

O-013-08

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 866236  
IN THE NAME OF  
HOT SHEYT MANAGEMENT & MUSIC PUBLISHING EST.  
OF THE TRADE MARK:**



**IN CLASSES 8, 9, 16, 18, 25, 32, 33, 34, 35, 38, 39, 41 AND 45**

**AND**

**THE OPPOSITION THERETO  
UNDER 71335  
BY PLAYBOY ENTERPRISES INTERNATIONAL, INC.**

## Trade Marks Act 1994

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international registration no. 866236  
in the name of Hot Sheyt Management  
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of the trade mark:**



**in classes 8, 9, 16, 18, 25, 32, 33, 34, 35,  
38, 39, 41 and 45  
and the opposition thereto  
under no. 71335  
by Playboy Enterprises International, Inc.**

### Introduction

1. Hot Sheyt Management & Music Publishing Est., which I will refer to as HS, is the holder of the above international registration. Protection in the United Kingdom is sought from 25 February 2005, claiming a priority date of 20 October 2004 (Switzerland). The request for protection was published in the United Kingdom, for opposition purposes, in *The Trade Marks Journal* on 10 February 2006. Protection is sought in respect of the following goods and services, classified according to the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended:

- Class 8            *Hand-operated hand tools and implements; cutlery (knives, forks and spoons); side arms, other than firearms; razors.*
- Class 9            *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), emergency (life-saving) and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmitting and reproducing sound or images; magnetic recording media, sound recording disks; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing and computer equipment; fire extinguishers.*
- Class 16           *Paper, cardboard and goods made of these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites (except*

*furniture); instructional or teaching material (except apparatus); plastic materials for packaging (not included in other classes); printing type; printing blocks.*

- Class 18 *Leather and imitation leather, goods made of these materials not included in other classes; animal skins and hides; trunks and suitcases; umbrellas, parasols and walking sticks; whips and saddlery.*
- Class 25 *Clothing, footwear, headgear.*
- Class 32 *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.*
- Class 33 *Alcoholic beverages (except beers).*
- Class 34 *Tobacco; smokers' articles; matches.*
- Class 35 *Advertising; business management; business administration; office functions.*
- Class 38 *Telecommunications.*
- Class 39 *Transport; packaging and storage of goods; travel arrangement.*
- Class 41 *Education; training; entertainment; sporting and cultural activities.*
- Class 45 *Personal and social services for organizing and promoting human and/or partner relations; advice concerning emotional and sexual flirting and seduction techniques; security services for the protection of property and individuals.*

2. On 10 May 2006, Playboy Enterprises International, Inc., which I will refer to as PEI, filed a notice of opposition. PEI's opposition is based upon sections 5(2)(b), 5(3), 5(4)(a) and 56 of the Trade Marks Act 1994 (the Act).

3. PEI bases its claims under sections 5(2)(b) and 5(3) on two trade mark registrations, neither of which had been registered for five years or more at the date on which the international registration was published in the *Journal*. There is no requirement therefore to prove use of the marks. The two registrations are:

i) Community Trade Mark Number 60434, filed on 1 April 1996 and registered on 28 October 2004:

PLAYBOY

- Class 3 *Washing and bleaching means, cleaning, polishing, scouring and abrasive means or preparations; bleaching preparations and other substances for laundry use; preparations to clean, polish, degrease and abrade; automotive waxes, polishes and cleaners and bottled and*

*packaged car wash solutions; soaps, scented soap, deodorant (soap), shower gel, shampoo; preparations for cleaning the teeth; dentifrices; perfumeries, perfumes, perfumery; aftershave; eau de toilet; essential oils; cosmetics, beauty products, unmedicated body care and beauty care products, personal care products, body care products, toiletries, toilet preparations, non-medicated toilet preparations, toilet articles as far as not included in other classes; hair lotions, hair care products, preparations for the hair, non-medicinal preparations for the hair, shaving cream; deodorant, deodorants for personal care, deodorant for personal use, anti-perspirants, preparations for preventing underarm wetness (anti-perspirants); nail polish, preparations for removing nail polish; nail varnish and products to take off nail varnish.*

Class 5 *Pharmaceutical, veterinary, and sanitary substances; infants' and invalids' dietetic foods; plasters, material for bandaging; material for stopping teeth, dental wax; disinfectants; preparations for killing weeds and destroying vermin; pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; preparations for destroying vermin; fungicides, herbicides; air fresheners, air freshening and air deodorizing preparations; vitamins and vitamin supplements; medicinal preparations for the hair, medicated cosmetics and deodorants, medicated preparations for the scalp and skin, medicated bath preparations, liquid eye washes, medicated lotions, medicated washes for human use, medicated paper, medicated pads for the eyes, breath freshening preparations, medicated oils and deodorants, medicated toilet preparations, medicated body care preparations and deodorizing preparations (deodorants).*

Class 6 *Common metals and their alloys; metal and metallic building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; iron mongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores; metallic materials for railroads; non-electric metallic cable and threads; metallic locks and hardware; metallic tubes; safe boxes; metallic products not included in other classes; metallic minerals, particularly safety locks (including those for motor vehicles), radiator plaques, auto plaques made from metal; grill emblems; anti-theft door locks; license plate holders; locks, including anti-theft locks for motor cars; key-rings; metal grill emblems; license plate holders of metal; anti-theft door floor; security door locks; strong boxes; keys, key rings, key fobs and key chains; badges and emblems all of common metals, keys (none for typewriters or musical instruments), and key rings, all made of common metal; signs for cars; metal baskets, metal accessories for beds, bells for animals, metal bracelets, metal buckles, leashes for dogs, metal chains, metal coffers, metal boxes, metal frames, decorations (made of metal), metal accessories for doors, door-handles, door wings, metal tiles, metal molds for foundries, metal*

*accessories for furniture, metal plates for identification, metal key-holders, metal padlocks for bags, metal caps for bottles, art works and objects for ornamental purposes in metal (except for bronze); unwrought and partly wrought metals and their alloys; anchors, anvils, bells, rolled and case building materials; rails and other metallic materials for railway tracks; chains (except driving chains for vehicles); cables and wires (non-electric); locksmiths' work; metallic pipes; safes and cash boxes; steel balls, horseshoes; nails and screws, other goods in non-precious metal not included in other classes; frames of metal for car number plates; car signs of metal.*

- Class 8 *Hand-operated tools and implements, hand driven tools and appliances, hand operated appliances, tools; cutlery, cutlery goods, forks and spoons, tableware, swords and foils, razors, safety razors (shavers), razor blades, all kind of razor machines and other shaving articles, cases for shavers and shaving accessories, razors, electric razors, electric shavers; shaving cases with shaving instruments; pocket knives, harpoons, side arms, steel arms and other cutting instruments, including hides for their hand sharpening; all goods.*
- Class 9 *Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines and data processing equipment; fire-extinguishing apparatus, particularly spectacle glasses, including anti-dazzle spectacles, safety goggles, sunglasses, motorcycle and sport glasses; spectacle frames, spectacle cases; spectacles, motorcycle and ski goggles and glasses for use with different sorts of sport; optical frames; optical glasses; goggles, visors (for protection of the eyes); opticals, ophthalmic frames; magnifying glasses; scuba diving goggles; cases for these glasses; diving goggles; thermometers, thermometers for car engines, speedometers, compasses, temperature measuring and regulating instruments for motor vehicles, temperature gauges for motor cars, tire gauges, tire pressure counters, mileage counters, mileage minders; apparatus and instruments, all for measuring or recording temperature, pressure or distance, all for use in connection with motor vehicles; cigar and cigarette lighters, all for motor vehicles; all included in class 9; compact-disc read only memories (CD-ROMs), compact-disks; tapes and discs, all for information storage; optical data carriers; laser discs and laser tapes; parts and fittings for all the aforesaid goods; all included in class 9; information storage discs and tapes; CD-ROM products; apparatus for recording, transmission and reproductions of sound, picture, and images; apparatus for recording and reproducing sound; magnetic recording carriers; cassette tapes and compact discs for sound recordings; discs and tapes, all for or bearing sound and/or video recordings; records, discs and tapes, all for recording and reproducing sound and images;*

*cassette tapes and compact discs for sound recordings; records and tapes for recording and reproducing sound; phonographic, cinematographic and television apparatus; recorders, radio apparatus, television apparatus, photographic and cinematographic films, cinematographic images; television equipment, video equipment, radios, phonograph record equipment; cameras, movie cameras; gramophones, radio gramophones and record players, video recorders, recorded and unrecorded sound carriers, pre-recorded video discs, sound and video cassettes and tapes; phonograph records, phonograph discs, phonographic, mechanically grooved discs, recording discs, recording tapes, tape cassettes, magnetic tapes, records and tapes, tape records, music records, films, sound films, cassettes, video tapes and cassettes, video discs, laser discs; sound and video recordings, all in the form of records, discs or tapes, and cassettes and holders all adapted for use therewith; telephones and telephone answering machines; computers, computer software programs, computer-game equipment, computer programs, computer software and computer games; discs, diskettes and tapes all for use with computers; and cassettes and holders; all adapted for use with the aforesaid goods; computer mouse pads, screen savers; data processing equipment, data processing and transferring devices and equipment whose parts and accessories are not included in other classes, data input and output apparatus; (computer) processing, central processing units; peripheral devices for data processing installations, including printers and their parts, keyboards for (data) inputting, indicator instruments, television (computer) screens, magnetic tape recorders, floppy and hard disk drives, software, programmed and unprogrammed data recording devices; data carriers provided with programs; tire pressure measuring instruments; temperature gauges.*

Class 10      *Condoms, contraceptives, means or contraception, marital aids; sexual aids and appliances, parts and fittings therefore; surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth, orthopedic articles; suture materials.*

Class 11      *Headlights and taillights for motor vehicles; reflectors; reflectors included in class 11 for motor vehicles; apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, including head lamps for automobiles; reflectors (auto accessories).*

Class 12      *Automobile seat covers, seat covers for motor vehicles; vehicle seat covers; car seat covers, seat covers for cars; motor car accessories, included in this class, including gear shift knobs, dash trays; automotive goods not included in other classes; mirrors for automobiles, rearview mirrors and mirrors for inside the vehicle; gear-lever buttons, rubber cushions for motor vehicle doors, inside motor vehicle equipment for storage or fastening of objects; door guards; visor organizers; ash trays; steering wheels, covers for spare wheels; parts and fittings included in class 12 for vehicles; vehicles;*

*apparatus for locomotion by land, air or water; automobile parts and accessories as far as not included in other classes; boats, automobiles and boat trailers; land, air, water, and maritime locomotion apparatuses, their parts and accessories, including; covers, coatings, and tapestry for said vehicles; gearsticks, visors and instrument boards, all auto accessories.*

Class 14 *Horological instruments, watches, chronometric instruments, clocks, clock and watch making articles in general; jewelry, jewelry made of gold and of silver, including sterling silver, jewelry made of precious metal or coated therewith; jewelry (precious and non-precious metals and other materials); jewelry of non-precious metals; costume jewelry; imitation jewelry and parts and fittings for all the aforesaid goods; cuff links, tie tacks, earrings, necklaces, bracelets, pins, ornaments, dress accessories (brooches, buttons); key rings made of precious metals; key rings, key chains, grill emblem; precious stones, valuable stones; precious metals and their alloys and goods in such materials; precious metals and their alloys and goods in precious metals or coated therewith; articles included in class 14 made of precious metals or coated therewith; precious metals and their alloys and goods made out of said materials or plated; precious metals and their alloys as well as decorations made from or plated with them; paperweights, letter openers, writing instruments, all these goods made of precious metals and their alloys; all goods; watches for scuba divers.*

Class 15 *Musical instruments and their accessories.*

Class 16 *Magazines, monthly magazines, photographic and printed matter, print matter, printed publications, periodicals, periodical publications, printed periodical publications, newspapers, books, trading cards; cd-rom manuals; printed computer programs; picture postcards, photographs, photographic products, playing cards, sheet music, printed music in sheet or book form, printed music, greeting cards, vow cards; stick-on decals, plastic stick-on decals, plastic stickers, decalcomanias, stick on and press on transfers made from synthetics; litter bags, garbage bags, garbage and litter bags of paper or of plastics; stationery, stationery items, address and telephone books, notebooks, journals, folios, calendars, appointment books, memo pads, diaries, envelopes, paper articles for stationery use; trays for arranging and counting money; non-magnetic identification cards; desk accessories, writing and drawing implements, all writing material and instruments (pencils, engineer's pencils, ball pens, pens); pencil cases; writing instruments and paper weights; desk sets and desk accessories (metal writing instruments, letter openers, paper weights, pencil holders and leather desk pads); pens, ball point pens and other accessories, apparatus, devices and articles for writing; pens in non-precious metal, desk sets in non-precious metal, office articles including desk accessories in non-precious metal; paper napkins, paper articles included in class 16; mats for beer glasses, cocktail mats of paper or of cardboard, cocktail napkins, clips for currency*

*notes; advertising material relevant to the management and lease of catering and related establishments, booking offices for hotels and sports events, publishing companies, agencies and sound recording studios; advertising material relating to managing, hiring and leasing hotels, restaurants and cafes and like activities, agencies for hotel and sporting event reservations, publishing firms, agencies for performers, models and mannequins and studios for sound recording; marketing material; paper goods, artists' and sculptures' materials; paper, cardboard and goods made from these materials, not included in other classes; bookbinding material; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters, instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; including non-electrical office machines (included in this class), instructional materials consisting of printed materials or in game form; articles of paper or of cardboard; pouches and bags made of synthetics; sound carriers on paper basis, paper and cardboard goods, office requisites, printing products, signs, type, printing blocks and objects d'art; paperweights, letter openers, writing instruments, all these goods made of unprecious metals and their alloys; coin trays; book covers; writing cases; binder portfolios with a ring-shape formed binding mechanism (so-called ring-binders); pocket secretaries.*

Class 18

*Leather and imitation leather, articles made of these materials, skins and hides, leather goods; leather and imitations of leather, and goods made of these materials, goods made of leather or imitation leather; articles made from leather or imitation leather; saddlers' and bagmakers' goods of leather and imitation leather; animal skins, hides; trunks and travelling bags, umbrellas, parasols and walking sticks, leather articles, leather accessories, suitcases, handbags, belts, leather letter cases, brief cases, key cases, billfolds, leather purses, leather key chains, paper cases, sport bags, briefcases, drivers license card cases, license card cases, purses, card cases, wallets, purses, handbags, money folds, portfolios, zippered portfolios, bags, cases; whips, harness and saddlery.*

Class 20

*Goods not included in other classes made out of wood, cork, reed, cane, wicker, rushes, willow, horn, bone, ivory, whalebone, tortiseshell, amber, mother of pearl, meerschaum, and other imitation materials or synthetics; waste baskets for attaching in motor vehicles; plastic motor car accessories, included in this class, including grill emblems, coin trays and trays for maps, guides and wallets; license plate holders; cushions, including car seat cushions; furniture, mirrors, picture frames; goods made of shell, substitutes for all these materials, or of plastics, including coin trays; decorative wall plaques and household mirrors; trays; baskets; ornaments; sculptures; badges for motor vehicles; pillows, mattresses; key rings; vehicle number plates and holders therefor; ornaments, sculptures, and non-metallic key rings; visor mirrors; shaving mirrors; frames for car number*

*plates; car signs; plastic cases for coins; shaving sets consisting of mirrors.*

Class 21 *Drinking glasses; mugs; ceramic mugs, tankards (non-metallic), ice pails, alcohol flasks, alcohol decanters, cocktail glasses, dishes, tableware, glassware, porcelain and earthenware; china and crockery; goods of glass, stoneware; grooming accessories including hair brushes, haircombs, shaving brush holders; men's grooming accessories; men's grooming articles such as shaving brushes, toothbrushes and stands; men's grooming accessories (boxes-stands) and similar items; toilet articles as far as not included in other classes; implements and containers for household and kitchen uses; small domestic utensils and containers; household or kitchen utensils and containers; devices and containers for household or kitchen; small household and kitchen implements; small domestic and kitchen utensils; portable receptacles for the household and kitchen; baskets, bins, boxes, buckets, cans and receptacles, all for litter or refuse; cleaning utensils and materials, instruments and material for cleaning purposes; articles for cleaning purposes; cleaning materials; steel wool; metallic and steel scrubbers; non-electric cleaning brushes for domestic use; combs, sponges and brushes; brushmaking materials, materials for brush manufacturing; unworked or partially worked glass; semi-worked glass (except glass used in building); rough or partially worked glass (except glass used for building materials).*

Class 23 *Yarns and threads, for textile use.*

Class 26 *Lace and embroidery, ribbons and braid, buttons, hooks and eyes, pins and needles; artificial flowers, trinkets (not of precious metal or coated therewith) for personal wear, decorative fabric patches being textile smallwares, and badges for wear (not of precious metal or coated therewith); dress accessories (brooches, buttons).*

Class 27 *Carpets, rugs, mats, door mats, matting, linoleum and other floor coverings; coverings for existing floors; other materials for covering floors; other materials for covering existing floors; floor coverings made of synthetic or textile materials; wall coverings, wallpaper, wall hangings (non-textile), non-textile wall coverings, wall upholstery not made of textile stuffs.*

Class 28 *Games and playthings, gymnastic and sport articles, sports goods; ornaments and decorations for Christmas trees; dolls, doll's clothing and accessories for dolls, playblocks, toys, stuffed toys, toy animals and puppets, puzzles, jigsaw puzzles, toy airplanes, stuffed animals; sporting goods, namely golf and tennis articles; equipment for tennis, skiing, skating, golf and wind-surfing, golf balls, golf bags, club covers, golf clubs, golf club head covers, golf tees, golf putters and head covers therefore, golf bag covers, head covers, tennis raquets and racquet covers, frisbees, balls, flippers, snorkle, diving items, dive boards and water-skis, surf boards and boards for watersking, fishing*

*implements; apparatus for playing the games of billiards, snooker, or pool; parts and fittings for all the aforesaid goods; equipment for billiards and billiard halls, especially cues, billiard balls, cue-carriers.*

- Class 29 *Meat and fish, meat extracts, preserved meat and fish, poultry, game; preserved, dried and cooked fruit and vegetables; eggs, milk, butter, cheese, potted cheese, margarine, cooking oil, edible oils and fat, jellies, jams, fruit sauces; milk products; pickles.*
- Class 30 *Confectionery items, chocolate and chocolates; non-medicated confectionery containing or flavored with chocolate; non-medicated confectionery; coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard, vinegar, sauces (condiments); spices; ice; salad dressings.*
- Class 31 *Agricultural, horticultural and forestry products, and grains not included in other classes, living animals, fresh fruits and vegetables, seeds, natural plants and flowers, food-stuffs for animals, malt; meal for forage and biscuits for animals, but not including biscuits coated with or containing chocolate.*
- Class 32 *Beers, mineral water, non-alcoholic beverages, mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.*
- Class 33 *Alcoholic beverages, particularly wines, spirits and liquors; mixed drinks with wine or spirit bases.*
- Class 34 *Manufactured tobacco; tobacco, raw or manufactured; tobacco whether manufactured or unmanufactured; cigarettes, cigars, smoke for pipe; smokers' articles, ash trays, ash trays, not of precious metals; tobacco pouches, snuff-boxes, containers for tobacco, cigar and cigarette holders and cases, tobacco pipes, smoking pipes, pipe and cigarette filters, pipe tamper, articles for cleaning pipes, and cigar lighters, matches, cigarette lighters, lighters for smoking; cases for cigarettes and cigarette lighters; cigar boxes, cigarette boxes.*
- Class 35 *Advertising and business services, employment agency; business consultancy (control, direction, inspection and supervision); directories; press agency (publicity); distribution of leaflets, distribution of samples, renting of advertising material, help with industrial or business contracts, business advice, creating business statistics, business information, business administration, stenotype, bookkeeping, copying, renting machines for writing; journal subscription; subscription of books, magazines, and printed matter in general; professional consultants regarding conducting business.*
- Class 36 *Insurance services; debit telephone card services.*

- Class 38 *Telecommunication, telecommunications services; broadcasting of television programs such as pay television and cable television; broadcasting of television programs via cable and pay television; broadcasting of television programs by cable and on behalf of subscribers; communications, including serial television and video broadcasting; communications, all services including cable, satellite, pay and free television and video broadcasting; communication services; press agencies and news bureaus; radio, telegraph or telephonic communications; teleprinting, transmission of messages; telegrams; audiotext services.*
- Class 39 *Transportation; travel agency services, travel tour arrangement, escorting of travellers, hire of airplanes, airline services, airport services, air transport services; distribution (transport) of books, magazines, and printed matter in general.*
- Class 40 *Dressmaking; bookbinding.*
- Class 41 *Education and entertainment; entertainment and amusement, such as by pay television and cable television; recreation and amusement via pay television and cable television; production of films and videos; rent of videotapes; production and rental of films and videotapes; production and rental of cinefilms and of videos; production of radio and television programs; production of tv and video programs; radio, television and stage entertainments; the production of stage shows; the organization, production and assembling of all kind of entertainment centers, shows, including theatrical and variety shows, films, television, song and dance, sound recordings and lease of those programs and shows of all kind of films and sound recordings; provision of live music entertainments; production of shows for cable, satellite, pay and free television, entertainment services, pay television services, pay per view television services; theater decorations; cabaret, nightclub and club services; musical and choral entertainment and shows; entertainment with musical and vocal presentations and shows; amusement center services; cabaret and nightclub services rendered by vocal and/or instrumental groups; casino services; gaming services; music concert services; operating establishments which feature entertainment and performances; publication of reviews and books; agencies for artists (performers), models and mannequins; instructing dancers, singers, actors, models and mannequins; model studios; book editing, revues, preparing books; educational and entertainment services and in particular those connected with the publication and lending of books, magazines, and printed matter in general, the supply of recreation and sport facilities; the provision of recreation and sporting facilities; offering of recreation and sport facilities; provision of recreation and of sport facilities; instruction; art schools and artists agencies, providing of training; entertainment; sporting and cultural activities; recreation and amusement, amusement arcade and amusement park services, recreational, entertainment and amusement services; services of recreation, entertainment and*

*amusement; audiotext services; training of animals; exploitation of casinos; provision of and hiring out of sporting grounds.*

Class 42 *Hotel reservation, hotel and tourist accommodation services; exploitation of hotels and clubs (food and drink); hotel services; lodging and boarding of guests; operating establishments which feature food and drink; exploitation of restaurants, cafes, cafeterias and snack bars; facilities for eating and drinking; hotel, club (food and drink), restaurant, cafe, bar, cafeteria and snack-bar services; social club (provision of accommodation and food), restaurant, cafe, cafeteria, drinks bar, restaurant business, restaurants; hairdressing and beauty salons; keeping and hiring out of saunas and baths; rest and convalescent homes, nurseries, funerals, crematoriums, professional consultants regarding prospectors, drilling, industrial research, laboratories, rental of equipment for agricultural cultivation/services, rental of automatic distribution machines, legal services; computer services, namely providing access to on-line magazines in the field of fashion, entertainment, health, lifestyle and other topics of general interest; interior decoration.*

ii) United Kingdom Trade Mark Number 2324198, filed on 19 February 2003 and registered on 15 August 2003:

PLAYBOY

Class 25 *Articles of clothing, headgear, footwear, belts.*

4. Under section 5(2)(b), PEI states that the marks PLAYBOY and PLAYBOYSKOOL & Device are similar and that their use on identical or similar goods will lead to a likelihood of confusion occurring and that consumers will associate HS's mark with PEI's mark. PEI claims that the PLAYBOY mark is well known by virtue of its extensive use in the UK since 1953, in particular to adult entertainment goods and services, including printed publications, videos, DVDs and a television channel, as well as various items of merchandising, including clothing, jewellery and homeware.

5. Under section 5(3), PEI claims a reputation in the UK, as detailed above, and further states that HS's specification in Class 45 specifically relates to the areas of partner relations, sexual flirtation and seduction techniques and claims that these are areas in which the reputation of the opponent's PLAYBOY mark is highly relevant. PEI claims that the international registration would be without due cause and would take unfair advantage of and be detrimental to the distinctive character of its earlier PLAYBOY mark. PEI states that that its adult entertainment material is less sexually explicit than much of the other adult material available in the UK. Consumers may be disappointed by the quality of HS's goods and offended by their explicitness.

6. The opponent seeks refusal of protection in the United Kingdom under section 5(4)(a) of the Act because it has goodwill in PLAYBOY in the UK and the holder's registration would constitute a misrepresentation, resulting in damage to the

opponent's goodwill. PEI also seeks relief under section 56 of the Act, claiming that PLAYBOY has acquired the status of a well-known mark, within the meaning of the Paris Convention and the TRIPS Agreement, in relation to at least goods and services for the adult entertainment market.

7. PEI requests total refusal of protection in the United Kingdom of the international registration and an award of costs in its favour.

8. HS filed a counterstatement. It denies that PEI's PLAYBOY marks have acquired an extensive reputation in all the goods and services covered by the two earlier marks relied upon for the purposes of section 5(2)(b) of the Act. HS denies that its services in Class 45 relate to the goods and services of the opponent's registrations. It denies any visual, phonetic or conceptual similarity between the marks. As for section 5(3), HS denies that PLAYBOY has acquired a reputation in the field of adult entertainment such that it could prevent a younger mark with the element 'Playboy' from obtaining registration. Under section 5(4)(a), HS denies PEI's mark has a reputation for clothing, jewellery, watches, fashion accessories or homeware. In relation to section 56, HS says that the opponent's PLAYBOY mark may be known in relation to magazines and Class 16 goods, but that it is not well known for all kinds of goods and services in all the different classes. HS requests that the opposition be dismissed and that PEI bears the full costs of the proceedings.

9. Only PEI filed evidence. The parties were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing. PEI filed written submissions, some of which was repetition from its statement of case. HS filed the briefest of statements as formal written submissions, although its counterstatement contained several pages of submissions in relation to likelihood of confusion between the respective marks.

## **Evidence**

10. The evidence consists of two witness statements by Judy Kawal (the second statement is a supplement to the first). Ms Kawal is the Senior Director of Business Management at Playboy Enterprises International, Inc., a position she has held for over eleven years. Included in her evidence are twenty-six exhibits, numbering in excess of six hundred pages. The evidence suffers from several flaws, not least that the turnover figures in the witness statement (although large) are given entirely in US dollars, with no indication as to what, if any, proportion of that turnover was generated in the UK and with no particularisation as to turnover for areas of business, let alone specific goods or services. They are worldwide figures. The evidence of Ms Kawal gives no turnover figures in relation to use in the European Union, which is significant in relation to the claim of reputation in PEI's Community trade mark registration. Much of the exhibited material is undated; there are exhibits where it is impossible to discern any trade mark due to the poor quality of reproduction; a large proportion of exhibits refer to a rabbit-head logo rather than the word mark PLAYBOY; and there is a volume of material which does not appear to bear any relevance to use of the trade mark in the UK or the European Union. I assume it has been filed in support of the opponent's claim under Section 56 of the Act. None of the evidence has been highlighted to direct me in particular to UK (or EU) use.

11. Ms Kawal states that PLAYBOY is the name of a world famous printed publication, first published in the United States in 1953. The PLAYBOY brand has branched out into “many other areas”; including operation and distribution of global PLAYBOY television and radio networks and programming; operation of a website *Playboy.com*; the sale of videos and DVDs and the licensing of the PLAYBOY mark internationally for a range of consumer products and services. Exhibit JK1 is a corporate overview of PEI. It gives US market and some very general worldwide market information about the company. There is a single mention of the United Kingdom, where it says that “Playboy is now offering wireless entertainment services through licensees in 30 territories around the globe including Germany, the United Kingdom, Australia, France, Italy and Brazil”. There is no indication of when the service commenced in the UK and I note that the exhibit is a copy of a print from a website, the print being dated 3 July 2006. There are links to press releases on the first page, all dated within 2006. This is after the relevant date.

12. Exhibit JK2 is a booklet aimed at advertisers about the PLAYBOY brand. It is undated, so tells me nothing about the position at or before the relevant date, and it refers to US and global use of PLAYBOY. It is unclear whether the references to PLAYBOY are in respect of the company, the mark or both. Again, there is scant reference to the UK, this time in respect of the company’s operation of “Playboy Online” and the provision of “Playboy Wireless” via licensees. There is a reference to sale of “Playboy-branded products” in Harrods in London. However, it is unclear what trade mark these products bear, since the text refers not only to Playboy’s brand name, but also to “its Rabbit Head logo – one of the most recognized trademarks in the world”. Use of a rabbit head logo is entirely irrelevant to this opposition action.

13. Ms Kawal says that the PLAYBOY brand celebrated its 50<sup>th</sup> anniversary in 2003 and exhibits at JK3 a copy of PEI’s annual report from that year, together with annual reports from 2000 and 2004, exhibit JK5. There is a statement in JK3 that PEI has two television networks in the UK, competing with twenty six other adult networks. PEI also licenses rights to publish PLAYBOY magazine to seventeen international partners, including Bulgaria, Croatia, the Czech Republic, France, Germany, Greece, Hungary, the Netherlands, Poland, Romania, Serbia, Slovenia and Spain, with a combined monthly circulation figure of 1.1 million copies monthly. The other countries are Japan, Mexico, Russia and Brazil; the 2004 Annual Report states that the July 2004 edition of the British magazine *Esquire* voted the Brazilian edition of the PLAYBOY magazine as the “sexiest magazine in the world”. Beyond this, the annual reports do not refer to the UK or EU. Of more relevance is JK4 which is a copy of an article celebrating 50 years of PLAYBOY magazine, published in the UK January 2003 edition of *GQ* magazine. According to the exhibit, *GQ* had a circulation figure of 125,885; I assume that figure is for that particular month’s edition.

14. Ms Kawal gives turnover figures for the years 1998-2004 in her witness statement. There is no breakdown as to the goods and services and although impressive, running into hundreds of millions of US dollars, there is no indication as to the proportion of that revenue gained from trading within the UK. The relevant information is that PLAYBOY magazine has been available in the UK since 1953 and that the average UK sales of PLAYBOY magazine for 2001 to 2004 were “in excess

of 80,000 copies per year”. I note that, in 2003, the monthly circulation of the magazine in the US was approximately 3.1 million copies.

15. Ms Kawal states that in 1995, “PEI launched the PLAYBOY TV satellite/cable television channel in the UK, offering adult content on a subscription basis”. The number of subscribers per month for 2000 to 2003 was over 70,000 per month. In 2002, these services were offered to viewers on a pay-per-night basis; during 2000 to 2003, there were over 1 million sales per year. Exhibits JK6 to 8 show UK press reports regarding the launch and; details of programming in UK satellite TV publications and UK tabloid press; and celebrity sign-ups. Prices are in UK sterling and there is mention of PLAYBOY TV’s online activities and online access for mobile phones. In 2003, the revenue from television in the UK was predicted to hit £15 million, according to a report in JK8.

16. The witness statement gives evidence that PLAYBOY video recordings were first sold in the UK in 1988, later as DVDs. These recordings feature adult content including feature films, content from PLAYBOY TV and instructional videos for couples. JK9 shows examples of these for sale in the UK on PEI’s website. The print is dated 2 August 2007, but the Ms Kawal states that all of the examples shown were on sale in the UK prior to October 2004. She says that PLAYBOY video recordings are also sold in the UK from high-street and online retailers.

17. JK10 shows PEI press releases regarding the launch of a gaming/betting site called PlayboySportsBook.com, with betting available in 23 currencies, specifically mentioning prices in £sterling. Further than that, there is no information relating to the service in the UK. Ms Kawal makes statements regarding the provision of PLAYBOY websites, but I cannot tell from the evidence what the access rate is by UK residents. Other developments for the PLAYBOY brand have been a free on-line radio service in 2000, broadcast on Radio Free Virgin, in UK from London’s Virgin Megastore; the launch of a video game in 2004 called ‘PLAYBOY: The Mansion’; and in 2003, a wireless service for customers of Hutchison’s 3G mobile phone network. Exhibits JK11 and 12 have been filed in support of these statements.

18. The remainder of the witness statement and exhibits relate to what one might term as merchandise. Ms Kawal says that this includes men’s and women’s clothing, footwear, headgear, fashion accessories, collectibles, slot machines, interactive video games, cigars, watches, jewellery, perfume, cosmetics, leather goods, stationery, music, eyewear, barware and home furnishings. Such goods are produced by licensees of the PLAYBOY mark. Exhibit JK14 is a document which gives brief details of the various PLAYBOY product categories licensed in the UK and information regarding the UK retail business in 2004. It lists several London stores and UK retailers where PLAYBOY products are sold. Ms Kawal says that PLAYBOY merchandise is widely available to UK consumers on-line, both from third-party retailers and from PEI’s UK website (.co.uk suffix). She states that many consumers in the UK also order from PEI’s international website (.com suffix). She exhibits at JK15 three documents. Two are from UK publications, respectively entitled “Drapers Record & Menswear (UK)”, dated 20 March 2004 regarding “Playboy Opens Bunny Boutique in Harrods”, and the other called “Retail Week (UK)” dated 19 March 2004, regarding “Harrods prepares to celebrate 50 years of Playboy”. Both of these documents are illegible. The other is a press release from

PEI relating to worldwide (including Harrods in London) merchandising and retailing initiatives to celebrate the 50<sup>th</sup> anniversary. It does not show any goods. JK16 consists of a selection of newsletters from PEI's international website relating to merchandise available. I have looked closely for references to UK and the European Union and for examples of PLAYBOY in use as a trade mark on goods. Most of the material relates to the US and to use of what PEI calls its rabbit head logo. I found a picture of a hooded jacket with PLAYBOY across the front, separated by the zip between the 'Y' and the 'B' next to an article about PEI selling its clothing in the UK and Ireland (the newsletter dates from 2001). However, the article focuses on clothing featuring the rabbit head brand. There is a poorly reproduced photograph from a UK House of Fraser store window, again showing clothing with the rabbit head. In 2001 there was some use in the UK of PLAYBOY on stationery. In 2002, a licensee sold bags and belts in the UK and continental Europe; however, it is impossible to see a trade mark in the picture as it is so blurred. The report about Playboy fashion in the European Union shows goods bearing the rabbit head. There is little use shown of the word mark on merchandise.

19. Ms Kawal says that a licensee in the UK has sold PLAYBOY clothing in the UK since 2001. Exhibits JK17 and 18 are clothing catalogues and clothing samples, respectively from Autumn 2004 (just at the relevant date). The catalogue shows the word mark on a range of women's and men's clothing sold in the UK by the licensee. JK19 is a selection of invoices from the UK licensee which are said to relate to sales of PLAYBOY clothing to retailers in the UK, although I cannot tell what mark is visible on the items since the invoices do not show pictorial representations of the goods. I have been unable to match the reference numbers in the catalogues to those in the invoices. As for footwear (exhibit JK20) I have been able to discern the word mark on the sole of a trainer in a magazine called *The Face* (UK) in May 2004 and on a flip-flop sandal in *Cosmopolitan* magazine (UK) in July 2003. Boots and stiletto footwear are represented as emanating from "Playboy"(2003). The reproduction of the documents in this exhibit is particularly poor. On many of the pages I cannot see any trade marks at all. Ms Kawal states that watches are sold in the UK by a licensee under the mark PLAYBOY (October –December 2003, 42,000 in the UK and Ireland). She exhibits at JK25 extracts from an *Argos* catalogue. This is undated. All but one of the invoices post-date the international priority date claimed by the international registration which is the subject of this opposition. I cannot tell how the mark is used on the watches from the invoices alone and they are not cross-referenced to any material which may give assistance.

20. Ms Kawal says that the PLAYBOY brand and products "regularly feature in the UK press" and she exhibits some such articles at JK21, much of which relate to PLAYBOY magazine and are indeterminately dated.

21. Exhibit JK24 is a copy of an article from the April 2004 edition of *Trademark World* which lists PLAYBOY at joint place 19-23 in a list of top well-known marks.

## **Decision**

## **Likelihood of confusion – section 5(2)(b) of the Act**

22. Section 5(2)(b) of the Act states that a trade mark shall not be registered if because:

“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 mark.”

Section 6(1)(a) of the Act defines an earlier mark as:

“a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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”.

PEI’s two UK and Community registrations are earlier trade marks as per section 6(1)(a).

23. The leading authorities which guide me in this section 5(2)(b) ground are: *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon KabushikiKaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1 and *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] F.S.R. 77. I have to determine whether there are similarities between the marks and the goods and the services which will give rise to a likelihood of confusion.

### **Average consumer**

24. With the exception of Class 45, the international registration seeks protection in the UK in its other classes for a wide range of goods and services within each class. Based upon notional and fair use across the spectrum of these goods and services, the average consumer is the general public, both junior and adult (except for leather and imitation leather, animal skins and hides which are trade goods, and for goods and services which are illegal to sell to those who are under-age). The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd*, supra). However, the level of attention paid to the goods and services in each case will vary, according to the item being bought. In the case of clothing, the public is increasingly brand conscious and the visual appearance of the trade mark and where it is placed on the clothing or footwear item is of some importance to many purchasers. They will exercise a degree of care in selecting the items before purchase. The same may be said to be true of consumer goods such as mobile phones, handbags and umbrellas which, particularly amongst the young, are carried as fashion accessories to fit in with their own personal image. The services in Class 45 appear to be aimed at an entirely adult market and are largely what might be called services of a personal or sensitive nature. For these, I think that the level of attention paid to their purchase will be reasonably high. I note from the opponent’s evidence that it considers the average consumer of its magazines, in the US, to be male, aged 18 to 34, with the median at 33, and with a household income of \$55,000 (exhibit JK5); and

that, in the UK, those who watch its television channels are “90 per cent male and come from across all age and socio-economic groups” (JK8).

### **Comparison of goods and services**

25. The established tests for assessing similarities between goods and services are to be found in Canon (*supra*) and in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281. I must consider nature, intended purpose, method of use, whether the goods or services are in competition with or complementary to each other and also the nature of the users and the channels of trade.

26. There is identity of goods and services between PEI’s registered specifications and HS’s specifications in all but Class 45. Class 45 appears in HS’s international registration but not in PEI’s registrations and a comparison of the Class 45 services against PEI’s goods and services will be on the basis of similarity rather than identity. It reads:

“Personal and social services for organizing and promoting human and/or partner relations; advice concerning emotional and sexual flirting and seduction techniques; security services for the protection of property and individuals”.

In making a comparison between HS’s Class 45 specification and the specifications of PEI’s marks, I have to consider how the average consumer would view the services, given their natural meaning and practical application in trade. I should not give the specifications an overly narrow meaning; nor should I accord them an overly wide construction.

27. I find the following similarities:

a) *Advice concerning emotional and sexual flirting and seduction techniques* is akin to teaching something. I consider there to be a high degree of similarity between these services and *education* of PEI’s Community trade mark, since *education* covers each and every facet of teaching and educating;

and

b) *Transportation* of PEI’s Community trade mark will include transport of valuables in security vehicles; such services like *security services for the protection of property* are for the protection of property and so have the same intended purpose. The main difference between the services is that one is primarily static and the other primarily mobile. In my view this leads to a high degree of similarity between the respective services.

28. I have considered all of the goods and services of the earlier trade marks of PEI and can find no meaningful coincidence between those goods and services and the remaining class 45 services of the international registration based on the criteria set out in the case law. Therefore, it is not that I just cannot find that the respective goods and services are not similar, I consider that they are dissimilar.

## Comparison of trade marks

29. The trade marks to be compared are:

**PEI's trade mark(s):**

PLAYBOY

**HS's trade mark:**



30. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant. The likelihood of confusion must be appreciated globally by evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed. However, I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. I must compare the mark applied for and the opponent's registrations assuming normal and fair use of the marks on the relevant goods and/or services covered within the width of their respective specifications.

31. PEI states in its submissions that PLAYBOY is wholly contained in HS's mark and forms a dominant and distinctive element of the overall mark. It says the device in HS's mark is simplistic and that the presence of the word 'SKOOL', "a relatively common colloquial mis-spelling of 'school'", does little to affect the overall impression given by the mark. PEI says the marks are visually, phonetically and conceptually similar and that consumers will associate HS's mark with its own, in the way of an "off-shoot, or sub-brand of the PLAYBOY mark".

32. HS submits that Playboy (in Playboyskool) is simply descriptive and that its mark has a completely different meaning to PLAYBOY and has a "characterising device element". It says 'playboy' does not form the solely dominant element within the overall impression created by its composite mark. HS points to the word element in its mark as being a single word without any separation between 'Playboy' and 'Skool'. It further states that 'playboy' means "a rich man who spends his time enjoying himself" and that 'playboy' and 'skool' have equal dominance. Conceptually, "a 'school' is completely different from 'PLAYBOY', a single rich man enjoying himself and having fun. In contrary hereto a 'skool/school' is an institution which children –not single rich men – attend to study and not to enjoy themselves."

33. PEI states that the hat device in HS's mark is "simplistic". By this, I assume PEI means that the device is banal and therefore lacks distinctive character. It does not

follow that a simplistic device (whether or not one agrees that this device can be described as such) lacks distinctive character merely because it is simplistic. It is not an ‘abstract’ device but, apart from use on hats, there is no reason that I can see for it being so simplistic that its distinctive character, and therefore its affect on the identity of HS’s mark, can be so readily dismissed. My assessment of it, without artificially dissecting the mark, is that it bears a reasonable level of distinctive character, without it being the dominant element of the mark as a whole. I have it in mind that ‘words speak louder than devices’ and it is to the word component that I now turn.

34. The common element in PEI’s marks and HS’s is the word PLAYBOY. It is the sole element of PEI’s marks and is the first element of HS’s conjoined PLAYBOYSKOOL word component. The consumer’s consciousness will register a dictionary word that he or she knows. Visually, there is a considerable degree of similarity; however, one cannot ignore the SKOOL element and the device. A natural reading of HS’s mark is likely to be ‘PLAYBOY SKOOL’; less likely is PLAYBOYS KOOL, since it is ungrammatical (leaving aside the mis-spellings in both versions). Aurally, one will hear the PLAYBOY element first, so that the degree of similarity in this respect is also considerable.

35. HS has provided me with a definition, in parenthesis but without attributing a source, of the word ‘playboy’ (see paragraph 30 above). My own impression of a playboy is along much the same lines, although I would define a ‘playboy’ as displaying a particular type of behaviour, regardless of his financial situation. Such a person might be termed a womanizing socialite – a sort of Casanova. Conceptually, this word is where the marks converge. HS’s mark, despite the word SKOOL being a mis-spelling, conveys the idea of a school for playboys. However fanciful that may be, the idea is that one can touch a playboy lifestyle by purchasing HS’s goods and services. Bearing in mind HS’s specification in Class 45, that is clearly what HS wants the consumer to think that he will get. PEI’s evidence leaves no doubt that the above definition of a playboy is its brand image aim. Of the three elements in HS’s mark – by this I mean the device, PLAYBOY and SKOOL, since there is a natural rhythmic break in pronunciation – I consider that PLAYBOY is the more dominant. It is PLAYBOY that defines ‘SKOOL’, in an adjectival way: a school for playboys. I believe this is how the English language-aware public would see the mark and, consequently, I consider that my interpretation does not artificially dissect the mark. My conclusion is that there is a high degree of conceptual similarity.

### **Likelihood of confusion - conclusion**

36. In reaching my conclusion, I am directed to weigh the proximity of the goods and services against the relative distance between the marks - the interdependency principle – whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon, supra*). In respect of the earlier Community trade mark, the goods and services are identical and highly similar, and in respect of the earlier UK registration, they are identical. I must also appraise the distinctive character of the earlier mark, because the more distinctive it is (either *per se* or by reputation), the greater will be the likelihood of confusion (*Sabel, supra*). The distinctive character of a mark must be assessed by reference to the particular goods or services to which it is attached and by reference to the relevant consumer’s perception of the mark. I have found that

there is similarity in the conceptual identity of the marks. The consumer, who is reasonably well informed and reasonably circumspect and observant, will see PLAYBOY as a cheeky, fanciful idea, the distinctive appeal of which lies in its escapist connotations of glamour.

37. PEI's mark possesses a significant degree of inherent distinctiveness but I am unable to say whether PLAYBOY would be pushed into the top bracket of distinctiveness by reputation because of the lack of evidence of reputation in the UK for any of the goods or services, with the possible exception of its satellite/cable television programmes. It is difficult to square the coverage in the UK press of fifty years of a magazine brand that sells only 80,000 copies a year in the UK. It may be a generation matter, perhaps famous for being groundbreaking in the genre decades ago. That seems to be the US position, but I am reluctant to find a reputation in the UK that would affect my assessment of PLAYBOY's already high-end inherent distinctive character.

38. I think it unlikely that the marks would be directly confused with one another. However, according to the jurisprudence cited above, I must also have regard to a scenario where, although the marks are not mistaken directly, there is a belief or an expectation upon the part of the average consumer that the goods bearing the individual marks emanate from a single undertaking because there are points of similarity which lead to association. If the association between the marks causes the public wrongly to believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section (*Canon*, supra). Having regard to the identity or close proximity of the goods and services, the distinctive character of the word PLAYBOY, and the fact that both marks convey messages that focus on the idea of a PLAYBOY, I find that there is a likelihood of confusion within the meaning of Section 5(2)(b) in all but the following services in Class 45: "Personal and social services for organizing and promoting human and/or partner relations; security services for the protection of individuals". **The opposition succeeds under section 5(2)(b) in relation to all the goods and services except for "Personal and social services for organizing and promoting human and/or partner relations; security services for the protection of individuals".**

### Section 5(3) of the Act

39. This reads:

"(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the alter mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

40. The relevant date at which the question of reputation must be assessed is the filing date of the international registration, taking into account the priority claim. The reputation that PEI is required to show is set out in *General Motors Corporation v Yplon SA* [1999] E.T.M.R. 950, a copy of which the opponent filed with its written submissions:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

41. Although likelihood of confusion is not a requirement under section 5(3) of the Act, it is necessary for the opponent to show that the relevant public would make a link between the earlier trade mark and the later one. Any link shown must be one that affects the economic behaviour of the public (*Electrocoin Automatics Limited v Coinworld Limited and others* [2005] E.T.M.R. 31) and the damage or advantage caused by that link must be more than a hypothetical possibility (*Mastercard International v Hitachi Credit (UK) Plc* [2005] E.T.M.R. 10).

42. As I have explained above, the evidence provided by the opponent is ill-directed in a number of respects which are necessary to show the required level of reputation. There is a substantial amount of evidence, but much of it relates to use outside the UK and the EU, is undated, indeterminately dated or post-dates the relevant date. Several of the exhibits are international or US corporate and marketing materials which do not provide a UK-market context. Where there is UK use shown – I am considering here the UK television channels – I cannot tell how significant the market share is of PEI. I cannot therefore say that at the relevant date that PLAYBOY was known by a significant part of the public. The opponent’s UK registration is for clothing, headgear, footwear and belts and there is little evidence to back the claim under section 5(3). The same evidential weaknesses exist in relation to PEI’s Community trade mark registration; however, there is a much more fundamental problem in relation to this earlier mark. Mr Richard Arnold QC, sitting as the Appointed Person, in *Mobis Trade Mark* BL O/020/07, said:

“30. The opponent contends that, where an opponent relies upon a Community trade mark, it is sufficient for the purposes of section 5(3) to show

that it has a reputation in the United Kingdom and that the hearing officer was wrong in law to hold that it was required to show a reputation in the Community.

31. I am unable to accept this argument. Section 5(3) on its face expressly distinguishes between what is required in the case of an earlier national mark, namely “a reputation in the United Kingdom”, and what is required in the case of an earlier Community trade mark, namely “a reputation...in the European Community”...I cannot see any basis on which the Act, the Directive and the Regulation can be interpreted as merely requiring that the Community trade mark relied upon should have a reputation in the Member State in question...

32. It follows that the hearing officer did not make the error of law alleged.”

43. Given that the evidence filed by the opponent does not establish a reputation in the European Community at the relevant date, PEI cannot rely upon its earlier Community trade mark registration to support its claim under this ground. **The opposition fails under Section 5(3).**

#### **Section 5(4)(a)**

44. PEI relies under section 5(4)(a) upon its use of PLAYBOY in the UK. It has, in the main, been successful under Section 5(2)(b), save for (in Class 45): “Personal and social services for organizing and promoting human and/or partner relations; security services for the protection of individuals”. I therefore propose to confine my analysis of the claim under section 5(4)(a) to these services.

45. Section 5(4)(a) of the Act says:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented

(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 principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly,

he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

46. It is necessary to decide what the material date in relation to the claim of passing-off is. It is well established that this date is the date of the behaviour complained of. Section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 of December 21, 1998 which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark.”

In the absence of any indication to the contrary, the relevant date in these proceedings is 20 October 2004, the priority date claimed by the international registration. PEI must therefore establish that at that date it possessed goodwill in the UK, in the above services, and that a misrepresentation had taken place by HS which had damaged, or would be likely to damage, that goodwill.

47. I found under Section 5(2)(b) that “personal and social services for organizing and promoting human and/or partner relations; security services for the protection of individuals” were dissimilar to any of PEI’s goods and services. The difficulty in establishing confusion where there is a distance between the fields of activities was considered by Millet LJ in *Harrods v Harrodian School* [1996] RPC 697. Millett LJ stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services”

In the same case Millet LJ held:

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

In *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501 Slade LJ considered the difficulty of establishing damage where the parties are in different lines of business:

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth

likely to ensue and to cause them more than a minimal loss is in my opinion a heavy one.”

In *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 Lord Fraser commented upon what the plaintiff must establish:

“That he has suffered, or is *really likely* to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill is attached.”

In *Lego System Aktieselskab and Another v Lego M Lemelstrich Ltd* [1983] FSR 155 the distance between the fields of activity was bridged by an enormous reputation, Lego being classed as a household word, and survey evidence.

Christopher Wadlow in “The Law of Passing-Off” (third edition) at 4-23 puts forward the following proposition:

“Most of the authorities may perhaps be reconciled with the proposition that the risk of damage is sufficiently real if:

1. Confusion between the parties will be widespread and inevitable, even though there may be no immediate reason to believe that actual damage in any particular form will occur, or
2. There will be some confusion of the parties, and the defendant’s business poses a special risk to the claimant because of the way it is currently conducted or because of future developments which can actually be expected.

If confusion with the claimant is slight and tangible damage speculative then there is no liability for passing off.”

48. The requirement for establishing a goodwill in relation to the law of passing-off is very different to that for a reputation in respect of section 5(3) of the Act. Despite the inadequacies of the evidence, I have no doubt that at the material date PEI enjoyed a goodwill in relation to television broadcasting, magazines and recorded media by reference to the sign PLAYBOY. The content of the goods and services is primarily based on sex and sexual relations. The specific nature of this goodwill is, in my view, of key importance as it makes a clear connection with “personal and social services for organizing and promoting human and/or partner relations, which would encompass such services relating to sexual relations”. Taking into account the nature of the services and the degree of similarity of the respective trade marks, I consider that there would be almost inevitable deception. In the sensitive area in which the services of HS would operate PEI’s trade reputation would be very much open to injury for any failings in the services or even through the very nature of the services. There is also the injury inherently likely to be suffered by any business when on frequent occasions it is confused by customers or potential customers with a business owned by another proprietor or is wrongly regarded as being connected with that business. **I find, therefore, that in relation to “personal and social services for organizing and promoting human and/or partner relations” use of HS’s trade**

**mark is liable to be prevented under the law of passing-off and that protection of the international registration should be refused in relation to such services.**

49. This leaves “security services for the protection of individuals” to consider. These services appear to me to be akin to bodyguard and similar services. I can see no connection between these services and the goods and services for which PEI has a goodwill. In the absence of any such connection, despite the similarity of the trade marks, I cannot see that there would be deception and so the claim under section 5(4)(a) against such services is dismissed.

50. The same cannot be said of the remaining “security services for the protection of individuals”. There is no link between these services and any of PEI’s goods or services and its goodwill in sexual television programmes in the UK cannot stretch as far as security services for the individual. **The opposition under Section 5(4)(a) succeeds in relation to “personal and social services for organizing and promoting human and/or partner relations” but fails in respect of “security services for the protection of individuals”.**

### **Section 56**

51. PEI has claimed that PLAYBOY is a well-known trade mark in respect of various goods and services. As it already has registrations for a variety of goods and services, it already has earlier marks under Section 6(1)(a) of the Act and so its position will not be improved by having earlier trade marks as per section 6(1)(c) of the Act:

“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 or the WTO agreement as a well known trade mark”.

### **Conclusion**

52. The international registration is to be refused protection in the UK except for the following services:

“security services for the protection of individuals” (Class 45)

for which it should be protected.

### **Costs**

53. The opponent has been successful in its action under Sections 5(2)(b) and 5(4)(a) of the Act. I bear in mind in making an award of costs against HS that HS did not file any evidence which PEI had to consider and that PEI’s own evidence was ill-directed in this, case which has largely been determined on a straight mark-to-mark, goods-to-services comparison. Consequently, I consider that PEI should receive a reduced contribution towards the cost of the evidence that it has filed, taking account of its success under Section 5(4)(a), achieved through a small proportion of its evidence. I award costs on the following basis (based upon the scale applicable at the time the opposition proceedings commenced):

Opposition fee	£200
Notice of opposition and statement of grounds	£300
Considering counterstatement	£200
Filing evidence	£100
Written submissions	£100
TOTAL	£900

54. Accordingly, I order Hot Sheyt Management & Music Publishing Est. to pay to Playboy Enterprises International, Inc. the sum of £900. This sum is 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.

**Dated this 18 day of January 2008**

**Judi Pike  
For the Registrar  
the Comptroller-General**