

**O-238-11**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2474635  
BY CMP INVESTMENTS PTY LTD  
TO REGISTER THE TRADE MARK**

**QUEST**

**IN CLASSES 16 and 43**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 97848  
BY  
BROOK LEISURE HOLDINGS LIMITED**

## Trade Marks Act 1994

**In the matter of application 2474635  
by CMP Investments Pty Ltd  
to register the trade mark:**

### **QUEST**

**in classes 16 and 43  
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under no 97848  
by Brook Leisure Holdings Limited**

1. An application to register the trade mark QUEST in classes 16 and 43 of the Nice Classification system<sup>1</sup> was made on 10 December 2007. Following publication of the application in the *Trade Marks Journal* on 30 May 2008, Brook Leisure Holdings Limited (“the opponent”) filed notice of opposition. An amendment was made to the class 43 services, which did not dispose of the opposition. The attack is against the entire application which, as it now stands, reads:

*Class 16: Brochures, pamphlets, magazines, booklets, printed publications, including printed advertisements, all relating to hotel and motel services, local attractions, local activities, local facilities, maps, the provision of accommodation, the provision of food and drink; books, all relating to hotel and motel services, local attractions, local activities, local facilities, maps, the provision of accommodation, the provision of food and drink; printed publications, books and manuals, all relating to training services for the operation of hotels and motels; napkins, tray mats, cutlery bags, glass cover bags, toast bags, disposable bags including those for sanitary napkins, toilet paper, paper towels, bath mats, all of or principally of paper; advertisement sheets (printed matter), advertisements paper, advertisement frames, and all other advertising material included in Class 16 all relating to hotel and motel services, local attractions, local activities, local facilities, maps, the provision of accommodation, the provision of food and drink; blotting pads, album and book covers, account books, receipt books, commercial books, namely accommodation registers; office stationery in this class including letterheads, envelopes, desk pads, writing pads, pens, computer programmes in this class; motel and hotel compendiums.*

*Class 43: Services in this class provided for or by motel or hotel owners and/or operators, namely accommodation services, reservation of hotel and motel rooms, booking of cabins, hotel and/or motel management, room hire or leasing.*

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<sup>1</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

2. The opposition is brought under sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (the Act). These sections state:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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.”

3. The opponent relies upon a single earlier registered trade mark:

2355518

QUEST

Class 43: *Nightclub services; café, restaurant and bar services.*

Date filed: 11 February 2004

Date registration procedure completed: 4 March 2005

4. The earlier mark had not been registered for five years or more prior to the date the opposed application was published; consequently, it is not subject to the proof of use regulations<sup>2</sup>. The applicant filed a counterstatement, denying section 5(1) and denying a likelihood of confusion (erroneously referring to section 5(2)(b)) but admitting that the marks are identical. The applicant filed written submissions in lieu of evidence and also written submissions in lieu of a hearing. The opponent did not file anything beyond its notice of opposition and the accompanying brief statement of case. Neither side requested a hearing, both being content for a decision to be made from the papers on file.

#### 5. Section 5(1)

The opponent's statement of case says the following in relation to its section 5(1) objection:

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<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5<sup>th</sup> May 2004.

“3...the Application is identical to the Opponent’s earlier trade mark and is applied for in respect of identical services namely, “cafeteria, cafes, restaurants and/or snack bars, catering management, preparation of meals” which are identical to the Opponent’s café, restaurant and bar services.

4. Registration of the mark would therefore be contrary to Section 5(1) of the Act ”.

These services were originally included in the applicant’s class 43 specification, but were removed by the applicant after the commencement of the opposition. The opponent has not claimed that any of the other services of the applicant are identical to its own services, so the section 5(1) ground consequently falls away. I will consider the opposition solely on the section 5(2)(a) ground. This is pleaded as follows:

“...registration of the mark which is the subject of the Application would be contrary to Section 5(2)(a) of the Act in that the goods covered by the Application are similar to or are associated with the services covered by the Opponent’s earlier trade mark and there is a likelihood that the public making use of the mark which is the subject of the Application on or in relation to any of the goods or services covered by the Application would be confused into believing that they were associated with or connected to the Opponent’s commercial activities and their earlier trade mark.”

## **Decision**

6. As the marks are identical, there is no need to set out the case-law relating to the comparison of marks. In terms of the other factors relevant to likelihood of confusion, I note the well-established principles from the CJEU (Court of Justice of the European Union) in *Sabel BV v Puma AG* [1998] RPC 199 and *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117:

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

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

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

(d) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant.

#### Comparison of goods and services

7. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* where the CJEU stated at paragraph 23 of its judgment:

“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 are complementary.”

The criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 for assessing similarity between goods and services were:

- (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, taking into account how goods/services are classified in trade.

If goods and services fall within the ambit of terms within the competing specification, they are considered to be identical (see *Gérard Meric v Office for Harmonization in the Internal Market (OHIM)*, General Court (“GC”), case T-133/05, at paragraph 29). When considering the coverage of services, I bear in

mind *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16, in which Jacob J<sup>3</sup> held that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

8. The applicant has made submissions on the comparison between the parties' goods and services. The opponent has not provided any submission as to why it considers all of the applicant's goods and services to conflict with its own. In comparing the opponent's *nightclub services; café, restaurant and bar services* with the goods and services of the application, I will look at the applicant's terms individually or in homogenous categories, where convenient<sup>4</sup>.

#### 9. Class 43

The effect of the word “namely” in the applicant's specification is that the services are limited to those which follow the word “namely”; i.e, the services are to be treated as *accommodation services, reservation of hotel and motel rooms, booking of cabins, hotel and/or motel management, room hire or leasing, all provided for or by motel or hotel owners and/or operators*.

10. The applicant has made submissions based on earlier decision BL O/356/09<sup>5</sup>. The applicant in these proceedings relies on a small part of the goods and services comparison in BL O/356/09 as relevant for the purposes of the comparison in these proceedings. It relies upon the finding of no similarity between *arranging, booking and reservation services in hotels, motels, guest houses, and boarding houses* (class 43) and *services providing food and drink* (also class 43) as support for its submission that there is no similarity in this case between its class 43 services and those of the opponent. However, the applicant's submissions only refer to “reservation and booking services” and “arranging a stay in a hotel, motel or cabin”. This represents only a part of its

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<sup>3</sup> Jacob J also said, in *Treat*: “When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade”.

<sup>4</sup> As per the decision of Mr Geoffrey Hobbs Q.C. , sitting as the appointed person, in *Separode Trade Mark* BL O-399-10, with reference to BVBA Management, Training en Consultancy v. Benelux-Merkenbureau [2007] ECR I-1455 at paragraphs [30] to [38]: “The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

<sup>5</sup> Coincidentally, I was the hearing officer for the case.

class 43 specification: *reservation of hotel and motel rooms, booking of cabins*. I will look at this category of services first.

(i) *Reservation of hotel and motel rooms, booking of cabins*.

These services are not of the same nature as the opponent's *nightclub services; café, restaurant and bar services*. They share the same users (the general public), but not the same purpose. The applicant's services are specifically for booking accommodation; the opponent's are nightclubs and restaurants, cafés and bars. They are not in competition and are not complementary in the sense of being indispensable or important for each other in such a way that consumers may think that the responsibility for the production of the goods or the provision of the services lies with the same undertaking, (*Commercy AG v OHIM*, Case T-316/0757, General Court ("GC"), paragraph 57). These services are not similar.

(ii) *Hotel and/or motel management*.

Bearing in mind the advice in *Avnet*, this term is taken to mean the running of a hotel or motel. The users of this service will be professionals in the hotel trade, not the general public. The channels of trade will be different, there is no element of competition between *nightclub services; café, restaurant and bar services* and the services are not complementary. There is no shared purpose. The terms must be confined to the core of their meanings. These services are not similar.

(iii) *Room hire or leasing*.

The users for these services will be the general public. In relation to room hire, there may be a sharing of purpose, depending on what the reason is for hiring a room: it may be to hold a celebration of some sort, where food, drink and entertainment may be required. There is thus an element of competition: the choice may be whether to hire a room or visit a restaurant or nightclub (the applicant provides a definition from Collins English Dictionary for nightclubs as "place[s] of entertainment open until late at night, usually offering drink, a floor show, dancing, etc"). The trade channels may also coincide as restaurants and clubs may hire out a room on the establishment for private functions. There is a moderate level of similarity between *room hire* and *nightclub services; café, restaurant and bar services*. However, the natural meaning of *leasing* is more of a long-term service, without the expectation of food and drink or entertainment. Room leasing does not share nature, purpose, method of use or channels of trade with *nightclub services; café, restaurant and bar services*. Room leasing is not in competition with nor is it complementary to the opponent's services. Room leasing is not similar to the opponent's services.

(iv) *Accommodation services.*

This is the widest of the applicant's terms in class 43. The meaning of accommodation is a place to stay (or live), such as a hotel. Applying the *Avnet* principle, the expectation of accommodation services would be the provision of somewhere to sleep and, in the context of a hotel, there would be an expectation that there would also be the provision of food and drink in the form of a restaurant and/or a bar. This is not stretching the meaning of *accommodation services* beyond its core. Consequently, there is a sharing of users (the general public), methods of use and channels of trade (access via a hotel establishment) and a complementary aspect to the services. These services are reasonably similar.

11. Class 16

(i) *Blotting pads, album and book covers, account books, receipt books, commercial books, namely accommodation registers; office stationery in this class including letterheads, envelopes, desk pads, writing pads, pens.*

These goods are all in the nature of stationery, including the specific office-type stationery of accommodation registers. They do not share nature, purpose, channels of trade, method of use and are not in competition with *nightclub services; café, restaurant and bar services*. The relevant public for the services is the general public and while there are some goods here which are used by the general public, the others are used by office professionals. The goods and services are also not complementary. These goods are not similar to the opponent's services.

(ii) *Computer programmes in this class.*

Computer programmes are used in every part of modern life. This does not make computer programmes similar to the services which use computer programmes to operate (*Commercy*, paragraph 55). Although the users of computer programmes may be the general public, as they are for the opponent's services, computer programmes do not share the same purpose or method of use as for nightclubs, restaurants and bars. They are not in competition and do not share the same channels of trade. In addition, they are not complementary: although a restaurant may use a computer programme, e.g. for taking and processing food and drink orders, the relevant public in such a circumstance will be different (as per *Commercy*, paragraph 58). These goods are not similar to the opponent's services.



(iii) *Disposable bags including those for sanitary napkins, toilet paper, paper towels, bath mats, all of or principally of paper.*

None of these share nature, intended purpose, method of use or channels of trade with the opponent's services. They are not in competition and are not complementary; simply because a nightclub, bar, restaurant or café has toilet facilities does not mean that consumers will think that the responsibility for the production of toilet paper, paper towels and disposable bags for sanitary napkins lies with the same undertaking as that for the nightclub, bar, restaurant or café services. These goods are not similar to the opponent's services.

(iv) *Napkins, tray mats.*

Napkins and tray mats are everyday items which the general public will encounter in restaurants and cafés. In the case of napkins, the users will be the general public; in the case of tray mats, the user may be the bar/restaurant staff or customer carrying a tray. The users are therefore the same, although the nature, purpose and method of use will not be the same. Neither will the channels of trade be the same, as napkins are not bought in restaurants, they are self-service items bought in retail stores. Napkins and tray mats are not in competition with restaurant services. Although it would be unusual to dine in a restaurant without napkins being a part of the table setting, this connection is insufficient to fall within the case law definition of complementary. That there is merely a connection between them does not make them complementary. The use of napkins by diners is a subsidiary activity of dining in a restaurant. The purchasing process for napkins is very different to that for the opponent's services; the average consumer will not assume, when buying QUEST napkins, that they emanate from the undertaking responsible for restaurants and bars of the same name. Tray mats are less frequently used than napkins. Napkins and tray mats are not similar to the opponent's services.

(v) *Cutlery bags, glass cover bags, toast bags.*

These goods all appear to be in the nature of catering items. It is not clear why cutlery bags, glass cover bags and toast bags fall within the parameters of the case law. It has not been my experience in a bar, restaurant or café to encounter cutlery bags, glass cover bags or toast bags. Cutlery bags and glass cover bags strike me as items which the restaurant or bar would use prior to the cutlery being available for use by the customer, but which would be removed before setting the items out for use. There is no explanation which tells me otherwise. Toast bags are possibly bags for cooking toasted items or bags for putting toast in but, again, the term is not explained. The users for cutlery bags, glass cover bags and toast bags will be the restaurant staff or catering service, not the general public. The nature, purpose, method of use, and channels of trade are not shared with the opponent's services. These goods are not in competition with nightclubs, bars, restaurants and cafés, nor are they complementary as

there is a different set of users involved. These goods are not similar to the opponent's services.

(vi) *Printed advertisements, all relating to hotel and motel services, local attractions, local activities, local facilities, maps, the provision of accommodation, the provision of food and drink; advertisement sheets (printed matter), advertisements paper, advertisement frames, and all other advertising material included in Class 16 all relating to hotel and motel services, local attractions, local activities, local facilities, maps, the provision of accommodation, the provision of food and drink.*

Advertisement paper and advertisement frames are not explained but they appear to be media for use in producing (paper) advertisements. They are not advertisements themselves. The users of a nightclub, bar or restaurant will not be the users of materials for producing an advertisement. The nature, methods of use, purpose and channels of trade will not coincide. The opponent's services and advertisement paper and advertisement frames are not substitutable so are not in competition, and they are not complementary. There is no similarity between *advertisements paper, advertisement frames* and the opponent's services. The remaining goods in this category are in the nature of printed advertisements, all relating to hotel and motel services, local attractions, local activities, local facilities, maps, the provision of accommodation and the provision of food and drink. Advertisements are the product of an undertaking providing the service of advertising or providing advertising materials. The nature, users, intended purpose, methods of use and channels of trade of advertisements, being products of an advertising service, are not the same as for nightclubs, restaurants, bars and cafés. Whether the content of the advertisement relates to another service does not make that other service similar to the advertisement, which is tied to advertising services. If this were not the case, then an advertisement would be similar to everything. These goods are not similar to the opponent's services.

(vii) *Brochures, pamphlets, magazines, booklets, printed publications, all relating to hotel and motel services, local attractions, local activities, local facilities, maps, the provision of accommodation, the provision of food and drink; books, all relating to hotel and motel services, local attractions, local activities, local facilities, maps, the provision of accommodation, the provision of food and drink; printed publications, books and manuals, all relating to training services for the operation of hotels and motels; motel and hotel compendiums.*

The nature, intended purpose and methods of use for these goods are obviously different to nightclubs, bars, restaurants and cafés. The channels of trade for the goods will involve a retail store or online retail equivalent. Printed matter is not in competition with the opponent's services. As for advertising matter, the mere fact that the factual content of the printed matter may relate to food and drink does not make it complementary with services which provide food and drink.

Brochures, pamphlets, magazines, booklets and printed publications relating to food and drink are not indispensable or important for the provision of the service of providing food and drink. The goods in this category are not similar to the opponent's services.

12. To re-cap, the applicant's goods and services are not similar to the opponent's services, except for *accommodation services; room hire*, which I have found to be reasonably similar and moderately similar, respectively.

#### Average consumer and the purchasing process

13. The average consumer for the opponent's services, and for most of the applicant's services, is the general public. The cost and type of entertainment, food and drink provided by the terms in its specification vary widely. The level of attention will be neither higher nor lower than the normal level of attention of the average consumer, who is deemed to be reasonably observant and circumspect, but whose level of attention varies according to the category of goods and services. The level of attention of the goods aimed more at the professional consumer will also not be the subject of a high level of attention, although they will involve more than a casual degree of attention in purchase. The applicant's class 16 goods are largely items of self-selection from retail stores, so the purchasing process will be very different to entering and choosing food and drink from an entertainment venue (nightclub) or food and drink establishment, as covered by the opponent's specification.

#### Likelihood of confusion

14. A factor in the global comparison is a consideration of the distinctive character of the opponent's trade mark because the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion<sup>6</sup>. The opponent has filed no evidence so it cannot claim an enhanced level of distinctive character through use. QUEST is a dictionary word meaning a search for something (particularly a long, arduous search). It has no direct or specific relationship to the services and so has a reasonably high level of inherent distinctive character.

15. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). Where there is no similarity of goods or services, there can be no likelihood of confusion<sup>7</sup>. I found no similarity between the opponent's services and any of the applicant's goods. Consequently, I need

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<sup>6</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>7</sup> *Commercy AG v OHIM*, Case T-316/07 and *Waterford Wedgwood plc v OHIM* Case C-398/07.

only assess the likelihood of confusion in relation to the applicant's services for which I found a level of similarity with those of the opponent.

16. The applicant's services for which I found there to be a level of similarity are *accommodation services; room hire*. The trade marks are identical and QUEST has a high level of inherent distinctive character. For the average consumer, paying an average amount of attention during the purchasing process, there are no distinguishing features between the trade marks of the parties to allow differentiation between them, since they are identical. Factoring in the interdependency principle, the identity of the marks together with a reasonable level of similarity between the services will lead to a likelihood of confusion in respect of *accommodation services; room hire*. The opposition succeeds against these services but fails for all the goods and, save for *accommodation services; room hire*, for the remainder of the services.

### **Costs**

17. The applicant has been largely successful in defending this total opposition. It is entitled to an award of costs<sup>8</sup> in respect of its success, offset by the opponent's much smaller measure of success. The opponent did not file anything beyond its notice of opposition and brief statement of case, the content of which was reproduced at the beginning of this decision. The applicant's counterstatement was perfunctory: its submissions supporting the defence were contained in its letter of 26 October 2010 and in its written submissions of 11 May 2011 in lieu of a hearing. The latter was almost entirely a repetition of the former. Consequently, I will make no separate award for the written submissions in lieu of a hearing. I will deduct 10% of what I would have awarded to the applicant in order to take account of the opponent's limited success (I have made the assessment based on the categorization approach to the comparison of goods and services, in which the opponent achieved approximately 10% success). The breakdown of costs is as follows:

Considering the other side's statement and preparing a counterstatement:	£300
Written submissions:	£500
Subtotal	£800
Reduction of 10%	£80
<b>Total:</b>	<b>£720</b>

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<sup>8</sup> As per the scale in Tribunal Practice Notice 4/2007.

18. I order Brook Leisure Holdings Limited to pay CMP Investments Pty Ltd the sum of £720. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 5<sup>th</sup> day of July 2011**

**Judi Pike  
For the Registrar,  
the Comptroller-General**