

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION **m** 2060607
BY GRAHAM SKINNER
TO REGISTER THE TRADE MARK

PLANETARIAN

AND

IN THE MATTER OF OPPOSITION BY
BY THE TUSSAUDS GROUP LIMITED
THERE TO UNDER OPPOSITION **m** 45596

DECISION

Graham Skinner applied on 9 March 1996 to register the trade mark PLANETARIAN in Class 41:

5 Leisure and recreation services; entertainment services; provision of club facilities and services; provision of the aforesaid as multi-lingual services; provision of the aforesaid as audio-visual services;

and Class 42:

10 Hotel, bar and catering services; cafe, bistro, cafeteria, snack bar and restaurant services; cocktail lounge services; nightclub services.

The application is opposed by Tussauds Group Limited on the following grounds:

- ! s 3(1) as the Applicant's mark is devoid of any distinctive character in relation to services associated in some manner with a planetarium,
- 15 ! s 5(4)(a) in that use of the Mark applied for is liable to be prevented by virtue of the law of passing-off, and
- ! s 3(6) as the conduct of the applicant and/or the nature of the Mark and/or such use as may already have been made of it.

20 The Opponents are owners of the registration listed in the Annex attached to this Decision, which was filed 24 July 1996 (after the Applicant's mark), but registered on 6 March 1998. A counter statement is provided by the Applicants denying the grounds of opposition, but no evidence was submitted in reply. Both Opponents and Applicants ask for their costs. A Hearing took place on 24 November 1998, with Mr Birss of Counsel for the Opponents, instructed by Forrester and Ketley & Co, Trade Mark Attorneys. The Applicant, without explanation, did not appear.

25 The Decision

The first ground of opposition is that the Applicant's mark is devoid of any distinctive character under s 3(1), as 'it has the meaning of any person associated in some manner with a planetarium'. This appears to me to be a reference to ss 3(1)(b)(c) and (d). These state:

'3.- (1) The following shall not be registered:

- 30 (a) ... ,
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bonafide and established practices of the trade:

5 Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) 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.'

No evidence has been produced that demonstrates distinctiveness through use, so the final clause of s 3(1) does not apply. Turning to the remaining clauses under consideration, I have come to the view that the mark PLANETARIAN does fail to pass the requirements they set out. My reasons for this are as follows.

10 First, the striking similarity with the word PLANETARIUM. At the hearing Mr Birss pointed out that both words shared the first nine of eleven letters and emphasised the importance that the beginning of a word has in determining phonetic similarity. He stated: '..if I say the word "planetarium", it is not actually clear whether I have said one word or the other'. S 3(1) is concerned with absolute grounds for refusing the registration of a mark, that is grounds
15 relating to the nature of the mark itself. Such grounds would exist, in my view, under subsection (b), if there was such a similarity between a word and another wholly descriptive word to the extent that confusion was inevitable. In these circumstances the former lacks distinctive character. In other words, the invented word is so close in appearance and pronunciation to the descriptive word that it becomes contaminated by its lack of
20 distinctiveness. I believe this is the case here.

Second, in view of this similarity, I do not consider it unreasonable that consumers who note the difference between the two words will, *prima facie*, consider PLANETARIAN descriptive of activities somehow related to planetaria. Even if they did not know its meaning they would assume it was descriptive and therefore not perceive the word as a trade mark. In view of this
25 conclusion the mark is not registerable under s 3(1)(b).

Third, the evidence provided by the Opponents supports the contention that the word PLANETARIAN is a sign that may serve in trade to designate a characteristic of planetaria, in that 'planetarians' work in or are somehow associated with them (see below). In my view this is enough to refuse registration under s 3(1)(c). The Opponents provide a Statutory
30 Declaration from Mr Undine Concannon, the Archivist of the Tussauds Group Limited. Mr Concannon states that PLANETARIAN is a word commonly used to describe any person associated in some manner with a planetarium of any size or type. This does not appear to be a Dictionary word. However, a trade journal called 'The Planetarian', produced by the International Society of Planetarium Educators, is provided in evidence. Extracts from this
35 journal show the word PLANETARIAN being used descriptively. It is introduced as an invented word in the first issue of the journal in June 1972:

‘PLANETARIAN. As the reader will discover, the word “Planetarian” is not to be found in any dictionary - it has nothing to do with flatworms (sic) or astrology by the way - but is the product of Norman Sperling’s fertile imagination. Because we wanted a journal for all planetarium folk, this new name represents by definition (dictionary publishers please note)
5 any person associated in some manner with a planetarium of any size or type, be he teacher, student, professor, docent, technician, writer, artist, entertainer, guest’

The word is used throughout the text of later copies of the journal, also provided in evidence. A letter from a UK correspondent, reproduced in the December 4 1995 issue, indicates that there is some circulation of the journal in this country.

10 Even after 26 years of publication, the injunction to dictionary publishers given in the definition above does not appear to have met with a response in the UK. However, the evidence suggests that PLANETARIAN is a word that would be recognised by those involved with planetaria, and ‘may’ (s 3(1)(c)) be used by them. There is not enough evidence to refuse
15 registration under s 3(1)(d), which requires ‘customary’ use of a trade term, but the Opposition is successful under sub-section (c), and the Application is therefore refused for goods in class 41 in so far as it relates to planetarium services.

The next ground of opposition is under s 5(4)(a). The Opponents claim that use of the Mark applied for is liable to be prevented by virtue of the law of passing-off.

20 Geoffrey Hobbs QC, acting as the ‘Appointed Person’, summed up the current law under Section 5(4)(a) of the Act in the WILD CHILD¹. He stated that:

‘A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd -v- Borden Inc [1990] RPC 341 and Erven Warnink BV -v- J Townend & Sons (Hull) Ltd
25 [1979] ACT 731 is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- 30
- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
 - (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

¹*Wild child* [1998] 14 RPC, 455.

- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

5 The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off
10 which were not under consideration on the facts before the House"

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that;

15 "To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

20 (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

25 While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

30 (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

35 (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.” ’

This can be summarised under the headings ‘Reputation’ (goodwill), ‘Deception’ and ‘Damage’. Extensive evidence is provided, by the Opponents, relating to the reputation enjoyed by the London Planetarium. This is briefly summarised as follows.

Mr Concannon says that his Company is renowned throughout the United Kingdom for providing the Madame Tussauds Exhibitions including the Chamber of Horrors and the shows and associated merchandising at the London Planetarium. Apparently the main exhibition has been open from 1958 (but for very short periods of refurbishment) and has been continuously referred to as LONDON PLANETARIUM or THE LONDON PLANETARIUM, with distinctive merchandise being sold since the 1960s, including posters, star maps, crockery, clothing, games and stationery.

Mr Concannon refers to the list of goods and service listed in the Annex and gives the value of such goods provided under LONDON PLANETARIUM from 1992 to 1996 (£) as:

Year	Admissions	Shop	Guide books
1992	1,256,000	52,000	63,000
1993	1,448,000	63,000	57,000
1994	1,577,000	60,000	69,000
1995	1,143,000	130,000	56,000
1996	2,115,000	226,000	N/A

He says that the goods and services provided under LONDON PLANETARIUM are advertised and promoted by a number of means including advertising in magazines, bill posters on the London Underground, on local radio, in a large variety of tourist and educational books and directories and on leaflets produced and distributed to hotels (at a cost of approximately £65,000 per annum). Apparently, joint national promotions with publishers or astronomy societies and commercial companies as well as promotions by way of special offers (Safeway Supermarkets, the Sun newspaper and National Express coaches) have also taken place.

Mr Concannon provides information on the total advertising/promotional expenditure for Madame Tussauds, including the London Planetarium. For 1996, for example, this is given as £1,223,000. A number of other exhibits are included in evidence listing advertisements for concerts and corporate entertainment, and information included in school resource packs and trade journals.

Finally, it is implied that the reputation of the London Planetarium is national as a list is also provided showing towns and cities where Mr Concannon's Company has had a presence over the last ten years at trade fairs, conferences or at locations where staff have given talks to local groups, such as astronomy societies and teachers groups.

5 In view of the evidence provided, I am prepared to accept that the Opponents have very significant reputation in the mark LONDON PLANETARIUM for planetarium services, which fall within the classification of goods and service listed in Class 41. I am not convinced, however, that this reputation extends to PLANETARIUM alone. At the Hearing Mr Birss stated:

10 "The London Planetarium uses its name gives more prominence to the word "Planetarium" than to "London". Even in the way that the logo is organised, "London" is smaller than "Planetarium". That is a small point but it should be made.

15 Exhibit UC3 is a brochure with the heading "A Journey Into Space". It begins with a perfectly natural thing for my clients to say: "For most people the high point of a visit to the Planetarium" - with a capital "P" - "is the show that is presented under the copper dome". There is no question that my clients do not just call it "The London Planetarium" but also refer to it as "the Planetarium". It is of course a planetarium. That is why my clients do not have a registration for "Planetarium" but for "The London Planetarium" acquired through use. That does not alter the fact that my clients do refer to their thing and to the services
20 they provide as "the Planetarium", without the reference to London. There are many other instances where the word "Planetarium" appears without "London".

Much the same point is made in evidence by Mr Concannon. It therefore appears key to the Opponents' case under s 5(4)(a) that PLANETARIUM has acquired a secondary meaning as a trade mark of the London Planetarium, as opposed to a description of their services. In my
25 view there is insufficient evidence to support this contention. The promotional literature and other material provided in evidence all refer to the 'London Planetarium' and though 'London' may be in the smaller font in some cases, and there may be references within the text of individual items that refer to 'the Planetarium' this is insufficient to establish that the word PLANETARIUM has come to denote only the services of the Opponents. Given that the
30 services they provide are the provision of a planetarium - which is the name of the building which supplies such services according to the dictionary - I would expect to see much stronger independent evidence than this. It seems to me that the word LONDON is used to distinguish their services from planetaria elsewhere. A person alluding to 'The Planetarium' in London would, in all likelihood, be referring to the Opponents' establishment; but this is very far from
35 certain if the statement was made in Cardiff.

I must conclude, therefore, that the Opponents' reputation have a significant reputation in the mark they have applied to register LONDON PLANETARIUM, but there is no evidence that this extends to PLANETARIUM alone.

40 In his evidence Mr Concannon also states that the reputation the London Planetarium enjoys would extend to the services listed in class 42, for which the Applicant has also requested registration of the PLANETARIAN mark. He says:

‘Whilst my Company has not sought to register LONDON PLANETARIUM/THE LONDON PLANETARIUM in Class 42 there are cafes within the building housing my Company’s Exhibitions including a cafe on the first floor where the ‘space zone’ part of the London Planetarium Exhibition is situated. By virtue of the substantial reputation of my
5 Company in the Mark LONDON PLANETARIUM, I have been advised...that any use of PLANETARIAN in relation to the services covered by the Applications under opposition is liable to be prevented by virtue of the law of passing-off and therefore registration of the Mark applied for by Mr. Skinner offends against the provisions of Section 5(4) (a) of the Trade Marks Act 1994.’

10 Applying the points referred to by the Appointed Person above, I have already determined that the Opponents have a significant reputation in LONDON PLANETARIUM. In my view, this reputation applies to planetarium services, but the evidence that it extends to other services, particularly restaurant services etc. in Class 42, is rather thinner. The London Planetarium do not own restaurants and cafes and those facilities they do operate are merely an adjunct to the
15 main function of providing planetarium services. In the context of the discussion above I find it hard to conclude that the Opponents have any meaningful reputation in the sign PLANETARIUM for this type of services.

Moving on to the issue of deception, in his evidence Mr Concannon refers to a copy of a leaflet produced in evidence from which, he says, it is apparent that the word
20 ‘PLANETARIUM’ is the distinguishing and most dominant feature of his Company’s Trade Mark. He then says that the marks PLANETARIAN and LONDON PLANETARIUM or PLANETARIUM are clearly almost identical (both visually and phonetically) and, in his view ‘..consumers..seeing the Mark PLANETARIAN when used in relation to leisure and recreation services and also entertainment services would associate that Mark with..’ his
25 Company.

Although it is possible (but not proven) that some people in London may equate the word PLANETARIAN with the Opponents’ business, this is likely to be because the Opponents are the only planetarium in London, or at least the only well known one. As pointed out above, this is much less likely to be the case outside the Capital.

30 At the Hearing and Mr Birss referred me to the JIF LEMON², the CAMEL HAIR BELTING³ and SLIP-ON SHOES⁴ cases, and stated:

‘..one could go to court and say, “I have a trade mark that has a descriptive character but I have established that it has acquired distinctiveness as a result of use.” If one could prove that it had acquired distinctiveness as a result of use and that the public, seeing “The Planetarian” would associate it with me, then one would have the right, under the law on
35 passing off, to prevent that being done. That is exactly what is up for consideration here.’

²*Reckitt & Coleman Products Ltd v Borden Inc* [1990] RPC 341.

³*Reddaway v Banham* (1896) AC 199.

⁴*Burberrys v Cording* (1909) 26 RPC 108.

The JIFF LEMON case was decided in favour of the plaintiffs on the basis of overwhelming evidence of acquired distinctiveness. As discussed above, this has not been established here. Further, I find the words of Lord Oliver in that case particularly relevant:

5 ‘The application by a trader to his goods of an accepted trade description or of ordinary
English terms may give rise to confusion. It probably will do so where previously another
trader was the only person in the market dealing in those goods, for a public which knows
only of A will be prone to assume that any similar goods emanate from A. But there can be
no cause of action in passing off simply because there will have been no misrepresentation.
10 So the application to the defendant’s goods of ordinary English terms ... cannot entitle a
plaintiff to relief simply because he has used the same or similar terms as descriptive of his
own goods and has been the only person previously to employ that description.’

15 Though use of a descriptive term does not necessarily defeat a claim for passing off, as the
CAMEL HAIR BELTING case demonstrates, where the evidence shows that the term at issue
(PLANETARIUM) has been used with another distinguishing word (LONDON) a tribunal
should be slow to find that the wholly descriptive word has, by itself, acquired a truly
distinctive character as a trade mark. A case closer to the present one, in my view, is the
McCain’s Oven Chips⁵ case. Here, ‘oven chips’ had, in the words of Templeman LJ, become
‘a name which is apt and appropriate to describe a produce rather than a manufacture’. He
further stated:

20 ‘In the present case.. it seems to me that it is quite impossible for the plaintiffs to establish
that a secondary meaning has been attached to anything other than that which is claimed on
their own packet and what is claimed on their own packet is “McCain oven chips”. I have
no doubt that in the trade, both as regards consumers and retailers, the name “McCain oven
chips” means those oven chips made by the plaintiffs, but the words “oven chips”
25 *simpliciter* never have been used in isolation by the plaintiffs. There has been neither the
opportunity nor the time for people to form the impression that the only makers of oven
chips are and will remain McCain’.

30 There is the obvious difference that ‘oven-chips’ became descriptive, while ‘planetarium’ has
never been anything else but descriptive; however, the point is that both terms are
distinguished by another qualifying word without which the terms are indicative of a product
or service rather than a supplier. I also fail to see how the SLIP-ON SHOES case can help the
Opponents’ case. The following extract - where ‘goods’ or ‘article’ can be replaced by
‘service’ - is pertinent:

35 ‘It is only rarely that an English word primarily descriptive and which has become the name
of a particular article of commerce, can be so distinctive of the goods of a particular
manufacturer that the Court will restrain its use as calculated to deceive where there has
been no actual deception and no intention to take any fraudulent advantage of another by
using the word. It is of course a truism to state that unfair dealing of any sort ought to be

⁵*Mccain International Ltd. V Country Fair Foods Ltd* [1981] 5 RPC 69.

restrained by Courts of Justice, but there is another principle and one equally important, namely, that everybody dealing in an article of commerce is entitled to use any words which are or have become current in the English language as denoting or describing that article provided he can do so without deceiving the public to another's injury. I am speaking of course without reference to Trade Mark legislation. The word "Slip-on" was a known word in the English language long before the Plaintiffs used it at all. Though not in very general use, it was used by a considerable number of tailors and their customers as denoting or describing a coat of a particular cut. Such use has continued to the present time. The word possibly now denotes generally not only the cut but also the material of the article to which it is applied. This is probably in the main due to what the Plaintiffs have done, but it still denotes primarily a particular kind of coat which it is open for any one to make. It is generally associated with the Plaintiff firm, because the Plaintiff firm is by far the most celebrated manufacturer of coats of the sort. If other traders wish to meet the popular demand for the kind of article primarily denoted by the word "Slip-on" they are at liberty to do so, and to grant an Injunction restraining them from using the term by which the article is known, would, unless there is strong evidence that such use would be calculated to deceive by reason of some secondary meaning of the word, be in my opinion an undue interference with trade and tend towards establishing a monopoly. I have come to the conclusion that the evidence of probable deception in this case is not strong enough to warrant my granting the injunction which is asked.'

This last sentence is particularly relevant to this case. There is simply not the evidence available that allows me to conclude that 'planetarium' has the required distinctiveness that would result in deception as to the origin of services purveyed under the banner 'Planetarian'.

Turning now to goods in class 42, in view of the above, it seems even less likely that confusion would occur with these goods and services. At the hearing Mr Birss accepted that class 42 was further away than class 41 from the services the London Planetarium provided, but argued that a cafe or restaurant based in London called 'The Planetarian' could be confused with the London Planetarium. The Opponents have no specific business in this class and I consider that there is little likelihood that use of the mark PLANETARIAN in this way would result in passing off.

Finally, as to the issue of damage, in the light of the above considerations, I do not think they would be above the level of *de minimus*. The Opposition therefore fails under s 5(4)(a).

In reference to bad faith under s 3(6), the final ground of opposition, the Opponents state that they have liaised with Graham Skinner with a view to trying to reach an amicable settlement, but Mr. Skinner was not amenable to settling in the proposed terms and, Mr Concannon states, 'tried to use the existence of his application as a lever to enter into a joint venture'. He adds 'The settlement proposals put forward by my Company would have resulted in the co-existence of Mr. Skinner's and my Company's Trade Marks. His failure to agree to proposals which I believe were fair to both parties causes me to question Mr. Skinner's motives in filing his Application for a Trade Mark virtually identical to my Company's Trade Mark LONDON PLANETARIUM for services conflicting with those for which my Company's Trade Mark has been used for nearly 40 years.' Mr Concannon also says that Mr Skinner admitted during the course of conversations that he has yet to use his Mark.

Section 3(6) of the Act reads as follows:-

‘A trade mark shall not be registered if or to the extent that the application is made in bad faith’

5 The Act does not indicate what is meant by ‘bad faith’ and it must therefore be for the Registrar or the Court to decide in a particular case what this amounts to. However, in the ‘Notes on the Trade Marks Act 1994’⁶ one of the examples given where bad faith might be found is:

‘..where the applicant has no bona fide intention to use the mark..’

10 There is no evidence before me that would make me conclude that Mr Skinner has no intention to use the mark PLANETARIAN. The other contentions made by Mr Concannon should have invited some comment by the Applicant in evidence but, inspite of this, cannot not, in my view, amount to bad faith without further supporting material. I therefore find the Opponents unsuccessful in their opposition under Section 3(6) of the Act.

15 The Opponents have been partially successful in their opposition. As grounds for refusal exist only in respect of planetaria services the application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision, the Applicant files a TM21 restricting the specification as follows:

20 Class 41 - Leisure and recreation services; entertainment services; provision of club facilities and services; provision of the aforesaid as multi-lingual services; provision of the aforesaid as audio-visual services; but not including any such services relating to planetaria.

Class 42 - Hotel, bar and catering services; cafe, bistro, cafeteria, snack bar and restaurant services; cocktail lounge services; nightclub services.

If the Applicant does not file a TM21 restricting the specification as set out above the application will be refused in its entirety.

25 The Opponents are entitled to a contribution towards their costs. I therefore order the Applicant to pay them the sum of £200.00

Dated this 22nd day of January 1999

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

⁶A publication called ‘Notes on the Trade Marks Act 1994’ which was prepared for the use by Parliament during passage of the Bill.

ANNEX: OPPONENTS REGISTRATION

Mark	No.	Filing Date	Classes	
5 LONDON PLANETARIUM/ THE LONDON PLANETARIUM	2,105,955	24.7.96	16, 20, 21, 25, 28 and 41.	<p>Books; printed matter; printed publications; stationery; paper knives; paper weights; writing instruments; pens, pencils, rulers, erasers, pencil sharpeners; pen and pencil holders and cases; colour charts; post cards; photographs; colouring books; sticker books; stickers; note pads; photograph albums; address books; jotters; calendars; diaries; prints; pictures; playing cards; artists' materials; paint boxes; paint brushes; stencils; book markers; instructional and teaching materials.</p> <p>Figurines; statuettes; novelty badges; bins; cushions; fans for personal use; jewellery cases and boxes; mirrors; picture frames; plaques.</p> <p>Household or kitchen utensils and containers; combs and sponges; brushes; candlesticks; ceramic goods; glassware; pottery, chinaware; porcelain and earthenware; bottles; drinking vessels; mugs, cups, glasses; bread boards; cruets; butter dishes; egg timers; money boxes.</p> <p>Articles of outer clothing; shirts; T-shirts, sweatshirts; belts; footwear; headwear; hats.</p> <p>Toys, games and play things; toy archery sets; novelties in the form of souvenirs; puppets.</p> <p>Theme park services; amusement park services; amusement and amusement arcade services; entertainer services; production and presentation of shows and displays; arranging and conducting of exhibitions and lectures; zoological gardens; parks and gardens for recreational purposes; circus entertainment services; training services relating to circus arts.</p>