



How not to confuse your cocktails with your conferences

A review of new conference and cocktail-related trade mark decisions from the EU IPO

The worldwide business-to-business events industry is valued at £30 billion, and 'competition from within the industry' was cited as the second most important issue facing the worldwide exhibition industry in 2018 after the state of the economy.

Protecting the brand of a conference, convention or congress is key to optimising its value, and this can include a range of services and

related products, from cocktail parties to delegate packs.

European trade mark attorney James Cornish of Page White and Farrer has examined the trade mark cases of the EU Intellectual Property Office over the last year and identified 21 lessons that affect brand owners in this (and many other) sectors.

Distinctiveness

1. To be distinctive, EU trade marks for the arranging of conferences should not be a simple combination of words giving information about the services and they need to be an indication of a commercial origin. CONNECT & COLLABORATE was declared devoid of any distinctive character for advice on the business organisation of conferences. [TM: 16885378](#)
2. The EU IPO considers CON to be an abbreviation for convention, such that StyleCon was refused as descriptive and non-distinctive, in having a direct and obvious reference to the nature and subject of the convention being organised. This was despite the fact that Con is more commonly used in the context of sci-fi conventions and STYLE itself seems vague. [TM: 15883648](#).
3. Adding limiting wording to seek to avoid non-distinctiveness objections for conference services can fail, as in BANNER CREATE. Adding limiting wording can emphasise the descriptiveness and the sign could still be understood as informational and descriptive. [TM: 13886551](#)
4. Sometimes registration is possible despite descriptiveness issues for particular goods, but not all. THE ART OF HOTEL LIVING was refused as non-distinctive, an ordinary advertising message and a mere promotional formula for hotel services, but allowed for conducting conferences, despite the fact that conferences occur within hotels. No undertaking should be given a monopoly right to use banal, commonplace, or everyday terms to promote its commercial activities, declared the EU IPO. [TM: 15517576](#).
5. In relation to cocktail lounge services as well as arranging conferences, the EU IPO can be persuaded that it has been over-strict in refusing certain marks for descriptiveness, where the descriptive context and any meaning is vague and indirect. Whilst GENIE may suggest clever or ingenious it was registrable because it is not clear how it describes conference services or what it relates to. Consumers have to engage in a mental process to find a descriptive meaning, such that it has sufficient distinctiveness. This reaffirms that it can be worth contesting objections. [TM: 16456171](#)

6. Brands for cocktail services can also be refused for non-distinctiveness. WEIN FÜR PROFIS & logo, (meaning wine for experts) was said to be a commonplace advertising slogan and it was laudatory. The EU IPO really disliked this trade mark, saying that even if the sign had not had a directly descriptive meaning, it was still not distinctive and they added that, if it had not been descriptive, they would have refused it anyway, as being deceptive. [TM: 15326531](#)
7. A way forward in terms of distinctiveness can be to show **acquired distinctiveness**, but the option needs to be pursued properly and applicants need to supply good evidence. If the applicant files evidence of invitations to conferences, sponsorship of conferences and expenditure on promotion, such evidence can still be rejected, if the EU IPO is not certain whether the expenditure relates to the relevant trade mark and relates to the correct services, as seen in the refusal of KRAJOWJ REJESTR DLUGOW. [TM: 15301328](#).
8. Likewise, the evidence of acquired distinctiveness must relate to the EU, and specifically the EU countries where the mark is non-distinctive. For English terms, this is the UK, Ireland, Malta etc. Evidence of use in the USA and in Italy was not sufficient evidence of acquired distinctiveness for BUSINESS ASSOCIATION ITALY AMERICA for conference services. [TM: 16227365](#).
9. The evidence of acquired distinctiveness must also be sufficient in quality. The evidence must relate to the mark applied for and preferably include evidence of market surveys, Chamber of Commerce statements and promotional expenditure, or it may be refused for conference services, as in THE AMERICAN SOCIETY OF MECHANICAL ENGINEERS [TM: 1195673](#).
10. Quantity of delegates is important too. If the number of conference attendees is too low and there is no evidence of the number from EU states, descriptive marks for conference services can be refused. 500 attendees was declared too low in EUROPEAN FACILITY MANAGEMENT CONFERENCE. [TM: 16071565](#).



Non-use

11. Having acquired a registration for conference services, it might be the subject of a cancellation action for non-use. The EU IPO ignored an invitation for the mark holder for participating in a French conference as proof of use, but was more impressed by their membership of the French Chamber of Commerce. EURO CHINA CAPITAL & logo was cancelled for non-use for conference services. [TM: 968443](#).
12. Interesting cases occur concerning proper reasons for non-use of a trade mark, including for conference services. Such excuses are examined strictly. The reasons cannot simply be the owner's own rules, or its own commercial decisions as to how and when it uses a trade mark. The reasons must relate to external circumstances and have a direct relationship with the mark. MALL OF THE NETHERLANDS & logo was cancelled, in an unusual case concerning the owner's decision not to use its trade mark, which led to its cancellation, including for conference services. [TM: 6833834](#)



Similarity

13. Where your conference services brand is dissimilar, the fact that you have the same conference services as a later applicant will not enable you to win an EU opposition. UKIPO/KIO (stylised). [TM: 15079023](#).
14. Likewise, where the shared element is weak, lost within the later mark, differences can outweigh similarities in oppositions to conference services brands. This is shown in LEADERS & logo and YOUNG LEADERS PROGRAMME & logo. [TM: 14903603](#).
15. Having acquired a registration for conference services, to what extent can you argue that there is a similarity to other goods and services? Clearly, conducting congress is highly similar to organising a conference, as they are of the same nature, same purpose, same public and are provided by the same undertakings, as seen in STRAWBERRY & logo/Strawberry.com trade mark [TM: 15850431](#).



16. At the other extreme, your conference folder is not similar to clothing, bags in class 18 and jewellery items. Different manufacturers, purposes, channels of trade etc prevent there being a similarity. JJ & logo, JJ stylised. [TM: 15675713](#)
17. Organising and conducting conferences is deemed identical to provision of continuing education and seminars, as seen in C&P/ C&R. Interestingly, this was a case involving two brands of intellectual property firms, where the Appeal Board said that the differences between C&P and C&R would be immediately perceptible, due to the high level of attention displayed by consumers of IP services. [TM: 13611314](#)
18. Where there is a registration for specific goods, this does not give its owner the right to object to conference services, simply because a conference could have those goods as its subject matter. The mere possibility that the conference might relate to hearing aids, was not sufficient to establish a similarity with hearing aids in OPTICON (stylised) and OTICON. [TM: 11616687](#).
19. To finish up by looking at cocktail lounge services, it is no surprise that services for providing food and drink are deemed to conflict with cocktail lounge services, cocktail lounge buffets, food and drink catering for cocktail parties, TORO and TORRO GRANDE MEAT IN STYLE. This case also said that hotel services are similar at least to a low degree to organising conference events, due to the same consumers and suppliers often being involved. [TM: 14744452](#)
20. Likewise, cocktail bars are deemed identical to services for providing food and drink, as seen in UTOPIA SOUND (stylised) and UTOPIA GROUP OF CINEMAS, a case which is a useful encouragement when arguing that marks are dissimilar on the basis of figurative elements, different fonts, different extra descriptive and extra weak words. The differences outweighed the similarities. [TM: 14767511](#).



21. Sometimes, the EU IPO seems to go too far in declaring a similarity of goods. Cocktail lounge services were declared similar to a low degree to tea, cakes and pastries because they coincide in the producer and distribution channel and for being complementary. Trade mark CAFFE ROMA/CAFFE ROMA & logo. TM: 16324031

Summary

In summary, a review of EU trade mark case law for organising conferences and cocktail parties demonstrates the same issues and complexities as in most categories of goods. Conference names may be more likely to be descriptive, informational and promotional, and filing evidence of acquired distinctiveness needs to be addressed carefully and relate to the correct trade mark, correct countries where the objection relates and be sufficient in volume and quality.

As you perfect the art of conference living and networking, please ensure that you do not confuse your pastries with your cocktails.

This note is not legal advice and please note that the law and the final outcome of these recent decisions may change.

This briefing is for general information purposes only and should not be used as a substitute for legal advice relating to your particular circumstances. We can discuss specific issues and facts on an individual basis. Please note that the law may have changed since the day this was first published in May 2018.



Prepared by:



James Cornish
Partner

+44 (0)20 7831 7929
james.cornish@pagewhite.com

Bedford House
John Street
London WC1N 2BF