

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2116249B  
BY BIG FISH LIMITED  
TO REGISTER A TRADE MARK  
CAFÉ MAMBO  
IN CLASS 35

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER No 47472  
MICHEL HARPER

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5 TO REGISTER A TRADE MARK IN CLASS 35

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UNDER NUMBER 47472  
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10

## DECISION

15 On 19 November 1996, Big Fish Limited of 2<sup>nd</sup> Floor, Mardy Chambers, 6 Wind Street, Swansea, SA1 1DH applied under the Trade Marks Act 1994 for registration of the trade mark **CAFE MAMBO** in relation to the following services in Class 35:

20 “Business management services; advisory services concerning franchising, franchise services.”

25 On the 4 September 1997 Michel Harper of Onslow Street, Guildford, Surrey GU1 4SQ filed notice of opposition to the application, amended on 5 September 2000. The grounds of opposition are in summary:

30 i) The opponent is the proprietor of the UK trade mark number 2112584 BAR MAMBO (and others) in Class 42 filed on 10 October 1996.

35 ii) The application covers franchising which could include franchising of CAFE MAMBO café, bar and like services which are included in Class 42.

40 iii) The mark applied for offends against Sections 3(1)(b), 3(1)(c), 3(4), 3(6), 5(2)(b) & 5(4).

45 iv) Registration of the mark in suit could obstruct or prejudice the legitimate conduct of the opponent’s business.

The opponent further requested that the Registrar refuse application number 2116249B in the exercise of her discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as she did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects.

The applicant filed a counterstatement denying all the grounds of opposition. Both sides asked for costs. Only the opponent filed evidence in these proceedings, and the matter came to be heard on 20 September 2000 when the applicant was represented by Mr Bubb from trade mark agents Gee & Co, whilst the opponent was not represented but instead submitted observations.

## OPPONENT'S EVIDENCE

5 This consists of a statutory declaration, dated 12 June 1998, by Ms Michel Harper, the Managing Director of Harpers Leisure International Ltd, a position she has held since the company's formation in 1990.

10 Ms Harper states that on 19 December the opponent opened a live music bar and restaurant under the trade mark BAR MAMBO in Guildford. Preparations regarding the club began in "the summer of 1996" and at exhibit MH1 are quotes for lighting, promotional items and advertising which date from October 1996. She states that the mark was chosen after a search of the UK Trade Marks Register. The name was chosen after the mark BAR CUBA was abandoned as BAR MAMBO had "a much more general latin theme and not merely indicative of a particular location or culture".

15 Ms Harper states that as a result of an article in the November 1996 issue of "Theme Magazine", provided at exhibit MH2, she discovered that the applicant was preparing to launch a chain of "Café mambo" restaurants and bars. Ms Harper states that the article makes it clear that CAFÉ MAMBO was not in existence and that the artists impression of the interior does not show a café but a bar. She also claims that from the article it is clear that the applicant intends franchising CAFÉ MAMBO café, bar and like services. Exhibit MH2 consists of a page which is numbered but not dated, although there is a column headed "November's Top Bribes". The page is titled "Intelligence" and carries a short article with an illustration of a café/ bar interior. The article states that :

25 "We saw Chameleon Design open their first operation last month and this month we find that ADI Design of Swansea are planning to do the same. In partnership with Stephen Entwistle, formerly of Metrodiner Ltd, the company have set up Big Fish Ltd - with Stephen as MD - to launch a chain of Café Mambo restaurants and bars. Promising a fusion of Latin American, Cuban and Caribbean Cuisine, the chain will be launched in  
30 Swansea next month."

35 Ms Harper states that in her view the trade mark BAR MAMBO is distinctive of the services provided by the opponent and "that franchising of similar services under the confusingly similar name CAFÉ MAMBO will inevitably lead potential customers to assume that any such services are provided by my company".

That concludes my review of the evidence. I now turn to the decision.

## 40 DECISION

At the hearing Mr Bubb withdrew the grounds of opposition under Sections 3(4), 3(6) and 5(4).

45 I shall consider first the ground of opposition under Section 3(1)(b) & (c), which reads:

*3). 1 The following shall not be registered -*

(b) *trade marks which are devoid of any distinctive character,*

(c) *trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*

(d) ...

*Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.*

I begin by considering the law. In *British Sugar Plc v James Robertson and Sons Limited (TREAT)* 1996 RPC 281, Mr Justice Jacob said -

“Next is “Treat” within Section 3(1)(b). What does *devoid of any distinctive* character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word *inherently* from the old Act but the idea is much the same) devoid of any distinctive character.”

I also have regard to the comments of Aldous LJ in the *Phillips Electronics NV v Remington Consumer Products Limited* case (1999) RPC 23 in which he stated:

“The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing.”

The decisions above indicate that the correct approach is to start with the premise that a trade mark is capable of distinguishing insofar as it is not incapable. A trade mark which is found to have sufficient inherent distinctive character to be able to distinguish must be capable of distinguishing. A trade mark which does not have any inherent distinctive character may nonetheless acquire distinctiveness through the use made of it, and in doing so it must, by inference, be capable of distinguishing.

The wording of sub-section (c) goes to whether the mark is sufficiently descriptive of a characteristic of the goods for there to be a reasonable likelihood that it will be required for use by other traders. If the answer to this question is in the affirmative, it follows that the mark must, prima facie, be lacking in the necessary distinctive character to function as a trade mark and be contrary to sub-section (b).

The mark in question is CAFÉ MAMBO which is clearly two basic English words. One CAFE is a well known word. MAMBO has a recognised definition of:

“A Latin American dance or dance tune of Haitian origin, resembling the rumba.”

The specification of the application in suit is “Business management services; advisory services concerning franchising, franchise services.”

5

At the hearing Mr Bubb contended that if the opponent’s application for the marks BAR MAMBO / MAMBO BAR were not distinctive for bar and restaurant services in Class 42 then the mark in suit could not be distinctive. He further contended that the applicant was intent on using the mark in suit in relation to business advice or franchising of café services which the applicant would provide. Thus, he concluded, the services of the opponent and the applicant were similar and the same objection should be upheld.

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As Section 3 relates to objections on absolute grounds, objections based on other marks are not valid. However, the objection based on the descriptive nature of the mark must be considered..

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MAMBO BAR and CAFÉ MAMBO may be descriptive of bars and restaurants with a “Mambo” theme as per JAZZ BAR, but CAFÉ MAMBO is not descriptive of franchising services.

The term “Franchising services” covers services provided to others in relation to a franchise. For example, a business that franchises on behalf of others is providing a franchise service to the businesses who wish to franchise, akin to an Estate Agent selling physical property for others.

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Although the mark in suit is descriptive of a type of themed restaurant it is not descriptive of franchising services. Similarly, if the mark is registered, any other party seeking to franchise their own business under the name CAFÉ MAMBO should not be affected by this registration. That is because the words would be used in relation to a franchised bar or restaurant rather than in relation to the franchising service.

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Consequently the opposition under Section 3(1)(b) and (c) fails.

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Lastly I consider the ground of opposition under Section 5(2) which is as follows:

*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 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.”*

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An earlier right is defined in Section 6, 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 which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities*

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*claimed in respect of the trade marks,*

*(b)...*

*(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 as a well known trade mark.”*

I have to determine whether the marks are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding this issue I rely on the guidance of the European Court of Justice in *Sabel Bv v Puma AG [1998 RPC 199 at 224]*, *Canon v MGM [1999 ETMR 1]* and *Lloyd Schfabrik Meyer & Co GmbH v Klijsen Handel BV [1999 ETMR 690 at 698]*. It is clear from these cases that:-

(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 / 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;

(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 therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2);

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section.

In order to make the global assessment on the likelihood of confusion, it is necessary to consider individual aspects of the question. I propose to firstly consider the similarity of the services of the two parties. In this I rely on the decision by Jacob.J. in the *British Sugar plc v James Robertson & Sons [“TREAT” 1996 RPC 281]*. In that case the court stated that:

*“The following factors must be relevant in considering whether there is or is not 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 the 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”.*

Whilst I acknowledge that in view of the CANON - MGM judgement by the European Court of Justice ( C-39/97) the TREAT case may no longer be wholly relied upon, the ECJ said that the factors identified by the UK government in its submissions, which are the factors listed in TREAT, are still relevant.

The opponent’s mark has not been registered, but its refusal is subject to an appeal. The opponent’s mark had a specification of:

Class 42: “Restaurant services; catering services; bar, cocktail bar and nightclub services; catering for the provision of food and drink; provision of facilities for the consumption of alcoholic and non-alcoholic beverages.”

Whereas the mark in suit has a specification of

Class 35: “Business management services; advisory services concerning franchising, franchise services.”

The uses of the respective services are different even if one takes account of the franchising services concerned with restaurants, bars and cafes. Similarly the users are very different with the opponent’s providing services to the general public and the applicant’s to businesses. The trade channels are different with the opponent’s providing food and beverages whereas the applicant is providing a business service. Lastly, the services are not competitive.

The respective marks, CAFE MAMBO and BAR MAMBO, both have a common word (BAR and CAFE) which have a virtual identical meaning. The second word in each case is identical.

When considering the marks globally I take account that the marks are very similar, however the services are dissimilar. The almost identical nature of the marks is insufficient to give rise to a likelihood of confusion in these circumstances, and that mere association (in the strict sense) is not enough to justify refusal. Therefore, notwithstanding the fact that the marks are similar and even allowing for the notion of imperfect recollection, it is my opinion that the trade marks are not similar enough to have given rise to a likelihood of confusion at 19 November 1996. The

opposition under Section 5(2) therefore fails.

5 The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £235. This sum to be paid 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 26 day of October 2000

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15 George W Salthouse  
For the Registrar  
The Comptroller General