch).

a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances Where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER)..."

74. The applicant also relies on a recent decision of Mr Daniel Alexander QC, sitting as the Appointed Person, in *Pia Hallstrom*,³⁶ where at paragraph 37, when summing up the nature of the overall evaluation that had to be made, he stated:

"Moreover, if a trader choses a forename as a trade mark, the average consumer is not particularly likely to think that another trader who uses a full name incorporating that forename is thereby denoting goods or services from the first undertaking rather than those connected with someone else what happens to share that forename. That is a problem which arises as a result of a choice of mark which, precisely because it is a name which others either do or could reasonably wish to use to denote themselves, does not start high on the distinctiveness scale. Large-scale use of such a mark does not, as such, enhance its distinctiveness in a relevant way, namely so as to increase the likelihood of confusion (see above)."

75. Turning to the assessment of the likelihood of confusion, I remind myself of the comments of Morritt L.J. in *Neutrogena Corporation and Another v Golden Limited and Another*,³⁷ in which he stated that:

³⁶ *BL O/303/17*

³⁷ *[1996] RPC 473*

“The role of the court, including this court, was emphasised by Lord Diplock in *GE Trade Mark*³⁸ at page 321 where he said:

‘...where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

76. Whilst the case cited above dealt with goods the situation is analogous to services where those services are used by the general public and the nature of confusion or deception is a ‘jury question’. That is clearly the case here where the services are bar, restaurant and café services and the relevant public is the general public.

³⁸ [1973] R.P.C. 297

77. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related).

78. In *L.A. Sugar Limited v By Back Beat Inc*,³⁹ Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

79. In terms of direct confusion, even bearing in mind the concept of imperfect recollection, and even though the services in class 43 are identical, there is no likelihood of the consumer mistaking one mark for the other. The addition of the second name, GORDON, in both of the applicant’s marks is not likely to go unnoticed nor is it likely that the average consumer will simply remember one name and not the other.

80. With regard to indirect confusion, in *Duebros Limited v Heirler Cenovis GmbH*,⁴⁰ Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect

³⁹ *BL O/375/10*

⁴⁰ *BL O/547/17*

confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

81. In my view, consumers are used to distinguishing between names and using them to identify individuals and particular undertakings and it is not uncommon to encounter bars and restaurant's using names, either forenames, surnames or combinations for their businesses.

82. HARRY GORDON'S or HARRY GORDON'S BAR will not be perceived as a reconfiguration of HARRY'S BAR. It would not be usual to reconfigure a mark by adding or subtracting the name GORDON in such a way. In terms of a sub-brand, I do not believe that the average consumer will make such an assumption. HARRY is a fairly common forename. The average consumer will not put the sharing of that name down to the responsible undertakings being the same or being related. They will put the commonality down to a co-incidental sharing of a not uncommon male forename with nothing to suggest a same-stable relationship. The addition of the second name to the applicant's mark, results in two marks which the average consumer will identify as two different individuals or undertakings. As Mr Alexander stated in *Pia Hallstrom*, 'the average consumer is not particularly likely to think that another trader who uses a full name incorporating that forename is thereby denoting goods or services from the first undertaking rather than those connected with someone else who happens to share that forename'. This is applicable in the case before me.

The opposition under section 5(2)(b) fails.

83. Having reached this conclusion based on the parties' identical services, I do not intend to revisit the remaining terms in the specifications as they cannot put the opponent in any better position.

CONCLUSION

84. The opposition fails under section 5(2)(b).

The 5(4) ground of opposition

85. Section 5(4) of the Act states:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade...

(b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

86. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

87. Parker J in *Burberrys v J C Cording & Co Ltd* [1909] 26 RPC 693 said:

"The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but the property in the trade or good-will which will be injured by its use. If the use of a word or a name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business."

The relevant date

88. Whether there has been passing off must be judged at a particular point (or points) in time. In the decision of the Court of Appeal in *Roger Maier and Assos of Switzerland SA v ASOS plc and ASOS.com Limited* [2015] EWCA Civ 220 it was stated:

"165. ...Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should

be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc.*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the Community trade mark would have amounted to passing off. But if the Community trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

89. The above related to a community trade mark, however, the same principle applies to a UK national trade mark.

90. The filing date of the subject trade mark is 24 May 2013. There is no evidence or claim by the applicant that their mark has been used prior to this date. Accordingly, the matter need only be assessed as of 24 May 2013.

Goodwill

91. The first hurdle for the opponent is to show that they had the required goodwill at the relevant date. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

92. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with

evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

93. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

94. In her first witness statement, Ms MacElhone states:

“7. The Opponent’s bar is extremely well known in the United Kingdom among UK residents who visit the United Kingdom among UK residents

who visit Paris...and when celebrating the centenary of the bar in 2011 the celebrations were attended by well-known UK newspapers, including The Times and The Scottish Sun. The bar also has connections to British universities, including Oxford and Cambridge, whose university insignia are affixed to the walls of the bar (such as All Souls, Wadham, or Saint Edmond's Hall of Oxford University). The Opponent's trade mark had gained a reputation to such an extent that we have opened bars under the same name in Frankfurt, Cologne, Berlin and Hanover."

95. In paragraph 18 of its skeleton argument (under the heading 'enhanced distinctive character'), the opponent submits:

"In accordance with the principles in Maxim's Ltd v Dye⁴¹ the opponent claims that its goodwill extends to persons in the United Kingdom, in particular persons in London, where the Applicant's establishment is resident, as such persons often visit Paris, Berlin, Hanover, Frankfurt and Cologne where the opponent's establishments are based."

96. In its skeleton argument the applicant states:

"9. Ms MacElhone gives evidence of the history and activities of the Opponent with a view to establishing the reputation etc. of the Opponent's trade mark.

10. In lieu of cross-examination we challenged, by way of written submission, certain assertions of Ms MacElhone, thus giving her the opportunity to respond.

11. First, at Paragraph 4 of her 1st Witness Statement Ms MacElhone claims, without any corroboration, that the Opponent's bar 'is the central point in Paris where English speakers congregate'. It was submitted to Ms MacElhone that this statement was an incredible exaggeration. Ms

⁴¹ [1977] 1 WLR 1155

MacElhone did not respond to this submission in her 2nd Witness Statement. We therefore invite the tribunal to disregard her evidence on this point, either on the basis of the absence of any response to the challenge or on the basis that it is self-evidently incredible.

12. Ms MacElhone also stated in paragraph 7 of her 1st Witness Statement that the 'The Opponent's bar is extremely well known in the United Kingdom among UK Residents who visit Paris'. Part of the corroboration offered in her 1st statement was that certain UK newspapers had attended the bar's Centennial celebration. It was put to her that this proved nothing, to which Ms MacElhone responded in her 2nd Witness Statement (paragraph 15) that the BBC had also attended. The problem for Ms MacElhone is, that there is no evidence from any of the organisations concerned to support her apparent view that their attendance at the centenary reflects her specific opinion as to the extreme notoriety of the Opponent's Parisian Bar amongst UK visitors to Paris. There is no evidence as to the perception or knowledge of the British public and the mere presence of news organizations at an event does not, of itself, prove the point in issue. The evidence should be disregarded.

13. Ms MacElhone also says, in support of her claim, that the 'bar has connections to British universities...whose university insignia are affixed to the walls'. It was put to her that the connections were questionable and that these insignia appeared to be purely decorative rather than reflective of any formal connection.

14. Given that she claims to have access to the Opponent's records, Ms MacElhone could have denied this, or put forward documentary or narrative evidence that these insignia were supplied by the universities as a result of the alleged connections. It is instructive that rather than do so, in her 2nd Witness Statement Ms MacElhone instead refers to a 'YouTube' interview, which is not itself in evidence, supposedly with an American who personally

contributed his own unrelated college memorabilia. She says ‘There is therefore a genuine connection to patrons who have attended these colleges and universities’.

15. There is a great deal of difference between a ‘connection’ with ex-university students who personally donate insignia when they happen to visit the bar and the assertion that there are connections to British universities, especially when the latter is put forward as evidence of a UK reputation. If these ‘connections’ existed, or if the insignia were not simply decoration, one would have expected a fulsome explanation, evidence from the institutions concerned or an emphatic denial. None of these were forthcoming, the response being tangential, and we therefore invite the tribunal to conclude that this evidence of supposed UK notoriety should also be taken with a large pinch of salt and disregarded. Indeed, that caution should be applied to all of Ms MacElhone’s evidence, since her undoubted enthusiasm for and belief in her bar seems to cloud her objectivity.”

97. The applicant concludes, in its skeleton argument:

“56. The Opponent’s case under s. 5(4)(a) is wholly dependent on the existence of goodwill in its signs in the UK. The only pleaded basis for such goodwill is ‘reputation...among Britons...who attend its bars in Paris, Berlin, Hanover, Frankfurt and Cologne etc’, further citing Maxim’s v Dye...No evidence of an actual business of the Opponent within the UK under any of the marks HARRY’S, HARRY’S BAR or HARRY’S NEW YORK BAR is pleaded or evidenced.

57. The current position at common law is that mere reputation (which is not, in any event, admitted) in the UK is not enough – Starbucks (HK) Ltd & Anor v British Sky Broadcasting Group PLC & Ors⁴²per Neuberger LJ at [52]. Maxim’s v Dye is no longer good law, if indeed it ever was. Consequently, the opponent’s case under S.5(4)(a) is untenable.”

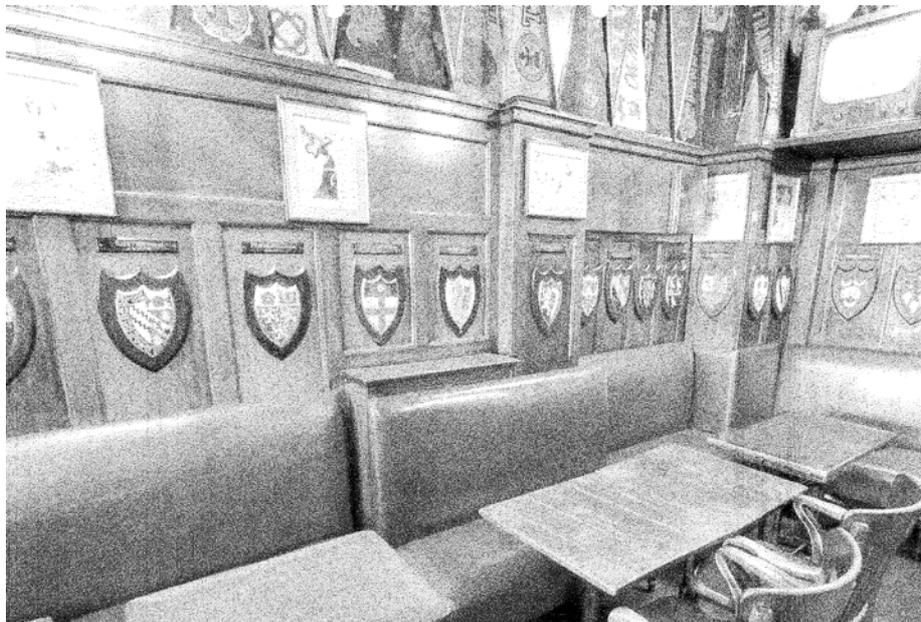
⁴² [2015] UKSC 31

98. The relevant paragraph from the *Starbucks* case, referred to above, is as follows:

“52. As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough, as the cases cited in paras 21–26 and 32–36 above establish. The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere. Thus, where the claimant's business is carried on abroad, it is not enough for a claimant to show that there are people in this jurisdiction who happen to be its customers when they are abroad. However, it could be enough if the claimant could show that there were people in this jurisdiction who, by booking with, or purchasing from, an entity in this country, obtained the right to receive the claimant's service abroad. And, in such a case, the entity need not be a part or branch of the claimant: it can be someone acting for or on behalf of the claimant.”

99. It is clear from my assessment of the opponent's evidence in support of its claim to enhanced distinctive character, that the opponent has a protectable goodwill in respect of the sign HARRY'S NEW YORK BAR. It is also clear that this goodwill is situated in Paris (and may extend to other areas of France, though I am not prepared to make such a finding in the absence of evidence to that effect). At the hearing the opponent drew my attention to pages 18-24 of IM1, taken from www.worldsbestbars.com which includes a number of comments, some of which are possibly from people resident in the UK, for example, one comment begins ‘...planning our long weekend from Scotland to Paris...’ and another which is reviewing the service received comments, ‘This would never happen in the UK or Ireland’. These pages as well as the rest of the opponent's evidence support a finding that any customers from the UK who visit the opponent's bar are tourists (and possibly people who have relocated to Paris).

100. With regard to the submission that the opponent's business has 'connections' with UK universities, the inside of the bar is shown as follows:⁴³



101. When asked, by the applicant, to provide evidence of its connections with UK universities, the opponent did not do so. The *youtube* video referred to is simply a discussion with a customer who donated some university memorabilia to the bar. Above the shields on the wall are numerous US pennants from, inter alia, Utah,

⁴³ See exhibit RNW1

Michigan and Oregon. These, along with the shields displayed above the seating areas, appear to be nothing more than decorative choices, there is nothing in the evidence to show that the opponent has any specific relationships with any universities in the UK, beyond using their insignia as decoration in its bar.

102. There was considerable discussion at the hearing regarding the correct authorities to be considered in this case. The opponent submitted that I should find in its favour based on *Maxim's Ltd v Dye [1977]*, the applicant sought to rely on *Starbucks*. The *Starbucks* case is the later authority and comes from the UK Supreme Court and it is this authority which I must apply here.

103. It is clear from that case that it is not enough for the opponent to show that it has some customers for its business in Paris who have travelled from the UK, although it may be enough if there were people in the UK who by booking or purchasing services whilst in the UK obtained the right to receive the opponent's bar/restaurant services whilst in Paris. The opponent has not provided any evidence to that effect. There is no indication that bookings are made from the UK or that sales are made direct to the UK, nor has the opponent provided anything to show what the perception of the opponent's sign and its business is in the minds of the relevant UK public. A number of assertions are made with regard to the opponent's customers being some of the same customers who frequent the applicant's business but there is nothing in evidence to support that view.

104. Having considered the evidence in detail I find that the opponent does not have the necessary goodwill in the UK and its claim under section 5(4)(a) fails.

105. For the sake of completeness, I note that even if the opponent could show the goodwill required to begin a case under section 5(4)(a) of the Act, the nature of the marks is such that there would not be the necessary misrepresentation, for all of the reasons already provided above.

106. The opposition fails under section 5(4)(a) of the Act.

The opposition under section 5(3)

107. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

108. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective

marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers,

in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

109. In *General Motors*,⁴⁴ the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

110. Under this section of the Act the opponent relies upon its EU trademark HARRY'S BAR. The applicant submits that there is insufficient evidence for the opponent to prove the requisite reputation for its mark HARRY'S BAR either in the UK or at all.

⁴⁴ *Case C-375/97*

111. I have already found above that the opponent's evidence supports a finding that any use, goodwill or reputation generated by the opponent, resides in the sign HARRY'S NEW YORK BAR. Consequently, the opponent cannot show the necessary reputation in the mark HARRY'S BAR for getting a case off the ground under section 5(3) of the Act and the opposition under this ground fails at the first hurdle.

112. In addition, even if the opponent were to have a reputation for HARRY'S BAR in the EU (and the evidence does not show that to be the case),⁴⁵ it has not been shown that any commercially significant part of the UK public are aware of it. Further, the UK public is used to distinguishing both individuals and undertakings by their given names. Consequently, the coincidence of the forename Harry in both parties' marks, would not be sufficient to result in the necessary link being established, even if the earlier mark had a certain degree of recognition amongst the UK public.⁴⁶

113. The opposition fails under section 5(3) of the Act.

Conclusion

114. The opposition has failed in respect of all of the grounds pleaded by the opponent. Consequently, the fact that the mark HARRY'S BAR relied on by the opponent under 5(2)(b) and 5(3) is subject to cancellation proceedings, does not have any effect on this decision which is a final decision.

COSTS

115. The opposition having failed, the applicant is entitled to a contribution towards its costs. I take into account the fact that oppositions were made to two applications, but that large parts of the submissions were duplicated.

116. Three case management conferences (CMCs) were held during these proceedings. The first was to discuss the next steps following suspension of these

⁴⁵ *I need not consider the extent to which the opponent's reputation in Paris may or may not spill over into the UK since the reputation has not been shown for the mark on which the opponent relies.*

⁴⁶ *Defined in Adidas Saloman [2004] ETMR 10 and Intel [2009] ETMR 13.*

cases, the second concerned a two month extension request from the opponent and the third concerned a two month extension request from the applicant. Having considered all of the relevant material, I find that the parties' should bear their own costs with regard to the CMCs.

With regard to the substantive proceedings, I award costs on the following basis:

Preparing counterstatements and considering the other side's statements: £500

Commenting on the other side's evidence and filing evidence: £900

Preparation for and attending a hearing £800

Total: £2200

117. I order Harry's New York Bar SA to pay Selfridges Retail Limited the sum of £2200. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of April 2018

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