

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO.2004452
BY NEIL KING
TO REGISTER A TRADE MARK IN CLASS 42**

AND

**IN THE MATTER OF JOINT OPPOSITION THERETO
UNDER NO 43645
BY HARD ROCK INTERNATIONAL PLC AND
HARD ROCK CAFE(LONDON) LTD**

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HARD ROCK INTERNATIONAL PLC AND HARD ROCK CAFE (LONDON)
LTD**

DECISION

15 On 7 December 1994 Neil King of Harrogate applied under the Trade Marks Act 1994 to register the series of two trade marks shown below:-



25 in Class 42 in respect of the following services:

Restaurant, catering, cafe, cafeteria, canteen, bistro and bar services.

30 On 6 December 1995 Hard Rock International plc and Hard Rock Cafe (London) Ltd jointly filed notice of opposition against the application.

35 It is claimed that Hard Rock International plc (hereafter referred to as HRI) is the proprietor of the following earlier trade marks registered in the UK: 989347, 989348, 1096808A, 1172977A, 1172978, 1202260, 1274869, 1275461, 1553699, 1582769, 1582770 and 2013132. (Details of these registrations are given in Annex A of this decision.)

40 It is claimed that the Hard Rock Cafe (London) Limited (hereafter referred to as HRC) is a subsidiary of HRI and operates by the authority of HRI; since June 12 1971 HRC together with its predecessors in trade has continuously operated a restaurant at 150, Old Park Lane, London, W1Y 3LJ and that this restaurant trades under the name Hard Rock Cafe.

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0 It is claimed that the trade marks applied for are similar to the above trade marks which it
is claimed are earlier trade marks and encompass similar services. Also it is claimed that
use of the trade marks in suit is liable to be prevented by virtue of the law of passing off
protecting an unregistered trade mark, namely ROCK CAFE in respect of similar services.
5 It is claimed that HRI is the proprietor of the unregistered trade mark ROCK CAFE, and
enjoys a substantial exclusive reputation therein by virtue of the extent to which it has used
the trade mark.

10 Finally it is claimed that because of the earlier trade marks, both registered and
unregistered, there exists a likelihood of confusion on the part of the public.

The applicants did not file a counterstatement or any evidence in relation to these
proceedings.

15 Neither side wished to be heard in the matter. My decision is therefore based on a careful
reading of the pleadings and the evidence filed in this case.

OPPONENTS' EVIDENCE

20 The evidence of the opponents consists of two statutory declarations.

The first statutory declaration dated 11 December 1995 is by Paul Adam Garland, a trainee
solicitor of Eversheds. Mr. Garland's statutory declaration relates to a survey he conducted
on behalf of the opponents. A copy of the questionnaire that he used in conducting the
survey is exhibited as PAG 1. (A copy of this is attached to the decision as Annex B.)
25 Mr. Garland states that he interviewed people in Oxford Street, London; he selected the
interviewees at random. He states that he chose persons who were between the ages of 16
and 55 approximately and as nearly as possible equally divided between males and
females. The original completed questionnaires are exhibited as PAG 2. Mr. Garland
states that a total of 50 questionnaires were completed and that 7 people referred to the
30 HARD ROCK CAFE in one way or another when questioned. Exhibited as PAG 3 are
selected quotations from the 7 interviewees who referred to the HARD ROCK CAFE.

35 The second statutory declaration dated 10th September 1996 is made by John Eric Crippen
who is the Director of Franchise for the Hard Rock Cafe Group for Rank Organisation plc
which includes Hard Rock International Limited (hereafter referred to as HRIL). Mr.
Crippen has been employed or associated with HRIL and/or its related entities for over 5
years.

40 Mr. Crippen states that the first HARD ROCK CAFE restaurant was established at 150, Old
Park Lane, London on 14 June 1971. He states that since that time the operation has
flourished. He continues by giving a history of the development of the use of the trade
mark and of the subsequent owners of the trade mark. He states that the Rank
Organisation plc is the ultimate owner of the companies using the HARD ROCK CAFE

0 trade mark. The various companies who use the trade mark are stated as being Hard Rock
Cafe Licensing Corporation (HRCLC), Hard Rock Holdings Limited (HRHL), Hard Rock
Limited (HRL) and Hard Rock Cafe International, Inc (HRCII) and HRIL. Mr. Crippen
states that HRCII, under license from HRCLC, either directly or through entities under its
5 control, own and operates 24 HARD ROCK CAFE restaurants in the USA in addition to
one in both the U.S Virgin Islands and Puerto Rico. HRCLC owns, it is stated,
approximately 30 HARD ROCK CAFE trade mark registrations, details of these are
exhibited as JEC 1. Mr. Crippen states that the Rank Organisation plc owns and operates
HARD ROCK CAFE restaurants and stores in Melbourne and Tel Aviv. Mr. Crippen states
10 that HRIL (previously Hard Rock International plc) holds all rights in the trade mark
HARD ROCK CAFE in the United Kingdom, Gibraltar, Fiji and the Turks and Caicos
Islands. He states that HRIL owns approximately 28 HARD ROCK CAFE trade mark
registrations, details of these are exhibited as JEC 2; of these registrations 13 are in the
United Kingdom of which 3 do not include the words HARD ROCK CAFE. HRHL holds
15 all rights in the trade mark HARD ROCK CAFE in Western Europe (excluding the UK and
Greece); the trade mark is used through restaurants and stores in 8 locations in Europe. Mr.
Crippen states that HRHL owns approximately 78 HARD ROCK CAFE trade mark
registrations, details of these are exhibited as JEC 3. Mr. Crippen states that HRL holds all
rights in the trade mark HARD ROCK CAFE in the remainder of the world and that it is
20 used by them in restaurants and stores in 21 locations in 12 countries. HRL he states
owns approximately 272 HARD ROCK CAFE trade mark registrations, details of these are
exhibited as JEC 4. Mr. Crippen states that overall there are approximately 60 HARD
ROCK CAFE restaurants owned and franchised by the Hard Rock Cafe Group; exhibited
as JEC 5 is a list of all the HARD ROCK CAFE locations together with their opening
dates.

25 Mr. Crippen continues in his statutory declaration to describe the standards and style of the
restaurants operating under the trade mark HARD ROCK CAFE. He states that all of the
HARD ROCK CAFE restaurants use the HARD ROCK CAFE trade mark and trading style and
that as the number of restaurants has grown so has the reputation. He goes on to
30 enumerate the various distinctive features of the HARD ROCK CAFE trading style.
Included in these elements are the HARD ROCK CAFE logo which is exhibited as JEC 6
and a memorabilia guide which is exhibited as JEC 7. Mr. Crippen states that the HARD
ROCK CAFE trade mark is used on menus, napkins, order books, receipts, food flags, bags
and matches. A sample menu from the London restaurant is exhibited as JEC 8 and
35 photographs of various HARD ROCK CAFE restaurants throughout the world is exhibited
as JEC 12 and JEC 13. Mr. Crippen states that various merchandise bearing the HARD
ROCK CAFE logo has been sold from the premises, including T-shirts, caps and
sweatshirts, non-precious metal jewelry, key chains, watches, pins and toys. A copy of a
40 photograph of HARD ROCK CAFE key chains, watches and pins is exhibited as JEC 14.

Mr. Crippen states that merchandising is of particular importance and is a substantial
source of income. He states that the Hard Rock Cafe Group has been selling a substantial

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0 range of merchandise since the mid 1970's, including t-shirts, sweatshirts, jackets, bags, hats, watches, sunglasses and pins, all bearing the HARD ROCK CAFE trade mark and logo.

5 Mr. Crippen states that trade mark rights are vital to the merchandising and restaurant operations of the Hard Rock Cafe Group. The first trade mark registrations were issued on 22 March 1977, namely registration nos. 989,347 and 989,348. The trade marks owned by the Hard Rock Cafe Group which consist of the words HARD ROCK CAFE in block letters or of the HARD ROCK CAFE logo have been registered throughout the world in respect of clothing, restaurant services, entertainment services, jewelry, bicycles, paper
10 articles, menus, brochures, food products, etc.

Mr. Crippen states that the Hard Rock Cafe Group has invested approximately the following amounts in promotion and advertising: in 1992 \$2 million; in 1993 \$2.25 million and in 1994 \$2.5 million. He states that the HARD ROCK CAFE name and trade marks
15 are at the heart of the business and that the Hard Rock Cafe Group has gone to great efforts to control how the trade mark is used.

Mr. Crippen states that Hard Rock Cafe Group creates global awareness of the HARD ROCK CAFE name and mark through the four following methods:

- 20
1. Through the press. The HARD ROCK CAFE restaurants are widely written about in the press throughout the world. A press guide about HARD ROCK CAFE is exhibited as JEC 15 and a selection of press clippings as JEC 16. The press clippings begin at least as early as 4 October 1971 with an article published in
25 *Newsweek* magazine.
 2. Through broadcast media, television and radio publicity. Mr. Crippen lists examples of such coverage.
 - 30 3. Hosting of events. Such events include charity parties, sports parties, after-concert parties and backstage catering at concerts and memorabilia presentations.
 4. Through its VIP clientele. Mr. Crippen lists a number of stars who have visited HARD ROCK CAFE establishments.

35 Mr. Crippen states that the Hard Rock Cafe Group has been involved in major concerts and events and he gives a list of a selection of these.

Mr. Crippen states that the World Music Awards Concert was broadcast in approximately
40 eighty countries with the HARD ROCK CAFE logo shown in the credits.

Mr. Crippen states that the total sales figures of Hard Rock Cafe (London) Limited are as follows:

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<u>Date of Accounts</u>	<u>Number of weeks</u>	<u>Total Sales</u>
1987 June 30	52	£5.5m
1988 December 31	78	£11.5m
1989 December 31	52	£10.3m
1990 October 31	43	£9.1m
1991 October 31	52	£9.3m
1992 October 31	52	£11.2m
1993 October 31	52	£11.7m
1994 October 31	52	£12.3m

10 Mr. Crippen states that total sales figures of the HARD ROCK CAFE restaurants worldwide for the year 1987 was \$25million, for the years 1988 to 1990 it exceeded \$50 million for each year and in 1991 and each year after is has exceeded \$100 million. He states that excluding franchise royalties approximately one of half of total sales in made up of merchandise sold at the restaurants, whilst the remainder is derived from restaurant services rendered at the restaurants. Mr. Crippen states that as a result of these activities the opponents have built up a worldwide reputation in HARD ROCK CAFE such that any restaurant or merchandise sold would automatically be presumed to be connected with them.

20 Mr. Crippen states that the net asset value of Hard Rock International Limited as on 31 October 1994 was greater than \$100 million. He states that in 1992 and 1993 the Hard Rock Cafe Group spent over \$10 million developing new restaurants around the world. In 1994 the Hard Rock Cafe Group spent over \$20 million developing new restaurants around the world.

30 Mr. Crippen states that the worldwide reputation and goodwill attached to the HARD ROCK CAFE name and the high quality distinctive trading style is such that franchisees will pay in excess of one million dollars for franchise rights.

35 Mr. Crippen concludes his evidence by referring again to the reputation in the trade mark HARD ROCK CAFE. He states that owing to its international reputation, publications circulated around the world, the registrations and pending trademark and service mark applications in the UK and throughout the world, the presence of foreigners in the UK who are aware of HARD ROCK CAFE and the fact that people residing in the UK have travelled and visited or become aware of many HARD ROCK CAFES throughout the world that HARD ROCK CAFE has an extensive reputation in the UK and that the trade mark HARD ROCK CAFE and the associated trading style in relation to restaurant services have an extensive reputation.

40 This completes my review of the evidence filed in these proceedings.

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0 **DECISION.**

There are two grounds of opposition I will deal with the following ground first:

5 “The use of the Mark applied for is liable to be prevented by virtue of the law of passing off protecting an unregistered Trade Mark, namely ROCK CAFE in respect of similar services. The first Opponent is the proprietor of the unregistered Trade Mark ROCK CAFE, and enjoys a substantial exclusive reputation therein by virtue of the extent to which it has used the Mark.”

10 I consider that this claim is based on Section 5(4)(a) of the Act which 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-

15 (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”

The opponents have stated that they should benefit from this provision of the Act in relation to the unregistered trade mark ROCK CAFE. However, they have filed no evidence in relation to the trade mark ROCK CAFE; nor any evidence that the public at large or any of the relevant traders associate the term ROCK CAFE with the opponents. All of the evidence filed relates to the trade mark HARD ROCK CAFE. Therefore, as no evidence has been filed directly relating to this claim it must fail, the opponents’
20 opposition under Section 5(4)(a) of the Act is dismissed.
25

I go on to consider the opponents’ other ground of opposition. This ground claims:

30 “The Mark applied for is similar to the said earlier Trade Marks and is to be registered for services similar to those for which the earlier Trade Marks are protected.”

Details of the earlier trade marks referred to in the statement of grounds are given in Annex A of this decision.

35 I consider that the above claim is based on Section 5(2)(b) of the Act which states:

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

40 (a)

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0 (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,

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

The term “earlier trade mark” is itself defined in Section 6 of the Act as follows:-

10 “6.-(1) In this Act an “earlier trade mark” means -

- 15 (a) a registered trade mark, international trade mark (UK) or Community
trade mark which has a date of application for registration earlier
than that of the trade mark in question, taking account (where
appropriate) of the priorities claimed in respect of the trade marks,
- (b) a Community trade mark which has a valid claim to seniority from an
earlier registered trade mark or international trade mark (UK), or
- 20 (b) a trade mark which, at the date of application for registration of the
trade mark in question or (where appropriate) of the priority claimed
in respect of the application, was entitled to protection under the
Paris Convention as a well known trade mark.”

25 All of the registrations in the ownership of the opponents are, in my view, earlier rights
under the provisions on Section 6(1)(a). In considering the matter I have regard for the
approach adopted by the European Court of Justice in *Sabel v Puma* 1998 RPC 199. The
Court considered the meaning of Article 4(1)(b) of the Directive (EC Directive 104/89)
which corresponds to Section 5(2) of the Act and stated that:

30 “... it is clear from the tenth recital in the preamble to the Directive that the
appreciation of the likelihood of confusion ‘depends on numerous elements and, in
particular, on the recognition of the trade mark on the market, of the association
which can be made with the used or registered sign, of the degree of similarity
between the trade mark and the sign and between the goods or services identified’.
35 The likelihood of confusion must therefore be appreciated globally, taking into
account all factors relevant to the circumstances of the case.

40 That global appreciation of the visual, aural or conceptual similarity of the marks in
question, must be based on the overall impression given by the marks, bearing in
mind, in particular, their distinctive and dominant components. The wording of
Article 4(1)(b) of the Directive - ‘... there exists a likelihood of confusion on the
part of the public ...’ - shows that the perception of marks in the mind of the

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0 average consumer of the type of goods or services in question plays a decisive role
in the global appreciation of the likelihood of confusion. The average consumer
normally perceives a mark as a whole and does not proceed to analyse its various
details.”

5 Whilst the opponents have a number of registrations consisting of or containing the words
HARD ROCK CAFE it will be convenient to consider the matter on the basis of
registration no. 1582770 for the words HARD ROCK CAFE solus. The registration is for:

10 Restaurant services; cafe services; bar services; preparation of food for
consumption off the premises”.

I consider first of all that there is a clear and direct overlap with all the above services and
the services set out in the application in suit. The services are identical or similar. The
sole issue therefore to be resolved is whether there is a likelihood of confusion between the
15 respective trade marks and that consequent upon this if there exists a likelihood of confusion
on the part of the public, which includes the likelihood of association with the earlier trade
mark.

The trade marks in suit are a series of two. The sole difference between the two marks in
20 the series is that one is in colour. I do not consider that this affects the matter in question
as the same issues are involved and so all comparisons will be against both trade marks.
The trade marks in suit include a stylisation element of the words; this, however, is a minor
element and does not affect the identity of the trade marks. Essentially the trade marks
consist of the words JACK & DANNY’S in large lettering and ROCK CAFÉ in smaller
25 lettering.

The opponents have produced in evidence a statutory declaration by Mr. Garland which
relates to a survey which he conducted. Clearly the survey was conducted to show that the
trade marks of the opponent and those of the application in suit are confusingly similar and
30 that there is a likelihood of confusion or association with the trade marks of the opponents. The
methodology of surveys conducted for trade mark purposes should follow the
guidelines set out in Imperial Group plc v. Philip Morris Ltd (1984) RPC 293

35 “If a survey is to have validity (a) the interviewees must be selected as to represent
a relevant cross section of the public, (b) the size must be statistically significant,
(c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including
the number carried out, how they were conducted, and the totality of the persons
involved, (e) the totality of the answers given must be disclosed and made available to
the defendant, (f) the questions must not be leading nor should they
40 lead the person answering into a field of speculation he would never have
embarked upon had the question not been put, (h) the exact answers and not some
abbreviated form must be recorded, (i) the instructions to the interviewees as to
how to carry out the survey must be disclosed and (j) where answers are coded for
computer input, the coding instructions must be disclosed.”

I consider that the survey fails in relation to points (a) and (b) above. I cannot envisage how a survey conducted in one street in one city in the United Kingdom on one day can be said to represent a cross section of the public. It is also not stated why it was decided to only interview persons between the approximate ages of 16 and 55. If this has a statistical significance this should have been indicated in the evidence. It is also not explained how the interviewer decided that the persons he approached were between and 16 and 55. If this was to be a criteria, logic dictates that one of the first questions in the survey should have been to ask if the interviewee fell into this category. I assume that the interviewer decided that the interviewees were in the relevant age band on the basis of how he perceived them, this is clearly not satisfactory. Further, a sample of fifty persons cannot be considered statistically significant, especially when the survey has been further restricted to one very limited geographical location.

However, even more damaging to the validity of the survey than the above is that it does not represent or relate to the trade marks in suit. The interviewer refers orally to the trade mark. As the ROCK CAFÉ element of the trade marks is in considerably smaller type face than the JACK & DANNY'S element of the trade marks it would have been appropriate for the interviewees to be shown the actual trade marks in suit. Taking into account all these deficiencies I can give no weight at all to the survey or its results.

I go on therefore to consider the matter under the test set out above. I note that the trade marks in suit include the words JACK & DANNY'S as a significant element of the mark, and in doing so that there is no clash between this element of the trade marks and registration no. 1582770. However, *Sabel v Puma* requires me to consider the conceptual similarity between the marks and to consider the matter from the point of view of the average consumer. The ROCK CAFÉ elements of the marks represent the clash between the trade marks in suit and registration 1582770. In registration 1582770 the ROCK CAFÉ element of the trade mark is a very significant element, it is a key element of the identity of the mark. In the trade marks in suit the ROCK CAFÉ element is less dominant but nevertheless a distinctive and clear identifier of significance in the trade marks. In my view the ROCK CAFÉ element of the respective trade marks at issue is one which the public at large will see and take cognisance of and as a result represent a conceptual similarity between them. I can readily envisage that the average consumer familiar with the mark HARD ROCK CAFE would, if they encountered the applicants' trade marks, think they were connected with the trade mark with which they were familiar. This is particularly so in a case such as this where there is a clear evidence that the registered trade mark has been used and known in the market place whereas the trade mark applied for would appear to be an un-used trade mark.

I have for convenience taken registration 1582770 as an exemplum of the matter at issue. However, I also note that in Class 42 the opponents have registrations for the trade marks HARD ROCK CAFE and device (registration no. 1274869) in respect of restaurant, café and bar services and BABY ROCK CAFE (registration no. 1275461) for restaurant services. The specifications of services of these registrations encompass similar or the same services; ROCK CAFE is a common element of all three registrations.

Consequently I consider that in relation to restaurant and similar services that ROCK CAFE when used by the opponents may represent a family of trade marks as defined by Beck Koller 64 RPC 76. Therefore, it adds to the likelihood of confusion on the part of the public and a likelihood of association with the trade marks of the opponents.

In all the circumstances, and in the absence of any response by the applicant to the Notice of Opposition and evidence filed by the opponent I therefore find that the opposition under Section 5(2)(b) succeeds in respect of all the services claimed by the applicants. No order as to costs was sought and none has therefore been made.

Dated this 13th day of October 1998

**M.KNIGHT
For the Registrar
the Comptroller-General.**

Annex A

Trade Mark Registrations Referred to in the Opponents' Statement of Grounds.

Number	Mark	Journal/ Page	Specification and Class
989347	HARD ROCK	5001/ 1198	Class 29. Dairy products and meat products, all for food; and hamburgers.
989348	HARD ROCK	5001/ 1200	Class 30. Ice cream.
1096808A	HARD ROCK	5298/ 512	Class 25. Articles of clothing made from textile materials but not including rights in so far as they extend to the Cayman Islands.
1172977A		5527/ 2116	Class 16. Paper and paper articles; printed matter; except in Grenada and the Cayman Islands.
1172978		5818/ 2082	Class 25. Complete articles of outer clothing.



1202260

5886/ Class 25. Complete articles of
4768 outerclothing.



1274869

5896/ Class 42. Restaurant services; cafe
6278 services; bar services.



1275461 BABY ROCK CAFE

5823/ Class 42. Restaurant services.
2942

1553699

6032/ Class 25. T-shirts, shirts, sweatshirts
4118 polo shirts, sports shirts, jackets,
hats, caps, bolo ties, belts and sun
visors.



582769	HARD ROCK CAFE	6071/ 2511	Class 25. Articles of outer clothing; t-shirts; sweatshirts, polo shirts; sports shirts; jackets; hats; caps bolo ties; belts; sun visors.
1582770	HARD ROCK CAFE	6071/ 2569	Class 42. Restaurant services; cafe services; bar services; preparation of food for consumption off the premises.
2013132		6095/ 8172	Class 14. Watches; ornamental pins. Class 18. Rucksacks, knapsacks, bags supported on shoulder straps or waist - belts. Class 26. Badges; lapel pins.



Annex B

[Hard Rock - Jack & Danny's Rock Cafe]

M/F

QUESTIONNAIRE

1. I am doing some market research. could I take 30 seconds of your time? Yes/No

If no. close interview without taking name and address.

If yes. continue to question 2.

2. Could I have your immediate reaction and first thoughts if I say to you that there was a restaurant in the UK called JACK & DANNY'S ROCK CAFE [Record answer verbatim]

If mentioned HARD ROCK CAFE continue to question 3.

If no mention. close interview.

3. (a) What caused you to refer to HARD ROCK CAFE? [Record answer verbatim]

(b) Anything else?

(c) Is it because you have eaten there?

(d) When did you last eat there?

4. How do you feel about a rock themed restaurant being called JACK & DANNY'S ROCK CAFE? [Record answer verbatim]

5. Would you mind if this questionnaire was used in Court as evidence? Yes/No

6. Would you prepared to be contacted again concerning this survey? Yes/No

7. Could I have your name, address and telephone number? Yes/No

Name:

Address:

Telephone No.:

.....
SIGNATURE INTERVIEWEE

DATE.....

.....
SIGNATURE INTERVIEWER