

O-398-18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3181778
IN THE NAME OF ROOFTOP FILM CLUB LIMITED

AND

OPPOSITION THERETO UNDER NO. 408297
BY JAGUAR LAND ROVER LIMITED

Background

1. Application no 3181778 is for the trade mark EXPERIENCE. It has a filing date of 23 August 2016, stands in the name of Rooftop Film Club Limited (“the applicant”) and seeks registration for goods and services in classes 9, 16, 35, 38, 41, 42, 43 and 45 as shown in the Annex to this decision.

2. Following publication of the application on 18 November 2016, notice of opposition was filed by Jaguar Land Rover Limited (“the opponent”). The grounds of opposition, which are brought under the provisions of sections 3(1)(a), (b) and (c) of the Trade Marks Act 1994 (“the Act”) are directed to each of the goods and services for which registration is sought. The opponent puts its claims thus:

- “For the reasons given below, the trade mark EXPERIENCE is incapable of distinguishing the goods and services of the Applicant from those of other undertakings, Accordingly, the mark offends against the provisions of Section 3(1)(a).
- The trade mark EXPERIENCE lacks any capacity to distinguish the goods and services of the Applicant from those of other undertakings. This is because the mark is a generic term that is so widely used by third parties in relation to, for example, entertainment/event based products and services- these being the products and services that the relevant public would wish to experience/enjoy, or for whom such products and services will deliver a memorable experience-that the Applicant’s mark would be perceived by the relevant public as only providing general information on the nature of the goods and services concerned, or a characteristic of those goods and services. Accordingly, the Applicant’s mark cannot perform its essential function in denoting commercial origin and therefore offends against the provisions of Section 3(1)(b).
- The trade mark EXPERIENCE offends against the provision of Section 3(1)(c) because it describes characteristics of the Applicant’s goods and services. For example, the mark is descriptive of the Applicant’s ‘experiential marketing services’ in Class 35 and the nature or intended purpose of its entertainment/event based services in Class 41 -these being ‘experienced based’ services that the relevant public would wish to experience/enjoy, or for

whom such services will deliver a memorable experience. The relationship between the Applicant's mark and the goods and services covered by the application is sufficiently direct and specific to allow the relevant public to immediately perceive, without further reflection, a description of the Applicant's goods and services, or one of their characteristics."

3. The applicant filed a counterstatement denying the grounds of opposition. As it filed neither evidence nor written submissions in lieu of either evidence or attendance at a hearing, the counterstatement provides the only comments the applicant has made in these proceedings. I set them out below:

"4. The burden is entirely on the Opponent to substantiate its grounds of opposition.

5. The Application was accepted by the Registrar without objection on any of the aforementioned grounds.

6. The Applicant states as follows:

a. it denies that the trade mark is non-distinctive;

b. it denies that any consumer will consider the term EXPERIENCE as a generic or descriptive term incapable of distinguishing goods and/or services;

c. it notes that the Opponent appears to use specific examples of ways that the trade mark allegedly offends s3, but has opposed all goods and services claimed in the application, a position that appears to be inherently contradictory;

d. it asserts that the relevant consumer is not the same for all goods and services claimed in the application, and puts the Opponent to proof that each relevant category of relevant consumer will interpret the trade mark as alleged by the Opponent;

e. it asserts that the trade mark is sufficiently opaque and vague in nature so as not to provide any direct information about the relevant goods and/or services, and therefore is perfectly capable of functioning as a trade mark;

f. it asserts that the Opponent, in stating that a consumer consciously identified characteristics of products or services as being 'experience based' and that it would want to 'experience/enjoy' and that would be a 'memorable experience' and would as a direct result of this process understand the trade mark to be purely a generic term or descriptor, has contrived a mental or interpretive process that is unrealistic and impractical, has done so purely for the purposes of this opposition, and puts the Opponent to proof of the contrary;

g. it generally denies that the Application in whole or in part offends s3."

4. I pause at this point to record that, during the course of these proceedings, I held a Case Management Conference ("CMC") primarily to discuss the volume of evidence originally filed by the opponent. In relation to this, and following that CMC, I wrote to the parties giving directions as follows:

"At more than 900 pages, the evidence filed by the opponent grossly exceeds the standard limits set out in Tribunal Practice Notice 1/2015.

I acknowledge that these proceedings are based on objections under section 3(1) of the Act and further acknowledged the breadth of the goods and services opposed, however, I did not consider this merited such a large volume of evidence.

In particular, the evidence at exhibits DC34-DC56 of Mr Carter's witness statement is evidence originally filed by a third party in respect of proceedings which were determined some thirteen years before the relevant date at issue here.

It should review its evidence with a view to reducing its volume..."

5. The opponent subsequently filed a reduced volume of evidence which was admitted into the proceedings. This consists of two witness statements. In addition, it filed written submissions in lieu of a hearing, I give this decision after a careful review of all the material before me.

The law

6. The relevant provisions of section 3 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)...:

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.”

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

“1.-(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.”

8. The opponent’s first witness statement is that of Dale Carter, a Chartered trade mark attorney with Reddie & Grose LLP, the opponent’s professional representatives in these proceedings. Attached to his witness statement are some 33 exhibits. The second is by Justine Lynch, a trainee trade mark attorney at the same firm, along with 6 exhibits.

9. Mr Carter states the applicant “operates a business concerning the screening of films to its members. Such screening take place on roof tops of premises in various

locations, including several locations in the UK.” At DC4 he exhibits printouts from the applicant’s website which shows this. At page 26 these screenings are described as “The ultimate film experience”. Mr Carter points out that at page 27, purchasers are able to buy tickets to the screening electronically as gifts for others. Mr Carter states he obtained this material on 22 June 2017 which, I note, is after the relevant date in these proceedings. As can be seen from the Annex to this decision, the application is not limited to such services.

10. At DC1, Mr Carter exhibits a copy of an extract from oxforddictionaries.com defining the meaning of the word EXPERIENCE, which includes one that accords with comments of the Hearing Officer in a previous decision (BL O-202-03 exhibited at DC5) to which the opponent has referred me. Together, they show that the word is a standard one in the English language which has long been used in circumstances where the purchaser, whether for himself or another, is being offered the opportunity to participate in or undertake some form of an activity, particularly through the purchase of a redeemable voucher. Recognising the earlier decision referred to above as being of some age, at DC6 to DC10, Mr Carter exhibits printouts and other materials from a number of third party sources and dating from 2017 to reflect ongoing use of the word in relation to a very wide range of entertainment, cultural or other activities or events including those involving driving, food and drink, travel, sports, hotel stays, theatre shows, concerts, photoshoots, cinema and spa visits.

11. The vast majority of the exhibits attached to Mr Carter’s witness statement contain the results of various searches he carried out via the Google search engine each of which, he states, were “restricted in scope to the UK and in time up to 23 August 2016”. Each exhibit follows a similar format: one or more pages listing the first results brought back by the search, along with pages taken from some of the various third party websites identified in that search. The pages exhibited include various references to the word EXPERIENCE e.g. “..our Software and App Experience” (DC13, p124), “digital experiences” (DC13, p126), “Software experience” (DC14, p143), “Design the experiences and services...customers need (DC15, p153), “Realtime digital experiences” (DC15, p157), “mobile experiences” (DC15, p161), “a collection of mini-games, experiences and tech demos” (DC15, p169), “exciting multimedia experiences” (DC17, p188), “Projection Artworks creates

multimedia experience for BA” (DC17, p198), “inclusive digital student experience” (DC18, p213), “choosing your entertainment and information experience” (DC19, p217), “the ultimate Multi-Touch experience” (SC20, p224), a “user experience designer” (DC20, p234), “a new virtual fashion experience” (DC20, p236) and “interactive experiences” and “visual experience” (DC20, p237). At DC16 are printouts taken from GooglePlay showing various apps available for purchase including: Bible Experience, Heineken Experience, Sightseeing Experience, My Disney Experience, Galaxy Note 5 Experience, Atheist Experience and Bohemian Rhapsody Experience, the latter described as a virtual reality experiment.

12. At DC21 to DC23 are similar searches relating to printed matter. They include references such as “how to create an experience book” (DC22, p257), vouchers to be redeemed for various experiences such as flying experiences, food and drink experiences and theatre experiences (DC23). There are also references to experience gift vouchers and experience days (DC23, p287).

13. Other exhibits show the results of similar searches relating to advertising and marketing. A printout from Wikipedia at DC 24 for the term “Engagement marketing” notes that it is “sometimes called “experiential marketing”, a “marketing strategy that directly engages consumers and invites and encourages them to participate in the evolution of a brand or a brand experience”. It goes on to say it is a “growing trend which involves marketing a product or a service through experiences that engage the customers...” and that “Physical and interactive experiences are used to reinforce the offer of a product and make customers feel as if they are part of them” (p324). There are also references to “live experience campaigns” (DC25, p333) and a “brand experience agency” which is “helping companies... succeed in the experiential age” (DC26, p352).

14. There are further exhibits reflecting services relating to entertainment, events, clubs, food and drink, hospitality, cinema and theatre. The accompanying printouts refer to “the entertainment ‘experience’ at sports events” (DC27, p362), “premium event cinema experiences including theatre productions, sporting history, ballet, opera, arts and culture from across the globe” (DC27, p365), “The everyday TV watching experience” (DC27, p370), “Entertainment Experience” and “gaming

experience” (DC27, p374), “the video game console experience” (DC27, p375), “The Dickie and Mandy Entertainment Experience” by which entertainment is said to be provided in a number of forms including quiz shows and murder mysteries at private parties or corporate events (DC27, pp376-377), “the light experience” at a cinema (DC27, p379), an “entertainment experience” whereby music, light, smoke and bubble machines and lasers are provided for private events (DC27, pp384-385), a booklet providing tips to allow organisers to “understand [-] event experience & behaviours” (DC28, p388), a “ticketing experience” for FIFA, Ryder Cup and Grand Prix events (DC28, p398), “The Club Experience” for health and fitness clubs (DC29, p402), the Edgbaston [cricket] Experience Club (DC29, p409), “Pro-Club Experience Football Tours” (DC29, p411), a health club experience (DC29, p416) and cinema experiences which involve watching films whilst in a certain location such as in a hot tub, on rooftops terraces or whilst afloat or whilst eating the provided “film-relevant nibbles” which “bring certain smells to the fore” at appropriate points in a film (DC32).

15. Ms Lynch’s witness statement acts as a vehicle to introduce exhibits which, she states, show results of searches she carried out via Google on 22 May 2017. This is some 9 months after the relevant date in these proceedings. Much of what she exhibits consists of extracts and articles presumably downloaded from various websites though the sources are not always identified and many are undated or post-date the relevant date. That said, at JL1, page 6 is a report dated 2004 which indicates it is from Loughborough University’s Institutional Repository. It is entitled “Mobile Phone Games: Understanding the user experience” and “aims to provide insight into what motivates people to play existing mobile phone games, despite their limitations, and seeks to identify elements of the current mobile gaming experience that should be preserved within future games”. At page 9 is an extract from an Ofcom report dated 12 August 2014 entitled “Consumer experiences of mobile phone calls”. At page 12 is an article dated 14 November 2012 taken from marketingweek.com entitled “looking for a visual feast in the tablet experience” which concludes that “Tablet users demand interactive and engaging experiences when they surf the web, so brands need to evolve their content quickly if they want to keep customers”.

16. At JL3 is an article published by the Careers Group University of London dated 2 January 2013. It is entitled “Getting experience in advertising” and provides a reflection of one student’s time undertaking work experience. At JL4, page 42, is an article dated “06/01/2915” published on the huffingtonpost.com website entitled “This Is Not a Music Festival: It’s an Experience” which is described as “what you take with you long after the bands have left and your sunburn has faded.” At JL4, page 43, is an article published in the Independent on 1 June 2016 entitled “Festival Season 2016: How to make sure you have the best experience this summer”. At JL4, pp45-46 are extracts from a report published in March 2014 by UK Trade & Investment entitled “Experience UK A guide to creative excellence in visitor attractions”.

17. At JL5, page 56, is what appears to be an advertorial published on the Telegraph Travel website dated 31 March 2016 and entitled “The most amazing hotel experiences in the UK”. At JL6, p64, is an article from “Customer Experience Insight” and dated 4 April 2016, entitled “22 ways to add value to your social media experience” and, at page 64, an extract from “ideal” dated 13 April 2015 entitled “Virtual Networking Experience from the field”.

The objections under sections 3(1)(b) and (c) of the Act

18. In its written submissions, the opponent indicates that its main focus is directed to the grounds founded on sections 3(1)(b) and (c) of the Act. I therefore find it convenient to consider these grounds first.

19. In short, the provisions of section 3(1)(b) and (c) of the Act respectively preclude registration of a mark which is “devoid of distinctive character” or “consists 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”. Even if a mark falls foul of these grounds, however, there is a provision to section 3(1) which allows for registration in circumstances where the trade mark is shown to have acquired a distinctive character through its use prior to the date of the application for registration. The applicant does not rely on this proviso here, however, and, consequently, I shall say no more about it.

20. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union (“CJEU”) stated:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

21. For convenience, I intend to consider the objection under section 3(1)(c) in the first instance.

22. Section 3(1)(c) is the equivalent of Article 7(1)(c) of the Community Trade Mark Regulation, the case-law of which was summarised by Arnold J. In *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-

191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined

Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the

goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms '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', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

23. I have to consider the matter from the perception of the average consumer who is deemed to be reasonably observant and circumspect. The average consumer's level of attention will vary depending on the particular goods or services in issue. In respect of the vast majority of the goods and services for which the applicant seeks

registration, the average consumer will be the general public though for some, such as the advertising services in class 35 or licensing services in class 45, the average consumer is more likely to be a commercial undertaking. I see no reason why either class of average consumer would pay more or less than a normal degree of attention when selecting any of the goods and services at issue.

24. The trade mark applied for is the word EXPERIENCE presented in plain block capitals and with no additional elements. The parties do not appear to dispute that it is an ordinary everyday word in the English language which will be well-known to the average consumer and is defined, as the evidence shows, as meaning “Practical contact with and observation of facts or events”, “the knowledge or skill acquired by a period of practical experience of something, especially that gained in a particular profession” and “an event or occurrence which leaves an impression on someone” as per the dictionary references exhibited at DC1. The applicant has not challenged any of the opponent’s evidence. It appears, therefore that there is agreement that the word describes an activity which “leaves an impression on someone” or which provides, or is provided by, someone who has “knowledge or skill acquired by ...practical experience of something”. The uses of “experience” shown in the evidence support the dictionary references.

25. Most of the goods covered by the application in class 9 take the form of software, digital media and apps which includes those which could be or are specified as being intended to relate to such uses as e.g. gaming, sports and other live events. They are goods which allow the user to interact with or experience something in the virtual world. I therefore find that EXPERIENCE is a sign which may serve, in trade, to designate a characteristic of the goods i.e. goods that provide a user experience. The remaining goods in the class are accessories or equipment which combine to allow the user to carry out that experience e.g. screens, loudspeakers, eyewear or electronic publications. The same objection therefore also applies to these goods.

26. The evidence shows the word EXPERIENCE has long been, and continues to be used and understood to offer those undertaking it the opportunity to partake in an activity of some sort, particularly those which are not an everyday event including e.g. attending a show of some sort, partaking of afternoon tea or some other special

meal, taking a trip in or on a particular form of transport or having the opportunity to experience undertaking a specific job role for a (part of a) day. In relation to such activities, I find the word EXPERIENCE designates the intended purpose of such services as each are or could be offered as an experience. This would include each of the services as applied for in classes 41 and 43. As the earlier decision in BL O-202-03, to which the opponent referred me, made clear, such activities are often bought as a voucher or ticket, whether in printed or electronic form, which the person who is to undertake the activity exchanges at some later point; the user will also often have some sort of record of the day, whether electronic or physical photographs, in certificate or book form or some other way. The objection therefore also applies to these goods in classes 9 and 16.

27. The applicant's services in class 35 are, in general terms, advertising, marketing and other business services, all of which are subject to the limitation that they are "provided in conjunction with cinema and film club services". The evidence shows "experiential marketing" is a term of art and, indeed, the specification of services in this class includes the term "experiential marketing services". The evidence also shows that cinemas and films are provided as the subject matter or focus of various activities offered as an experience. The objection therefore applies to these services as the mark designates the intended purpose of such services.

28. That leaves the applicant's services in classes 38, 42 and 45 to consider. There is no evidence, and I am not aware, that these services have been or are the subject of an experience activity. They are, however, in my view, services which are technical ones provided by professionals in the particular field. Because of this, I consider the mark designates the intended quality of those services i.e. services provided by those with experience in the particular area of trade. The objection therefore also applies to these services.

29. The opposition therefore succeeds under section 3(1)(c) of the Act in full.

30. On a strict view of the matter, having found against the applicant under section 3(1)(c) of the Act, it is not necessary for me to assess the opponent's remaining grounds of opposition. In case I am found to be wrong in my assessment under

section 3(1)(c), however, I will also consider the ground of opposition under section 3(1)(b) of the Act. Given that it is not an objection primarily relied on by the opponent, I will not consider the objection under section 3(1)(a).

The objection under section 3(1)(b) of the Act

31. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se,

three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

32. In its written submissions, filed in lieu of attendance at a hearing, the opponent submits:

"No level of distinctiveness resides in the non-stylised word EXPERIENCE for the goods and services at issue.

The Applicant's mark does not possess any degree of stylization to 'save it' from the provisions of section 3(1)(b). It is not a misspelling or a slogan mark which could be said to possess a quirkiness, originality or could be considered as being a play on words. Rather, it is an everyday dictionary word which the Opponent's evidence has shown to be in widespread use across a number of relevant categories of goods and services. The Applicant's mark also has a direct and specific relationship to the goods and services in question. That position has not changed over time -as evidenced by the earlier UK decision exhibited at DC5 and the more recent evidence exhibited under the witness statements of Mr Carter and Ms Lynch.

...it is the Opponent's submission that the average consumer (or average consumers) of the Applicant's goods and services would, irrespective of the level of attention they display, perceive the Applicant's mark as nothing more

than a common dictionary word which indicates/suggests that the Applicant's goods and services would deliver an 'experience' or describe the intended purpose or other characteristic of the goods and services in question...

...In addition, or in the alternative, the Applicant's [-] goods [and services] describe the intended purpose or other characteristic of the goods [and services], namely that they will deliver an 'experience'".

The opponent concludes:

"The Applicant's mark would be perceived by the average consumer/average consumers of the goods and services in question as being origin neutral and incapable of functioning as a trade mark."

33. The applicant has not disputed the dictionary references exhibited in the opponent's evidence. I consider the mark EXPERIENCE is one which is descriptive of goods and services which "provide practical contact" with an activity or event, particularly those which are interactive or which leave an impression on the user and services provided by professionals experienced in the field. Taking the evidence as a whole into account, I see no reason why the average consumer would be likely, on a prima facie view, to regard the word as identifying a particular trade source of any of the goods and services for which registration is sought. As a consequence, I find the mark independently falls foul of the provisions of section 3(1)(b) of the Act.

Summary

34. The application is refused because registration would be contrary to sections 3(1)(b) and (c) of the Act.

Costs

35. The opponent has succeeded and is entitled to an award as a contribution towards its costs. I make the award on the following basis:

Preparing a notice of opposition and considering the counterstatement:	£300
Fee:	£200

Preparing evidence:	£1000
Filing written submissions in lieu of a hearing:	£300
Total:	£1800

36. I do not consider it appropriate to include in the award any contribution resulting from the appointment of the CMC which was held entirely because of the opponent's failure to comply with the requirements of the Tribunal Practice Notice regarding the volume of evidence filed.

37. I order Rooftop Film Club Limited to pay Jaguar Land Rover Limited the sum of £1800. This sum is to be paid within fourteen days of the end of the period allowed for appeal or, if an appeal is filed, within fourteen days of the conclusion of that appeal (subject to any order made by that appellate tribunal).

Dated this 03rd day of July 2018

Ann Corbett
For the Registrar

Annex

Class 9

Computer software; downloadable computer software; downloadable and interactive files and applications for computers, multi-function hand-held computers, electronic personal organizers, e-readers, tablet computers, personal audio players, personal electronic entertainment devices, game consoles and mobile phones; magnetic data carriers, audio CDs; compact discs, DVDs and other digital information carrying mediums, including with recordings; downloadable, non-downloadable, interactive and networked software, files and applications for computers, multi-function hand-held computers, electronic personal organizers, e-readers, tablet computers, personal audio players, personal electronic entertainment devices; computer software, including software for or relating to sports, competitions, celebrities, actors, producers, directors, festivals, musicians, sports figures, tournaments, live events, televised events, entertainment sports, sports training, stunts, tricks, performances, exhibitions, documentaries, films, artistic works, videos, video compilations, music and music concerts, opera, theatre, performance art, highlight reels, ticket sales, merchandise sales, education, fan clubs, sports clubs; video games; video game discs, video game software; downloadable video games and video game software; downloadable video files and files for playing video; downloadable digital media and computer files; downloadable digital animations and moving images; downloadable files being tickets, coupons and event passes; downloadable files being tickets, coupons and passes for entertainment and film events; floppy discs; hard discs; teaching apparatus; downloadable digital media and computer files being text messages, video messages, musical messages and multimedia messages; downloadable digital educational media; electronic publications and downloadable electronic publications; interactive data media; podcasts; broadcasting apparatus and equipment; apparatus for recording, transmission or reproduction of sound and/or images; electronic publications; communications and telecommunications apparatus; computers; multi-media recordings and publications; personal computer, mobile computer, tablet computer, ereader and phone applications; personal computer, mobile computer, tablet computer, e-reader and phone applications for or relating to sports, competitions, celebrities, sports figures, tournaments, live events, televised events, entertainment sports, sports training, stunts, tricks, performances, exhibitions, documentaries, videos, video compilations, music and music concerts,

highlight reels, ticket sales, merchandise sales, education, combat, martial arts, extreme sports, fan clubs, sports clubs, sports camps; contact lenses, spectacles, eyeglasses, sunglasses, eyewear and their frames, cases, chains and lenses; cases and stands for mobile phones, e-readers, tablet computers, computers, personal audio players, electronic personal organizers; cameras, video cameras and other devices used to capture images and cases, lenses, stands, covers, caps, parts and accessories for these products; downloadable ring tones, music, multimedia, audiovisual media, MP3s, graphics, games, videos, images and information for wireless mobile communication devices; downloadable software; web-based applications and software; eyewear for watching images and films; eyewear for watching images and film in three dimensions; projectors; screens for projectors; screens for films; loudspeakers; headphones and ear buds.

Class 16

Printed matter; posters; advertising posters; printed programmes; leaflets; printed publications; membership certificates; loyalty cards; tokens for advertising purposes for collection in sets; brochures, books, newsletters, photographs; stationery; gift vouchers and coupons; printed tickets and printed event passes; envelopes; wrapping paper; paper; book bindings; magazines; booklets; manuals; posters; instructional and teaching material (except apparatus); calendars.

Class 35

Advertising, promotional and marketing services; experiential marketing services; on-line advertising on a computer network; promotional services in the form of sharing of multimedia content via the Internet and other computer and communications networks; trendsetting services, being viral marketing, advertising and promotional services; promotional services and mass-marketing services, being trendsetting services and advertising in popular media; office functions; distribution of leaflets and samples, including electronic leaflets and samples; newspaper subscription services for others; public relations services; registration and composition of written and digital communications; radio advertising; rental of advertising time and advertising space, including on all means of communication; provision of online advertising space and services; provision of video advertising space and services; product placement services; retail services connected with the sale of magnetic data carriers, audio CDs, compact discs, DVDs and other digital information carrying mediums,

including with recordings, downloadable, non-downloadable, interactive and networked software, files and applications for computers; compilation of advertisements for use as web pages on the Internet, provision of space on web sites for advertising goods; provision of database and computerized database management and compilation market research services; business intermediary services in the field of selling images, photographs, audio and visual recordings, sound, music, video; business intermediary services; distribution services and digital distribution services all relating to promotional matter, promotional material, samples, samples for publicity purposes, discount cards and coupons, publicity brochures, publicity materials, publicity texts, publicity leaflets, products for advertising purposes, advertising announcements; services comprising the recording, transcription, composition, compilation and systematization of written communications and recordings, as well as the compilation of mathematical or statistical data; advisory and information services relating to the aforementioned services; sponsorship search; newsclipping services; artist management; auctioneering; sales promotion for others; compilation and management of business directories; business management and administration services; customer club services for commercial, promotional and advertising purposes; loyalty, incentive and bonus card and scheme services; provision of information, advisory and consultancy services in relation to the aforementioned services; all of the aforesaid services provided in conjunction with cinema and film club services.

Class 38

Broadcasting, relaying and transmission of programs, messages, live events, multimedia, music, video and audiovisual media and recordings featuring these things via satellite, radio, cable, websites, social media, the internet, and computer networks; messaging services; providing wireless transmission of uploading ring tones, voice, music, multimedia, audiovisual media, MP3s, graphics, games, videos, images, information and news via a global computer network to a wireless mobile communication device; sending and receiving voice, sound, image, video, film, audiovisual, multimedia and text messages between communication devices; providing online and networked forums for social networking, transmission of messages, and discussion; chat room services; streaming data, audio, visual, video, film and multimedia material on the internet and through networks; web portal

services; data, video, film, audio streaming; broadcasting, transmission, messaging, bulletin board, chat room, forum and mobile communications for building and maintaining online communities; news agency services; electronic bulletin board services; provision of podcasts; provision of information, advisory and consultancy services in respect of the aforementioned services.

Class 41

Entertainment services; cinema and theatre services; education and training services; cultural activities; sports; sports and fitness; sports tournaments; extreme sports; music, video and film entertainment services; producing video compilations; selection and compilation of video and sound recordings; booking of events and competitions, tickets and seats; ticket reservation, agency, booking, procurement and information services for theatre, film, cinema, entertainment, sports, shows; arranging and conducting colloquiums, exhibitions, concerts, entertainment events, conferences, congresses, seminars, symposiums, festivals, fairs, circuses, shows, workshops, fashion shows and contests; scriptwriting services; ghostwriting services; news reporter services; entertainment by way of pre-recorded messages and video messages; music, video and media recording, recording studio, and production services; publication and publishing services, including online and over the internet; cinema presentations; disc jockey and dj services; organizing, producing, arranging and curating entertainment, recreational, educational and cultural events; game shows; provision of games; games equipment rental; games offered on-line and from a computer network; gambling services and betting services; entertainment services being provision of virtual or online environments within which users can interact for recreational, competition, gaming, leisure or entertainment purposes; entertainment services provided by way of blogs and online forums; entertainment services provided by way of podcasts; provision of web based programmes for mobile communications devices, being nondownloadable media, multimedia, audiovisual media, games and publications; entertainment services by way of music and media provided through the internet or mobile telephone communication; entertainment services on social networking websites; the provision of on-line electronic publications and digital music (not downloadable) from the Internet; production, preparation, exhibition, distribution and rental of video, audio, audiovisual and radio programmes and of films, animated films, sound and video recordings and live

events, including through interactive media, including on the internet; provision of recreational and entertainment facilities; creation of formats for media, television, music and video; digital music (not downloadable) supplied from MP3 websites on the Internet; fan club services; providing digital music (not downloadable) from MP3 Internet websites; booking agencies [entertainment, cultural, sports, educational and competition events]; text, image, sound and video editing services; music, video and photographic composition services; video recording, taping, editing, production, exhibition; arranging and conducting of business and commercial conferences and seminars; rental of projectors, grandstands, films, dvds, cameras, cinemas, venues and facilities for entertainment and film and recreation, stage and entertainment venue lighting, theatre and entertainment venue seats and seating; advisory and consultancy services relating to the aforementioned services.

Class 42

Internet search engine services; provision of computer, data and software facilities; provision of space on the internet for web logs, blogs, videos, film; provision of on-line computer and software support; website hosting; providing an online website for creating and hosting micro websites for business; encoding and encryption of digital images, music, videos, and text; hosting digital content; design, drawing and commissioned writing for compilation of websites; arranging on-line website links and/or hypertext links featuring user related information; placing of hypertext links on third-party websites; keyword referencing services, being the provision of a technological service that matches search terms with search results; graphic design, animation design, and graphic arts design; digital editing; designing, creating and maintaining web sites and databases; research and analysis services, and sociological and economic research and analysis services; new product research and testing; designing, managing and monitoring online forums for discussion; providing temporary use of online non-downloadable software for displaying and sharing user location data, photographs, videos, messages and images, and for searching for and locating other users and places and interacting therewith; providing temporary use of online non-downloadable software for displaying and sharing user location data, photographs, videos, messages and images, and for searching for and locating other users and places and interacting therewith; filtering of digital content; application provider services (ASP); providing temporary use of

online non-downloadable software; providing temporary use online of non-downloadable software to enable uploading, downloading, capturing, posting, showing, editing, playing, streaming, viewing, previewing, displaying, tagging, blogging, sharing, manipulating, distributing, publishing, reproducing, or otherwise providing electronic media, multimedia content, videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the Internet and other computer and communications networks; providing temporary use to online non-downloadable software to enable sharing of multimedia content and comments among users; providing temporary use of online non-downloadable software to enable content providers to track multimedia content; hosting multimedia content for others; hosting multimedia entertainment and educational content for others; rental of computers; rental of computing equipment; rental of computer hardware; rental of computer facilities; rental of computer software; provision of information, advisory and consultancy services in relation to the aforesaid services.

Class 43

Services for providing food and drink; temporary accommodation; restaurant, cafe, bar services; night club services relating to provision of food and drink; catering services; club services for the provision of food and drink; contract food services; serving food and drink; food and drink consultancy; preparation of food and drink; restaurant services for the provision of fast food; take away services; corporate hospitality services relating to food and drink; charitable and benevolent provision of food and drink; provision of information relating to food, drink, restaurants, bars, supermarkets, providers of food and drink; providing food and drink via mobile transportation, mobile vans, mobile trucks, mobile vehicles; food truck services; personal chef services; provision of information, advisory and consultancy services in relation to the aforesaid services.

Class 45

Licensing services; intellectual property licensing and negotiation services; management of intellectual property; social networking services; online social networking services; social introduction and networking services; provision of information, advisory and consultancy services in relation to the aforementioned services.

