

O/0415/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003680465
IN THE NAME OF REVOLUTION BARS GROUP PLC
FOR THE SERIES OF TRADE MARKS:

The word 'PLAYHOUSE' is rendered in a stylized, outlined font. Each letter is composed of multiple parallel lines, creating a 3D effect. The letters are white with a thin black outline, set against a plain white background.The word 'PLAYHOUSE' is rendered in the same stylized, outlined font as above. The letters are yellow with a thin black outline, set against a solid yellow rectangular background.The word 'PLAYHOUSE' is rendered in the same stylized, outlined font as above. The letters are white with a thin black outline, set against a solid black rectangular background.The word 'PLAYHOUSE' is rendered in the same stylized, outlined font as above. The letters are yellow with a thin black outline, set against a solid black rectangular background.

IN CLASSES 41 AND 43

AND

THE OPPOSITION THERETO UNDER NO. 428562

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Background and pleadings

1. On 11 August 2021, Revolution Bars Group plc (“the applicant”) applied to register the series of four trade marks shown on the cover page of this decision in the UK.
2. The application was accepted and published in the Trade Marks Journal on 01 October 2021 in respect of services in classes 41 and 43. The contested services will be set out later in this decision.
3. On 29 November 2021, Catering UK Ltd (“the opponent”) opposed the application under Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).
4. Under Sections 5(2)(b) and 5(3), the opponent relies on the trade mark set out below:

UK00003422406

TSQ Playhouse

Filing date: 19 August 2019

Registration date: 17 January 2020

5. The opponent relies on all of the services for which the mark is registered, as set out later in this decision.
6. The opponent’s mark has a filing date that is earlier than the filing date of the contested application and, therefore, it is an earlier mark, in accordance with Section 6 of the Act, however, as it has not been registered for five years or more before the filing date of the application, it is not subject to the proof of use requirements, as per Section 6A of the Act.
7. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the applicant’s mark is similar to the earlier mark, and the respective services are identical or similar. In particular, the opponent states that (a) the marks coincide in the identical distinctive word ‘PLAYHOUSE’; (b) the word ‘PLAYHOUSE’ in the earlier mark has an independent distinctive role; and (c) the sequence ‘TSQ’ in the earlier

mark has no conceptual meaning and, accordingly, the conceptual similarity between the elements 'TSQ Playhouse' and 'PLAYHOUSE' is high.

8. Under Section 5(3) the opponent states that the earlier mark has acquired a reputation in the UK, because its extensive use of the mark 'TSQ Playhouse' in relation to the registered services. The opponent claims to be the owner of a highly successful and reputed venue in Covent Garden which trades under the name 'TSQ Playhouse' and the organiser of entertainment events, which include the provision of bespoke cocktail and dining experiences. The events are offered under and by reference to the mark 'TSQ Playhouse' and have been advertised since November 2019 and run since January 2020 with over 16,000 customers attending over 75 events. The opponent also claims to have received significant awards for its 'TSQ Playhouse' venue, including recognition at the World Luxury Bar and Restaurant Awards 2021, and extensive media coverage in publications and on TV, including Made In Chelsea, The Residents magazine, Urban Adventurer, Londontopia, and recognition through the activities of major influencers on TikTok and Instagram. The opponent therefore claims that use of the applicant's marks would, without due cause, take unfair advantage of or be detrimental to the reputation of the earlier mark.

9. In respect of its Section 5(4)(a) ground, the opponent claims to have used the sign 'TSQ Playhouse' throughout the UK since November 2019 for *entertainment services* and *bar and restaurant services*. The opponent claims that it has a protectable goodwill and that use of the contested mark would result in misrepresentation and damage.

10. The applicant filed a defence and counterstatement in which it conceded that the respective services in class 43 are identical but denied all of the other grounds. In particular, the applicant argues that the shared element 'PLAYHOUSE' is non-distinctive because it is used by a wide variety of traders in relation to entertainment services and the provision of food and drink, and it is a synonym for a theatre.

11. Both parties filed evidence during the evidence rounds. I shall refer to the evidence to the extent that I consider necessary.

12. The opponent is represented by Potter Clarkson LLP and the applicant by Novagraaf UK. A hearing took place on 14 February 2023 at which the applicant was represented by Aaron Wood (of Brandsmiths). The opponent did not attend but elected to file written submissions in lieu, in advance of the hearing.

EU Law

13. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

The evidence

14. The opponent's evidence consists of two witness statements by Haim Elies Danous, who is the opponent's director. Mr Danous's first witness statement is dated 20 May 2022 and is accompanied by 15 exhibits (HED01 - HED15). Mr Danous's second witness statement was filed in reply to the applicant evidence, it is dated 1 September 2022 and is accompanied by one exhibit (HED2-1).

15. The applicant's evidence is provided by Luke David Portnow, a chartered trade mark attorney employed by Novagraaf UK, the firm representing the applicant in these proceedings. Mr Portnow's witness statement is dated 18 July 2022 and is accompanied by nine exhibits (LDP1 – LDP9).

DECISION

Section 5(2)(b)

16. Section 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because-

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

17. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

18. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of services

19. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary.”

20. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

21. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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 trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

23. The services to be compared are as follows:

The applied-for services	The opponent’s services
<p>Class 41: <i>Provision of services and venues for entertainment and amusement purposes, other than of a live theatrical, musical and/or cinematic nature; social club services for entertainment and amusement purposes other than of a live theatrical, musical and/or cinematic nature; provision of venues and facilities for playing</i></p>	

competitive and non-competitive games, board games, table-top games, amusement arcade games machines and video games machines, all for entertainment and amusement purposes only.

Class 43: *Provision of venues and community centers for social gatherings and meetings; preparation, serving and dispensing of food and drink; takeaway food services; pizza parlors; bar, lounge bar, wine bar, snack bar, juice bar, and coffee bar services; pubs; restaurant and cafe services.*

Class 43: *Bar and restaurant services; Bar services; Bars; Beer bar services; Cafe services; Cafés; Cafeteria services; Cafeterias; Catering; Catering (Food and drink -); Catering for the provision of food and beverages; Catering for the provision of food and drink; Catering of food and drink; Catering of food and drinks; Catering services; Catering services for the provision of food and drink; Club services for the provision of food and drink; Cocktail lounge services; Cocktail lounges; Coffee bar services; Food and drink catering; Food and drink catering for cocktail parties; Food and drink preparation services; Food preparation; Juice bar services; Juice bars; Night club services [provision of food]; Preparation and provision of food and drink for immediate consumption; Preparation of food and beverages; Preparation of food and drink; Providing drink services; Providing food and beverages; Providing food and drink; Providing food and drink for guests; Providing food and drink for guests in*

	<i>restaurants; Providing food and drink in restaurants and bars; Providing of food and drink; Pubs; Restaurant and bar services; Restaurants; Room hire services; Services for providing drink; Services for providing food; Services for providing food and drink; Serving food and drink for guests; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Serving food and drinks; Tea room services; Tea rooms; Wine bar services; Wine bars.</i>
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24. As the applicant has admitted that the respective services in class 43 are identical and has denied that the contested services in class 41 are similar to opponent's services in class 43, I only need to assess the similarity between the opponent's services in class 43 and the applicant's services in class 41.

25. The opponent's position, as set out in its notice of opposition and submissions in lieu is that the contested services in Class 41 are similar to the opponent's services in class 43 because:

- venues and undertakings which offer entertainment and amusement services frequently also offer food and drink and vice versa. Consumers are well aware of this and are liable to understand that such services are provided by the same undertakings;
- the term *Room hire services* in the opponent's specification is similar to the contested services in Class 41 given that such services may coincide in purpose and relevant public and are complementary to one another, in the sense that the registered services may be essential or important for the provision of the contested services in Class 41.

- the applicant's own evidence at LDP5 shows that venues and undertakings which offer entertainment and amusement services frequently also offer food and drink.

26. In his skeleton argument, Mr Wood reiterated the applicant's position that the contested services in class 41 are not similar to the opponent's services in Class 43, noting that whilst the opponent claims that venues offering services in Class 43 often provide services falling in the specification under class 41 of the application, it is not suggested (nor is it true) that these are either complimentary or competitive such as to render them similar for the purposes of the comparison. Mr Wood also cited my decision *O-917-22 HULA* where I stated:

“Although restaurants can provide on-site entertainment such as dances and parties, the latter are merely ancillary. Restaurants do not necessarily need entertainment services to exist and vice versa, although these services may target the same public. Restaurants can host the contested services, but those services are usually provided by separate undertakings engaged by the restaurants. It follows that the relevant public would not perceive the conflicting services as having a common commercial origin. These services are dissimilar”.

27. The Class 41 services at issue in that decision were *Entertainment; night clubs; nightclub services; discotheque services; club entertainment services; disc jockey services; organisation of entertainment events; organisation, provision and presentation of live performances; live music services; live music shows; live musical performances; live band performances; provision of recorded entertainment; audio-visual display presentations; ticketing and event booking services; ticket reservation services; information, advisory and consultancy services in connection with the aforesaid.*

28. The Class 41 services at issue here are *Provision of services and venues for entertainment and amusement purposes, other than of a live theatrical, musical and/or cinematic nature; social club services for entertainment and amusement purposes other than of a live theatrical, musical and/or cinematic nature; provision of venues*

and facilities for playing competitive and non-competitive games, board games, table-top games, amusement arcade games machines and video games machines, all for entertainment and amusement purposes only.

29. Although the Class 41 services at issue in these proceedings are different from those in *HULA*, similar considerations apply. The earlier Class 43 services concern the provision of food and drink in various settings, including restaurants, bars, pubs, café, catering and club services. The contested services cover the provision of services, venues and facilities for entertainment and amusement purposes including for playing competitive and non-competitive games, board games, table-top games, amusement arcade games machines and video games machines. It is true that providers of the opponent's services in class 43 can offer entertainment or arcade services in their premises. Nevertheless, those services are normally provided by separate undertakings, and the managers of establishments usually restrict themselves to hiring out their premises and do not take on the organisation of those activities. These services have a different nature, purpose and method of use. They are not in competition with each other. They are also not complementary to each other: the services are not closely connected in the sense that one is indispensable or important for the use of the other. Moreover, even if I were to accept that the opponent provides food and drink as well as entertainment within its premises, it would not be sufficient to establish that the usual commercial origin of the services and their trade channels coincide. On the contrary, from my experience, the competing services are normally provided separately and are offered by different types of undertakings. The mere fact that the services are on occasion provided next to each other does not render them similar.

30. As regard the opponent's reliance on the applicant's evidence produced at LDP5, the primary purpose of that evidence was to establish that the trade mark 'PLAYHOUSE' is used by other traders. Whilst I note the opponent's attempt to rely on the applicant's evidence to support its argument that venues and undertakings which offer entertainment and amusement services frequently also offer food and drink, that is not the primary purpose of the applicant's evidence - if it shows such a thing, it is only in an incidental way. This also raises the question of why, if the opponent wanted to demonstrate that the services at issue have converged in the

market in such a way that they have become complementary, it decided that it was not necessary to file its own evidence on the point. In any event, the evidence shown at LDP5 is of limited assistance because it is after the relevant date. Further, it is limited to only nine venues some of which are geographically close to the opponent's venue (so are far from showing convergence of the services on the UK market at large) whilst others relate to the provision of theatre-related services, which are clearly excluded by the contested specification.

31. Finally, as regard the argument that the opponent's *Room hire services* are similar to the contested services in Class 41, it must be noted that the term covers essentially rental of rooms, such as, for example, rental of meeting rooms (which falls in class 43). Even if providers of arcade or entertainment services would use the opponent's services to rent a space where they would provide their services to their final customers, that would not create any complementarity relationship between the services, and the users of the services would be different, i.e. the applicant would be the user of the opponent's rental services whilst the user of the applicant's entertainment and arcade services would be the general public. These services are dissimilar.

Average consumer

32. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively

by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

33. The average consumer of the services at issue (in class 43) is a member of the general public, who is over the age of 18 when the relevant services involve the sale of alcohol. The purchase is normally visual in nature with the services being selected from signage appearing on the frontage of food and beverage establishments, or from websites visited in order to make bookings. However, I do not disregard that aural considerations may sometimes play a part when, for example, services are selected following aural recommendations.

34. The degree of care the average consumer will display when selecting such services is likely to vary, depend on the type of food and drink on offer. Consumers, however, are increasingly more alert to the selection of restaurant and bar services and will consider factors such as the nature of the food on offer and the type of occasion – for example celebratory or a casual eating experience. Overall, I consider that the selection process will involve a medium degree of attention.

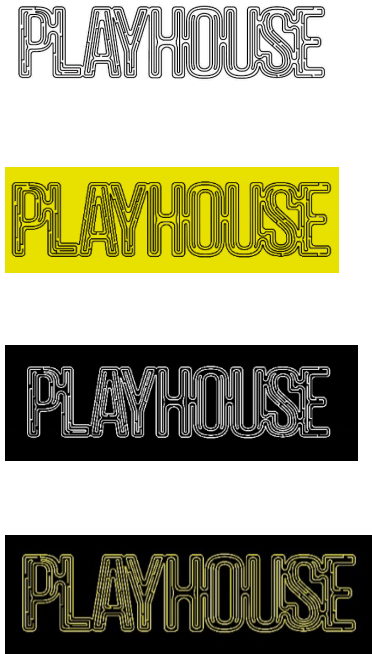
Comparison of marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

36. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The respective marks are shown below:

The applicant’s mark	The opponent’s marks
	<p data-bbox="810 1077 1034 1111">TSQ Playhouse</p>

37. The applicant’s position as regard the comparison of the marks (as stated in Mr Wood’s skeleton argument) is as follows:

“There are significant visual, phonetic and conceptual differences between the marks. To the extent that there is any similarity between the marks, it is in relation to a word which has a relevant inherent meaning, which has not been the subject of substantial use as part of the mark TSQ PLAYHOUSE, and which is used by a number of third parties”.

38. The opponent's position is that each element of the earlier mark, namely 'TSQ' and 'Playhouse' is distinctive.

39. The applicant's mark is for a series of four figurative marks comprising the word 'PLAYHOUSE' presented in capital letters in a neon font, with three of the marks presenting the word in black against a yellow background, or in white or yellow against a black rectangular background. Although the elements 'PLAY' and 'HOUSE' are presented as conjoined, they are instantly understandable words that are likely to be appreciated instantly. However, neither is more dominant or distinctive over the other and so the mark as a whole must be considered. Whilst the stylisation, colours and backgrounds contribute to the impression conveyed by the marks, they will be perceived as ornamental, and I consider the dominant and most distinctive element of the mark to be the word 'PLAYHOUSE'.

40. The earlier mark consists of the two verbal elements 'TSQ' and 'Playhouse'. The evidence shows that the opponent's is somehow connected to a business trading under the name 'Thai Square' and that the opponent's 'TSQ Playhouse' venue offers Thai-inspired quality bar snacks. Whilst it is possible that the component 'TSQ' of the earlier mark stands for 'Thai Square', it is unlikely that the average consumer will recognise it as such – rather the average consumer will naturally perceive it and pronounce it as an initialism without knowing what it stands for.

41. In assessing the contribution made by the word 'PLAYHOUSE' to the overall impression of the mark, I take into account the applicant's argument that the word is non-distinctive (or less distinctive than the sequence 'TSQ') because it is used by other traders. In this connection, the applicant filed the following evidence:

- copies of webpages showing the results of a Google search for the words 'playhouse entertainment uk'.¹ The pages are undated save for the printing date of 15 July 2022, which is after the relevant date. I also note that most of the results do not actually show use of the word 'PLAYHOUSE' at all and/or appear to relate to theatre-related events and venues, as shown below:

¹ LDP4

<https://lancastergrand.co.uk> ▼

[Lancaster Grand Theatre: Live Comedy, Family Shows, Music ...](https://lancastergrand.co.uk)

Lancaster's theatre for live entertainment since 1782- book a show! See comedy by top comics, drama, dance, music, family and more.

<https://www.scunthorpetheatres.co.uk> ▼

[Scunthorpe Theatres: Entertainment Events & Venue Details](https://www.scunthorpetheatres.co.uk)

Welcome to Scunthorpe Theatres! Combining the events of Baths Hall and the Plowright Theatre find out more on our amazing line-up of gigs, artists & events ...

<https://www.sevendialsplayhouse.co.uk> › about-us ▼

[About Us - Seven Dials Playhouse](https://www.sevendialsplayhouse.co.uk)

With a focus on new writing, European/UK/London premieres, revivals and adaptations, Seven Dials Playhouse provides creates opportunities for people to ...

<https://www.discoveryyorkshirecoast.com> › things-to-do ▼

[Theatre & Entertainment in Scarborough](https://www.discoveryyorkshirecoast.com)

Experience first class entertainment in Scarborough with a whole host of shows, musical acts and theatre productions.

<https://shakespearenorthplayhouse.co.uk> › support-us ▼

[Business Partnerships - Shakespeare North Playhouse](https://shakespearenorthplayhouse.co.uk)

Will@shakespearenorthplayhouse.co.uk ... From the amphitheatre style seating space, audiences can enjoy all kinds of outdoor entertainment.

<https://www.livenation.co.uk> › venue › darwin-entertai... ▼

[Darwin Entertainment Centre Playhouse - Live Nation](https://www.livenation.co.uk)

Buy Darwin Entertainment Centre Playhouse tickets with confidence from co.uk. Browse all events and schedules. We have location, travel, parking and seating ...

<https://thekiterunnerplay.com> ▼

[The Kite Runner - A stunning new play!](https://thekiterunnerplay.com)

Martin Dodd for UK Productions and Derek Nicol & Paul Walden for Flying Entertainment proudly present the Nottingham Playhouse and Liverpool Everyman and ...

<https://perthplayhouse.co.uk> ▼

[IMAX Playhouse | Independent Cinema | Perth](https://perthplayhouse.co.uk)

Experience movies in IMAX at Perth's independent cinema. 7 Screens showing all the latest releases and old favourites.

- screen captures from third party websites (undated) showing use of the word 'PLAYHOUSE'.² This includes: (a) a company offering theatre-related entertainment services for children parties at www.playhouseparties.co.uk; (b) a company offering cinema-related services at www.montroseplayhouse.co.uk; (c) a company offering theatre-related entertainment services at www.theplayhousetheatre.co.uk; (d) a company selling tickets for the Playhouse Theatre in London at www.atgtickets.com; (e) a company offering theatre-related entertainment services at www.playhousewhitleybay.co.uk; (f) a company offering theatre-related entertainment services at

² LDP5


www.leedsplayhouse.org.uk; (g) a company offering theatre-related entertainment services at www.southwarkplayhouse.co.uk; (h) a company offering circus, dance and theatre-related entertainment services at www.harlowplayhouse.co.uk and (i) a theatre called www.sevendialsplayhouse.co.uk;

- copies of webpages³ showing the results of a Google search for the words 'playhouse bar uk'. The pages are undated save for the printing date of 15 July 2022, which is after the relevant date. The first page of results is shown below:

https://playhouse-bars.com ⓘ

Playhouse Bars: Playhouse Fine Gaming, Bar and Pizza

21 Sept 2021 — WELCOME TO PLAYHOUSE. Next-level gaming meets the finest pizza in town. — Get to grips with our next-level mix of gaming experiences



https://www.southwarkplayhouse.co.uk › your-visit › pl... ⓘ

Bar/Cafe - Southwark Playhouse | Theatre and Bar

Bar/Cafe · Monday 5.30pm to 11pm. Tuesday 1pm to 11pm · Our bar serves an assortment of beverages to suit all tastes from hot and cold soft drinks to beer, wine, ...

https://en-gb.facebook.com › ... › The Playhouse Bar ⓘ

The Playhouse Bar - Home | Facebook

The **Playhouse Bar** is a fantastic, friendly space serving real ales from local breweries, German... 42-58 St Georges St, NR3 1AB Norwich, UK.
★★★★★ Rating: 4.8 · 16 votes

https://en-gb.facebook.com › playhousebarandkitchen ⓘ


Playhouse Bar & Kitchen - Home | Facebook

Our Restaurant, Deli and Bar are located at Nottingham **Playhouse**. We offer seasonal menus suitable... Wellington Circus, NG1 5AF Nottingham, UK.
★★★★★ Rating: 4.8 · 23 votes

https://www.northamptonchron.co.uk › food-and-drink ⓘ

Video: Take a look inside new town centre bar Playhouse ...

19 Nov 2021 — Video: Take a look inside new town centre bar **Playhouse** dubbed 'Northampton's very own funhouse'. The bar's grand opening is TONIGHT (Friday, ...



https://www.rpbi-openings.co.uk › openings › sample ⓘ

Playhouse - RPBI Openings

Revolution Bars Group plc is a leading UK operator of 67 premium bars, trading under the Revolution and Revolución de Cuba brands. Floated on LSE in 2015. ID: ...

https://www.tripadvisor.com › ShowUserReviews-g186... ⓘ

"Never again!!!" Review of Playhouse Bar & Kitchen

Playhouse Bar & Kitchen: Never again!!! - See 69 traveler reviews, 10 candid photos, and great deals for Nottingham, UK, at Tripadvisor.
★★★★★ Rating: 1 · Review by ChefLiam231

³ LDP6

- copies of webpages showing the results of a Google search for the words 'playhouse entertainment venue'. The pages are undated save for the printing date of 15 July 2022, which is after the relevant date. They show, among others, results for venues called 'Stratford Playhouse', 'Cheltenham Playhouse', 'Harlow Playhouse', 'The Playhouse' (located in Portrush), 'Nottingham Playhouse', 'Epson Playhouse', 'Edinburgh Playhouse' etc, all of which appear to be theatres. Extracts from relevant websites are also produced;⁴
- webpages from the Cambridge online dictionary showing the definition of 'PLAYHOUSE' as "*a theatre. This is now only used in the name of theatres*" and as "*a small structure that looks like a house for children to play*".

42. In its submissions in lieu, the opponent states that whilst it does not dispute that the term "*PLAYHOUSE*" can be considered descriptive in relation to theatres (and perhaps cinemas, as the applicant's evidence may indicate) and toy houses, the same is not true of entertainment focussed restaurants and bars that provide food and drink" or in relation to the registered services in class 43.

43. I agree with the opponent. The results of the Google searches are after the relevant date and although they seem to indicate that there are a number of traders who offer bars services under trade marks incorporating the word 'PLAYHOUSE', it is far from clear to what extent these marks have been in use by the relevant date. The most that can be said is that the term 'PLAYHOUSE' is used in trade as a synonymous of the word 'theatre' - although I am not convinced that most average consumers will know that. In any event, whilst this might make the word inapt to denote the origin of services offered by theatres, it does not make the word 'PLAYHOUSE' descriptive in relation to the registered services in class 43, which are services for the provision of food and drink. This is because although the opponent might have used the earlier mark in the context of restaurant and bar services offered in conjunction with entertainment services, the specification of the earlier mark includes bar and restaurant services at large, and notionally covers the provision of bar and restaurant services without entertainment.

⁴ LDP7

44. Hence, I reject the applicant's argument that the word 'PLAYHOUSE' is descriptive in the context of the Class 43 services at issue.

45. Having concluded that the word 'PLAYHOUSE' is distinctive for the registered services in Class 43, I find that the overall impression of the mark 'TSQ PLAYHOUSE' lies in the combination of the two words 'TSQ' and 'Playhouse' which contribute in equal measure to the distinctiveness of the mark. Although I bear in mind that beginnings of marks are more focused upon, a number of cases have stressed that this only a rule of thumb⁵ and in this case the element 'TSQ' will be understood as an initialism, which, while not allusive or descriptive of the services at issue, is not particularly remarkable. I say this on the basis that the average consumer in the UK is used to seeing initialisms as the basis for trade marks.

Visual similarity

46. The marks clearly overlap in the presence of the words 'PLAYHOUSE'. As the earlier mark is a word mark, it may be used in upper- or lower-case letters. Consequently, no weight can be attached to the use of lower-case letters in the opponent's mark and upper-case letters in the applicant's marks. The additional sequence 'TSQ' in the opponent's mark acts as a point of difference but is much shorter than the word 'PLAYHOUSE'. Likewise, although the stylisation and colour in the applicant's marks add to the differences between the marks, they are purely ornamental. Consequently, I consider the marks to be visually similar to between a medium and high degree.

Aural similarity

47. The words 'PLAYHOUSE' will be pronounced identically in the respective marks. The word 'TSQ' in the opponent's mark will act as a point of aural difference. The stylisation and colours in the applicant's marks have no impact on how the marks will be articulated, so the differences they introduced are not relevant when comparing the marks aurally. The marks are aurally similar to a high degree.

⁵ BL-O-167-11

Conceptual similarity

48. Conceptually, the element 'TSQ' has no meaning in English and is therefore unlikely to be given any conceptual meaning by the average consumer. The only meaning conveyed by the marks to compare therefore is that conveyed by the word 'PLAYHOUSE', that is the same in both marks. In this connection, I find that whilst some average consumers might be aware of the meaning of the word 'PLAYHOUSE' as a theatre, a significant proportion of the relevant public will understand it as a reference to a toy house for children to play; however, this makes no difference when comparing the marks conceptually because whatever the concept of 'PLAYHOUSE' might mean for the average consumer, it is the same in both marks. The marks are conceptually similar to a high degree.

Distinctive character of earlier mark

49. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; 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 section of the public which, because of the mark, identifies the goods or services as

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

50. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

51. Overall, given what I said above in relation to the distinctiveness of the word ‘PLAYHOUSE’ in the context of the registered services in class 43, I consider that, inherently, the opponent’s earlier mark enjoys a medium degree of distinctive character.

52. Turning to consider the position in respect of enhanced distinctiveness, the opponent’s evidence is as follows:

- the opponent owns a highly successful and reputed venue which trades under the name ‘TSQ Playhouse’ offering immersive hospitality and culinary experiences, party, club and entertainment services, including bespoke cocktails, themed events, games and karaoke. The ‘TSQ Playhouse’ venue was always intended to be a high-end restaurant, cocktail bar and experiential business;
- The ‘TSQ Playhouse’ venue is in the prime London location of Covent Garden, a shopping and entertainment hub in London's West End known for its upscale restaurants and nearby theatres, which draw large crowds annually for plays and musicals. The venue was open in 2019 and has had the signage shown below since its opening in November 2019:



- The events provided from the 'TSQ Playhouse' venue were first advertised in November 2019 and have run since 16 January 2020 when the opponent hosted the grand opening event. A copy of a press release publicising the event is attached which refers to the 'THAI SQUARE RESTAURANTS' launching the 'TSQ Playhouse' which is described as a cocktail bar. Copy of an email discussing the text of an invitation dated September 2020⁶ indicates that the main group under the venue is THAI SQUARE RESTAURANTS, which was established in 1996 and has 13 restaurants in London and the Southeast serving authentic Thai food;
- Prior to the filing date of the contested application on 11 August 2021, approximately 80 events had been hosted at the 'TSQ Playhouse' venue since it opened, with over 16,000 customers attending. A list of events is provided, which cover January-February-March 2020, and then July-August-October-December 2020 and then May-June-August 2021;
- In addition to the above themed events, the opponent has also hosted regular non-themed nights at the 'TSQ Playhouse' venue since January 2020;
- The revenue from the opponent's events at the 'TSQ Playhouse' venue organised prior to 11 August 2021 is approximately £280,000. Copies of receipts are provided which are said to be a sample of the 'TSQ Playhouse' venue's customer receipts, however, they do not display the mark 'TSQ Playhouse' but only the mark 'THAI SQUARE' in the following forms:

⁶ HED1 page 49



COVENT GARDEN

166-170 Shaftesbury Ave London
WC2H 8JB

- The opponent has spent approximately £100,000 in relation to the entertainment provided at the 'TSQ Playhouse' venue prior to 11 August 2021. This confirms what I have said above about bars and restaurants not directly providing entertainment services;
- Examples of promotional material is provided from social media,⁷ along with samples of menus (undated) which confirm that the 'TSQ Playhouse' is a cocktail bar which also offers food;
- The 'TSQ Playhouse' venue's Facebook page, created on 5 December 2019, has 1,028 followers and its Instagram account created on 20 November 2019, has 9,188 followers. Videos featuring the tag #tsqplayhouse uploaded on the social media platform TikTok have been viewed 635,800 times. Examples of advertising through what are described as "major influencers" is provided, however, I have no idea whom those individuals are and there is no information about their followers;
- The 'TSQ Playhouse' venue appeared in an episode of Made in Chelsea which was aired on 20 April 2020 and has received coverage on a number of magazines, including the Residents magazine (which is London-based and has an estimated 163k monthly visits to its website), Urban Adventurer, Londontopia, LouiselovesLondon (which has 32.6k Instagram followers with an estimated 7.1k monthly visits to the account), CultureWhisper (an estimated 114k monthly visitors to its website).
- The 'TSQ Playhouse' venue has been awarded 'Best Cocktail Menu 2021' and has been shortlisted in the 'Visual Identity' category at the 2021 Restaurant & Bar Design Awards. It also appeared in the World Luxury Bar and Restaurant

⁷ HED5

Awards 2021 Ultimate Restaurant Guide and was voted by The Resident the 2nd best new restaurant and bar opening in January 2020 in London.

53. The picture painted by the evidence is consistent with the 'TSQ Playhouse' venue being a cocktail bar based in London and associated with a chain of 16 restaurants located in London and the Southeast trading under the name 'THAI SQUARE RESTAURANTS'. Although it is clear that the 'TSQ Playhouse' venue is the bar arm of the 'THAI SQUARE RESTAURANTS' business, which appears to be a relatively successful business having traded since 1996, it cannot benefit from the (potential) reputation associated with the latter because (1) such claim has not been pleaded by the opponent and (2) the name 'TSQ Playhouse' is different from the name 'THAI SQUARE RESTAURANTS' and there is nothing in the trade mark 'TSQ Playhouse' which would indicate to the average consumer that 'TSQ' is an initialism for 'THAI SQUARE'.

54. Focusing on the evidence relating to the 'TSQ Playhouse' venue, the venue hosted its opening event on 16 January 2020, which is only one year and seven months before the relevant date. The opponent says that during that period it ran 80 events with over 16,000 people attending, which, from a rough calculation, equates to approximately 200 people attending each event. There were no events in April, May, June and November 2020 and between January and April 2021. So, of the one year and seven months of trading, eight months should be discounted, as there were no events, and it is not clear whether the venue was open to customers when no events were held. The business was opened just two months before the first lockdown was announced in March 2020 and the period of trading coincides with the COVID 19 pandemic – this may explain the period of non-trading, as confirmed by the reference to another lockdown in an email dated 26 November 2020 which was sent from a PR Marketing agent to someone at @thaisq.com asking the question "*we are keen to know if you are planning on restarting PR when lockdown ends on 2 December?*". Whilst I am not here to compare the list of events produced by the opponent with the timeline of UK coronavirus lockdowns (and restrictions) between March 2020 and March 2021,⁸ the fact that this has not been addressed in the evidence about the events renders the

⁸ Mr Wood at hearing confirmed that the applicant does not challenge the fact that those events took place

evidence somehow opaque. Further, as noted by Mr Wood in its skeleton argument, it is difficult to reconcile the turnover figures of £280,000 with the alleged number of customers and the prices listed on the menus and receipts. This is because if one divides the total turnover by the number of customers, the average spend per customer is £17.50 - this does not sit well with the prices shown on the menus, which include, for example, an offer of £650 per five persons (which includes drink and snacks) and an average cost per cocktail of £15-19. More generally, the figures provided by the opponent are not consistent with the evidence that the 'TSQ Playhouse' venue was always intended to be a high-end restaurant, cocktail bar and experimental business based in a prime location in London.

55. I also note that some of Mr Danous' statements are clearly inaccurate, for example, the receipts exhibited at HED3 are said to be samples of the 'TSQ Playhouse' venue's customer receipts, however, they seem to be rather something else, as they show the trade mark 'THAI SQUARE' (but not the trade mark 'TSQ Playhouse'), are for dining experiences (rather than for bar and snack services which the 'TSQ Playhouse' is purported to offer), and are very expensive, ranging between over £600 to nearly £2,000 (which do not support the turnover figures and the evidence about the number of customers attending the events). Even if these inconsistencies could be explained by the fact that, as Mr Wood pointed out at the hearing, 'TSQ Playhouse' seems to be a bar within a restaurant called 'THAI SQUARE', it would not take the opponent's case any further forward. Furthermore, the applicant has filed evidence showing that the opponent did not actually win the Restaurant & Bar Design Awards and it was not shortlisted, explaining that entries are made by way of a collaboration between the designer and the project operator and are paid entries. Although the opponent responded to this evidence by claiming to have been invited by Restaurant & Bar Design Awards to participate in the award programme, this does not take away from the fact that this information was omitted in the initial evidence which gave the different impression that the award was independently given rather than bought by the opponent for marketing and PR purposes.

56. The fact that the evidence is not very consistent is certainly a fact which weighs against the opponent. Nevertheless, even if I were to ignore the inconsistencies mentioned above, the evidence is far from sufficient to establish that the

distinctiveness of the mark has been enhanced through use. The use of the mark has been geographically limited to one venue in London, the mark has been used only for a short period before the relevant date which, taking into account the period of non-trade amounts to less than one year, the use has been intermittent and the turnover figures are small in the context of the relevant market, which even in the absence of specific information about market share, I consider to be very large. Hence, I reject the opponent's claim to enhanced distinctiveness.

Likelihood of confusion

57. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

58. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the

earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

59. Earlier in this decision I found that:

- the competing goods in class 43 are identical;
- the contested goods in class 41 are dissimilar;
- the relevant consumers of the services at issue are members of the general public. The purchasing process will be predominantly visual although I do not discount aural considerations and the services will be selected with a medium degree of attention;
- the earlier mark and the contested marks are visually similar to a medium to high degree, and aurally and conceptually similar to a high degree;

- the earlier mark is inherently distinctive to a medium degree and the evidence is not sufficient to establish that the distinctiveness of the mark has been enhanced through use.

60. As some similarity of services is essential,⁹ the opposition under Section 5(2)(b) against the contested services in Class 41 fails.

61. Turning to the Class 43 services, and proceeding on the basis that (1) the parties' services are identical, (2) the word 'PLAYHOUSE' in the earlier mark is distinctive (in the context of the class 43 services at issue) and (3)) the word 'PLAYHOUSE' retains and independent distinctive role in the earlier mark 'TSQ Playhouse', I consider that the use of the word 'PLAYHOUSE' in the applicant's mark is sufficient to give rise to a likelihood of both direct and indirect confusion. Even if the average consumer were to recollect the element 'TSQ' of the earlier mark, it would understand it as an initialism and would consider the element 'PLAYHOUSE' as having its own trade mark significance within the earlier mark. Consequently, when encountering the applicant's mark, which is centred around the word 'PLAYHOUSE' (being the only verbal element of the mark) on identical services, the average consumer is likely in my view to consider it as use of a variant mark (of the opponent's earlier mark) believing that the services are provided by the same or related entities. There is a likelihood of confusion.

62. The opposition based upon Section 5(2)(b) is successful in relation to the applied-for services in class 43 and fails in relation to the applied-for services in class 41.

Section 5(3)

63. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United

⁹ *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

64. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

65. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and*

Spencer v Interflora, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

66. The relevant date for the assessment under Section 5(3) is the filing date of the application at issue, being 11 August 2021.

Reputation

67. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

68. I have produced a summary of the opponent's evidence above. Based on the same reasons for which I have rejected the opponent's claim to enhanced distinctiveness, I find that the evidence does not establish that at the relevant date the opponent's mark had achieved a level of knowledge and/or reputation amongst a significant part of the public sufficient to sustain a claim under Section 5(3).

69. Given that the conditions for establishing a claim under Section 5(3) are cumulative, without being able to establish a reputation the opposition under Section 5(3) fails at the first hurdle.

Section 5(4)(a)

70. Section 5(4)(a) states:

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

(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, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

(c)

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.”

71. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

72. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (Reckitt &

Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

73. I will consider the opponent's claim under this ground only insofar as the claim brought under Section 5(2)(b) has failed.

Goodwill

74. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

75. Under this ground the opponent claims goodwill in a sign which is identical to the earlier registered mark in relation to *entertainment services* and *bar and restaurant services*. Although I concord with what Mr Wood said at the hearing that given the nature of the claims, I only need to consider the Section 5(4)(a) claim in relation to entertainment services, I will briefly say why. In light of my previous findings that there is a likelihood of confusion in relation to the parties' services in Class 43 and no likelihood of confusion in relation to the parties' services in Class 41, even if the opponent had sufficient localised goodwill in its bar services to bring an action for passing off, it would be in no better position relying on bar/restaurant services to

oppose the contested services in Class 41. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “*a substantial number of members of the public are deceived*” rather than whether the “*average consumer are confused*”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this would be the case here and I find that even if the opponent’s had sufficient goodwill in relation to bar services, there would be no misrepresentation (or damage) in relation to the contested services in Class 41 because of the different field of activities – which although not fatal is an important and highly relevant consideration in deciding whether there is misrepresentation¹⁰ - the differences between the marks and the small size of the opponent’s goodwill.

76. Turning to *entertainment services*, my primary finding is that the evidence does not establish any goodwill in relation to entertainment services, because what the opponent provides is essentially a cocktail and snack bar. Whilst the opponent might have used third party performers and artists to provide entertainment at its venue, it did not provide the entertainment services themselves, for example, if a music band performed at the ‘TSQ Playhouse’ venue, consumers would not think that the band is economically connected with the opponent’s bar business. Likewise, whilst the entertainment provided at the venue might have encouraged some people to use the opponent’s bar and cocktail services (and in this sense the entertainment provided at the venue might bring in customers) that would be a promotion idea, not the opponent’s goodwill bringing customers in, because consumers would know that the ‘TSQ Playhouse’ venue does not denote the origin of the entertainment services. If the opponent has any goodwill, it is in its own business, is in the bar services it provides and over which it has quality control, not on services provided incidentally by third parties within its venue.

77. For the sake of completeness, I will also consider what the position would be if, indeed, the opponent owned goodwill in relation to entertainment services provided within its cocktail bar.

¹⁰ *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)

78. In such circumstances the opponent's goodwill would be small and geographically limited to London, where the venue is located. Whilst this is not fatal, because localised goodwill has been held to be sufficient to prevent an applicant from acquiring a national trade mark,¹¹ the opponent's goodwill would be limited to *bar events*, and would not go further to cover entertainment at large. Considered in that context, the word 'PLAYHOUSE' in 'TSQ Playhouse' suddenly acquires an allusive connotation insofar as it will be understood as alluding to a form of entertainment which involves some playing activity (or themed events inspired by characters from theatrical plays such as, as shown in the evidence, Mad Hatter and White Rabbit) as accompanying the drinking experience.

79. Likewise, when considering the contested mark in the context of the applied-for services in class 41, which cover the provision of "*services and venues for entertainment and amusement purposes, other than of a live theatrical, musical and/or cinematic nature; social club services for entertainment and amusement purposes other than of a live theatrical, musical and/or cinematic nature; provision of venues and facilities for playing competitive and non-competitive games, board games, table-top games, amusement arcade games machines and video games machines, all for entertainment and amusement purposes only*", the word 'PLAYHOUSE' will be seen as referring to an element of playing as a characteristic of the entertainment services provided. This is especially so in relation to amusement arcade services (which are either listed in the contested specification or are encompassed by the listed services) which consist of entertainment services provided in an indoor area containing coin-operated game machines where consumers play games. Given that in those scenarios the element 'PLAYHOUSE' is of very low distinctiveness, my conclusion would be that taking into account the low degree of distinctiveness of the shared element in the context of the parties' services (namely the opponent's bar events and the contested services in Class 41) the very small size of the opponent's goodwill, and the differences between the signs at issue, there would be no misrepresentation (or damage).

80. The claim under Section 5(4)(a) fails.

¹¹ *Caspian Pizza Ltd v Shah* [2017] EWCA (Civ) 1874

OUTCOME

81. Subject to appeal, the opposition has been successful in relation to the contested services in class 43 - which will be refused - and has failed in relation to the contested services in class 41 - which will proceed to registration.

COSTS

82. Since each side has achieved a measure of success, I direct that each party bears their own costs.

Dated this 4th day of May 2023

**Teresa Perks
For the Registrar**