

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2016188
BY STEPHEN WILLIAM NOCK TO REGISTER A
TRADE MARK IN CLASS 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No 45439 BY PLANET HOLLYWOOD INTERNATIONAL INC
AND PLANET HOLLYWOOD (TROCADERO) L.C.**

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5 **IN THE MATTER OF Application No 2016188**
by Stephen William Nock to register a trade mark
in Class 42

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10 **IN THE MATTER OF Opposition thereto under**
No 45439 by Planet Hollywood International Inc
and Planet Hollywood (Trocadero) L.C.

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BACKGROUND

20 On 31 March 1995, Stephen William Nock of Hastings, East Sussex, applied to register the
words PLANET EARTH as a trade mark in Class 42 in respect of the following services:-

Restaurants, restaurant services, catering services; all included in Class 42.

25 On 20 September 1996 Planet Hollywood International Inc of Orlando, Florida, United States
of America and Planet Hollywood (Trocadero) L.C. of London, filed a Notice of Opposition
to the application for registration. The Grounds of Opposition are in summary:-

30 1. Under the provisions of Section 5(2)(b) of the Act - because the applicants trade
mark is similar to the opponents earlier trade marks (set out in an Annex to this
decision) such that there exists the likelihood of confusion on the part of the public
(including the likelihood of association of the applicants trade mark with those of the
opponents) such that the application should be refused.

35 2. Under the provisions of Section 5(4)(a) of the Act - because having regard to the
extent of the opponents reputation in their trade marks the use by the applicant of their
trade mark is liable to be prevented by virtue of the law of passing off.

The opponents ask for an award of costs in their favour.

40 The applicants filed a counterstatement stating that the statements made in the Notice of
Opposition were not agreed. They too sought an award of costs in their favour.

45 Both sides filed evidence in these proceedings and the matter came to be heard on 29 February
2000 when the applicant represented himself. The opponents were represented by Mr Ian
McKelvey of their trade mark attorneys, Serjeants.

Opponents evidence

5 This consists of an affidavit sworn on 1 July 1997 by Scott E. Johnson, Secretary and Senior Vice President of Planet Hollywood International Inc. He states that the facts contained in the affidavit are either within his own knowledge or are derived from the records of his company.

10 Mr Johnson first of all provides some background on Planet Hollywood Inc and the establishment and operation of the 53 Planet Hollywood restaurants operating around the world in various countries. He goes on to explain that through franchise and company owned operations the company strictly controlled the character and quality of the services provided under the trade mark together with items of merchandise bearing the Planet Hollywood trade mark.

15 The company opened a restaurant in the United Kingdom in London in May 1993 and a further restaurant was opened at Gatwick airport in 1996. Merchandising is of particular importance to the restaurant operation because it provides the opportunity for promotion as well as an important source of income. Thus, items of merchandise bearing the Planet Hollywood trade marks includes t-shirts, shirts, sweatshirts, polo shirts, shorts, jackets and other items of clothing, together with stuffed animals. Such items can be purchased at all Planet Hollywood restaurants including those in the United Kingdom.

25 Mr Johnson goes on to say that the company's promotion policy focuses upon publicity rather than paid media advertisements and Planet Hollywood restaurants are often the venue for higher profile media events, some associated with the film industry. I am given a very large number of press cuttings as examples of this type of promotion. Also, as part of their promotional activities, Mr Johnson says that the restaurants involve themselves with local charities which benefit the communities the restaurants serve.

30 Mr Johnson goes on to provide gross sales figures for the operation as a whole and details of the total number of covers (ie persons having a meal) at the London restaurant. This amounted to 768,000 covers in 1996 and there were 208,000 transactions, ie the number of rings of the register for merchandise. Finally, Mr Johnson provides details of the various trade mark registrations Planet Hollywood International Inc owns in the United Kingdom. He considers that his company has built up a worldwide reputation in its trade marks such that any restaurant or merchandise sold by others using similar trade marks was likely to cause confusion and deception.

Applicants evidence

40 This consists of a Statutory Declaration by Deanne Evelyne Jones dated 5 November 1997. Ms Jones is a trade mark attorney in the firm of Graham Jones & Co who represent the applicant for registration.

45 Ms Jones states that she has had cause to make searches into the use of the word PLANET and she attaches details. These consist of trade marks which consist of the words PLANET or PLANETS, or incorporate these words and which are in respect of registrations falling into Classes 42 and 44 (of Schedule 3) and Classes 30, 33 and 42 (of Schedule 4). All are in the

names of proprietors or applicants other than the opponents. She also provides a list of companies that have the word PLANET as part of their name together with a store guide from Harrods Ltd of Knightsbridge which shows a Planet Harrods restaurant in that store. There are also provided as Exhibits articles from various publications which describe a club called
5 PLANET BIG GIRL in London, a television show called PLANET SHOWBIZ, and a supermarket called PLANET ORGANIC. Ms Jones states that the Trade Marks Registry in its examination report did not cite against this application for registration any of the opponents trade marks. She notes too that the opponents restaurant at Gatwick Airport was opened only after the date the applicant filed his application for registration.

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Opponents evidence in reply

This consists of a further Statutory Declaration by Ian McKelvey dated 20 February 1998. He notes that the details of the other trade marks provided by Ms Jones in respect of trade marks
15 containing or consisting of the word PLANET were all dated March 1995, more than 2½ years prior to the date of her Statutory Declaration. He attaches up-to-date details from the Trade Mark Registry's computer system which he states brings the details up-to-date. In particular he notes that one registration has expired and another has been the subject of part cancellation. That concludes my review of the evidence in this case.

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DECISION

The first opponent Planet Hollywood International Inc is the owner of a number of registrations, nationally and internationally, the second opponent, Planet Hollywood
25 (Trocadero) L.C. is their licensee in the United Kingdom.

The first ground of opposition is based upon Section 5(2) of the Act which states:

5.-(2) A trade mark shall not be registered if because-

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(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,
or

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(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.

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The European Court of Justice has provided guidance for the consideration of matters under this Section of the Act in *Sabel BV v Puma AG (1998 RPC 199 at 224)*, *Canon v MGM (1999 ETMR 1)* and *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV (1999 ETMR 690 at 698)*. It is clear from these cases that:-

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

- 5 (b) the matter must be judged through the eyes of the average consumer, of the goods/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;
- 10 (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 therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;
- 15 (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and services, and vice versa;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;
- 20 (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2);
- 25 (h) but if the association between the marks causes to the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section.

30 In applying the above guidance I take the following into account;

- 35 i) the opponents' trade marks have become highly distinctive through use in respect of restaurant services (but I ignore the opening of their second restaurant at Gatwick Airport which was after the date of application here). Through marketing in its widest sense (press publicity and the sale of souvenir merchandise) they have built up a significant reputation, which extends well beyond the locality in which their restaurant is located;
- 40 ii) use of the term PLANET by those providing the same or similar services as those provided by the parties involved in this case has become quite common. However, as I have no evidence as to how some of the examples provided came to be registered or whether the trade marks which include the term are in use I do not give the fact much weight;
- 45 iii) the trade marks are only similar, in addition to the common element PLANET they each have a different second element (HOLLYWOOD and EARTH);

- iv) the relevant public in this case is the population at large, most of whom eat out and use restaurant services.

5 It seems to me that most people who dine out visit restaurants which have been recommended
to them or whose reputation is known. In this case the opponents' reputation is for a
restaurant named PLANET HOLLYWOOD in London and for restaurants overseas bearing
the same name. That being so I do not consider it likely that the reasonably well informed,
circumspect and observant consumer is going to be confused as to the origin of the services
10 provided under the respective trade marks. The two trade marks are in my view sufficiently
different for that not to happen. The opponents' reputation whilst significant is not such as to
diminish the differences between the two trade marks, or introduce conceptual similarities
which I do not believe are there in the first place.

15 Of course there may be some individuals who, if they saw the applicants' restaurant PLANET
EARTH, may associate it with the applicants PLANET HOLLYWOOD restaurant. But that
is not sufficient to produce a positive finding for the opponents. In my view there is unlikely
to be confusion on the part of the public at large as to the origin of the services provided
under these two trade marks. Thus the opposition under Section 5(2) fails.

20 In view of my findings under Section 5(2) I do not propose to consider in detail the ground of
opposition based upon 5(4) because if the respective trade marks are not confusingly similar
under 5(2) they are no more similar under 5(4). However, the opponents submitted that one
of their earlier trade marks which included the device of a globe, (No. 1483631) could
enhance the likelihood of misrepresentation. This was because the device was often coloured
25 blue, the colour the earth appeared when viewed from space. Therefore when this trade mark
was compared with the applicants' trade mark there was a greater possibility that the public
would see the device of the globe, perceive it to be the earth and therefore associate the
applicants PLANET EARTH trade mark with it. I reject this scenario. I have no evidence as
to how the general public will perceive the trade mark and in the absence of such I am not
30 prepared to go along with the opponents' submissions on the point. There is no more
likelihood of the applicants' trade mark PLANET EARTH being confused with that of the
opponents where it includes, in addition to the words PLANET HOLLYWOOD, the device of
a globe coloured blue. The opposition under Section 5(4) fails also.

35 The applicants are entitled to a contribution towards their costs and I therefore order the
opponents to pay to them the sum of £650. This sum 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.

40 **Dated this 5 day of May 2000**

45 **M KNIGHT**
For the Registrar
The Comptroller General

ANNEX A

The first opponent, Planet Hollywood International, Inc., is the registered proprietor of the following United Kingdom registered trade marks:

5	No.	Mark	Class	Journal	Specification
	1437222	PLANET HOLLYWOOD	42	6031	Restaurant services included in Class 42.
10	1483631		42	5950	Restaurant, bar and night club catering services; all included in class 42.

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	1483634		42	5950	Restaurant, bar and night club catering services; all included in class 42.
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The first opponent additionally has registrations of the words and device of Registration No. 1483631 as follows:

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No.	Class
1481442	09
1481443	16
10 1481445	28
1483629	26
1483630	41

The first opponent additionally has an application for registration of the words and device of Registration No. 1483634 as follows:

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No.	Class
1481438	09
20 1481439	16
1481441	28
1483632	26
1483633	41

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