

World Trademark Review Daily

**Casino de Monte-Carlo fails in trademark infringement and passing-off claims
United Kingdom - Burges Salmon LLP**

**Confusion
Passing off**

October 14 2013

Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco (SBM), the owner of the [Casino de Monte-Carlo in Monaco](#) (founded in 1863), brought a claim for trademark infringement and passing off against Anglofile International Limited (AIL), a UK-based company which provided 'fun' casino entertainment (roulette and black-jack tables with no real bets) at weddings, corporate functions and charity events, under the trading name Monte Carlo Casino Entertainment. AIL and its predecessors had been trading in the United Kingdom under this name since 1995. SBM relied on two word marks: MONTE CARLO, registered in 2009, and CASINO DE MONTE-CARLO, registered in 2010.

The case was heard in the Patents County Court (PCC) by Miss Recorder Amanda Michaels, who dismissed SBM's claim on both counts (*Société Anonyme des Bains de Mer et du Cercle des Etrangers à Monaco v Anglofile International Limited, trading as Monte Carlo Casino Entertainment* ([2013] EWPC 38, September 11 2013)).

The trademark infringement case failed for the following reasons:

- Although AIL's trading name was found to be moderately similar to SBM's marks, SBM could not establish a likelihood of confusion - there was no evidence of actual confusion after many years of trade, and the recorder's view was that a consumer of AIL's services would exercise a high degree of attention when booking entertainment for an event, and it is unlikely that a transaction would be conducted without direct interaction between AIL and the client. Therefore, the average consumer would not be confused (this was distinguished from goods purchased over the counter or internet, where the degree of attention exercised by the average consumer would be lower). The context of use of the AIL's trading name was particularly relevant in this case.
- AIL's use of its trading name since 1995 (many years before SBM registered its marks) was honest and had not been without due cause. Therefore, it was not competing unfairly with SBM.

It was also found that AIL could have relied on the 'own name' defence, as it had been using its trading name in accordance with honest practices at all times.

The passing-off claim failed principally because SBM could not establish goodwill in the United Kingdom. Recorder Michaels concluded that SBM's evidence went no further than to show reputation in the United Kingdom, without any 'supporting local business'. The case is therefore a reminder that goodwill and reputation are not the same thing, and a case in passing off will not get off the ground unless a claimant can show evidence of goodwill in the United Kingdom. Further, there was no evidence that instances of deception had occurred, or were likely to occur, after such a lengthy period of trading by both companies.

AIL counterclaimed for invalidity of SBM's word marks, but was unsuccessful. The arguments that (i) Monte Carlo is a geographical name; and (ii) the CASINO DE MONTE-CARLO mark was purely descriptive, were not accepted on the facts.

The case does not establish new law, but is interesting from a procedural perspective, since it highlights the fact that the PCC is actively managing cases to ensure that they remain streamlined (and therefore can be dealt with in a short trial of one to two days). In this case, it was ordered at the case management conference that statements of case should stand as evidence in chief, and permission was given for service of witness statements dealing with five specific issues only.

The case also considered to what extent the parties' pleadings need to identify the legal basis of its arguments (in addition to setting out the facts and arguments that the parties wish to rely on). Recorder Michaels found that, where a party - especially an unrepresented party - had alleged facts which, if proved, would provide a good defence, but had relied on the wrong legal principle, it is in the interests of justice to give effect to that defence. It is questionable, though, whether a court would take the same view in relation to a legally represented party.

Georgina Shaw, Burges Salmon LLP, Bristol

World Trademark Review *Daily*

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.