

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2171778
BY ANDREW SOUTHAM**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 49450
BY TGI FRIDAY'S OF MINNESOTA INC**

TRADE MARKS ACT 1994
IN THE MATTER of Application No 2171778
by Andrew Southam

and

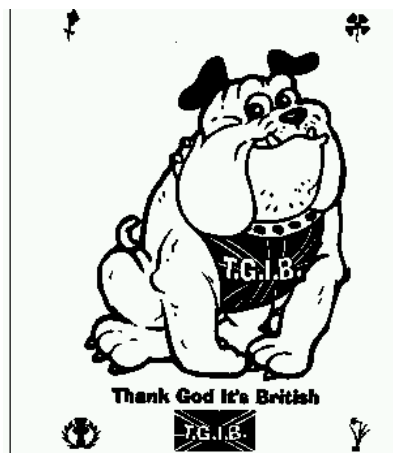
IN THE MATTER OF Opposition thereto under No 49450
by TGI Friday's of Minnesota Inc

Background

1. On 10 July 1998 Andrew Southam applied under the Trade Marks Act 1994 to register the trade mark shown below in respect of a specification of services which reads:

Class 42

“Hotels; fast food outlets; take away restaurants; public houses; restaurants; wine bars; catering; bars; cafes; inns; taverns; brasseries; bistros.”



2. The application is numbered 2171778.

3. The application was accepted and published and on 4 February 1999 TGI Friday's of Minnesota Inc filed notice of opposition to the application. The statement of grounds accompanying the notice of opposition set out various trade marks on which the opponents sought to rely; further registrations were listed in the opponents' evidence. These are reproduced as an Annex to this decision. The grounds of opposition can in summary, be stated as follows:

- (a) under section 5(2)(b) of the Trade Marks Act 1994 in that the trade mark the subject of the application is similar to the opponents' earlier trade marks and is to be registered for services identical to the goods and services for which the earlier trade marks are protected;

- (b) under section 5(3) of the Act in that the trade mark the subject of the application is to be registered for services not similar to some of the goods for which the opponents' earlier trade marks are protected and that the opponents' trade marks enjoy a reputation and that use of the trade mark the subject of the application would be detrimental to the distinctive character and repute of the opponents' earlier trade marks;
- (c) under section 5(4)(a) of the Act in that the opponents' trade marks have been used extensively in the United Kingdom and have built up a substantial reputation and that use of the trade mark the subject of the application would be liable to be prevented by the law of passing off.

4. The applicant filed a counterstatement denying the grounds of opposition. Both sides seek an award of costs. Only the opponents filed evidence in these proceedings and both parties have requested that a decision be taken from the papers filed in the proceedings. The applicant filed written submissions in letters dated 15 January 2001 and 6 March 2001. The opponents filed written submissions in a letter dated 5 February 2001. Acting on behalf of the registrar and after a careful study of the papers, I give this decision.

Evidence

5. As noted above, only the opponents filed evidence in these proceedings. That evidence consists of a statutory declaration and an affidavit. The statutory declaration, dated 14 August 2000, is by Ms Emma Louise Pettipher a partner with Boulton Wade Tennant, the opponents' representatives in this matter. The affidavit is dated 9 August 2000 and is by Leslie Sharman, the Vice President of TGI Friday's of Minnesota Inc, the opponents in this matter. I need not summarise the evidence but will refer to it where necessary as part of my decision, however, the basic facts can be briefly stated as follows.

6. The opponents, TGI Friday's of Minnesota Inc, are the registered proprietors of a large number of trade mark registrations in the United Kingdom and throughout the world. A full list of the registrations held in the United Kingdom is provided in the affidavit of Mr Sharman. The opponents license to TGI Friday's Inc, the right to use the various T.G.I. Friday's trade marks in conjunction with the operation of restaurants. They also grant to T.G.I. Friday's Inc the right to license others to open and operate T.G.I. Friday's Restaurants.

7. The first T.G.I. Friday's Restaurant opened in March 1965 in New York. The first restaurant outside the United States opened in Birmingham in March 1986. At the relevant date in these proceedings, 10 July 1998, there were twenty-five T.G.I. Friday's restaurants operating in the United Kingdom; I have calculated this figure from the list of restaurants and dates of opening provided in the affidavit of Mr Sharman at paragraph 5. UK net sales figures for the restaurants are provided in the statutory declaration of Ms Pettipher, it is sufficient to list the figures for 1993 - 1997 as follows:

	US \$
1993	48,867,580
1994	61,266,185

1995	73,362,703
1996	84,959,690
1997	96,027,744

Decision

8. The grounds of opposition refer to sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

“5.- (1)

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

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

(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) 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, or
- (b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

9. The term ‘earlier trade mark’ is defined in section 6 of the Act as follows:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

10. I will consider first the opponents’ ground of objection under section 5(2)(b). The opponents cite various trade marks in support of their opposition. All are earlier trade marks within the meaning of section 6 but the opponents do not identify the trade mark(s) they consider to be relevant to the test under section 5(2)(b). The provisions of this section require an earlier trade mark, similar to that the subject of the application and that the earlier trade mark is registered for similar or identical goods or services. In the absence of any indication from the opponents I must judge the matter for myself. The applicant’s specification is in respect of a range of services that fall within Class 42. The opponents have two registrations in that class and it seems to me that the services covered by those registrations are the closest to those covered by the application and thus these registrations represent the opponents’ strongest ground of opposition under section 5(2)(b). For ease of reference I reproduce the opponents’ trade marks and the applicant’s trade mark below:

Opponents’ trade marks

1283966

T.G.I. FRIDAY’S

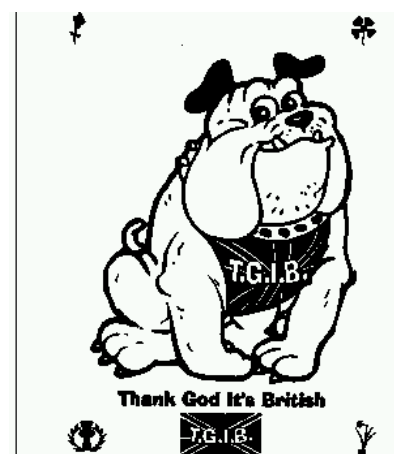
Class 42

Restaurant services and bar services for the provision of food or drink, all included in Class 42.

1283967



Applicant’s trade mark



Class 42

Hotels; fast food outlets; take away restaurants; public houses; restaurants; wine bars; catering; bars; cafes; inns; taverns; brasseries; bistros.

Restaurant services and bar services for the provision of food or drink all included in Class 42.

11. In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly 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 Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

12. The likelihood of confusion must be appreciated globally taking into account the various factors listed above. One of the factors that I must take into account is any reputation that the earlier trade mark(s) may enjoy. The opponents filed a large amount of evidence in support of the opposition. This evidence was directed to establishing a reputation in their trade marks. This evidence was criticised by the applicant's representative as being irrelevant. In particular, the applicant noted that no specific turnover figures had been given for the various marks referred to in the opponents' evidence. Many of these criticisms were justified and much of the evidence relates to use of the opponents' trade marks in other jurisdictions. I have no explanation as to why such information should be relevant to the issues before me, therefore, I discount those parts of the evidence that relate to use outside the United Kingdom.

13. That said, the evidence does show consistently high levels of turnover in the United Kingdom over a prolonged period of time. Such use seems to me to have been under the trade mark T.G.I. Friday's or under the trade mark T.G.I. Friday's with device registered under number 1283967. The use that has been shown seems to me to relate primarily to restaurant and bar services; see examples of the opponents' restaurants in the United Kingdom photographs of which are shown at exhibit LS3 and also example in the press cuttings at LS9 which cover reviews of the opponents' restaurants etc. Thus, for the purpose of my consideration under section 5(2)(b), I am satisfied, on the basis of the evidence that is before me, that I should find that the opponents' two trade marks shown above have a reputation in the United Kingdom in respect of what might be termed restaurant and bar services. Therefore, I will take this finding into account when considering the likelihood of confusion.

14. As part of the assessment of a likelihood of confusion under section 5(2)(b) I must consider whether the services covered by the application and the earlier trade marks are identical or similar. With the exception of hotels, the applicant's specification in my view covers services which could be considered identical or very similar to the term restaurant and bar services for the provision of food or drink; such services being covered by the opponents' registrations. Further, whilst hotel services would include services that go beyond those covered by the opponents' earlier trade marks, there is some similarity in that hotel services may frequently include restaurant and bar services. Thus, for the purpose of this decision I will treat hotel services as being similar to the services covered by the opponents' registrations.

15. The case law also tells us that I must take into account the fact that members of the public are unlikely to see the two trade marks side by side but instead must carry around an imperfect picture of them kept in their minds. Thus, having regard to all these factors including the reputation the opponents' earlier trade marks enjoy, I go on to consider whether the trade marks are similar, taking into account the visual, aural and conceptual similarities between the two trade marks.

16. Visually, the applicant's and opponents' trade marks are in my view very different. The applicant's trade mark consists of a bulldog wearing a Union Jack vest with the letters T.G.I.B. printed thereon. Underneath is prominently displayed the phrase "THANK GOD IT'S BRITISH". Below this are the letters T.G.I.B. contained again within a Union Jack. Both the opponents' trade marks strike the eye as T.G.I. Friday's.

17. The opponents contend that a prominent element of their trade mark are the letters T.G.I. In their submissions, they claim a reputation in those letters. I will consider whether the

opponents are entitled to any separate reputation and goodwill in respect of the letters T.G.I. in my considerations under section 5(4)(a). However, I should state here that in my view the evidence submitted shows use of the trade mark T.G.I. FRIDAY's and the trade mark T.G.I. Friday's plus device taken as a whole. For the purpose of my consideration under section 5(2)(b) I must consider the mark(s) as a whole but have regard to their distinctive and dominant components. It seems to me that the letters T.G.I. are no more distinctive or dominant than any other part of the opponents' trade marks and I see nothing in the evidence to suggest that the average consumer has been educated to regard those elements as anything other than a part of the overall trade mark(s). Therefore, visually I find the two trade marks dissimilar and I find no likelihood of visual confusion.

18. Aurally I believe that the opponents' trade mark would be referred to as T.G.I. Friday's and the applicant's as either THANK GOD IT'S BRITISH or T.G.I.B. Considering either of these possibilities I find the trade marks aurally dissimilar and that there is no likelihood of aural confusion. In so finding I take into account the fact that some consumers may be aware that the T.G.I. element of the FRIDAY's trade marks stands for THANK GOD IT'S; see for example exhibit LS9 *The Daily Telegraph* 7 August 1989.

19. Finally I consider any conceptual similarity between the two trade marks. As stated above, it seems to me that some consumers may be aware of the meaning of the T.G.I. element of the opponents' trade marks. Thus, there is some conceptual link between the two trade marks. Both seek to make use of or bring to mind, the phrase "THANK GOD IT'S". As noted above, in my view the T.G.I. element of the opponents' trade marks is merely one element of the mark and taken overall I find that there is only slight conceptual similarity between the applicant's and opponents' trade marks.

20. Thus, I have found that the opponents' trade marks are visually and aurally dissimilar to the application in suit and only slight conceptual similarity between the trade marks. This in my view is not sufficient to find the necessary likelihood of confusion required by section 5(2)(b).

21. That said, on the basis of the slight conceptual similarity, I would not discount the possibility that some consumers may, on seeing the applicant's trade mark in use call to mind the opponents' earlier trade marks. Is this sufficient for a finding of confusion under section 5(2)? The ECJ in *Sabel v. Puma* rejected this approach. The requirements of section 5(2) require a likelihood of confusion or an association in that the public wrongly believe that the respective services come from the same of economically linked undertakings. Mere association in the sense that the later mark brings the earlier trade mark to mind is not sufficient for the purpose of section 5(2)(b). Therefore the ground of opposition under section 5(2)(b) is not made out. In so finding I note the guidance of the ECJ in *Marca Mode* where the ECJ found that the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association.

22. The opponents also seek to rely on the provisions of section 5(3). The first requirement for this section is that the earlier trade mark should be similar to the trade mark the subject of the application and be registered for goods or services dissimilar to those for which the applicant seeks protection. The earlier trade mark must also have a reputation.

23. As noted above, the evidence filed by the opponents in my view establishes that they have a reputation in restaurant and bar services. However, the opponents have various other registrations covering goods which could be considered dissimilar to the services covered by the application in suit. They have registrations in classes 16, 25, 29, 30, 31, 32 and 33. However, it seems to me that the evidence filed by the opponents has failed to show a reputation in respect of these registrations. The turnover figures provided in the evidence of Ms Pettipher relates to the net sales figures of the restaurants in the United Kingdom. These figures are not broken down to show use for example on clothing (Class 25), or any of the goods in classes 29,30,31, 32 or 33. Further, I find that the examples of use submitted as exhibits to Mr Sharman's affidavit include use outside the United Kingdom.

24. If I consider the use that has been shown in the United Kingdom this relates primarily to the provision of a restaurant and bar service; see for example the press articles at exhibit LS9. Exhibit LS8 is said to show examples of use on pre-packaged alcoholic beverages, pre-packed foods, clothing, hats, tableware and stationery, umbrellas and athletic bags. Mr Sharman states that these have been sold through T.G.I. Friday's restaurants and also other retail outlets; see paragraph 13 of his affidavit. Exhibit LS8 consists of various catalogues showing a range of goods. From examining this exhibit I reach the view that three of these are aimed at the market in the United States. I base this finding on the fact that the price is given in US\$ and a US telephone number is given. Two of the examples give no indication as to where the products were sold - a drink named "Frozen Very Vanilla" and some food containers showing a range of foodstuffs. The last example does show use of the trade mark on a frozen desert sold through TESCO - though no date is given for this use.

25. In the absence of specific turnover figures showing the level of turnover and duration of use of these trade marks in the United Kingdom in relation to the goods for which they are registered, I am unable to assess the level of reputation, if any, these registrations enjoy. As such I find that the opponents have failed to show the necessary reputation required by section 5(3) and therefore, I find that the opponents' ground of opposition under section 5(3) fails and should be dismissed.

26. Finally I consider the opponents' ground of objection under section 5(4)(a). I should state at the outset that I cannot see how the opponents can be in a better position under this section than under section 5(2)(b). The requirements for passing off have been restated many times and can be found in the decision of Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents; and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

27. As part of my decision under section 5(2)(b) I found that the opponents had established a reputation in the United Kingdom in respect of what might be termed restaurant and bar services. As stated under section 5(3), in my view, on the basis of the evidence before me I am unable to find that their reputation extends to other goods or services. Having found that the opponents have the necessary reputation in relation to restaurant and bar services, I must consider whether there is a misrepresentation by the applicants. The opponents' reputation is, in my view, established in respect of the opponents' trade marks set out above under section 5(2)(b). However, I will also consider whether the opponents have any reputation in the letters T.G.I.. In their written submissions, the opponents claim a reputation in those letters, but, on the basis of the evidence before me, I find that claim to be unsubstantiated. As noted above, I reach the view that the opponents' trade marks should be taken as a whole and I find insufficient evidence to support a separate or enhanced reputation in the letters T.G.I. when used on restaurant or bar services. Therefore, the question of misrepresentation under section 5(4)(a) has to be determined on the basis of a comparison of the applicant's trade mark and the opponents' trade marks set out above. I have already considered the likelihood of confusion between these trade marks under section 5(2)(b) and for the reasons given above, I reach the view that use of the applicant's trade mark on the services for which registration is sought would not result in any misrepresentation. The opponents' case under section 5(4)(a) has not been made out and falls to be dismissed.

28. The applicant has been successful and is entitled to a contribution towards his costs. The applicant's representative requested a higher award costs than would normally be the case. This submission was based on the volume of evidence that was submitted by the opponents and the applicant's contention that much of the evidence was irrelevant. I have found some of the applicant's criticisms to be well made and so will take into account the fact that the applicant's representative had to consider all the evidence filed by the opponents in these proceedings. A standard award of costs from the scale for these proceedings would be £235-00. However, in the circumstances of this case I am prepared to increase those costs to £435-00. Therefore, I order that the opponents pay the applicant the sum of £435-00 as a contribution towards his costs. 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 July 2001

**S P Rowan
For the Registrar
the Comptroller General**

Annex

1257646



Class 29

Meat; fish, poultry and game, none being live; all for food for human consumption; meat extracts; fruits and vegetables, all being preserved, dried or cooked; jellies and milk products, all for food; jams, eggs, milk; edible oils and edible fats; salad dressings; food preserves.

1257647



Class 30

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour, preparations made from cereals for food for human consumption, bread, pastry, non-medicated confectionery; ices, honey, treacle; yeast and salt, all for food; baking powder, mustard, vinegar, sauces (other than salad dressings), spices (other than poultry spice); ice.

1257648



Class 31

Fresh fruits and fresh vegetables.

1267638



Class 32

Beers; mineral waters, aerated waters, non-alcoholic drinks, syrups and preparations for making beverages, all included in Class 32; fruit juices for use as beverages.

1267639



Class 33 Alcoholic beverages included in Class 33.

1283967



Class 42

Restaurant services and bar services for the provision of food or drink all included in Class 42.

1257644



Class 16

Articles included in Class 16 made from paper and from cardboard; printed matter; plastics material included in Class 16 for packaging; all being for use in the restaurant and catering trades or in franchising operations associated therewith.

1257645



Class 25 Footwear and headgear, all included in Class 25.

1254937

T.G.I. FRIDAY'S

Class 16

Paper, paper articles, cardboard and cardboard articles, all included in Class 16 printed matter, books, transfers (decalcomanias); bags and wrapping materials, all included in Class 16; boxes of paints for use by children; crayons, writing chalks, chalkboards and calenders; all for use in the restaurant and catering trades or in franchising operations associated with such trades.

1167129

T.G.I. FRIDAY'S

Class 29

Meat; fish, poultry, game and vegetables all being prepared; preserved and cooked fruits, soups made from any of the aforesaid goods; eggs, milk, cheese; dairy products, jellies, all for food; jams, fruit preserves, vegetable preserves and pickles.

1167130

T.G.I. FRIDAY'S

Class 30

Prepared coffee, decaffeinated coffee; mixtures of coffee and chicory, coffee essences and coffee extracts; chicory and chicory mixtures, all for use as substitutes for coffee; tea, sugar, rice, tapioca, sago, bread, cakes, pies, pastry, ices, honey, salt for food, mustard, pepper, condiments, vinegar for salads, sauces, spices (other than poultry spice).

1505884

T.G.I. FRIDAY'S

Class 31

Fresh fruit and vegetables; all included in Class 31.

1167131

T.G.I. FRIDAY'S

Class 32

Beer, ale, and porter; non-alcoholic beverages, and concentrates, syrups and preparations for making such beverages, all included in Class 32.

1167132

T.G.I.FRIDAY'S

Class 33

Wines, spirits (beverages) and liqueurs; but not including rum

1283966

T.G.I. FRIDAY'S

Class 42

Restaurant services and bar services for the provision of food or drink, all included in Class 42.

1506128, 1506129, 1506130, 1506131, 1506132, 1506133, 1283965

FRIDAY'S

In Classes

16, 29, 30, 31, 32, 33, 42

1348537



Class 42

Restaurant and bar services for the provision of food and drink; all included in Class 42.

1246032

T.G.I. FRIDAY'S POTATO SKINS

Class 29

Cooked potato products containing fillings.

1246983

T.G.I. FRIDAY'S POTATO SKINS

Class 16

Paper, paper articles, cardboard cardboard articles, bags and wrapping materials, all included in Class 16; table linen, table mats, table napkins, table cloths, coasters, decanter mats, drinks mats, all made of paper; printed matter, printed publications, books, menu cards (printed), transfers (decalcomanias), crayons, chalks for use in writing and drawing, chalkboards and calendars; all for use in the restaurant and catering trades or in franchising operations associated with restaurant and catering trades.

2116379

FRIDAY'S WRAPPERS

Class 42

Restaurant and bar services.

Class 29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; eggs; milk products; prepared snacks and meals containing predominantly any of the aforesaid products.

1268373



Class 32

Beer; fruit juices for use as beverages; non-alcoholic drinks and preparations for making beverages, all included in Class 32.

1292469

T.G.I. FRIDAY'S THE AMERICAN BISTRO

Class 42

Restaurant and bar services, all included in Class 42.