

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NO. 16003  
BY ALFREDO INTERNATIONAL INC.  
FOR A DECLARATION OF INVALIDITY  
5 IN RESPECT OF INTERNATIONAL REGISTRATION NO. 659592  
IN THE NAME OF  
J.J. DARBOVEN HOLDING AG & CO.

10 DECISION

1) International Registration No 659592 ALFREDO is protected in the UK for "Providing of food and drink" under Class 42. The mark has an international priority date of 5 July 1996 due to its registration in Germany.

15 2) By an application dated 27 April 1999 Alfredo International Inc. of the Italian Pavilion-Epcot Center, Lake Buena Vista, Florida 32830, USA applied for a declaration of invalidity in respect of this registration. The grounds stated were in summary:

20 a) The applicant is the proprietor of the world-famous Alfredo restaurant and has rights in the UK in the marks ALFREDO and ALFREDO THE ORIGINAL OF ROME in respect of the provision of food and drink by virtue of the use and reputation in the UK. The applicant has on 5 June 1997 applied for registration of these marks in the UK in respect of "Restaurant, café and bar services, services in providing food and drink".

25 b) The applicant is the proprietor of three world famous restaurants in the USA which trade under the trade marks Alfredo and Alfredo the Original of Rome. The restaurants have close connections with Alfredo Dilelio (creator of Fettuccine Alfredo) and his restaurant in Rome which is still operated by the Dilelio family.

30 c) The mark in suit should not have been granted protection in the UK as it offends against Sections 1(1), 3(1)(a), 3(1)(b), 3(4), 3(6), 5(1), 5(2), 5(4)(a) and 56.

35 3) The registered proprietor filed a counterstatement denying all the grounds.

4) Both sides ask for an award of costs in their favour.

40 5) Both sides filed evidence in these proceedings and the matter came to be heard on 6 September 2001 when the applicant was represented by Mr McCall of Messrs W P Thompson & Co, and the registered proprietor by Mr Bubb of Messrs Gee & Co.

APPLICANT'S EVIDENCE

45 6) The applicant filed an affidavit by Russell Bellanca president of the applicant company. Mr Bellanca states that the applicant has for the past seventeen years operated a restaurant under the ALFREDO mark in the Epcot Center [sic] in Florida. Further, another restaurant in New York under the name ALFREDO has operated since 1978, although currently closed this restaurant is due to re-open in 2000.

7) M Bellanca states that the Epcot centre restaurant has the highest volume, the highest turnover of guests and the fewest vacancies of any of the restaurants at the Epcot centre. He states that the restaurant uses the mark ALFREDO on signs, menus and advertising material. He provides number of guests and turnover figures. The turnover was stated in US\$ and I have converted the figures into UK£.

Year	Guests	Sales £ (approximately)
1993	496,992	5.8 million
1994	490,712	5.9 million
1995	521,086	6.4 million
1996	526,983	6.8 million
1997	530,119	7.3 million
1998	476,198	7.0 million

8) Mr Bellanca states that “the percentage of visitors to EPCOT that comes from the UK is 7%, which figure has been derived from the Disney’s attendance figures”. Based on this he claims that 35,000 UK residents per annum have eaten at the restaurant. He claims that based on this the number of UK residents who have visited the Florida restaurant since 1993 is over 213,000, and that since the restaurant opened some 600,000 UK residents have visited.

9) Mr Bellanca states that the EPCOT restaurant is world famous and serves many famous personalities from the entertainment, sports and political areas. He also claims that the restaurant is well known to European residents who have travelled to the USA, and particularly those who have gone to Florida. He also claims that the mark ALFREDO has been well publicised in magazines, newspapers, radio and television. The applicant has since 1997 had a website using the mark ALFREDO and other ALFREDO combination marks.

10) Mr Bellanca provides two exhibits. Exhibit A consists of:

a) two pages from a US magazine “Southern Living” dated 1995. This gives details of the various restaurants at the EPCOT centre and mentions Alfredo’s.

b) two pages from a magazine called “Diversion” from April 1995 which lists all the restaurants at the Disney theme park including “L’Originale Alfredo di Roma Ristorante”.

c) A booklet entitles “Alfredo The original of Rome since 1914, Publicity highlights”. This has numerous cuttings from a variety of US publications which mention in articles the restaurant ALFREDO’S. None have UK prices and there is no evidence of sales outside of the USA.

11) Exhibit B consists of various copies of pages from the applicant’s web site. All are dated February 1999. Some show menu’s. Others give a potted history and mention various

celebrities who have visited.

12) The applicant also filed an affidavit by John S Hale an Attorney in the Commonwealth of Virginia and the District of Columbia. Mr Hale states that the applicant is the owner of a web site which bears the mark ALFREDO on a number of its pages. He states that this web site has been operative since March 1996 and that he has periodically reviewed the site and various of its pages in the past several years.

13) Mr Hale states that he carried out a search of the mark ALFREDO on a variety of major Internet search engines. He provides details of his searches, stating the search engine used and the result obtained. On each occasion the search revealed a reference to the applicant company. Mr Hale concludes that his work shows that the mark ALFREDO is associated by the general public with the applicant and that the applicant's web site is a form of advertising which could have been accessed by UK residents. This access in the UK was available prior to the filing of the International mark and constitutes prior use in the UK of the applicant's mark.

#### REGISTERED PROPRIETOR'S EVIDENCE

14) The proprietor filed a declaration by Hans Albert Eugen Darboven, the Chairman of the proprietor company.

15) Mr Darboven states that the mark ALFREDO was devised in 1987 for use in connection with Italian style coffee and that the mark has been used since that date in connection with the sale and distribution of coffee products throughout Germany and Europe. The mark is registered in respect of coffee products in the USA and numerous European countries including, as of 19 December 1994, the UK. He states that the mark was adopted as being an Italian fore-name that would reinforce in customers minds that the coffee was of Italian style. At exhibit AD1 he provides an example of literature in German which shows the mark used on bags of coffee.

16) Mr Darboven states that in 1994 a coffee bar named "Café Alfredo" was opened in Germany. Subsequently two others have also been opened in Germany. At exhibits AD2 &3 he provides photographs of the frontage showing the name "Café Alfredo" on the initial café one and the name "Alfredo Espresso Bar" on the other two.

17) That concludes my review of the evidence. I now turn to the decision.

#### DECISION

18) The application for invalidity is based on a number of grounds. At the hearing Mr McCall stated in regard to the grounds under Section 1(1), 3(1)(a), 3(1)(b), 3(4) and 3(6) "I am not proposing to withdraw them, but I am not proposing to argue them. I am leaving them there for possible argument on appeal". For the sake of completeness I therefore will deal with each ground of opposition.

19) Section 1(1) states:

“1 (1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings”.

5 “A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

20) Section 3(1) of the Act is in the following terms:

10 3 (1) The following shall not be registered -

(a) signs which do not satisfy the requirements of section 1(1),

15 (b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

20 (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

25 *Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.*

30 21) There is no suggestion that the mark is not represented graphically so the objection relates to the inherent capacity of the mark to distinguish the proprietor’s goods. The question is whether the mark in suit “ALFREDO” can perform the function of a trade mark. In considering this question I have regard to the comments of Aldous L.J. in *Philips Electronics NV v. Remington Consumer Products Ltd* [1999 RPC 809 at 818]:

35 “The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing those goods from similar goods of another trader. An example of a trade mark which is capable of distinguishing is WELDMESH, whereas WELDED MESH would not be. The former, despite its  
40 primary descriptive meaning, has sufficient capricious alteration to enable it to acquire a secondary meaning, thereby demonstrating that it is capable of distinguishing. The latter has no such alteration. Whatever the extent of use, whether or not it be  
45 monopoly use and whether or not there is evidence that the trade and public associate it with one person, it retains its primary meaning, namely mesh that is welded. It does not have any feature which renders it capable of distinguishing one trader’s mesh from another trader’s welded mesh.”

22) I also have regard to the comments of Morritt L.J. in the *Bach and Bach Flower*

*Remedies Trade Marks* case [2000 RPC 513 at page 526 line 10]:

5 “The question is whether or not the word BACH had, by 1979, acquired such a  
meaning so as to be incapable, without more, of affording the requisite distinction. If it  
had then section 1(1) is not satisfied, the word BACH cannot be a capricious addition  
so that registration of the sign would be in breach of paragraph (a); if it had not then  
the word BACH is an addition to the words FLOWER REMEDIES which is  
10 ‘capricious’ because it is not purely descriptive, so that both the expression BACH  
FLOWER REMEDIES and the word BACH are capable of affording the necessary  
distinction. Accordingly I accept the submission that it is both permissible and  
necessary in considering the application of paragraph (a) to determine the meaning of  
the word as used at the time of the application for registration. I do not understand  
Aldous L.J. in *Philips v. Remington* in the passage I have quoted, to have been  
15 considering the relevance of use to the meaning of the word.”

20 “The usage in question must be by those engaged in the relevant trade or activity.  
Normally that will be the usage of the average consumer of the goods in question as  
described in *Lloyd Schuhfabrik* [European Court of Justice, *Lloyd Schuhfabrik Meyer  
v. Klijsen Handel BV* 1999 ETMR 690]. Obviously the evidence on that question is  
not limited to those who are consumers or end-users but may extend to others  
concerned in the trade such as manufacturers, wholesalers and retailers.”

25 23) I am not convinced that the term ALFREDO is so descriptive that I can say now that the  
proprietor will never be able to educate the public to regard the term as a trade mark denoting  
only its goods or services. The term therefore passes the “soap for soap” test of Section 1(1)  
and 3(1)(a).

30 24) Neither, in my opinion, is the term devoid of any distinctive character. The proprietor  
seeks to protect the mark ALFREDO for “Providing of food and drink” under Class 42. The  
applicant has not provided any evidence or submissions as to why the mark in suit is devoid of  
distinctive character. The ground of opposition under Section 3(1)(b) therefore fails.

25) The next ground of opposition is under Section 3(4) which reads:

35 3. (4) A trade mark shall not be registered if or to the extent that its use is prohibited in  
the United Kingdom by any enactment or rule of law or by any provision of  
Community law.

40 26) From the grounds of opposition it is clear that the applicant is seeking to use Section 3(4)  
in relation to an anticipated passing off action. I do not accept that this section allows such  
action. Section 3(4) is derived from Article 3(2)(a) of the Directive 89/104 which reads:

45 “3(2) Any Member State may provide that a trade mark shall not be registered or, if  
registered, shall be liable to be declared invalid where and to the extent that:

(A) the use of that trade mark may be prohibited pursuant to provisions of law  
other than trade mark law of the Member State concerned or of the  
Community...”

27) The ground of opposition under Section 3(4) therefore fails.

28) The next ground of opposition is under Section 3(6) which states:

5           *“ A trade mark shall not be registered if or to the extent that the application is made  
in bad faith.”*

10           29) The Act does not define the term bad faith, leaving it to the Tribunal or the Court to  
determine whether an application was made in bad faith based upon the circumstances of a  
particular case. The Notes on Sections, published by the Patent office, and based upon the  
Notes on Clauses provided to Parliament during the passage of the Trade Marks Bill in  
relation to Section 3(6) provides examples of where bad faith might be found, these are:

15           (i) where the applicant had no bona fide intention to use the mark, or intended to use  
it, but not for the whole range of goods and services listed in the application;

20           (ii) where the applicant was aware that someone else intends to use and /or register the  
mark, particularly where the applicant has a relationship, for example as employee or  
agent, with that other person, or where the applicant has copied a mark being used  
abroad with the intention of pre-empting the proprietor who intends to trade in the  
United Kingdom;

25           (iii) where the mark incorporates the name or image of a well-known person without  
his agreement. (This should not be taken as meaning that this provision is legislating  
for the protection of a personal name or reputation - these remain unprotected under  
English law, but the nexus between unregistrability and the name of a well-known  
person is that of bad faith in which the application is made.)

30           30) I also take account of the views of Lindsay.J. in *Gromax Plastics Ltd v Don and Low  
Nonwovens Ltd* (1999 RPC 367 at page 379) where the learned judge said:

35           *“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty  
and, as I would hold, includes also some dealings which fall short of the standards of  
acceptable commercial behaviour observed by reasonable and experienced men in the  
particular area being examined.”*

31) It is well established that in an opposition under Section 3(6) of the Act the onus is on the  
claimant, reflecting the usual approach under English law that he who asserts must prove.

40           32) An allegation that the proprietor “deliberately and knowingly adopted the trade mark  
ALFREDO so as to suggest a connection with the applicant” is very serious. The proprietor  
in this case has denied the allegation and the applicant on whom the onus rests has provided  
no evidence. Therefore the ground of opposition based on Section 3(6) is dismissed.

45           33) In the statement of grounds the applicant also claimed that the application should be  
rejected under Sections 1(1), 3(1)(a), 3(1)(b), 3(4) and 3(6) as it was similar to the mark of  
the applicant. I note that Section 3 is annotated with the words “Absolute grounds”, thus  
precluding a comparison with other trade marks. Therefore the opposition based on a  
comparison with the applicant’s mark under these sections must fail.



5 makes reference to the South African case of *McDonalds Corporation v Joburger's Drive-Inn Restaurants and others*. This case was unreported but was referred to approvingly by Jacob J in *Phillips Electronics NV v Remington Consumer Electronics* [1998] RPC 283 and [1998] EMTR 124. In the South African case it was held that the term “well-known” was to be tested by reference to whether sufficient people knew the mark well enough to entitle it to protection against deception or confusion, a degree of knowledge similar to that protected by the law of passing off. So the relevant “universe” was not the entire population of the country, but rather the smaller one of potential customers (a more affluent segment of the population) and (here) potential franchisees.

10 38) My attention was also drawn to the recent *Joint Recommendation Concerning Provisions on the Protection of Well Known Marks* which was adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organisation (WIPO). In Article two on the determination of whether a mark is well known in a Member State the following information is said to be of relevance:

15 “(1) The degree of knowledge or recognition of the mark in a relevant sector of the public;

20 (2) The duration, extent and geographical area of any use of the mark;

(3) The duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and / or services to which the mark applies;

25 (4) The duration and geographical area of any registrations, and / or any applications of the mark, to the extent that they reflect use or recognition of the mark;

30 (5) The record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognised as well known by competent authorities;

(6) The value associated with the mark.”

35 39) At paragraph 2.4 of The Explanatory Notes to the Joint Recommendation it is stated:

40 “The duration, extent and geographical area of any use of the mark are highly relevant indicators as to the determination whether or not a mark is well known by the relevant sector of the public. Attention is drawn to Article 2(3)(a)(i), providing that actual use of a mark in the State in which it is to be protected as a well-known mark cannot be required. However, use of the mark in neighbouring territories, in territories in which the same language or languages are spoken, in territories which are covered by the same media (television or printed press) or in territories which have close trade relations may be relevant for establishing the knowledge of that mark in a given State.”

45 40) Mr McCall contended that the evidence filed shows that at the relevant date the mark was well-known and also that the UK and USA are neighbouring territories which share the same language and media and which have close trade relations.

41) The evidence shows that the applicant has a restaurant in the EPCOT centre in Florida.



This restaurant has been trading for seventeen years and in the period prior to the relevant date, 5 July 1996, averaged 500,000 visitors per annum with a turnover of approximately £6million. Reference was made to another restaurant in New York but no details were provided. It is claimed that seven percent of visitors to the Disney centre are from the UK.

5 However, this claim is made by Mr Bellanca the President of the applicant company. It is not clear how he can make a statement on the number of UK visitors to the Disney Centre. No corroborative evidence regarding the proportion of UK residents visiting the centre is provided.

10 42) However, even if I were to accept that the Florida restaurant had been visited by an average of 35,000 UK residents per annum this does not prove that the applicant's mark is well known by the relevant public in the UK. The applicant claims that the mark has been well publicised in magazines, newspapers and on radio and television. However, the evidence provided showed only publications sold in the USA. None had UK prices and no circulation figures for the UK were provided. Despite Mr McCall contention that a number of US

15 television programmes were shown in the UK and that US newspapers and magazines are sold in the UK I do not accept that the USA and the UK share the same media. Nor do I accept that they are neighbouring territories. Whilst there is a close political relationship between the two countries, particularly at the present, evidence of a close trading relationship has not been

20 provided, particularly given that the trade in question relates to the provision of food and drink.

43) The applicant also contented that the use of the applicant's mark on the internet should be regarded as promotion of the restaurant service in the UK. Whilst the applicant's web site can be accessed by UK residents, it clearly refers to a service available only in the State of Florida.

44) In my view the applicant has failed to show that it's mark is recognised in the UK at all, let alone by a sufficient number of the relevant public. As the applicant has failed to prove that it has a well-known trade mark the grounds of opposition under Sections 5(1), 5(2) & 5(4) fail.

45) The Registered Proprietor having successfully defended the mark in suit is entitled to a contribution towards costs. I order the applicant to pay the registered proprietor the sum of £1335. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 06 day of November 2001

40

George W Salthouse  
For the Registrar  
45 The Comptroller General