

O-395-09

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2394319

BY TERRY MILLER & LINDA MILLER

TO REGISTER THE TRADE MARK:

ROCKAFELLA

IN CLASSES 29, 30 & 43

AND

IN THE MATTER OF OPPOSITION NO 93911 BY

UMG RECORDINGS INC

TRADE MARKS ACT 1994

**In the matter of application No 2394319
by Terry Miller & Linda Miller
to register a trade mark in classes 29, 30 & 43**

and

**In the matter of opposition No 93911 by
UMG Recordings Inc**

Background

1. On 15 June 2005 Mr Terry Miller & Mrs Linda Miller¹ (“the Millers”) applied to register the following trade mark for the following goods and services:

ROCKAFELLA

Class 29: Prepared meals to include meat, fish, poultry, game and vegetables and snacks.

Class 30: Pizzas and pastas and prepared desserts.

Class 43: Restaurant, bar and catering services.

2. On 14 November 2005 opposition to the registration of the Millers’ application was made by UMG Recordings Inc (“UMG”). UMG’s opposition is made under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) & 5(3), UMG relies on its Community Trade Mark (“CTM”) registration 4650917 for the mark ROC-A-FELLA in classes 9 & 41. Under section 5(4)(a) UMG relies on its claimed goodwill associated with its use of the signs ROC-A-FELLA and ROCAFELLA since February 1997.

3. The Millers filed a counterstatement denying the grounds of opposition. Both sides filed evidence, this is summarized below. Neither side requested a hearing or filed written submissions. I note, however, that both sides made submissions/observations in its evidence and in its statement of case/counterstatement; this will, of course, be considered.

¹ Trading under the name Millers Catering

UMG's CTM

4. UMG's CTM has a date of filing later than that of the mark it seeks to oppose². However, the CTM has a priority date of 11 April 2005 based on an application made in the USA. The Millers' application has no claim to priority. Section 6(1) of the Act states:

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

- (a) a registered trade mark, international trade mark (UK), 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,
- (b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK),
- (ba) a registered trade mark or international trade mark (UK) which-
 - (i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and
 - (ii) accordingly has the same claim to seniority, or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.”

5. It is clear from the above (particularly section 6(1)(a)) that priorities claimed must be taken into account when determining the existence of an earlier trade mark. If UMG's priority claim is valid then this will have the effect of its trade mark leapfrogging the Millers' application. In their counterstatement the Millers highlight that a print from the United States Patent and Trademark Office (“USPTO”) shows a specification which is narrower than the goods and services of UMG's CTM and, therefore, that priority can only be taken into account in

² UMG's CTM was filed on 23 September 2005 whereas the Millers' application was filed on 15 June 2005.

relation to the narrower specification. The Millers rely on Article 29 of the Community Regulation (EC) NO.40/94 of 20 December 1993 and paragraph 5.1 of OHIM's Examination Guidelines to support its argument.

6. UMG's evidence (I will return to the rest of it later) deals with the above point. Whilst it does not dispute the Millers' interpretation of the extent to which a party can claim priority, it highlights that when the USPTO application was made it was for a wider range of goods and services which, in fact, mirrored that of the CTM. Exhibit DHO1 of UMG's evidence consists of a copy of an e-mailed filing receipt from the USPTO in respect of the relevant application from which it can clearly be seen that the goods and services initially filed match that of the CTM. UMG explains that the restricted specification was the result of a subsequent restriction during the examination of the USPTO application.

7. Priority claims stem from an application for the same mark for the same goods and services. This much is clear from the guidance provided by the Millers. I do not, therefore, consider that the subsequent restriction of the USPTO application from which priority is claimed can affect matters. There is no tie to the USPTO application beyond the point of application. The priority date, therefore, stands and UMG's application counts as an earlier trade mark for the full extent of its specification.

8. Matters could, of course, change had the proof of use provisions contained in section 6A³ of the Act applied to UMG's earlier mark. But given that UMG's mark was not registered until after the Millers' mark was published (let alone registered five years prior to that date) then the provisions do not apply. This means, for the purposes of the opposition based on sections 5(2)(b) and 5(3) of the Act, UMG's CTM counts as an earlier trade mark in relation to the following goods and services:

Class 09: Pre-recorded audio tapes, discs and cassettes, video tapes, digital audio and audio video tapes and discs, CDs, DVDs, laser discs, and phonograph records featuring music and entertainment; theatrical or musical sound and video recordings; motion picture films about the music and entertainment industries; virtual reality software; downloadable ring tones, music, mp3s, graphics, games, images and videos for wireless communication devices; and computer and video game equipment containing memory devices, namely, computer and video game software, tapes, cartridges, cassettes, joysticks and remote control units.

Class 41: Production and distribution of television and radio programs; production, distribution and publishing of music; fan clubs; radio entertainment production and distribution; audio recording production; record production; videotape production; entertainment in the nature of

³ Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

ongoing television programs in the field of music and entertainment; entertainment, namely a continuing music and entertainment show distributed over television, satellite, audio, and video media; entertainment in the nature of live concerts and performances by musical artists and groups; entertainment services, namely personal appearances by musical groups, musical artists and celebrities; educational and entertainment services, namely, production and presentation of television shows, sports events, fashion shows, game shows, music shows, award shows and comedy shows before live audiences which are all broadcast live or taped for later broadcast; entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials; entertainment services, namely, providing on-line reviews of music, musical artists and music videos; entertainment services, namely, providing pre-recorded music, information in the field of music, and commentary and articles about music, all on-line via a global computer network; entertainment services namely live, televised and movie appearances by a professional entertainer; conducting entertainment exhibitions in the nature of music festivals; organizing exhibitions for the promotion of music and the arts

UMG's evidence

Witness statement of DeAnne Hideko Ozaki

9. Ms Ozaki is the head of trademark group for the Universal Music Group family of companies which includes UMG. Ms Ozaki states that ROC-AFELLA/ROCAFELLA has been used in the UK since 1997 in relation to, *inter alia*, the management, production, distribution and promotion of sound recordings, music videos and films and entertainment services in the field of music, such as the promotion of live concerts and performances by musical artists and groups. She refers to the "well known and international" artists Jay-Z and Kanye West who are signed to ROC-A-FELLA RECORDS.

10. Reference is made to the circumstances surrounding its opposition (the receipt of a watch notice) and the earlier mark it relies on. Ms Ozaki also refers to the issue of priority as I have already identified. She states her view that the marks are similar, as are the respective goods and services. In support of goods/service similarity she states that there is an overlap between entertainment services and the provision of food and drink. She states that if a ROC-A-FELLA artist such as Kanye West performed a concert at which food was offered under the name ROCKAFELLA [the Millers trade mark] then consumers would believe the services to come from UMG. She refers to the decision of Mr Steve Rowan (a hearing officer for the registrar) in the *Polo Lounge* case (BL O/463/01) in which Mr Rowan found that it was not uncommon for restaurant services or bars to be offered during live performances and other such events and that these services were similar.

11. Ms Ozaki also refers to celebrities owning their own restaurants and, therefore, that the Millers' mark may be perceived as a natural extension in trade of UMG. She believes that all of this means that there will be confusion and that the use of the Millers' mark will take unfair advantage of, and be detrimental to, the distinctive character or repute of UMG's mark.

12. Reference is made to the promotion of UMG's mark by way of it appearing on CDs and CD covers. Exhibit DH03 consists of CD covers. One is for JAY-Z UNPLUGGED with this name (as opposed to ROC-A-FELLA) being the most prominent sign used. There are, though, some uses of ROC-A-FELLA RECORDS/ROC-A-FELLA.COM on the back cover (also shown are the signs MTV and UNPLUGGED), the inside front cover, the CD itself (both, again, with other signs) and on the spine to the left of the words JAY-Z UNPLUGGED and being in smaller print. Similar examples are provided for JAY-Z THE BLUEPRINT (although with less additional signage).

13. Ms Ozaki states that albums produced by ROC-A-FELLA artists are distributed widely throughout the UK and internationally. In the UK they are sold via the retailers ENT UK, HMV, Handleman, Virgin and T.H.E, who all, Ms Ozaki states, have stores nationwide. To illustrate, over one and a half million Kanye West albums were sold in the UK between October 1997 and October 2005 which translates to over \$21million in gross sales. She also provides some further examples of sales relating to ROC-A-FELLA artists from a particular week in 2005 (week 39). The figures are given in shipments (but no information is given as to what a shipment consists of). 4 recordings by Jay-Z are listed which had 86, 11, 57 & 18 shipments respectively, 3 by Beanie Sigel of 24, 2 & 5 shipments, 1 by Memphis Black of 12 shipments and 1 by Tearirra Mari of 68 shipments.

14. Ms Ozaki states that the ROC-A-FELLA brand has achieved prominence through the success of its artists including the success of them winning music awards. For example, in 2004 both Jay-Z and Kanye West received nominations in the 2004 MTV Europe Music Awards. The award ceremony was screened in the UK.

15. Reference is made to the ROC-A-FELLA website. Ms Ozaki states that the domain name has been registered since 1998. An extract is provided in DH04 and it shows various pieces of information about its artists such as tour dates, news, photos of live events etc. ROC-A-FELLA is a prominent sign on the website. I note from this that Kanye West won a Brit Award in 2006 (but this is, of course, after the relevant date). This exhibit also features information about films that ROC-A-FELLA has produced (the 2002 films "Paid in Full" and "State Property" and the 2003 film "Paper Soldiers"). Ms Ozaki states that these films feature ROC-A-FELLA artists and were screened in the UK.

The Millers' evidence

Witness statement of Terry Miller

16. Mr Miller explains that he works in partnership with his wife, Linda. Mr Miller's primary role is as head chef in a restaurant called ROCKAFELLA. Mrs Miller's primary role is in the running of the business but she sometimes helps out in the restaurant. The Millers' business is though characterised by two distinct parts, the restaurant (ROCKAFELLA) which opened in 2005 and an events catering side which trades as Millers Catering; this part of the business started in 1999. Since 2005, Mr Miller has concentrated on the restaurant rather than event catering.

17. Mr Miller recounts the creation of what he calls his signature dish called "King Prawn Rockafella". He created it in 1992 at which point the Millers ran a pub/restaurant called the Plough Inn. The dish was his own creation but it appears to have been inspired by a dish that he was already aware of called Oysters Rockefeller; exhibit TM1 contains an extract from one of his cookery books (I presume one he owns rather than one he has written) showing Oysters Rockefeller. At this point, the name may have been spelt "Rockefeller" rather than "Rockafella". The name was chosen because the dish was expensive and the name was reminiscent of the Rockefeller family in New York which is associated with expense and glamour.

18. The Plough Inn was sold in 2000 and the dish was not used again professionally until 2005 when Mr Miller appeared on the television programme Hell's Kitchen. A lot of detail is provided about this, but it is sufficient to record that this is a TV reality show for chefs/would-be chefs who compete to win a £250,000 prize. Mr Miller was on a team led by Gary Rhodes (the other was led by Jean Christophe Novelli). Mr Miller won the contest and used the prize money to set up his restaurant. The producers of the show informed Mr Miller that he received 450,000 of the 600,000 votes cast. The show's presenter, Angus Deyton, described this as a landslide. He was informed that the show had between 3.5-5.5 million viewers per night over its 15 night run.

19. Exhibit TM2 features some national press articles about Hell's Kitchen 2005 (April 17 – May 2008). Mr Miller himself received a lot of exposure not only for being the ultimate winner, but also for using instant mash potato rather than real mash in his King Prawn Rockafella at an early stage of the competition; Gary Rhodes, his team leader, was not pleased by this. The dish is mentioned in a number of the press articles, as is Mr Miller's plan to open a restaurant under the Rockafella name. Exhibit TM3 contains a menu Mr Miller used on the show and also that of a fellow contestant. Mr Miller's menu includes his Rockafella (although spelt Rockerfella). Comment cards are also provided which, again, make reference to the Rockerfella dish. Mr Miller notes the spelling differences

but he explains that he had not given much thought to the actual spelling until he subsequently named his restaurant.

20. Mr Miller has also appeared on other TV shows such a “Through the Key hole” in 2007 and his own 4 part special in 2007 (“A bite of history”). He states that the King Prawn Rockafella has undoubtedly become known as his signature dish. He refers to filming with Gary Rhodes the day before winning Hell’s Kitchen, he says that after stating that he wanted to open a restaurant, Gary Rhodes suggested that he should call it ROCKAFELLA as that was his specialty and the dish should never come off the menu. Angus Deyton also wished Mr Miller luck on live TV and stated that he looked forward to visiting his ROCKAFELLA restaurant.

21. In relation to the restaurant, this was opened in December 2005 by Gary Rhodes and Alan Shearer. The spelling ROCKAFELLA was used as A-FELLA (rather than E-FELLER) gave it a more north eastern feel. He states that he was often referred to as the “Geordie Fella” whilst on Hell’s Kitchen. Some photographs of the restaurant interior are shown in TM4. He states that the design was intended to be similar to the Hell’s kitchen restaurant (classy and luxurious) but with chic and decadence reminiscent of luxury with which the Rockefeller family is famed. The restaurant seats 74 and they serve up to 120 people on busier nights. TM5 contains a copy of the current⁴ menu, it features various ROCKAFELLA dishes as starters and main courses. Since opening, over 30,000 customers have been served. He has served over 8000 Rockafella dishes. He states that Rockafella is the most popular dish with 1 in 4 people ordering it.

22. Mr Miller states that his restaurant is fine dining in style and he does not consider entertainment of any sort to be part of this. Booking is essential at the restaurant for weekends and they are booked weeks in advance. The average customer spend is £45-50 per head. He states that the restaurant is regarded as trendy and glamorous and he refers to a number of famous people who have dined there. He states that all of this is quite different to the food that is offered at live performance events. He states that although the business also has a catering arm, the ROCKAFELLA name is totally separate from this. He states that his advisers have said that catering should be removed from the specification; I note that this has not been done.

23. Mr Miller refers to the absence of confusion. He states that no one has ever asked whether his restaurant is connected with the ROC-A-FELLA record label. Mr Miller does not agree that if food were provided under ROCKAFELLA then this would be linked to the record label. He states that others he has spoken to have never seen any connection. He states that although he is a hip-hop fan himself and that he is aware of the work of Jay-Z, he had never heard of the Roc-a-fella label before he became aware of its opposition. He believes the only

⁴ Mr Miller’s evidence is given in November 2007

association people might see is with the Rockefeller family name. He understands that the original Oysters Rockefeller may have been named after the Rockefeller family (Exhibit TM6 provides some information in support). He also refers to a song from 1960 called Cinderella Rockefeller which is the only music related connection to the name.

UMG's reply evidence

24. The "evidence" is headed "observations in reply". I will take this into account but will not summarise it separately here.

The section 5(2)(b) ground of opposition

25. Section 5(2)(b) states:

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

(a)

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

26. When reaching my decision I have taken into account the guidance provided by the European Court of Justice ("ECJ") in a number of judgments germane to this issue, notably: *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, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). The above judgments set out the primary principles to be applied in matters such as these; I will refer to them, to the extent necessary, in more detail later in this decision.

27. I should say at this point that the Millers' apparent focus on their exact form of service (fine dining restaurant services) against UMG's primary field of activity (as a record label) is not the test to be applied. The test is, instead, a notional one based on the use (by both parties) of its respective mark in all the circumstances in which it might be used for the goods and services for which it is applied for or registered⁵. Neither can a current marketing strategy of the parties

⁵ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

be taken into account for similar reasons⁶. This is particularly so in the case before me given that neither party has amended their specifications in any way and, also, given that the proof of use provisions do not apply to UMG's mark.

The average consumer and the purchasing act

28. As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) I will begin with an assessment of who this is.

29. The Millers' goods and services are ones aimed at the general public. They are not specialist in any way. There is one exception to this in that catering services could be offered to both the general public and to businesses, there are, therefore, two average consumers to consider there. The average consumer is to be regarded as reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The purchase of a food product is a relatively casual purchase. This can also be said about a bar service. This could increase, to some extent, the significance of imperfect recollection on the assessment I have to make. Restaurant services and catering services are more considered purchases (although I would not say highly considered). The significance of imperfect recollection is not increased, although, it is still a relevant factor.

30. UMG's goods and services are varied. In terms of entertainment services, the average consumer would be the general public. This would also be true of its goods in class 9 such as CDs. The goods and services are neither casual purchases nor highly considered one. A reasonable degree of care and attention will be utilised when they are purchased. Services such as production services are different. The average consumer here would be those who wish to have something produced such as, for example, a musician or group or others in the music field. The purchase is a highly considered one.

Comparison of goods/services

31. All relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services

⁶ See, for example, the judgment of the Court of First Instance (“CFI”) in *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 147/03.

themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

32. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant in the assessment of goods/services similarity:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

33. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

34. In terms of understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark

specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”⁷ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁸. However I must also be conscious not to give a listed service too broad an interpretation; in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 (“*Avnet*”) Jacob J stated:

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

35. UMG focuses, initially, on the following services of the Millers’ application (I will come back to the Millers’ goods later):

“Restaurant, bar and catering services”

36. UMG says that all of its services in class 41 are similar to the above. However, it can clearly be seen from its specification that many of its terms relate to the production of music etc and, certain types of entertainment service (e.g. entertainment in relation to on-going televisions programmes) which, on the face of it, bear little similarity with the opposed services. Its evidence/submissions focus more on live concerts etc, therefore, I consider UMG’s best case to lie with the following service (I can see no closer term that would improve its case):

“Entertainment in the nature of live concerts and performances by musical artists and groups”

37. I will begin by assessing what each of the respective services actually mean/cover. As services are being compared, the comments highlighted above from *Avnet* are particularly important. In relation to the Miller’s terms, a restaurant is an establishment where meals are prepared and served to paying customers. A bar is similar but relates to drink (often alcoholic) rather than food. A bar will often provide food as an additional service and a restaurant will often provide drink as an additional service to accompany a meal. Whilst one could go to a bar with food or drink as a motivator, it is unlikely that you would go to a restaurant merely to drink – the provision of food is the motivating factor.

38. Irrespective of the above, I must highlight that a listed service covers what it says. Therefore, a restaurant is a food related service and a bar is a drink related service. A bar could also be a mobile facility provided at catered events.

⁷ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

⁸ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

39. Catering services would involve the provision of food (and perhaps drink) at particular functions such as weddings, birthdays etc. In this instance, the average consumer would be the person engaging the service provider rather than the person who may end up eating the food (the food eater may never be aware of the caterer's trade mark). However, also falling within this term would be the provision of catering direct to the end-user (the food eater) at events (potentially including music events) or other environments where the end user uses the service of a caterer to obtain food from them.

40. UMG's service could cover differing circumstances. For example, the service could be offered by individual musical artists/groups or their promoters who tour different venues or, perhaps, offer their services to weddings or other functions. Alternatively, a particular venue could also offer entertainment in the nature of live concerts or performances. It would most likely select different musical artists or groups to perform at the venue. The service would, effectively, be offered under the name of the venue.

41. UMG argues that there is a good deal of overlap between the services. It states in evidence that food and drink is often provided at music venues and concerts. UMG states in its "observations in reply" that it is not uncommon for live entertainment to be provided at food and drink establishments including fine dining restaurants. It states that fine dining is a form of entertainment. It states that musical entertainment is provided at restaurants during special occasions or events. It states that there is a concept of a "dinner concert" where guests dine and listen to musical entertainment. The entertainment, it says, can also be provided pre or post dining. UMG highlights a number of decided cases where similarity has been found. The relevant text of one of them is set out below:

2149720 POLO LOUNGE – MR STEVE ROWAN FOR THE REGISTRAR

"34. In contrast, Mr Fernando noted that the uses of the two services were dissimilar, one relates to oral consumption, the other to listening or watching the live performance. Again, the users would be the same but that would be true of any entertainment, it was also his view that establishments that offered live entertainment would inevitably offer food and drink as it was necessary for humans to eat and drink when away from home. He suggested that the nature of the services were different, one relating to the provision of food and drink, the other to the display of artistry, skill or creativity. Thus, although Mr Fernando accepted that there would be some restaurants that might offer live performances, this would be a narrow class and in general, the trade channels would be different.

35. Again, I find that the opponents' evidence supports my own view that it is not uncommon for restaurants or bars to offer live entertainment from time to time. As such there is some overlap and therefore similarity between the applicants' and opponents' specifications. Whilst I accept that

this will not be across the full range of services that might fall within the term 'live performances' there will be some overlap. I reject Mr Fernando's submission that a bar tender would not be in competition with a live performer. The term live performances is in my view broad enough to cover the provision of a venue for live performances and would not be restricted to a live performer. As such, I find that there is some similarity between live performances and the services covered by the opponents' registration.

.....

47. With regard to the term within the applicants' specification 'live performances' I have stated my view that there is less similarity with the services covered by the opponents' specification. As identified by the opponents, there will be services that fall within the term live performances which are removed from the areas covered by the opponents' specification. However, the evidence does show that certain venues for live performances offer a bar and also restaurant services. In such cases, it seems to me that these services are not offered as merely ancillary to the live performance. They are part of the services offered by the venue. Indeed, in some venues, the evidence would suggest that the bar or restaurant is the primary service and the live performance is offered as part of the services offered to customers. Live performances clearly covers a broad spectrum of events, the nature of the bar and restaurant services provided will vary from event to event. The applicants' specification is not limited in any way. In those cases where restaurant and bar services, and live performances are all an integral part of the services offered by a venue then there will be overlap and similarity of services. As the applicants specification is not limited, I reach the view that use of the applicants' trade mark on such live performances would result in the public wrongly believing that the services came from the opponents or an economically linked undertaking. Therefore, I find that the opponents' case in respect of live performances under section 5(2)(b) has been made out."

42. Two further UK opposition decisions and two CTM opposition decisions are also referred to where similar findings were made. It should be noted that none of these decisions are binding upon me. Whilst I have considered them, my decision must be based on the facts and evidence presented in the case before me.

43. In relation to bar and catering services, UMG argues that the link is even stronger. It additionally highlights that bars often have television programmes on screen to allow patrons to watch sports programmes. It highlights that celebrities often open their own restaurants/bars (evidence is provided in SJL2 on this).

44. The Millers say that fine dining (which is what they offer) focuses on the dining experience and that they know of no fine dining restaurant that offers entertainment. The Millers say that the type of food offered at live performances is a totally different proposition. They agree though, that catered food (catering is covered by its specification) is of a more similar nature.

45. Much of UMG's arguments centre on the suggestion that food and drink is offered at live musical events or, alternatively expressed, that live musical events are offered at food and drink establishments. UMG says that this is common, but despite saying this it has filed no evidence to support its proposition. However, it is important to bear in mind that even (I stress the word even because I have not yet dealt with this point) if a restaurant offered some form of musical entertainment service alongside its dining, this would, effectively, be a distinct and additional service to the restaurant. As I have already found after applying *Avnet*, a restaurant is an establishment where food is prepared and served to paying customers. If the service provider also offers further services then that is all well and good, but it is not a restaurant service.

46. In terms of comparing restaurant services with live musical performances, the purpose is different in that one relates to the provision of, and the eating of, food whereas the other relates to listening to and watching a musical performance. This also relates to the method of use. The end users are the same, however, as the end user is likely to be a member of the general public then this cannot create a particularly relevant degree of similarity because this could equally apply to any service aimed at the general public no matter how different they may be. In terms of competition, the choice of either going to eat at a restaurant or going to listen/watch a live musical performance is not one which represents a normal competitive choice due to the nature of the services and the output that the average consumer receives. Neither do I see any complementary relationship as neither are important or indispensable for the use of the other.

47. I am left with the consideration of the trade channels. This represents the strongest argument for UGM. It says that both are commonly offered together at the same establishment. As stated earlier, no evidence has been provided to support this proposition. I must, therefore, decide whether what UMG says is a notorious fact of which I could take account. Whilst I accept that there may be occasions where live music may be provided in a restaurant, this seems to me to be the exception rather than the rule. It is certainly not the norm. Without evidence to demonstrate the commonality of the use of which UMG claims, my finding is that the trade channels of restaurants and live musical performances do not normally overlap.

48. Overall, I have found only one relevant factor (the end user) where there could be any similarity but I have also found that this is a superficial factor when it comes to general public targeted services. As such, I cannot find that these services are similar.

49. In relation to bar services, all of the observations made in the preceding paragraph apply here (bars providing drink rather than food) other than one aspect. This is the aspect relating to the channels of trade. I am prepared to accept in this instance, as a notorious fact, that bars routinely and regularly offer live musical performances and that in any live musical performance venue there is likely to be a bar service. This creates a strong degree of similarity in terms of the trade channels. As the end user (a shared end user) could encounter the respective services in the same establishment then this must create a degree of similarity. However, given the difference in nature etc. then any similarity must be at the lower end of the spectrum.

50. In relation to catering services, the Millers concede that the food served at live musical events will be in the nature of catered for food, the type provided under their catering service. Furthermore, in the circumstance of catering services being used by the actual end user (as opposed to an event organiser) then there is also a link to the same average consumer. This creates a degree of similarity in terms of channels of trade and end user. The nature and intended purpose is, though, different. In my view, the similarities are not strong and, therefore, any similarity between these services must be very low.

51. I will finally return to the goods of the Millers' application. UMG says that the Millers' food products are similar to its entertainment services. I roundly reject this argument. I see no similarity at all in terms of nature, intended purpose, channels of trade. The degree of similarity alleged (that a pizza could be offered at an entertainment service) is far too superficial to result in similarity.

52. In conclusion, I have only found "bar and catering services" to have any degree of similarity to anything in UMG's specification. The opposition under section 5(2) in relation to the other goods (all the goods in classes 29 & 30) and services (restaurant services) must, therefore, fail⁹.

Comparison of the marks

53. When assessing this factor I must do so with reference to the visual, aural and conceptual similarities between the respective marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23). The marks to be compared are:

⁹ See, for example, the ECJ's judgment in *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-398/07*.

UMG's mark:

ROC-A-FELLA

The Millers' mark

ROCKAFELLA

54. There is no difference in how the respective marks will be spoken. They are aurally identical. In terms of visual analysis, UMG's mark is broken down into three segments by the use of hyphens. Whilst this creates a degree of visual difference, the actual text itself is virtually the same (the only difference being the additional K in the Millers' mark and its unremarkable stylisation) which, therefore, creates a strong degree of visual similarity. In terms of concept, whilst I must be wary about not accepting too readily the degree of knowledge that the average consumer may possess¹⁰, I am prepared to accept that the fame of the Rockefeller family of New York is well known by the average consumer (as identified earlier) and given that this is such an unusual name then the average consumer will understand that both marks are suggestive of that name even though they may not be spelt in the same way as that name. Suggestive meanings may be considered in the assessment¹¹. Overall, I find there to be a very high degree of similarity between the respective marks.

Distinctive character of the earlier trade mark

55. The distinctiveness of the earlier mark is another factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). I have already stated that the ROC-A-FELLA mark is an unusual word. I regard it as a fanciful and striking mark. I must, therefore, accord it with a high degree of inherent distinctive character.

56. In terms of whether the distinctiveness is enhanced, this is only worth considering in relation to where I have found similarity between the goods/services. This relates to entertainment services in the nature of live performances. Does ROC-A-FELLA have enhanced distinctiveness here? The answer to this must be no. Whilst some of the artists that are signed to the ROC-A-FELLA record label may have provided such services in the UK, there is no evidence as to the scale of such use or the extent that the ROC-A-FELLA sign is used in relation to this service.

¹⁰ See, for example, the decision of Ms Carboni (sitting as the Appointed Person) in *Chorkee* (BL 0/048/08).

¹¹ See, for example, the decision of the CFI in *Usinor SA v OHIM* (Case T-189/05).

Likelihood of confusion

57. It is clear that the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*, paragraph 17) and that 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.

58. I will firstly consider the matter in relation to bar services. In doing so I must bear in mind the concept of imperfect recollection (which relates to the fact that consumers rarely have the chance to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he or she may have kept in mind¹²). The concepts underpinning the marks are the same which means, despite the presentational differences, that the marks may be recalled as the same. There is, therefore, nothing in the marks to really assist the average consumer to differentiate between them. The earlier mark has a high degree of distinctiveness which is another important factor. On the other hand, I have found that a bar service and an entertainment (live music) service are only similar to a low degree. Nevertheless, it is clear from the case-law that a low degree of similarity between the services can be off-set by a high degree of similarity between the marks. In this instance, I believe that the factors would combine to create a likelihood of confusion. If an average consumer encountered a venue offering live music under the name ROC-A-FELLA then a subsequently encountered bar service (which the average consumer will be aware of often provides live music) called ROCKAFELLA (or vice versa) is likely to lead to the belief that the undertakings offering the services were linked in some way perhaps indicative of an extension into bar services (such as pubs) which also focus on music.

59. In relation to catering services, I found any similarity to be very low. Whilst, as above, there is little to distinguish between the marks themselves and that the earlier mark is high in distinctiveness, I struggle to see why an average consumer who has encountered the ROC-A-FELLA live music service would presume that a subsequently encountered catering service called ROCKAFELLA (or vice versa) was being offered by the same undertaking. The argument put forward (by UMG) that a catering service offered together (under the Millers' mark) in the same venue as ROC-A-FELLA live music services presupposes that UMG actually employ the Millers to provide their catering service in their venue; confusion on such a hypothetical circumstance seems too remote to consider and the sequentially encountered test as outlined above is instead to be preferred. There is no likelihood of confusion.

¹² *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B*

60. I should say before moving on to the other grounds of opposition that the submissions regarding lack of confusion have not been ignored. Although considered, it is not relevant on the facts before me due to UMG not having used its mark in relation to the relevant entertainment service (or at least there is no evidence to that effect), and, therefore, confusion could not have arisen so far.

The section 5(4)(a) ground of opposition

61. Section 5(4)(a) of the Act reads:

“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, or

(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.”

62. The elements of passing off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position quite succinctly when he stated:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff...Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

63. I will deal with this ground briefly. This is because any goodwill UMG has would relate to the production/distribution services (the record label function) and CD's. I have found that there is insufficient evidence in relation to the entertainment services and this includes its use in relation to films because even if they were screened in the UK, no information is provided about their success or how the relevant sign is presented to the public.

64. Although a common field of activity is not required under passing-off¹³, it is still an important factor. In short, I do not see why anyone would believe that the ROC-A-FELLA record company is now providing a restaurant, bar or catering service (or food products). UMG refers to celebrities opening restaurants and bars. This, though, is an exception rather than the rule and, in any event, ROC-A-FELLA is not a celebrity, its artists are those with celebrity status. This ground of opposition fails.

The section 5(3) ground of opposition

65. Section 5(3)¹⁴ 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.”

66. The scope of Section 5(3) has been considered in a number of cases most notably: *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] FSR 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, C.A. *Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Davidoff & Cie SA v Gofkid Ltd (Davidoff)* [2003] ETMR 42, *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd (Adidas-Salomon)* (C-408/01), *Intel Corporation Inc v CPM (UK) Ltd (“Intel”)* (C-252-07) and C-487/07, *L'Oréal SA v Bellure NV*. I will take these cases into account, and will refer to them and the principles that they enshrine, to the extent necessary, in my decision.

¹³ See *Harrods Ltd v Harrodian School* [1996] RPC 697

¹⁴ 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 ECJ 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* (C-408/01).

67. I highlight at this point what the claim itself relates to. In its statement of case (attachment 2 to its notice of opposition) UMG states why the use of the Millers' mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of its earlier mark. UMG firstly repeats its claim of unfair advantage/detriment, but then goes on to state:

“The Opponent has developed a significant reputation in the brand ROC-A-FELLA and ROCAFELLA (evidence of which will follow during the evidential rounds) and is extremely well known in the music and entertainment industry as well as amongst general consumers of these goods. If these same consumers became aware of a restaurant under the name of ROCKAFELLA, then it is alleged consumers would link the name with our client leading to confusion and would clearly be detrimental to the Opponent as they have not given their endorsement.”

Reputation

68. The earlier mark must have a reputation. In *Chevy* the ECJ stated:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

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.”

69. The earlier mark relied on by UMG is a CTM. In case C-301/07 *PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH*, the ECJ gave

guidance on the issue of the required reputation in the Community. The Court stated:

“Article 9(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the European Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

70. The Member State referred to in the above judgment was Austria. This was held to constitute a substantial part of the Community. I have little doubt, therefore, that the UK would also constitute a substantial part of the Community.

71. I will consider the position in relation to goods such as CDs in the first instance. Much of the evidence filed by UMG relates to the activities of the artists that are signed to the ROC-A-FELLA record label rather than the label itself. There is though, use on CDs of the ROC-A-FELLA name and use on its web-site. The problem for UMG, though, is one faced by many record labels. That is, whilst the record label may be responsible for the overall production and marketing of the music produced by the artists whom it has signed, it is still the artist that will be remembered. Consumers do not normally buy a CD due to it originating from a particular record label but rather due to the artist. Whilst the sign is used on CDs and CD covers, its use is smaller in print than the artist's name, and the nature of the marketing process (based on the artist rather than the label) means that many consumers will not even take in the name of the record label even when they look at the CD. The position is not helped by the fact that ROC-A-FELLA records seems to be a sub label with only one or two main artists (Kanye West and Jay-Z). Whilst Kanye West and Jay-Z may be more generally known, I find it difficult to say that a significant part of the public (the general public) will know of their record label. My finding, therefore, is that ROC-A-FELLA does not have a reputation (in accordance with *Chevy*) for CDs or any other goods.

72. I extend the above finding to all of the entertainment services due to the fact that these are also aimed at the general public and there is nothing in the evidence to support the proposition that ROC-A-FELLA will be known by a significant part of the general public in relation to these services.

73. The only services that could, potentially, have a different conclusion would be its services relating to its record label function. This could include:

Production, distribution and publishing of music; record production; audio recording production

74. As stated earlier, the average consumer (or the relevant public in this assessment) would not be the general public but would, for example, be musicians or groups of musicians, e.g. those who wish to be signed to a record label (or to change to another). Despite the persons who make up the relevant public being more likely to pay attention to the record labels that operate in the music world, there is nothing in the evidence to suggest that such persons would have been exposed to the ROC-A-FELLA mark other than by noticing the record label on the recordings of its artists. Whilst ROC-A-FELLA has a website, this is only likely to be accessed by those who either already know of the record label or are particular fans of its artists. There is nothing in the evidence to suggest that the record label promotes itself in the traditional sense of promotion or that its name has been more generally exposed. The relevant public, although a smaller group than the general public, is still quite diverse covering musical genres of a variety of types. Given all this, I do not consider that the evidence demonstrates that ROC-A-FELLA will be known by a significant part of the relevant public. Whilst some will know of it, the evidence does not persuade me of its significance. I also highlight that the evidence itself is not particularly clear when it comes to the precise roles that ROC-A-FELLA actually undertakes for its artists, its evidence deals in quite general terms with little to support its general claims other than the eventual output of CD's etc.

75. In the event that I am wrong on my finding of no reputation in relation to the record label services, my view is that the ground of opposition would, in any event, have failed in relation to the link that is required to be made between the respective marks. In *Adidas-Salomon*, when answering a question as to whether a finding under article 5(2) of the Directive (equivalent to section 5(3) was conditional upon the existence of a likelihood of confusion, the ECJ stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

76. In *Intel*, the ECJ provided further guidance on the factors to consider. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in

respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”

77. Although the marks are highly similar, there is a large degree of dissimilarity between restaurant, bar and catering services on the one hand and the services relating to record production etc. on the other. Although the earlier mark is distinctive per se, any reputation it does have (if I am wrong on my primary finding) is not the strongest of reputations. I do not consider that the consumer would confuse the undertakings.

78. The primary claim set out by UMG is that there would be confusion on the basis of economic connection or endorsement. This is, effectively, a claim to unfair advantage. The link would, therefore, have to be made by the relevant section of the public of the Millers’ goods and services, namely the general public. However, as I have already found, UMG’s mark does not have a reputation with the general public so I fail to see how any link could possibly be made. Therefore, the factors would not combine so that a link is made. In my view, all a member of the relevant public would bring to mind would be the Rockefeller family name.

79. However, UMG also says that the confusion it highlights would “clearly be detrimental”. The type of detriment it relies on is not set out. However, if any form of detriment exists then this must be to the distinctive character or repute of the earlier mark which, in turn, means that the relevant section of the public to consider are those concerned with the services provided under the earlier mark – a link would have to be made by them. This puts UMG in a slightly better position because, despite my primary finding that they have no reputation, I am making here a fall-back finding in the event that I am wrong on that. However, in my view, even considering a member of the relevant public who is aware of ROC-A-FELLA as a record label, such a person will not make a link to the record label if they encountered the ROCKAFELLA restaurant (or its other goods and services) due to the respective services being so diverse. There is no real relationship between

a restaurant and a record label so that the record label would be brought to mind. The more likely response, in my view, would be that the Rockefeller family name would be brought to mind. There is no link and, therefore, no damage. Even if I was wrong on all this, I struggle to see what advantage or detriment would actually be caused.

Summary of conclusions

80. The opposition succeeds under section 5(2) in relation to the Millers' "bar services". The opposition fails in relation to all of the other goods and services.

Costs

81. Both sides have achieved a measure of success. However, the bulk of the Millers' specification remains with only one term refused. In the circumstances, I consider it appropriate to make an award of costs in the Millers' favour, although, this will be reduced from what I would have awarded had the Millers been 100% successful. I hereby order UMG Recordings Inc to pay Mr & Mrs Miller the sum of £400. This sum is calculated as follows:

Considering notice of opposition:	£75
Preparing and filing counterstatement:	£100
Filing evidence:	£150
Considering other sides' evidence:	£75
Total:	£400

Dated this 22nd day of December 2009

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