

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE
MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

BETWEEN

GEORGE SMULLEN (Proprietor)

and

GOURMET BURGER KITCHEN LIMITED (Applicant for Declaration of Invalidity)

CONCERNING

Trade Mark No. 237233

The registered trade mark

1. George Smullen, of 110 Old Finglas Road, Dublin 11 is the registered proprietor of the Trade Mark (the “said mark”)

GOURMET BURGER KOMPANY

which was applied for on 16th April, 2007 (the “relevant date”) and is registered under No. 237233 in Class 43 in respect of ‘services for providing food and drink; temporary accommodation’.

Application for declaration of invalidity


2. On 2nd October, 2008, Gourmet Burger Kitchen Limited, a company organised and existing under the laws of England and Wales, applied under Section 52 of the Trade Marks Act 1996 (the “Act”) for a Declaration of Invalidity in respect of the registration and included with the application a statement of the grounds on which it was made. On 11th February, 2010, the Proprietor filed a Notice of Opposition against the application under Rule 41(3) of the Trade Mark Rules, 1996 (“the Rules”). No evidence was furnished by either the Applicant or the Proprietor and both parties declined an offer to be heard.

3. The matter was decided by me, acting for the Controller, on the basis of the documentation filed, and my decision is to refuse the application and to allow the registration of the mark to stand. I now state the grounds of my decision and the materials used in arriving thereat.

Grounds of the Application

4. In its Statement of Grounds in support of the application for a declaration of invalidity, the Applicant makes a number of statements and claims, which I summarise as follows:

- (i) The Applicant has since 2001 used its trade marks in the UK and since March 2008 in Ireland and enjoys unregistered rights in its trade marks by virtue of its reputation. Therefore, the registration of the said mark is prohibited by virtue of Section 10(4)(a) of the Act, which deals with rules of law protecting unregistered trade marks and signs used in the course of trade.
- (ii) The Applicant holds the Community Trade Marks (CTM’s) listed below, all of which have filing dates prior to the relevant date.

Trade Mark	Number	Application Date	Class
	4616546	2 nd September 2005	29, 30, 31, 32, 33 & 43
Gourmet Burger Kitchen	4615341	2 nd September 2005	43
Gourmet Burger Kitchen	6783567	2 nd September 2005	29, 30, 31, 32 & 33

- (iii) The said mark is of such a matter to deceive the public and to lead to the Proprietor’s services being passed off as, or mistaken for, goods or services provided by or for the Applicant and, therefore, the said mark was registered in breach of section 8(3)(b) of the Trade Marks Act, 1996.
- (iv) The use of the said mark is prohibited in the State by enactments or rules of law and, therefore, offends against Section 8(4)(a) of the Act.

- (v) The application was made in bad faith and, therefore, offends against Section 8(4)(b) of the Act.
- (vi) The said mark is similar to the applicant's marks and was registered for services which are identical or similar to those for which the Applicant's marks are protected and there exists a likelihood of confusion or association on the part of the public and, therefore, the said mark was registered in breach of Section 10(2)(b) of the Act.
- (vii) The said mark is similar to the Applicant's marks and the use of the said mark, without due cause, takes unfair advantage of and is detrimental to the distinctive character and reputation of the Applicant's marks and as such was registered in breach of Section 10(3) of the Act.

Notice of Opposition

5. In its notice of opposition against the application for a declaration of invalidity, the Proprietor denies all the grounds and makes a number of statements and claims supporting that denial.

Issues for Decision

6. The Statement of Grounds lodged by the Applicant contained certain allegations (summarised at (iii), (iv) and (v) above) that the Controller considered warranted to be particularised and supported by way of evidence. Accordingly, the Applicant was requested to particularise and submit evidence to support these allegations. The Applicant elected not to do so and informed the Controller that these grounds were no longer being pursued.
7. In light of the above the relevant Sections on which this case rests, and on which I have decided the matter, are Section 10(2)(b) (likelihood of confusion or association), Section 10(3) (unfair advantage of, or detrimental to, earlier marks) and Section 10(4)(a) (protection of unregistered trade marks).
8. Firstly, I shall deal with Section 10(4)(a) (protection of unregistered trade marks). The Applicant has, by its own admission, stated that it commenced trading in the State in

March 2008. As the said mark was applied for on 16th April 2007, it is clear that the Applicant did not enjoy any unregistered rights in its trade marks in the State on that date. Therefore, without further ado, I refuse the application on that ground.

Section 10(2)(b)

9. Turning now to Section 10(2)(b), the relevant part of which, insofar as the present application is concerned, reads as follows:


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

(a)

(b) it is similar to an earlier trade mark and would 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 of the later trade mark with the earlier trade mark.

10. As is evident from the wording of Section 10(2), the four basic requirements that must be met in order for an objection under it to succeed are that, (i) there must be “an earlier trade mark”, (ii) the goods of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, (iii) the mark applied for must be similar to that earlier trade mark, and, (iv) there must be a resultant likelihood of confusion on the part of the public. The following table assesses the Applicant’s marks against the first two criteria.

Trade Mark	Number	Earlier	Class	Similarity of Goods
	4616546	Yes	29, 30, 31, 32, 33 & 43	Identical (in respect of Class 43)
Gourmet Burger Kitchen	4615341	Yes	43	Identical
Gourmet Burger Kitchen	6783567	Yes	29, 30, 31, 32 & 33	Totally Dissimilar

11. The first of the conditions is clearly fulfilled in respect of all three of the Applicant's marks. The marks were filed, at the Community Trade Mark Office, prior to 16th April, 2007 (the relevant date) and by virtue of Section 11(1)(a) of the Act, are earlier trade marks as against the Proprietor's mark for the purposes of Section 10. However, the goods/services protected by CTM 6783567 are not identical or similar to the goods/services of the said mark and, therefore, I reject the application in respect of the ground centred on Section 10(2)(b) of the Act in relation to CTM 6783567, as it fails to meet the second condition of Section 10(2)(b) of the Act.

Comparison of the marks

12. I have compared the respective marks of the parties on the criteria of visual, aural and conceptual similarity and have attempted to make an overall assessment of the extent to which they should be regarded as similar or different. It is important to stress that this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the goods protected by the marks. Notwithstanding the detailed comparisons I make below I am mindful that the European Court of Justice has noted (*Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*)¹ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, the appreciation of the visual, aural and conceptual similarity of the marks must be based on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.

Comparison of the said mark and CTM 4615341

13. Visually and aurally the said mark and CTM 4615341 are similar. Each contains three words, the first two of which, in both cases, are 'gourmet burger'. The third words in each case are not similar, but share insignificant characteristics, i.e. each contains seven letters and begins with a 'k'. The degree of aural similarity matches that of the visual similarity. I would assess the level of both visual and aural similarity as being medium to high. There is conceptual similarity between the said mark and CTM 4615341 as both refer to places, on the one hand a kitchen and on the other a company, (when one takes the view that 'KOMPANY' is a simple play on the common word 'company' - which is the viewpoint I take in this case) from where you can get a 'gourmet burger'. I would

¹ Paragraph 23 of decision dated 11 November, 1997

therefore, describe the overall level of similarity between the said mark and CTM 4615341 as being high.

Comparison of the said mark and CTM 4616546

14. The said mark and CTM 4616546 share less similarity. The figurative element of CTM 4616546 (the concentric circles), and in particular the large letters 'gbk' dominate the mark and immediately catch the eye. The words 'gourmet burger kitchen' are far less prominent or distinctive and, in my view, do no more than provide an explanation of what the letters 'gbk' stand for. Therefore, compared visually, I consider the said mark and CTM 4616546 to be far more dissimilar than they are similar. Verbally, they share some similarity - the reference to 'gourmet burger kitchen', but, in my opinion, one is as likely, if not more likely, to refer to CTM 4616546 as 'gbk' than 'gourmet burger kitchen'. Conceptually they are similar for the same reasons as outlined in paragraph 13 above. In conclusion I consider the level of overall similarity between these two particular trade marks as medium.

Likelihood of confusion or association

15. I must now turn to the question of whether that similarity is likely to result in confusion on the part of the public. It is important, at this juncture, to point out that a decision on likelihood of confusion cannot be reached solely on the basis of the level of similarity as determined by a forensic analysis of the marks. In some cases a low level of similarity could lead to confusion, while it is also possible that a high level of similarity might not. Case-law of the European Court of Justice (ECJ) directs that the likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case². Those factors include, in all cases, the degree of similarity between the respective trade marks and the respective goods/services (which I have already assessed), the distinctiveness of the earlier trade marks, the nature of the goods/services at issue and the circumstances of the trade in them as well as the perception of the average consumer of the goods/services concerned, who is to be regarded as reasonably observant and circumspect but who may rarely have the opportunity to make a direct comparison between the marks and must rely instead on the imperfect picture of them that he keeps in his mind. While each of those factors must be assessed individually and objectively, it

² Case No. C-251/95, Sabel BV v Rudolf Dassler Sport

would be an artificial exercise to seek to separate them, one from the next, in the assessment of likelihood of confusion. Indeed, the concept of a global appreciation of the likelihood of confusion implies some interdependence between the relevant factors³ and their respective effects must be weighed against each other in the overall assessment. For the purposes of setting out the reasons for my decision, I look therefore at the facts of the case as they affect each of the relevant factors individually before turning to the matter of their combined effect on the question of whether or not confusion is likely.

Distinctiveness of the earlier marks

16. In these proceedings the words '*gourmet burger*' are contained in all the Applicant's marks. These two words, individually and combined, lack distinctiveness when used in connection with '*services for providing food and drink*' for which Community Trade Marks 4616546 and 4615341 stand protected. Without at least one additional element that bestows some level of distinctiveness, no matter how low, the words '*gourmet burger*' are incapable of distinguishing one undertaking from another in terms of '*services for providing food and drink*'. The word 'KITCHEN', when added to '*gourmet burger*', provides that level of distinctiveness, albeit a very low one, and just about makes CTM 4615341 a distinctive trade mark. The distinctive elements of CTM 4616546 extend beyond the addition of the word 'KITCHEN' and include the more dominant individual letters 'gbk' and a figurative component comprising concentric black and white circles.

17. However, the distinctive elements of the earlier marks are not to be found in the said mark. Also, by the Applicant's own admission, there was no use of the Applicant's marks in this State before the relevant date and, therefore, the level of distinctiveness of the Applicant's marks was not in any way enhanced through use.

Nature of the services and consumer behaviour

18. The services under consideration are 'services for providing food and drink; temporary accommodation'. These services are aimed at the general public and are typically delivered from premises that are used by the average consumer as food and drink emporiums and meeting places. The service provider may sell food and drink bearing a

³ ECJ in Case No. C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

variety of different trade marks, including its own, or sell food and drink that bear no trade marks (e.g. fish and chips or a cup of coffee). The important point here is that the average consumer associates the delivery of the services in question with an actual place that must be visited (which is, of course, stating the obvious in terms of ‘temporary accommodation’). In terms of the services in question the average consumer is well accustomed to distinguishing one undertaking from another not alone by virtue of their trade marks but also by their ‘get-up’ (the shop-front, décor, furnishings, corporate colours, staff uniforms, etc). Consumers choose to return to a particular undertaking in the knowledge that the overall experience will be exactly what it was the last time the undertaking was visited – albeit that it may be even in a different location. That is the essence of the business of restaurant chains. The Gourmet Burger Kitchen Limited is one such chain, and anyone who uses its services is unlikely to mistake it for, say, a ‘McDonalds’ or an ‘Eddie Rockets’.

19. Notwithstanding all the above the question is how likely is someone, who has previous knowledge of the ‘Gourmet Burger Kompany’ trade mark, to be confused or to associate it with the ‘Gourmet Burger Kitchen’ trade marks, or vice versa? In my opinion the answer to that question is not likely at all, particularly when one considers the typical behaviour of the average consumer of the services in question and that the trade marks relate to services which are delivered from a premises (either permanent or mobile).

20. The term ‘gourmet burger’ is a generic definition for any burger purporting to consist of high-quality or exotic ingredients that requires skilled preparation and must be kept free for use by all undertakings that provide the services in question. Despite the similarity of the trade marks (which relates totally to their non-distinctive elements) the addition of the words ‘kompany’ and ‘kitchen’ respectively, indicates two completely different entities, and, therefore, in my opinion the average consumer would have no difficulty differentiating between the said mark and the Applicant’s trade marks. Therefore I have no hesitation in rejecting the application on the grounds relating to Section 10(2)(b).

Section 10(3) – will use of the said mark take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Applicant’s marks?

21. This is the final ground on which I must decide this matter and the relevant Section of the Act is written in the following terms:

“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 State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.

22. As is evident from the wording of the Section, there are a number of conditions that must be fulfilled in order for it to apply. Firstly, there must be identity or similarity of the marks at issue and I am satisfied that the said mark may be regarded as similar to the Applicant’s marks. Secondly, there must be dissimilarity or similarity⁴ between the respective goods and I have already found this to be the case. Thirdly, the earlier mark must have a reputation in the State. Fourthly, the use of the later trade mark must be without due cause. Fifthly and finally, that use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

Reputation

23. It is clear, therefore, that Section 10(3) is intended to protect only those trade marks that have a reputation in the State and the first thing to be decided in considering the application for declaration of invalidity under this provision is whether the Applicant’s trade marks had a reputation in the State (or in the Community in this case) as of the date of filing of the present application, viz. 16th April, 2007. By the Applicant’s own admission it did not have a reputation in the State at the relevant date. However, the Applicant is the proprietor of Community trade marks that predate the said mark. But does this translate into an entitlement to protection under the Paris Convention as a well-known trade mark? Such a reputation would be expected to extend beyond the limited

⁴ In the light of the ECJ decision in Case C-292/00 *Davidoff* [2003] ECR I-389, it is now more correct to say that there is not a requirement that the goods/services be dissimilar and the provision is equally applicable in the case of similar goods/services.

class of direct users of the Applicant's services and to penetrate the consciousness of the wider public such that a substantial number of people would know and recognise the mark even if they had never used the Applicant's services. The Applicant has adduced no evidence to support a finding that its marks enjoyed that level of reputation as of the relevant date. For that reason, I reject the application under Section 10(3).

24. I would add, in passing, that nothing was presented by the Applicant to support the claim that use of the said mark was without due cause, or to support the claim that use of the said mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Applicant's marks. In that regard, no argument whatsoever has been made by the Applicant as to how the use of the said mark would tarnish the reputation of the Applicant's marks or even diminish the latter's capacity to identify the Applicant's goods/services or, indeed, how such use would in any way profit from or harm the Applicant's marks.

Decision

25. For the reasons stated, I have decided to reject the application for a declaration of invalidity and allow the registration of Trade Mark No. 237233 'GOURMET BURGER KOMPANY' to stand.

Dermot Doyle

Acting for the Controller

17th November 2010