

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2142905
BY BERYL SCOTT SMITH, CHAIR OF TRUSTEES
THE GATEHOUSE THEATRE**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 48359
BY OVATION THEATRES LIMITED**

TRADE MARKS ACT 1994

IN THE MATTER OF Application No 2142905

by Beryl Scott Smith, Chair of Trustees

5 **The Gatehouse Theatre**

and

IN THE MATTER OF Opposition thereto under

10 **No 48359 by Ovation Theatres Limited**

BACKGROUND

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On 22 August 1997 Beryl Scott Smith, Chair of Trustees, The Gatehouse Theatre applied under the Trade Marks Act 1994 to register various trade marks as a series. Following deletions, the application showed that it was for the trade mark THE GATEHOUSE THEATRE and GATEHOUSE THEATRE as a series of two marks for a specification which reads:

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Class 41

Theatre entertainment services.

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The application is numbered 2142905.

The application was accepted and published and on 2 April 1998 Ovation Theatres Limited filed Notice of Opposition to the application. The grounds of opposition as set out in the accompanying statement of case are, in summary:

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(1) that the applicants by registering the name THE GATEHOUSE THEATRE, will cause irreversible damage to the opponents' business;

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(2) that the opponents own a theatre situated at the Gatehouse Public House, whilst the applicants are a group who perform at various locations in and around North London. The opponents do not wish to change the name of the public house and know of no other word to describe an auditorium that stages drama, plays and musicals other than the word theatre;

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(3) that the application for the trade mark in suit was not made until August 1997 two months after the opponents had registered the name 'THE GATEHOUSE THEATRE' with Camden Council;

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(4) that use of 'THE GATEHOUSE THEATRE' is misleading to members of the public as use of this phrase would lead them to expect to see a drama in a building called THE GATEHOUSE THEATRE.

The applicants filed a counterstatement denying the grounds of opposition and they seek an award of costs. The matter came to be heard on 22 June 2000 when the applicants were represented by Mr Symonds of Brookes & Martin and the opponents by Mr Plews their Company Secretary.

5 Prior to the hearing the Trade Marks Registry wrote to the opponents on 22 May 2000, asking them to clarify the basis of their objections. The opponents, in a letter dated 30 May 2000, indicated that Sections 3(3)(b) and 5(4)(a) of the Trade Marks Act 1994 were relevant but that these objections should not be taken in isolation but alongside the other reasons for objection and evidence presented to The Patent Office during these proceedings.

10 The Evidence

15 Both sides filed evidence in the proceedings, the opponents' evidence consists of two statutory declarations dated 16 August 1998 and 22 February 1999 by Mr John Plews, Company Secretary of Ovation Theatres Ltd, the opponents. The applicants' evidence consists of a single statutory declaration dated 25 November 1998 by Beryl Scott Smith. Ms Scott Smith states that she is the registered proprietor of the application in suit.

20 In so far as it is necessary, I will refer to the evidence filed by the parties only as part of my decision.

Decision

25 One of the grounds of opposition put forward by the opponents was under Section 5(4)(a) which reads:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

30 (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

35 (b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

40 At the hearing Mr Plews conceded that he could not make a claim to an earlier right. He was right to make that concession. The elements for an action for passing-off were set out by the Appointed Person, Mr Geoffrey Hobbs Q.C., in *Wild Child Trade Mark* [1998] RPC 455. The three elements which the opponents would have to satisfy me are in place can be summarised as:

- 45 (a) that, at the relevant date, that is 22 August 1997, the opponents had a goodwill or reputation in the market place and were known by some distinguishing feature;
- (b) that the applicants are likely to misrepresent their services as those of the opponents; and
- (c) that the opponents have or are likely to suffer damage.

5 All three elements must be present for the action to succeed. The evidence filed by the opponents shows that the earliest date on which they used the trade mark UPSTAIRS AT THE GATEHOUSE was in association with a production staged in January 1998. In his first statutory declaration, Mr Plews' states "Since December 12th 1997 a total of 6562 tickets have been issued....". At the hearing Mr Plews confirmed that the use by the opponents began in December 1997 in advertising the January 1998 production. Thus, the opponents fell at the first hurdle in that they could not claim to have a goodwill or reputation in the market place at the date the trade mark application was filed. Their ground of objection under section 5(4)(a) is not made out and I dismiss it accordingly.

10 I turn to consider the ground of objection under Section 3(3)(b) of the Trade Marks Act 1994. This reads:

15 "A trade mark shall not be registered if it is-

- (a)
- (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or services)."

20 This is an absolute ground of objection. For a trade mark to be refused registration under this head some characteristic of the trade mark must make it inherently deceptive. There is nothing to suggest that here. Mr Plews suggested that the term was geographical and referred to the Gatehouse public house in Highgate. Whilst I accept that there is a public house in Highgate called the Gatehouse, and there has been so for many years, that does not mean that the trade mark THE GATEHOUSE THEATRE would bring that building to mind for the vast majority of the relevant public. The relevant public in this case are the public at large of the United Kingdom. Objections under section 3(3)(b) are taken to place names indicating geographical origin only where the place has a reputation for the goods or services in question. The example given in the Trade Marks Registry Work Manual Chapter 6 page 99 is that of SOMERSET GOLD for cider. There is nothing in the evidence in this case to suggest that the Gatehouse public house had a reputation for theatre services before the opponents started productions there such that the application should be refused under this section.

35 Mr Plews also submitted that the applicants' title is "The Gatehouse Theatre Club". In support of his argument, Mr Plews' declaration of 16 August 1998 exhibits documents at JP2 & JP3 which show use of this term. Thus, he argued that they could not claim 30 years use of "The Gatehouse Theatre". However, whether the applicants have or have not used the trade mark is not necessarily a relevant factor when considering whether the trade mark can be accepted for registration. It is not a requirement of the Trade Marks Act 1994 that an applicant must have used the trade mark in question prior to their application. But, where a term may be held to be, for example, descriptive the use that the applicant has made of the trade mark may assist in showing that it has acquired a distinctive character. This is under the proviso to section 3(1) of the Trade Marks Act 1994. However, in my view, the trade mark THE GATEHOUSE THEATRE is acceptable for registration without the need for such evidence to show that it has become distinctive of the applicants' services.

45 The proviso to section 3(1) does not apply to subsection 3(3), but when considering whether a trade mark is of such a nature as to deceive the public, any use that the applicant has made of the

trade mark should be taken into account in determining the matter. Indeed the fact that an objection under this section can be overcome by evidence of use is recognised in the Trade Marks Registry Work Manual. In this case, the evidence submitted by the applicants, at exhibit BSS1, does, in my view, show that the applicants have used the trade mark THE GATEHOUSE THEATRE for many years. Advertisements for productions as early as 1969 and 1974 show use of this name.

Mr Plews referred to the use on the applicants' letterhead of the term "THE GATEHOUSE THEATRE N6" and submitted that the term N6, being the postcode for Highgate, suggested a connection with that area. That may be so but the term N6 is not a part of the trade mark shown on the application form and is not therefore part of the trade mark under consideration and I can take no account of it.

Finally Mr Plews argued that the use of the term 'theatre' within the trade mark was deceptive as the applicants did not own or occupy a building called the Gatehouse Theatre. I do not think that the term theatre is so narrow as to only apply to a building. Nor in my view does the trade mark GATEHOUSE THEATRE or THE GATEHOUSE THEATRE necessarily call to mind a building carrying that name. The applicants have for many years produced plays at a number of locations using their trade mark THE GATEHOUSE THEATRE alongside the name of the building in which that particular play is to be performed. The public, it seems to me, are accustomed to productions being staged by different theatre groups in various locations. Mr Plews states that there have been instances of confusion but I am given no evidence of this.

In summary, the opponents have not made out a case in support of their ground of objection under Section 3(3)(b) and therefore, this ground of objection fails.

Mr Plews asked me to exercise any discretion I had in his favour and in doing so asked me to take account of various other factors. The Trade Marks Act 1994 sets out circumstances in which the registrar shall refuse to allow an application for registration and within those provisions the Registrar or her Hearing Officers have to exercise their judgment. There is no general discretion outwith these provisions. If a trade mark does not fall foul of any of the provisions of the Act it must be allowed to go forward for registration. The Trade Marks Act 1994 does not allow me to take account of factors not provided for within the Act. For example, I cannot take any account of the commercial damage that the opponents may suffer if the application is allowed to proceed. I understand that Mr Plews' concern in that area arises from his belief that if this application is registered it might prevent the opponents from using the name of the Gatehouse public house where they are based, as part of their address. His concerns in that direction may be misplaced because under the provisions of Section 11 of the Act (section 11(2)) a registered trade mark is not infringed by the use by a person of their own name or *address* (my emphasis). Also, at the Hearing Beryl Scott Smith seemed to indicate that the applicants had no objection to a theatre in the building.

Mr Plews also sought to draw attention to the date on which the application was made and sought to imply that it was made because of his company's application for a theatre licence. There may be a number of reasons why an application is filed on a particular day. The date on which the applicants sought protection for their trade mark is not a factor which I can take into account.

5 It is unfortunate that this dispute between these two parties reached the point where a hearing became necessary. Mr Plews stated at the hearing that he had only opposed the applicants' trade mark application in order to defend himself but a negotiated and less costly settlement may have been preferable. Whilst I understand his motives for filing the opposition my decision can only be taken on the basis of the Trade Marks Act 1994, the associated rules and relevant judicial authorities. As can be seen from the above, I do not consider that there were any grounds of opposition which could be sustained against this application for registration and therefore dismiss the opposition accordingly.

10 As the applicants have been successful, they are entitled to a contribution towards their costs. I direct that the opponents pay the applicants the sum of £650-00. This sum to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

15 Dated this 1 day of September 2000

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M.KNIGHT
For the Registrar
the Comptroller-General.