

[2012] EWPC 3

IN THE PATENTS COUNTY COURT

Case No: 1CL70027

Rolls Building
7 Rolls Buildings
London EC4A 1NL

Date: 24 January 2012

Before :

MISS RECORDER AMANDA MICHAELS

Between :

WASEEM GHAS t/as GRILLER

Claimant

-and-

**(1) MOHAMMED IKRAM t/as THE
GRILLER ORIGINAL**

(2) ESMAIL ADIA t/as GRILLER KING

(3) SHAHZAD AHMAD t/as GRILLER HUT

(4) GRILLER ORIGINAL LIMITED

(5) GRILLER HUT LIMITED

Defendants

Ian Silcock (by direct professional access) for the Claimant
Paul Dipré (instructed by **ATM Law Solicitors**) for the Defendants

Hearing date: 13 December 2011

Judgment

Miss Recorder Michaels:

1. Since approximately 2003 the Claimant, Mr Waseem Ghias, has been running a fast food business under the name 'GRILLER'. The Claimant has run his own restaurant under that name, and has franchised others to do the same. This is an action for infringement of two trade marks which he registered in relation to that business.
2. The trade marks upon which the Claimant relies are:

- a. UK Registered Trade Mark No. 2326754, registered with effect from 15 March 2003. It is a device mark, consisting of the word 'GRILLER' with flame effects on either side. There is no colour limitation to the registration:



For convenience, I shall call this mark "the Logo".

and

- b. UK Registered Trade Mark No. 2376629, registered with effect from 26 October 2004. It is also a device mark, in which the word GRILLER and the flame device of the Logo are included, in flame-red, together with a device of a chicken dressed as a waiter, partly coloured yellow, red and orange:



For convenience, I shall call this mark "the Device."

3. Both trade marks are registered in the Claimant's own name and for the same specification of goods and services. The specifications include a wide range of foods and beverages in Classes 29, 30 and 32 and a range of services in Class 43, notably including "Restaurant, bar and catering services." The full specification is set out at the end of this judgment.
4. The identity or name of some of the Defendants has changed as the proceedings have progressed. The only Defendant who has not changed at all is the First Defendant, Mr Ikram, who is sued in relation to a restaurant business trading at 527 Cranbrook Road, Ilford, Essex, IG2 6HA and at 84 Hermit Road, London E16. The business is now run through a company incorporated on 8 September 2010, of which Mr Ikram is a director, called The Griller Original Limited. That company was recently joined as the Fourth Defendant.

5. The current Second Defendant, Mr Adia, runs a business known as 'Griller King' at 10 Central Parade, Denning Avenue, Waddon, Croydon, CR0 4DJ. That business was previously run by a partnership, and sued as such in the claim form. The Particulars of Claim named a Mr Khan and a Mr Ismail as the partners in that business and as the 'joint' Second Defendant. However, by an Order of 29 September 2011, Mr Esmail Adia was named as the Second Defendant, in place of the partnership. I have been told that the Claimant believes that Mr Adia is the same person as the "Mr Ismail" previously named as one of the partners, although this does not appear clearly from any of the evidence before me.
6. The Third Defendant, Mr Ahmad, again was substituted for the original third Defendant, having taken an assignment of a business trading as 'Griller Hut' from such Defendant in June 2010. Mr Ahmad incorporated a company, Griller Hut Limited, on 6 September 2011, and that company was joined as the Fifth Defendant. The 'Griller Hut' restaurant is at 70 High Street, South Norwood, London SE25 6EB.
7. The three businesses, The Griller Original, Griller King and Griller Hut, are not connected and the Defendants are not all alleged to be liable for the same infringements. However, the Defendants all instructed the same firm of solicitors in June 2011 and were represented by the same counsel at trial.
8. Case management directions were given by HHJ Birss QC on 29 September 2011. These provided for the various changes of party which I have described above and limited both disclosure and the evidence to be adduced at trial. The Claimant was given permission to rely on a single witness statement to address the topic of the Claimant's reputation, and the Defendants were given permission to rely on one witness statement per business, intended to address (if so advised) the Claimant's reputation and 'how the alleged similarities between the Claimant's registered trade marks and the Defendants' trading names or styles complained of came about.' The trial was ordered to consist of oral submissions on behalf of the parties, with no oral examination or cross-examination of witnesses. In the event, witness statements were filed by the Claimant, Mr Ikram, Mr Adia and Mr Ahmad.
9. There is one further preliminary point with which I should deal at this stage. The Claimant consulted solicitors in 2009 but has acted throughout these proceedings as a litigant in person. He was represented at the trial by Mr. Ian Silcock of counsel through the direct professional access scheme. In his skeleton argument, Mr Silcock submitted that the claim was for passing off as well as for trade mark infringement. He relied upon the claim form which said "All 3 Defendants have violated our legitimate legal trade mark rights under Trade Mark Act 1994 and Any other law [sic] court see relevant." He also said that correspondence had made it clear that the claims related to the violation of the Claimant's goodwill in the name 'Griller.' He referred me to a letter written by solicitors then acting on the Claimant's behalf to the 'owner/occupier' of 'Griller King' on 11 December 2009. The letter is headed "Trade Mark Infringement" and sets out the Claimant's potential trade mark infringement claim. It also refers to a possibility of bringing a claim for passing off if the

‘Griller King’ signage, etc caused confusion. That was the only such letter which was sent prior to the issue of the claim form. The Claimant also relied on a letter which he wrote to the Defendants on 6 December 2011, that is, in the week before the trial and after exchange of witness statements, saying that the claim was for passing off as well as trade mark infringement.

10. The Defendants objected that the claim for passing off had not been properly pleaded. The Particulars of Claim certainly refer only to the registered marks and to the ‘violation’ of those marks under the Trade Marks Act 1994. Mr Dipré, on behalf of the Defendants, referred me to CPR 16.2. He had appeared at the case management conference before HHJ Birss QC and his recollection was that the lack of any claim for passing off had been mentioned at that hearing, although the Claimant who had also been present disputed this. In the circumstances, Mr Dipré said that the Defendants had not prepared their witness statements on the basis that they needed to deal with passing off, nor had Mr Dipré understood that he needed to deal with the point before receiving the Claimant’s skeleton argument.
11. In my view, the wording of the Claim Form and the Particulars of Claim is not such as to disclose a claim for passing off as well as for infringement of the registered marks. The fact that references to passing off were buried in the body of the Claimant’s solicitors’ letter of 11 December 2009, sent only to the Second Defendant or his predecessor in title, did not suffice in my judgment to put all of the Defendants on notice that such a claim was intended to be made, given the wording of the Particulars of Claim filed over a year later in March 2011. It seems that no further reference was made to a claim for passing off until the case management conference in late September and none was clearly intimated until 6 December 2011, which was after exchange of witness statements. In my judgment, that was too late in the proceedings to raise the point. I note that no application to amend was made at any stage. Even making due allowance for the Claimant’s position as a litigant in person, I consider that it would be unfair to the Defendants to permit the Claimant to advance a claim based on passing off at this stage, and I intend to limit my judgment to consideration of the allegations of trade mark infringement.
12. Mr Silcock also raised an issue as to how I should treat the evidence before me, where none of it was challenged either on paper or through cross-examination. He referred me to the decision of Mr Richard Arnold QC (as he then was) sitting as the Appointed Person in *Brutt* trade mark [2007] R.P.C. 19 and *Pan World Brands Ltd v Tripp Ltd, “Extreme”* [2008] R.P.C. 2. Mr Arnold QC held that where evidence had been given in a witness statement which was not obviously incredible, and the opposing party had not given the witness advance notice that his evidence was to be challenged, nor challenged his evidence in cross-examination, nor adduced evidence to contradict the witness’s evidence despite having had an opportunity to do so, it was not open to the opposing party to invite the tribunal to disbelieve the witness’s evidence.
13. Mr Arnold QC was considering the credibility of unchallenged evidence in proceedings in the UKIPO, where sequential exchange of evidence is the norm, considerations which are rather different from those which arise in this case,

where the parties' evidence was filed simultaneously. Neither 'side' had an opportunity to challenge the other side's witness(es) in their own evidence. Nevertheless, disputed points could have been raised in correspondence before trial, or an application could have been made after the exchange of witness statements for permission to cross-examine on specific points. That was not done, nor were any submissions made to me by either counsel suggesting that any part of the evidence should be disbelieved or was 'obviously incredible.' On the other hand, there is at least one area in which there is a direct conflict of evidence between the Claimant and the First Defendant, which I discuss further below, namely whether the First Defendant was aware of the Claimant's business prior to this dispute arising.

14. In those circumstances, it seems to me that I should accept the contents of each of the unchallenged witness statements before me as accurate so far as they go, but only in so far as they are not inconsistent with another witness statement or with the documents before me. Where there is a conflict of evidence which needs to be resolved, I must do my best to resolve it in the light of all the circumstances and the documentation before me.

The Claimant's business

15. The Claimant's evidence was that in about 2003, with the help of his two brothers, he started his 'Griller' business at premises at 49 High Road, Chadwell Heath, Romford, Essex. At the outset, the Claimant had a single restaurant selling grilled chicken and "fried style chicken". The menu (as shown in some of his exhibits) also offered other fast foods, such as burgers and pizza. The Claimant said that he applied to register the Logo as a trade mark in 2003 and at all times used the Logo as the main house mark and sign over the shop. Although the trade mark registration is not limited to use of the Logo in red, the Claimant's exhibits show use of the Logo in large red letters on the shop fascia, and generally in red in his publicity materials. The sample leaflets exhibited to the witness statement show use of both of the Marks.
16. The Claimant says that he began distributing leaflets advertising the business from 2003 onwards, and had 100,000 leaflets a year printed for his restaurant alone. These are displayed in the shop and included with home deliveries. 2000 leaflets per week are dropped through local letter boxes.
17. From 2005, the Claimant began to expand the business and in particular began to grant franchises to use the Marks and the business model. The number of franchises leapt from 2 in 2005-2006 to 14 in 2007, and from then on, as some opened and others closed, varied from a minimum of 10 to a maximum of 14. About half of the franchised businesses have been situated in London, another 4 in Essex (3 of which are still trading), and the rest in other towns in England and Wales. The franchisees use the marks in a similar fashion on the shops and menus, as shown by some of the Claimant's exhibits, and on similar leaflets. The Claimant says that he prints 100,000 leaflets a year for each of his franchisees and they use them as he does. The Claimant did not suggest that there had been any additional advertising expenditure by his franchisees.

18. In addition, a website was set up in 2005, advertising both the business and the availability of franchises. The Claimant did not provide evidence of the number of hits on that site. He did provide copies of some email inquiries about the availability of franchises. There is also a Griller Facebook page, set up in 2008, which the Claimant says has around 150 friends.
19. The meat used in the restaurants is Halal and the Claimant's evidence was that his primary market was amongst the Moslem and Asian community. His advertising was therefore aimed at that market with, for example, advertisements on Asian TV and Kismet Radio (which he said is broadcast nationwide) and various newspapers, especially free Asian newspapers. The Claimant exhibited sample advertisements, without identifying the papers in which they appeared or the dates of the advertisements, save for two advertisements in the "Recorder" (he did not explain what that is, its spread or readership) in August and September 2011. He also exhibited a CD with recordings of some television and radio advertisements for the restaurants and the availability of franchises, and a weekly Asian TV magazine program which was sponsored by his business. These made numerous references to 'Griller' and the TV advertisements used the Logo, and the 'chicken-waiter', though not, it seemed to me, the rest of the Device. Mr Ghias did not provide evidence of the numbers of viewers of any of the TV stations on which he had placed advertisements. He exhibited some invoices for his advertising costs, without saying how much he had spent on advertising in any one year. The exhibit was difficult to follow, and many of the pages seemed to me to be duplicates, but it did show payments for press advertisements since 2005 and for TV and radio advertising and sponsorship, costing at times thousands of pounds. Mr Silcock said that he had totalled up the sums spent and that they averaged around £10,000 p.a., although for 2011 only £1300 was shown.
20. The Claimant gave the turnover figures for his Chadwell Heath restaurant from 2005 to 2011, which he said rose from £35,000 odd to an estimate of £90,000 for 2011. He provided no documentary evidence in support of these figures; however, they were not specifically challenged by the Defendants. Mr Ghias said that he was unable to give turnover figures for the franchised outlets. I find the suggestion that the Claimant did not have any knowledge of the franchisees' turnover somewhat surprising, as the franchise agreements which the Claimant exhibited to his witness statement required the franchisees to furnish statements of the gross turnover of the franchised business to the Claimant each month and to provide audited accounts of the franchised business at the end of the franchisee's financial year. It is of course possible that the Claimant did not insist upon compliance with the franchisees' obligations in that respect. However, that was not the explanation proffered by the Claimant in paragraphs 33-4 of his witness statement for his inability to be precise about the turnover of the franchise network as a whole, which he said was because the franchise fees are fixed, and not based upon the franchisee's turnover. That inconsistency, or possible inaccuracy, leads me to the view that I should treat with a degree of circumspection the estimate of the franchisees' turnover provided by the Claimant.

21. The Claimant estimated that most of the franchised outlets would have had a similar turnover to his own so that turnover for the whole chain could be estimated by multiplying the number of outlets each year by the relevant turnover. The estimated combined turnover ranged from about £770,000 in 2008 at the lowest to just over £1 million in 2009 at the highest.

The claims

22. The claim for trade mark infringement was put on the Claimant's behalf on the basis of each of sub-sections 10(1), (2) and (3) of the Trade Marks Act 1994, although the sub-section 10(1) allegation was only advanced in respect of the Logo. As the Defendant's various businesses are not connected and trade under different names and signs, I shall consider each in turn.

The claim against the 1st and 4th Defendants: 'Griller' or 'The Griller Original'

23. The complaint against the First Defendant relates to two fast food restaurants: 'The Griller Original' at 527 Cranbrook Road, Gants Hill, Ilford, Essex and 'Griller' at 84 Hermit Road, Canning Town. The Claimant said that he first became aware of the Cranbrook Road restaurant when he received a complaint from a Mr Umer Siddiqi. The Claimant exhibited a letter from Mr Siddiqi dated 31 December 2010 in which Mr Siddiqi said that he had previously been to the Seven Kings and Chadwell Heath branches of 'Griller' (both of which are in the Ilford area). He complained about the poor quality of the food and service provided at 'one of your franchise.'
24. The Claimant exhibited photographs of the front of the First Defendant's small shop at 527 Cranbrook Road. The fascia and signage use the word 'Griller' in large red letters, with a capital G, and with the words 'the' and 'original' in tiny red letters; on the projecting sign above the fascia board, the only word which seems to me to be legible is the word 'Griller.' The fascia advertises that the business sells chicken, burgers and pizza, and the photograph shows advertisements for grilled chicken and fish and chips posted onto the window. The Claimant also exhibited a photograph of the Hermit Road shop-front, albeit one downloaded from an Internet directory. That photograph shows a different style of shop signage, as the word 'Griller' is shown in white letters on the black oval background and there does not seem to be any use of the words 'the' or 'original' on that fascia.
25. The Claimant wrote a letter of claim on 10 January 2011, stating "Griller® is a registered trademark" and demanding removal of the name from both premises. That letter appears to have elicited no response from the First/Fourth Defendants, nor did they reply to further similar letters in early 2011. The Particulars of Claim complain without any specificity of the infringement of the two Marks by Mr Ikram. The Defence stated that the business was being run by the Fourth Defendant, not by the First Defendant in a personal capacity. It denied that the sign used by the Fourth Defendant is identical to the marks, denied a likelihood of confusion and denied that the Claimant's marks have a reputation sufficient to sustain a claim under sub-section 10(3) of the 1994 Act.
26. In his witness statement, the Claimant said that Mr Ikram had worked at a genuine 'Griller' franchise which opened in Walthamstow High Street in 2007.

One of the partners in that franchise business was Mr Ikram's brother. He said that the premises had been badly run and members of staff including Mr Ikram had been forced to leave. The Claimant alleged that Mr Ikram's subsequent activities arose from his knowledge of the Griller business and resentment at losing his job, points which had not been pleaded.

27. Mr Ikram provided a witness statement on behalf of himself and the Fourth Defendant of which he is now the sole director. He said that the Fourth Defendant was incorporated on 8 September 2010, before this dispute arose. Mr Ikram denied any personal liability for any infringement, on the basis that the company is the entity using the names complained of. He did not specify the date of opening of either restaurant. Indeed, he does not deal in his witness statement with the Hermit Road premises. However, as the registered office address of the Fourth Defendant is at the Hermit Road premises, it seems to me that the Claimant's allegation that this is an outlet run by the First/Fourth Defendants is correct, and this point was not disputed by the Defendants' counsel at the trial. Mr Ikram accepted that the Fourth Defendant uses the trading name 'Griller Original' and indeed it applied to register its own trade mark, in the form of a word mark 'The Griller Original' for services in Class 43 on 8 August 2011. That application was opposed by the Claimant and the opposition is pending.
28. Mr Ikram also said that he had no knowledge of the Claimant and had never met him, that he knew nothing of his business interests until these proceedings arose, and had no connection with or knowledge of his trading premises at Chadwell Heath. There is thus a direct conflict of evidence between the Claimant and Mr Ikram on this issue. Nothing in the documents before me helps to resolve that conflict, although I note that the letters of complaint in respect of the First/Fourth Defendant's business make no reference to the alleged connection between Mr Ikram and the 'Griller' franchise. In the circumstances, I am unable to decide whether it is right to say that Mr. Ikram was aware of the 'Griller' business, as the Claimant alleges; fortunately, nothing in this judgment turns on the question of his knowledge or intent.

Infringement under sub-section 10(1)

29. The Claimant alleged infringement of the Marks by the First/Fourth Defendants pursuant to sub-section 10 (1) of the 1994 Act which provides:
- “ (1) A person infringes a registered trade mark if he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.”
30. The signs used by the First/Fourth Defendants, which consist of 'The Griller Original' in one case and 'Griller' in the other, are plainly not strictly identical to either Mark. However, in order to succeed in an action under sub-section 10 (1) of the Act, strict identity is not needed. Guidance has been provided by the CJEU on 'identity' of marks and the law was summarised by Arnold J recently in *Och-Ziff* [2010] EWHC 2599 (Ch); [2011] F.S.R. 11 at §68 ff:
- “68 In *LTJ Diffusion v Sadas Vertbaudet* (C-291/00) [2003] E.C.R. I-2799; [2003] E.T.M.R. 83, the Court of Justice ruled that:

“a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

69 In *Reed Executive Plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] R.P.C. 40 Jacob L.J., with whom Auld and Rix L.J.J. agreed, considered the Court of Justice’s guidance in *Diffusion* [2003] E.T.M.R. 83 in detail at [22]–[32]. His conclusion was that, as he put it at [27], “... there is no reason to suppose that the Court meant to soften the edges of ‘strict identity’ very far.” On the facts of the case, the Court of Appeal concluded that the sign “Reed Business Information” was not identical to the trade mark REED.

70 Similarly, in *Compass Publishing BV v Compass Logistics Ltd* [2004] EWHC 520 (Ch), [2004] R.P.C. 41 Laddie J. held, applying the guidance of the Court of Justice in *Diffusion* [2003] E.T.M.R. 83 and the Court of Appeal in *Reed* [2004] R.P.C. 40, that the sign “Compass Logistics” was not identical to the trade mark COMPASS.”

31. Mr Silcock accepted that his case under sub-section 10(1) was stronger in respect of the Logo than in respect of the Device. He submitted that the use of the word ‘Griller’ by these Defendants, which he said is the main and dominant element both of the Logo and of the First/Fourth Defendants’ signs was close enough to mean that their signs are identical to the Claimant’s marks. I do not accept that argument. In my view, that would soften the strict identity test too far. It seems to me that the “flame” element of the Logo is an element which would not go unnoticed by the average consumer, still less would the additional elements in the Device go unnoticed. The addition of the word "original" where used by the First/Fourth Defendants would also take their sign away from identity with the Marks. Therefore, in my judgment the claim under sub-section 10(1) fails in relation to both of these Defendants’ signs.

Infringement under sub-section 10(2)

32. As for infringement under sub-section 10(2), the Act provides:
- “(2) A person infringes a registered trade mark if he uses in the course of trade a sign where because -
- (a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or
 - (b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,
- there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.”
33. Again, the test to be applied under this sub-section was considered in *Och-Ziff*. Arnold J held:
- “73 In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), ...¹ Geoffrey Hobbs QC sitting as the Appointed Person quoted with approval

¹ Now reported at [2011] R.P.C. 5

the following summary of the principles established by these cases for use in the registration context:

- “(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, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

74 This summary has the advantage over the summary which I quoted in *Cipriani* at [115] that it includes the Court’s guidance with regard to composite marks...

76 ... there is an important difference between the comparison of marks in the registration context and the comparison of mark and sign in the infringement context, namely that the former requires consideration of notional fair use of the mark applied for, while the latter requires consideration of the use that has actually been made of the sign in

context. This was established by the judgment of the Court of Justice in *O2 Holdings Ltd v Hutchison 3G UK Ltd* (C-533/06) [2008] E.C.R. I-4231; [2008] E.T.M.R. 55.”

34. There is an additional factor to bear in mind when comparing the Marks with the Defendants' signs, which is the relevance of any level of descriptiveness of the Marks. The Defendants all allege that the word ‘Griller’ is descriptive and said that this was a factor which I should bear in mind in comparing the marks and in assessing the likelihood of confusion. There is no general rule that an element of a mark which describes goods/services cannot be regarded as the distinctive and dominant component of the mark for the purpose of an evaluation under sub-section 5(2)(b) of the Act. That, it seems to me, follows from the General Court’s decision in *Shaker di Laudato v. OHIM* T-7/04 [2009] ETMR 16 that the dominant element of the earlier mark was the descriptive term “limoncello,” and from Case C-235/05, *L’Oreal SA v OHIM* [2006] ECR I-57 in which registration of FLEXI AIR was refused because of the prior registration of FLEX. The CJEU held that the weak level of distinctiveness of the earlier mark was not determinative of the issue of the likelihood of confusion. At paragraph 43 it held that one must
- “distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.”
- Moreover, putting too much emphasis on the descriptiveness of the word ‘Griller’ risks assessing just one component of the both parties' composite marks and failing to examine each of the marks as a whole. The same considerations apply, in my view, to the assessment of the similarity of the Marks/signs for the purposes of section 10(2).
35. The Second and Third Defendants both claimed, in their witness statements, that the word ‘Griller’ is used by a number of other businesses in the United Kingdom, including some companies which include the word in their company name. Mr Ahmad exhibited a trade mark search and a company search which he said supported that contention. The former showed the existence on the UK register of 8 current registrations and one expired registration for marks including the word ‘Griller’ or ‘Grillers’ (other than the parties’ respective marks/applications) with application dates from 2000 onwards. This goes some way to showing that the word was not invented by the Claimant; it does not show whether, when, to what extent or in what manner the word (as comprised in those marks or otherwise) may have been used in the UK, or the extent to which members of the relevant public may have come to see ‘Griller’ as merely a descriptive term. The company search showed 5 companies which have the word ‘Griller’ as part of the company name. Four of these, I was told, were companies incorporated by franchisees of the Claimant and the fifth was the Fifth Defendant. In the circumstances, in my judgment, such evidence did not fully support the claim that ‘Griller’ is used as a descriptive term, whether in general or in the relevant trade nor that the word has been established as a common term in the trade.

36. However, the word ‘Griller’ is plainly simply derived from ‘grill’ and although it may not be a ‘dictionary’ word, in my view many members of the public would understand it, when used in relation to a restaurant, as describing the restaurant as a ‘grill’. If it is not descriptive, it is certainly strongly allusive to the services within the Claimant’s specification. It is also descriptive/allusive of some of the goods in that specification (e.g. meat) but neither descriptive or allusive of other specified goods (e.g. cocoa).

Comparison of the goods and services

37. The Claimant’s mark is registered for the specification of goods and services set out in the Annex to this judgment. That specification includes in particular ‘restaurant services’ and in my judgment it is clear that the First/Fourth Defendants have been providing such services, that is to say, identical services to those for which the Marks are registered, under the signs described above. I bear in mind the guidance of the CJEU in Case C-17/06, *Céline Sarl v Céline SA*, [2007] E.C.R. I-7041; [2007] E.T.M.R. 80 at paragraph 21, that use of a trade or shop name is limited to identifying a company or designating a business and is not made “in relation to goods or services.” The evidence, such as the Defendants’ menus, did not show that they have used the signs in relation to any particular food, which might amount to use on goods identical to those in the Claimant’s specifications. The only use shown was in relation to services.

Comparison of the Marks/signs

38. The signs used by these Defendants must be compared to the Marks and assessed for visual, aural and conceptual similarity, bearing in mind the guidance set out above.

Comparing the signs to the Logo: In my view there is visual similarity between both of the First/Fourth Defendants’ signs and the Logo. Although the flame element of the Logo is far from negligible, the overall impression created by the Mark depends heavily on the word ‘Griller.’ In my view that is the dominant feature of the Mark, or, at the least, the word has an independent distinctive role in the Mark without necessarily constituting its dominant element. It is clear to me that the dominant element of the signs as actually used on both of the First/Fourth Defendants’ premises is the word ‘Griller.’ Where that word is used in conjunction with the words ‘the’ and ‘original’, those words appear to be used in so small and insignificant manner as to leave the word ‘Griller’ as the dominant element of the sign. Where the word is used by these Defendants alone on an oval background, it is the word which is the dominant element of the sign.

There is also aural similarity between both of the First/Fourth Defendants’ signs and the Logo. The Logo is likely to be used orally simply as ‘Griller,’ as is the Hermit Road sign. There is less similarity in relation to the full sign ‘The Griller Original’ but still some similarity due to the inclusion of the word ‘Griller.’

Again, there is conceptual similarity between the Logo and the signs as all of them include the word ‘Griller’ which I consider to be allusive (if not descriptive) of the services offered. The word ‘original’ is not apt in my view to add any distinctiveness on the conceptual front.

Comparing the signs to the Device: The level of visual similarity between the Device and the First/Fourth Defendants’ signs is far lower, given the more complicated composite nature of the Device Mark. In my judgment the word

‘Griller’ and the chicken-waiter device both play roughly an equal role in the overall impression of the Device. There is an element of visual similarity between the Device and the signs, because of the inclusion of the word ‘Griller’ in each of them, but the similarity is at an extremely low level.

Again the level of aural similarity depends solely upon the inclusion of the word ‘Griller’ in both the Device and the signs, but as the Device is unlikely to be described simply as ‘Griller’ because of the chicken feature and the additional wording, again the similarity is a very low level.

The same conclusion may be reached in relation to conceptual similarity. There is some low-level similarity because of the shared allusion to grilling, but it is at a very low level given the conceptual impact of the chicken device in the Device Mark.

Likelihood of confusion

39. In considering whether these similarities lead to a likelihood of confusion between the Marks and these Defendants' signs it is also necessary, as set out above, to take into account:

- a. *the identity of the services* being offered under the sign to the services for which the Marks are registered;
- b. *the average consumer of the goods and services*: The goods and services for which the Marks are registered and in relation to which the signs have been used are ordinary, everyday goods or services. They are not specialist goods/services and will be purchased by members of the general public. However, these goods/services may of course vary in price and the amount of attention which the average consumer is likely to give to the marks may depend upon the cost of the goods or services provided to him. In view of all this, the degree of consideration utilised by the average consumer in relation to restaurant services will not be higher than the average and may be lower.

However, the average consumer is still deemed to be reasonably well informed and reasonably circumspect and observant, although he is not likely to have the chance to make direct comparisons between the marks and will instead rely upon the imperfect picture of them he has kept in his mind; and

- c. *the inherent or enhanced distinctiveness of the Marks*: In my view, the Logo has an average degree of inherent distinctiveness. Both the word element of the Mark and the flame device are clearly at least strongly allusive to the provision of grilled food, as discussed above. The Device Mark has a higher level of inherent distinctiveness, particularly given the chicken device, although the word ‘griller’ is again allusive and the rest of the wording is descriptive, and, indeed, banal.

The Claimant however claims that the extensive use which he says has been made of the Marks has enhanced their distinctiveness and I was invited to take this into account for the purposes of assessing the likelihood of confusion. The factors to take into account in this regard were set out by the CJEU in Case C-342/97, *Lloyd Schuhfabrik*, [1999] E.C.R. I-3819; [1999] E.T.M.R. 690 at paragraphs 22-23 and include:

“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.”

The Claimant has made use of the Logo since 2003 and of the Device since, presumably, 2005. The Claimant’s own restaurant’s turnover in goods and services under the Marks is relatively modest, and in particular represents a tiny and insignificant proportion of the enormous market for fast food and fast food restaurants. I would have been more inclined to find that the distinctiveness of the Claimant’s Marks had been enhanced by their use by the Claimant’s franchisees had I had more confidence in the turnover figures suggested for the franchised outlets, but for the reasons given above I feel I must treat those figures with some caution. The letters produced by the Claimant from some of his franchisees, supporting his case, do not constitute independent evidence and carry little weight. Equally, the amounts spent upon advertising and publicity by the Claimant have been modest and, as I have said above, the evidence before me does not show the readership figures for any newspapers or listening/viewing figures for radio/TV advertisements in which advertisements have been placed. The existence of a Facebook page with 150 friends, and a number of e-mail enquiries about possible franchises, some from outside the UK, do not lead me to conclude that there is any very great level of enhanced distinctiveness of these Marks. In the circumstances, it seems to me that given the length of time of trading under the Marks and the number of franchises which have been established, there may be some level of enhanced distinctiveness of the Marks, but in the absence of any independent evidence of reputation I do not consider that it significantly enhances any likelihood of confusion.

40. According to the case-law of the CJEU, re-stated recently in Case C-278/08 *Die BergSpechte* [2010] ETMR 33, there is a likelihood of confusion where (in all the relevant circumstances) there is a risk that the public might believe that the goods or services in question come from the same undertaking or from economically-linked undertakings. Evidence of actual confusion is not needed, but if provided, can be persuasive.
41. The only instance of confusion before the Court in respect of the activities of the First/Fourth Defendants was in the letter from Mr Siddiqi mentioned above which related to the Cranbrook Road restaurant. No witness statement was provided from Mr Siddiqi. Nothing in the Claimant’s witness statement shows whether he investigated further the basis or extent of Mr Siddiqi’s confusion. The letter alone in my view carries little weight. No-one else was said to have been confused.
42. The absence of further, clearer or (possibly) more reliable evidence of actual confusion does not preclude there being a likelihood of confusion, taking all of

the factors discussed above into account. Furthermore, whilst the absence of such evidence is highly material when the acts complained of have been on-going for some time, it is not determinative (see e.g. *Julius Sämann Ltd v Tetrosyl Ltd* [2006] E.T.M.R. 75 at §58, and *Och-Ziff* at §117). The question is one for assessment by the judge and

“if the judge's own opinion is that the case is marginal, one where he cannot be sure whether there is a likelihood of sufficient deception, the case will fail in the absence of enough evidence of the likelihood of deception. But if that opinion of the judge is supplemented by such evidence then it will succeed. And even if one's own opinion is that deception is unlikely though possible, convincing evidence of deception will carry the day.” (per Jacob J in *NEUTROGENA Corporation v Golden Limited* [1996] R.P.C. 473 – a passing off case - at p 482).

43. In my judgment, the manner of use by the Fourth Defendant of the name ‘Griller’ on its Hermit Road premises leads to a likelihood of confusion with the Logo mark, as it appears to me to take the dominant element of that mark (the word ‘Griller’) and use it as a sign in relation to identical services to those within the Logo’s registration. Equally, in my judgment, the manner of use of the sign ‘The Griller Original’ on the Cranbrook Road restaurant is such as to lead to a likelihood of confusion, especially as the additional words ‘the’ and ‘original’ are used in such an unobtrusive way that the Defendant’s sign essentially consists of the dominant element of the Logo. I therefore find that those signs both infringe the Logo, in breach of sub-section 10(2) of the 1994 Act.
44. In my view, however, the differences between the Device and the Fourth Defendant’s signs are such as to prevent there being a likelihood of confusion between them and there is no infringement of that Mark under sub-section 10(2).

Infringement under sub-section 10(3)

45. Sub-section 10(3) of the Act provides:

“A person infringes a registered trade mark if he uses in the course of trade in relation to goods or services a sign which ... is identical with or similar to the trade mark, where the trade mark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.”

46. The scope of the tort was discussed by Arnold J in *Och-Ziff*, and he said:
“125 In *Davidoff & Cie SA, Zino Davidoff SA v Gofkid Ltd* (C-292/00) [2003] E.C.R. I-389, [2002] E.T.M.R. 99 and *Adidas-Salomon AG v Fitnessworld Trading Ltd* (C-408/01) [2003] E.C.R. I-12537; [2004] E.T.M.R. 10 the Court of Justice held that, ..., this form of protection also extends to cases where a sign which is identical with or similar to the trade mark is used in relation to goods or services identical with or similar to those covered by the trade mark.

126 The first requirement is that the trade mark has a reputation. This is not a particularly onerous requirement: see *General Motors Corp v Yplon SA*

(C-375/97) [1999] E.C.R. I-5421; [1999] E.T.M.R. 950 at [24]. Moreover, although the mark must be known by a significant part of the relevant public in a substantial part of the territory of the European Union, in an appropriate case the territory of a single Member State may suffice for this purpose: see *PAGO International GmbH v Tirolmilch Registrierte Genossenschaft mbH* (C-301/07) [2009] E.C.R. I-9429; [2010] E.T.M.R. 5 . In my judgment this requirement is satisfied in the present case.

127 The next requirement is that the use of the signs complained of gives rise to a “link” with the trade mark in the mind of the average consumer as explained in *Intel Corp Inc v CPM United Kingdom Ltd* (C-252/07) [2008] E.C.R. I-8823; [2009] E.T.M.R. 13 . In my judgment this requirement is satisfied in the present case since the signs will remind the consumer of the trade mark.

128 Finally, it is necessary for Och-Ziff to establish the existence of one of three kinds of injury, which were described by the Court of Justice in *L’Oréal v Bellure* [2009] E.T.M.R. 55 as follows:

“37. The existence of such a link in the mind of the public constitutes a condition which is necessary but not, of itself, sufficient to establish the existence of one of the types of injury against which Article 5(2) of Directive 89/104 ensures protection for the benefit of trade marks with a reputation (see, to that effect, *Intel Corporation*, paragraphs 31 and 32).

38. Those types of injury are, first, detriment to the distinctive character of the mark, secondly, detriment to the repute of that mark and, thirdly, unfair advantage taken of the distinctive character or the repute of that mark (see, to that effect, *Intel Corporation*, paragraph 27).

39. As regards detriment to the distinctive character of the mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so (see, to that effect, *Intel Corporation*, paragraph 29).

40. As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.

41. As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the

characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.

42. Just one of those three types of injury suffices for Article 5(2) of Directive 89/104 to apply (see, to that effect, *Intel Corporation*, paragraph 28).”

47. The passage in *General Motors* relating to the level of reputation required before reliance can be placed on this sub-section stated:

“23 ... Article 5(2) of the Directive, ... implies a certain degree of knowledge of the earlier trade mark among the public. It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.

24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

48. Hence, the Claimant needs to show that his Marks are known by a ‘significant part of the public concerned’ which in this case I take to be the huge proportion of members of the public who purchase food from restaurants such as the Claimant’s. I need to take into account the market share and the extent of use of and investment in the Marks. I have discussed already the Claimant’s evidence of use of his Marks, his turnover, and advertising. Even if, as I have accepted above, the Marks have some level of enhanced distinctiveness, that is in my view insufficient to show that they have a reputation for the purposes of sub-section 10(3), applying the test set out in *General Motors*. In particular, there is no evidence that Marks are known by a significant part of the relevant public, there is no evidence that the fairly modest amounts spent by the Claimant on advertising have increased the reputation of the Marks, and no evidence as to market share. I take judicial notice of the fact that the turnover figures, even accepting the figures put forward for the franchise as a whole, must represent a minuscule proportion of the market for fast food restaurants. If I am wrong on that point, and one or both of the Marks have the necessary reputation, I am not

persuaded on the scant evidence before me that members of the public would make a link between the Marks and the signs, as required by *Intel*.

49. In my judgment, therefore, the claim under sub-section 10(3) must fail.

Separate liability of the First/Fourth Defendants

50. To the extent that the claim has succeeded under sub-section 10(2), the issue arises as to which of the First and Fourth Defendants is liable for that infringement. Mr Ikram sought to argue that the Fourth Defendant was incorporated on 8 September 2010 before this dispute arose and that it alone was liable for any infringements. He did not specify the date when either of the restaurants opened. The letter which alerted the Claimant to the name of the Gants Hill restaurant was dated 31 December 2010 and a letter of claim was sent on 10 January 2011. It is certainly possible therefore that there was no infringement until after incorporation of the company. However that does not resolve the question of any personal liability on the part of the First Defendant, who has at all times been a defendant in his own name, and remained as a defendant to the proceedings when the Fourth Defendant was joined as the defendant in September 2011.

51. The Claimant relies upon *MCA Records v Charly Records Limited* [2002] F.S.R. 26 and argued that Mr Ikram was personally liable as a joint tortfeasor for acts of infringement committed by the Fourth Defendant. Mr Dipré did not suggest that Mr Ikram was not directly responsible for the company's activities. In *MCA Records v Charly*, Chadwick LJ held:

“48. It is because there is a balance to be struck on the facts of each case that it is dangerous for an appellate court to appear to attempt a formulation of the principles which may come to be regarded as prescriptive. But I think it can be said with some confidence that the following propositions are supported by the authorities to which I have referred.

49. First, a director will not be treated as liable with the company as a joint tortfeasor if he does no more than carry out his constitutional role in the governance of the company—that is to say, by voting at board meetings. That, I think, is what policy requires if a proper recognition is to be given to the identity of the company as a separate legal person. Nor, as it seems to me, will it be right to hold a controlling shareholder liable as a joint tortfeasor if he does no more than exercise his power of control through the constitutional organs of the company—for example by voting at general meetings and by exercising the powers to appoint directors. Aldous L.J. suggested, in *Standard Chartered Bank v. Pakistan National Shipping Corporation (No. 2)* [2000] 1 Lloyd's Rep 218, 235—in a passage to which I have referred—that there are good reasons to conclude that the carrying out of the duties of a director would never be sufficient to make a director liable. For my part, I would hesitate to use the word “never” in this field; but I would accept that, if all that a director is doing is carrying out the duties entrusted to him as such by the company under its constitution, the circumstances in which it would be right to hold him liable as a joint tortfeasor with the company would be rare indeed. That is not to say, of course, that he might not be liable for his own separate tort, as Aldous L.J.

recognised at paragraphs 16 and 17 of his judgment in the *Pakistan National Shipping* case.

50 Second, there is no reason why a person who happens to be a director or controlling shareholder of a company should not be liable with the company as a joint tortfeasor if he is not exercising control though the constitutional organs of the company and the circumstances are such that he would be so liable if he were not a director or controlling shareholder. In other words, if, in relation to the wrongful acts which are the subject of complaint, the liability of the individual as a joint tortfeasor with the company arises from his participation or involvement in ways which go beyond the exercise of constitutional control, then there is no reason why the individual should escape liability because he could have procured those same acts through the exercise of constitutional control. As I have said, it seems to me that this is the point made by Aldous J (as he then was) in *PGL Research Ltd v. Ardon International Ltd* [1993] F.S.R. 197.

51 Third, the question whether the individual is liable with the company as a joint tortfeasor—at least in the field of intellectual property—is to be determined under principles identified in *C.B.S. Songs Ltd v. Amstrad Consumer Electronics Plc* [1988] A.C. 1013 and *Unilever Plc v. Gillette (U.K.) Limited* [1989] R.P.C. 583. In particular, liability as a joint tortfeasor may arise where, in the words of Lord Templeman in *C.B.S. Songs v. Amstrad* at page 1058E to which I have already referred, the individual “intends and procures and shares a common design that the infringement takes place”.

52 Fourth, whether or not there is a separate tort of procuring an infringement of a statutory right, actionable at common law, an individual who does “intend, procure and share a common design” that the infringement should take place may be liable as a joint tortfeasor. As Mustill L.J. pointed out in *Unilever v. Gillette*, procurement may lead to a common design and so give rise to liability under both heads.”

52. In addition, in *SABAF SpA v Meneghetti SpA* [2002] EWCA Civ 976, [2003] R.P.C. 14 Peter Gibson L.J. giving the judgment of the Court said at [59]:
- “The underlying concept for joint tortfeasance must be that the joint tortfeasor has been so involved in the commission of the tort as to make himself liable for the tort. Unless he has made the infringing act his own, he has not himself committed the tort. That notion seems to us what underlies all the decisions to which we were referred. If there is a common design or concerted action or otherwise a combination to secure the doing of the infringing acts, then each of the combiners has made the act his own and will be liable.
53. The question in this case is, therefore, whether Mr Ikram, as a director of the Fourth Defendant company has been personally involved in the commission of the tort to an extent sufficient to render him liable as a joint tortfeasor. That is a question of fact, and requires an examination of the role (if any) played by him in the commission of the tort. The mere fact that he is a director of the Fourth Defendant will not suffice to make him liable as a joint tortfeasor. Perhaps not surprisingly, in the circumstances, the point was not pleaded but, as I said above, neither was the Fourth Defendant substituted for Mr Ikram after the

Claimant learned of its existence and its involvement with the infringing business.

54. There was little direct evidence before me to support the claim of joint tortfeasorship. The Claimant, as I have said, alleged that Mr Ikram set up the business in full knowledge of the 'Griller' business and out of resentment at losing his job at one of the 'Griller' franchises. However, that allegation was not supported by any other evidence and was contradicted by Mr Ikram's own witness statement. I cannot resolve that point and I am not in a position to make findings as to Mr Ikram's intentions.
55. The company records which have been put into evidence show that the Fourth Defendant company had two directors when it was first incorporated, Mr Ikram and a Mr Butt. Each of them held one share in the company. Mr Butt resigned on 23 May 2011 and since then Mr Ikram has been the sole director of the Fourth Defendant. Hence he has, presumably, been the 'controlling mind' of the company since that date. Mr Ikram in his own witness statement referred to the Fourth Defendant's business involving him in the sale of fast food. I also note that when the trade mark application for 'The Griller Original' was made on 8 August 2011 in the Fourth Defendant's name, Mr Ikram made the declaration of intent to use the mark, and his details were given as the person to contact in case of a query.
56. This evidence is rather scanty and it is possible that prior to 23 May 2011, it was Mr Butt rather than Mr Ikram who was responsible for the Fourth Defendant's business. However, it seems to me that the reality of the position is that since 23 May 2011 Mr Ikram has been the sole person responsible for running the business of the Fourth Defendant, and has actively pursued its intention to use the infringing sign 'The Griller Original.' I am not in a position to make any equivalent finding for the period up to 23 May 2011. In the circumstances I find that he was a joint tortfeasor with the Fourth Defendant from 24 May 2011 onwards.

The claim against the 2nd Defendant: 'Griller King'

57. The Claimant was alerted to the opening of the 'Griller King' restaurant in Waddon, Croydon by his Norbury franchisee in July 2009. As I have said above, that business was then apparently run by two gentlemen in partnership. Letters from the Claimant and the letter from his then solicitors dated 11 December 2009 (mentioned above) were variously addressed to 'Owner, Griller King', Mr Khan/Mr Ismail' and 'Mr Molvi Ismail Khan & Mr Mustafa Malik.' I am told that the Claimant believes that Mr Esmail Adia is the same 'Mr Ismail', and the change of name of the Second Defendant was to correct his name and remove that of his partner, who I assume is or was believed to be no longer involved with the business. That has not been clearly confirmed by Mr Adia or his solicitors.
58. The photographs of the Second Defendant's premises show that it is a moderate sized fast food restaurant. It uses the words 'Griller King' in red capital letters on the fascia, the two words appear side by side, in the same font. Under the name appears a list of the products sold, Peri Peri & Fried Chicken, Kebabs,

Pizza, and Curry. It is, in my view, a rather commonplace type of fascia for such a fast food restaurant. There is also use of a roundel device on the shop door:



The Claimant also exhibited some pages from the 'eat it now' website, which appears to offer an online takeaway ordering service, showing items from the 'Griller King' menu and some printouts of 'Griller King' menus. These use the roundel device prominently.

59. A letter of complaint was sent to the premises on 3 August 2009, alleging trade mark infringement without identifying the Claimant's registered marks and signed by the Claimant as "Owner of Griller® Trademark globally." Proceedings were threatened. A further letter was sent, addressed to Mr Khan and Mr Ismail (who is, the Claimant says, the Second Defendant) as the partners running the business at that date, on 24 August 2009. Their response was twofold: on 1 September they wrote to the Claimant denying any infringement and on 8 September 2009 they applied to register the roundel device as UK trade mark (that application was withdrawn in November 2009). A formal letter before action was written on 11 December 2009. These proceedings were issued on 2 March 2011. A Defence was filed in June 2011 which named Mr Esmail Adia as the Second Defendant. On 20 June 2011, 'Griller King' again applied to register its roundel device as a mark for restaurant services in Class 43. That pending application has been opposed by the Claimant.

Infringement under sub-section 10(1)

60. In my view, it is plain that the sign 'Griller King' and the roundel device are not identical with the Logo or the Device for the purposes of the alleged infringement under sub-section 10(1).

Infringement under sub-section 10(2)

Comparison of the goods and services

61. The Second Defendant's use has been shown only in relation to restaurant services, identical to the Claimant's services; there is no evidence of use of the sign in relation to goods.

Comparison of the Marks/signs

62. The signs used by the Second Defendant must be compared to the Marks and assessed for visual, aural and conceptual similarity, bearing in mind the guidance set out above.

Comparing the signs to the Logo: In my view there is some visual similarity between the Second Defendant's name 'Griller King' and the Logo. The dominant or independently distinctive word 'Griller' is also used in the name 'Griller King' and has some prominence in being the first word of two. However, the additional word 'King' is used in the sign in the same size, style and colour of font and this reduces the level of visual similarity between the Mark and the name.

There is also some aural similarity between the Second Defendant's sign and the Logo. The Logo is likely to be used orally simply as 'Griller,' and so there is

aural similarity as that is the first word in the Second Defendant's name, but dissimilarity in the addition of a second and distinct word 'King' in the latter.

There is a level of conceptual similarity between the Logo and the name due to the inclusion of the allusive word 'Griller' but in my judgement it is significantly reduced by the addition of the word 'King,' which adds an additional and discernibly different (albeit laudatory) conceptual element to the Second Defendant's sign.

Use of the Second Defendant's name in the form of its own roundel device, rather than as on the shop fascia, seems to me to be less similar to the Logo than the name alone, visually, aurally and conceptually.

Comparing the signs to the Device: The level of visual similarity between the Device and the Second Defendant's name is low, especially given the more complicated composite nature of the Device Mark.

Again the level of aural similarity depends solely upon the inclusion of the word 'Griller' in both the Device and the name, but for the reasons given above I consider such similarity to be of very low level

The conceptual similarity resides in the shared allusion to grilling, but is significantly reduced by the use of the chicken-waiter device in the Device and by the addition of the word 'King' in the Second Defendant's name.

The Second Defendant's roundel device includes a chicken device, as does the Device. That increases the level of conceptual similarity but not the level of visual or aural similarity over the name alone. I note that the use of chicken devices for takeaway restaurants is very common.

Likelihood of confusion

63. In considering whether these similarities lead to a likelihood of confusion between the Marks and the Second Defendant's signs it is necessary also to take into account the matters set out in paragraph 39 above.
64. In my judgment, this is one of those marginal cases in which I would not find there to be a likelihood of confusion of the Second Defendant's name or device with the Logo or Device Marks in the absence of convincing evidence of such a likelihood of confusion. Mr Silcock suggested that by adding the word 'King' to 'Griller' the Second Defendant would be likely to cause a member of the public to make an association between the Second Defendant's business and the well-known business of 'Burger King.' He argued that this would be likely to increase the likelihood of confusion between the Claimant's Marks and the Second Defendant's business. If it is right to say that an average member of the public seeing the Second Defendant's name might make some connection with 'Burger King' in my view that would reduce rather than increase the likelihood of confusion with the Marks, because there is nothing to suggest that any association would be made or assumed between 'Burger King' and the Claimant's business.
65. There was little evidence of confusion before the Court in respect of 'Griller King' even though the restaurant opened in about August 2009. The Claimant was alerted to its opening at the end of July 2009, by his Norbury franchisee, Mr Akhtar. The Claimant exhibited two letters from customers. First, there was a letter dated 8 September 2009 sent to 'Griller Norbury Head Office' at the Norbury address, from a Mr Hassan, who said he was a regular customer of the

Norbury restaurant. He mentioned having visited the ‘Griller King’ restaurant, as well as the ‘Griller Hut’ restaurant, “as it seems that they were part of the same franchise.” He said that on going to ‘Griller King’ the menu and food type looked different; he thought the food was of an inferior taste. He said that one of the workers at the restaurant told him that ‘Griller King’ was part of the ‘Griller’ franchise chain. At the end of his letter he asked whether ‘Griller King’ and ‘Griller Hut’ are part of the ‘Griller’ chain, and if so why is the taste of their food so different and inferior? Secondly there was a letter dated 10 October 2009 sent to the Claimant's restaurant address by a Mr Iqbal, who described himself as a regular customer of the Griller franchise at Norbury. He explained that when in the Croydon area he saw ‘Griller King’ and went in there assuming that it is the same ‘Griller’ that he knew. He was surprised that his usual meal was cheaper than the Norbury branch and said that he was told that this was a special promotional rate for a new Griller branch. He thought that the food was of inferior quality and asked for an explanation of the variation of food taste and price. Letters from Mr Akhtar, the franchisee, were also exhibited by the Claimant; although he alleged that there had been damaging confusion, he provided no direct evidence of confusion but referred to letters of complaint which I take to be those described above. No any instances of alleged actual confusion were pleaded.

66. The letter from Mr Hassan to my mind suggests that he was not confused by the use of the name ‘Griller King’ into thinking that the restaurant was connected with the Norbury restaurant he knew. Apparently he felt it necessary to ask a member of staff at the Second Defendant's restaurant whether the restaurants were connected and repeated that question in the letter of 8 September 2009. The letter from Mr Iqbal, on the other hand, suggests that there may at least have been initial interest confusion on his part, if he went into the ‘Griller King’ in the belief that it was the same Griller restaurant with which he was familiar. Such confusion may be actionable (see *Och- Ziff*, above at §101).
67. However, the letters alone in my view carry little weight, not just because they are not confirmed by a statement of truth but because one cannot tell clearly whether, to what extent and in what way the gentlemen concerned may have been confused, nor do I know the circumstances in which the letters were written. Although the ‘Griller King’ business has been open since about August 2009, no further evidence of confusion was put before me. Even allowing for the acknowledged difficulty of obtaining such evidence, the fact that there may have been a single instance of confusion in October 2009, but there is no evidence of any confusion since then suggests to me that there is no likelihood of confusion.
68. I therefore reject the allegation of infringement under sub-section 10(2).

Infringement under sub-section 10(3)

69. For the same reasons given in relation to the First/Fourth Defendants, I reject the claim of infringement under subsection 10 (3).

The claim against the 3rd and 5th Defendants: ‘Griller Hut’

70. The Claimant says that he was alerted to the opening of the ‘Griller Hut’ restaurant in South Norwood in 2008. He alleges that the business was opened by a Mr Nadeem, a cousin of his franchisee Mr Akhtar, who therefore was well aware of his ‘Griller’ business. The Claimant says that when he complained to Mr Nadeem about infringement of his trade mark, he offered to change the name of the business, but never did so despite being "chased" in 2010. In June 2010, Mr Nadeem assigned the ‘Griller Hut’ business to the current Third Defendant. As mentioned above, the Fifth Defendant was only incorporated in September 2011.
71. The photographs of the Third/Fifth Defendants’ premises show that it is a small-moderate sized fast food restaurant. It uses the words ‘Griller Hut’ on the fascia of the restaurant in stylised grey-blue capital letters which, it seems to me, are supposed to look like gas flames. There is also a logo consisting of a chicken sitting on top of a pitched roof, in the same colour (see below).
72. A letter before action described as a final notice was sent to Mr Nadeem by the Claimant on 3 September 2009 referring to assurances previously given by him. Although a letter was written to Griller King by SZ Solicitors on 11 December 2009, no equivalent letter appears to have been sent to Mr Nadeem. Another letter was written by the Claimant on 23 February 2011 before these proceedings were issued on 2 March 2011. Mr Ahmad had taken over the business some 7 or 8 months previously, but it does not seem that he replied to the Claimant’s letter to Mr Nadeem. The Fifth Defendant was incorporated only in September 2011. Mr Ahmad denied any personal liability for trade mark infringement, without distinguishing the position after incorporation from that before it, when he personally used the trading name ‘Griller Hut.’
73. On 20 June 2011, Mr Ahmad (in person) applied to register the device shown below as a trade mark for takeaway services in Class 43. That pending application has been opposed by the Claimant.



Infringement under sub-section 10(1)

74. In my view, it is plain that the sign ‘Griller Hut’ is not identical with the Logo or the Device, nor is the ‘Griller Hut’ device identical to either Mark. The claim fails under sub-section 10(1).

Infringement under sub-section 10(2)

Comparison of the goods and services

75. The Third/Fifth Defendants’ use has been shown in relation to restaurant services identical to the Claimant’s service; there is no evidence of use of the sign in relation to goods.

Comparison of the Marks/signs

76. The signs used by the Second Defendant must be compared to the Marks and assessed for visual, aural and conceptual similarity, bearing in mind the guidance set out above.

Comparing the signs to the Logo: In my view there is some visual similarity between the Second Defendant's name 'Griller Hut' and the Logo. The dominant or independently distinctive word 'Griller' is also used in the name 'Griller Hut' and has some prominence in being the first word of two. However, the additional word 'Hut' is used in the Defendants' sign in the same size, style and colour of font and this reduces the level of visual similarity between the Mark and the name. The level of similarity is reduced still further in relation to this name by the stylisation applied to the name 'Griller Hut.' Though both the Logo and the name include a flame effect, these are in my view so different that they further reduce the visual similarity to an extremely low level and would do so in my view even supposing the use of the Logo in a similar colour to that used by the Third/Fifth Defendants.

There is also some aural similarity between the Third/Fifth Defendants' signs and the Logo. The Logo is likely to be used orally simply as 'Griller,' and so there is aural similarity, as that is the first word in the Second Defendant's name, but there is dissimilarity in the addition of a second and distinct word 'Hut' in the latter.

There is a level of conceptual similarity between the Logo and the name due to the inclusion of the allusive word 'Griller' but this is reduced by the addition of the word 'Hut' which adds an additional, albeit not very individual, conceptual element to the Third/Fifth Defendants' sign. The addition of flame effects to both adds a little to the conceptual similarity.

The Third/Fifth Defendants' device seems to me to be significantly less similar to the Logo than the name alone on all fronts.

Comparing the signs to the Device: The level of visual similarity between the Device and the Third/Fifth Defendants' name is low, given the more complicated composite nature of the Device Mark and the points which I have made above.

Again the level of aural similarity depends solely upon the inclusion of the word 'Griller' in both the Device and the name, but for the reasons given above I consider such similarity to be of very low level.

The conceptual similarity resides in the shared allusion to grilling, but is significantly reduced by the use of the distinctive device in the Device and by the addition of the word 'Hut' in the Third/Fifth Defendants' name.

The Third/Fifth Defendants' device includes a chicken device, as does the Device. That increases the level of conceptual similarity but not the level of visual or aural similarity over the name alone.

Likelihood of confusion

77. In considering whether these similarities lead to a likelihood of confusion between the Marks and these Defendants' signs it is necessary to take into account the matters set out in paragraph 39 above.

78. I would not consider there to be a likelihood of confusion with the Logo or Device Marks in the circumstances set out above, in the absence of evidence of such a likelihood of confusion. Mr Silcock suggested that the name 'Griller Hut'

might raise an association with 'Pizza Hut' and that this would, again, increase the likelihood of confusion with the Marks. If any such association were made, in my view it would not increase the likelihood of confusion with these Marks, which I do not consider that an average member of the public would be likely to associate in any way with 'Pizza Hut.'

79. The only evidence of confusion caused by use of the 'Griller Hut' name or device which was put before me was in the letter from Mr Hassan, which I have discussed above. Strangely, to my mind, Mr Hassan does not seem to have distinguished in any way between the 'Griller King' restaurant and the 'Griller Hut' restaurant, although the names and the fascias of the restaurants are significantly different from each other, as well as different from the Claimant's restaurants with which he says he is familiar. This may suggest that Mr Hassan is not a 'reasonably circumspect and observant' average consumer. In any event, for the reasons given above, in my judgment Mr Hassan's letter does not show that he was confused into thinking that the 'Griller Hut' restaurant was connected with the Marks.
80. Although the 'Griller Hut' business has been open since sometime in 2008, no other evidence of confusion was put before me. I accept that it is often difficult to obtain evidence of confusion, but 'Griller Hut' has been trading for a period of some 3 to 4 years and yet the only evidence before me was the letter from Mr Hassan.
81. In the circumstances, I find that there is no likelihood of confusion and I reject the allegation of infringement under sub-section 10(2).

Infringement under sub-section 10(3)

82. For the reasons given above, I also reject the claim of infringement under subsection 10 (3).

Conclusions

83. The claim succeeds under sub-section 10(2) in relation to the First and Fourth Defendants' activities but is otherwise dismissed. I will hear counsel as to the appropriate form of Order.

Annex

Specification of the Claimant's registered UK trade marks:

Class 29:

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats.

Class 30:

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

Class 32:

Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 43:

Restaurant, bar and catering services; provision of holiday accommodation; booking/reservation services for restaurants and holiday accommodation, services for providing food and drink; temporary accommodation.