

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2121289
BY BAHIR BAHJAT SABIR
TO REGISTER A TRADE MARK IN CLASSES 25 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO 47174 IN THE NAME OF OFFICIAL ALL STAR CAFE**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2121289
by Bahir Bahjat Sabir
to register a trade mark in Classes 25 and 42**

And

**IN THE MATTER OF Opposition thereto under
No 47174 by Official All Star Cafe**

DECISION

On 20 January 1997, Bahir Bahjat Sabir, of 56 Bettws-y- Coed Road, Cyncoed, Cardiff, applied to register a series of two trade marks in Classes 25 and 42 for the following specifications of goods:

Class 25

Articles of clothing; belts, caps, hats, jackets, shirts, polo necks, sweatshirts, ties, T-shirts, socks, shorts, sun visors, all included in Class 25.

Class 42

Provision of food and drink for consumption on or off the premises, restaurant, bar and night club catering..

The respective marks are:



The application, numbered 2121289 was published for opposition purposes on 11 June 1997 and on 9 July 1997, Official All Star Cafe filed notice of opposition to the application. The grounds on which the opposition is based are, in summary:

- Under Section 3(6)** The opponents have a worldwide reputation and the mark applied for is so similar to the device used by the opponents that the application was made in bad faith.

2. **Under Section 5(4)(b)** The opponents own the copyright in the mark applied for so its registration would be prevented by the law of copyright.

5 3. **Under Section 32(3)** The applicant is not in the restaurant business or garment trade or any similar activity so has no intention to use the mark.

10 The applicants filed a counterstatement in which they deny these grounds of opposition.

The matter came to be heard on 8 March 1999 when Mr Bahir Bahjat Sabir, the applicant in these proceedings represented himself, the opponents were not represented.

15 **The opponents' evidence**

This consists of a statutory declaration dated 7 January 1998 by Andrew Charles Serjeant, a senior partner in Serjeants, a firm of Chartered Patent Agents, and the opponents trade mark attorneys.

20 Mr Serjeant begins by referring to exhibit ACS1 which is an example of the headed paper used by the opponents, which is headed with "A star and circle" logo, with the opponents' address and contact details in Orlando, Florida at the foot. He says that the opponents own the copyright in the design which was created around March 1994. Mr Serjeant goes on to say that in 1995 the opponent started opening restaurants under the logo and gives a list of locations with opening
25 dates. In all but three cases, Cancun, New York and Las Vegas these opened after the relevant date. He says that the openings were heavily publicised and refers to exhibit ACS2 which consists of various items of printed matter, although in a number of cases these are dated after the relevant date and cannot be given any weight. Those bearing an earlier date include extracts from publications circulated in the United Kingdom, and depict items of clothing bearing the logo, some
30 being worn by personalities. The remainder consists of two articles from what appear to be catering and leisure industry publications, one relates to theme restaurants in general including a reference to the opponent and their proposals to open in the United Kingdom, the other relates solely to the opponents. Mr Serjeant goes on to say that the opponents have invested a great deal of money (although he gives no additional information) and that in his opinion the opponents will
35 suffer damage to their reputation if the application is registered.

Mr Serjeant refers to the visit of a private investigator to the opponents address in Cardiff and the results of some research from the Electoral Roll, and Companies House which revealed two
40 companies registered in the applicants name; The all Star Cafe (London) Limited (subsequently Cafe Alfa (London) Limited, and The All Star Cafe Limited (subsequently Cafe Alfa Limited). Mr Serjeant says that the name changes were effected following a challenge by the opponents' lawyers and makes a number of deductions regarding the applicants' intention to use the company names and the mark applied for. He concludes by referring to the correspondence sent to the applicants following publication of the mark, which is shown at exhibit ACS3.

Applicants' evidence

5 This consists of a statutory declaration dated 30 March 1998 by Mr Bahir Bahjat Sabir who says he is a Chartered Engineer currently engaged in education. Mr Sabir says he is secretary of Star Cafe (London) Limited (subsequently Cafe Alfa (London) Limited, and director of The All Star Cafe Limited (subsequently Cafe Alfa Limited), neither of which have traded since incorporation in November 1995, which he points out is before the opponents started trading in the United States.

10 Mr Sabir says that he encountered the words "All Star and the Star and Circle" designs before the opponents' venture came about, and refers to exhibit BBS1 which is a copy of the cover of a holiday brochure dated 1994/5, and which bears a Star and Circle logo with the words "ALL-STAR RESORT". He goes on to say that searches at Companies House revealed that there are many companies trading using the words "All Star". He also says that a cafe in San Francisco
15 currently trades under the name All Star and refers to exhibit BBS2 which is a copy of two photographs depicting a building with the sign "ALL STAR CAFE" and endorsed "San Francisco, Ca., USA" which Mr Sabir says were taken in August 1997

20 Mr Sabir acknowledges that the opponents have used their logo in the United States but not in the United Kingdom or Europe. He says that he has also encountered a similar "A and Star" design and refers to exhibit BBS3 which are copies of photographs of the club Astoria in Cardiff taken in August 1997. Mr Sabir goes on to refer to marks used by other companies which incorporate elements of the mark he has applied to register, and refers to exhibit BBS4 which consists of examples of leaflets and photographs depicting the marks referred to, and to exhibit
25 BBS5 which consists of examples of names incorporating a star device. Mr Sabir goes on to refer to correspondence between himself and the opponents, copies of which are shown at exhibit BBS6. He concludes referring to Mr Serjeants' declaration and commenting on the exhibits attached.

30 That concludes my review of the evidence, and I turn to consider the respective grounds upon which the opposition has been brought.

Decision

35 I turn first to the objections under Section 32(3) of the Act, which reads:

32(3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used.

40 In my view, Section 32(3) does no more than set out a requirement in respect of an application to register a trade mark. The prescribed application form contains a statement in accordance with Section 32(3), which has been signed by Mr Sabir. Any challenge that this statement was made in bad faith must be considered under Section 3(6) of the Act. I do not consider therefore that
45 Section 32(3) does provide a ground of opposition in this case (or any other case) and is dismissed accordingly.

I next turn to consider the grounds of opposition under Section 5(4)(b) of the Act, which reads:

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-

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an ‘earlier right’ in relation to the trade mark.

The opponents say that their “A star and circle” logo was devised around March 1994 and that the artwork was assigned to them. Apart from the assertions in the pleadings there is no material to support this ground. There is no evidence before me to support the assertions or that the opponents possess an earlier right in terms of the law of copyright as claimed. In the Wild Child trade mark case, Geoffrey Hobbs QC sitting as the Appointed Person said:

“..I am not willing to regard assertions without any real substantiation as sufficient to sustain any objection under section 5(4). On my assessment of the evidence the asserted “*earlier right*” remains unsubstantiated and the question of conflict does not arise.”

Consequently, the opposition founded under Section 5(4)(b) also fails.

This leaves the matter of the ground of opposition under Section 3(6) which reads:

3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

The opponents objection is founded on their belief that the applicants' mark is so similar to the device element of a mark used by them that they believe it to be their mark, and that in applying to register their mark the applicants acted in bad faith. The first matter which needs to be determined is the similarity (or otherwise) of the respective marks, for if they are not the same, or at least very similar, there can be no foundation to the claim that the application was made in bad faith.

Similarity of the marks?

Both sides put forward a detailed examination of the component parts of the marks. It is well established that for the purpose of comparison, marks must be considered as a whole and not dissected into their various component parts, (see Erectiko trade mark case [1952] RPC 136). The European Court of Justice recently issued guidance on the approach that should be followed in determining whether two marks are similar in the case of Puma v Sabel C251/95. The Court said:

“That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.”

Both marks have a letter “A” stylised in a very similar fashion placed inside a five pointed star and centrally over two concentric circles, and I have no difficulty in finding that they are visually and conceptually very similar. In assessing the distinctive and dominant components of the marks I note that generally speaking, words “speak louder” than devices in a composite mark. Although
5 the opponents' mark has the words “OFFICIAL ALL STAR CAFE” running around the outside of the circles, it is in relatively small lettering and placed inside the points of the star which breaks up their continuity and makes them difficult to read, the overall effect being to reduce their significance. The device element, and in particular the letter “A” inside the star is in my view such a dominant part of the mark, that if the marks were to be referred to by word of mouth, it is likely
10 that it would be by reference to these elements. I therefore conclude that the marks are very similar, and that he who owns one, owns both.

This brings me to the matter of proprietorship. It seems to me that where the applicants claim to be the proprietor of a mark is challenged, it is appropriate to consider the guidance of the decision of the Court of Appeal in the Al Bassam trade mark case [1995] RPC 511, in which Morritt L.J. made the following observations:

at page 522 line 6 et seq:

20 “Accordingly, it is necessary to start with the common law principles applicable to questions of ownership of unregistered marks. These are not in doubt and may be shortly stated. First the owner of a mark which had been used in conjunction with goods was he who first used it. Thus in Nicholson & Sons Ltd's application (1931) 48 RPC 227 at page 253 Lawrence LJ

25 “The case to which I have referred (and there are others to the like effect) show that it is firmly established at the time when the Act of 1875 was passed that a trader acquired a right of property in a distinctive mark merely by using it upon or in connection with his goods irrespective of the length of such user and of the extent of his trade and that such
30 right of property would be protected by injunction restraining any other person from using the mark.”

and at page 522 line 40 et seq:

35 “In my view it is plain that the proprietor is he who satisfies the principles of the common law to which I have referred. Accordingly in the case of a used mark, as in this case, the owner or proprietor is he who first used it in relation to goods for the purpose indicated in the definition of trade mark contained in Section 68 which I have already quoted.

40 The evidence from both sides is very thin and does little to ease the difficulty in determining what is the fundamental question of who owns the trade mark. Neither party appears to have used their mark in any trade in goods or services in the United Kingdom, although use in connection with the relevant goods and services, such as in the preparation for trading would appear to be sufficient to establish proprietorship. There is no evidence before me to show that the applicants
45 have made any preparations to begin trading and they do not give any details in this respect or say when trade is likely to commence. The opponents have stated that they intend to commence trading under their mark, but after the relevant date. There is evidence dating from before the

relevant date publicising the opponents' mark and establishing the connection with the relevant goods and services, but this has been in trade magazines and a small number of "teen" and a general interest magazine.

5 The opponents have claimed that the application was made in bad faith, inferring that the applicant
knew that the mark belonged to them, but nonetheless made the application. This is a serious
allegation and in my view the onus in such cases rests firmly with the opponent, who must
10 establish that their mark was well known to the point that the applicant must have known it
belonged to them, or would have known through some other circumstances, for example, a trade
connection. I find that the opponents claim to a "world wide reputation" to be somewhat
overstated and nowhere near substantiated by the evidence before me. While they may have a
claim to first use, the evidence is so limited that I cannot find that they have established their claim
15 to be the proprietor of the mark in the United Kingdom, or that the applicant acted in bad faith
in making his application, and consequently, the opposition under Section 3(6) fails.

The opposition having failed on all grounds I order that the opponent pay the applicant the sum
of £635 as a contribution towards their costs.

20 **Dated this 17 day of March 1999**

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30 **Mike Foley**
for the Registrar
The Comptroller General

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