

BL O/1009/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF

TRADE MARK APPLICATION/REGISTRATION NOS 3557944 & 3557940

IN THE NAME OF FATBURGER NORTH AMERICA, INC. AND

OPPOSITION THERETO/APPLICATION FOR CANCELLATION THEREOF

(UNDER NOS. 600001708 & 503891, RESPECTIVELY) BY

IMP LTD

&

TRADE MARK REGISTRAION NOS 3482347 & 3488210

IN THE NAME OF IMP LTD AND APPLICATIONS FOR CANCELLATION

THEREOF (UNDER NOS. 503991 & 503992, RESPECTIVELY)

BY

FATBURGER NORTH AMERICA, INC.

BACKGROUND

1) This dispute concerns four consolidated cases; three of those cases are applications for cancellation and one is an opposition. The parties to the dispute are IMP Ltd ('IMP') and Fatburger North America, Inc. ('FNA').

The opposition and application for cancellation by IMP to FNA's trade mark application and registration, respectively

2) On 19 November 2020, FNA applied to register the following, as a trade mark, in the UK:

- Trade Mark No: 3557944 ('944')



The mark is applied for in respect of various goods and services in classes 29, 30, 32, 35 & 43.

Mark '944' was published in the Trade Marks Journal on 12 March 2021. On 28 April 2021, IMP filed a notice of opposition (under the Fast Track opposition procedure) against the application.

3) FNA is also the registered proprietor of the following UK trade mark registration, which was filed on 19 November 2020 and completed its registration procedure on 14 May 2021:

- Trade Mark No: 3557940 ('940')

FATBURGER

The mark is registered in respect of various goods and services in classes 29, 30, 32, 35 & 43.

On 3 June 2021, IMP filed an application to cancel registration '940.

4) IMP claims that FNA's application ('944) and registration ('940) both offend under sections 5(1) and 5(2)(a) & (b) of the Trade Marks Act 1994 ('the Act'). It relies upon the following two trade mark registrations in support of those grounds:

- **Trade mark No: 3482347 ('347)**



Filing date: 17 April 2020

Date of entry in register: 10 August 2020

Class 35: Online food ordering service; Online ordering services.

- **UKTM 3488210 ('210)**



Filing date: 09 May 2020

Date of entry in register: 11 August 2020

Class 43: Takeaway food and drink services; Restaurants.

5) FNA filed a counterstatement in defence of its application and its registration. It admits that the respective marks are visually, aurally and conceptually very similar but denies that all of its goods and services are similar to the services covered by the earlier marks. It also states that the earlier marks are invalidly registered owing to FNA's earlier unregistered rights in the UK and the law of passing off ('amongst other' reasons) and that, contrary to IMP's claims, the average consumer is, in fact likely to be misled and deceived into believing that IMP's services originate from FNA (or an undertaking related thereto).

FNA's applications to cancel the trade marks of IMP

6) In response to the opposition and application for cancellation filed by IMP against its marks, FNA filed applications to cancel the earlier marks relied upon by IMP. FNA relies upon grounds under sections 5(4)(a), 3(6), 5(2)(b) and 5(3) of the Act. The two latter grounds are based upon FNA's claim to have two 'well known' marks as defined in Section 56(1), which are earlier marks in accordance with section 6(1)(c) of the Act. All of the latter provisions can be relied upon in cancellation proceedings by virtue of Section 47(1), (2)(a) and (2)(b) of the Act.

7) Under section 5(4)(a) of the Act, FNA claims that it has used two signs, which correspond exactly in their representation to those covered by marks '944 and '940 (shown above) throughout the UK since 31 December 2008 in relation to the following services (which FNA collectively describes as the 'franchising services'):

'business assistance, advice and consultancy relating to franchising, including the establishment and operation of restaurant franchises; franchising services providing marketing assistance; assistance in franchised commercial business management; management advisory services related to franchising; business advertising services relating to franchising; Business assistance and advice relating to restaurant franchising; administration of the business affairs of franchises; advisory services relating to publicity for franchisees; provision of business information relating to franchising; advice in the running of establishments as franchises; assistance in business management within the framework of a franchise contract; assistance in product commercialization, within the framework of a franchise contract; services rendered by a franchisor, namely, assistance in the running or management of industrial or commercial enterprises; marketing services in the field of restaurants; business management assistance and advisory services in the establishment and operation of restaurants; information, advice and consultancy relating to all the aforesaid services'

8) It is further claimed that the two signs have also been used throughout the UK, since 21 May 2015, in relation to the following services (which FNA collectively describes as the 'restaurant services'):

'restaurant management for others; business management of restaurants; on-line ordering services in the field of restaurant take-out and delivery; restaurant services; grill restaurants; restaurant reservation services; carry-out restaurants; fast food restaurants; take-out restaurant services; Bar services; restaurant services incorporating licensed bar facilities; provision of food and drink in restaurants; making reservations and bookings for restaurants and meals; serving food and drink in restaurants and bars; take-away food and drink services; catering in fast-food cafeterias; information, advice and consultancy relating to all the aforesaid services.'

9) It is claimed that use of IMP's trade marks will lead to misrepresentation and damage to the goodwill vested in FNA's business by virtue of i) loss of sales owing to consumers using IMP's services in the mistaken belief that they are the responsibility of FNA and ii) injurious association on the basis that poor quality services provided by IMP would be damaging to FNA's goodwill.

10) Under section 3(6), FNA refers to the use made by it in the UK (as relied upon under section 5(4(a)) and also to the claimed use of both of its earlier signs for around 70 years overseas. It is said that such use commenced in the US, then moved to Canada and later more broadly such that its reputation extended to the UK in relation to the 'restaurant services' set out above. It claims that IMP was aware of the aforementioned use and that it therefore had a dishonest state of mind when it applied for its marks, which was twofold, as follows:

- i) IMP intended to undermine, in a manner inconsistent with honest practices, the interests of FNA under its FATBURGER signs in the UK, by obtaining an exclusive right in the registered trade mark for purposes other than those falling within the functions of a trade mark, i.e. to block genuine applications made by the Applicant for the FATBURGER signs, which actions are now being played out before the UKIPO in the related opposition and cancellation actions.
- ii) To obtain an unfair advantage by exploiting the Applicant's significant goodwill, reputation and well-known rights in the FATBURGER signs in the UK, without having to invest in its own advertising activities, but instead free-ride off the coattails of FNA and its significant advertising efforts over several decades.

FNA also submits that IMP must have known about its earlier FATBURGER signs because IMP used FNA's signs, without consent, on a website. Further, FNA will also adduce evidence in the form of an email which was sent to FNA's marketing email address (apparently in error) from a company who appeared to be developing an online platform for IMP. It is claimed that the said email contained a QR code designed to access IMP's menu for online food ordering, which used one of FNA's signs (that corresponding to mark '944) at its heart.

11) Further, FNA claims that the signs which are relied upon under section 5(4)(a) of the Act are also entitled to protection as well-known marks, as per Article 6*bis* of the Paris Convention and section 56 of Act, which qualify as earlier marks under section 6 of the Act. Those marks are relied upon under sections 5(2)(b) and 5(3) of the Act. It relies upon the same goods and services as relied upon under section 5(4)(a) and claims that there is a likelihood of confusion under section 5(2)(b) and that the earlier marks have a reputation and the later marks will take unfair advantage of, or be detrimental to, the reputation and/or distinctive character of the earlier marks.

12) IMP filed a counterstatement in defence of each of its registrations. The statements made therein can be summarised as follows:

- It is denied that any of FNA's pleaded grounds are sustainable.

- IMP puts FNA to proof of its claim to have used its signs in relation to the 'franchising service' in the UK since 2008
- IMP accepts that FNA has made 'limited use' of its earlier signs in relation to 'restaurant services' since 21 May 2015 but submits that that use is not sufficient to show the requisite goodwill to sustain an action for passing off. It states that FNA has claimed to open only three restaurants in the UK since 2015 and one of those closed within twelve months of opening.
- IMP claims to have operated restaurants in the UK since 2010 under its 'Fatburgers' mark (and online at its website and social media accounts).
- IMP claims to currently have 21 restaurants operating under the 'Fatburgers' name in the UK. A table is provided listing the addresses of those restaurants and the 'approximate date of opening'.
- It is said, therefore, that IMP possesses a significant goodwill of its own and that any confusion amongst consumers is likely to be due to them using FNA's services in the mistaken belief that they are the services of IMP. It is therefore denied that there would be any misrepresentation of the kind claimed by FNA because any misrepresentation is likely to be the other way around.
- It is denied that IMP's marks were applied for in bad faith. It is claimed that IMP was wholly unaware of the existence of FNA and its 'Fatburger' marks until FNA applied to register its marks in the UK. It states that the bad faith allegation is wholly inconsistent with the fact that IMP has operated restaurants under its mark since 2010.
- It is denied that the marks relied upon under section 5(2)(b) and 5(3) are well-known marks in the UK, as defined by section 56(1) of the Act. IMP does not, however, take issue with the claimed similarities between the respective marks and services, pointing out that it relies upon the same claims for the purposes of its own opposition and cancellation against FNA's application and registration.

13) In the light of the relationship between all four cases, and the evidence required to substantiate the various claims, the opposition, which had initially been filed under the fast-track procedure, was transferred to the standard opposition procedure and

all four cases were consolidated. Both parties filed evidence. A hearing took place before me at which FNA was represented by Mr Daniel Selmi of Counsel, instructed by Dentons UK and Middle East LLP. IMP neither attended the hearing nor filed written submissions in lieu.

APPROACH

14) If FNA's applications for cancellation against IMP's trade marks succeed, this will mean that IMP will have no valid earlier rights upon which it can rely for the purposes of its opposition and application for cancellation against FNA's application and registration. It therefore makes sense to begin by considering FNA's applications for cancellation against IMP's trade mark registrations.

SECTION 5(4)(a) – PASSING OFF

15) Section 5(4)(a) states:

“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, or

(b) [.....]

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.”

16) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

The relevant date

17) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of section 5(4)(a) of the Act and concluded as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

18) FNA must show that it had the necessary goodwill at the filing dates of the contested marks. Those dates are 17 April 2020 (in respect of mark '347) and 9 May 2020 (in respect of mark '210). However, IMP has claimed to have used its mark prior to those dates. It is therefore necessary to consider IMP's evidence in order to establish whether there is any earlier relevant date(s). That evidence has also been challenged by FNA in its own evidence. Accordingly, it is necessary to also consider FNA's evidence on the matter. I will begin by summarising the relevant aspects of IMP's evidence, before turning to summarise the relevant aspects of FNA's evidence.

19) IMP's evidence comes from five individuals. Those individuals are Aaron Khan, Imran Shahzad, Faheem Badur, Deepak Kabra and Tanveer Mohammed who all provided evidence in chief. Mr Mohammed also provided a second witness statement, in reply to FNA's evidence.

Mr Khan's evidence in chief for IMP

20) Mr Khan states that he is 'the 100% shareholder of IMP Ltd'. He further explains that IMP has licensed the use of its marks to separate legal entities which operate various restaurants. No copies of any licenses are provided. He states that he is also 'the shareholder of the restaurant operating companies'. It is said that, although the marks were registered in 2020, the use of the marks goes back much longer.

21) Mr Khan states that 'we' operate a successful chain of restaurants and that the 'Fatburgers' name has been used since around 2010. However, he states that the website www.fatburgers.com was acquired earlier than this, in 2001. A copy of the registration is provided¹. The copy shows no indication that it is owned by IMP or by any of the other companies referred to by Mr Khan in his statement, nor by any of the individuals who have given evidence in these proceedings. The 'registrant contact' details are in Arizona.

22) Mr Khan states that he and Mr Badur had been thinking about setting up a restaurant chain as far back as 2001. At that time, the two had operated a café

¹ Exhibit AK1

together in Birmingham. He states that neither of them had any knowledge, at that time, of FNA.

23) Mr Khan states that the website www.fatburgers.co.uk was acquired in 2020 but he does not give the precise date in 2020.

24) Mr Khan provides a number of screenshots from Facebook sites. One of these is from www.facebook.com/Gourmet4UK/, which is stated to be a 'Food court model'. The page is undated and shows the mark 'Gourmet 4' in use in relation to a 'restaurant'. There are images of burgers and other foodstuffs on the page. Similar undated screenshots are provided showing use of the marks 'Smokin-Buns', 'Saucy chicks' and 'bsocial'. There are nine screenshots in total, only two of which show use of the contested marks and they are, in any event, undated.

25) Mr Khan states that 'we' commissioned Mr Imran Shahzad (of Noor Grafix Solutions Ltd and then Colour Cottage Ltd) to create the contested 'Fatburgers' logo and design. He does not state when this was.

26) Mr Khan states that in 2009, he and his cousin, Mr Faheem Badur, set up the company Bennys Ltd (07018099) to operate restaurants. The two were business partners and started using the 'Fatburgers' name. The name of that company was later changed to Superios Ltd. That company traded until 2017. Mr Khan provides copies of accounts for that company from Sept 2012, Sept 2014, June 2014 and Sept 2015². I note that all the reports state that the person who had served as director of the company for the previous year was Faheem Badur (there is no mention of Mr Khan) and that the principal activities of the business were a 'fish and chip shop'.

27) Mr Khan states that he acquired Mr Badur's share of the business in 2016. Thereafter, Mr Khan became the sole owner of the business and restaurants that had already been set up. He states that he also acquired Buttershaw Ltd (086623811). He then set up a separate company, Percivale Ltd (10874017) in 2017 and acquired Roms-K Ltd (09594674). It said that these three companies are still trading and make use of the 'Fatburgers' name, along with 'other brands'. The main

² Exhibits AK2 – AK5

operating company is said to be Percivale Ltd which has traded successfully for a number of years. Accounts from July 2018, July 2019, July 2020 are provided³. In the reports, the principal activity is said to be a 'fast food restaurant'. Again, there is no mention of Mr Khan being a director of that company in any of the reports. The directors are other individuals. None of those individuals have given evidence in these proceedings. Mr Khan states he does not provide any accounts for Buttershaws Ltd or Roms-K Ltd because that would make the exhibits too lengthy.

28) It is said that, throughout this period, from 2009 onwards, 'we' have used the same firm of accountants, CBS Associates UK Ltd (a separate witness statement is provided by the accountant which I will come to later).

29) Mr Khan reiterates that IMP is the owner of the trade marks and that the restaurants were operated by Superios Ltd, and then later by Percivale Ltd and other companies. In addition to using the 'Fatburgers' name, the companies also use other brands, namely, 'Gourmet4', 'Eat4Less', 'Saucy Chicks', 'Smokin Buns', 'Smoky Joes' and 'B Social Bar'. It is said that 'we' do not have separate accounting for just the 'Fatburgers' restaurants. One bank account is operated for Percivale Ltd. The other companies have their own bank accounts. The restaurant brands do not have separate accounts. One payroll is operated for the entire group and the money from electronic orders and card payments go to one bank account for the operating company.

30) Mr Khan states that 'our business' operates two restaurant models. Firstly, it is said that there are restaurants which are solely branded 'Fatburgers'. He provides a table listing 22 addresses in various parts of the UK and the 'approximate date of opening' for each address for those sites which are said to be branded 'Fatburgers'⁴. Many of these dates of opening fall after the filing dates of the contested marks but there around 12 that pre-date the filing dates of the contested marks.

31) Secondly, it is said that there is a food-court type model where 'we' acquire a large property and have several brands operating within it, one of which is 'Fatburgers'. Customers are able to order from any of the different restaurants in the

³ Exhibit AK6-AK8

⁴ [13] of Khan

food court. The food court is under the mark 'Gourmet4' and contains several restaurant brands. He provides a table of the locations of those food courts⁵. There are 35 UK addresses in the table.

32) Mr Khan states that leases have been acquired for all the above properties. Those leases are said to be owned by different companies whilst the restaurants are operated by Percivale Ltd, as well as other entities. Mr Khan provides copies of some of the leases⁶. All of the leases post-date the filing dates of the contested marks.

33) Mr Khan provides photographs which are said to show some of the restaurants that are operated⁷. These are in various locations such as Newcastle, Bromborough, Crewe, Birmingham etc. None of the photographs are dated.

34) Mr Khan reiterates that he and Mr Badur have been operating restaurants using the 'Fatburgers' name since around 2010 and that the first time he heard about the existence of FNA was when he received the initial letter from their UK solicitors, Dentons LLP.

Mr Imran Shahzad's evidence in chief for IMP

35) Mr Shahzad states that he runs a printing and design company. He used to work for Noor Grafix Solutions and he currently runs Colour Cottage Ltd. The business designs logos and other creative content for its customers. They also print, produce and fix signs on shops and restaurants and produce websites and posters.

36) Mr Shahzad states that he has worked with Superios Ltd and later Percivale Ltd and their other entities for about 10 years and his business has been producing menus, logos and designs, shop signs and fitting those signs.

37) Mr Shahzad states that his team created the contested mark. He states that this was 'many years ago' but he 'cannot recall the exact date'. He states that he had never heard of FNA and that the design was not in any way influenced by their marks.

⁵]14] of Khan

⁶ Exhibits AK9 – AK13

⁷ [18] of Khan

38) Mr Shahzad states that, for about ten years, his business has been creating and producing menus for the 'Fatburgers' brand. He provides copies of invoices which, he states, relate to the production of leaflets for the 'Fatburgers' name⁸. On the face of it, there are a large number of invoices spanning the period 2010 - 2019, however, on closer inspection, many of these appear to be duplicates. None of the invoices are addressed to IMP. Some are addressed to 'Benny's Chicken', some to 'Superio's Chicken' and some have no address at all. The others (being the vast majority) are addressed to 'Eat4less' at addresses in i) 108 Corporation Street, Birmingham, ii) Unit 4E Cobalt Central, Newcastle upon Tyne iii) 125 Northumberland Street, Newcastle upon Tyne and iv) 3 Richmond Street, Liverpool. The invoices appear to relate to the production of flyers. An example of the description given in the invoices is: 'A5 Flyers Eat4Leass + Fat Burgers'. No copies of the said flyers are in evidence.

39) Mr Shahzad states that his business takes measurements at shops, then creates designs base upon those measurements and shows them to the client. Once approved by the client, the signs are produced and fitted by one of their specialists at the restaurants. An invoice is raised for a particular job after the work has been carried out. Mr Shahzad states that he has tried to locate as many invoices as possible for the 'Fatburgers' and 'Gourmet4' jobs. He states that much of the information has been lost due to changing servers about 3 times. He provides, what he states are, true copies of some of the invoices⁹. There are four invoices dated July 2018, Nov 2017, June 2015 and April 2015. They are all issued by Noor Grafix Solutions or Colour Cottage to 'FAT BURGER'. The first is addressed to 'Fat Burger', Liverpool, the second to 'Fat Burger', Northampton and the third and fourth to 'Fat Burger', New Street, Birmingham. The descriptions in the invoices state 'main facial sign fret cut illuminated sign FAT BURGER' (or similar) and 'fitting and fixture'. Some other descriptions in the invoice are 'Fat Burger' and 'Fresh Handmade Burger'.

Mr Badur's evidence in chief for IMP

40) Mr Badur states that he is Mr Khan's cousin. He confirms that he and his cousin set up a restaurant business in around 2010 using the 'Fatburgers' name. He also confirms that they set up a company, Benny's Ltd, which later changed its name to

⁸ Exhibit IS1

⁹ Exhibit IS2

Superios Ltd. He states that the purpose of the operating company was to operate restaurants which he and Mr Khan had developed. One of those restaurant concepts was the 'Fatburgers' brand. He recalls that Mr Shahzad and his team developed that brand.

41) In 2016, Mr Badur states that he sold his share of the business to Mr Khan. Thereafter, the two went separate ways, with Mr Khan continuing to develop the 'Fatburgers' concept. He states that Mr Khan wanted to acquire more sites and build more restaurants. Mr Badur continued to develop other, different, kinds of restaurants.

42) Mr Badur states that he recalls that, in 2001, 'we' registered the name 'Fatburgers' as a website under www.fatburgers.com.

43) Mr Badur states that he had never heard of FNA until the beginning of this dispute.

Mr Deepak Kabra's evidence in chief for IMP

44) Mr Kabra states that he is a chartered certified accountant and that he owns the firm CBA Associates UK Ltd. He has been the accountant for Superios Ltd and Percivale Ltd from the very beginning. He states that he has not acted for IMP and he is not privy to the agreements of IMP and the use of its trade marks.

45) Mr Kabra states that he is very familiar with the restaurant business that has been operated by his clients (Superios Ltd and Percival Ltd) and he is familiar with the 'Fatburger' branded restaurants and the use of that name by his clients. He states that the name 'Fatburger' has been used by his clients since around 2010. It was first used by Superios Ltd and later by Percivale Ltd and other entities.

46) Mr Kabra states that his responsibilities were to prepare the accounts, tax returns and VAT returns and maintain a trial balance for the client companies.

47) Mr Kabra states that both of his client companies operated a number of restaurants, using several brands, including the 'Fatburger' name. They operated one bank account into which all the funds went. All of the monies taken from the card payments and the website go into one account. As such, the 'Fatburger' restaurants

do not have their own accounting and banking facilities. The group shares one accounting system and banking facility. Mr Kabra refers to the accounts that have already been filed by Mr Khan with his evidence.

Mr Mohammed's evidence in chief for IMP

48) Mr Mohammed states that he is the head of operations at Percivale Ltd and previously held the same position at Superios Ltd. He has worked for about 10 years in this position. He is very familiar with the 'Fatburger' branded restaurants and the 'Gourmet4' food-court restaurants.

49) Mr Mohammed states that it is his responsibility to locate new properties and then to construct branded restaurants and market the locations. He says that he has been responsible for finding and then redeveloping all the restaurants listed in the two tables he provides¹⁰. One of the tables is headed 'Fatburgers restaurants' and lists 22 restaurants at various locations in the UK. The second table is headed 'Gourmet4 restaurants, including Fatburgers restaurant as part of the food-court'. The latter table lists a total of 35 locations in the UK. Mr Mohammed states that he worked on redeveloping all the restaurants listed in the tables, converting them into 'our' branded restaurants. He states that he manages the shopfitting process and then contractors are hired to do the work on the individual parts of the overall project.

50) Mr Mohammed says that he has been building 'Fatburgers' branded restaurants since he has been working in his role and that, throughout that period, 'we' have been using the same printers, Colour Cottage in Birmingham, who have produced the signs, logos and menus etc.

Mr Warren Christiansen's evidence in chief (for FNA)

51) Mr Warren Christiansen is Legal Counsel at FAT Brands Inc., which is the ultimate parent company of FNA.

¹⁰ [3] of Mohammed

52) The relevant parts of Mr Christiansen's evidence, challenging IMP's claim that it has used its marks in the UK from an earlier date than the filing dates of the contested marks, is as follows:

53) Mr Christiansen states that the table of restaurants set out in the counterstatement of IMP, listing various restaurants which are said to have been operated under the name 'Fatburgers', is not true and that IMP is attempting to mislead the tribunal by suggesting that it has used the 'Fatburgers' name for longer than it has, in fact, done so and on a larger scale than it has, in fact, used the mark. He reproduces the relevant table from IMP's counterstatement¹¹.

54) Mr Christiansen provides a large number of photographs of premises at the addresses that were listed in IMP's table¹². The photographs are all from Google Streetview and are dated. Mr Christiansen provides his own table, summarising what is shown in the Goggle Streetview photographs which were taken at each of the sites listed in IMP's evidence at various dates in time prior to, and after the filing dates, of the contested marks. I will not set out here all those details because many of them pertain to restaurants that are claimed by IMP to have opened after the filing dates of the contested marks and are therefore not relevant to establishing an earlier relevant date. As to the relevant restaurants (i.e. the restaurants that are said to have opened prior to the filing dates of the contested marks), Mr Christiansen's evidence states, and shows in the relevant photographs, that:

- The address at 237 Hagley Road, Edgbaston, said to have opened in 2019, was an 'Ask' Italian restaurant until at least August 2020 (it was later branded FAT BURGERS, in March 2021)
- The address at Stratford Road, Shirley, said to have opened in January 2020, was a PREZZO until at least September 2020 (it was later branded FAT BURGERS, along with Gourmet4, in May 2021)
- The address at 22 Princess Alice Drive, Sutton Coldfield said to have opened in September 2019, was a Frankie & Benny's until at least March 2019 and

¹¹ [39] of Christiansen

¹² Exhibit WC26

was an unoccupied building as of September 2020 (it was later branded FAT BURGERS, along with Gourmet4, in February 2021)

- The address at Earle Street, Crewe, said to have opened in December 2019, was a Frankie & Benny's until at least March 2020 (it was later branded FAT BURGERS, along with Gourmet4, in June 2021).
- The address at 2 Sheep Street, Northampton, said to have opened in 2015, was a butcher's shop until at least May 2019, trading under the name of 'Sheep Street Quality Butchers' and, later, 'Smith & Lynch' (it was later branded FAT BURGERS in November 2020 (after the filing date of the contested marks)).
- The address at 110 New Street, Birmingham said to have opened in 2011, was an 'Eat4Less' from at least July 2011 until April 2019.
- The address at 3 Richmond Street, Liverpool said to have opened in 2012, was an 'Eat4Less' on September 2014 and April 2019.
- The address at Unit 4E, Cobalt Central, Silver Fox Way, Newcastle said to have opened in 2012 or 2013, does not show any premises on Google Streetview. Any restaurant that did operate from that site must, says Mr Christiansen, have been an 'Eat4Less' up to August 2020 in the light of use shown on IMP's Facebook site of that name at that time in relation to that location. The only available Google Streetview image of that address shows a 'Tesco Express' trading at October 2020.
- The address at 125 Northumberland St, Newcastle, said to have opened in 2014, was an 'Eat4Less' until at least April 2019.
- The address at 108 Corporation Street, Birmingham said to have opened in 2012 or 2013, was an 'Eat4Less' until at least September 2020¹³
- The address at 3 Coleshill Rd, Birmingham, said to have opened in 2010, was a chicken shop from around August 2010 ('Benny's Chicken') until at least September 2020 ('Superios Chicken').
- The address at 75 Linthorpe Rd, Middlesbrough said to have opened in 2015 (but now closed), was an 'Eat4Less' at July 2018.

¹³ Although Mr Christiansen says it is a 'baguette4less', it can be seen in the photos that it actually says 'Eat4less', which also accords with Mr Kellingray's evidence in reply in the table on page 10 of his statement, where he states it is an 'Eat4less'.

55) Mr Christiansen submits that his evidence shows that the evidence of IMP is materially false. He submits that this casts a shadow upon all of IMP's evidence in these proceedings generally and that I should place no weight upon any of IMP's evidence. He also states that his evidence shows that the earliest date that IMP could possibly show any use of its marks is November/December 2020, being after the filing date of the contested marks.

Mr Mohammed's evidence in reply for IMP

56) Mr Mohammed provides a second witness statement, in reply to Mr Christiansen's evidence. It will be recalled that Mr Mohammed is head of operations at Percivale Ltd (and previously Superios Ltd).

57) Mr Mohammed acknowledges that the evidence in reply should have been provided by Mr Khan but he states that, at the time of writing this second statement, Mr Khan is unwell with COVID and that is why Mr Mohammed is making this second statement, instead of Mr Khan, on behalf of IMP.

58) Mr Mohammed refers to the allegations made in Mr Christiansen's evidence to the effect that IMP's restaurants do not exist or have not been open for a long time.

59) Mr Mohammed provides two tables listing all of IMP's claimed sites, at which he says the mark 'Fatburger' has been used in relation to restaurant services. These tables list all the sites, together with references to property leases¹⁴ relating to those sites and photographs/video evidence of those sites¹⁵. I note that, although all the videos and photos show use of the contested mark, together with Gourmet4 at the sites, none of the photos or video extracts are dated and Mr Mohammed does not state that they come from a date which pre-dates the filing date of the contested marks and nor does he say that they are representative of how those locations looked at the claimed earlier dates. Furthermore, none of the leases emanate from prior to the filing dates of the contested marks, with the exception of one lease, dated

¹⁴ Exhibits TM1 – TM41

¹⁵ Exhibits V1 – V27

2 September 2016, which relates to the property at 75 Linthorpe Road, Middlesborough and is between Northern Retail Consortium Limited and HK Foods LTD¹⁶. I note that Mr Mohammed states that this site is now closed but it 'was an Eat4Less that sold Fat burgers menu as a dark kitchen'¹⁷. Mr Mohammed states that each property is leased using a special purpose vehicle (SPV), to ring fence liability. Mr Mohammed states that he would like to explain 'our' business model. He states that 'we have many restaurants and takeaways and operate several brands, including 'Fat Burgers'. There are standalone 'Fat Burgers' restaurants and also food courts, which operate under the name 'Gourmet 4'. The latter is usually a large site containing four different restaurants, one of which is 'Fat Burgers'. There are several of these sites in the UK.

60) He states that 'we' also have a bar and nightclub business, Be Social. These also serve the 'Fat Burgers' menu.

61) Mr Mohammed explains that there are also 'dark kitchens', which is a different way of serving customers. He states that this involves having a restaurant, or some other premises, which operates under 'Eat4Less'. However, the kitchen at the back will be able to produce all different types of foods from a range of brands. He states that 'we' have been operating dark kitchens for several years, but since the pandemic, this model has taken off more. Customers order food from mobile delivery apps like Uber Eats, Deliveroo etc. from the 'Fat Burgers' menu but that food may not be prepared at a dedicated 'Fat Burgers' site, but rather from one of 'our' other sites which is nearest to the customer and then delivered to the customer. For example, he states that 'Fat Burgers' has no restaurant in Reading but, Mr Mohammed states that, 'we' still service our customers there.

62) Mr Mohammed provides prints from the websites of delivery apps such as Uber Eats which show use of the mark 'Fatburgers' in relation to fast food services on those apps¹⁸. One such example is in relation to IMP's claimed site at St Mary's Butts, Reading which Mr Mohammed states is actually a 'Smokin Buns' restaurant

¹⁶ Exhibit TM22

¹⁷ See the first entry in the table at page 7 of Mr Mohammed's statement.

¹⁸ Exhibits TMA - TMG

but, Mr Mohammed states that customers can order online from the 'Fatburgers' menu and their food will be prepared at that site and then delivered to them. The other locations are at i) Abbeywood, Bristol, ii) Cobalt Business Park, Newcastle, iii) Wolverhampton, iv) Northumberland Street, Newcastle, v) Borehamwood and vi) Corporation Street, Birmingham (which is an 'Eat4Less'). None of the screenshots from the delivery apps are dated and no explanation is given to indicate that they nevertheless pre-date the filing dates of the contested marks.

Mr Kellingray's evidence in reply for FNA

63) Mr Kellingray is a registered trade mark attorney at Dentons UK LLP and Middle East LLP.

The relationship between IMP and the various companies referred to in IMP's evidence

64) Mr Kellingray provides extracts from Companies House in respect of Bennys Ltd/Superios Ltd¹⁹. He says that these show that Mr Aaron Khan has never been a director, shareholder or person with significant control of this entity, even when he claims to have acquired full control of the same in 2016. The only person who has had any recorded interest in this company is Faheem Badur. Mr Kellingray states that Mr Khan does not, therefore, appear to be capable of attesting to the activities of this company.

65) Mr Kellingray provides extracts from Companies House relating to the directorship and shareholder details of Percivale Ltd²⁰. Similarly, Mr Kellingray states, Mr Khan also does not appear to ever have been a director or shareholder of this company and therefore does not appear capable of attesting to use by that company of the 'Fatburgers' name. The position is the same, says Mr Kellingray, as regards Bittershaw Ltd and Roms-K Ltd, both of which are claimed, by Mr Khan to

¹⁹ Exhibit RK1

²⁰ Exhibit RK2

be under his ownership and yet there is no trace of his involvement with these companies on Companies House register²¹.

66) Mr Kellingray states that, as IMP Ltd itself is registered in Belize, he has not been able to locate information about the corporate control and ownership of that company and is therefore unable to check the veracity of Mr Khan's claims to be the 100% shareholder of that company.

Ownership and operation of fatburgers.com

67) On 14 March 2022, Mr Kellingray states that he requested and obtained a WHOIS history report for the fatburgers.com domain from Domain Tools. The latter is one of the leading domain research services in the world. They collect and store WHOIS and related hosting/DNA data and provide this information to users in reports of the kind which Mr Kellingray exhibits²². The report comprises a reverse chronological history of the ownership of the fatburgers.com domain taken at regular intervals, presented alongside screenshots showing how the domain looked to those who accessed it at that date. The report shows that the owner (registrant) of the domain as of 8 January 2002 was Worldwide Media, Inc. which is an Internet advertising, marketing and development company owning approximately 75,000 domain names²³. That entity appears to have owned the domain name until at least 10 December 2015. Mr Kellingray states that the domain acted purely as a 'parked' landing page, showing sponsored links to other, unrelated websites, throughout that period. Thereafter, the registrant was NameFind LLC, who owned the domain until at least 16 October 2020. It also acted as a 'parked' landing page during that time. The ownership then changed to Domains by Proxy, LLC as of 22 October 2022, from which time it then redirected to fatburgers.co.uk (IMP's primary website), which was acquired in 2020. It therefore appears that IMP did not own the domain name prior to 22 October 2022 as no explanation is given about its relationship with the previous owners of the domain name prior to that date.

²¹ Exhibits RK3 – RK4

²² Exhibit RK5

²³ Exhibit RK6

68) Mr Kellingray states that Mr Khan's and Mr Badur's claims to have registered the domain fatburgers.com in 2001 is not, therefore, supported by publicly available records and therefore appears to be materially false.

Ownership and operation of Fat Burgers social media pages

69) Mr Kellingray states that the first of the social media pages referred to by Mr Khan²⁴ in his statement was not created until 3 June 2020²⁵. Similarly, a screenshot of the first photo posted by the @fatburgersuk Instagram page cited by Mr Khan shows it to have been posted on 10 September 2020²⁶. Mr Kellingray says that these pages therefore fall after the relevant dates in these proceedings.

Ownership and operation of claimed Fat Burgers locations

70) Mr Kellingray points out that there is a significant amount of duplication across the two tables provided by Mr Khan in his statement, despite Mr Khan stating that the first table constitutes stand-alone 'Fatburger' restaurants and the second table constitutes food-court models under the mark Gourmet 4. Mr Kellingray points out that, any sensible reading of Mr Khan's statement would lead one to believe that the two tables constitute two distinct lists of different locations when that is not the case. Mr Kellingray states that there are sites given in both tables but with slightly different addresses which are, in fact, the same site. For example, he refers to the site at Welton Road, Brombrough, Birkenhead which is claimed, by Mr Khan to be a stand-alone Fatburgers site, but the same site is also listed in the second table, under a slightly different address, for the food-court sites under Gourmet 4. In support of this, Mr Kellingray refers to IMP's websites for 'Fat Burgers' and 'Gourmet4' which both refer to a single site in Bromborough, namely Unit 4, Croft Retail Park, Welton Road, Bromborough, Birkenhead, Wirral, CH62 3PN. The same duplication is said to arise in respect of many of the other sites listed in Mr Khan's two tables such as those in Sutton Coldfield, Shirley, Crewe, Harlow, Hagley Road, Watford, Ruislip, Hedge End and more.

²⁴ As per [5] of Kahn

²⁵ Exhibit RK8

²⁶ Exhibit RK9

71) Mr Kellingray provides a table reiterating the information already provided by Mr Christiansen which is said to disprove the claimed opening dates of the restaurants claimed by Mr Khan. It is, though, accepted that some of the restaurants did appear to operate prior to the relevant dates under the mark 'Eat4less', namely i) 110 New Street Birmingham which opened in 2011, ii) 3 Richmond Street Liverpool which opened in 2012, iii) Unit 4E, Cobalt Central, Newcastle which opened in 2012 or 2013, iv) 125 Northumberland St, Newcastle which opened in 2014, v) 108 Corporation Street, Birmingham which opened in 2012/2013 and vi) 75 Linthorpe Road, Middlesborough which opened in 2015.

The invoices for promotional material and signage

72) Mr Kellingray states that the 104 invoices provided by Mr Shahzad²⁷ appear to be duplicates of one another such that there are, in fact, only 23 unique invoice numbers. He states that, whilst the description in the invoices allegedly mention 'Fat Burgers', the invoices are addressed to Benny's Chicken, Superio's chicken and Eat4less, not Fat Burgers.

The invoice at page 103 of exhibit IS2

73) Mr Kellingray states that this invoice claims to relate to the manufacture and fitting of an illuminated FAT BURGER sign. This invoice is dated 27 July 2018 and is addressed to 'FAT BURGER Liverpool'. He points out that the only 'Fat Burgers' site claimed to be open by IMP at that time, in Liverpool, was at 3 Richmond Street, Liverpool²⁸. Mr Kellingray provides a collection of dated screenshots from Google Streetview of that address²⁹. The first of these, dated June 2017, shows an 'Eat4Less' outlet with red external signage bearing the mark 'Eat4Less'. The second of these, dated August 2018 (a month after an illuminated Fat Burgers sign was allegedly installed at this site), shows a new, black external signage, bearing the

²⁷ Exhibits IS1 – IS2

²⁸ As per [13] Khan

²⁹ Exhibit RK13

mark 'Eat4Less'. Mr Kellingray states that no Fat Burgers sign is visible on the outside or inside of the outlet.

The invoice at page 104 of exhibit IS2

74) Mr Kellingray states that this invoice, again, claims to relate to the manufacture and fitting of an illuminated FAT BURGER sign. This invoice is dated 25 November 2017 and is addressed to 'FAT BURGER Northampton'. He points out that the only 'Fat Burgers' site claimed to be open by IMP at that time, in Northampton, was at 2 Sheep Street, Northampton³⁰. Mr Kellingray provides a collection of dated screenshots from Goggle Streetview of that address³¹. The first of these, dated May 2017, shows an outlet operating under the name 'Sheep Street Quality Butchers'. The second of these, dated June 2018 (in excess of six months after the date of the relevant invoice covering fixture and fitting of the sign), shows no change. The third and fourth screenshots, dated October 2018 and May 2019 respectively, show that the site then operated as a butcher's shop under the name 'Smith & Lynch'. Mr Kellingray states that no Fat Burgers sign is visible on the outside or inside of the outlet.

The invoices at pages 105 and 106 of exhibit IS2

75) Mr Kellingray states that these invoices cover, amongst other things, illuminated FAT BURGER signs. They are both addressed to 'FAT BURGER, New Street, Birmingham' and are dated 30 June 2015 and 30 April 2015. He points out that, at that time, IMP claims to have operated a solitary Birmingham 'Fat Burgers' site at 110 New Street³². Mr Kellingray provides a collection of dated screenshots from Google Streetview of that address³³. These show that the site operated as a 'MEAL DEAL' between at least May 2014 and June 2016 and then as an 'Eat4Less' as of October 2016.

³⁰ As per [13] Khan

³¹ Exhibit RK14

³² As per [13] Khan

³³ Exhibit RK15

Conclusions on the relevant date(s)

76) I have carefully reviewed all the evidence submitted on behalf of IMP and the evidence from FNA, challenging that evidence. In doing so, I have also borne in mind that in *Robot Energy Limited v Monster Energy Company* [BL O/308/20], Ms Emma Himsworth, as the Appointed Person, reviewed the case-law covering the weight to be attached to a witness's evidence in the absence of cross examination, as set out in *Pan World Brands v. Tripp (EXTREME)* [2008] RPC 2, *Williams and Williams v. Canaries Seaschool SLU (CLUB SAIL)* [2010] RPC 32 and *Advanced Perimeter Systems Ltd v. Keycorp Ltd (Multisys Trade Mark)* [2012] RPC 14 at paragraphs [17] to [22]. She stated that:

“73. As was made clear in the decision in CLUB SAIL grounds of opposition cannot be rejected automatically on the basis that the witness who sought to refute them was not cross-examined. It is necessary to form a view as a matter of judgment whether the evidence is sufficient to establish the relevant fact which requires, as the Hearing Officer correctly said, the decision taker to consider the evidence as a whole. That the Hearing Officer took this view is entirely consistent with the guidance set out in CLUB SAIL (and EXTREME and MULTISYS). This includes weighing up in particular (1) the power of one side to produce the evidence and the other to contradict it; and (2) the plausibility of the positions that have been adopted in the context of the evidence as a whole which entails where the parties have elected to proceed without cross examination accepting that the evidence of one witness might be found to have been disproved or displaced by the evidence of another.”

77) Firstly, I note that the relationship between Mr Khan and the various entities referred to in his evidence is unclear, particularly in the light of Mr Kellingray's evidence showing the apparent lack of any record of Mr Khan having ever had any directorship or shareholding status in relation to Superios Ltd (previously Bennys Ltd), Percivale Ltd (the claimed 'main operating company'), Buttershaw Ltd or Roms-K Ltd. Of course, none of these entities are IMP and it is IMP that must show that it made prior use of the contested marks or, if did not make use of the marks itself, that there was, nevertheless, some agreement between all the former companies and

IMP to the effect that any use made of the marks by those companies was, effectively, use by IMP (for example, by confirming that any goodwill generated through that use would accrue to IMP). Furthermore, although Mr Khan states that Percivale Ltd and the other companies operate restaurants using the contested marks under license from IMP, there is no further evidence before me showing the terms of that license or that any goodwill generated through that use would accrue back to IMP.

78) Further, Mr Kabra's evidence attests to use by his clients since 2010 of the 'Fatburgers' name. However, his clients are Superios Ltd and, later, Percivale Ltd, not IMP. He states that he has not acted for IMP and he is not privy to the agreements of IMP and the use of its trade marks. Accordingly, given my comments in the preceding paragraph, any knowledge of use that he has of the contested marks by Superios Ltd and Percivale Ltd does not help IMP given that the nature of the relationship between IMP and the former companies is not clear. In any event, his evidence does not assist me in determining the exact, or even rough, date of any such use or whether it was continuous or intermittent/sporadic nor does it show what the nature of any such use may have been.

79) A further important problem with IMP's evidence is that nowhere does it show any external/customer facing use of the contested marks prior to the filing dates of the contested marks. The examples of external use shown in IMP's various exhibits are not dated and there is no narrative evidence to the effect that such particular use (on social media or food delivery apps, for example) is illustrative of the use that took place prior to the filing dates of the contested marks or any statement to the effect that such use does indeed emanate from before those dates. Further, a large number of the restaurants listed in the tables provided by Mr Khan and Mr Mohammed have opening dates which post-date the filing dates of the contested marks and are therefore clearly not capable of establishing any earlier date(s).

80) Turning to Mr Badur's evidence, he claims that he and Mr Khan (his cousin) started registered the website www.fatburgers.com back in 2001 when they first thought about using the name 'Fatburgers'. However, IMP's evidence showing a print of the registrant details of that website does not give any indication that the

domain is, in fact, owned by Mr Khan or IMP or any of the other entities referred to in IMP's evidence. Mr Kellingray's evidence also casts doubt on the website name ever been owned by Mr Khan or any of those entities.

81) I note that Mr Mohammed, who is head of operations at Percivale Ltd, stated in his first witness statement, that he has been locating, developing and building 'Fatburgers' branded restaurants (as listed in his statement) since he has been working in his role (which is said to be more than ten years). Those are the same restaurant sites listed in Mr Khan's evidence. However, the dated Google Streetview images provided in FNA's evidence from Mr Christiansen and Mr Kellingray shows that none of the restaurants listed in Mr Khan's and Mr Mohammed's evidence traded under the sign 'Fat Burgers' (at least externally) prior to the filing dates of the contested marks. Moreover, a number of those restaurants appear to have been operated by completely unrelated third parties prior to the filing dates. For example, one was an 'Ask' Italian, another a 'Frankie and Bennys' and another a Butchers shop. IMP's evidence in this regard was clearly challenged in Mr Christiansen's evidence in chief. However, in IMP's evidence in reply (which evidence is only given by Mr Mohammed, not by Mr Khan), Mr Mohammed provides no explanation for any of the aforementioned discrepancies identified by Mr Christiansen. There is therefore no explanation before me from IMP as to why certain of the restaurants it claimed to operate, locate and develop prior to the filing dates under the 'Fatburgers' name appear to, in fact, have been restaurants operated under entirely different marks by third parties or, why one of the sites is shown on Google Streetview to have been a Butcher's shop at all times prior to the filing dates. Whilst Mr Mohammed does provide a large number of leases pertaining to a number of the claimed sites, in his evidence in reply, none of these, with the exception of one, relate to the period prior to the filing dates and, the one that does pre-date the filing dates (from 2 September 2016)³⁴, does not, in any event, show me what marks were used at that site at that time and is not in the name of IMP or, indeed, any of the other entities referred to in IMP's evidence.

³⁴ Exhibit TM22

82) The high point of IMP's case appears to me to be that, in Mr Shahzad's evidence, he states that he has worked with Superios Ltd and later Percivale Ltd and 'their other entities' for about 10 years and his business has been producing menus, logos and designs, shop signs and fitting those signs. He provides numerous invoices which appear to relate to the production of flyers³⁵ and restaurant signage³⁶, some of which are as far back as 2010. However, as noted earlier, there appears to be a great deal of duplication in the invoices provided for the flyers and none of them are addressed to IMP (and the relationship between IMP and the other entities is not clear).

83) Most of the invoices in Mr Shahzad's evidence are addressed to 'Eat4less'. In this connection, I note that, in his evidence in reply, Mr Mohammed introduces, for the first time (as it was not mentioned anywhere in IMP's evidence in chief), the claimed operation of 'dark kitchens' under brands such as 'Eat4less', where the customer can order from the 'Fatburgers' menu but the food is prepared at a site which may not necessarily be branded 'Fatburgers'. This evidence was filed after Mr Christiansen's evidence, where he pointed out that a number of the sites listed in Mr Khan's evidence were actually branded 'Eat4less' (not 'Fatburgers') prior to the filing dates. In the light of this, I have considered whether the fact that a number of 'Eat4less' restaurants were in operation prior to the filing dates, combined with Mr Shahzad's evidence that he produced flyers, menus and signs for such sites is enough to satisfy me that IMP used the contested marks prior to the relevant dates in relation to the services applied for. In coming to a view on this, I have borne in mind, again, that none of the invoices are addressed to IMP and it is not clear what the relationship was between it and Percivale Ltd or any of the other entities which are said to have used 'Eat4less' and 'Fatburgers'. Furthermore, Mr Kellingray's evidence in reply casts doubt on whether the signs referred to in the invoices in Mr Shahzad's evidence were indeed used at the sites to which they were addressed and there is no other evidence to shed light on where else they may have been used. In any event, it is also impossible to tell what the flyers or signage looked like at any claimed earlier date. I cannot tell when, where or how often the flyers or menus were used/distributed or the nature of the use that was made on them.

³⁵ Exhibit IS1

³⁶ Exhibit IS2

Bearing all of this in mind, I am not prepared to infer that the flyers and/or signage were indeed the subject of use by IMP, or an entity appropriately related thereto, in relation to the services applied for, or, indeed, that any such use was carried on in such a way so as to be sufficient to 'fix'³⁷ any earlier date prior to the filing dates of the contested marks.

84) Bearing in mind all the above, and that IMP's evidence in reply has failed to adequately clarify the nature and extent of its claimed use prior to the filing dates of its marks (despite FNA's clear challenges made to its evidence), I come to the view that IMP's evidence raises more questions than it answers, even when viewed collectively. I find that it is not sufficiently solid to satisfy me that there is any other relevant date in these proceedings other than the filing dates of the contested marks. I therefore proceed to assess FNA's claim to goodwill at the filing dates of the contested marks only. Those dates are 17 April 2020 and 9 May 2020.

Goodwill

85) The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

86) In terms of the evidence that is required to establish the existence of goodwill, in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

³⁷ See [38] of BL O/349/16, decision of the Appointed Person, Mr Thomas Mitcheson QC (as he then was).

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

87) However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

88) In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

89) However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

See also: Stannard v Reay [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA).

90) FNA must show that it had goodwill in a business at the relevant dates of 17 April 2020 and 9 May 2020 and that each of the signs relied upon is associated with, or distinctive of, that business.

91) As noted earlier, in its counterstatements, IMP conceded that FNA has made use of both earlier signs since May 2015 in relation to 'restaurant services'. However, it states that the use has been 'limited' and is insufficient to show the requisite level of goodwill. It also points out that one of the FNA's three restaurants closed within 12 months of opening.

92) FNA's evidence in support of its claim to own the necessary goodwill, comes from Mr Christiansen. That evidence shows that FNA operated a restaurant service, through franchisees, under the earlier signs in Camden Town and Wembley from 21 May 2015 and 3 December 2017 (respectively). I note that the Camden Town restaurant closed on 5 May 2020 (being after one of the relevant dates but shortly before the other relevant date). A third restaurant, in Dundee, operated from 22 January 2019 to 22 December 2019 (it therefore closed some 4-5 months prior to both relevant dates). The annual gross sales figures for all those restaurants in the period from when they opened, up to the relevant dates are steady and healthy³⁸. Those figures alone indicate to me that the business, in all three locations, was more than a trivial one. The evidence shows that the earlier signs were displayed prominently at the restaurants, on external and internal signage (for example), in the years leading up to the relevant dates³⁹. There is also some evidence showing advertisements/promotion of the relevant restaurants in UK newspaper articles⁴⁰ and evidence to show use, and customer reviews, on food delivery apps prior to the relevant dates in relation to the Wembley restaurant⁴¹. I find that the evidence before me is sufficient to show that FNA had goodwill in its restaurant business in the Wembley area (at the very least) at both relevant dates (bearing in mind that that restaurant was the only one still operating at both of those dates) and that the level

³⁸ [23] of Mr Christiansen's statement

³⁹ See, for example, exhibit WC9

⁴⁰ Exhibit WC7

⁴¹ Exhibit WC10

of goodwill was substantial enough to meet the required threshold. Both of the signs relied upon were distinctive of that goodwill.

Misrepresentation and Damage

93) In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

94) IMP's registrations are national rights which include the locality in which FNA enjoyed the requisite level of goodwill at both relevant dates. IMP do not appear to dispute that its marks are highly similar to the earlier signs relied upon by FNA or that the parties' respective services are in the same field of activity (its defence under section 5(4)(a) appears to rely upon antecedent use, which I have found has not been made out on the evidence before me). In any event, even if IMP had disputed these points, I would have found that the marks are highly similar and that IMP's services in classes 43 and 35 are either identical or similar to the restaurant services in which FNA enjoys goodwill. Bearing all of this in mind, I find that those familiar with the FNA's restaurant business will assume that the services provided under IMP's marks are the responsibility of FNA. Misrepresentation is, therefore, made out. The damage that follows is likely to be in the form of loss of sales for FNA, with customers using IMP's services instead. Damage can also be wider than simply loss of custom.⁴² The reputation of a restaurant business is no doubt very important. Placing that reputation in the hands of another could have a serious negative impact on the FNA's business and is another form of damage that must be guarded against.

95) IMP is liable to be prevented from use of its trade marks under the law of passing-off. **The ground under section 5(4)(a) of the act succeeds against all the services for which IMP's marks are registered.**

96) I do not consider that FNA is in any stronger position as regards its claim to have used its signs in relation to the various services which would be proper to class 35 (i.e. the franchising services and other business services). Even if FNA had satisfied me that it had goodwill in those services, the relevant public for those services is businesses whereas the relevant public for the contested services is the general public. I cannot therefore see how misrepresentation could arise in circumstances where the relevant public for the respective services is not the same.

⁴² See, for instance, *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), where Warrington L.J. stated that: "To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me."

97) At the hearing, Mr Selmi stated that, given the strong case under section 5(4)(a), it is hoped that I would not need to deal with the claims of well-known marks or bad faith in any detail. I agree that FNA's strongest ground is clearly its claim of passing off, for which it has been successful. I will, therefore, deal with the remaining grounds relatively briefly.

WELL-KNOWN MARKS

98) In *Hotel Cipriani SRL & Ors v Cipriani (Grosvenor Street) Ltd & Ors* [2008] EWHC 3032 (Ch), Arnold J (as he then was) concluded at [237] that the following factors are relevant to determining whether a mark is well known:

- 1) the degree of knowledge or recognition of the mark in the relevant sector of the public;
- 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;
- 4) the duration and geographical area of any registration, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;
- 5) the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;
- 6) the value associated with the mark.

99) I remind myself that whilst use overseas is relevant to the assessment, it is the perception of the UK consumer that is relevant to this claim. Although I am satisfied that the evidence before me is sufficient to show that FNA had the requisite goodwill

in the UK at both relevant dates, I do not consider that the evidence before me is sufficient to show that FNA's marks were entitled to protection under section 56 of the Act as well-known marks for any of the services relied upon. Whilst there has been some advertising in UK publications and bill-boards in London, it is not particularly extensive, wide spread or longstanding and the social media followings and customer reviews appear to be fairly modest in number. I also have no record of any successful enforcement of rights in the earlier marks in the UK. **The claims under sections 5(2)(b) and 5(3) of the Act based upon well-known marks therefore fail at the first hurdle.**

SECTION 3(6) – BAD FAITH

100) This section of the Act states:

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

101) In *Sky Limited & Ors v Skykick, UK Ltd & Ors*, [2021] EWCA Civ 1121 the Court of Appeal considered the case law from *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, Case C-529/07 EU:C:2009:361, *Malaysia Dairy Industries Pte. Ltd v Ankenævnetfor Patenter Varemærker* Case C-320/12, EU:C:2013:435, *Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ*, Case C-104/18 P, EU:C:2019:724, *Hasbro, Inc. v EUIPO, Kreativni Dogaaji d.o.o. intervening*, Case T-663/19, EU:2021:211, *pelicantravel.com s.r.o. v OHIM, Pelikan Vertriebsgesellschaft mbH & Co KG (intervening)*, Case T-136/11, EU:T:2012:689, and *Psytech International Ltd v OHIM, Institute for Personality & Ability Testing, Inc (intervening)*, Case T-507/08, EU:T:2011:46. It summarised the law as follows:

“68. The following points of relevance to this case can be gleaned from these CJEU authorities:

1. The allegation that a trade mark has been applied for in bad faith is one of the absolute grounds for invalidity of an EU trade mark which can be relied on before the EUIPO or by means of a counterclaim in infringement proceedings: *Lindt* at [34].

2. Bad faith is an autonomous concept of EU trade mark law which must be given a uniform interpretation in the EU: *Malaysia Dairy Industries* at [29].
3. The concept of bad faith presupposes the existence of a dishonest state of mind or intention, but dishonesty is to be understood in the context of trade mark law, i.e. the course of trade and having regard to the objectives of the law namely the establishment and functioning of the internal market, contributing to the system of undistorted competition in the Union, in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable the consumer, without any possibility of confusion, to distinguish those goods or services from others which have a different origin: *Lindt* at [45]; *Koton Mağazacılık* at [45].
4. The concept of bad faith, so understood, relates to a subjective motivation on the part of the trade mark applicant, namely a dishonest intention or other sinister motive. It involves conduct which departs from accepted standards of ethical behaviour or honest commercial and business practices: *Hasbro* at [41].
5. The date for assessment of bad faith is the time of filing the application: *Lindt* at [35].
6. It is for the party alleging bad faith to prove it: good faith is presumed until the contrary is proved: *Pelikan* at [21] and [40].
7. Where the court or tribunal finds that the objective circumstances of a particular case raise a rebuttable presumption of lack of good faith, it is for the applicant to provide a plausible explanation of the objectives and commercial logic pursued by the application: *Hasbro* at [42].
8. Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all the factors relevant to the particular case: *Lindt* at [37].

9. For that purpose it is necessary to examine the applicant's intention at the time the mark was filed, which is a subjective factor which must be determined by reference to the objective circumstances of the particular case: Lindt at [41] – [42].

10. Even where there exist objective indicia pointing towards bad faith, however, it cannot be excluded that the applicant's objective was in pursuit of a legitimate objective, such as excluding copyists: Lindt at [49].

11. Bad faith can be established even in cases where no third party is specifically targeted, if the applicant's intention was to obtain the mark for purposes other than those falling within the functions of a trade mark: Koton Mağazacılık at [46].

12. It is relevant to consider the extent of the reputation enjoyed by the sign at the time when the application was filed: the extent of that reputation may justify the applicant's interest in seeking wider legal protection for its sign: Lindt at [51] to [52].

13. Bad faith cannot be established solely on the basis of the size of the list of goods and services in the application for registration: Psytech at [88], Pelikan at [54]".

102) According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

- (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?
- (b) Was that an objective for the purposes of which the contested application could not be properly filed? and
- (c) Was it established that the contested application was filed in pursuit of that objective?

103) It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012]

EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

104) At the hearing, Mr Selmi submitted that this is a case of so-called trade mark 'squatting'. In his submission, given the longstanding use by FNA's of its earlier signs in both the UK and overseas in relation to its fast-food business, it is inconceivable that IMP did not know about that use. I remind myself that the case, as pleaded is:

- i) IMP intended to undermine, in a manner inconsistent with honest practices, the interests of FNA under its FATBURGER signs in the UK, by obtaining an exclusive right in the registered trade mark for purposes other than those falling within the functions of a trade mark, i.e. to block genuine applications made by the Applicant for the FATBURGER signs, which actions are now being played out before the UKIPO in the related opposition and cancellation actions.
- ii) To obtain an unfair advantage by exploiting the Applicant's significant goodwill, reputation and well-known rights in the FATBURGER signs in the UK, without having to invest in its own advertising activities, but instead free-ride off the coattails of FNA and its significant advertising efforts over several decades.

Having carefully considered the evidence before me, I am not satisfied that it is sufficient to show that the contested marks were filed in pursuit of the specific aims pleaded by FNA. Although I have found that FNA had the requisite level of goodwill to sustain an action for passing off at the relevant dates due to localised goodwill, I am not persuaded that the use of FNA's marks, as shown in the evidence, was on such a scale prior to the relevant dates that would justify a finding that IMP must have been aware of FNA's marks and claimed reputation and/or goodwill in the UK (or in US/Canada/elsewhere) when it filed the contested marks. As I have already noted earlier, the advertising and promotion, for example, that has taken place in the UK is not particularly extensive or longstanding. Further, even if IMP *had* been aware of FNA's use overseas, there is insufficient evidence before me to show that IMP

should have had reason to believe that FNA planned to expand its services to the UK.

105) As regards FNA's claim that IMP must have known about its earlier FATBURGER signs because IMP used FNA's signs, without consent, on a website, I can see nothing in the evidence before me to indicate that there was any such use by IMP. It is true that there is evidence from FNA in the form of an email which was sent to an individual, said to be related to IMP, and copied to FNA's marketing email address (apparently in error) from a company who appeared to be developing an online platform for IMP. That email contains a QR code designed to access IMP's menu for online food ordering and one of FNA's signs (that corresponding to mark '944) is on the menu. However, there is nothing before me to show that that menu did subsequently 'go live' on any website associated with IMP. Furthermore, that email is dated 23 November 2020, which falls after the relevant dates (the filing date of the contested marks) and, without more evidence as regards the specific circumstances which gave rise to that email containing FNA's earlier mark, or what action was taken by IMP in response to that email, I do not consider that that evidence is sufficient to raise a prima facie case of bad faith.

106) It follows that, there is nothing before me to warrant a finding that IMP's intention was to unfairly benefit from FNA's claimed well-known status/reputation by blocking FNA's expansion to the UK and/or to frustrate the business that FNA had already established in the UK and/or unfairly benefit from the goodwill associated with that business. **The claim under section 3(6) of the Act fails.**

107) My finding above under section 5(4)(a) means that both of FNA's applications for cancellation have succeeded. As IMP's opposition and application for cancellation to FNA's application and registration (respectively) are based solely upon claims under sections 5(1) and 5(2) of the Act, relying upon marks '347 and '210, those grounds therefore automatically fail for want of any valid earlier rights.

OUTCOME

108) FNA's applications for cancellation against IMP's trade mark registrations have succeeded. **Trade Mark registration numbers 3482347 and 3488210 are therefore declared invalid and will be removed from the register.**

109) IMP's opposition and application for cancellation against FNA's trade mark application and registration have failed for want of any valid earlier marks upon which it may rely. **Trade mark application number 3557944 may therefore proceed to registration and trade mark registration number 3557940 will remain registered.**

COSTS

110) FNA has been successful. It is therefore entitled to an award of costs. FNA makes a request a request for costs off the scale. In support of this request, Mr Selmi relied upon the following factors:

- The claimed 'scattergun' approach of IMP to its pleadings and the filing of evidence. Mr Selmi referred, in particular, to Mr Mohammed's evidence in reply which consisted of over 70 exhibits, took several attempts by IMP to file in an acceptable format and none of which, in his submission, were relevant, in any event, to the matters at hand but which still had to be considered by Dentons and himself.
- FNA has spent considerable time and resources analysing the data put forward in IMP's evidence as regards its claimed trading activity prior to the relevant dates, which, he states, has been shown to be untrue. In his submission, most of the time spent compiling FNA's evidence has been devoted to demonstrating the misleading and untruthful nature of IMP's evidence.

Mr Selmi submitted that litigants who approach proceedings before the IPO without the required sense of professionalism, focus and proportionality and submits voluminous irrelevant and untrue evidence, should be penalised in costs.

111) I have carefully considered all of the factors put set out by Mr Selmi. In relation to the first bullet point, it is true that it took IMP several attempts to put its evidence in reply, from Mr Mohammed, into acceptable format⁴³. However, I note from the relevant official letters on file that IMP did adhere to the directions given to it by the caseworker in all those letters and but that the USB stick upon which the evidence was repeatedly re-filed was not showing all of the relevant exhibits when accessed by the IPO. The official letters specifically state that this was not the fault of IMP's representative⁴⁴. I also note that none of those issues gave rise to any case management conferences and therefore FNA has not incurred any costs in that regard (although I accept that it filed some emails querying the position with the admission of that evidence). As to the claimed excessive volume of those exhibits, it is true that there was a large number of leases put in evidence which were all dated (except for one) after the filing dates of the contested marks. However, as Mr Selmi acknowledged, these were all clearly irrelevant, for that reason alone and, therefore, whilst I acknowledge that some time would have been spent by FNA's representatives going through that evidence, it should not, in my view, have taken considerable time or resources for FNA's professional representatives to come to the conclusion that it was irrelevant.

112) As to the second bullet point, I appreciate that FNA will have spent some time in compiling its evidence as regards the claimed trading activity of IMP and that that evidence has assisted me in identifying some apparent discrepancies in IMP's evidence. However, I have not gone so far as to conclude that IMP's evidence is wholly untrue. Rather, I have concluded that, on the whole, it is insufficiently solid in a number of important respects which has ultimately failed to support its claim to antecedent use. I also bear in mind that many of the sites claimed to have been operated by IMP had a date of opening which post-dated the filing dates of the

⁴³ The official letters of 21 January 2022, 16 February 2022, 21 April 2022, 1 June 2022, 18 July 2022 and 2 September 2022 refer.

⁴⁴ See, for example, the official letter of 18 July 2022

contested marks and therefore it should have been obvious to FNA that those sites were irrelevant to establishing any earlier date such that the evidence challenging their existence was not, strictly, necessary.

113) Taking all the circumstances of this case into account, I come to the conclusion that costs should be awarded on the scale. However, given the considerable volume of evidence filed by both sides, the award will be at the very top of that scale.

114) Bearing in mind that all four cases were consolidated before the filing of evidence and, using the guidance in Tribunal Practice Notice 2/2016, I award FNA costs on the following basis:

Preparing statements and considering the other side's statements x 4	£1200
Official fee (Form TM26(I)) x 2	£400
Preparing and filing evidence and considering IMP's evidence	£2200
Preparing for, and attending, the hearing	£1600
Total:	£5400

115) I order IMP Ltd to pay Fatburger North America, Inc. the sum of **£5400**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of October 2023

Beverley Hedley

For the Registrar, the Comptroller-General