

TRADE MARKS ACT 1938 (AS AMENDED) AND THE TRADE
MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION N° 1540904
BY TENNESSEE FRIED CHICKEN (EUROPE) LTD TO REGISTER THE
MARK



AND
IN THE MATTER OF OPPOSITION
THERE TO UNDER OPPOSITION N° 43071
BY HYCARE FAST FOODS LTD

TRADE MARKS ACT 1938 (AS AMENDED) AND THE TRADE MARKS ACT 1994

IN THE MATTER of trade mark
application N° 1540904 by Tennessee Fried Chicken (Europe) Ltd
to register a mark in class 29

5 and

IN THE MATTER of opposition
thereto under opposition N° 43071
by Hycare Fast Foods Ltd

DECISION

10 Tennessee Fried Chicken (Europe) Ltd applied on 7 July 1993 under section 17(1) of the
Trade Marks Act 1938 to register the mark shown below in Class 29 for:

“Chicken products; cooked or prepared vegetables; vegetarian burgers; salads; soups;
all included in Class 29; all for sale in the Greater London area and Birmingham.”



15 The application was given the number 1540904 and published for opposition purposes on
7 June 1995. On 6 September 1995 Hycare Fast Foods Ltd formally opposed the application.

I summarise the grounds of opposition as follows:-

- Section 12(1) — The mark applied for so closely resembles the opponent’s trade mark (N° 1342494) as to be likely to deceive or cause confusion; the mark applied for is in respect of goods or a description of goods which are associated with the services of the registration and therefore grant of application N° 1540904 would be contrary to the provisions of section 12(1) of the Trade Marks Act 1938 (as amended).
- Section 11 — In view of the opponent’s prior use of the mark TENNESSEE FRIED CHICKEN, use by the applicant of the mark applied for would be disentitled to protection in a Court of Justice as it is likely to deceive or cause confusion; therefore

its registration is contrary to the provisions of section 11 of the Trade Marks Act 1938 (as amended).

- 5 ● Section 17(1) — The opponent contends that its plans to use the mark TENNESSEE FRIED CHICKEN were known to the applicant; accordingly the adoption and use of the mark applied for by the applicant, insofar as it includes the words TENNESSEE FRIED CHICKEN, is not bona fide and the applicant cannot claim to be the proprietor of the mark. Accordingly registration of the mark would be contrary to section 17(1) of the Trade Marks Act 1938 (as amended).
- 10 ● Section 9 & 10 — The opponent contends that by virtue of the geographical signification of the word TENNESSEE and the non-distinctiveness of the words FRIED CHICKEN, the mark applied for would be contrary to sections 9 and 10 of the Trade Marks Act 1938 (as amended) and should be refused.
- 15 ● Section 11 — The opponent further contends that because the mark applied for includes the words FRIED CHICKEN, use of this mark on goods other than those containing fried chicken would be likely to deceive or cause confusion and would be contrary to the provisions of section 11 of the Trade Marks Act 1938 (as amended).
- Section 17(2) — Finally, the opponent also requests that the application be refused in the exercise of the Registrar’s discretion.

In response, the applicant filed a counterstatement denying each of the grounds pleaded.

20 Both parties seek an award of costs in their favour.

The matter came to be heard on 2 December 1998. At the hearing, the applicant was represented by Ms Jennifer Maddox of the Trade Mark Protection Society. The opponent was represented by Mr Alan Bernard of F J Cleveland & Co.

25 By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. Nevertheless, these proceedings having begun under the provisions of the Trade Marks Act 1938, they must continue to be dealt with under that Act in accordance with the transitional provisions set out at Schedule 3 of the 1994 Act. Accordingly, and unless otherwise indicated, all references in the remainder of this decision are references to the provisions of the old law.

30 Opponent’s Evidence

The opponent filed two statutory declarations by Mustafa Ahmed Mahmoud (one of which was in reply to the applicant’s evidence) and one by David Harvey Lloyd Edwards

35 Mr Mahmoud is a Director of Hycare Fast Foods Limited (hereafter “Hycare”), a position that he has held since February 1986. Prior to that date, he had been employed by Hycare Fast Foods Limited as general manager since July 1983.

In his first declaration, dated 20 August 1996, Mr Mahmoud declares that Hycare Fast Foods Limited has been operating fast food shops since 1976. Between 1976 and 1988, the company held franchises from the well-known company Kentucky Fried Chicken and ran five outlets in South Wales, Gloucestershire and Wiltshire under the name Kentucky Fried
5 Chicken. At the end of 1987, the opponent decided to become independent of Kentucky Fried Chicken and run its own outlets. They commissioned a designer in Switzerland to design a logo incorporating the words Tennessee Fried Chicken. At the beginning of 1988, Hycare sought to terminate its franchise agreements and operate the shops independently under the new name of Tennessee Fried Chicken.

10 As a former employee, Mr Mahmoud handled the negotiations with Kentucky Fried Chicken (Great Britain) Limited. He says that he was completely open with Kentucky Fried Chicken and advised them of his plans during the spring of 1988 telling them that Hycare planned to open under its new style from mid-September of that year. In order to obtain Kentucky Fried
15 Chicken's agreement to terminate the franchise agreements, it was a condition that they would have to give their prior approval to Hycare's proposed trading name and style of operation. Therefore, says Mr Mahmoud, full details of Hycare's proposed trading name, logo, colours, packaging and uniforms were submitted to Kentucky Fried Chicken for their approval prior to the termination of the franchise agreements. Mr Mahmoud states that all the
20 important details of Hycare's proposed operation were known to the relevant persons in the Kentucky Fried Chicken offices.

On 23rd April 1988, Hycare applied to register its trade mark (N^o 1342494) in Class 42 for "Restaurant services; all included in Class 42". That application was entered on the register on 24 November 1993.

25 Mr Mahmoud then goes on to say that Hycare received a letter dated 21st July 1988 from a firm of solicitors acting for a company called Tennessee Fried Chicken (European) Limited which had recently been formed. The letter claimed that their clients (the applicant in these proceedings) had been trading as a fast food shop since 20th July 1988, i.e. the day before the letter was written. A copy of the solicitors' letter is exhibited to Mr Mahmoud's declaration at MM5. The text of the letter is reproduced at page 9 of this decision.

30 Mr Mahmoud says that he was very suspicious of the alleged use claimed by Tennessee Fried Chicken (European) Ltd. He says:

"We noticed that the solicitors' letter was referenced "Mattadeen" and we knew a Mr Mattadeen to have been a business associate of a person in the office of Kentucky Fried Chicken to which we sent our advance details."

35 After Hycare's trade mark was registered, their solicitors wrote to Tennessee Fried Chicken (European) Ltd and requested that they cease infringement of the registered mark. But, says Mr Mahmoud, the applicant's response was that they did not provide **restaurant services** under the name of Tennessee Fried Chicken and that their business is concerned with take-away foods only.

Mr Mahmoud says that Hycare subsequently checked out various of the applicant's premises and took photographs clearly showing seating and tables in some of the stores and the inclusion of the word restaurant on the fascia boards.

Sales figures for the years since Hycare changed its trading name to Tennessee Fried Chicken are given as:

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Six months to 31.3.1996	£510,401
Year to 31.3.1990	£972,156
Year to 31.3.1991	£963,389
Year to 31.3.1992	£872,445
Year to 31.3.1993	£826,498
Year to 31.3.1994	£795,416
Year to 31.3.1995	£808,616
Year to 31.3.1996	£839,361

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(It seems likely that the reference to 1996 in the first row is a mistake, and that the period should in fact be the six months to 31.3.1989; in the event, nothing turns on this.)

20

Mr Mahmoud adds that Hycare has advertised its products and services extensively since the first outlets were opened. Advertisements have been placed in the local press, including most of the main local papers in each of the areas where they have an outlet. He says that his company has also placed advertisements on local buses, and he exhibits (MM9) a photograph of a bus advert for the Gloucester shop and restaurant. Advertisements have also been placed on buses in Newport.

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Hycare opened a new outlet in 1996 in Merthy Tydfil and plans to open others in due course. Mr Mahmoud confirms that it has always been Hycare's intention to expand its business further by franchising; a practice which he describes as a normal development for a business of this kind. But he says that he has already encountered a number of instances of confusion between his company's outlets and those of the applicant. Some customers have remarked that they have seen one of the opponent's stores in London, whereas in fact it is one of the applicant's stores. Mr Mahmoud says that Hycare is concerned that this kind of confusion could damage their business.

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The opponent also filed a statutory declaration by Mr David Harvey Lloyd Edwards, a technical assistant employed by F J Cleveland & Co. Mr Edwards' evidence concerns a number of visits he made to fast food outlets operated by the applicant, as well as other take-away food stores. The purpose of Mr Edwards' evidence appears to be to show a) that the applicant's stores provide tables and chairs for customers to eat-in, and b) that take-away foods stores are commonly regarded as restaurants. At the hearing into this matter, Ms Maddox criticised Mr Edwards' evidence on the grounds that it all related to

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circumstances **after** the material date in these proceedings. Whilst this is clearly true, I do not accept Ms Maddox's conclusion that Mr Edwards' evidence is flawed as a result — in particular it is difficult to see how the opponent could be expected to have conducted such investigations prior to the material date unless they had prior notice of the applicant's intention to file the application in suit.

Nevertheless, in the circumstances my decision in this matter does not depend on Mr Edwards' testimony and I therefore see no need to review his evidence in detail.

Applicant's Evidence

The applicant's evidence comprises a statutory declaration, dated 7 April 1997, by Lincoln Matadeen. Mr Matadeen is a Director of Tennessee Fried Chicken (European) Limited.

Mr Matadeen says that the first TENNESSEE FRIED CHICKEN take-away food shop opened at 228 High Street North, East Ham, London in June 1988. By October 1988 his company was operating three more TENNESSEE FRIED CHICKEN shops at the following addresses:

339 Upper Richmond Road West, East Sheen SW14
21 Lavender Hill, Battersea, London SW11
159 Earls Court Road, London W8

He declares that the name TENNESSEE FRIED CHICKEN and the rooster device appeared on the shop fascias. The food sold by the shops consisted of cooked chicken, chipped potatoes, soups, salads, sauces and condiments which customers purchased for consumption off the premises.

In September 1988, the applicant instructed Trade Mark Protection Society to apply to register its trade mark in class 29 in respect of chicken products; cooked or prepared vegetables; vegetarian burgers; salads; soups. The application (N^o 1359584) was initially refused because of the geographical significance of the word TENNESSEE in relation to goods in class 29, but eventually proceeded for the rooster logo only, the words TENNESSEE FRIED CHICKEN having been removed from the application.

Referring to the current application, Mr Matadeen states that it was accepted for advertisement on the basis of evidence of use and honest concurrent use vis-à-vis trade mark N^o 1342494 of which the opponent is the registered proprietor. (Ms Maddox confirmed at the hearing that this part of Mr Matadeen's evidence is factually incorrect —the application did not proceed on the basis of honest concurrent use.)

Between 1988 and 1993, the applicant continued to trade under the name Tennessee Fried Chicken in the London area and opened further shops during that time. A number of the shops were operated under licence by franchisees. At the date of application (7 July 1993) the applicant was operating seventeen (17) shops in the Greater London area, two in Birmingham, one in Leonard-on-Sea and one in Letchworth.

Mr Matadeen provides the following turnover and advertising figures in respect of his company's TENNESSEE FRIED CHICKEN shops for the years 1988 to 1993:

	Year	Turnover	Advertising
	1988/89	£460,000	£2,500
5	1989/90	£750,000	£5,000
	1990/91	£2,028,000	£12,000
	1991/92	£3,000,000	£9,000
	1992/93	£2,850,000	£8,000

Mr Matadeen says that his company's TENNESSEE FRIED CHICKEN take-away shops have been promoted regularly in media directed mainly to the Greater London area but also to Birmingham. In particular, advertisements have appeared regularly in local newspapers such as:

15 Islington Gazette
Hackney Gazette
Richmond Herald

He adds that his company has also bought advertising time on local radio from time to time, eg Radio Kiss FM in August 1991, and that the trade mark appears on all the shop fascias and on all the packaging for the foodstuffs. It also appears on price lists, hand-outs, napkins, condiment packets and cleansing towelettes, as well as promotional posters from time to time.

20 Mr Matadeen concludes his declaration with the following two paragraphs:

25 "Through its trading efforts, my company was able to establish by July 1993 a reputation in its trade mark in the Greater London area and in Birmingham and considerable goodwill. At the date of application for registration of the trade mark in suit, my company was the proprietor of substantial common law rights in the name TENNESSEE FRIED CHICKEN in relation to take away foodstuffs - principally deep fried chicken and chips, but also other foods such as pork ribs and vegetarian burgers and soups, salads and sauces in the Greater London area and Birmingham.

30 I verily believe that the applied-for mark is distinctive of my company's business in the specified goods in the Greater London area and in Birmingham and fully meets the requirements for registration. I am not aware of any confusion between my company's business and anyone else's and in view of the reputation my company enjoys in its trade mark, I would not expect there to be any confusion."

That concludes my review of the evidence, and I turn to consider the respective grounds of opposition.

Section 12(1)

This section of the Act reads as follows:

- 5 “12(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-
- a. the same goods,
 - b. the same description of goods, or
 - 10 c. services or a description of services which are associated with those goods or goods of that description.”

The reference in this section to a near resemblance is clarified by section 68(2B) of the Act which says that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

- 15 The opponent has an earlier registration for the mark TENNESSEE FRIED CHICKEN in Class 42 for restaurant services. Before going any further, I need to establish whether such services are associated with the goods specified in the application: ie. chicken products, cooked or prepared vegetables, vegetarian burgers, salads, soups. The Act provides the following assistance at section 68(2A):

- 20 For the purposes of this Act goods and services are associated with each other if it is likely that those goods might be sold or otherwise traded in and those services might be provided by the same business, and so with descriptions of goods and descriptions of services.

- I think it is fair to say that Ms Maddox did not accept that the relevant goods and services are associated, but nevertheless in view of the wording of section 68(2A) I have little difficulty
- 25 reaching the conclusion that they are associated. It was common ground at the hearing that both parties operate in precisely the same field of trade, that is to say, operating chains of fast food outlets. Whereas the opponent chose to protect its mark in Class 42 with reference to ‘restaurant services’, the applicant has applied to register its mark in Class 29 for the sort of goods which are generally sold in restaurants. The distinction and its consequences in law
- 30 may well be the subject of endless debate in the trade mark profession, but yet it is of little or no significance to the average relevant consumer.

The standard test for opposition under section 12 has been laid down in the *OVAX* case¹ by Mr Justice Evershed. Applied to the facts of the present case, the test may be expressed as follows:

¹Smith Hayden & Co Ltd’s Application [1946] 63 RPC 97

Assuming use of the opponent's mark TENNESSEE FRIED CHICKEN in a normal and fair manner for the services covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception or confusion amongst a number of persons if the applicant uses their mark (shown right) normally and fairly in respect of any goods covered by the proposed registration?



Clearly both marks contain the same three words, TENNESSEE FRIED CHICKEN. Mr Bernard argued that the words 'speak' in a composite mark like the applicant's, and the rooster device is merely an adjunct. On the other hand Ms Maddox maintained that the words FRIED CHICKEN are highly descriptive, in comparison with which the rooster device is seen as a particularly distinctive element of her mark. The *ERECTIKO* case² cautions against analysing trade marks in such a way that they are differentiated as a result of comparison of individual elements without proper regard to the overall impression created. Notwithstanding this, I do not believe that I can easily overlook the fact that the opponent's earlier mark is entirely subsumed in the applicant's mark. Fast food outlets are often recommended by word of mouth, and in such situations the rooster device will not be able to distinguish between two separate undertakings.

I do not overlook the limitation contained in the specification of the rights sought by the applicant; that is to say, that the goods are all for sale in the Greater London area and Birmingham. The rights extending from the opponent's registration are not limited to any specific region(s) of the country, and although the opponent has so far confined its trading activities to South Wales, Gloucestershire and Wiltshire, Mr Mahmoud declares that it has always been the opponent's intention to expand its business further, eg by franchising. Mr Bernard also submitted that it was a normal development for a business of this kind to start with a small number of outlets and gradually expand to other towns and cities. Mr Bernard also pointed out that it was common for people to travel between South Wales and London and that the ease of such travel would increase the likelihood of confusion/deception.

Taking the best view I can of the matter, I believe that there **is** a reasonable likelihood of deception or confusion amongst a number of persons and the opposition under section 12(1) would succeed accordingly.

However, my finding under section 12(1) of the Act is not the end of the matter since Ms Maddox claimed that the application should be accepted by virtue of the provisions of subsection 2 of section 12 of the Act.

This subsection states:-

"12(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the court or the Registrar may permit the registration by more than one proprietor in respect of:-

- a. the same goods

² *ERECTIKO* Trade Mark [1935] RPC 136

- b. the same description of goods or
- c. goods and services or descriptions of goods and services which are associated with each other.

5 of marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or Registrar, as the case may be, may think it right to impose.”

The main matters for consideration under Section 12(2) were laid down by Lord Tomlin in the *PIRIE* case³. They are:

- (i) the extent of use in time and quantity and the area of trade;
- 10 (ii) the degree of confusion likely to ensue from the resemblance of the marks, which is, to a large extent, indicative of the measure of public inconvenience;
- (iii) the honesty of the concurrent use;
- (iv) whether any instances of confusion have been proved;
- 15 (v) the relative inconvenience which would be caused if the mark in suit was registered, subject if necessary to any conditions and limitations.

I told Ms Maddox at the hearing that the evidence in these proceedings raised serious doubts in my mind about the honesty of the concurrent use. The evidence shows that in the spring of 1988, Hycare held discussions with Kentucky Fried Chicken with a view to taking a number of stores out of the Kentucky Fried Chicken chain and restyling them under the new brand, TENNESSEE FRIED CHICKEN. The restyled branches were to be opened in September 1988, but on 21 July 1988 the applicant’s solicitors wrote to Hycare as follows:

re:-Tennessee Fried Chicken European Limited

We have been instructed by our above named clients to write to you regarding your proposed use of our client company name.

In this respect we are instructed that you propose to open fast food shops both in Wales and in Bristol using the same name as our clients. We would inform you that our clients’ company name has been registered and indeed they have been trading under that name [as] a fast food shop in London since 20th July 1988. In the circumstances we must inform you that it will not be possible for you to use the same name and we would ask you to confirm that you will not do so by 10.a.m. on Monday next the 25th July 1988.

Yours faithfully

Read & Rogers

³Pirie’s Trade Mark [1933] 50 RPC 147

Regarding the honesty of the concurrent use in this case, there are two questions that have been raised in the opponent's evidence but which have not been answered. The first is the suggestion that the applicant acquired advance information about the opponent's plans to use the mark TENNESSEE FRIED CHICKEN from a contact in the office of Kentucky Fried Chicken. The second question is to some extent an extension of the first, and concerns **how** the applicant found out about the opponent's plans in July 1988 such that the above solicitors' letter came to be sent the day after the applicant began trading under the same name. I should perhaps add that the opponent's earlier filed application, N^o 1342494, was not published until 20 May 1992.

10 Considering these questions in turn, Mr Mahmoud says that he was very suspicious of the alleged use claimed by Tennessee Fried Chicken (European) Ltd because "*we noticed that the solicitors' letter was referenced "Mattadeen" and we knew a Mr Mattadeen to have been a business associate of a person in the office of Kentucky Fried Chicken to which we sent our advance details.*" The applicant's evidence is provided by a Mr Matadeen. Despite the close
15 similarity between these names (Mattadeen and Matadeen), and notwithstanding Mr Mahmoud's clear suggestion of foul play, Mr Matadeen does not refer to the matter at all. In particular he does not deny an association with a person from the office of Kentucky Fried Chicken. Ms Maddox submitted that it was nothing more than a coincidence, and that the allegation in Mr Mahmoud's declaration was so preposterous that it did not merit a formal
20 response as part of her client's evidence. I disagree. Mr Mahmoud's evidence on the point is circumstantial, as Mr Bernard accepted, but it would have been easy for Mr Matadeen to deny the suggestion with a simple rebuttal, or by explaining how his company came to choose the name TENNESSEE FRIED CHICKEN.

25 If, as the evidence therefore suggests, the applicant decided upon the name after learning of Hycare's proposal for the new identity of its outlets, then the concurrent use that has since taken place cannot, in my opinion, be described as honest concurrent use. That is not to say that Mr Matadeen and/or any person in the office of Kentucky Fried Chicken has done anything illegal, or even dishonest — for there is no evidence that anyone has acted in such a fashion. It is simply that concurrent use of a mark in such circumstances cannot be such as
30 should entitle an applicant to benefit from the exceptional and discretionary provision of section 12(2).

35 But there remains the second question: How did the applicant find out about the opponent's plans in July 1988? Ms Maddox explained at the hearing that her client learned about the opponent's plans when they ordered packaging supplies bearing the mark from the same company⁴ that was supplying the opponent. She explained that the supplier had noticed the coincidence and warned her client of the potential conflict. This is an entirely reasonable explanation, and Mr Bernard did not disagree. Nevertheless, I am conscious that Ms Maddox's explanation in the course of her submissions cannot be elevated to the status of
40 evidence in these proceedings, and even if it could, I would still be obliged to regard it as hearsay.

⁴It appears from the evidence of Mr Mahmoud that the supplier in question was probably Automatic Catering Supplies Ltd, of Morden, Surrey, although nothing turns on this.

Moreover, in the specific context of this enquiry, ie the honesty of concurrent use, the timing of the letter from the applicant's solicitors is, to say the least, unfortunate. In other words, even if I accept the explanation provided by Ms Maddox, why did the applicant not take steps to avoid the ensuing conflict until the day after it had commenced trading under the name?

5 The packaging materials must surely have been ordered from the supplier well in advance of the commencement of trade, and the opponent discussed its packaging requirements with the supplier at a meeting on 10 June 1988 (as demonstrated by exhibit MM4 to Mr Mahmoud's declaration). Of course it is possible that several weeks passed before the supplier noticed the clash of names, and only warned the applicant just as they were about to commence trading,
10 but the coincidence does nothing to assist the applicant's case under section 12(2).

In all the circumstances, I have reached the conclusion that the applicant is not entitled to benefit from an exercise of the Registrar's discretion under section 12(2). The opposition under section 12(1) must therefore succeed.

Request for leave to file additional evidence

15 During the hearing, Ms Maddox sought leave to file additional evidence to remedy the defects which had become apparent in her client's evidence, and, were I minded to grant leave, she also requested an adjournment to allow time for such evidence to be prepared and executed.

Although I gave my decision on this request at the hearing, I find it convenient to state here that I did not find it an easy decision to make. On the one hand, it was clear to me that
20 Mr Matadeen's failure to answer the questions raised in Mr Mahmoud's evidence was likely to determine the fate of the application. If his silence on the point was the result of incorrect or inadequate professional advice, then it would not seem unreasonable to countenance a delay in proceedings such as would enable Mr Matadeen to remedy the position. But on the other hand, although Ms Maddox was positive as to how her client would respond to the latter
25 of the two questions that I have posed above, I was not persuaded that she was equally confident of his response to the former question regarding the association with Kentucky Fried Chicken. I was also mindful that the questions raised by Mr Mahmoud in his evidence were by no means enigmatic, and also that the applicant had had the benefit of professional representation throughout these proceedings. Weighing all these considerations, and having
30 regard also to the need to ensure that proceedings before the Registrar are conducted efficiently, I refused the request for leave to file additional evidence.

Strictly speaking, I do not need to consider the remaining grounds of opposition since the opposition has succeeded and application must be refused. Nevertheless, I offer the following brief comments in the event that my decision in relation to section 12 is overturned on appeal.

35 *Section 11*

This section is in the following terms:

40 **"11.** It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design."

The established test for objection under section 11 has been laid down in the *OVAX* case⁵ by Mr Justice Evershed and subsequently adapted by Lord Upjohn in *BALI*⁶. Applied to the facts of the present case, the test may be expressed as follows:

5 Having regard to the user of the opponent’s mark, is the tribunal satisfied that the mark applied for, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

10 Ms Maddox reminded me that the specification of her client’s application was limited to goods for sale in the Greater London area and Birmingham, and that the opponent did not trade in either of these areas — a criticism that Mr Bernard accepted. Nevertheless, Mr Bernard argued that it was common for people to travel between South Wales and London, and that, especially given the nature of the trade concerned, the geographical limitation in the specification would do little to reduce the likelihood of confusion. I have already accepted a similar argument in relation to section 12, and I cannot see why the position is any different in 15 this respect under section 11. However, the evidence clearly shows that the applicant was the first to use its mark and in such circumstances I do not believe that the opposition under section 11 would have succeeded on this basis.

20 The notice of opposition raises a further objection to registration under section 11; one which Mr Bernard did not, I think, pursue at the hearing. It is claimed that because the mark applied for includes the words FRIED CHICKEN, use of this mark on goods other than those containing fried chicken would be likely to deceive or cause confusion. Thus in this case the section 11 objection relates not to confusion as between conflicting marks but to the question of inherent deceptiveness of the mark itself in relation to some of the goods at issue. Ms Maddox submitted that the relevant public have long been accustomed to purchasing chipped 25 potatoes and other vegetable products along with meat products from fast food stores, and as a result the public would not be confused into thinking that every item on the menu necessarily contained fried chicken merely because the goods were offered under a mark containing the words FRIED CHICKEN. I accept that this is true, although I note that the specification is not limited to goods sold over the counter in a fast food store. In this case, 30 use in a normal and fair manner would include for example frozen goods offered for sale in a supermarket. Nevertheless, I can see no reason to interfere with the Examiner’s decision that the public would not be deceived or confused by normal and fair use of the mark. The opposition under section 11 would therefore have failed on this basis as well.

Section 17(1)

35 I next consider the opposition under section 17(1), which reads:

“17(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.”

⁵Smith Hayden & Co Ltd’s Application [1946] 63 RPC 97

⁶BALI Trade Mark [1969] RPC 472

The issue in relation to section 17(1) is whether, at the time of filing, the applicant had a bona fide claim to be the proprietor of the mark, or whether, in making such a claim, they were making a false representation to the Registrar. As such, and having regard to the individual circumstances of this case, the opposition based on section 17(1) stands or falls with my
5 decision in relation to the honesty of the concurrent use. Consequently the opposition would succeed under section 17(1) also.

Sections 9 & 10

Although the notice of opposition refers to section 9 and section 10, the application was accepted in Part A of the register. For the reasons given in the *PARISER* case⁷
10 the Registrar has held that he has no power in opposition proceedings to consider an application for registration in Part A as an application for registration in Part B. Therefore I need only decide whether the applicant's mark satisfies the requirements of section 9.

The section reads:

15 “9(1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- 20 (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- 25 (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

(2) For the purpose of this section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods
30 with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally, or where the trade mark is registered or proposed to be registered subject to limitations in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may
35 have regard to the extent to which -

- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.”

⁷In the matter of Parison Fabrics Ltd.'s Application to Register a trade mark and in the matter of Maurice Pariser's Application to Register a trade mark [1949] RPC 9 at page 222.

The opponent contends that the application should be refused because of the geographical significance of the word TENNESSEE and the non-distinctiveness of the words FRIED CHICKEN. Mr Bernard made some very helpful submissions on this part of his case; in particular he referred me to paragraph 8-33 of Kerly⁸ which sets out the usual practice under the 1938 Act in relation to geographical names. Having carefully considered this reference, and all the other submissions that were made at the hearing, I would not have reversed the Examiner's decision to accept the mark in Part A. The mark must be considered as a whole, and although the word TENNESSEE imports a clear geographical significance, I do not believe that it would take much to educate the public to look beyond the ordinary geographical indication and regard the mark, *as a whole*, as an indication of trade origin. In my opinion the evidence shows that by reason of the use of the mark before the date of application, the mark was in fact adapted to distinguish. The opposition under section 9 fails accordingly.

Registrar's Discretion

There remains the matter of the Registrar's discretion. However, this opposition having succeeded under section 12 (the consequences of which are mandatory), it is neither necessary nor appropriate for me to consider exercising the Registrar's discretion under section 17(2).

The opponent, having been successful in these proceedings, is entitled to a contribution towards the costs of mounting the opposition. I therefore order the applicant to pay to the opponent the sum of **£835**.

Dated this 16th day of December 1998

Mr S J Probert
Principal Hearing Officer
For the Registrar, the Comptroller-General

⁸Kerly's Law of Trade Marks and Trade Names; Twelfth Edition, pages 93, 94.