

TRADE MARKS ACT 1994

**IN THE MATTER OF Application N^o: 2156013
by Ruby Tuesday Business Development Incorporated
to register a Trade Mark and**

**IN THE MATTER OF Opposition N^o: 49638 by
Angela and Mark McGinley.**

1. Ruby Tuesday Business Development Incorporated, 150 West Church Avenue, Maryville, Tennessee 37801, USA applied on 21st January 1998 for the mark RUBY'S for 'Restaurant, catering and bar services.'
2. The mark is opposed by Angela and Mark McGinley, by virtue of s. 5(2)(b) of the Act, because of a likelihood of confusion with mark N^o. 2124526, RUBY TUESDAYS, for: 'Café, cafeteria, canteen, restaurant, snack bar, bar and catering services', for which they are the proprietors. This registration was filed 21st January 1997, and registered on 1st May 1998.
3. The applicants deny the grounds and both parties ask for their costs. The matter was heard on 22nd June 2001, where the applicants were represented by Mr Farrington of Ladas & Parry and the opponents by Mr Brown of Alpha and Omega.
4. S. 5(2)(b) states:

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

(a),

(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.'
5. Under s. 6(1) the opponents have an 'earlier mark' for the purposes of s 5(2)(b) (see s. 6(1)(a)).
6. The services at issue I regard as identical.
7. Guidance on this provision has been provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] ETMR 1 and *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.
8. It is clear from *Sabel* (page 224) that 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. The opponents have enclosed evidence on the reputation they have under the mark (see the Statutory Declaration of one of the joint proprietors, Angela McGinley). They have been trading under their name since 1990, via three restaurants, all in Belfast. There is little doubt that these are well known in that city, and it is clear from the exhibits appended to their evidence that have a significant and positive goodwill under the mark. However, there is nothing to suggest that it is anything other than localised, i.e. does not extend beyond Belfast itself.

9. Further, as was pointed out at the hearing by Mr Farrington, the applicants have not enclosed turnover figures, or indicated when their three restaurants were opened, and how long. In view of this, I do not consider that the applicants can pray in aid of their opposition under the s. 5(2)(b) ground the effect of enhanced distinctiveness as sired by reputation on the marketplace. Mr Brown said at the hearing they were not seeking to argue this anyhow.
10. But he did believe that the mark had enough inherent distinctiveness, in relation to the services specified, to benefit from the greater protection due to the increased likelihood of protection envisaged in *Sabel*. I discuss this below.
11. Mr Farrington suggested the necessary comparison under s. 5(2)(b) was a staged process, where the similarity of the marks, the services and then the likelihood of confusion were assessed in three steps. I'm not sure the case law counsels this. Rather, the likelihood of confusion is appreciated globally, taking account all relevant factors (*Sabel* 224). These factors are interactive - for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the services, and *vice versa* (*Canon* page 7, paragraph 17). I note the following from *Sabel*:

‘Article 4(1)(b) of the Directive [equivalent to 5(2)(b)of the Act] does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case. That global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components’.

12. There is no hint of a three stage test here. Rather, I would tend towards the view that the test under s. 5(2)(b) is a single question of the type:

‘Are there similarities between RUBY’S and RUBY TUESDAYS (including visual, aural and conceptual), and the goods or services they specify, which would combine to create a likelihood of confusion in the mind of the average consumer if they were used simultaneously on the market?’

13. A global appreciation involves other factors, but the aural, conceptual and visual similarities between the marks, is a good starting point. Beginning with the conceptual significance of the opponents’ mark, Mr Farrington said, at the hearing:

‘It stands possibly as a noun that is qualified by an adjective, and there is no apostrophe after the TUESDAYS, so it is a ruby kind of a Tuesday..’

And added:

‘We would say that RUBY TUESDAYS denotes something like a ruby kind of a Tuesday. We are thinking in terms of some like TGI Fridays where you have got the day being the predominant aspect and the first part of it not having that same sort of feel’.

14. Another alternative is that 'Ruby Tuesday' will be recognised by many as a reference to the song of the same name popularised by the Rolling Stones. The song is about a woman called 'Ruby Tuesday'. Of course others who are not familiar with the song or the Stones will not see this connection. But, I surmise, will still take the mark as a female name. Though 'Ruby' is not a common Christian name these days, it is not unknown (Ruby Wax, the comedienne, for example) I think that this is the conclusion most people will come to, on seeing the mark for the first time.
15. And there is evidence that this is what happens in practice. The following are from the opponents' exhibits (to Ms McGinley's Declaration):

Exhibit AM3: Article dated 1989, '..I brought a friend along to Ruby Tuesday's..', which uses a possessive form of the name which detracts from Mr Farrington's suggestion. Later on the article says that 'Ruby got the balance about right..'.

Exhibit AM4: A further article dated 1995 from the Irish News calls the opponents' restaurant 'Ruby's' several times. Again, this is consistent with the perception of the opponents' mark as a female name.

Exhibit AM5: Another article, dated 1991, which again refers to 'Ruby's' and finishes: 'I predict there will be a growth of small cafe restaurants like Ruby Tuesday and if they are all as good and friendly as *she* is, they're welcome'. (Emphasis mine).

Exhibit AM6: A further article, this time from 1993, which calls the restaurant 'Ruby Tuesday's'. I also note that in the photograph accompanying this document, depicting the front of one of the opponents' establishments, they, themselves, use this form of the name, despite the lack of apostrophe in their registration.

Exhibit AM7: A final article, dated 1997, which refers to the Stones' song, which is about a woman called Ruby Tuesday.

16. I mentioned above that Mr Brown believed that the mark had enough inherent distinctiveness, in relation to the goods, to benefit from the greater protection due to the increased likelihood of protection envisaged in *Sabel*. My conclusion here, I think, belies this. Though RUBY TUESDAYS is unusual, using the name of a person for that of a restaurant is not uncommon. I do not think I can conclude the mark is the possessor of egregious inherent distinctiveness, such that it is the recipient of the greater protection envisaged in *Sabel*. And, in the light of my conclusions above about the opponents' reputation, distinctiveness, either by 'nature or nurture' (*AD 2000 Trade Mark* [1997] 5 168) is not a factor I must account for in this decision.
17. Returning to the conceptual similarity of the marks, the applicants mark, RUBY'S, is clearly the possessive form of a female name, and thus shares a conceptual link with the opponents' mark.
18. Visually and aurally the marks obviously differ by the presence of TUESDAYS in the opponents mark. I note from *Sabel* that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (page 224). Which part of the opponents' mark is the most distinctive? Mr Farrington, unsurprisingly, said:

‘RUBY’S and RUBY TUESDAYS have a visual similarity and an aural similarity in so far as you have got RUBY at the start, but it is necessary always to look at marks in their entirety.

I think you have probably read through our evidence and we have tried to indicate the differences. With the opponents’ mark, RUBY TUESDAYS, we do not necessarily feel that the aural emphasis is upon the first part of the word. In general terms, I think, it is normally accepted that the first part of the word would dominate a mark, but we would think that probably TUESDAYS is more prominent.’

19. I do not believe the evidence bears this out. In use, consumers seem to focus on the first part of the opponents’ mark (see examples above, paragraph 15). There is, of course, a wider issue here, and it is that of what amounts to ‘normal and fair use of the opponents’ mark. Mr Brown sought to argue at the hearing that this extended to the natural tendency by consumers to shorten certain trade names (recognising the practice, I suggested the names of pubs as examples - the Red Lion to ‘the Lion’, George III to ‘the George’) thus, it is natural that the opponents be called ‘Ruby’s’. However, Mr Farrington thought that, though this might be relevant to s. 5(4)(a), where passing off is the issue, it went beyond normal and fair use for the purposes of s. 5(2)(b). He says, in paragraph 3 of his Statutory Declaration:

‘It is suggested in the Opponent’s evidence that their restaurants are known as RUBY’S. That is not relevant to the grounds of opposition in these proceedings. The Registrar must consider the state of the Register and the Opponent’s mark RUBY TUESDAYS when considering the issues of similarity and confusion and not corruptions of that mark which are not the subject of any protection. Any evidence regarding use of the mark RUBY’S by the Opponents is not relevant to the issues at stake’.

20. I do believe the case law is quite as simple as this. The following is from *Premier Brands UK v Typhoon Europe* [2000] FSR 779, at 778:

‘In this connection, the proper comparison is between the proprietor’s registered trade mark, on the one hand, and, on the other hand, the allegedly infringing sign in the way in which it is used; in this connection:

“[Section 10(2)] requires the court to assume the mark of the [proprietor] is in a normal and fair manner in relation to goods for which it is registered, and then to assess the likelihood of confusion in relation to the way in which [the alleged infringer] uses its [sign], discounting added matter or circumstances”.

(See per Jacob J. in *Origins Natural Resources Inc. v Origin Clothing Ltd* [1995] FSR 280 at 284, as subsequently amended by him in *British Sugar* [1996] RPC. 281 at 293-294).

On behalf of TEL, Mr Bloch argued that it follows from this observation that Premier could not rely upon the way in which it actually uses the TY.PHOO mark, and that, therefore, Premier could not claim a reputation in so far as it is based on its colour scheme (and in particular on the fact that the mark TY.PHOO was frequently used written white on red): Premier’s trade mark registration is not limited to that, or any other particular colour scheme. I do not accept that submission. Premier’s registrations are for the word mark TY.PHOO and, as Jacob J. said, the allegedly infringing sign has to be compared with that

mark “used in a normal and fair manner in relation to goods for which it is registered”. In my judgment, in the absence of argument or evidence to the contrary, the way in which the proprietor actually uses the mark can be said, at the very least *prima facie*, to be the paradigm case of its use in a normal and fair manner. It seems to me that Mr Arnold was also correct in submitting that this conclusion was consistent with the proposition, established in the three decisions of ECJ to which I have referred, that acquired reputation can broaden the protection afforded to a mark, even one which was initially wholly undistinguished. In the present case, Premier’s most frequent depicted use of the TY.PHOO mark (white capitals on a red background with the T in somewhat larger format than the rest) appears to me to be a normal and fair manner of the use of the mark’.

The ‘three’ decisions of the ECJ Neuberger J refers to are *Sabel*, *Canon* and *Lloyd*. I have already concluded that there is no enhancement of the distinctiveness of reputation of the opponents’ mark by virtue of its use on the market. However, I think the point made by Mr Justice Neuberger is normal and fair use of a mark is informed by the way the registered proprietor actually uses it. I note that the opponents do, indeed, use the term RUBY’S, as evidenced in Exhibit AM2, a children’s menu (used since 1990) which contains the statement colour in ‘colour-in “Ruby’s”’, against a black and white drawing of the restaurant.

21. Of course, this can be taken too far. The following is from *South Cone Incorporated v Reef*, a thus far unreported judgement of the High Court, dated 16th May 2001:

‘In my judgment, it is not legitimate effectively to vary the mark under consideration by considering how it (or related marks) have been used in practice. Thus, if the opponent’s use is fairly to be considered as use of the mark REEF alone, that use does not assist under section 5(2)(b), although it will be highly relevant under, section 5(4). However, fair use of the opponent’s mark as registered must encompass versions where BRAZIL does not play a prominent role. Thus, fair use of the mark will include uses generally of the type represented by these logos. In my judgment, the manner in which the word BRAZIL is to be taken to be used for the purpose of this comparison must also be taken to include a use suggesting a subclass or sub-division of the notional range of products offered under the specification of goods. A geographical term is apt to denote a subclass of this type’.

22. I must admit to some degree of puzzlement as to why the opponents did not plead s. 5(4)(a) as well, as I do not believe I can extend the comparison under s. 5(2)(b) to a part of the mark. However, though it is the case that the average consumer *normally* [my emphasis] perceives a mark as a whole and does not proceed to analyse its various details (*Sabel* page 224), the weight one gives to this must be determined on a case by case basis, and I do not believe here, I can disregard the tendency of restaurant goers - the ‘average consumer’ in this matter - as proved by the evidence, to shorten RUBY TUESDAYS to RUBY’S. Taking everything together - i.e. conducting a global assessment - I think I must come to the conclusion that confusion is likely. The applicants’ mark is subsumed by the opponents’; the services at issue are identical; there is a shared conceptual link and RUBY’S dominant in actual use of the mark.
23. Had the applicants done something to take their mark further away from that of the opponents - for example by calling it RUBY plus something else (another name for example) this might have been enough to tip the scales in their favour. However, RUBY’S *solus* is, in my view, predisposed to invade the distinctiveness of the earlier mark. The application is therefore refused.

24. I also note, from *Canon* (page 9, paragraph 29) that if the association between the marks causes the public to wrongly believe that the respective services come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section. In the light of my deliberations above, I think this is also a pertinent consideration.
25. Finally, for the sake of completeness, Mr Farrington referred to his evidence of use of the marks in other 'common law' jurisdictions, and to registrations in the UK that contain the word RUBY or RUBY'S. Neither of these submissions help, in my view. I have no idea of the circumstances which surrounded acceptance of these various applications, and it is usual to ignore the 'state of the register', and jurisdictions outside the UK where the subtleties of trade mark law may be very different.
26. In terms of costs, the opponents have won and should receive a contribution. I set this at £835 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 9TH Day of October 2001

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