

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 1534191
BY FREDERICK RICHARD GEARD AND
PATRICIA ELLEN GEARD
TO REGISTER A TRADE MARK IN CLASS 30**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER OPPOSITION NO. 43351
BY BURGER KING CORPORATION**

**TRADE MARKS ACT 1938 (as amended)
AND THE TRADE MARKS ACT 1994**

5 **IN THE MATTER OF application no. 1534191
by Frederick Richard Geard and Patricia Ellen Geard
to register a mark in Class 30**

and

10

**IN THE MATTER OF opposition thereto under
opposition no. 43351 by Burger King Corporation**

15

DECISION

20 On 29 April 1993 Frederick Richard Geard and Patricia Ellen Geard applied under the Trade
Marks Act 1938 (as amended) to register the mark DONUT KING in Class 30 for a specification
of goods comprising:- "Doughnuts; all included in Class 30". The application is numbered
1534191.

25 When the application for registration was examined it encountered objections under Sections 9
and 10 of the Act because the mark consists of the phonetic equivalent of the word DOUGHNUT
and the word KING conjoined being non-distinctive and descriptive of e.g. doughnuts
manufactured by a person named KING or doughnuts of a superior quality. Subsequently the
applicants filed evidence of use in support of their application and the Registrar Advertised the
30 mark before Acceptance in Part B of the Register under the provisions of Section 18(1) of the
Act.

On 30 October 1995 Burger King Corporation filed notice of opposition to this application.

The grounds of opposition are in summary:-

35

- i) the mark is not adapted to distinguish, as required by Section 9;
- ii) the mark is not capable of distinguishing, as required by Section 10;
- 40 iii) the opponents say they have a reputation in their mark BURGER KING and use
and registration of the applicants mark would be contrary to the provisions of
Section 11;
- 45 iv) registration of the applicants' mark would be contrary to the provisions of Section
12(1) of the Trade Marks Act 1938 as the opponents are the proprietors of the
following United Kingdom registrations:-

	<u>NUMBER</u>	<u>MARK</u>	<u>CLASS</u>	<u>REGISTERED WITH EFFECT FROM</u>
5	B935862	'Burger King'	29	30.12.68
	B935868	'Burger King of Great Britain'	29	30.12.68
	B1051223	'Burger King Whopper'	29	22.08.75
10	B1051226	'Burger King'	29	22.08.75
	B1102509	'Burger King'	29	6.10.78
15	1351793	'Burger King'	29	12.07.88
	1351796	'Burger King/Burger King/ Burger King	29	12.07.88
20	1434280	'Burger King Kids Club'	29	6.07.90
	1434515	'Burger King Kids Club'	29	6.07.90
	1078316	'Burger King Whopper'	30	11.05.77
25	1351794	'Burger King'	30	12.07.88
	1351797	'Burger King/Burger King/ Burger King	30	12.07.88
30	1434281	'Burger King Kids Club'	30	6.07.90
	1434516	'Burger King Kids Club'	30	6.07.90
35	B935863	'Burger King'	32	30.12.68
	B935869	'Burger King of Great Britain'	32	30.12.68
	1351795	'Burger King'	32	12.07.88
40	1351798	'Burger King/Burger King/ Burger King	32	12.07.88
	1282939	'Burger King'	42	1.10.86
45	1282940	'Burger King'	42	1.10.86
	1350599	'Burger King have it your way'	42	12.07.88
50	1434282	'Burger King Kids Club'	42	6.07.90
	1434517	'Burger King Kids Club'	42	6.07.90

- v) the applicant is not entitled to claim to be the true proprietor of the mark DONUT KING and therefore the mark applied for offends the provision of Section 17(1) of the Act.

5 The opponents also ask that the mark be refused in the exercise of the Registrar's discretion and they seek an award of costs.

By way of a counterstatement dated 5 January 1996 the applicants deny these various grounds. They ask the Registrar to dismiss the opposition and award costs in their favour.

10

The opponents filed evidence in these proceedings but the applicants relied on supporting arguments with their counterstatement. Both sides are content to seek the Registrar's decision on the basis of the papers filed in these proceedings, and without recourse to a hearing. Acting on the Registrar's behalf and after a careful study of the papers I now give my decision.

15

By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. Nevertheless, these proceedings having begun under the provisions of the Trade Marks Act 1938, they must continue to be dealt with under that Act in accordance with the transitional provisions set out at Schedule 3 of the 1994 Act. Accordingly, and unless otherwise indicated, all references in the remainder of this decision are references to the provisions of the old law.

20

I first turn to consider the evidence filed by the opponents in these proceedings.

25 The opponents' evidence comprises two Statutory Declarations and supporting exhibits. The first Statutory Declaration is by Mr Philip Kinnersly of Burger King Corporation and is dated 14 October 1996.

30 Mr Kinnersly states that he is Vice President for legal affairs in Europe, the Middle East and Africa of Burger King Corporation, which is the parent Corporation of all the Burger King companies worldwide. The United Kingdom affiliate is Burger King Limited of which Mr Kinnersly is a Director. He says that he has been with Burger King since September 1990, has full access to the opponents records and is authorised to make the declaration on their behalf.

35 Mr Kinnersly claims that the opponents are recognised as one of the world's leaders in fast food restaurants and their BURGER KING mark is famous worldwide. By way of background he explains that the opponents were formed in 1954 as "Burger King of Miami" and shortly afterwards reorganised into Burger King Corporation. In 1974 the first Burger King restaurant was opened in England and in 1989 some 100 Wimpy restaurants were purchased in the United Kingdom and converted to the BURGER KING brand. The same conversion process was undertaken during the following year in relation to a further 60 or so Wimpy restaurants. Mr Kinnersly states that there are now approximately 800 restaurants operating under the BURGER KING brand in Europe and the Middle East - over 400 of these are in the United Kingdom. There are also restaurants at both Heathrow and Gatwick International Airports selling BURGER KING products, including doughnuts. He states that the opponents are now part of the Grand Metropolitan Plc group, one of the United Kingdom's largest branded retailers.

45

At Exhibit 'PK1' Mr Kinnersly provides an advertisement showing the famous Burger King Whopper and states that the opponents are well known for their famous “flame grilled” hamburgers. He claims that the opponents have also generated an established reputation in other areas of their product range; the other products sold by the opponents include doughnuts, sweets and puddings, chicken burgers, vegetarian foods, onion rings, salads and drinks.

Mr Kinnersly provides at Exhibit 'PK2' advertisements showing a sample of the opponents product range sold under the BURGER KING mark and at Exhibit 'PK3' a BURGER KING menu which lists all the different products sold by the opponents.

Mr Kinnersly gives the following annual turnover figures for the products sold under the BURGER KING mark in the United Kingdom for the past five years:-

	<u>YEARS</u> FROM 1 OCTOBER	<u>AMOUNT</u>
15	1991	£157,092,000
	1992	£173,802,000
	1993	£217,994,000
	1994	£263,871,000
20	1995	£269,236,000

Doughnuts are sold by the opponents, says Mr Kinnersly, because they are a well known American fast food. He goes on to say that the public now come to BURGER KING restaurants for coffee and doughnuts and these products are also consumed as part of more complete meals. He exhibits at 'PK4' a poster showing the doughnuts sold by the opponents under their BURGER KING mark. Mr Kinnersly states that the opponents UK sales of doughnuts have been increasing steadily and the sales figures for sales of doughnuts in restaurants in the United Kingdom during May to September 1996 amounted to £253,764.

Mr Kinnersly states that advertisements featuring use of the BURGER KING mark on the opponents products (including doughnuts) have appeared in many newspapers and magazines in the United Kingdom. At Exhibit 'PK5' he provides examples of such advertisements and at 'PK6' examples of promotional material showing use of the BURGER KING mark. Mr Kinnersly goes on to say that the opponents products are also advertised and promoted through competitions and promotions which operate in-store and nationwide. At Exhibit 'PK7' he provides examples showing promotions co-sponsored by Walt Disney and Coca Cola and at 'PK8' a poster showing that the opponents were chosen as one of the official sponsors of the British Olympic Team. Early in 1996 the opponents became the official sponsors of the England football team. Mr Kinnersly provides the following figures in respect of the level of advertising by the opponents of their BURGER KING mark:-

	<u>YEARS</u> From 1 October	<u>AMOUNT</u>
45	1991	£8,605,000
	1992	£9,352,000
	1993	£10,531,000
	1994	£12,780,000
	1995	£10,029,000

He goes on to say that, in addition to the above advertising, the opponents specifically promote their doughnut products. An example of an advertisement depicting the opponents doughnuts is provided at Exhibit 'PK9'.

5 The opponents take the protection of their BURGER KING mark very seriously, says Mr
Kinnersly and he believes that the applicants DONUT KING mark would be likely to be
misunderstood by consumers as being a mark belonging to the opponents or otherwise associated
with the opponents. He refers to the opponents' forty five registrations in the United Kingdom
(see above) and in particular draws attention to registration nos. 1351797 and 1351794 which
10 cover "bread products containing cooked foods: filled buns, filled sandwiches" and registration no.
1051226 which covers "cooked or prepared foodstuffs for making meals or snacks or for use
as fillings in sandwiches or in bread rollsjams".

15 Mr Kinnersly understands that the applicants intend to extend their Eastbourne business by issuing
franchises to operate in other parts of the United Kingdom and he therefore contends that this will
exacerbate the likelihood of confusion. He goes on to claim that the general public are well aware
of the opponents BURGER KING mark, particularly in relation to fast food American style
products, and for them to see a similar mark used by the applicants in relation to doughnuts would
in his view lead them to suppose that the goods are those of the opponents. Also, in Mr
20 Kinnersly's view, the respective marks which comprise a product name coupled with the word
"King" would lead to confusion on the part of the public.

In the context of the Jellinek (1946) 63 RPC 59 case, Mr Kinnersly contends that goods of the
same description are involved. In conclusion, he states that in his view the public would believe
25 that the applicants' mark is that of the opponents - or at the very least associated with it - and it
is for these reasons that the opponents request that the application be refused.

I next deal with Laura Bence's Statutory Declaration which is dated 16 October 1996. Ms Bence
states that she is a Legal Assistant at Dallas Brett Solicitors and has read Mr Phillip Kinnersly's
30 declaration. She goes on to say that when considering the matter of goods of the same description
the third test - trade channels- put forward by Mr Justice Romer in the Jellinek case (1946) 63 RPC
59 merits consideration. Ms Bence states that the applicants' and opponents' products are sold
to the public through North American style fast food type retail outlets and both parties goods are
likely to be purchased by the same type of consumer. She submits that Justice Romer's third test
35 is clearly satisfied i.e. the applicants' and opponents' products are both sold through identical trade
channels.

The applicants provided supporting arguments with their counterstatement which is signed by
F.R Gear and is dated 5 January 1996. In summary Mr Gear makes the following points:-

- 40
- a) the registration of the applicants mark would not interfere with the legitimate
conduct of the opponents business because the applicants have used their mark in
the United Kingdom continuously since 1986;
 - 45 b) the opponents have failed to register either the word BURGER or the word KING
separately and the Registrar has allowed registration of the opponents' mark only
on the basis of the use together of the two words;
 - c) a disclaimer to the exclusive right to the word KING is entered on registration nos

1051226 and 1102509. All the other registrations owned by the opponents are all associated with these two registrations. Consequently, the opponents are estopped by the disclaimer from maintaining their objection to the applicants' mark;

- 5 d) the Registrar should use his powers under Section 32 of the Act to revoke or restrict by the imposition of a condition the abuse by the opponents of their registered marks in seeking to obtain a trade monopoly in the word KING;
- 10 e) if the opponents' registrations do entitle them to prevent the applicants use of the word KING, then those registrations are inconsistent with other registrations on the register subject to a like disclaimer; and
- 15 f) the applicants deny that there can be any confusion on the part of the public between the marks DONUT KING and BURGER KING. Also, if the opponents do sell doughnuts then such sale is not common to all or even in most of the opponents shops and is such an insignificant part of their business as to be unconnected in the minds of the public with the mark BURGER KING.

20 These rebuttal claims by the applicants have not been supported by evidence in statutory declaration form. Thus, while I note these claims, I can take no account of them in reaching my decision. I now turn to the grounds of opposition.

25 It will be convenient if I first set out some of the background to the events which lead up to the advertisement of this application. When it was first examined objection was taken under Section 9 because, to quote the Examiner, "it consists of the phonetic equivalent of the word DOUGHNUT and the word KING conjoined, being non-distinctive for and descriptive of e.g. doughnuts manufactured by a person or firm named KING or doughnuts of superior quality."

30 The Examiner also objected to the application under Section 10 because she did not think it capable of distinguishing the applicants goods.

35 To overcome these objections the applicant filed evidence of his use of the mark. It was sufficient to persuade the Examiner to allow the application to proceed to Advertisement before Acceptance, for Part B of the Register under the terms of the proviso set out in Section 18(1) of the Act.

40 The applicants have not filed any fresh evidence in these proceedings nor have they re-filed their evidence of user which they placed before the Examiner. It is also the case that the opponents have filed no evidence in support of their grounds of opposition under Section 10 of the Act. (Section 9 is not relevant as the mark is now proceeding in Part B). In these circumstances it is difficult to decide how to treat this ground of opposition. It would be feasible for example to consider the mark on a prima facie basis and if I do that then the likely result would be a finding that the mark is not capable of distinguishing. However, the applicants placed evidence of use before the Examiner and she decided on the basis of that evidence that the mark has the capacity to distinguish. As the opponents have filed no evidence with regard to this matter I have decided

45 in the particular circumstances of this case to endorse the decision of the Examiner. The opponents therefore fail in their ground of opposition under Section 10.

I go on to consider the grounds of opposition under Sections 11 and 12 of the Act. These sections read as follows:

Section 11 It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a Court of Justice, or would be contrary to law or morality, or any scandalous design.

5

Section 12(1) Subject to the provisions of sub-section (2) of this Section, no trade mark shall be registered in respect of any goods or description of goods that it identical with or nearly resembles a mark belonging to a different proprietor and already on the Register in respect of:

10

(a) the same goods

(b) the same description of goods; or

15

(c) services or a description of services which are associated with those goods or goods of that description.

The reference in Section 12(1) to a near resemblance is clarified by Section 68(2)(b) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

20

The established tests for objections under Sections 11 and 12 are set down in Smith Hayden and Company Ltd's application (volume (1946) 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case (1969) RPC 496. In relation to the matter in hand, these tests may be expressed as follows:

25

(a) **(Under Section 11)** having regard to the user of the mark BURGER KING, is the tribunal satisfied that the mark applied for, DONUT KING, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

30

(b) **(Under Section 12)** assuming user by the opponents of their marks BURGER KING in a normal and fair manner for any of the goods covered by the registration of those marks, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark DONUT KING, normally and fairly in respect of any goods covered by their proposed registration?

35

40 I deal first of all with the Section 11 ground.

The opponents say that their first Burger King restaurant opened in England in 1975 and have provided evidence of substantial sales for the years 1991 - 1995 inclusive for products sold under the BURGER KING marks in the United Kingdom and examples of promotional material used.

45 I consider that this evidence clearly supports the opponents claim that their BURGER KING trade marks have a significant reputation in relation to American style fast food products.

I next compare the marks in suit, BURGER KING and DONUT KING and I use the well established guidance propounded by Parker J in Pianotist Company's application (1906) RPC 774 at page 777 line 26 et seq-

5 “You must take the two words. You must judge of them both by their look and by their
10 sound. You must consider the goods to which they are to be applied. You must consider
 the nature and kind of customer who would be likely to buy those goods. In fact, You
 must consider all the surrounding circumstances; and you must further consider what is
 likely to happen if each of these trade marks is used in a normal way as a trade mark for
 the goods of the respective owners of the marks. If, considering all those circumstances,
 you come to the conclusion that there will be confusion - that is to say- not necessarily that
 one will be injured and the other will gain illicit benefit, but that there will be a confusion
 in the mind of the public, which will lead to confusion in the goods - then you may refuse
 the registration, or rather you must refuse the registration in that case”.

15 The respective marks consist of the word KING and the name of a food product. For comparison
 purposes I assume that the public will recognise the word DONUT appearing in the applicants
 mark as clearly indicating “Doughnut” particularly when the mark is used in relation to such
 products. It is thus clear that the word KING is the distinctive feature in both marks. I have
20 already found that the opponents have a significant reputation in their mark BURGER KING and
 that it is well known by the public. I believe that the public would assume that other marks
 consisting of the name of a product together with the word KING would be associated in some
 way with BURGER KING when this is not the case. I have no hesitation in arriving at a
 conclusion that the marks at issue here are confusingly similar.

25 I add here that I note the applicants comments about a disclaimer in two of the opponents
 registered marks. However, such disclaimers have no effect on my view when comparing the
 respective marks. The plain fact of the matter is that by the relevant date the opponents had a
 significant reputation in their marks and it is that fact which must be borne in mind. In any case
30 it is well established that disclaimers do not enter the market place.

 The opponents state that they sell doughnuts because they are a well known American style fast
 food product and therefore suit their product range. Indeed there is some evidence that they have
 sold doughnuts as part of their product range in recent years but such use appears to have been
35 after the relevant date of these proceedings which is 29 April 1993, the date of the applicants
 application. The opponents however, had a significant reputation in their mark at the relevant date
 in relation to American style fast food products and it is not disputed by the applicants that
 doughnuts are or could be one of the products in that range, which appears to be confirmed by the
 later use attested to by the opponents. At the very least it appears to me that all these goods are
40 closely associated and that the public could well be deceived as to origin if they encountered the
 respective goods sold under the same or confusingly similar marks.

 In conclusion, therefore, I have come to the view that in the context of the Smith Hayden test a
 significant number of the public would be deceived and confused as regards origin if they
45 encountered the applicants mark in relation to the goods at issue. The opponents thus succeed in
 their opposition under Section 11 of the Act.

My finding under Section 11 effectively decides the matter but for the sake of completeness I go on to consider the matter under Section 12(1) of the Act. I have already come to the conclusion that the respective marks are confusingly similar so the only matter to be decided is whether or not the applicants goods are the same or of the same description as those covered by the opponents registered marks. The opponents list 23 registrations in Classes 29, 30, 32 and 42 in their grounds of opposition. Applying the Smith Hayden test I have to assume normal and fair use of the opponents marks on any of the goods and services covered by the registrations.

It is clear that most of the opponents registrations do not cover the same goods or goods of the same description. However, registration nos. 1351797, 1351794 and 1051226 include within the specifications the following goods:-

“bread products containing cooked foods; filled buns, filled sandwiches; cooked or prepared foodstuffs for making meals or snacks or for use as fillings in sandwiches or in bread rolls jams”.

In considering the goods of the applicants - doughnuts- and the opponents goods (above) the opponents referred in their evidence to the well established tests set down in JELLINEK’s application (1946) 63 RPC 59. The Jellinek tests are as follows:

- a) the nature and composition of the goods
- b) the purpose of the goods
- c) the trade channels through which the commodities respectively are bought and sold

Applying the Jellinek criteria to these specifications of goods the nature, composition and use of the goods are such that confusion could, in my view, ensue. The respective goods are foodstuffs made from flour and could all be described as bakery products. The channels of trade could be the same. Consequently, I find that the goods could in fact be essentially the same goods or at the very least - as argued by the opponents - they are goods of the same description.

Having found that the applicants mark is confusingly similar to that of the opponents and that it is proposed to be used on goods which are the same as, or of the same description as, the goods specified in some of the opponents registrations, I must conclude that the opposition under Section 12(1) succeeds.

The opponents also say that the applicants cannot claim to be the proprietors of the mark at issue within the meaning of Section 17(1). No evidence was filed in support of these allegations and I can see nothing which would cast doubt on the applicants claim to proprietorship of their mark. The opposition, therefore, fails insofar as it is based on Section 17(1).

Finally, there is the matter of the Registrar’s discretion. The opposition under Sections 11 and 12 having succeeded, an exercise of the Registrar’s discretion is neither necessary nor appropriate.

The opponents having succeeded I order the applicants to pay them the sum of £535 as a contribution towards their costs.

5 Dated this 23rd day of February 1998.

D C MORGAN
For the Registrar
the Comptroller General

10