

O-416-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2648526
IN THE NAME OF
FORRES EVENTS LIMITED

AND

OPPOSITION THERETO UNDER NO 400352
BY KEITH HARRISON

Background

1. On 14 January 2013, Forres Events Limited (“the applicant”) applied under no 2648526 to register the trade mark PIPING HOT FORRES for the following services:

Class 41:
Organisation of pipe band championships

2. Following publication in *Trade Marks Journal* 6981 on 1 March 2013, notice of opposition was filed by Keith Harrison (“the opponent”). The opposition is based on a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade mark registration:

| Mark/no | Relevant dates | Specification of services |
|-----------------------------|---|----------------------------|
| 2559157 Piping Hot Piano | Filing date: 20 September 2010 Date of entry in register: 17 December 2010 | Class 41: Entertainment |

3. The applicant filed a counterstatement in which, essentially, it denied the claims made. Both parties filed evidence. The matter came before me for a hearing on 19 August 2014, in Newport, when the applicant was represented by Mr Ross Manaton of Bromhead Johnson, its legal representatives in these proceedings. The opponent attended in person and represented himself.

The evidence

4. Both parties filed evidence, which consisted of the following:

The opponent’s evidence in chief:

Witness statement of Keith Harrison with exhibits KH01 to KH05;

The applicant’s evidence:

Witness statement of J.T.P Widdowson with exhibits JTPW1 and JTPW2

Witness statement of Marc F. Hindley with exhibits MFH1 to MFH3

Witness statement of Ross Manaton with exhibits RTM1 to RTM9

The opponent’s evidence in reply:

A second witness statement of Keith Harrison with exhibits KH06 to KH09

5. Given the content of the evidence, I do not intend to summarise it here but have reviewed all of it and will refer to it as necessary in this decision.

Decision

6. Section 5(2)(b) of the Act 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.”

7. 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.”

8. The opponent relies under this ground on his mark shown above at paragraph 2. As can be seen from the dates shown, it is an earlier mark within the meaning of the Act. As it had been registered for less than five years at the date the application was published, it is not subject to the proof of use provisions set out in section 6A of the Act. The opponent is therefore entitled to rely on it in respect of all the services for which it is registered.

9. The test for determining whether there is a likelihood of confusion is well established. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs Q.C., expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 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; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

“(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.”

10. In essence, the test under section 5(2)(b) is whether there are similarities in marks and services which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the services, the category of services in question and how they are marketed.

Comparison of the respective services

11. In its skeleton argument, the applicant submits “There is doubt about the precise scope of the attack on the validity of the Application”. It bases this claim on the fact that in its notice of opposition, the opponent had ticked the appropriate box to indicate that only “some” of the applicant’s services are similar to those of the earlier mark. Its claim, as set out in its skeleton argument, is that “the Opponent himself has effectively admitted that not all of the Applicant’s services are “entertainment”.”

12. I note that the applicant’s services are specified as being “organisation of pipe band championships”. It is a single term and the applicant has not broken those services down in any way or further defined those services. It is clear from his submissions, made both before and at the hearing, that the opponent objects to the application in respect of the services for which it seeks registration. I take the view that his indication that ‘some’ services are opposed is simply the result of a clerical error he made when completing the form. My view is supported by the fact that the opponent also indicated in its notice of opposition that he relies on only ‘some’ of his services, however, as the services of his registration are specified by way of the single word ‘entertainment’, the use of ‘some’ would also be equally inappropriate here. The scope of an opposition is a fundamental point but the applicant did not raise any query either when served with the notice of opposition or during the evidence rounds, nor has it sought to amend its application and I take the view that it has understood at all times that the opposition is directed at the applicant’s services as a whole rather than some unspecified part of them. My view is not altered by the opponent’s apparent concession at the hearing that some “organisational” services would not be “entertainment” services. With that in mind, the services to be compared are:

| Opponent’s services | Applicant’s services |
|---------------------|---|
| Class 41 | Class 41 |
| Entertainment | Organisation of pipe band championships |

13. In his notice of opposition, the opponent submits:

“Bagpipe Competitions fall into the category of Entertainment”.

In his first witness statement, he expands on this and states:

“It is factual to report that a Pipe Band Championships are classed as a form of Entertainment, otherwise, members of the public would most likely not attend to watch. This is basic common knowledge, but also obtained from my childhood and up to date interests in traditional music, I also add my professional 25 years in the entertainment business.

As a few examples; members of the public invited to attend an event held in the public’s leisure time, which consists of music performance, speech and dance, the event held at any venue, party in the park, street party, on a boat etc, these all come under the banner of “entertainment”. A Pipe Band competition organised and held in a park “which is itself a recognised recreational area” for family entertainment purposes, or leisure time purposes is covered by the Piping Hot Piano registered Trade Mark using the term Entertainment. “

14. In its counterstatement, the applicant states:

“As to the respective services, the Opponent’s mark covers “entertainment”, and it may be assumed that such entertainment services relate in some way to piano playing (otherwise, the Opponent’s mark would be deceptive and would offend the provisions of Section 3(3)(b) [of the Act]. In order for the Opponent’s registration to be valid, the “entertainment” services should effectively be construed as “piano entertainment” services. On the other hand, the Applicant’s services relate specifically to the “organisation of pipe band championships”. It is denied that these services fall within the general description “entertainment” –and certainly not piano entertainment. It is also denied that there is any relevance in the fact that the respective services are both arbitrarily placed by the International Classification in the same class (class 41). In fact, the respective services are entirely different in nature and the average circumspect and well-informed member of the relevant purchasing public would not expect them to emanate from the same trade source. Furthermore, the highly specific nature of the Applicant’s services is emphasised by the obvious relationship between the word PIPING and the pipe band championships.”

15. In Mr Widdowson’s witness statement he states:

“To my mind, there is no similarity whatever between piano entertainment on the one hand and the organisation of pipe band championships on the other. By way of illustration of the difference in nature of the two enterprises, the 2013 Piping Hot Forres event attracted 122 bagpipe bands comprising 3,600 individual pipers. No pianos (or any other instruments even remotely resembling pianos) were involved”.

16. The applicant’s submissions invite me to make certain assumptions as to the opponent’s services based on the fact that the word piano is part of his trade mark, however, I am mindful of the findings of the Court of First Instance (now General Court) in *Saint-Gobain SA v OHIM* Case T-364/05 where, albeit referring to goods rather than services, it said:

“67... it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed.”

17. I also bear in mind the findings of the same court in the case of *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-414/05:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant’s goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors-whether carried out or not- which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

18. The effect of the above cases is that I have to compare the respective specifications as registered and for which registration is applied, as set out above. The opponent’s services are not subject to any limitation.

19. At the hearing, the applicant referred me to its skeleton argument where it submitted:

“The Opponent’s (sic) services...are not in the nature of entertainment. The fact that some members of the public may find it entertaining to watch pipe band championships is immaterial.

The Applicant’s services are accordingly not primarily in the nature of entertainment services; indeed, they cannot properly be regarded as entertainment services at all. The primary purpose of the services is the facilitation of a serious musical competition; any entertainment that may be derived therefrom is entirely secondary.”

20. The opponent countered that the organisation and delivery of entertainment are part and parcel of the same entertainment services.

21. 'Entertainment' is a very broad term encompassing many activities including those which involve music and will include not only the performance itself but also e.g. the organisation of various matters which enable that performance to go ahead. The organising of pipe band championships brings pipe bands together to compete with each other through their performances. Both the competitors and the audience will be entertained. As was mentioned at the hearing, the position is akin to 'talent' competitions which are the subject of various television programmes which also combine the organising of a competition with the delivery of a performance itself. (I do not consider the manner of delivery i.e. whether the competition or championships are televised or not, would alter this finding). In my view, the 'organisation of pipe band championships' are services which fall within the term 'entertainment'.

22. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*, the General Court considered the matter of identical goods and said:

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

By analogy, the same is true of services. In view of my finding that the applicant's services are included within those of the opponent, the respective services are identical.

Average consumer and the nature of the purchasing process

23. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services and then to determine the manner in which these services are likely to be selected by the average consumer in the course of trade.

24. As indicated above, 'entertainment' is a broad category of services. Such services may be purchased by businesses, organisations or individual members of the public which means the matter must be judged on the basis that the average consumer is a member of the general public. Whilst the applicant's services are more specific, they are also entertainment services which will be used by the general public, albeit those with an interest in pipe bands and their music. Whilst entertainment services are relatively commonplace and widely available, the purchasing process is one which is likely to involve a reasonable deal of care given the need to ensure e.g. the type of entertainment being purchased meets the purchaser's requirements, is provided at an appropriate venue and time and the likely cost involved. Despite being widely available, they are services which are provided by specialist suppliers. In the context of entertainment services, the visual and conceptual considerations of the marks are likely to have an important role to play though not to the extent that the aural aspects of the marks can be ignored.

Comparison of the respective marks

25. For ease of reference, the marks to be compared are as follows:

| | |
|------------------|-------------------|
| Opponent's mark | Applicant's mark |
| Piping Hot Piano | PIPING HOT FORRES |

There are obvious points of visual and aural similarity between the respective marks in that both consist of three words, the first two of which are identical (nothing hangs on the fact that the opponent's mark is presented in title case whilst the applicant's is presented in plain block capitals). There are obvious points of visual and aural difference between them given the third words of the respective marks differ, however, the word Piano is not distinctive for services involving a piano whilst Forres is a town in Moray, Scotland and so has a geographical meaning. At the hearing, Mr Manaton submitted that the earlier mark has a degree of alliteration, due to the first and third words both beginning with the letter P, which is absent from the mark for which registration was applied. Whilst I accept this, I find the respective marks are visually and aurally similar to a reasonably high degree.

26. The opponent submits that the words PIPING HOT hang together and are an idiom deriving from a description that something, usually an item of food or drink, has been heated to a high temperature. The applicant did not disagree with this. In its skeleton argument the applicant submitted that in both marks "the words PIPING HOT will be read and understood as a single element". It also submitted that the meaning of the words and the emphasis given to them had to be considered in the context of the services supplied. I accept that the words PIPING HOT can refer to something which has been heated to a high temperature but in the context of entertainment services, this would be an unlikely meaning. The word Hot/HOT is well known in common parlance as having the meaning of something that is good of its type, much favoured or which elicits much enthusiasm. In the context of the services for which it is registered, the opponent's mark is likely to be seen as an amusing laudatory reference to particularly good or enjoyable piano entertainment.

27. In terms of the applicant's mark, the word PIPING also has an obvious meaning in relation to services involving pipe bands but this does not alter the fact that the words PIPING HOT hang together. They are likely to be seen as an amusing laudatory reference in the form of a pun. The word FORRES is, as set out above, a place name. For those who are aware of the town, the mark is likely to bring to mind particularly good or enjoyable piping in or from Forres.

28. The dominant and distinctive element of each mark is the words Piping Hot/PIPING HOT which make up the first two words of each mark. Both marks bring to mind something particularly good or enjoyable such that they share a reasonably high degree of conceptual similarity despite the additional words Piano and FORRES giving a different object of that similarity.

The distinctiveness of the earlier mark

29. I must also assess the distinctive character of the earlier mark. The distinctive character of a mark can be appraised only, first, by reference to the services for

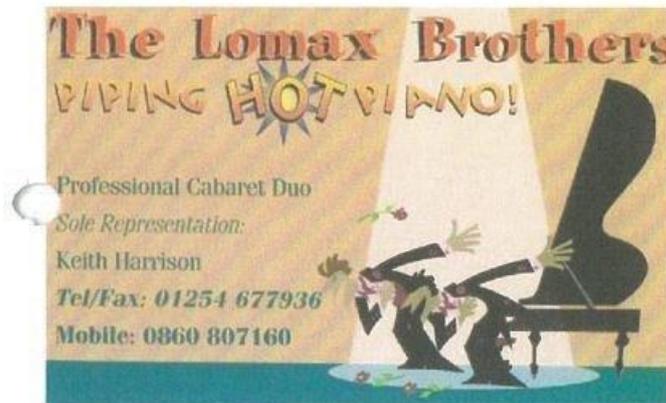
which it is registered and, secondly, by reference to the way it is perceived by the relevant public –*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings –*Windsurfing Cheimsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

30. In his evidence filed on behalf of the applicant, Mr Manaton filed a number of exhibits intended to show “how the phrase “piping hot” is used in the United Kingdom” presumably to support the claim made in the counterstatement that it “is a phrase used by a number of different providers of musical services, in particular by pipers or groups of pipers”. The exhibits, RM1-RM9 consist of pages downloaded from the internet on 26 March 2014 (the date of his witness statement) and most bear no other dates or do not include the phrase PIPING HOT and so do not show what the position might have been at the relevant date in these proceedings.

31. As for the opponent’s use of his earlier mark, whilst he filed two witness statements (erroneously numbered numbers 2 and 3) the only reference I can see to the use made of it is in the first of the two, where Mr Harrison states:

“We originally used Piping Hot Piano! as a fun sub heading to promote one of our professionally managed entertainments acts 1998/2000.”

32. At KH05 he exhibits what he says is a scanned copy of a business card used at that time. The undated card looks like this:



I note that the words are presented on the card in a particular style and include a device element, however, I intend to leave that issue aside. This is not only because the card is undated but also because whilst Mr Harrison refers to “originally” using the mark in the years 1998/2000, he does not say how it was used during this period, whether it was used after this date or what the position was on the relevant date which is the date the opposed application was filed. Neither has the opponent filed any evidence as to the extent of use, if any, he may have made of his mark at any

time in terms of e.g. the location of the venues where any performances may have taken place under the mark, the number of performances which may have been given or the numbers of people who might have attended any such performances. There is no evidence of any advertising having taken place nor is there any evidence of other promotional material. There are no advertising or turnover figures which allow me to form a view as to the extent of use of the mark in the context of the relevant market. In the absence of such evidence, I am unable to find that the earlier mark benefits from any enhanced distinctive character through its use. The mark has an average level of inherent distinctive character.

Likelihood of confusion

33. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. I also have to factor in the distinctive character of the earlier marks as the more distinctive they are the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he or she has retained in mind.

34. Earlier in this decision I found:

- the respective services to be identical;
- the respective marks as wholes to have a reasonably high degree of visual, aural and conceptual similarity, differing only in respect of non-distinctive elements;
- the average consumer is a member of the general public who will take a reasonable degree of care in his purchase;
- the earlier mark has an average degree of inherent distinctive character that has not been shown to have been enhanced through its use.

35. I have to consider the likelihood of both direct and indirect confusion. Taking all matters and submissions into account, I consider that whilst a reasonable degree of care in the purchase may lessen the likelihood of imperfect recollection, the situation here is that the average consumer will notice there is a difference between the marks so will not imperfectly recall or directly confuse them. I consider, however, that the average consumer will put the point of similarity down to the marks being used by the same or a linked company in relation to entertainment services utilising various instruments or provided in a particular location i.e. there will be indirect confusion.

Summary

36. The opposition brought on grounds under section 5(2)(b) of the Act succeeds.

Costs

37. The opponent, having succeeded, is entitled to an award of costs in his favour. In making that award, I note that whilst his evidence indicates he approached trade mark attorneys for advice on various aspects of this case, he chose to represent himself at all times in these proceedings. This leads to him being entitled to a lower amount than would otherwise be the case. I also note that the evidence he filed consisted overwhelmingly of submission or was of little if any relevance to the decision I had to make. Furthermore, the opponent chose to attend the hearing in person (as he was entitled to do) rather than attend by telephone or videoconference. I do not consider it reasonable or proportionate to undertake a full review of the cost he will have expended in dealing with these proceedings but in any event, I remind myself that an award of costs is not intended to compensate him for the expense to which he has been put but instead, is intended to be a contribution towards those costs. Taking all matters into account, I consider the sum of £600 to be an appropriate award.

38. I order Forres Events Limited to pay Keith Harrison the sum of £600 as a contribution towards his costs. This sum is to be paid within seven days of the expiry of the period for appeal against this decision or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 1st day of October 2014

**Ann Corbett
For the Registrar
The Comptroller-General**