

O-353-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3006345  
BY PENGUIN HOT TUBS LIMITED  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 41:**

**Hot Tub Box Office**

**AND**

**OPPOSITION THERETO (NO. 401157) BY DAVID ASHER CHARMAN**

## **The background and the pleadings**

1) Trade mark application 3006345 was filed by Penguin Hot Tubs Limited (“the applicant”) on 16 May 2013. It was published in the Trade Marks Journal on 2 August 2013. The mark and the services for which registration is sought are set out below:

### **Hot Tub Box Office**

**Class 41:** An entertainment event combining a film screening and groups of people sharing hot tubs.

2) Mr David Asher Charman opposes the registration of the mark. Mr Charman is the proprietor of the following earlier mark (2638231) which was filed on 12 October 2012 and which completed its registration process on 1 February 2013:

### **Hot Tub Cinema**

**Class 41:** An entertainment event combining a film screening and groups of people sharing hot tubs.

3) Mr Charman relies on the above mark under sections 5(2)(b) and 5(3) of the Trade Mark Act 1994 (“the Act”). The first of these grounds requires a likelihood of confusion on the part of the average consumer. The second requires that the earlier mark has a reputation and, further, that the use of the applied for mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark. Part of Mr Charman’s case is that:

- i) The mark has received widespread acclaim over the last 18 months for its unique service.
- ii) The applicant has copied imagery and text used by Mr Charman.
- iii) There is a correlation between the words BOX OFFICE and CINEMA which gives grave concern in terms of confusion etc.

4) The applicant filed a counterstatement denying the claims. The applicant states:

Hot Tub Box Office is a non descriptive term for the use of a cinema screen and hot tubs for private and corporate events across the UK and Ireland, unlike 'Hot Tub Cinema' which is a descriptive term (unaware that descriptive terms can now be trademarked?) who only at this moment of time have ever held events in London.

Website - Our website [www.hottubboxoffice.com](http://www.hottubboxoffice.com) had accidentally gone live without our consent, the moment we had been notified of this the website was immediately changed. We would also openly admit that we used the wording 'Hot Tub Cinema' and 'Hot Tub Movies' as a descriptive text to what we provide and was unaware that a descriptive text was trademarked.

Confusion - Hot Tub Cinema claim that customers may be confused and mistakenly purchase a ticket for the Hot Tub Box Office website instead of their own? We would like to highlight that Hot Tub Box Office was the first company to offer customers online bookings and also a list of locations in which they can attend.

If in the unlikely event a customer mistakenly purchases a ticket with the wrong company, we would automatically provide a full refund.

Hot Tub Box Office provides customers (inc corporate clients) a unique experience by providing a selection of hot tubs (inflatable, portable and acrylic) all year round and across the UK and Ireland - When we evaluated Hot Tub Cinema in 2013, they only provided Lazy-Spa inflatable hot tubs, operational during the summer months and London only events.

Events - Hot Tub Cinema had made comment on section Q10 stating that Hot Tub Box Office have yet to run any events, but simply created a website with great potential to mislead customers of Hot Tub Cinema.

Hot Tub Box Office have made no attempt to mislead Hot Tub Cinema customers and take these remarks very serious and would like these comment removed from the application and also the comments regarding that we have yet to run any events as we feel this is totally irrelevant to our application.

5) Only Mr Charman filed evidence. Neither side requested a hearing or filed written submissions in lieu. I will, of course, bear in mind all of the arguments that have been made in the papers before me.

### **Section 5(3) of the Act**

6) Section 5(3)<sup>1</sup> of the Act reads:

“5-(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 Community trade mark, in the European Community) 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.”

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<sup>1</sup> Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the CJEU in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (“Addidas-Salomon”) (C-408/01)).

7) It is a prerequisite of this ground of opposition for the earlier mark to have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 the Court of Justice of the European Union (“CJEU”) explained how known a mark must be to constitute having a reputation:

“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.”

8) The services in question are not ones aimed at specialists in a particular field. The public concerned with the services of the earlier mark is the general public in the UK. Mr Charman gives evidence about the use made of his mark. Mr Charman states that it was first used on 16 May 2011, the date on which the domain name [www.hottubcinema.co.uk](http://www.hottubcinema.co.uk) was registered. However, this does not establish use that the relevant public will have been aware of. The first time the mark was used publically appears to have been on 23 June 2012. This is when an announcement was made on Facebook regarding the first HOT TUB CINEMA event. The event itself was to take place the following month, on 7 July 2012. In terms of press awareness, Mr Charman refers to an article in *The Independent* dated 19 August 2012 about the service he offers. The rest of Mr Charman’s evidence relates to the use made by the applicant and Mr Charman’s claim that it has copied text etc from him. This does not, in my view, help to establish a reputation so I do not consider it necessary to comment on this further here.

9) Mr Charman is claiming a reputation, but the evidence he has provided in support of his claim is extremely thin. There is no indication of turnover or advertising. There is no indication of the number of events run or how many attendees there have been. I consider the evidence to fall a long way short of establishing a reputation under section 5(3) of the Act. **This claim is therefore dismissed.**

### **Section 5(2)(b)**

10) Section 5(2)(b) of the Act states that:

“5.-(2) A trade mark shall not be registered if because –  
.....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11) The CJEU has issued a number of judgments which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person,

quoted with approval the following summary of the principles which are established by these cases<sup>1</sup>:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

### **The average consumer**

12) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses can vary depending on what is involved. The services involved are ones which will most often be aimed at the general public. They could potentially be aimed at the corporate field, as highlighted in the applicant's counterstatement, but this is unlikely to be the norm. Either way, I consider the degree of care and attention likely to be used by the average consumer to be a reasonable one, but no higher or lower than that. Whilst one may not use the services that often, they are unlikely to be high cost events, although, perhaps a little more expensive than a traditional film screening. In terms of how the service provider is to be selected, it is likely that this will be through perusal of websites, brochures etc. This suggests that the visual impact of the marks will take on more importance than the aural impact. However, I will not ignore aural similarity completely because the services could be the subject of telephone bookings or word of mouth recommendations.

### **The distinctiveness of the earlier mark**

13) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

14) Given the findings I have already made with regard to the claimed reputation under section 5(3), Mr Charman is in no better position with regard to any claim that the distinctive character of his earlier mark has been enhanced through use. Therefore, I consider only the inherent qualities of the earlier mark to be pertinent. From that perspective, I note that in its counterstatement the applicant states that the earlier mark constitutes a descriptive term. However, whilst there are mixed national authorities on this point<sup>2</sup>, the judgment of the CJEU in *Formula One Licensing BV v OHIM* indicates that a registered trade mark must be considered to have at least a minimum degree of distinctive character and, therefore, it is not open to me to find that the earlier mark lacks distinctive character completely. In terms of what level of distinctive character the mark has, it is clear that the mark sends a very strong suggestive/allusive signal and I consider it to be very low in distinctive character.

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<sup>2</sup> Compare *Wella Corporation v Alberto-Culver Company* [2011] EWHC 3558 with *Samuel Smith Old Brewery v Philip Lee* [2011] EWHC 1879 at paragraph 82.

## Comparison of services

15) The specification of both marks is worded in exactly the same way:

An entertainment event combining a film screening and groups of people sharing hot tubs.

16) The services must, therefore, be considered as identical. Whilst I note the applicant's comments in its counterstatement that the actual service offerings of the parties have some differences (in the type of hot tubs used, the geographical and seasonal target market) this does not impact upon the inherent identity in the services. In any event, the way in which a business markets itself may change over time, so the point made by the applicant is not pertinent. **The services are identical.**

## Comparison of the marks

17) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

## Hot Tub Box Office

v

## Hot Tub Cinema

18) The words HOT TUB appear in both marks, but they are descriptive and so lack any distinctiveness. The additional words CINEMA/BOX OFFICE also lack any real distinctive character. This means that neither HOT TUB nor CINEMA/BOX OFFICE dominates the respective marks and any distinctive character resides in their totality.

19) From a visual perspective, both marks begin with the same two words HOT TUB, but they end differently. The same analysis applies to the aural comparison. I consider that this creates an average (but not high) level of visual and aural similarity, albeit this similarity is in relation to a descriptive word. The marks are of similar (although not identical) length.

20) From a conceptual perspective, both the words CINEMA and BOX OFFICE have connotations of film going. Both marks use the words HOT TUB which signals that the average consumer will be making use of a hot tub when they avail themselves of the service. Thus, both marks relate in some way to a film

going experience which involves the use of hot tubs. Clearly, the marks are not conceptually identical because the word “cinema” does not have the same meaning as “box office”, although, the former will normally have the latter inside them. I therefore agree with the opponent’s submission that there is a degree of association and a reasonable degree of conceptual similarity.

### **Likelihood of confusion**

21) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. 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.

22) In this case, the most obvious point of visual and aural similarity resides in an element which is clearly descriptive, HOT TUBS. The average consumer would not ordinarily make an assumption of there being a common economic origin on the basis of a shared descriptive element. However, I bear in mind that the marks have the same form of construction and that there is a reasonable degree of conceptual similarity between the marks. Having said that, the idea behind the marks is not very distinctive, as I have said, the distinctiveness in the earlier mark is very low. I must guard against imperfect recollection because the average consumer will often retain an imperfect picture of a mark he or she has encountered and they rarely have the opportunity to see competing marks side by side. Nevertheless, I come to the view that the overall differences are sufficient to offset the similarities, particularly bearing in mind the limited degree of distinctiveness of the earlier mark. **The opposition fails.**

23) In reaching this conclusion I have borne in mind the evidence regarding the applicant using text (etc) from the opponent’s website. I come to the view that whilst this type of evidence may establish that the applicant was inspired by the opponent, it does not establish that there is a likelihood of confusion on the basis of the marks presented.

### **Costs**

24) The applicant has succeeded and is entitled to a contribution towards its costs. I have reduced the award to take into account that it was not legally represented so would not have incurred any legal costs. My assessment is as follows:

*Preparing a statement and considering the other side’s statement - £150*

**Total - £150**

25) I hereby order David Asher Charman to pay Penguin Hot Tubs Limited the sum of £150 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 7th day of August 2014**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**

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<sup>i</sup> The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).