

**TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO 2135743
BY JIMMY NICKS PROPERTY COMPANY LIMITED
TO REGISTER A TRADE MARK IN CLASS 42**

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
NO 2135743 BY JIMMY NICKS PROPERTY COMPANY LIMITED
TO REGISTER A TRADE MARK IN CLASS 42**

DECISION

Background

On 12 June 1997, Jimmy Nicks Property Company Limited of Highbury House, 149a Balgrayhill Road, Springburn, Glasgow, Scotland, applied under the Trade Marks Act 1994 for registration of the following mark:

PLANET FOOTBALL TRADE DRESS

The trade mark for which protection is sought is the interior of a building for use as a bar, and/or restaurant, and/or nightclub and/or entertainment space having an interior providing the appearance of the interior of a football/soccer stadium with a central area featuring a floor giving the appearance of a football/soccer pitch with goals at either end, an area bordering the central area representative of a spectator viewing area, an entrance into the central area provided by a tunnel with dug-outs/coach seating on either side of the tunnel with sound effects of a football/soccer match with at least one server in the interior having the appearance of a football/soccer ball.

The following specification of services was filed:

“Restaurant, bar, nightclub and catering services and consultancy and advisory services relating thereto”.

Objection was taken against the mark under the following sections of the Act:

3(1)(a): on the ground that the mark consists of a sign which is not represented graphically and;

3(1)(b): on the ground that the mark consists of a sign which is devoid of any distinctive character.

Hearing and decision

5 At a hearing at which the applicant was represented by Ms M Doherty of Cruikshank and Fairweather, the objections were maintained and following refusal of the application under Section 37(4) of the Act, I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to provide a statement of the reasons for my decision.

10 The relevant parts of the Act under which the objections were taken are as follows:

“Section 3(1) The following shall not be registered-

(a): signs which do not satisfy the requirements of section 1(1):

15 (b): trade marks which are devoid of any distinctive character;

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

20 Section 1(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing good or services of one undertaking from those of other undertakings.”

25 No evidence of use was filed in these proceedings therefore I only have the prima facie case to consider.

Section 3(1)(a)

30 At the hearing, Ms Doherty said the application was filed with the above description in order to describe the concept of an establishment with a football theme. A pictorial representation was attached to the application (but did not form part of the application) which gave an impression of what the concept would look like in reality. Ms Doherty added that the design of the restaurant had changed since the application was filed. Ms Doherty, in support of the application,
35 referred to other marks which had been accepted in the past by the Registrar and argued that the applicant’s description was also represented graphically.

I was not persuaded by these arguments and maintained the objection.

40 The Registrar’s practice in relation to acceptable forms of graphical representation is set out in Chapter 5 of The Registry’s Work Manual, at page 18 and is reproduced as follows:

It is the Registrar’s view a sign is graphically represented when:-

45 (a) it is defined with sufficient precision so that infringement rights can be determined;

- (b) the graphical representation can stand in place of the trade mark without the need for supporting samples;
- (c) it is reasonably practicable for persons inspecting the register, or reading the Trade Marks Journal, to understand from the graphical representation what the trade mark is.

5

Firstly, I do not consider the representation in words alone is able to define with sufficient precision in order that infringement rights can be determined. For instance, the size of the pitch is not stated. In reality, football and soccer pitches differ in their sizes depending on the type of game being played or level of competition. The word football refers to various games such as American Football, rugby football, association football etc, all of which have different pitches. In the context of a catering establishment it is impossible to know what is envisaged by the description “a central area featuring a floor giving the appearance of a football/soccer pitch with goals at either end”. The description “an area bordering the central area representative of a spectator view area” is equally vague. Does the spectator viewing area comprise seating or standing room, or both for that matter? It is my opinion that if registered with the description on the application form, serious doubts would arise as to the scope of mark and as a consequence it would not be possible to determine clearly the applicant’s infringement rights.

10

15

20

25

Secondly, can the description provided by the applicant stand in place of the trade mark without the need for supporting samples? In my view it cannot. The relative proportions of the various features of the mark cannot be understood from the description stated on the application. Ms Doherty supplied a supporting sample which comprised a drawing of the concept which is the subject of this application. It was made clear that this did not form part of the mark. From the sample it was possible to gain an insight as to how the totality of the concept looked. But without the drawing it is not possible to understand clearly what the mark is. The description in my view cannot stand in place of the trade mark without a pictorial representation.

30

35

40

Thirdly, it is not reasonably practicable for persons inspecting the register or reading the Trade Marks Journal to understand from the description what the trade mark is. The mark, as I understand it, is meant to represent a simulated appearance (or concept) of a football stadium in the form of a catering establishment inside a building. This establishment includes a bar and/or restaurant, and/or nightclub and/or entertainment space. The appearance of football stadia may vary considerably depending on each individual’s idea and perception and one cannot tell from the description precisely what the mark is intended to convey. For instance a Second or Third Division club stadium may look very different from that of stadium owned by a Scottish or English Premier league club. Grounds in lower divisions allow standing areas whereas all seater stadia are the norm in the English Premier league. It is my view that people viewing the description on the register or seeing it in the Trade Marks Journal are more likely than not to interpret it very differently and have an entirely different conceptions on the composition of the individual elements and overall appearance conveyed by the mark.

45

Ms Doherty said that the purpose of the application was to represent what she described as a “concept” (or as is stated on the application form “trade dress”) and subsequent to the application being made, the design of the concept had changed, but the features in the written description remain unaltered. In my view, the applicants seem to be seeking to register their perceived infringement rights. The Act provides the proprietor of a registered trade mark with rights, in

certain circumstances, to prevent the use of signs which are similar enough to be confused with the applicant's trade mark. However, it is clear from Sections 1(1) and 32(3) of the Act that it is the sign that the applicant actually uses or proposes to use which must be the subject of any application for registration. Any wider rights must be determined by reference to this sign which must be graphically represented.

5

Ms Doherty enquired about amending the mark in order to conform with the Registrar's practice. My view is that in order to turn the description on the application into a graphic representation, any amendment would have to be so substantial as to not be within the scope of Section 39(2) of the Act (amendment of an application).

10

Therefore, I consider the mark does not satisfy Section 3 (1)(a) of the Act in that it is a sign which does not satisfy the requirements of Section 1(1) of the Act.

Section 3(1)(b)

15

Since I have found that the applications fails to meet the requirements of Section 1 of the Act, I do not need to go on to consider the objection under Section 3(1)(b). However, in the event of being found to be wrong under Section 1(1), I will do so.

20

At the hearing, Ms Doherty argued that the applicant's concept ought be capable of being protected from its launch, in order to prevent others from copying it. The concept as described on the application was not devoid of any distinctive character.

25

The mark, as described on the application form, is not in my view *prima facie* distinctive. In British Sugar PLC and James Robertson and Sons Ltd (1996) RPC 281 (referred to as the TREAT decision), Mr Justice Jacob said (page 306, lines 2-13):

30

“Next, is “Treat” within Section 3(1)(b). What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word *inherently* from the old Act but the idea is much the same) devoid of any distinctive character.”

35

Although Mr Justice Jacob was specifically referring to a word mark, he makes it clear that the same considerations apply to other signs and in my view this includes the form of wording used to describe the present application.

40

Theme restaurants, bars and cafes, which relate to a specific topic, including sports, are becoming increasingly common. THE HARD ROCK CAFE, which has the theme of popular rock music and PLANET HOLLYWOOD, which has a movie star theme, are two well known examples. However, for such marks to qualify for registration they either have to either be *prima facie* distinctive or acquire a distinctive character through use. It is my opinion that the applicant's mark is the type of sign falling within the category of marks which have to acquire a distinctive

45

5 character before being able to function as an indication of origin because the public would have to be educated that it was a trade mark and not merely a theme restaurant. Even if the mark was filed on a fresh application and was represented graphically in a manner which left no doubt as to what it intended to convey, I do not think it could ever be registered before acquiring a distinctive character as a result of the use made of it. Further, I think the Registrar would require persuasive evidence that the style of a theme restaurant had come to indicate only the services of one particular trader.

10 Ms Doherty, at the hearing referred to other marks which had been accepted by the Registrar in the past and argued that the applicant's mark ought to be treated on a similar basis.

I am not aware of the circumstances surrounding the acceptance of the marks that Ms Doherty referred to and, in any event, each case must be dealt with on its own merits. Mr Justice Jacob said again in the TREAT decision, page 305, lines 5-12:

15 "In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held that under the old act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see eg MADAME trade mark
20 (1966 RPC 541) and the same must be under the 1994 Act. I disregard the state of the register evidence."

Conclusion

25 The mark is not represented graphically under the terms of Section 1(1) and therefore is debarred from registration under Section 3(1)(a).

30 Furthermore, in the absence of evidence that the mark has acquired a distinctive character by reason of the use made of it, it is debarred from registration under Section 3(1)(b) of the Act.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application, and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(1)(b) of the Act.

35 Dated this 27 day of April 1998

40 Charles Hamilton
For the Registrar
the Comptroller General