

O-353-19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 279 772: FROZEN
FRIDAYS IN CLASS 32 BY RAZA REHMAN

AND

IN THE MATTER OF OPPOSITION THERETO BY TGI FRIDAYS FRANCHISOR,
LLC

Background and pleadings

1. Raza Rehman (the applicant) applied to register the trade mark FROZEN FRIDAYS under No 3 279 772 in the UK on 30th December 2017. It was accepted and published in the Trade Marks Journal on 19th January 2018 in respect of the following goods in Class 32:

Beers; mineral and aerated waters and other nonalcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; semi-frozen carbonated and non-carbonated beverages; soda; cola; lemonade; sports drinks; energy drinks; fruit based drinks; mixed vegetable-fruit beverages; juices; isotonic beverages; and soft drinks.

2. TGI Fridays Franchisor, LLC (the opponent) oppose the trade mark on the basis of Section 5(2)(b) and Section 5(3) of the Trade Marks Act 1994 (the Act). This is on the basis of, amongst others, the following earlier European Union (EU) trade mark: 806802: FRIDAY'S, registered for:

Class 16:

Printed matter; printed publications; paper articles; cardboard articles; stationery; posters.

Class 33:

Alcoholic beverages

Class 42:

Provision of food and drink; cafeteria services; bar and restaurant services.

3. Under Section 5(2)(b), the opponent argues that the respective goods and services are identical or similar and that the marks are similar. Under Section 5(3), the opponent argues that its earlier trade marks enjoy a reputation and that (the applicant) will benefit from (the opponent's) investment in advertising, leading to advantage. Further that the applicant will ride on its coat tails and will benefit from the power of attraction, reputation and prestige of the earlier mark(s). The opponent also claims that the later use will be out of its control and that poor quality or offensive goods will cause detriment to its valuable reputation and business. It claims that use of the later mark will dilute the distinctive character and reputation of its marks. Finally, the opponent claims that there is no due cause for adoption of the opposed mark.
4. The applicant filed a counterstatement denying the claims made. It did not request that the opponent provides proof of use of its earlier trade marks relied upon.
5. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
6. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Evidence

7. This is a witness statement, dated 23rd August 2018, from Leanne Stendell, a senior attorney of the opponent. She claims that the opponent has acquired a significant reputation in the marks FRIDAY'S and T.G.I FRIDAY'S throughout the UK.

8. The first restaurant under the name T.G.I FRIDAY'S opened in the UK in 1986. Since then the business has grown significantly to 84 restaurants by August 2018. A list of current restaurants is provided in Exhibit LES1. It is noted that the geographical reach of this is nationwide.
9. In 2015, the restaurants attracted 11.7 million customers; in 2016, this figure was 12.8 million. In terms of revenue, this was £174.4 million in 2014, £193.5 million in 2015 and £211 million in 2017.
10. Exhibit LES2 is a copy of a menu from the restaurant chain.
11. Exhibit LES3 is a copy of an article from "The Caterer", dated 2nd March 2015 within which it describes the restaurant chain having topped "The Sunday Times" list of best companies to work for in 2015.
12. LES4 are copies of articles from both The Sunday Times and The Sunday Times Scotland. The content of these is in respect of the restaurant chain celebrating its 30th anniversary.

Conclusions on the evidence

13. It is considered that the evidence filed clearly demonstrates that the opponent enjoys a significant reputation in respect of restaurant services under its earlier trade mark T.G.I. FRIDAY'S. This is demonstrated by the customer numbers, revenue figures and press articles provided. However, the same does not apply to its earlier trade mark FRIDAY'S. The sole mention of this is contained within the menu sample provided, for example FRIDAY'S desserts/appetizers. The impact of the inclusion of this in the menu is unclear as it is not supported by any other information. It is concluded that there is nothing further in the evidence to suggest that this earlier trade mark enjoys a reputation in its own right. This decision will therefore assess the opponent's position on that basis.

Proof of use

14. It has already been stated that the applicant, in its counterstatement, indicated that it did not require the opponent to provide proof of use of its earlier trade marks. The result of this is that all of the earlier trade marks will be considered across the full range of goods and services for which they are registered.

DECISION

Section 5(2)(b)

15. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(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”.

16. It is noted that more than one earlier trade mark is relied upon and in respect of different goods and services. As such, different considerations will apply. I will firstly compare the earlier European Union trade mark No 806 802 FRIDAY's with the trade mark applied for, returning to the remaining earlier trade marks, should it become necessary.

Comparison of goods and services

17. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

18. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

19. The earlier goods and services are:

Class 16:

Printed matter; printed publications; paper articles; cardboard articles; stationery; posters.

Class 33:

Alcoholic beverages.

Class 42:

Provision of food and drink; cafeteria services; bar and restaurant services.

20. The later goods are:

Class 32:

Beers; mineral and aerated waters and other non alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; semi-frozen carbonated and non-carbonated beverages; soda; cola; lemonade; sports drinks; energy drinks; fruit based drinks; mixed vegetable-fruit beverages; juices; isotonic beverages; and soft drinks.

21. In comparing the later *mineral and aerated waters and other non alcoholic drinks* (which will include all possible non alcoholic drinks including mineral and aerated waters) with the earlier *alcoholic beverages*, it is considered common for a wide range of drinks which initially began life containing alcohol to now have a non alcoholic version. Examples would be wine and cider. These terms therefore contain products that may be in direct competition with one another. They can also coincide in producer, end user and trade channels. They are considered to be similar, to a medium degree.

22. I will go on to consider the following goods: mineral and aerated waters; fruit drinks and fruit juices; semi-frozen carbonated and non-carbonated beverages; soda; cola; lemonade; sports drinks; energy drinks; fruit based drinks; mixed vegetable-fruit beverages; juices; isotonic beverages; and soft drinks. It is considered that these are all types of soft drinks (even those in semi frozen form) . As such and in comparing these goods with the earlier

terms, I am reminded that I am permitted to group items together for the purposes of making such an assessment:

Separate Trade Mark BL O-399-10 (AP):

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

23. In terms of general purpose, it is considered that the later goods and earlier services can coincide. This is because the earlier bar and café services provide drinks which aim to quench thirst. This is also true of the later goods. Further, such establishments are often used to sell the later goods. It is noted that the later specification also includes energy drinks, isotonic drinks and sports drinks. It is considered that these are merely types of soft drinks and their consumption is not restricted so narrowly so as to include only people who have (or are about to) undertake a physical or sporting activity. They are widely available consumables and are commonly offered in bars, cafes and other drink providing establishments. Persuasive support for this can also be found in a recent decision of the Board of Appeal, dated 1st June 2017 (Case R 2103/2016-1) which considered such goods and services to be complementary.

24. In respect of *syrups and other preparations for making beverages* it is considered common for such items to mirror flavours provided by alcoholic drinks (such as gin for example). This provides the consumer with a non alcoholic alternative with the same flavour. The earlier term is *alcoholic beverages* at large. There will be products which fall within this term that are likely to be in direct competition with the later terms. For example, a consumer could choose to buy gin instead of gin syrup and vice versa. Further, the later goods can be used together with the earlier term, for example to add flavour

to a cocktail. There is therefore also a degree of complementarity. As such, it is considered they are similar. To a low to medium degree.

25. In addition, the later *beers* it is noted that In *Group Lottus Corp., SL v OHIM*, Case T-161/07, the General Court held that there was a “lesser” [low] degree of similarity between beers and bar, nightclub and cocktail bar services. It is noted that the earlier trade mark includes the provision of drink at large as well as bar services. There is therefore similarity, to a low degree. The later term can also be compared to the earlier *alcoholic beverages*. They will all be served to the general public in bars and will also be found in the same sections of, for example, supermarkets. There is also therefore similarity here, to a low degree.

Comparison of marks

26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains 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. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

27. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of

the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

28. The respective trade marks are shown below:

FRIDAY'S	FROZEN FRIDAYS
Earlier trade mark	Contested trade mark

29. Both marks are word only and as such have no stand alone visually dominant component. In terms of distinctiveness, FROZEN in the later trade mark may have an allusive quality in respect of items that can be provided in a frozen/very cold manner. That said, the correct approach is to compare the marks as wholes.

30. Visually, the marks coincide in respect of the element FRIDAYS which (notwithstanding the use of a possessive in the earlier trade mark and a plural version in the later trade) appears in both marks. They differ in respect of the additional element in the later trade mark: FROZEN, which does have a visual impact. Despite this, it is considered that the marks are visually similar to a medium degree.

31. Aurally, the marks would coincide entirely in respect of FRIDAYS and differ in respect of FROZEN. There is a medium degree of aural similarity.

32. Conceptually, the earlier trade mark would be understood as referring to the day of the week that (usually) marks the end of the typical working week. There is the use of a possessive apostrophe but it is considered that this will not detract from this conclusion. The later trade mark conjures up a more odd idea of a weekday which has a particular feature: of being frozen, i.e. very cold or turned into ice. That said, the overall concept still centres around the weekday as this is when the frozen feature will occur. This is emphasised by the use of a plural form of the weekday which suggests this feature will take place on a rolling basis, on a Friday. The element FROZEN is therefore qualified by FRIDAYS. Bearing this in mind, it is considered that the addition of frozen to the later mark will not have the effect of creating a clear conceptual gap. As such, a degree of conceptual similarity is evident. This is pitched as being low to medium.

Average consumer and the purchasing act

33. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

34. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The

words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

35. The average consumer of these goods and services will be the public at large. The goods in question are purchased frequently, are consumables and usually inexpensive. The same is also true of many café and bar services (though it is accepted there can be a degree of variation with some such services being relatively more expensive). Bearing in mind all of the aforesaid, the degree of attention expected to be displayed during the purchasing process will therefore not be greater than average. In terms of these goods and services it is likely that the purchase will be visual in nature. This does not mean that aural considerations are ignored as the goods can also be aurally requested.

Distinctive character of the earlier trade mark

36. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested

by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

37. It is noted that the opponent claims it enjoys a reputation in FRIDAY’S. However, for the reasons already given above, it is considered that the evidence does not support this claim. If it cannot show a reputation, it is difficult to see how the opponent can enjoy an enhanced degree of protection through the use made of it. As such, the earlier trade mark must be assessed on a prima facie basis.

38. The earlier trade mark is a weekday. This has no direct relationship to the goods and services for which it is registered. It is considered to have an unusual and memorable quality to it. The use of the possessive apostrophe and its effect has been considered but it is concluded that it is the weekday that will be the core message gleaned from this mark. On this basis and because it is an unusual mark, it is considered that the degree of distinctive character is slightly above average.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

39. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

40. The goods and services have been found to be similar, to varying degrees. It is considered that nothing turns on this variation. The marks have been found to be similar to a medium degree, visually and aurally. There is no conceptual gap to counteract this. Rather, there is also a low to medium degree of similarity in this regard. The degree of attention displayed during the purchasing process is likely to be no greater than average due to the consumable nature of the goods and services. I also take into account that the trade marks are unlikely to be viewed side by side and so can be imperfectly recalled. That said the addition of FROZEN in the later trade mark is a point of difference and so leads to the view that the marks are unlikely to be mistaken for one another. There is considered to be no likelihood of direct confusion.

41. However, this is not the end of the matter in that I must also assess whether or not there is a likelihood of indirect confusion.

42. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

43. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

44. The earlier trade mark is unusual and memorable for the goods and services to which it relates. There is no clear conceptual gap between FRIDAY’S and FROZEN FRIDAYS. It is considered not unreasonable a prospect that many of the drinks provided by the earlier services can also be provided in ready made “frozen” form. This may quite reasonably have the effect of FROZEN in the later trade mark taking on an allusive quality for goods provided with a frozen or very cold feature. To this end, it is perfectly foreseeable that a consumer, familiar with the earlier trade mark in respect of services for the provision of drinks and upon seeing the later trade mark is more likely than not to conclude that the opponent has extended its trade into the provision of drinks (perhaps with a frozen feature). In doing so, a consumer is more likely than not to conclude that the later trade mark is a brand extension of the earlier trade mark. Bearing in mind all of the aforesaid, it is concluded that

there is a likelihood of indirect confusion and as such the opposition succeeds in its entirety.

Final Remarks

45. As the opposition has been found to be successful in respect of the above earlier trade mark, there is no need to consider the remaining earlier trade marks or grounds as they do not materially improve the opponent's position.

COSTS

46. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of opposition and accompanying statement of case (plus official fee) -
£500

Preparing evidence - £500

TOTAL - £1000

47. I therefore order Raza Rehman to pay TGI Fridays Franchisor, LLC the sum of £1000. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 24th day of June 2019

Louise White

For the Registrar