

O/449/11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2513855
BY PAUL GITTINS TO REGISTER THE TRADE MARK:**



IN CLASS 41

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 99346
BY FLYING MUSIC COMPANY LIMITED**

AND

**APPLICATION NO. 83926 BY PAUL GITTINS TO
INVALIDATE THE TRADE MARK:
THE RAT PACK
REGISTERED UNDER NO. 2391940
IN THE NAME OF FLYING MUSIC COMPANY LIMITED**

BACKGROUND



1. On 16 April 2009, Paul Gittins applied to register:



as a trade mark for: “live music entertainment” in class 41.

The application was published for opposition purposes on 22 May 2009.

2. On 21 July 2009, Flying Music Company Limited (“FM”) filed a notice of opposition which consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). FM’s opposition, which is directed against all of the services in Mr Gittins’ application, is based upon the following trade marks:

Trade Mark	No.	Application Date	Registration Date	Goods & services
<p>THE RAT PACK</p> <p>Proceeding because of distinctiveness acquired through use.</p>	2391940	14.05.2005	05.09.2008	41 - Entertainment services in the form of a musical theatre production.
	2342294	03.09.2003	20.02.2004	<p>9 –Musical recordings, CD's, videos, DVD's, tapes.</p> <p>25 –Clothing, T-shirts, hats.</p> <p>41- Entertainment shows.</p>
	2340120	08.08.2003	23.01.2004	<p>9 –Musical recordings, CD's, videos, DVD's, tapes.</p> <p>25 –Clothing, T-shirts, hats.</p> <p>41- Entertainment shows.</p>

3. On 30 September 2009 Mr Gittins filed a counterstatement (subsequently amended) in which he said, inter alia:

“2. Section 5(2)(b) is denied and not applicable as there are many Rat Pack musical tribute shows to “The Rat Pack”, “Frank Sinatra”, “Sammy Davis Jr” and “Dean Martin.” Within a large ongoing entertainment industry performers have had grace to perform bespoke live and recorded tribute productions of swing music from the era as a whole. We have not seen [FM's] own tribute show which is advertised as The Rat Pack Live From Las Vegas on the following [FM] link; THE RAT PACK LIVE FROM LAS VEGAS. Our performance are however unique and British. We do not impersonate the artists above. We offer bespoke entertainment goods and services in an existing tribute industry. Our particular show includes the music of Nat King Cole, Bing Crosby, Matt Monroe, Ella Fitzgerald as well as The Rat Pack.

3. Services in class 41 are denied and not applicable. The British Rat Pack (device) trade mark application in logo and name is unique. It does not lend itself to cause confusion with any other tribute act or theatre show called The Rat Pack in all its varied forms and names including by comparison (a) The Rat Pack Live From Las Vegas [and] (b) The British Rat Pack. There is no comparison to confuse the above...

4. The British Rat Pack has submitted a legitimate request for a unique trade mark registration that does not obstruct or prejudice the so called legitimate conduct of the opponents business. ...The British Rat Pack application is original in title and logo.”

4. On 1 December 2010, Mr Gittins filed an application to invalidate, in its entirety, FM's earlier registration No. 2391940 for the trade mark THE RAT PACK. Following amendment, Mr Gittins relies upon grounds based upon sections 3(1)(a), (b), (c) and (d) of the Act. Mr Gittins frames his objections in the following terms:

“3(1)(a)

(i)[FM's] trade mark comprising the words “The Rat Pack” does not distinguish its services from those of other undertakings, including tribute artists, using the generic term “The Rat Pack.”

“The Rat Pack” originated decades ago and is still marketed by Warner Bros. today...

Many other undertakings use the generic term “The Rat Pack”...The trade mark impeaches upon the individuals and mass music rights of those within the entertainment industry, particularly tribute artists.

(ii) The mark has no original content whatsoever.

The origin and conception of the title is not with [FM].

“The Rat Pack” is generic. It is synonymous with Warner Bros/Las Vegas.

[FM] perform a tribute show drawing solely on Warner Bros’ goods, content, inception and title.

3(1)(b)

“The Rat Pack” trade mark is devoid of any distinctive character. It copies the original Warner Bros term concisely to the letter in style and content, devoid of any original, distinctive or unique character. It relies upon third party origin.

3(1)(c)

[FM’s] trade mark consists solely of generic material signs and indications used for decades within the UK and worldwide by many entertainers and performers in the entertainment business.

3(1)(d)

The trade mark has no original or distinctive matter and is used by countless undertakings, including tribute artists.... Invalidating and removing “The Rat Pack” trade mark would thwart an apparent attempt to create an illicit monopoly over an existing generic term which has enjoyed wide use within the entertainment industry for almost half a century.”

5. On 4 May 2011 FM filed a counterstatement in which it said:

1. It is denied that registration of the mark THE RAT PACK (the mark) does not satisfy section 3(1)(a) of [the Act]. The mark is inherently registrable and received no objections of this nature from the Registry during examination. The applicant for invalidity is put to proof on the issue of non-compliance with section 3(1)(a).

2. It is denied that the mark is devoid of any distinctive character. It is at least the case the mark has acquired distinctiveness by virtue of use.

3. It is denied that the mark is descriptive. The acquired distinctiveness by virtue of use referred to above shows a corresponding lack of descriptiveness.

4. It is denied that the mark has become customary. The acquired distinctiveness by virtue of use referred to above shows a corresponding lack of customary use.”

6. Both parties filed evidence and following a Case Management Conference held in February 2011 the proceedings were consolidated. FM filed written submissions during the evidential rounds (dated 18 July 2011); neither party asked to be heard; both parties filed written submissions in lieu of attendance at a hearing (FM's submissions were dated 19 October 2010 i.e. prior to consolidation and Mr Gittins' submissions were dated 12 September 2011); I will refer to these various written submissions as necessary below.

EVIDENCE

Mr Gittins' evidence

7. This consists of a witness statement, dated 17 June 2010, from Paul Hayden Gittins accompanied by four exhibits. In his statement Mr Gittins says:

“3. The phrase “The Rat Pack” is a generic term which evolved from widely enjoyed swing music performed by Frank Sinatra, Dean Martin and Sammy Davis Junior decades ago.

4 [FM] imply that they own goods and services within an industry which enjoys widespread performance and recording of swing music. The term “The Rat Pack” was not created by [FM]. The original title is owned and marketed by Warner Bros.

5. Warner Brothers still produce and market CDs bearing the name “The Rat Pack” as they have for decades.”

8. Exhibit 1 consists of three pages. Page 1 looks like this:



9. Pages 2 and 3 are the results of an undated Google® search for the following phrase:

“the rat pack w arner bros”.

10. The first ten retrievals are provided and are as follows:

“1. [WBshop.com – The Official Online Store of Warner Bros. Studios...](#)
MOVIE DETAILS. A product thumbnail of Rat Pack, The (DVD). Add to Facebook/Share...2009 Warner Bros. Entertainment Inc. All Rights Reserved. ...
[www.wbshop.com/Rat-Pack.../1000003517, default, pd.html](#) –

2. [Warner Bros. The Rat Pack Collection – 3 Disc Box Set \[DVD\]...](#)
The Rat Pack Collection – 3 Disc Box Set [DVD] on Shopping Lycos. Find our offers for Warner Bros. The Rat Pack Collection – 3 Disc Box Set [DVD] at our...
[shopping.lycos.co.uk/product-warner-bros-the-rat-pack-collection-3-disc-box-set-dvd-c_94833-p_24275096.html](#) –

3. [Amazon.Com: The Rat Pack Ultimate Collectors Edition \(Ocean’s 11...](#)
Rat Pack buddies Frank Sinatra and Dean Martin were prized for their ability to....Warner Bros. is upgrading this DVD set as part of its 85th anniversary ...
[www.amazon.com/Ultimate-Collectors.../dp/B0013LL2Y8](#) -

4. [The Rat Pack revisited. \(Warner Bros.\)\(Brief Article\) | Video...](#)
The Rat Pack revisited. (Warner Bros.) (Brief Article) from Video Business provided by Find Articles at BNET.
[findarticles.com/p/articles/mi_hb5057/is.../ai_n18421360/](#) -

5. [SINATRA.COM | STORE | VIDEOS | Rat Pack Ultimate Collector’s Edition](#)
Roll the dice with four classic “Rat Pack” capers in this swinging Limited Collector’s Edition...Music: Nelson Riddle Released by Warner Bros. Pictures...
[www.sinatra.com/store/.../rat-pack-ultimate-collectors-edition-](#)

6. [Rat Pack Revival | Voxy.co.nz](#)
24 May 2009...The Rat Pack Ultimate Collectors Edition, Warner Bros, RRP \$39.99. If you can remember the 60s then the names Frank Sinatra, Dean Martin...
[www.voxy.co.nz/entertainment/rat-pack-revival/378/14733](#) -

7. [Recasting the “Rat Pack” | Movie News | Movies | Entertainment Weekly](#)
Recasting the “Rat Pack” – See what “Brat Packer” we think should play Dean...Warner Bros. has just re-optioned Dino: Living High in the Dirty Business...
[www.ew.com/ew/article/0,,291115,00.html](#) –

8. Ocean's Eleven (1960)

Frank Sinatra had signed a picture deal with Warner Brothers and was beginning a...After that the Rat Pack broke up with these guys going their own wav...
www.imdb.com/title/tt0054135/

9. The Rat Pack Ultimate Collectors Edition : DVD Talk Review of the...

The Rat Pack Ultimate Collectors Edition. Warner Bros...The last "true Rat Pack" movie, Sergeants 3 is a fun western comedy that is played very tongue...
www.dvdtalk.com/.../rat-pack-ultimate-collectors-edition-the/ -

10. Sinatra & the Rat Pack CDs from Funk & Junk Collectibles

Rat Pack CDs with Frank Sinatra, Dean Martin and Sammy Davis Jr, from Funk...Action Series Pepsi Warner Bros. Large Glasses Other Pepsi Large Glasses."

11. Mr Gittins goes on to say:

"6. The Rat Pack Live from Las Vegas cannot claim to have distinctiveness acquired through use. The swing music of the three artists it impersonates has been performed and recorded by the original artists and numerous impersonation acts since them for half a century. A simple search on the internet reveals approximately 3,060,000 results with numerous artists currently performing using the name "The Rat Pack" in their title or description."

12. Exhibit 2 consists of a Google® search conducted on 17 June 2010 for the phrase "the rat pack" which retrieved "About 3,410,000" results. The most relevant retrievals on page 1 of the 4 page exhibit are as follows:

"The RAT PACK is BACK Show

www.ratpackisback.com Now in its 12th smash year. The Real Vegas and National Touring Show.

Rat Pack – Wikipedia – the free encyclopedia

The Rat Pack was a group of actors originally centred on Humphrey Bogart. In the mid-1960s it was the name used by the press and general public to...
en.wikipedia.org/wiki/The_Rat_Pack_

The Rat Pack (film) – Wikipedia, the free encyclopedia

The Rat Pack was a 1998 HBO TV Movie about the Rat Pack. The movie featured Ray Liotta as Frank Sinatra, Joe Mantegna as Dean Martin, Don Cheadle as Sammy...
[en.wikipedia.org/wiki/Rat_Pack_\(film\)](http://en.wikipedia.org/wiki/Rat_Pack_(film))

The Rat Pack

www.theratpacklivefromlasvegas.com

News for the ratpack

“Marilyn Monroe” helps Bobath Cymru raise £25k at the Rat Pack Ball
The blonde bombshell arrived in a pink cadillac and greeted guests at the Bobath Cymru’s Rat Pack Birthday Ball, which took place at Cardiff’s City Hall...
WalesOnline – 2 related articles

Images for the rat pack

[5 images are shown which appear to show, inter alia, Frank Sinatra, Dean Martin and Sammy Davis Jr]

The Rat Pack – Dean Martin – Frank Sinatra – Sammy Davis Jr...

Get CDs, DVDs, Music, Movies, Posters, Books, and more. See the Ultimate Rat Pack Revue in Las Vegas.
www.ratpack.com/

Rat Pack

Rat Pack show paying tribute to the music of Frank Sinatra, Dean Martin and Sammy Davis.
www.ratpack.biz/

THE RAT PACK, Bournemouth Ratpack

rat pack Bournemouth swing band, Playing Swing, Rat pack Favourites, Jump, Jive, Latin, Retro, Pop and much More.
www.ratpackbournemouth.co.uk

The Rat Pack Productions Ltd

real new York tours. 10000 hits per month.
www.theratpack.co.uk/

The Rat Pack Singer “”Tom Rust crooner wedding and...

Vocalist available with a jazz quartet, orchestra or solo. Site contains MP3s and movies for download, contact information, and photo gallery.
www.theratpacksinger.co.uk/

Videos for the rat pack

[2 images are shown (but cannot be made out). Both are on www.youtube.com and both mention The Rat Pack]

Under the heading "Searches related to the rat pack" appears the following:
"the original rat pack", "the rat pack is back", "christmas with the rat pack" and
"who were the rat pack"

13. On page 2 of the exhibit under the heading "Sponsored links" the following relevant retrievals appear:

Rat Pack Tribute Shows

The UK's Top Rat Pack Tribute Acts. View Complete Listings and Demo's!
www.Dansatak.com/Rat-Pack-Tributes

Rat pack tribute

Booking now for 2010/2011, Frank and dean at your party.
sinatratributeact.com

Rat Pack Tribute Show

The Original Rat Pack Tribute Show!
Ultimate Frank, Dean and Sammy live
www.ratpacktribute.net

The British Rat Pack

5* Swing Entertainment for Special Party Events & Theatre Productions
www.britishratpack.com

The Rat Pack

The latest CDs At Low Prices
With Free Delivery from ASDA
asda-entertainment.co.uk/theratpack

The Rat Pack

Fantastic low prices on CDs.
Feed your passion on e.Bay.co.uk/
www.ebay.co.uk/music".

14. The most relevant retrievals on pages 3 and 4 of the exhibit (which I have not already reproduced above) are as follows:

"REVIEW: The Rat Pack at Bristol Hippodrome (from Worcester News)

8 June 2010...Legends of the 50s and 60s crooners Frank Sinatra, Sammy Davis Jr and Dean Martin are recreated in the "Sands Casino, Las Vegas at the...
www.worcesternews.co.uk/

Christmas With the Rat Pack; Frank Sinatra, Dean Martin, Sammy...

Christmas With the Rat Pack; Frank Sinatra, Dean Martin, Sammy Davis Jr;
Amazon.co.uk Music

www.amazon.co.uk Music Christmas Music Jazz

Dean Martin And The Rat Pack

Sinatra, Martin, Davis, Bishop, and Lawford Were the Rat Pack...and so were others...

www.deanmartinfancenter.com/.../15ratpack/15ratpack.html

The British Rat Pack and the Rat Pack all star swing band

The British Rat Pack All Star Show provides live entertainment for special party events with hospitality includes events team and entertainers.

www.britishratpack.com/

Tenors Un Limited – the Rat Pack of Opera Homepage

“(They) shivered the timbers! “EVENING STANDARD.

“...you absolutely made the night!” TATLER. Tenors Un Limited – The Rat Pack of Opera...

www.tenorsunlimited.com/

Two Rat Pack swing singers in the style of Dean and Frank

Sinatra, Dean Martin and Harry Connick Jnr, delivered with the charm and sophistication of the original artists, ensure your big day goes with a swing.

www.ratpackboys.co.uk

Under the heading “Searches related to the rat pack appears the following (in addition to those mentioned above): “the rat pack songs”, “the rat pack frank sinatra”, “peter lawford” and “the rat pack tribute.”

These pages also contain the following Sponsored links (which have not already been mentioned above):

Rat Pack Bedfordshire

Have the Rat Pack At Your Event In Bedfordshire, 0158 287 3030

www.ratattack.mfbiz.com

Classy Wedding Singer

Superb Rat Pack, Sinatra, Buble, Dean Martin, Harry Connick Jr etc

www.joeswing.co.uk

15. Mr Gittins adds:

“7. The Rat Pack Live From Las Vegas traded without a trade mark between 1999 and 2003. As an individual artist I have been performing swing music for approximately 12 years. The British Rat Pack has been performing live since 2007.

8. Moreover, [FM] does not trade under the style “The Rat Pack” but “the Rat Pack Live from Las Vegas”. If, which is denied, it is entitled to claim distinctiveness through use, then such claim should only apply to “The Rat Pack Live From Las Vegas...”

9. Unlike [FM] the British Rat Pack does not impersonate artists. We as international entertainers perform songs from the swing era but in our own unique British style and interpretation. The Rat Pack Live From Las Vegas is simply one of numerous “Rat Pack” tribute acts...[FM] simply mimic the original Warner Bros Rat Pack.

10. Moreover, The British Rat Pack does not merely perform the songs of Frank Sinatra, Dean Martin and Sammy Davis Junior. Our repertoire extends to include songs recorded and preceding artists including Billy Holiday, Glen Miller, Matt Monroe, Ella Fitzgerald, Nat King Cole, Nina Simone, Bobby Darin, to the fresh modern swing music arrangements of Michael Bubl  and other current chart performers.

13. The Rat Pack Live from Las Vegas cannot be confused with The British Rat Pack by the public in the marketplace. Our services may be similar by performing swing music but they are not indistinguishable and we will not obstruct or prejudice the business of [FM]. “

16. In paragraph 14 of his statement Mr Gittins says:

“14...I respectfully ask that judicial notice be taken of the 2009 case of TRP Entertainment and BC Entertainment in the Nevada Supreme Court which found that the term “The Rat Pack” cannot be trademarked as it is generic...”

17. Exhibit 4 to Mr Gittins’ statement consists of the judgment mentioned above. In his judgment, dated 28 September 2009, the District Judge summarised the background to the proceedings (which took place in the Nevada District Court under Case No. 2:08-cv-0579-LDG (RJJ)) in the following terms:

“TRP Entertainment, LLC, the plaintiff/counterdefendant, alleges that the defendant’s use of the marks “Rat Pack – Frank, Sammy, and Dean” “The Rat Pack A Tribute to Frank, Dean & Sammy”, and “Rat Pack” infringes its registered mark “The Rat Pack is Back” and its common law mark “the Tribute to Frank, Sammy, Joey, and Dean.” Barrie Cunningham, the defendant/counterclaimant, counters with claims seeking a declaration that “The Rat Pack” is generic and cannot be exclusively owned or registered by any party...”

18. In his judgment in which Cunningham was seeking partial summary judgment in respect of his claim that the words “The Rat Pack” were generic, the District Judge said, inter alia:

“Cunningham offers extensive evidence, undisputed by TRP, that the term “The Rat Pack” is recognised by the consuming public as a reference to a group of entertainers: typically identified as Frank Sinatra, Dean Martin, Sammy Davis Jr, Joey Bishop and Peter Lawford. This group of entertainers, either in total or in various combinations, appeared together in live stage performances and in movies during the 1960s. The entertainers, themselves, did not generally identify themselves as the Rat Pack. Rather, the reference appears to have been adopted by the popular media to refer to members of the group, often in reference to their joint live (and often impromptu) show appearances. Cunningham’s evidence establishes that, subsequent to the 1960s, numerous and various different types of products, including books, documentaries, movies and compact disc or DVD recordings (including recordings of joint performances from the 1960s), have used the term “The Rat Pack” to identify that the underlying product concerns this group of entertainers or is a recording of a joint entertainment performance involving this group of entertainers. As noted, from its initial use as a reference to this group of entertainers, the entertainers did not use the term “The Rat Pack” to identify the origin of a good or service offered by the group. Rather, “The Rat Pack” was a term used by persons or entities to refer to the group of entertainers, or to the activities of the group, or to indicate that an offered service or good concerned this group of entertainers in some fashion.”

And:

“Stated succinctly, Cunningham’s evidence establishes that, long before TRP offered live musical shows, the term “The Rat Pack” had a meaning that was used in connection with the joint performances of members of the Rat Pack during the 1960s. While some of these performances included movie appearances, typically the joint performances were live musical performances. Since the 1960s, the term “The Rat Pack” has been used by producers of many types of goods or services to indicate that the goods or services relate to members of the Rat Pack or to the joint movie or live (or recorded) musical performances of the Rat Pack during the 1960s. From its initial use to refer to members of the group, particularly when performing live musical entertainment, “The Rat Pack” did not and, indeed, could not refer to or identify TRP’s live musical show.

By contrast, TRP has not offered any evidence that, in using the term “The Rat Pack” in connection with its live musical show, it has deviated from this existing usage. Rather, TRP’s own common-law mark indicates that it adopted the term “The Rat Pack” to draw upon consumer’s association of the term with the Rat Pack. The Rat Pack is not a reference to TRP’s show, but a reference indicating that the live musical show concerns or is about the Rat Pack.

...TRP cannot appropriate the term “The Rat Pack” for its exclusive use. As the term “The Rat Pack” is generic in the context of live shows about or in tribute to

members of the Rat Pack, TRP does not have an exclusive right to use the term “The Rat Pack.””

19. In its submissions FM said of this judgment:

“It is submitted that exhibit 4...is not relevant to the current proceedings on the basis that it refers to a judgment in a United States Court, which does not have jurisdiction in the UK.”

20. Although I have, as requested by Mr Gittins, noted the above judgment and recorded the substance of the judge’s conclusions here, for the reasons explained by FM, it will play no part in the conclusions I reach and I will make no further mention of it in this decision.

FM’s evidence

21. The first witness statement, dated 18 March 2010, is from Richard Waddington who is a Partner at Appleyard Lees, FM’s professional representatives in these proceedings. Exhibit RW1 to Mr Waddington’s statement consist of a witness statement dated 10 January 2008 (accompanied by 3 exhibits) from Derek Nicol who is the joint Managing Director of FM and which was originally filed at the ex parte examination stage in support of what was then application No. 2391940.

22. Mr Nicol states that the trade mark THE RAT PACK was first used by FM in September 1999, adding that the trade mark has been used on advertisements and promotional material “relating to entertainment services in the form of musical theatre” since that time. He goes on to say that approximate turnover figures in relation to the above services conducted under the trade mark THE RAT PACK were as follows:

Year ending	Turnover - £
2000/2001	362,551
2001/2002	47,678
2002/2003	2,801,563
2003/2004	8,880,524
2004/2005	6,635,580
2005/2006	8,393,580
2006/2007	3,092,420

23. By the date of his statement, Mr Nicol explains that a total of £3,135,000 had been spent promoting services in the United Kingdom conducted under THE RAT PACK trade mark.

24. Exhibit DN1 consists of what Mr Nicol describes as:

“samples of a number of press advertisements...which have appeared in national newspapers. The advertisements date from 1 September 2002 to 16 February

2007. As can be seen, the mark THE RAT PACK has featured exclusively in such advertisements over the past five years.”

25. Despite the poor quality of the photocopies provided, the following are examples of how the words THE RAT PACK are used by FM and the dates and publications in which they appeared:

It's Las Vegas... and it's the coolest party in town!

FRANK SAMMY DEAN

The
RAT PACK
LIVE FROM LAS VEGAS

THE LAST IS A TRAMP
I GOT A KICK OUT OF YOU
FIVE GUYS AND A DANCE
THAT'S AMORE - MY TRICK
LITTLE BOY SCARED ME
THAT OLD BLACK MAGIC
NEW YORK, NEW YORK

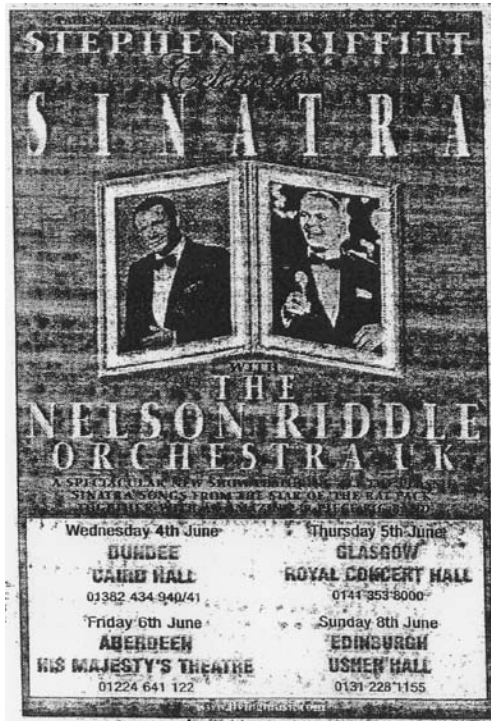
MY KINDA TOWN
FLY GIRL TO THE MOON
SWAY - VOLARE
STRANGERS IN THE NIGHT
RAY WAY - CANDYMAN
MEMORIES ARE MADE OF THIS
WHAT KIND OF FOOL

THE RAT PACK BIG BAND
THE RAT PACK STRIPPERS
THE RAT PACK COMEDY
THE RAT PACK DANCERS

UK TOUR 2002 · SEPTEMBER - NOVEMBER

SEPTEMBER	SEPTEMBER	SEPTEMBER
Wed 25	MARTFORD, The Orchard	01322 220 000
OCTOBER		
Sun 1	BASINGSTOKE, The Asad	01256 844 244
Wed 2	CHETENHAM, Town Hall	01242 227 973
Thu 3	SOUTHPORT, Theatre	0710 607 7568
Fri 4 - Sat 5	CROYDON, Astcroft Theatre	020 8688 8231
Sun 6	CAROLINE, St David's Hall	02526 878 444
Sun 8 - Sat 12	WELL, New Theatre	01482 22 66 55
Sun 13	SHEFFIELD, City Hall	0114 278 9789
Sun 15	EASTBOURNE, Congress Theatre	01323 412 000
Wed 16	ST ALBANS, Alhambra	01727 944 488
Thu 17	PORTSMOUTH, Guildhall	023 9282 4355
Fri 18	WESTON SUPER MARE, Playhouse Theatre	01534 645 544
Sat 19	TOURNAI, Princess Theatre	0870 241 4120
Sun 20	STONE, THE TOWN, Victoria Hall	01782 213 880
Sun 22 - Sat 25	BIRMINGHAM, Alexandra Theatre	0870 607 7552
Sun 27	LEICESTER, De Montfort Hall	0116 233 3111
Mon 28	CHESTERFIELD, Winding Wood Theatre	01246 345 334
Wed 30	PRESTON, Guildhall	01772 258 858
Thu 31	PETERBOROUGH, The Crescent	01753 265 705
NOVEMBER		
Fri 1	BARNSTAPLE, Queens Theatre	01271 32 42 42
Sat 2	CAMBRIDGE, Corn Exchange	01223 357 851
Sun 3	CAULDRAY, Central Theatre	01634 403 865
Sun 5 & Wed 6	BIRMINGHAM, Forum Theatre	01642 552 663
Thu 7 & Fri 8	Bournemouth, Pavilion Theatre	01202 6 436
Sat 9	TRURO, Hall For Cornwall	018 1766
		01202 1312

The Sunday Express, 1 September 2002 and 11 May 2003, *Sunday Mirror*, 22 September 2002, 5 September 2004, *Evening Standard*, 15 November 2002, 28 April 2005, *Metro (Metro Life)*, 27 February 2003, 24 February 2005, *Daily Mail*, 22 April 2005, 16 February 2007, *Telegraph Review*, 30 December 2006, *The Sun*, 12 January 2007.



The Sunday Post, 1 June 2003 and the Evening Standard 12 March 2004. Although very indistinct, below the words “with THE NELSON RIDDLE ORCHESTRA UK” the following words can be discerned:

“A SPECTACULAR NEW SHOW...SINATRA SONGS FROM THE STAR OF THE RAT PACK...”



Sunday Express, 5 December 2004, *The Sun*, 15 September 2006, *Sunday Mirror*, 15 October 2006, *The Mirror*, 20 October 2006.

26. Exhibit DN2 consists of what Mr Nicol describes as use of the trade mark THE RAT PACK on “brochures” whose dates range from 2002 to 2007. Once again the vast majority of the use shown is of the words THE RAT PACK accompanied by the phrase “LIVE FROM LAS VEGAS”. The following text appears (albeit in slightly different forms) in a number of the brochures:

“FRANK SINATRA, SAMMY DAVIS JR and DEAN MARTIN...names that have been immortalised on the silver screen and in the wider sphere of popular music. Simply put, they are legends of the 20th Century and icons of American history who, with their inexhaustible energy and sheer talent, are still a force to be reckoned with.

Enormously popular in records, film and television, they were pioneer entertainers of Las Vegas. They got their kicks from performing live – their favourite venue...The Sands, Frank, Sammy & Dean made the Sands famous as word spread about their many appearances there, some scheduled, a lot spontaneous but in all cases their zany banter and jokes were always present as they pulled on one another both on and off the stage. When the Rat Pack were in town everybody had the best of times and everybody made money. Everyone partied hard and everybody who was anybody wanted to be part of the hottest and coolest exclusive club the world has seen...THE RAT PACK.

The Rat Pack – Live from Las Vegas celebrates these amazing talents in a unique night of entertainment...”

27. Exhibit DN3 consists of newspaper and Internet reviews of FM’s theatre production which appeared between October 2002 and May 2007 in a range of publications, namely: the *Basingstoke Gazette Extra*, the BBC website, *Mirror Review*, *Ipswich Evening Star*, *Birmingham Evening Mail*, *Leicester Mercury*, *Irishy Examiner* (in relation to a show at the Opera house, Cork), *Gazette & Herald*, *Daily Echo*, *Bath Chronicle* and *Edinburgh Evening News*. Once again the majority of the articles refer to “THE RAT PACK LIVE FROM LAS VEGAS” (or similar).

28. The final witness statement, dated 21 January 2010, is from Paul Walden who is the joint Managing Director of FM. The purpose of Mr Walden’s evidence is, he explains, to:

“3...complete the picture from 2007...to 2009.”

29. Mr Walden explains that turnover in the periods 2007/2008 and 2008/2009 amounted to £3,083,570 and £1,380,142 respectively, and that an additional £460k has been spent promoting FM’s entertainment services under THE RAT PACK trade mark in the intervening period.

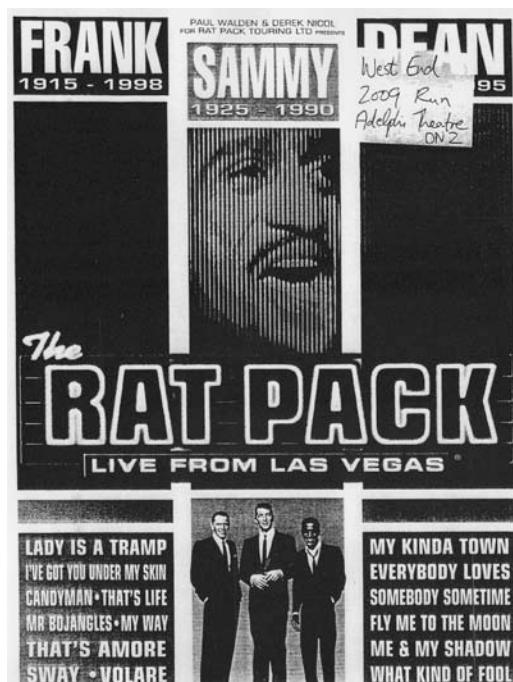
30. Mr Walden explains that exhibit PW1 contains a table of advertisements placed for 2009. The placement of these advertisements appears to have been handled on FM's behalf by an undertaking called Sold Out and relates to two separate campaigns i.e. "Rat Pack Xmas Tour 2009" and "RAT PACK 2009: Adelphi Theatre."

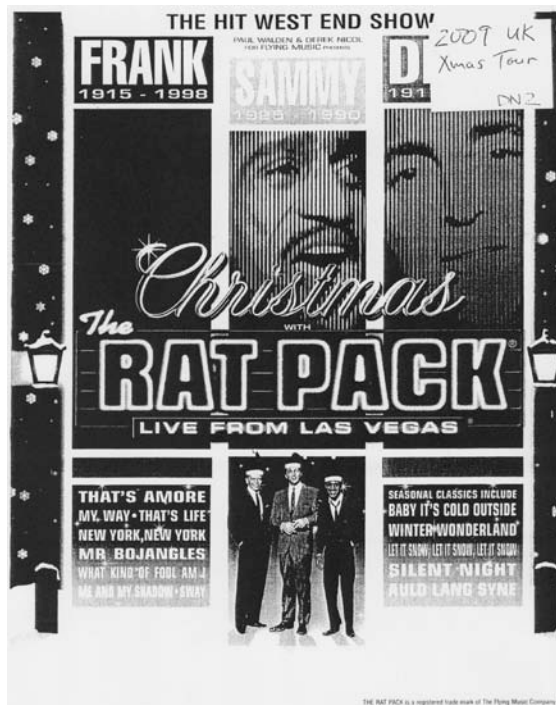
31. Insofar as the first campaign is concerned, it indicates that advertisements were placed in the: *Daily Mail Classified National* (on 5 occasions between 24 July and 27 November 2009), *Mail on Sunday* (on 11 October 2009), *Daily Telegraph Ents. Classified* (28 November 2009), *Metro – National* (10 August 2009), *Observer (Classified Ents.)* (4 October 2009), *Sunday Express* (on 6 September and 15 November 2009), *Sunday Mirror "Life" – National* (on 26 July, 4 October and 29 November 2009), *Sunday Telegraph – Seven (Class)* (1 November 2009), *Sunday Times – Culture Ents. Classified* (13 September, 1 November and 29 November 2009), *Independent* (2 October 2009), *Daily Telegraph Classified* (3 October 2009), *Jewish Chronicle* (18 September 2009), *Mirror Ticket National* (11 September and 30 October 2009), *Saga Magazine* (21 September 2009), *Sun (Something for the Weekend)* (24 July and 11 September 2009), *Daily Record* (11 September and 30 October 2009), *Sunday Mail (Scotland)* (13 September, 1 November and 29 November 2009), *Sun (Scotland) Classified* (30 October 2009), *Daily Telegraph – Display* (12 September 2009), *Proms in the Park Brochure 2009* (12 September 2009) and that on-line costs in relation to "AMAZON MPU" were also incurred.

32. In relation to the Adelphi Theatre campaign, advertisements were placed in the: *Daily Mail Classified National* (26 June, 24 July and 11 September 2009), *Mail on Sunday* (13 September 2009), *Metro National* (10 August 2009), *Sunday Express* (28 June and 6 September 2009), *Sunday Mirror "Life" National* (5 & 26 July & 20 September 2009), *Sunday Times – Culture Ents. Classified* (13 September 2009), *Jewish Chronicle* (18 September 2009), *Mirror Ticket National* (11 September 2009), *News of the World Ents. Section* (28 June 2009), *Saga Magazine* (21 September 2009), *Sun (Something For The Weekend)* (24 July and 11 September 2009), *Sunday Times – Culture Display* (5 July 2009), *Daily Telegraph – Display* (4 July and 12 September 2009), *Proms in the Park Brochure 2009* (12 September 2009), *Essex Chronicle Series* (11 September 2009), *Kent Messgr Series – What's On* (11 September 2009), *Surrey Adv Group What's On* (11 September 2009), *Evening Standard* (25 June, 12 August, 11 September and 23 September 2009), *Time Out* (15 September 2009), *Hampstead & Highgate Express* (11 September 2009), *London Lite* (18 September 2009), *Metro London Entertainments* (26 June, 17 July, 11, 22 & 24 September 2009), *Daily Telegraph – Theatre – Lineage* (7, 14, 21 and 28 September, 1, 5, 12, 19 and 26 October 2009), *Guardian Theatre Lineage* (7, 8, 14, 21, 24, 26 and 28 September and 5, 12 and 19 October 2009), *Observer – Theatre Lineage* (13 and 20 September, 4, 11, 18 and 25 October 2009), *Sunday Express – Lineage* (13, 20 and 27 September, 4, 11, 18 and 25 October 2009), *Times Theatre Lineage* (7, 14, 21 and 28 September, 1, 5, 12, 19 and 26 October 2009), *Daily Express – Theatre Lineage* (7, 14, 21 and 28 September 2009, 1, 5, 12, 19 and 26 October 2009), *Evening Standard – Theatre Lineage* (7, 14, 21 and 28 September, 1, 5, 12, 19 and 26 October 2009), *Evening Standard/Metro Lineage Comb* (11, 18 and 25 September, 2, 9, 16, 23 and 30 October

2009), *Independent – Lineage* (7, 14, 21 and 28 September, 1, 5, 12, 19 and 26 October 2009), *Independent on Sunday - Lineage* (13, 20 and 27 September, 4, 11, 18, 25 October 2009), *Sunday Telegraph – Theatre Lineage* (13, 20 and 27 September, 4, 11, 18 and 25 October 2009), *Daily Mail Classified National* (2 and 10 October and 27 November 2009), *Mail On Sunday* (11 October 2009), *Daily Star* (23 October 2009), *Daily Telegraph Ents. classified* (28 November 2009), *Guardian (G2 Classified Ents.* (21 October 2009), *Observer Classified Ents.* (4 October 2009), *Sunday Express* (15 November 2009), *Sunday Mirror “Life” – national* (4 October and 29 November 2009), *Sunday Telegraph – Seven (Class)* (1 November 2009), *Sunday Times – Culture Ents. Classified* (1 and 29 November 2009), *Independent* (2 October 2009), *Daily Telegraph Classified* (3, 24 October 2009), *Mirror Ticket National* (30 October 2009), *Times T2 (Classified)* (23 October 2009), *Mirror Ticket London/S.East* (23 October 2009), *Evening Standard* (22 October and 27 November 2009), *London Lite* (23 October 2009) and *Metro London Entertainments* (2 and 21 October 2009). I note that FM’s services were also promoted by means of posters in a range of locations, on signage at the theatre, on-line and by a variety of other marketing methods.

33. While none of the advertisements to which these details relate are provided, exhibit PW2 to Mr Walden’s declarations contain examples of brochures that were used in 2008, together with brochures used to support the run at the Adelphi Theatre in 2009 and the 2009 Christmas Tour of the United Kingdom, the front covers of which are as follows:





34. FM's 2008 programme contains, inter alia, the following text under the heading "The Rat Pack":

"Frank Sinatra. Sammy Davis Jr. Dean Martin. Three names synonymous with the popular culture of the twentieth century. Three very cool, wisecracking hip cats who reached the peaks of show business all around the world. However, it wasn't all about work, it was about fun, style and above all, friendship. It was about the pack. After their explosion onto the entertainment scene in the early 1950s and their subsequent domination of it, they continued doing what they did best, making the movies, singing the songs, and having a little "hey-hey" on the way.

Lauren Bacall coined the phrase "Rat Pack" when after a night out on the town, Humphrey Bogart, Frank Sinatra and a collection of friends staggered in for her to exclaim "...you look like a Goddamned rat pack.". The name stuck.

When Bogart died, Sinatra missed the fun the "pack" used to have so in an effort to keep the party going he formed his own group and brought in his buddies Sammy and Dean, who were later joined by Peter Lawford and Joey Bishop. This group of friends eventually became known as the Rat Pack also.

The Rat Pack's supreme moment arrived in 1960 when they were filming the casino robbery caper "Ocean's Eleven". Really, Frank got together a group of his closes buddies, took them to Vegas to have a good time, oh, and make a movie. Most of the filming took place at the Sands Hotel and Casino, in which Frank had a small stake. He decided that either he, Sammy or Dean would perform each night, doing two shows per night. Frank opened the first night, followed by Dean on the second, both shows going down well with the audiences. On the third night while Sammy was coming to the end of the show, Frank joined him on

stage, they ad-libbed a few funny lines and ended the show. They both walked off the stage to the biggest round of applause of the three nights.

The behaviour continued the next night, whilst Frank performed; Dean started to heckle “Frank that’s enough, Frank that song is too long, sing something shorter...”. The audience was shocked, after all this was Sinatra in the Copa Room in full tux doing a very professional show, they did not know if Dean was being serious, if he was drunk or if it was part of the act. This undisciplined joking around and horseplay was not what the audience was expecting but they loved it.

The Rat Pack called their act “The Summit” where Frank, Sammy and Dean would carry most of the act; they would croon, quip, one-up each other and roll out booze filled jokes accompanied by their on-stage liquor cart. As Dean Martin said: “The satisfaction I get out of working with these two bums is that we have more laughs than the audience.” The Copa Room, nestled in the heart of the Sands, became their home. The Sands became the coolest nightspot in the world.

With this recreation of one of those evenings at the famous Copa Room, you’ll be transported back to a chic era of glamour, indulgence, excess and all that was good, and bad, about the Rat Pack.

Not only were Frank, Sammy & Dean cool in their day, they’re still cool now. Their influence is currently all over the UK charts and still in the cinema. “Ocean’s Eleven” was re-made in 2001, but probably without as much fun on the set as the original cast members had.

Now, Frank, Sammy and Dean are probably sipping Jack Daniels on the rocks and playing the big casino in the sky. But not all good things have to end, the legends and the music still live on. So, kick back, get ready to click those fingers, and check out the coolest party in town in celebration of arguably the hardest partying clique in history. You won’t find anything like it anywhere else. After all, this is the Rat Pack. Ring-a-ding-ding.”

35. Exhibit PW 3 consists of further reviews of FM’s theatre show which (where they can be attributed and where they have not already been included in exhibit DN3) are as follows: *The Irish World* (24 October 2009 - Adelphi Theatre), *What’s on Stage* (29 September 2009 – Adelphi Theatre), *The Irish News* (11 September 2008 - Grand Opera House, Belfast) and *Western Morning News* (19 December 2008 – Plymouth Pavillons). Of the five new reviews provided, four refer to: “The Rat Pack Live from Las Vegas”.

36. That concludes my summary of the evidence provided to the extent that I consider it necessary.

DECISION

Invalidation action No. 83926

37. I shall deal first with Mr Gittins' request (based upon sections 3(1)(a), (b), (c) and (d) of the Act) to have FM's registration No. 2391940 for the trade mark THE RAT PACK registered in class 41 for: "entertainment services in the form of a musical theatre production" declared invalid. The relevant part of section 47 of the Act reads as follows:

"47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered."

Subsections 5 and 6 of section 47 of the Act state:

"(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

38) Sections 3(1)(a), (b), (c) and (d) of the Act state:

"3. - (1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1)

(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) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

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.”

39. Section 1(1) of the Act states:

“(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

The relevant date

40. The relevant date for assessing whether the words THE RAT PACK are contrary to sections 3(1)(a) to (d) of the Act is the date on which FM applied for registration i.e. 14 May 2005. Whilst I note that FM’s (then application) proceeded to publication on the basis of distinctiveness acquired through use, I must consider the matter afresh. I will return to the use FM have made of the words THE RAT PACK below.

The origin of the phrase THE RAT PACK

41. FM’s evidence indicates that the phrase The Rat Pack was coined by the actress Lauren Bacall to refer to Humphrey Bogart, Frank Sinatra and “a collection of friends”. Following Humphrey Bogart’s death, Frank Sinatra formed his own group, a group which consisted of Sammy Davis Jr. Dean Martin, Peter Lawford and Joey Bishop; this group also became known as The Rat Pack. FM’s evidence states:

“FRANK SINATRA, SAMMY DAVIS JR and DEAN MARTIN...names that have been immortalised on the silver screen and in the wider sphere of popular music. Simply put, they are legends of the 20th Century and icons of American history....

Enormously popular in records, film and television, they were pioneer entertainers of Las Vegas.”

42. FM’s evidence goes on to explain that in 1960 whilst filming “Ocean’s Eleven” in the Sands Hotel and Casino in Las Vegas, Frank Sinatra decided that either he, Sammy Davis Jr. or Dean Martin would perform each night. On the third night whilst Sammy Davis Jr. was performing he was joined on stage by Frank Sinatra; the following night Frank Sinatra was joined by Dean Martin; the audience’s reaction to these performances was extremely positive. FM’s evidence states that they would: “croon, quip, one-up each other and roll out booze filled jokes”, adding that the Sands Hotel and Casino became “the coolest nightspot in the world”. In relation to its services FM’s evidence goes on to say:

“With this recreation of one of those evenings at the famous Copa Room, you’ll be transported back to a chic era of glamour, indulgence, excess and all that was good, and bad, about the Rat Pack.

Not only were Frank, Sammy & Dean cool in their day, they’re still cool now. Their influence is currently all over the UK charts and still in the cinema. “Ocean’s Eleven” was re-made in 2001, but probably without as much fun on the set as the original cast members had.”

The objections based upon sections 3(1)(a) & 3(1)(d) of the Act

The Law – section 3(1)(a) of the Act

43. In *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* Case C-299/99 the Court of Justice of the European Union (CJEU) stated:

“36. It is true that Article 3(1)(a) of the Directive provides that signs which cannot constitute a trade mark are to be refused registration or if registered are liable to be declared invalid.

37. However, it is clear from the wording of Article 3(1)(a) and the structure of the Directive that that provision is intended essentially to exclude from registration signs which are not generally capable of being a trade mark and thus cannot be represented graphically and/or are not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

38. Accordingly, Article 3(1)(a) of the Directive, like the rule laid down by Article 3(1)(b), (c) and (d), precludes the registration of signs or indications which do not meet one of the two conditions imposed by Article 2 of the Directive, that is to say, the condition requiring such signs to be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

39. It follows that there is no class of marks having a distinctive character by their nature or by the use made of them which is not capable of distinguishing goods or services within the meaning of Article 2 of the Directive.

40. In the light of those considerations, the answer to the first question must be that there is no category of marks which is not excluded from registration by Article 3(1)(b), (c) and (d) and Article 3(3) of the Directive which is none the less excluded from registration by Article 3(1)(a) thereof on the ground that such marks are incapable of distinguishing the goods of the proprietor of the mark from those of other undertakings.”

44. In response to the objections based upon section 3(1)(a) FM says:

“It is submitted that the trade mark THE RAT PACK is eminently registrable and fulfils the requirements of section 1(1) of [the Act], because it is a sign that can be graphically represented. [Mr Gittins] submits that the trade mark THE RAT PACK does not distinguish the services of [FM] from other undertakings. It is submitted that this is not the case, because evidence of acquired distinctiveness has been filed and has been accepted by the Trade Marks Registry. Furthermore, additional evidence has been provided earlier in the oppositions, which evidence provides further basis for the acquired distinctiveness beyond that originally assessed by the Hearing Officer who allowed the mark THE RAT PACK to proceed to registration.”

45. In his submissions Mr Gittins says:

“in particular an internet search...shows that the term “The Rat Pack” is widely used by tribute artists in the entertainment industry. It is not unique to [FM] and does not distinguish [FM] from other tribute artists. Indeed [FM] is itself a tribute to a particular group of entertainers who performed in the United States of America in the 1960s.”

The Law – section 3(1)(d) of the Act

46. In *Telefon & Buch Verlagsgesellschaft mbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-322/03* the General Court (GC) stated:

“49 Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50 With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51 Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).”

47. To fall foul of section 3(1)(d) of the Act the words THE RAT PACK must have become customary in the current language or in the bona fide and established practices of the trade to designate the services for which FM's trade mark stands registered. In *Stash Limited v Samurai Sportswear Ltd* (BL O/281/04) Professor Annand, sitting as the Appointed Person, stated:

“33. In the event, I do not believe this issue of the interpretation of section 3(1)(d) is central to the outcome of the appeal. “Customary” is defined in the Oxford English Reference Dictionary, 1995 as: “usual; in accordance with custom”. In my judgment, the Opponent has failed on the evidence to prove that at the relevant date STASH contravened section 3(1)(d) as consisting exclusively of signs or indications which have become customary either in the current language or in trade practices for the goods concerned.”

48. In support of these grounds Mr Gittins provided exhibits 1 and 2 to his witness statement. He says:

“The large number of tribute artists using the sign “The Rat Pack” demonstrates that the sign has become customary in the current language or in the bona fide and established businesses in the industry.”

49. In response to the evidence filed by Mr Gittins FM says:

“[Mr Gittins] refers to evidence in exhibit 1...as showing that the mark THE RAT PACK originated some time ago and is still marketed by Warner Bros. Although the exact legal point being made is unclear in the context used, it is submitted that exhibit 1 merely shows copies of front covers of CDs to which THE RAT PACK has been applied. These goods are of course different to those of the registration of THE RAT PACK which is registered for entertainment services. Furthermore, no detail is given as to the relevant sales of any goods shown in exhibit 1 or where those goods were sold if they were sold. It is not clear if those goods were made available in the UK.

Exhibit 2 is also of no assistance in relation to [Mr Gittins'] contention of the invalidity of the registration of THE RAT PACK. The reason for this is that no information is given in the results of the internet search concerning use in the UK of the mark THE RAT PACK for relevant goods or services. Instead, some information is simply provided in terms of a Google search which refers to use of

THE RAT PACK. Indeed, some of the hits are uses by [FM]. Thus, there is insufficient detail in exhibit 2 to provide any basis for a lack of validity of the registration of THE RAT PACK.

And:

“there are many different types of use of THE RAT PACK in that evidence [exhibit 2] showing that there is no particular type of use or form of use that is customary.”

50. As to the first arm of section 3(1)(a) of the Act, FM's trade mark is clearly graphically represented. Insofar as the second arm of the test i.e. is it a trade mark capable of distinguishing the services of one undertaking from those of other undertakings and the objection based upon section 3(1)(d) of the Act i.e. is it a trade mark which has become customary in the current language or in the bona fide and established practices of the trade are concerned, the evidence provided by Mr Gittins suffers from a number of defects. The first page of exhibit 1 (the photographs of CD covers) is undated and there is no indication from which jurisdiction these CDs originate. Pages 2 and 3 of the same exhibit which consists of a Google® search for the phrase “the rat pack w arner bros” is also undated and none of the retrievals provided have been expanded. Although the 1st and 8th retrievals refer to 2009 and 1960 respectively, and although the 2nd retrieval refers to “shopping.lycos.co.uk”, the date and origin of the other retrievals is either uncertain or contains a reference which clearly indicates that it relates to a jurisdiction other than the United Kingdom e.g. retrieval 6 refers to www.voxy.co.nz and the price quoted is shown in what I assume is New Zealand dollars.

51. As for exhibit 2, the Google® search provided was conducted on 17 June 2010 i.e. after the material date in these proceedings and once again none of the retrievals provided has been expanded. Although the origin of a number of the retrievals is uncertain, many clearly relate to the United Kingdom (with some appearing to relate to the parties to these proceedings). However, in the absence of evidence as to when the undertakings in the United Kingdom began using the words THE RAT PACK, it is not possible for me to conclude that at the material date in these proceedings the words THE RAT PACK were not capable of distinguishing the services of one undertaking from those of other undertakings or that they had become customary in the current language or in the bona fide and established practices of the trade; **as a consequence, the objections based upon sections 3(1)(a) and 3(1)(d) of the Act must be dismissed.**

The objection based upon section 3(1)(c) of the Act

The Law

52. In *BioID AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-37/03 P the CJEU stated that for a term to be viewed as being descriptive of a characteristic of goods:

“there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see Case T-19/04 *Metso Paper Automation v OHIM(PAPERLAB)* [2005] ECR II-2383, paragraph 25 and the case-law cited).”

53. In *JanSport Apparel Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-80/07 the GC gave a helpful summary of the considerations to be taken into account in relation to article 7(1)(c) of the regulation, the equivalent of section 3(1)(c) of the Act:

“18 Under Article 7(1)(c) of Regulation No 40/94, ‘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 or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’ are not to be registered. In addition, Article 7(2) of Regulation No 40/94 (now Article 7(2) of Regulation No 207/2009) states that, ‘paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community’.

19 By prohibiting the registration of such signs, that article pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (Case C-191/01 P *OHIM v Wrigley* [2003] ECR I-12447, paragraph 31).

20 Furthermore, the signs covered by Article 7(1)(c) of Regulation No 40/94 are signs regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services, thus enabling the consumer who acquired the product or service to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (Case T-219/00 *Ellos v OHIM (ELLOS)* [2002] ECR II-753, paragraph 28, and Case T-348/02 *Quick v OHIM (Quick)* [2003] ECR II-5071, paragraph 28).

21 The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are thus only those which may serve in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought (see the judgment of 9 July 2008 in Case T-323/05 *Coffee Store v OHIM (THE COFFEE STORE)*, not published in the ECR, paragraph 31 and the case-law cited). Accordingly, a sign’s descriptiveness can only be assessed by

reference to the goods or services concerned and to the way in which it is understood by the relevant public (Case T-322/03 *Telefon & Buch v OHIM–Herald Business Data (WEISSE SEITEN)* [2006] ECR II-835, paragraph 90).

22 It follows that, for a sign to be caught by the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see Case T-19/04 *Metso Paper Automation v OHIM(PAPERLAB)* [2005] ECR II-2383, paragraph 25 and the case-law cited).

54. In *Score Draw Limited v Alan James Patrick Finch* [2007] ETMR 54 Mann J stated:

“39. The words "other characteristics of goods or services" are obviously more general than the more specific words which precede it. They demonstrate that the preceding words are not the only way in which the provisions of the subsection can be fulfilled. It is therefore open to Score Draw to seek to demonstrate that the badge operates so as to be descriptive of some characteristic of goods other than those enumerated in the section. It seeks to do so by saying that the badge identifies the Brazilian football team nature of the goods to which it is applied. Mr Reed found it hard to articulate the precise characteristic involved, but it was of that general nature. By way of a parallel, Mr Reed relied on Linkin Park LLC's Application, Case O-035-05 [2006] ETMR 74.

40 In that case the appointed person (Mr Richard Arnold QC) had to consider whether the name of a pop group (Linkin Park) was descriptive under head (c) when applied to posters and books. He held that the term "other characteristics" did not have to be construed ejusdem generis with the other characteristics referred to, and in paragraph 44 said:

"I see no reason why subject matter should not qualify [as a characteristic]."

He said that in order to deal with a submission that subject matter should indeed not qualify. He was implicitly accepting the suggestion that the expression "Linkin Park" in its context did indeed amount to a description of subject matter. He observed in paragraph 42:

"By the application date the Mark was no longer meaningless, but on the contrary had acquired a well-established meaning of denoting the Group."

41. I find this analysis, and the parallel with the present case, helpful. The mark in this case is not a mark which, in its actual terms, describes subject matter in the same way as the words "Linkin Park" would have described subject matter in the Linkin Park case by making those very words descriptive of the

characteristics of the goods. However, the effect of the badge, in the eyes of the relevant public is very similar. The CBD badge would, on the evidence, be recognised by them as denoting the clothing as Brazilian team clothing because the badge had been part of that clothing for many years, had in particular been part of the clothing of more modern successful teams, and since the mid-90's had been sold as a necessary and integral part of replica kit. It does not say "Brazilian National Club" in terms, but it would mean that to the relevant public even if (as seems likely) they do not know the Portuguese words for which the initials stand. I consider that in the circumstances the badge is descriptive of a characteristic of the clothing which bears it in the sense that it connotes that the clothing is, or has an association with, the historic Brazilian national team." 40 of 55

55. I also note that in *Linkin Park LLC's Application* [2006] ETMR 74, Mr Richard Arnold QC acting as the appointed person said, inter alia, in relation to section 3(1)(c) of the Act:

"49. The applicant's attorney argued that it was not necessary for someone wishing to trade in posters depicting the Group to use the Mark, as the hearing officer held. In my view it would be for difficult if not impossible for a trader to market such posters without using the Mark. How else, for example, would he describe the posters to wholesalers and retailers? Even so far as consumers are concerned, I do not believe that the members of the Group are as recognisable as, say, David Beckham—which, if it were the case, might permit posters to be sold to consumers by image alone. Even assuming that it would be possible for a trader to market posters without using the Mark, however, it is clear from cases such as *POSTKANTOOR* that this would not prevent the application of s.3(1)(c). The correct test is whether the mark sought to be registered is capable of being used descriptively.

56. In relation to section 3(1)(c) FM says:

"However, we again submit that the evidence put forward in relation to acquired distinctiveness helps to show that the mark is not descriptive of the goods (sic) concerned. No coherent description can be gleaned from the evidence [of Mr Gittins], because no particular use in terms of descriptiveness comes out of the evidence...Indeed, as mentioned at the original hearing for *THE RAT PACK* the make up of "the Rat Pack" is unclear because it can variously include Humphrey Bogart... or Frank Sinatra (more common). Thus, it cannot be said to be a description, because the people it is said to describe are not defined."

57. In relation to the submission above Mr Gittins says:

"This is at variance with the evidence filed by [FM] to support its argument of acquired distinctiveness showing plentiful photographic images as well as the names of Frank Sinatra, Sammy Davis Jnr. and Dean Martin... On the balance of

probabilities, there is little doubt who the original Rat Pack were or are perceived to be.”

58. The case law indicates that to fall foul of section 3(1)(c) of the Act there must be a “sufficiently direct and specific relationship” between the trade mark [THE RAT PACK] and [entertainment services in the form of a musical theatre production] “to enable the public concerned immediately to perceive, without further thought, a description of the services in question or one of their characteristics”. In *Linkin Park*, the Appointed Person commented that the correct test is whether the trade mark sought to be registered is capable of being used descriptively. Having explained the genesis of the phrase THE RAT PACK, FM’s own evidence indicates that although the words THE RAT PACK may have originally referred to Humphrey Bogart, Frank Sinatra and “a collection of friends”, following their performances at the Sands Hotel and Casino in Las Vegas in 1960, the phrase THE RAT PACK became inextricably linked to three performers, namely: Frank Sinatra, Dean Martin and Sammy Davis Jnr. Were this is any doubt, one need look no further than the various advertisements, brochures and reviews provided by FM. In short, I have no hesitation in concluding that at the material date in these proceedings the public concerned i.e. the public at large, would have been aware of the phrase THE RAT PACK, would have understood the phrase to refer to the three performers named above and that as a consequence the words THE RAT PACK would have constituted a sign which was capable of being used descriptively i.e. to designate the content of a musical theatre production based upon the music, style, performances etc. of Frank Sinatra, Dean Martin and Sammy Davis Jnr. in any combination. **As a consequence of those conclusions, the phrase THE RAT PACK was, at the material date in these proceedings and absent use, open to objection under section 3(1)(c) of the Act.**

The objection based upon section 3(1)(b) of the Act

The Law

59. In *KPN Nederland NV v Benelux Merkenbureau* the CJEU stated:

“86. In particular, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive. A mark may none the less be devoid of any distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.”

60. In relation to section 3(1)(b) FM says:

“We refer to the evidence of acquired distinctiveness filed in relation to the application to register THE RAT PACK...That evidence was accepted by the Trade Marks Registry as showing the mark has acquired distinctiveness by virtue of extensive use.”

61. As I have already concluded that at the material date and absent use FM's trade mark fell foul of section 3(1)(c) of the Act, it follows that it also falls foul of section 3(1)(b) of the Act.

Acquired distinctiveness

62. However, that is not an end of the matter as FM argues that the trade mark THE RAT PACK has acquired distinctiveness through the use it has made of it (this would apply to the position at both the application stage ((under the proviso to section 3(1)) and to the position following registration (under the proviso to section 47(1) of the Act)). In *Premier Luggage and Bags Ltd v. Premier Co (UK) Ltd & Another* [2002] ETMR 69 Chadwick LJ stated:

“51 The relevant question, therefore, is whether the trade mark had acquired a distinctive character through use in connection with products supplied by Premier Luggage either by the date of application, or (if not) by the date of the trial. The judge did not differentiate between those dates - because, as he said at paragraph 21 of his judgment:

"Although the proviso [to section 3(1) of the Act] refers to the mark acquiring distinctiveness prior to the date of the application for registration, section 47 of the 1994 Act provides that, if it is sought to obtain a declaration of invalidity where a mark has already been registered, it is sufficient if a distinctive character has been acquired since registration."

52 There is, I think, a danger in that approach, because it fails to recognise where the burden of proof lies in the two cases. The position was explained by Jacob J. in the *British Sugar* case, at page 302 (lines 7-12). After pointing out that section 72 of the Act provided that registration of a person as proprietor was prima facie evidence of the validity of the original registration, Jacob J. went on to say this:

"This clearly casts the onus on he who wishes to attack the validity of the original registration. But once the attacker can show the registration was wrongly made (particularly for non-compliance with section 3(1)(b)-(d)) and the proprietor wishes to rely on the proviso to section 47(1) it is for the proprietor to show that is [sic] mark is distinctive."

63. In *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* Joined Cases C-108/97 and C-109/97 the CJEU stated:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread

and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

64. In *Rautaruukki Oyj v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-269/06 the GC stated:

“43 Article 7(3) of Regulation No 40/94 provides that the absolute grounds for refusal do not preclude the registration of a trade mark if it has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it. In the circumstances referred to in Article 7(3) of Regulation No 40/94, the fact that the sign which constitutes the mark in question is actually perceived by the relevant section of the public as an indication of the commercial origin of a product or service is the result of the economic effort made by the trade mark applicant. That fact justifies putting aside the public-interest considerations underlying Article 7(1)(b) to (d), which require that the marks referred to in those provisions may be freely used by all in order to avoid conceding an unjustified competitive advantage to a single trader (*Shape of a bottle of beer*, paragraph 21 above, at paragraph 41, and *Shape of a sweet*, paragraph 21 above, at paragraph 55).

44 First, it is clear from the case-law that the acquisition of distinctiveness through use of a mark requires that at least a significant proportion of the relevant section of the public identifies the products or services as originating from a particular undertaking because of the mark. However, the circumstances in which the condition as to the acquisition of distinctiveness through use may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data, such as specific percentages (see *Shape of a sweet*, paragraph 21 above, paragraph 56, and case-law cited).....

46 Third, in assessing, in a particular case, whether a mark has become distinctive through use, account must be taken of factors such as, inter alia: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the significance of the investments by the undertaking to promote it; the proportion of the relevant class of persons who, because of the mark, identify the goods as originating from a particular

undertaking and statements from chambers of commerce and industry or other trade and professional associations. If, on the basis of those factors, the relevant class of persons, or at least a significant proportion thereof, identifies the goods as originating from a particular undertaking because of the trade mark, it must be concluded that the requirement for registering the mark laid down in Article 7(3) of Regulation No 40/94 is satisfied (see *Shape of a sweet*, paragraph 21 above, at paragraph 58, and case-law cited).”

65. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 Jacob J stated:

“With that in mind I must deal with the evidence – for all depends upon the conclusions to be drawn from that. I begin with the original registration. As I have said I do not have to consider whether the mark was rightly registered under the 1938 Act. By virtue of section 105 of the 1994 Act and Schedule 3 paragraph 18(2) it is section 47 of the 1994 Act which sets out the grounds upon which a mark registered under the old Act can be attacked. I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that “use equals distinctiveness”. The illogicality can be seen from an example: no matter how much use a manufacturer made of the word “Soap” as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark. Again, a manufacturer may coin a new word for a new product and be able to show massive use by him and him alone of that word for the product. Nonetheless the word is apt to be the name of the product, not a trade mark. Examples from old well-known cases of this sort of thing abound. The Shredded Wheat saga is a good example: the Canadian case is *The Canadian Shredded Wheat Co. Ltd. v. Kellogg Co. of Canada Ltd.* in the Privy Council and the United Kingdom case *The Shredded Wheat Co. Ltd. v. Kellogg Co. of Great Britain Ltd.* in the House of Lords. In the former case Lord Russell said:

“A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else.”

It is precisely because a common laudatory word is naturally capable of application to the goods of any trader that one must be careful before concluding that merely its use, however substantial, has displaced its common meaning and has come to denote the mark of a particular trader. This is all the more so when the mark has been used in conjunction with what is obviously taken as a trade mark.

I do not consider that the evidence filed to support the registration was anywhere near enough to support the conclusion that when the mark was registered, it was

distinctive. Yes it had been used for about 5 years in conjunction with Silver Spoon, but it was not proved that the public regarded it as a trade mark - a reliable badge of trade origin - on its own. Further the use was only for what was essentially an ice cream topping. It did not cover the full range of goods covered by the registration.

What then of the position now? British Sugar rely upon more extensive evidence. First there is a great deal more use of exactly the same type as went on before. Sales figures went on going up - to nearly £3m p.a. Since introduction in 1986 sales over the 10 year period total about £13m. of which over half have taken place since registration in September 1992. The product has just over 50% of the ice cream topping market sector. Next British Sugar rely upon evidence from Mrs. Nash MBE. She was in public relations at British Sugar. She took telephone inquiries and dealt with letters from the general public. People sometimes complained when a flavour disappeared (blackcurrant did) or wanted information on availability (for instance when the toffee flavour came out, magazines, mainly at British Sugar's instigation, published recipes for making banoffi pie, a dessert made from bananas, toffee and ice cream). She said that customers often referred simply to "your "Treat" range". But of course all the customers concerned, whether writing or telephoning, knew they were dealing with Silver Spoon the manufacturers. I do not think Mrs. Nash's evidence establishes that the general public perceive the word "Treat" to be a badge of trade origin in itself. I think her evidence does show recognition of the word amongst British Sugar customers, but recognition does not necessarily mean recognition as a trade mark."

66. FM's evidence consists of the witness statements of Mr Nicol (filed to support the now registration at the application stage) and Mr Walden filed to: "complete the picture from 2007 to 2009." When considered as a totality the evidence indicates that FM first began using the phrase THE RAT PACK in September 1999, and that in the period 2000/2001 to 2008/2009 turnover amounted to some £35m. The evidence also demonstrates that FM spent some £3.6m promoting its services in a wide range of both local and national publications, in brochures and on posters, theatre signage etc. and that FM's musical theatre production was reviewed on both a local and national basis. In his submissions Mr Gittins says:

"The evidence of acquired distinctiveness filed by [FM] confirm the use of the sign "The Rat Pack Live from Las Vegas"... "The Rat Pack" alone however is not distinctive and therefore should not be capable of being registered."

67. Put simply, I agree with Mr Gittins conclusions. While FM have undeniably made use of a sign which incorporates the phrase THE RAT PACK, as my summary of the evidence filed by FM in these proceedings shows, when used by FM to identify its musical theatre production (and indeed by the vast majority of those reviewing FM's production) the sign used is THE RAT PACK LIVE FROM LAS VEGAS and not the phrase THE RAT PACK alone. That is not surprising, given that in its own evidence FM

uses the phrase THE RAT PACK descriptively to refer to the content of the musical theatre production they have been providing.

68. In short, FM's own evidence demonstrates that the phrase THE RAT PACK was, on a prima facie basis, open to objection under sections 3(1)(b) and (c) of the Act. In the *British Sugar* case mentioned above Jacob J said, inter alia:

"I have already described the evidence used to support the original registration. It was really no more than evidence of use. Now it is all too easy to be beguiled by such evidence. There is an unspoken and illogical assumption that "use equals distinctiveness". The illogicality can be seen from an example: no matter how much use a manufacturer made of the word "Soap" as a purported trade mark for soap the word would not be distinctive of his goods. He could use fancy lettering as much as he liked, whatever he did would not turn the word into a trade mark..."

69. Given the trade mark that has been used by FM (and others) to identify its musical theatre production i.e. THE RAT PACK LIVE FROM LAS VEGAS, the evidence of use provided by FM at both the application stage and in these invalidation proceedings is, in my view, clearly insufficient to justify the conclusion that the phrase THE RAT PACK alone has, as a result of FM's use, acquired a distinctive character.

70. As a consequence, Mr Gittins' request to invalidate FM's trade mark THE RAT PACK has succeeded under sections 3(1)(b) and (c) of the Act, and under the provisions of 47(6) of the Act the registration shall be deemed never to have been made.

The opposition proceedings – No. 99346

71. FM's opposition is based upon section 5(2)(b) of the Act which reads as follows:

"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."

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.”

72. In these proceedings FM initially relied upon the trade marks shown in paragraph 2 above, all of which constituted earlier trade marks under the above provisions. Given the interplay between the date on which Mr Gittins’ application was published and the date on which FM’s earlier trade marks completed their registration procedure, FM’s earlier trade marks Nos. 2342294 and 2340120 are, in principle, subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004. However, by answering “No” to question 5 on the form TM8 Mr Gittins has not asked FM to provide proof of use.

Section 5(2)(b) – case law

73. The leading authorities which guide me are from the CJEU (Court of Justice of the European Union): *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, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(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; *Sabel BV v Puma AG*,

(e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) 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; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) 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; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

The average consumer and the nature of the selection process

74. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which these services are likely to be selected by the average consumer in the course of trade. The services at issue in these proceedings are all entertainment services, the average consumer for which would be a member of the general public. As the evidence provided indicates that trade marks promoting the services will appear in a

wide range of publications (both in hard copy and on-line), and will appear on, inter alia, posters and on signage at venues, it suggests that the selection of the services will be primarily a visual one. As to the nature of the selection process, in my experience the cost of attending an entertainment event is likely to vary depending on the nature of those performing and where and when the event will be held e.g. will it be held in a large stadium, a theatre in the West End of London, a regional theatre, a pub or club or at a wedding, birthday or corporate event. The need for the average consumer to satisfy themselves that not only the content of the event is to their liking, but also the timing, cost etc. of the event is acceptable to them, suggests they will pay a least a reasonable level of attention when selecting such services.

Comparison of services


75. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 the GC said:

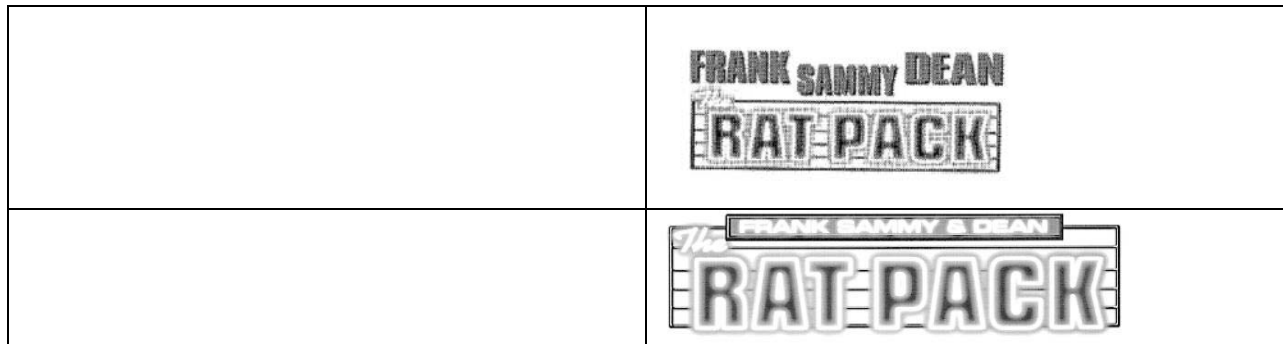
“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

76. As Mr Gittins’ specification in class 41 for “live music entertainment” would include “entertainment services in the form of a music theatre production” in class 41 or would be encompassed by the phrase “entertainment shows” in class 41, the competing services are identical.

Comparison of trade marks

77. The trade marks to be compared are:

Mr Gittins' trade mark	FM's trade marks
	<p>THE RAT PACK</p> <p>(*included here for the sake of completeness but found above to be invalid).</p>



78. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive & Dominant Components

79. Mr Gittins' trade mark consists of three elements i.e. the silhouettes of what appears to be the upper bodies of three men, the conjoined words BritRatPack (the majority of the letters of which appear in various combinations of red, white and blue) set against a black background and the words "The British Rat Pack". As FM's trade marks are not limited to colour, it is necessary, in line with the guidance provided in *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2011] FSR 1, for me to keep in mind that the competing trade marks could be presented in the same colours.

80. In its written submission FM said:

"The dominant visual element of [Mr Gittins'] mark is The British Rat Pack. The remaining elements in the mark include a non-distinctive group of three silhouettes and a graphical element based on the word BritRatPack. However, the latter graphical element is difficult to read in comparison to the words The British Rat Pack. The graphical element BritRatPack only serves to reinforce the reference to The British Rat Pack and adds little in the way of any distinctive matter to allow differentiation between the words THE RAT PACK and the mark applied for. Consequently, the overriding impression gained by an addressee of the mark would be that the mark relates to the words The British Rat Pack.

Similarly, the words THE RAT PACK are dominant elements of [FM's] other two registrations, leading to the conclusion that there is a strong conceptual and aural similarity between the latter two registrations and [Mr Gittins'] mark."

81. In light of the evidence filed by both parties, I think it is reasonable to assume that the three silhouettes are intended as an indirect reference to the three performers who made up the Rat Pack. As to the conjoined words BritRatPack, I agree with FM that when considered in the context of the trade mark as a whole (particularly given the well established practice of shortening the word British to “Brit” (of which I take judicial notice)) they will be seen as a shortened version of the words which appear beneath them i.e. “The British Rat Pack”. The background upon which the conjoined words are presented is likely, in my view, to go unnoticed by the average consumer and the colours in which the word BritRatPack is presented must (given my comments in para. 79 above) also be kept in mind.

82. The device element present in Mr Gittins’ trade mark is, in my view, a distinctive but not dominant element of the trade mark. Whilst the conjoined words BritRatPack and the words “The British Rat Pack” are, by virtue of their size and positioning, the dominant elements of Mr Gittins’ trade mark, they are not, in view of the conclusions I reached above regarding the descriptive nature of the phrase THE RAT PACK, distinctive elements, as, in my view, the average consumer is likely to see them as simply describing live musical entertainment based upon the music, style, performances etc. of the Rat Pack and which have a British origin. In summary, the distinctiveness of Mr Gittins’ trade mark lies, in my view, in the device element appearing in the trade mark combined with the manner in which the other elements present in the trade mark are configured.

83. Turning to FM’s trade marks I have already concluded above that trade mark No. 2391940 consisting solely of the words THE RAT PACK should be declared invalid under sections 3(1)(b) and (c) of the Act. It flows from that conclusion that whilst the words The RAT PACK appearing in registration Nos. 2342294 and 2340120 may be dominant elements of those trade marks (particularly the words RAT PACK) they cannot be distinctive elements. Insofar as the elements which remain are concerned the background upon which the words The RAT PACK appear would, in my view, go unnoticed by the average consumer, whilst the words Frank, Sammy and Dean (which in my view are less dominant than the words RAT PACK) would, given the evidence filed by FM, be seen by the average consumer as references to Frank Sinatra, Sammy Davis Jnr. and Dean Martin and as such would not be distinctive elements. In conclusion, any distinctiveness present in FM’s trade marks can only lie in the totalities.

Visual similarity

84. The only similarity between FM’s trade marks which remain valid and Mr Gittins’ trade mark are the words “The” and “Rat Pack”. The fact that both parties’ trade marks contain these words as dominant elements, results, in my view, in a fairly high degree of visual similarity between them.

Aural similarity

85. In my view, Mr Gittins' trade mark would (most likely) be referred to as either The British Rat Pack or (less likely) BritRatPack, whereas FM's trade marks are most likely, to be referred to as The Rat Pack (I see no reason why the average consumer would attempt to describe the device element present in Mr Gittins' trade mark and I very much doubt that the average consumer would articulate the names of the three performers present in the trade marks when referring to FM's trade marks). The fact that both trade marks would be referred to in the manner I have suggested, results, in my view, in a high degree of aural similarity between them.

Conceptual similarity

86. As the totalities of both parties' trade marks focus on the words The Rat Pack, the meaning of which would be well known to the average consumer, the concepts the competing trade marks will create in the mind of the average consumer would be highly similar differing only to the extent that Mr Gittins' trade mark contains a reference to Brit and British.

Distinctive character of FM's earlier trade marks

87. I must now assess the distinctive character of FM's remaining earlier trade marks. The distinctive character of a trade mark must be appraised first by reference to the services in respect of which it has been registered and, second, 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 trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the 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 Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

88. FM's earlier trade marks have both achieved registration and their validity has not been challenged. In those circumstances they must be considered to possess at least some distinctive character – the comments of Mr Justice Arnold in *Samuel Smith Old Brewery Tadcaster v Philip Lee (trading as Cropton Brewery)* - [2011] EWHC 1879 (Ch) refer. However, as far as I can tell (and there are no submissions from FM to the contrary) as there has been no use of these trade marks in the form in which they stand registered and as all of the word elements present in the trade marks refer to the Rat Pack or its members, the distinctiveness of the trade marks can, in my view, only lie in the way in which these otherwise descriptive/non-distinctive elements are configured and as a consequence FM's trade marks are, in my view, possessed of an extremely low degree of inherent distinctive character.

Likelihood of confusion

89. In determining whether there is a likelihood of confusion, I need to bear a number of factors in mind. The first is the interdependency principle i.e. 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. It is also necessary for me to keep in mind the distinctive character of FM's earlier trade marks (as the more distinctive these trade marks are, the greater the likelihood of confusion), 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 upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that the average consumer was the public at large who would select the services by primarily visual means, that the competing services were identical and that the competing trade marks shared a fairly high degree of visual similarity and were aurally and conceptually highly similar but that FM's earlier remaining trade marks were possessed of only an extremely low degree of inherent distinctive character.

90. In *L'Oréal v OHIM* – case C-235/05 P the CJEU said:

“42. It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.

43. It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

44. In the second place, as was pointed out at paragraphs 35 and 36 of this judgment, the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case.

45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier

mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

91. I must now apply the guidance in *L'Oréal v OHIM* to my earlier conclusions regarding the descriptive/non-distinctive nature of the phrase The Rat Pack. In doing so, I have no doubt that the average consumer would be familiar with the practice of tribute artists using descriptive/non-distinctive wording such as The Rat Pack to indicate the content rather than the origin of the entertainment service being provided. That being the case, I can see no reason why the average consumer would assume that the presence of the descriptive/non-distinctive phrase The Rat Pack in otherwise distinctive trade marks indicated that the entertainment services provided under the competing trade marks originated from the same or economically linked undertakings. **As a consequence of the above, FM's opposition based upon section 5(2)(b) of the Act is dismissed.**

Costs

92. Mr Gittins has been successful and is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide but bearing in mind that the proceedings were consolidated and that for a significant part of the proceedings Mr Gittins was unrepresented, I award costs to Mr Gittins on the following basis:

Preparing statements and considering FM's statements:	£300
Preparing evidence and commenting on FM's evidence:	£400
Written submissions:	£300
Official fee (Invalidation No. 83926):	£200
Total	£1200

93. I order Flying Music Company Limited to pay to Paul Hayden Gittins the sum of **£1200**. This sum is 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 13th day of December 2011

**C J BOWEN
For the Registrar
The Comptroller-General**