



## TRADE MARKS ACT 1955

### DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS WITH REASONS

**Re** Opposition by JOHNNY ROCKETS LICENSING CORPORATION to the registration of Trade Mark applications numbers 579009 and 579010 in the name of PACIFIC VENTURES INTERNATIONAL LIMITED

Applications Nos. 579009 and 579010 were lodged on 25th May 1992 in the name of PACIFIC VENTURES INTERNATIONAL LIMITED. Both applications sought registration of the words JOHNNY RAMJETS BAR AND DINER. Acceptance of the applications was advertised in the *Official Journal* of 23rd September 1993, the former being in class 42, in respect of “restaurant, cafe, cafeteria, snack-bar and bar services” and the latter application in class 41, in respect of “disco and musical entertainment services”.

Notices of opposition to registration of the marks, in terms of s 49 of the Act, were lodged on 22nd December 1993 by JOHNNY ROCKETS LICENSING CORPORATION (the opponent). Although opposition is based on various grounds, the main grounds relied upon by the opponent in its evidence and argued at the hearing concentrated on s 33: that the applicant’s marks were substantially identical or deceptively similar to the marks of the opponent’s three registrations for the same or closely related goods or services.

#### **The evidence**

The service and lodgment of the opponent’s and applicant’s respective evidence were completed on 29th August 1995. The evidence in support comprises a statutory declaration with exhibits WRH1 to WRH4 by Walter R Host. A statutory declaration by James Andrew Weschler forms the evidence in answer. Another declaration by Walter R Host constitutes the evidence in reply.

In the evidence in support, Mr Host, who is the vice-president-franchising of the opponent company, briefly relates the origin of the 1950's style restaurant operating under the name JOHNNY ROCKETS THE ORIGINAL HAMBURGER. The trade mark has been franchised in a number of countries, including Australia, where restaurants are located in Victoria, New South Wales and Queensland. In 1994 it was proposed to open restaurants in Perth and Adelaide. The first such restaurant was opened in Melbourne on 28th October 1992. Prior to signing of the franchise for this restaurant, discussions had taken place with a potential franchisee in early 1991. Under WRH2 are exhibited newspaper articles, magazine advertisements and video tapes in relation to promoting the opponent's mark. Exhibit WRH3 contains samples of the mark in use.

In his declaration comprising the evidence in answer, Mr Weschler, as a director of the applicant company, contests the allegation that the marks under consideration and their use are similar, contending that all the applications do not fall in the same classes, that the words THE ORIGINAL HAMBURGER do not appear in the applicant's marks, that the words ROCKETS and RAMJETS have a different sound and appearance, that the word RAMJETS has no definition, whereas ROCKETS is a dictionary word, and that the applicant does not trade under its marks, but merely displays the marks in a snack bar of a "Studebaker's" restaurant which is a restaurant/nightclub. In his opinion, the usage and concept of the applicant's marks are totally different from those of the opponent.

In Mr Host's second declaration, lodged as evidence in reply, he refers to Mr Weschler's statement relating to the word RAMJETS being a fictional name without a definition and, as exhibit WRH5, attaches copies of dictionary extracts relating to the word.

The hearing of the opposition was set down before me, as the Registrar's delegate, in Canberra on 12th October 1995. The opponent was represented by Mr Leon Allen, of the Canberra Office of Davies Collison Cave, patent and trade mark attorneys. No one appeared on behalf of the applicant.

## Submissions



Mr Allen first directed my attention to the opponent's three registrations for the mark:

being No A459811 in class 42, in respect of "restaurant services",

No A499648 in class 25, in respect of "clothing in this class including: T-shirts, sweat shirts, aprons and jackets and all other goods in this class",

No A499649 in class 14, in respect of "jewellery in this class including pins and all other goods in class 14".

He then referred to two copies of articles of exhibit WRH2, pointing out the performance aspect of the opponent's restaurants, in that members of the food serving staff are called upon to perform a sing and dance routine. From Mr Host's declaration emerged a clear picture as to the nature of the opponent's theme restaurants, and how successful the concept had become world wide and more recently in Australia, he said. In relation to Mr Weschler's declaration, he commented that "ramjet", in fact, was a dictionary word, as shown in the evidence in reply, and noted use of the applicant's marks in a restaurant/nightclub environment.

Comparing the opponent's and the applicant's marks, Mr Allen drew a number of resemblances between the marks. He noted the shared given name JOHNNY, the letter 'R' at the beginning of the second word in the marks, the plural form of the words ROCKETS and RAMJETS, their similar appearance and the common suffix '-ETS'. Registration of the applicant's marks was being sought in plain form, but the likelihood that a similar format to that of the opponent's marks could be adopted by the applicant ought to be taken into account. He further emphasized the effect of the marks in the minds of consumers in that a similar concept was conjured up by the words ROCKETS and RAMJETS, particularly in

combination with the word JOHNNY. In support of his contention, he cited *Jafferjee v. Scarlett* (1937) 57 CLR 115. The general recollection conveyed by the marks under consideration would be so similar that strong likelihood existed for the opponent's marks to be retained in the purchasers' minds, given the similarity between the essential and distinctive elements in the marks, i.e. JOHNNY ROCKETS and JOHNNY RAMJETS. For further authority on this aspect, Mr Allen mentioned *Australian Woollen Mills Ltd v F S Walton & Co Ltd* (1937) 58 CLR 641.

In considering the nature of the applicant's services of application 579009 and the opponent's services of registration 459811, Mr Allen submitted that cafe and restaurant services were indistinguishable, while cafeteria and snack bar services were closely related to those of a restaurant. Most restaurants provided bar services, therefore these too were closely related, he observed. He drew a similar conclusion regarding the services of application 579010 and registration 459811, because it was a common practice in a number of establishments, such as hotels or night clubs, to provide both musical entertainment and restaurant services concurrently, or subsequently to partaking of a meal. In that regard, he directed my attention to Mr Weschler's reference to use of the applicant's marks in relation to a restaurant/nightclub. Furthermore, by requiring the applicant's marks to be associated for the purpose of s 36, the Trade Marks Office itself had acknowledged the close relationship between those services, he argued. Additional evidence of this relationship was illustrated by entertainment provided in the opponent's restaurants which formed an integral part of the opponent's services.

With reference to *Chili's Inc's Application* 10 IPR 92, Mr Allen submitted that, even though in that decision the hearing officer conceded a connection between theatre restaurants and entertainment, that was not an authority to say that entertainment services and restaurants did not have a sufficiently close relationship. In his view, a broader interpretation should be made, particularly in relation to the opponent's evidence, as the services were provided by one person and under the same roof. There is therefore a connection between those services in the course of trade. Finally, Mr Allen sought costs to be awarded to the opponent.

## Decision

### *Section 33 - Substantially identical or deceptively similar*

Sub-section 33(2) provides:

Subject to this Act, a trade mark is not capable of registration by a person in respect of services if it is substantially identical with or deceptively similar to a trade mark which is registered, or is the subject of an application for registration, by another person in respect of the same services, of services of the same description as those services, or of goods that are closely related to those services, unless the date of registration of the first-mentioned trade mark is, or will be, earlier than the date of registration of the second-mentioned trade mark.

In determining whether registration of the marks under consideration is prohibited under the provisions of s 33, I will first decide whether the services of the present applications are the same, or of the same description, as those of the opponent and whether the goods of registrations Nos 499648 and A499649 are closely related to the applicant's services.

It seems to me that by no stretch of imagination could clothing and footwear items embraced in registration A499648, and goods falling in the categories of precious metals, their alloys and goods in precious metals; jewellery, precious stones; horological and chronometric instruments, which broadly are covered by registration No 499649, be regarded as being closely related to the applicant's services. There remains for me to decide whether the "restaurant services" of the opponent's registration No 459811 are the same as, or of the same description, as those offered by the applicant.

While I agree with Mr Allen's submissions that the services of application No 579009 are the same, or of the same description, as those of registration 459811, I am not satisfied that discos and musical entertainment are provided in the majority of restaurants. Considered in light of the tests outlined in *Jellinek's Appn* (1946) 63 RPC 59, the aim of discos and musical entertainment is to amuse or to afford diversion to the listeners. Such entertainment may be presented in vocal or instrumental form, or a combination of both, or as a show with songs, instrumental music and dancing, whereas the primary purpose of restaurants is to provide meals and drinks in a comfortable atmosphere, recorded or live music often being played in the background. In theatre restaurants live entertainment usually follows the

completion of a meal to allow members of the audience to concentrate on the presentation. To my knowledge, persons responsible for live performances in restaurants do not normally provide services associated with the serving of food. While the combination of these services in the opponent's theme restaurants may be an exception to the accepted and common practice, the primary function of its restaurants is, I believe, the provision of meals, the song and dance performance by the waiters playing a subsidiary role. I cannot therefore accept the argument that the opponent's restaurant services are of the same description as the services of application No A579010.

The other aspect to be considered for the purpose of s 33 is whether the applicant's mark of registration A459811 is substantially identical with, or deceptively similar to, the marks of the present applications.

In *Shell Co (Aust) Ltd v Esso Standard Oil (Aust) Ltd*. (1961) 109 CLR 407 at p 414 Windeyer J said:

“In considering whether marks are substantially identical they should, I think, be compared side by side, their similarities and differences noted and the importance of these assessed having regard to the essential features of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison...”.

Applying this test to the subject marks and the mark of registration A459811, I do not find the marks to be substantially identical. The only element shared by the marks is the given name JOHNNY, otherwise the features comprising the respective marks form entirely different composites.

Pursuant to sub-section 6(3), a mark is deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion. Comparing marks comprising a device with words, in *Australian Woollen Mills v F S Walton*, supra, Dixon and McTiernan JJ. enunciated at p 658:

“In deciding this question, the marks ought not, of course, to be compared side by side. An attempt should be made to estimate the effect or impression produced on the mind of potential customers by the mark or device for which the protection of an injunction is sought. The impression or recollection which is carried away and retained is necessarily the basis of any mistaken belief that the challenged mark or device is the same. The effect

of spoken description must be considered. If a mark is in fact or from its nature likely to be the source of some name or verbal description by which buyers will express their desire to have the goods, their similarities both of sound and of meaning may play an important part. The usual manner in which ordinary people behave must be the test of what confusion or deception may be expected.”

Considering the marks in question in light of these principles, I am to decide whether the marks in question are so similar in their totality that, when viewed in isolation, they are likely to be confused by members of the public.

The applicant’s and the opponent’s marks consist of five words each. As already noted, the word JOHNNY appears as a given name in these marks. While it is true that the words BAR AND DINER in the applicant’s marks and THE ORIGINAL HAMBURGER in the opponent’s mark are purely descriptive and non-distinctive, these words must be taken into account for the purpose of comparing the marks as wholes (*GRANADA Trade Mark* [1979] RPC 303). A meticulous comparison of the marks reveals a common first letter and the same suffix, as well as equal number of letters in the words ROCKETS and RAMJETS, as observed by Mr Allen, but I do not think persons concerned with restaurant services are unlikely to distinguish between the idea conveyed by the two words. The word ‘rocket’, which would be more familiar to the majority of ordinary persons, in my opinion, would conjure up an image of at least an object that can be projected to a height or distance, used in firework displays or for signalling or, in a more technical sense, for propelling a military warhead or spacecraft. Even if the exact technical definition of the word ‘ramjet’ was unknown to a number of persons, many persons would associate the word with an engine as part of an aircraft. Moreover, given that restaurants are usually selected for their particular menu, as well as pleasant decor or atmosphere, and being mindful of the principle that the marks are to be considered in their entirety, as was long established in *Clark v Sharp* (1898) RPC 141, I regard it as inconceivable that persons with normal intelligence and memory would recall only the essential features in the marks, the words JOHNNY ROCKETS and JOHNNY RAMJETS, respectively, entirely ignoring the other features whereby the words THE ORIGINAL HAMBURGER on one hand, and BAR AND DINER on the other hand, convey some information on the nature of the restaurants.

It follows therefore that the opponent has not made out a case in relation to s 33.

### **Conclusion**

I find that the opponent has not succeeded in relation to the grounds upon which it has relied in the notice of opposition, evidence and submissions. Accordingly, I dismiss the opposition, and, subject to any appeal from this decision, the mark will proceed to registration.

I see no reason why costs should not follow the result. Consequently, costs in the matter are awarded to the applicant.

Vija Zars  
Acting Hearing Officer  
13 December 1995