

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK Application
No. 2125569 to register trade a mark in the name of
Island Leisure SL**

**AND IN THE MATTER OF Opposition
No. 48142 thereto by Anchor International Limited.**

Decision

Island Leisure SL, Apartamentos Laguna Park 1, 5-6 San Eugenio, Adage (Tenerife), Spain applied on 4th March 1997 to register the mark PLANET FOOTBALL for:

‘Disco-pub services; disco and musical entertainment services; all included in Class 41.’

The application is opposed by Anchor International Limited, who give their grounds for opposition as:

‘The opponent is the proprietor of the trade mark PLANET FOOTBALL No. 281246 applied for as a Community Trade Mark for goods and services in International Classes 25 and 42 with an application date of 7 June 1996....The opponent’s mark is an earlier trade mark as defined by s (1)(a) and s 6(2) of the Trade Marks Act 1994.

The applicant’s mark is identical to the opponent’s mark ... and is for similar services. The applicant’s mark therefore offends against s 5(2)(a) of the Trade Marks Act 1994 and should be refused on these grounds.’

In response, the applicants say:

‘It is admitted only that Anchor International Limited .. has applied for the trade mark PLANET FOOTBALL as a Community Trade Mark under No. 281246 in classes 25 and 42 on 7th June 1996. In all other respects the statements and claims made in paragraph 1 of the Opponent’s Statement of Grounds are denied, and Island Leisure SL ... reserves all its rights in respect of paragraph 1 of the said Statement of Grounds.

It is denied that the Opponent’s Community Trade Mark Application is an earlier trade mark as defined by Sections 6(1)(a) and 6(2) of the Trade Marks Act 1994.

All statements and claims made in paragraph 3 in the Opponent’s Statement of Grounds are denied. In particular it is denied that the Opponent’s Community Trade Mark 2181246 and the Applicant’s United Kingdom mark 2125569 are made for similar services, and that the Applicant’s mark should therefore be refused under Section 5(2)(a) of the Trade Marks Act 1994.’

Both parties ask for their costs, but no hearing was requested. No evidence has been submitted, and I have only the *prima facie* case to consider.

The Decision

The only ground is that under s 5(2)(a). This states:

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

(a) it is identical with an earlier mark and is to registered for goods or services similar to those for which the earlier trade mark is protected, or

10 (b) ... ,

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

15 The marks at stake are identical; I will consider the services specified by the parties in a moment; first there is the outstanding issue of the status of the opponents’ mark - they say it is an ‘earlier mark’ for the purposes of the Act under ss 6(1)(a) and (2) and the applicants deny this. These sections state:

20 ‘6.-(1) In this Act an “earlier trade mark” means -

(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,

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(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

30 (c) 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.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.’

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The opponents submitted with their Statement of Grounds filing details of their Community Trade Mark Application. This gives the filing date as 6th June 1996 and specifies the following goods:

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Class 25 ‘Articles of clothing, footwear, headgear’

Class 42 ‘Provision of food and drink, catering services; café, cafeteria, food bar, restaurant, wine bar, public house and inn services’.

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The applicants say in their Counterstatement that this not an earlier mark for the purposes of the Act. This statement is unsupported: the opponents’ application exists and was applied for almost one year before the applicants’ current application. It is an earlier mark by virtue of s 6(1)(a). However, this earlier trade mark has not yet been registered and, under the provisions Section 6(2), this status depends on the mark achieving registration.

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In approaching this matter under s 5(2)(a), I have taken into account the guidance provided by the European Court of Justice (ECJ) 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. Though these cases were primarily concerned with s 5(2)(b), it is clear that the following will also apply to s 5(2)(a) as well:

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

(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;

(c) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and *vice versa*;

(d) 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.

I think that this decision turns on the extent to which the services at stake are similar. Similarity of goods and services has previously been determined by the criteria established by Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] 9 RPC 281. The latter have been confirmed in *Canon*:

‘In assessing the similarity of the goods or services concerned... all the relevant factors relating to those goods or services themselves should be taken into account...includ[ing], *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary..’

To this list, Jacob J included the respective trade channels through which the services are supplied.

The applicants specify ‘Disco-pub services; disco and musical entertainment services; all included in Class 41.’ These are to be compared with the opponents’ Class 42 services: ‘Provision of food and drink, catering services; café, cafeteria, food bar, restaurant, wine bar, public house and inn services’. These activities are certainly not identical. The question as to whether they are similar remains. At first glance, one might conclude that they are not, and that would be the end of the matter. However, the case law summarised above counsels against a ‘piecemeal’ approach to appraising the likelihood of confusion. Rather, it must be ‘appreciated globally, taking account of all relevant factors’, which includes a ‘trade off’ between the similarity of the services, the closeness of the marks at issue and also the distinctiveness of the mark with the earlier right.

It seems to me that the term ‘disco-pub’ is a specification of a type of public house; that is a public house which incorporates a disco. The opponents intend to supply under their mark ‘public house and inn services’. Though it might be argued that pubs are primarily identified with the supply of food and drink, they are also places of entertainment, and are associated with music as well. Further, though ‘disco-pubs’ may be primarily identified with music, they are still pubs, and it would be extremely unlikely if they did not also provide alcohol in

particular and drink in general. Or even food. Though the nature of the services is different, the end users will be the same and the trade channels are identical.

5 It seems to me that the average consumer would draw little distinction between disco-pub services and a pub or inn services as such. There is a similarity between the goods at issue and this leaves me to conclude that the likelihood of confusion is high. In my view, this would also be the case for 'disco and musical entertainment services' which carry the PLANET FOOTBALL mark. In the light of the link between pubs and music - and the fact that the marks are identical and distinctive for the services specified - the average consumer is likely to consider that such services come from the same source as the 'pub services' supplied by Anchor International Limited. The opponents have made their case.

10 Although I have found the opposition to have been successful, under the provisions of Section 6(2) the final outcome is dependant upon the earlier Community trade mark owned by the opponents proceeding to registration. Accordingly, this is a provisional decision, dependant on that occurrence. The opponents are to inform the registry once registration has been achieved, and a supplementary, final decision will be issued at that time. Consequently, I make no order on costs now. Further, the period for appeal will begin from the date of that final decision.

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20 **Dated this 23rd day of August 2000**

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30 **Dr W J Trott
Principal Hearing Officer
For the Registrar
the Comptroller-General**