

**O/204/03**  
**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2187008**  
**BY MR MUHAMMAD SARMAD**  
**TRADING AS KENNEDY FRIED CHICKEN**  
**TO REGISTER A TRADE MARK IN CLASS 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**  
**UNDER No. 50844 BY KENTUCKY FRIED CHICKEN**  
**(GREAT BRITAIN) LIMITED**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2187008  
by Mr Muhammad Sarmad trading as Kennedy Fried Chicken  
to register a trade mark in Class 42**

**and**

**IN THE MATTER OF Opposition thereto under No. 50844  
by Kentucky Fried Chicken (Great Britain) Limited**

### **Background**

1. On 25 January 1999 Mr Muhammad Sarmad trading as Kentucky Fried Chicken applied to register the trade mark KENNEDY FRIED CHICKEN in Class 42 of the register for a specification of:

“Catering services relating to the preparation and provision of takeaway foods and beverages”.

2. The application was subsequently accepted by the Registrar on the basis of distinctiveness acquired through use and was published in the Trade Marks Journal.

3. On 22 March 2000 Kentucky Fried Chicken (Great Britain) Limited filed a Notice of Opposition. In summary the grounds (as subsequently amended) are:

- (i) under Section 5(2)(b) of the Act because the mark applied for is similar to the following marks owned by the opponent which cover identical and similar services and goods and a likelihood of confusion exists on the part of the public:- UK registration numbers 1067977, 1092599, 1298067, 1075823, 969352, 1021181, 1021182, 1082780, 1021184, 1110075, 1021180, 1021186, 1298011, 1064936, 1064935, 1064716, 1298012, 969348, 1021175, 1082787, 1021177, 969347, 1021179, 1021173, 969345, 1082792, 1298013, 845870, 845878, 845873, 845881, 845874 and 845882. The opponent claims a reputation in its trade marks and draws particular attention to its following registrations in Class 42 which, it submits, cover identical services to the mark in suit.

Registration No.	Mark	Registration Effective	Specification of Services
1298011	<p><b>Kentucky Fried Chicken</b></p> <p><b>Kentucky Fried Chicken</b></p>	16 January 1987	Class 42 – Restaurant services included in Class 42.
1298012	<p><b>Kentucky Fried Chicken</b> <i>it's finger-lickin' good!</i></p> 	16 January 1987	Class 42 – Restaurant services included in Class 42.
1298013	<p><b>Kentucky Fried Chicken</b></p> 	16 January 1987	Class 42 – Restaurant services included in Class 42.

(ii) Under Section 5(3) of the Act because the mark applied for is similar to the earlier trade mark owned by the opponent and to the extent that the services and/or goods are deemed not similar, registration of the mark in suit would take unfair advantage of or be detrimental to, the distinctive character or the repute of the opponent's earlier marks.

(iii) Under Section 5(4)(a) of the Act by virtue of the law of passing off.

4. The applicant filed a Counterstatement denying the above grounds and stating that the applicant's mark had been continuously used for at least twelve years, that such use had been honest and concurrent and that the applicant was not aware of any instances of confusion with the opponent's trade marks.

5. Both sides filed evidence and asked for an award of costs in their favour. The matter came to be heard on 5 June 2003 when the applicant for registration was represented by Ms Tolson of Withers & Rogers and the opponent by Ms Hutchinson of The GSCP Partners hip.

## Opponent's Evidence

6. This consists of four statutory declarations, one each from Justinian Joseph Ash, Julie A Daniels, John Arthur Samuels and Cameron Frederick Gowlett, dated 27 July 2001, 26 July 2001, 27 September 2001 and 30 July 2001 respectively.

7. Mr Ash is a Board Director for Kentucky Fried Chicken (Great Britain) Limited (the opponent) and he explains that his company operates through its own restaurant outlets and via franchises, a quick service restaurant business in the UK featuring dining and take-away restaurant services. He draws attention to the opponent's numerous UK trade mark registrations for food and drink products as well as those for articles used in the consumption or preparation of food.

8. Mr Ash states that first use of the KENTUCKY FRIED CHICKEN trade mark in the UK was in 1965 and he adds that there are over five hundred restaurant outlets in the UK which are present in all major towns and cities. Mr Ash declares that the name KENTUCKY FRIED CHICKEN was used as the name of every one of his company's outlets for many years and that following rebranding of their outlets to KFC, the name KENTUCKY FRIED CHICKEN continued to be used as the corporate name for the business. As Exhibit "JJA1" to his declaration, Mr Ash attaches copies of his company's accounts for the last seven years. He summarises the annual turnover under the company name Kentucky Fried Chicken (Great Britain) Limited for the last seven years as follows:

<b>YEAR</b>	<b>TURNOVER £000</b>
28 November 1999	122,666
29 November 1998	107,023
30 November 1997	96,886
1 December 1996	94,825
3 December 1995	72,641
26 November 1994	66,331
31 January 1993	56,416

9. Next, Mr Ash refers to Exhibit "JJA2" to his declaration which contains examples of point of sale material.

10. Mr Ash states that his company's investigator has provided a colour photograph of Mr Samad's shop (Exhibit "JJA4") which shows that the applicant has adopted and uses the colour scheme red and white. He adds that red and white have been the corporate colours of KENTUCKY FRIED CHICKEN since the company first commenced trading and he submits that Mr Samad's action is intended to trade upon the opponent's reputation. Exhibit "JJA5" is an example of the opponent's use of the colour scheme red and white which is taken from their Internet website.

11. Ms Daniels is Corporate Secretary of Kentucky Fried Chicken International Holdings Inc which is an affiliate company of the opponent.

12. Ms Daniel's declaration goes mainly to the businesses origins of KENTUCKY FRIED CHICKEN in the USA and its global and international reputation. She explains that "in recent years" the name KENTUCKY FRIED CHICKEN has been abbreviated to KFC and many stores renamed. She adds that KFC is synonymous with KENTUCKY FRIED CHICKEN and both names are trade marks designating her company's products. Unfortunately, Ms Daniels supporting exhibits largely go to use and reputation globally and in the USA ie. outside or not specific to the UK.

13. Mr Samuels is a self employed market and social research consultant of thirty five years experience and he sets out his qualifications and experience. Mr Samuels explains that he was asked by the GSCP Partnership (the opponent's professional advisors) to comment on two surveys conducted in relation to the current opposition.

14. Exhibited at "JAS1" to Mr Samuels' declaration is a copy of the report of the surveys provided to the GSCP Partnership, entitled OMNIMAS CHICKEN SHOPS STUDY. Mr Samuels states that both of the surveys comprised a single question and were conducted via an omnibus survey (where many different clients' subjects and questions are included together) run by Omnimas. Mr Samuels opines that the Omnimas survey is a very well established, professionally executed omnibus survey and is one of the five or six large and respected omnibus surveys in Britain.

15. Mr Samuels description and view of the surveys is as follows:

- "(i) The survey design for Omnimas uses 150 sampling points. Each sampling point is a postcode sector, and two separate blocks of 100 addresses are selected within it and issued to the interviewer. The interviewers must only interview people who live at the specified addresses, and they are given demographic quotas to obtain. Typically, the task would involve a total of 15-16 interviews, with quota controls for sex, working status, and presence of children in the household. This is a type of sample design known as 'random location' and is of high technical quality. Split-running the sample, as with the present surveys, means that one survey is conducted in 75 locations, and the other survey in the other 75 locations.
- (ii) On the first survey, comprising a representative sample of 1021 adults, the single question involved showing respondents a screen with a picture of the Kennedy Fried Chicken outlet, and asking them: "This is used on the front of a Take away and restaurant. Can I ask you who runs it?". After the respondents had given their answer, the computer screen was taken away from the respondent's view. The interviewer then moved on a frame, and coded the response. Five pre-coded responses were offered and if the respondent's answer did not fit one of these, their response was written on the screen verbatim and later coded in the office of Omnimas.
- (iii) This question yielded results of 24% "Kentucky Fried Chicken", 6% "KFC", and 3% "Colonel Sanders/The Colonel". About 1% of respondents said two of these three answers, and the net proportion mentioning any one or more of the three

was 32%. This compares with a net proportion of 16% saying anything related to Kennedy or Kennedy Fried Chicken. The difference between 32% and 16% is statistically significant.

- (iv) In my professional view the question is at first sight *unbiased and neutral* and of itself would not lead respondents either in the direction of saying “Kennedy .....” or “Kentucky .....”. However, it is not a particularly usual sort of question to be asked. I believe, as a result, it is possible that two mechanisms could be at work, each of which might lead to an *underestimate* of the true proportion who associate the picture with Kentucky Fried Chicken.
- (v) These are as follows:
  - a. There may be some people who, at first sight of the picture (or when walking past a shop front), think it is a Kentucky Fried Chicken outlet. However, when asked the question, they think something along the lines of: “Why are they asking me so obvious a question? ..... There must be a trick in it ....., Let me look at everything very closely ..... Ah yes! ..... So that’s it! ..... It says *Kennedy* not Kentucky”. This process would lead some people who initially thought ‘Kentucky Fried Chicken’ to end up saying “Kennedy”, which is an artefact of the research process and would not occur in a real life situation.
  - b. There may be other people who look at the picture and think it is Kentucky Fried Chicken, but interpret the question to mean something more specific. They may think they are being asked the somewhat different question “Who runs Kentucky Fried Chicken?”. They may variously think the answer to this question is something like ‘The Management’, ‘The Shareholders’, a particular individual, or whatever. Whatever this group take the question to mean precisely, they then do not know the answer. Thus they give a ‘Don’t Know’ answer.
- (vi) I believe there is quite strong evidence that a lot of respondents fall within this category. First, we see 3% actually saying Colonel Sanders/The Colonel which shows they are interpreting the question this way and trying to give the answer to the question they believe they are being asked, by naming a person.
- (vii) I requested the opportunity to inspect the open ended answers which were coded as Kennedy’s/Mr Kennedy/Kennedy Fried Chicken. Exhibited hereto marked “JAS 2” are the pages reflecting the open ended answers given in relation to the survey. 133 respondents said either ‘Kennedy’, ‘Kennedy’s’ or ‘Mr Kennedy’, whilst only 16 said ‘Kennedy Fried Chicken’. So in this case, also, most people are trying to give a named person.
- (viii) Finally, and most tellingly, altogether 50% of all respondents gave a ‘Don’t Know’ answer to this question. This is an exceptionally high figure for a market

research survey and I believe stems from the fact that most of these respondents thought they were being asked to *name the owners*, and they did not know the answer to *this* question. Of course this point would apply equally whether the respondent thought the signage was Kentucky or Kennedy. However, it is my view that more people who saw 'Kennedy' would believe they could have a guess at it being owned by a Mr Kennedy, than would be the case for people who saw "Kentucky" who would be prepared to make a guess (as in all probability they would believe that, whoever the owner was, it was not a 'Mr Kentucky'). Thus I believe that most of the people who are in the 'Don't Know' category, because they believed they were being asked for a person's name, would be in the 'Kentucky' group rather than the 'Kennedy' group.

- (ix) Overall therefore it is my view that the 32% associating the picture with Kentucky Fried Chicken is likely to be an underestimate of the true proportion. It may possibly be a quite substantial underestimate, but it is not possible to quantify this from the present survey.
- (x) The second survey comprised a representative sample of 1103 adults who were asked the single question; "I'd like to ask you a question about restaurants. What do the letters KFC mean?" There were no prompts of any kind. This yielded the following results: 81% said "Kentucky Fried Chicken", 17% said they did not know, and 2% gave some other answer. Almost all of these other answers referred to chicken or fast food. In my view this clearly demonstrates that the letters KFC overwhelmingly mean Kentucky Fried Chicken to the people of Britain."

16. Finally, the statutory declaration of Cameron Frederick Gowlett. Mr Gowlett is employed by The Duncan Mee IPI Partnership as Intellectual Property Manager. As part of his job he conducts intellectual property investigations.

17. Mr Gowlett explains that he was instructed to conduct enquiries on behalf of Claire Hutchinson of The GSCP Partnership with regard to the extent of use of KENNEDY FRIED CHICKEN by a Mr. Muhammad Samad in the United Kingdom. Mr Gowlett states that Ms Hutchinson provided a copy of the Statutory Declaration of Muhammad Sa mad dated 22 October 1999 filed in support of the application in which Mr. Samad defines the extent of his use of KENNEDY FRIED CHICKEN in the United Kingdom since 1987 and claims in paragraph 7 that, by reason of his extensive use of the mark since 1987, it is well known to purchasers of fried chicken and chips throughout the Greater London area. Ms Hutchinson advised that she wished to establish the extent of business of KENNEDY FRIED CHICKEN in view of the claim to be well known throughout the Greater London area.

18. Initially Mr Gowlett contacted Kennedy Fried Chicken by telephone on 30 March 2001 at 12.00pm and asked the female assistant if they deliver to the local area. She advised that Kennedy Fried Chicken have no delivery service. He then followed up his telephone call with a visit to the premises at 99 Stoke Newington Road where he purchased some food. Mr Samad

served him and, in response to general enquiries, advised Mr Gowlett that he could pre-order food to be collected. The premises had no seating area and no menus to take away.

19. Mr Gowlett goes on to declare that he followed up with a further telephone call to Mr. Samad at 3.30pm on the 30<sup>th</sup> March 2001 when he enquired about discount for large orders and whether Mr Samad could supply any offices in other areas. Mr Gowlett was advised that he could be given a 10% discount on the menu board and that the KENEDY FRIED CHICKEN at Stoke Newington Road was the only outlet.

20. At Exhibit "CF61" to Mr Gowlett's declaration is a copy of his letter of report of 30 March 2001 including a colour photograph of the KENNEDY FRIED CHICKEN outlet in Stoke Newington Road.

### **Applicant's Evidence**

21. This consists of a witness statement by Muhammad Samad dated 17 June 2002.

22. Mr Samad states that he is the proprietor and sole trader trading as Kennedy Fried Chicken. He declares that the Kennedy Fried Chicken business was established in 1987 operating from premises in Stoke Newington, London and that he purchased the business in 1994. Mr Samad confirms that the trade mark KENNEDY FRIED CHICKEN has been used continuously since the business was established and he explains that the business is a catering service selling mainly take away foodstuffs such as fried chicken, chips, condiments and beverages. As Exhibit "MS1" Mr Samad attaches illustrations indicating the services supplied under the mark in suit.

23. Mr Samad goes on to provide the following sales figures for the services supplied under the mark in the UK:

<b>YEAR</b>	<b>£</b>
1987	1,167
1988	9,515
1989	23,672
1990	29,540
1991	39,351
1992	32,035
1993	32,103
1994	31,650
1995	32,790
1996	33,072
1997	44,318
1998	44,077
1999	45,594
2000	50,784
<b>TOTAL</b>	<b>459,668</b>

24. Turning to the promotion of the mark, Mr Samad states that he advertises his trade mark and business in publications including police diaries. He provided the following figures for approximate total advertising expenditure:

<b>YEAR</b>	<b>Advertising Expenditure (£)</b>
1988	150
1989	150
1990	200
1991	275
1992	300
1993	300
1994	400
1995	400
1996	500
1997	600
1998	600
1999	700
2000	800
2001	800
<b>TOTAL</b>	<b>6175</b>

25. At Exhibit “MS2” to his declaration, Mr Samad provides copies of packaging for the goods sold under the mark in suit and at Exhibit “MS3” are sample advertisements and merchandising items, such as key rings, which bear the mark.

26. Mr Samad declares that he is unaware of any confusion between his trade mark and that of the opponent and given the length of use of his mark Mr Samad believes that if confusion was likely to occur, he would already have become aware of it.

27. This completes my summary of the evidence filed in this case. I now turn to the decision.

### **Decision**

28. Firstly I turn to the ground of opposition based upon Section 5(2) of the Act which reads as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

29. An earlier right is defined in Section 6, the relevant parts of which state:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

30. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, page 224;

- (g) account should be taken of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd*, paragraph 29;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, page 224;
- (i) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 333, paragraph 29.

31. The reputation of a mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection of such a mark. The opponent has filed evidence relating to the reputation of the trade mark KENTUCKY FRIED CHICKEN covered by their prior registrations. However, it seems to me that there are obvious deficiencies in relation to this evidence. Firstly, there is a paucity of evidence to show use of the mark in the UK market place and the only relevant example of definite use of the mark KENNEDY FRIED CHICKEN, as opposed to KFC, in the UK is contained within the video of a 1997 television advertisement where it is secondary to the KFC mark. While “Kentucky Fried Chicken” appears as the copyright owner on the small print on the bottom of leaflets and posters etc. filed, I do not believe that this greatly enhanced the opponent’s claims in relation to its reputation as a trade mark. In addition to the lack of evidence relating to the use and promotion of the mark KENTUCKY FRIED CHICKEN in the UK, the opponent has filed no independent trade support nor documentation in the form of press cuttings or comment relating to the UK position. On the other hand, the accounts submitted with Mr Ash’s declaration show that up until 1996 the opponent conducted business under the KENTUCKY FRIED CHICKEN trade mark and from 1997 it used the trade mark KFC. Furthermore, Mr Ash declares that use of the KENTUCKY FRIED CHICKEN commenced in the UK in 1965, there are over five hundred restaurant outlets in the UK and sales for the year up to 1 December 1996 amounted to £94,825,000. There is also the evidence of Mr Samuels in relation to the Omnimas Chicken Shops Survey. While I have reservations about the survey evidence, which I will elaborate upon later in this decision, in relation to the straightforward question “I’d like to ask you about restaurants. What do the letters KFC mean?”, 81%, of the sample of 1103 adults replied “Kentucky Fried Chicken”. This goes to indicate a high level of awareness amongst the relevant public.

32. Notwithstanding the obvious deficiencies in relation to the opponent’s evidence on UK reputation, it seems to me that the length and extent of the opponent’s trade in the UK, as declared to by Mr Ash, was likely to create a high level of awareness in the trade mark KENTUCKY FRIED CHICKEN amongst the relevant public, a finding consistent with the Omnimas survey. With some hesitation I have come to the conclusion that on the evidence, I

should infer that, at the relevant date, the opponent had a reputation in the trade mark KENTUCKY FRIED CHICKEN in relation to quick service restaurant and take-away restaurant services. I will take this into account in my decision.

33. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the services, the category of services in question and how they are marketed. In this case it is accepted that the opponent's mark has a reputation. However, it was held in *Marca Mode v Adidas AG* [2000] ETMR 723:

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

34. Furthermore, in addition to making comparisons which take into account use of the respective marks, I must also compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the services covered within the respective specifications.

35. At the hearing Ms Hutchinson, on behalf of the opponent, made it clear that the opponent's strongest case under Section 5(2) rested with registration number 1298011. I agree. I do not believe that the opponent has any stronger case under Section 5(2)(b) in relation to its other registered trade marks. However, in relation to the evidence going to the use of the mark in suit, Ms Hutchinson drew my attention to the opponent's registration number 1298067 (see Appendix One to this decision) which includes a colour limit and I will give this issue consideration later in this decision.

36. Turning to a comparison of the respective services covered within the specification of the mark in suit and the opponent's registration number 1298011 it seems to me arguable as to whether “catering services relating to the preparation and provision of takeaway foods and beverages” are identical services to “restaurant services” but I have no doubt that if the services are not strictly identical, they are very closely similar, especially as restaurant and take away services are commonly run side-by-side in the same undertaking and provide food and drink from an identical menu.

37. The opponent's trade mark number 1298067 is registered in respect of “Fried chicken; cooked and prepared vegetables; cooking oil and pickles all included in Class 29”. On the consideration of whether these goods are similar to the services applied for in the application in

suit I am assisted by the guidelines formulated by *Jacob J in British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (Pages 296, 297) as set out below:

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

38. Whilst I acknowledge that in view of the CANON-MGM judgement by the European Court of Justice (3-39/97) the Treat case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in TREAT) are still relevant in respect of a comparison of goods.

39. It seems to me that there is some degree of similarity between the provision of takeaway food services which include the provision of takeaway fried chicken and in the fried chicken foodstuff itself, in that the customer of the takeaway food service purchases fried chicken through the takeaway outlet.

40. Next, I turn to the opponent’s survey evidence which is considered in the statutory declaration of Mr Samuels – the OMNIMAS CHICKEN SHOPS STUDY. The survey was conducted by an omnibus survey whereby many different clients’ subjects and questions are covered by the interviewers with the interviewees.

41. In *Bach and Bach Flower Remedies Trade Marks* [1999] RPC 1 at 20, 21 Neuberger J. accepted expert evidence to the effect that while omnibus surveys are suitable for commercial purposes, they are generally considered to be inappropriate for the purposes of legal proceedings:

“It is difficult to weight the value of an answer recorded by an interviewer in circumstances such as these. One cannot assess the context, either in the physical sense or in the sense of knowing precisely what was said before the interview started or precisely what was said by the interviewee (and, possibly, the interviewer) before the crucial question is asked. Nor does one know whether the interviewee asked for

clarification of the vital questions and, indeed, whether the interviewer recorded verbatim the answers given.”

42. It seems to me that issues of this kind remain unresolved in relation to the omnibus survey I am now considering.

43. Notwithstanding the above I go on to consider the survey evidence in light of the standard tests set out in *Imperial Group Plc & Another v Philip Morris Limited & Another* [1984] RPC 293. For convenience I refer to the headnote which gives a clear synopsis of what is required:

“If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (h) the exact answers and not some abbreviated form must be recorded, (i) the instructions to the interviewers as to how to carry out the survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed.”

44. In essence, the survey involved showing the respondents a screen with the picture of the applicant’s KENNEDY FRIED CHICKEN outlet (which clearly and prominently includes the words KENNEDY FRIED CHICKEN on the front of the premises) and asking them the question:

“This is used on the front of a take away and restaurant. Can I ask you who runs it?”

45. My major concern with the survey is that the above key question leads the person answering into a field of speculation he/she would never have embarked upon if the question had not been put. It may lead the interviewee to believe that the establishment was not run by e.g. Kennedy & Co or Mr Kennedy, because if it was the question would not have been put. It may therefore lead the interviewee to speculate as to who runs the business and whether there is any involvement by a major business in the field of take-away fried chicken e.g. KFC/KENTUCKY FRIED CHICKEN, a business of which the interviewee may well of heard and be aware of. In particular, the survey gives no clue as to why the interviewees believed that the applicant’s premises were run by the opponent and whether they believed that the KENNEDY FRIED CHICKEN mark was a KENTUCKY FRIED CHICKEN mark due to a close and confusing similarity between the marks. I do not consider the survey evidence to be of assistance in this case.

46. I now go on to compare the mark in suit with the opponent’s registration number 1298011.

47. The mark in suit comprises the words KENNEDY FRIED CHICKEN. The words FRIED CHICKEN merely describe a product which is available under the service provided, whereas the

word Kennedy is a family name which I believe would be readily recognised as such by the UK public due to the fact that a number of well known individuals (alive and deceased) have borne this surname. The opponent's registration consists of the words KENTUCKY FRIED CHICKEN, the presentation of the words having a minimal element of stylization. As stated above, the words Fried Chicken merely describe a product available under the service provided. The word Kentucky describes a southern state of the United States of America, and I believe this fact would be generally well known amongst the UK public.

48. The respective marks must be compared as a whole and by reference to overall impression but, as recognised in *Sabel BV v Puma AG* (mentioned earlier in this decision) in any comparison reference will inevitably be made to the distinctiveness and prominence of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind when making the comparisons.

49. Firstly, I turn to a visual comparison of the respective marks. Both marks share the descriptive words FRIED CHICKEN and the words KENNEDY and KENTUCKY both commence with the letters KEN and terminate with the letter Y. However, as stated earlier I believe both the words KENNEDY and KENTUCKY would be commonly known to the public and in this context I believe the meaning and look of a word will be closely associated by the public. A common word will be identified with its meaning when it is viewed and the visual interpretation will be based upon the identification of the word. Accordingly, I believe that in totality the respective marks are not visually similar.

50. In relation to aural considerations, notwithstanding that the marks share the same first syllable and a similar final syllable, it seems to me that overall the marks have an obviously differing aural impact given the obvious meanings of KENNEDY and KENTUCKY and that the words FRIED CHICKEN are merely descriptive.

51. On the conceptual comparison of the respective marks, it seems to me that the obvious different connotations of the word KENNEDY and KENTUCKY, as mentioned earlier in this decision, means that in totality the marks do not share a conceptual association or similarity.

52. In assessing the degree of similarity between the respective marks and whether it is likely to give rise to a likelihood of confusion I must consider the average customer of the services. At the hearing it was common ground that the customer for the relevant services was the public at large who would in the main enter the respective premises to purchase a drink, snack or meal. Accordingly, the customer is not a sophisticated or specialist consumer.

53. Before reaching my conclusions in relation to the Section 5(2)(b) ground I go on to consider the opponent's evidence and submissions in relation to the use of the respective marks in the market place.

54. The applicant's mark is commonly used in a red and white colour combination, often with a stylized chicken's head next to the words KENNEDY FRIED CHICKEN. As mentioned earlier in this decision there is a paucity of evidence showing use of the opponent's KENTUCKY

FRIED CHICKEN mark in the UK but what evidence there is does go to confirm Ms Hutchinson's submission that the opponent uses the colours red and white in its trade marks. Furthermore, Ms Hutchinson has drawn specific attention to the opponent's registration number 1298067, which is limited to the colours red, black and white and shows the words KENTUCKY FRIED CHICKEN adjacent to a portrait of the individual known as "The Colonel" on a background of red and white stripes.

55. While both parties use the colour combination red and white it seems to me that this fact does not place the opponent in any stronger position in relation to Section 5(2)(b). There is no evidence to show that the combination of these colours is unusual, that they are solely identified with the opponent or that the opponent is able to claim a monopoly in the colour combination. In my view, the overall dissimilarity in the marks stemming from the strong visual, oral and conceptual differences in the words KENNEDY and KENTUCKY remains. I would add that the presence of "The Colonel" portrait also goes to accentuate the overall differences.

56. On a global appreciation taking into account all the relevant factors I have come to the conclusion that while some people encountering the applicant's mark may think it reminiscent of the opponent's marks, it does not follow that a likelihood of confusion exists among the average customer for the services. While the respective specifications cover identical/very closely similar services, the overall differences in the marks and the category of services, which are wholly experienced by the customer in person at the service provider's premises, means that the possibility of confusion amongst the relevant customers cannot be regarded as a likelihood.

57. The opposition under Section 5(2)(b) of the Act fails.

58. Next, the Section 5(4)(a) ground. Section 5(4)(a) states:

"5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade".

59. The law on the common law tort of passing off is clearly set out by Geoffrey Hobbs QC, acting as the 'Appointed Person', in *Wild Child* [1998] 14 RPC, 455:

"A helpful summary of the element of an action for passing off can be found in Halsbury's Laws of England 4<sup>th</sup> Edition Vol 48 (1995 reissue) at paragraph 165. The Guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

- (b) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

The restatement of the elements of passing off in the form of this classical trinity has been referred to as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration of the facts before the House."

60. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely, the courts will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is

alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

61. Thus, to succeed in a passing off action, it is necessary for the opponent to establish that at the relevant date (25 January 1999) (i) they had acquired goodwill under their mark, (ii) that use of the applicant’s mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

62. Earlier in this decision I found that the opponent does have a reputation and thus goodwill in the trade mark KENTUCKY FRIED CHICKEN in the UK but that the application in suit and the opponent’s registrations were not confusable. However, in relation to the points raised in relation to Section 5(2) Ms Hutchinson referred me to the actual use of the respective marks with the overall packaging or “get up” of the products.

63. As far as I am aware, no case has considered this question for the purposes of section 5(4)(a) of the Act. However, the point was decided by the Court of Appeal in relation to section 11 of the Trade Marks Act 1938 in *OPEN COUNTRY Trade Mark* [2000] RPC 477. An application to register OPEN COUNTRY for clothing was opposed by the proprietor of OPENAIR in respect of identical goods. Both marks were in use at the date of the application. The opponent sought to rely on the way the applicant’s mark had been used as an illustration of normal and fair use. On appeal from the registry, the judge rejected that approach:

“It seems to me that in making the comparison, the section and authority of *Re BALI* and, in particular, the speech of Lord Upjohn, require a comparison between the opponent’s mark as used and the applicant’s mark in notional fair use. It does not seem to me that it is appropriate to compare the way in which the marks were actually presented, the actual contention being that what was in fact being done was an attempt to pass off the goods of the applicant as the goods of the respondent because the marks were similarly presented. It does not seem to me to be logical or right to use that argument as a reason to oppose registration.”

On further appeal, Aldous L.J., at p. 482, disagreed:

“The test laid down in *Smith Hayden*, adapted in accordance with the speech of Lord Upjohn in *BALI*, is the test applicable whether the applicant has or has not used his trade mark. However, no court would be astute to believe that the way that an applicant has used his trade mark was not a normal and fair way to use it, unless the applicant submitted that it was not. It does not follow that the way that the applicant has used his trade mark is the only normal and fair manner. However in many cases actual use by an applicant can be used to make the comparison. I believe that this is such a case.”

64. There are clear differences between section 11 of the 1938 Act and on the section 5(4)(a) of

the 1994 Act, in particular, that under section 11 it was unnecessary to prove passing off and it was for the applicant to show its mark was registrable. Nevertheless, in my view the ratio of Aldous L.J. above is equally applicable to the determination of normal and fair use under section 5(4)(a). Remarks by Pumfrey J. in *South Cone Inc v Jack Bessant and others (a partnership)* 25 July 2001 appear to support that view although the applicant's mark in that case had not been used at the application date.

65. As mentioned earlier in this decision there is a minimal evidence of use of the KENTUCKY FRIED CHICKEN mark in the UK. However, on the basis of the evidence filed it seems to me that the words KENNEDY and KENTUCKY are very strong elements in the respective marks and that the respective marks are often used with the device of a chicken's head (the applicant's get-up) and the device of a portrait of "The Colonel" (the opponent's get-up). While both parties use a red and white colour combination, sometimes in vertical stripes on packaging, there is no evidence to show that the combination of these colours is unusual or that they are solely identified with the opponent. Furthermore, the only independent or third party evidence filed by the opponent which goes to confusion is the survey evidence which, for the reasons I set out in paragraphs 40 to 45 of this decision, I do not believe is of assistance to the opponent.

66. In my view the opponent has not demonstrated that the relevant public would believe the applicant and opponent to be economically linked or that there has been misrepresentation. I am reminded of the comment of Millett L.J. in *The European Limited v The Economist* [1998] FSR 283 in relation to section 10(2) but I believe equally applicable in the present context:

"A degree of similarity is tolerable; the question is whether there is confusing similarity."

67. The applicant's motives in seeking to register a surname which is not that of the proprietor of the business have also been questioned by the opponent. This seems to be something of a "red-herring" in my view but in any event, as pointed out by Ms Tolson the present proprietor acquired the business under the name KENNEDY FRIED CHICKEN using the same as a trade mark in 1994, well before the application date. Furthermore, it is not unusual or illegal for a business proprietor to use a name, including a personal name, other than his/her own to identify a business. The reasons may be many e.g. image.

68. In my view the opposition under Section 5(4)(a) of the Act must fail.

69. Finally, the ground of opposition under Section 5(3) of the Act, which states:

"5.-(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European

Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

The term “earlier trade mark” is defined in Section 6 of the Act, which is set out earlier in this decision.

70. In the light of my earlier findings in relation to Section 5(2)(b), the Section 5(3) ground cannot succeed and it places the opponent in no stronger position.

### **Costs**

71. The applicant having succeeded he is entitled to a contribution towards his costs. At the hearing, Mr Tolson submitted that the award should be at the upper end of the scale because a large volume of irrelevant evidence was filed, particularly in that it was not relevant to the position in the UK. I have some sympathy with this view. Certainly the bulk of Ms Daniels declaration and the large number of exhibits attached had no real relevance to the particular grounds of opposition and laboured the international, as compared to UK, activities of the opponent to an excessive degree. While I do not feel it necessary to award costs at the upper extreme of the scale, I deem it appropriate to increase by £200 the amount I would have awarded in this case – a relatively straightforward opposition at which the parties are not represented by Counsel.

72. I order the opponent to pay the applicant the sum of £1,900. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16<sup>th</sup> day of July 2003**

**John MacGillivray  
For the Registrar  
the Comptroller General**