

O/427/21

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3454708
BY STEVE GALLAGHER AND MATTHEW AYRES**

TO REGISTER:



AS A TRADE MARK IN CLASS 43

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 419424 BY
ALVIN HARRIS JR**

BACKGROUND AND PLEADINGS

1. Steve Gallagher and Matthew Ayres (“the applicants”) applied to register the mark shown on the cover page of this decision as a trade mark in the United Kingdom on 30 December 2019. The application was accepted and published on 10 January 2020 in respect of *Bar and restaurant services* in Class 43 of the Nice Classification.

2. The application was opposed by Alvin Harris Jr (“the opponent”). The opposition is based on sections 5(4)(a) and 5(4)(b) of the Trade Marks Act 1994 (“the Act”) and concerns all the services of the application.

3. Under section 5(4)(a), Mr Harris claims that he has been using the contested mark throughout the United Kingdom since 20 January 2010 for the following services: *Personal chef services; BBQ chef services; catering services; provision of food and drink*.¹ He asserts that he is well-known around the world via television and live shows by the name “Dr Sweetsmoke” and the contested mark, and to have built up a considerable reputation and goodwill. He claims that use of this mark by Mr Gallagher and Mr Ayres would amount to a misrepresentation in that the public would be led to believe that there is an economic connection between the applicants and himself, or that he has endorsed or licensed their use of his sign. He further claims that damage would occur as the bar and restaurant services they offer would divert trade from him or, if they were of inferior quality, would ruin his goodwill and reputation.

4. Under section 5(4)(b), Mr Harris claims that he is the owner of the logo that makes up the contested mark. He says that he created it in 2010 and took it to a designer, Mr Patrick Carlson, for further development. Both Mr Harris and Mr Carlson are US citizens, although Mr Harris has indefinite leave to stay and work in the UK. Mr Harris states that the any copyright owned by Mr Carlson was assigned to him on 20 July 2020.

¹ Mr Harris also claims to have used the contested mark in other countries in Europe, Vietnam and Australia. However, it is use within the UK that is relevant for section 5(4)(a).

5. The applicants filed a defence and counterstatement denying the claims made. They state that in September 2019, together with another two individuals, they opened a restaurant with the opponent in Phu Quoc, Vietnam, called Dr Sweetsmoke BBQ and using the contested mark as a logo. Mr Harris was not a financial investor but would work in the restaurant. The applicants say that the name and logo were approved by all parties and Mr Harris received compensation in the form of continued rent payments on his property in the UK, in addition to salary and expenses. This arrangement was the subject of a verbal agreement. Mr Gallagher and Mr Ayres also make certain allegations about the opponent's conduct. I shall not detail them here as they are not relevant to the present proceedings.

6. Mr Harris filed evidence in the form of a witness statement dated 30 November 2020. He denies that it was ever agreed that he would give them his name and logo. The witness statement and exhibits are also adduced to show his use of the contested mark and the ownership of the copyright in it. I will return to these in due course. For the record, I also note that Mr Harris denies the specific allegations made by the applicants about his conduct.

7. The applicants filed no evidence.

8. Neither side requested a hearing or made any written submissions. I have taken this decision following a careful consideration of the papers. In these proceedings, both parties are litigants in person.

DECISION

9. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

Section 5(4)(a)

10. Section 5(4)(a) of the Act states that:

“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 or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met

...”

11. Subsection 4(A) is as follows:

“The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

12. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly,

he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."²

Relevant date

13. In *Advanced Perimeter Systems v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*, BL O/212/06:

"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."³

14. The date of application is 30 December 2019. The applicants state that in September 2019 they opened the restaurant in Vietnam using the contested mark and have taken steps to register it with the Vietnam Intellectual Property Office. However, it is use in the UK that is relevant, as Thomas Mitcheson QC, sitting as the Appointed Person, in *CASABLANCA*, BL O-349-16, noted:

"I accept that the type of use which is alleged to amount to antecedent use must be assessed carefully. Some of the factors referred to are clearly relevant – nondistinctive use, use on different goods and use outside the UK would rarely give rise to antecedent rights."⁴

² Page 406.

³ Quoted in paragraph 43 of BL O-410-11.

⁴ Paragraph 33.

15. I will therefore assess whether Mr Harris had established a protectable goodwill at 30 December 2019, rather than at any earlier date.

Goodwill

16. 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 advantages 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates.”

17. Mr Harris claims that he has a considerable reputation and goodwill. He describes himself as a freelance chef who has attended numerous festivals: The Game Fair, Blenheim Palace, Oxfordshire (2011), Grillstock Festival in Bristol, London and Manchester (2010-2018) and Wingfest in London and Manchester (2016-2019). No information is provided on attendance numbers at these festivals. An invoice to Wingfest is shown in Exhibit AH7. The invoice is dated 15 August 2019 and is for the sum of £252.89, covering labour and transport costs. There is no further information on sales made.

18. He also says that he has appeared on two television shows. The first was called *There's No Taste Like Home* and was shown in 2015; the second was *The Five O'Clock Show* with Peter Andre. He does not state when the second was shown, on which channels either programme was broadcast, or how many viewers there might have been.

19. In addition, Mr Harris states that he has attended some private events. Two are listed in the witness statement, but the years are not given, and again it is not clear how many people were present.

20. In *Smart Planet Technologies, Inc. v Rajinda Sharma (Recup Trade Mark)*, BL O/304/20, Mr Thomas Mitcheson QC, sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. He then concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”⁵

21. The courts have not laid down a list of essential items of evidence that should be filed, but they have given guidance on what the evidence needs to show. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J stated:

“27. There is one major problem in assessing a passing off 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 RPC 97 as qualified by *BALI Trade*

⁵ Paragraph 34.

Mark [1969] RPC 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.”

22. 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.”⁶

23. It may be that Mr Harris has the substantial record of sales and appearances that he claims, but he has not shown this to me in his evidence. The section 5(4)(a) claim falls at the first hurdle.

Section 5(4)(b)

24. Section 5(4)(b) of the Act is as follows:

⁶ Paragraph 8.

“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) or (aa) above, in particular by virtue of the law of copyright, or the law relating to industrial property rights.

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.”

25. In deciding Mr Harris’s claim under section 5(4)(b) of the Act, I must address the following questions:

- Is the contested mark a work under the Copyright, Designs and Patents Act 1988 (“CDPA”) and therefore capable of being protected by copyright?
- Who is the owner of the work and when was it created?
- Does the work meet the qualification criteria for copyright protection?
- Would use of the contested mark constitute an infringement of any copyright?

Whether the contested mark is a work under the CDPA

26. Section 1 of the CDPA states that:

“Copyright is a property right which subsists in accordance with this Part in the following descriptions of work –

- (a) original literary, dramatic, musical or artistic works,
- (b) sound recordings, films or broadcasts, and
- (c) the typographical arrangement of published editions.”

27. Section 4 of the CDPA is as follows:

“(1) In this Part ‘artistic work’ means-

- (a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality,
- (b) a work of architecture being a building or a model for a building, or
- (c) a work of artistic craftsmanship.

(2) In this Part –

...

‘graphic work’ includes –

- (a) any painting, drawing, diagram, map, chart or plan, and
- (b) any engraving, etching, lithograph, woodcut or similar work;

...”

28. I can accept that the contested mark (and Mr Harris’s logo) is a graphic work.

Ownership of the work and its creation

29. In his witness statement, Mr Harris says that he “thought of and created the logos shown below in 2010”.⁷



⁷ Paragraph 5.

30. The evidence shows that the logo on the right and substantial parts of the middle logo were in use in 2011. It can be seen on a photograph Mr Harris states was taken that year and a section of which I have reproduced below.⁸ The only difference between this image and the middle logo is the colour of the outer ring and the words therein. Mr Harris's statement has not been challenged so I accept it. The logo is also shown on the invoice to which I have referred in paragraph 17 above and which predates the date of application for the contested mark.



31. The ownership of the work is important for two reasons, the second of which I shall come to in due course. Article 2 of the Trade Marks (Relative Grounds) Order 2007, SI 2007 No. 1976, states that it is the proprietor (owner) of the earlier right who can bring a claim under any of the grounds covered by section 5 of the Act.

⁸ Exhibit AH3(c).

32. Section 11(1) of the CDPA states that, subject to certain provisions that are not relevant here, “The author of a work is the first owner of any copyright in it...”. The author of a work is defined in section 9(1) of the CDPA as “the person who creates it”. Ownership may be assigned to another party.

33. The editors of *Copinger and Skone James on Copyright*, 18th edition, give the following commentary on how to identify the author of an artistic work (with footnotes omitted):

“In the case of artistic works, the author is the person who is most nearly the effective cause of the final representation. To be an author, a person must have played a substantial role in putting the artistic work on the material in question. In the ordinary case this will be the person whose hand fixes the picture upon the paper, canvas, etc. So for example, where a person conceived of the idea of a card to help illiterate voters, consisting of a picture of a hand holding a pencil in the act of completing a cross but, being unable to draw, employed another, under his or her direction, to execute the idea, the latter was the author of the work. By contrast, in theory, no doubt a person might have such close control over the application of pencil or paint to paper by another that they might be the sole author but it seems unlikely to arise often in practice. An example might be the case where an artist directs his or her apprentice precisely where and how to apply paint to a partially completed work.

A more likely outcome in cases where more than one person is involved in the creation of an artistic work is that the work is one of joint authorship. This might be the case where a person, although not actually putting pen to paper, made such an input into the work, by way, for example, of providing preliminary sketches, stipulating the form of the final design and shepherding the design as it evolved, that the person could be said to have provided part of the intellectual creativity that went into producing the artistic work. The fact that a person may have used computer software as a tool to

assist him in creating the drawing will not make him any the less the author of it.”⁹

34. As I have already noted, Mr Harris claims to have created the logo in 2010 and then taken it to a Mr Carlson for further development. On 19 January 2011, Mr Harris contacted Mr Carlson saying:¹⁰

“I’m Al Pitmaster for Dr.Sweetsmokes BBQ and would like to know if you could help us with out [sic] badly done logo. We want to keep the bull but we are in need of a little updating...”

35. Mr Carlson replied on the same day:

“Do you need this logo recreated exactly as is, just in a printable, clear format? Or do you want to start over and have me create my own version based on this logo?”

36. Mr Harris responded:

“What’s the price difference? I *need* it cleaned up for a printer to be able to use use [sic] it and just before the season starts I’m looking at having it put to your imagination.

I know that’s not a tonne of help but I’m working on the cheap at the moment. Just getting the bull all nice and tidy in vector format should do for now.”

37. Mr Carlson gave the prices for a clean up and formatting and for the design of a new logo. Mr Harris chose the first option at £30 and received the results the same day. Mr Carlson sent a further version the following day and it appears from the email exchange that this now contained the stars. On the basis of this evidence, it appears to me to be probable that Mr Harris was the author of the artistic work. He was

⁹ Paragraph 4-36.

¹⁰ The email exchange is in in Exhibit AH1(a).

substantially responsible for the creation of the artistic work. The elements added by Mr Carlson are, in my view, minor.

Whether the work meets the qualification criteria for copyright protection

38. Section 153 of the CDPA states that copyright does not subsist in a work unless certain conditions are met. These are set out in the following sections of the Act and relate to the citizenship or residence of the author at the time the work was created or published, or the place where it was first published.

39. Mr Harris states that he is a US citizen with indefinite leave to stay and work in the UK. As the US is a party to the Berne Convention for the Protection of Literary and Artistic works, the qualification criteria are met: see section 159(1) of the CDPA.

Whether use of the mark would constitute an infringement of the copyright in the work

40. Having established that Mr Harris's logo qualifies as a copyright work, I must now consider whether the contested sign would be an infringement of that copyright. Section 16 of the CDPA is the relevant legislation and reads as follows:

“(1) The owner of the copyright in a work has, in accordance with the following provisions of this Chapter, the exclusive right to do the following acts in the United Kingdom –

- (a) to copy the work (see section 17);
- (b) to issue copies of the work to the public (see section 18);
- (ba) to rent or lend the work to the public (see section 18A);
- (c) to perform, show or play the work in public (see section 19);
- (d) to communicate the work to the public (see section 20);
- (e) to make an adaptation of the work or do any of the above in relation to an adaptation (see section 21);

and those acts are referred to in this Part as the ‘acts restricted by the copyright’.

(2) Copyright in a work is infringed by a person who without the licence of the copyright owner does, or authorises another to do, any of the acts restricted by the copyright.

(3) References in this Part to the doing of an act restricted by the copyright in a work are to the doing of it –

(a) in relation to the work as a whole or any substantial part of it, and

(b) either directly or indirectly;

and it is immaterial whether any intervening acts themselves infringe copyright.”

41. In *Designers Guild Ltd v Russell Williams (Textiles) Ltd (t/a Washington DC)*, [2000] 1 WLR 2416, Lord Millett set out the approach to assessing whether artistic copyright has been infringed at [2425]-[2426]. He said:

“The first step in an action for infringement of artistic copyright is to identify those features of the defendant’s design which the plaintiff alleges to have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied on are sufficiently close, numerous or extensive to be more likely to be the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are too commonplace, unoriginal or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying.

...

Once the judge has found that the defendant’s design incorporates features taken from the copyright work, the question is whether what has been taken constitutes all or a substantial part of the copyright work. This is a matter of impression, for whether the part taken is substantial must be determined by its quality rather than its quantity. It depends upon its importance to the copyright work. It does not depend upon its importance to the defendant’s work, as I have already pointed out. The pirated part is considered on its own (see *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273, 293, *per* Lord Pearce) and its importance to the copyright work assessed. There is no need to look at the infringing work for this purpose.”

57. I have reproduced the middle logo as shown in paragraph 17 of Mr Harris’s witness statement and the contested trade mark below:

Copyright Work	Contested Mark
	

58. Both images contain an identical figure of a muscular bull with human arms and hands holding barbecue tools within a white circle surrounded by a red border. Within the border are the words “DR. SWEETSMOKE’S” at the top and “SMOOTH & SLOW BBQ” at the bottom. The two halves of the phrase are separated on the left and right by a white star with two smaller white stars on either side of it. The colours used are the same in both the copyright work and the contested mark. The only difference lies in the vertical lines that can be seen on the white circle in the contested mark. I note that it is possible that one of the images I reproduced in paragraph 29 above may also have the lines, but the image is not of sufficient quality for me to be able to say for

certain. Nevertheless, I consider that the lines represent a very minor feature, so nothing turns on this difference.

59. As I have already noted in paragraph 5 above, the applicants admit that they had access to the logo before the date of application. I find that the striking similarities between the logo and the contested mark are not coincidental. The applicants had the opportunity to file evidence in response to Mr Harris's witness statement and denial of their counterstatement, but they chose not to do so. The absence of any written agreement is significant. I also note that the application was made by two of the financial investors in the Vietnamese restaurant, rather than all of them or a corporate body, and that the applicants have not explained why this should be.

60. I find that use of the trade mark would be prevented in the UK under the law of copyright, and so the opposition succeeds under section 5(4)(b).

OUTCOME

61. The opposition succeeds and Trade Mark Application No. 3454708 is refused.

COSTS

62. The opponent has been successful. At the end of the evidence rounds, both parties, as litigants in person, were invited to submit pro formas detailing the time spent on particular activities associated with the opposition. Mr Harris has submitted a cost pro forma stating that he spent a total of 220 hours on the proceedings.

63. Section 5.2 of the Tribunal Work Manual concerns costs awarded to unrepresented parties. It states that:

“Any cost awards made in favour of an unrepresented party will include the full cost of any official fees, but will only cover 50% of the amount from the published scale. This ensures that the unrepresented party is not overcompensated for the cost of the proceedings.

When an award is given by the Hearing Officer either with, or after, the issue of the substantive written decision, the unrepresented party will be invited to provide a breakdown of the costs incurred. The itemised account will include the number of hours spend on the proceedings including travel costs.

The Litigants in Person (Costs and Expenses) Act 1975 sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 per hour.”

64. The published scale is set out in section 5.3 of the Manual and Tribunal Practice Notice (TPN) 2/2016. For convenience, I reproduce the relevant parts below:

Task	Cost
Preparing a statement and considering the other side's statement	From £200 to £650 depending on the nature of the statements, for example their complexity and relevance.
Preparing evidence and considering and commenting on the other side's evidence	From £500 if the evidence is light to £2200 if the evidence is substantial. The award could go above this range in exceptionally large cases but will be cut down if the successful party has filed a significant amount of unnecessary evidence.
Expenses	(a) Official fees arising from the action and paid by the successful party (other than fees for extension of time). (b) The reasonable travel and accommodation expenses for any witnesses of the successful party required to attend a hearing for cross examination.

65. Mr Harris claims to have spent 12 hours preparing his statement and considering the other side's statement. For an unrepresented party unfamiliar with trade mark law, this is not unreasonable. At £19 per hour, this would result in an award of £228.

66. The estimate of 208 hours for the evidence round seems excessive, particularly given the relative shortness of the witness statement and exhibits and the fact that the other party filed no evidence. This figure also includes an additional 20 hours for “completing of TM7 and TM8” but even without those the award would be considerably higher than the published scale. I will base my award on 8 hours (rather than 80 hours)

for “General admin, research, email, telephone, photocopy, printing, consideration, planning, mailing” and 6 hours (rather than 60) for compiling the documents. This is a total of 14 hours at £19 hour (£266).

67. Mr Harris is entitled to an award of £200 to cover the official fees. He has also claimed a FEDEX fee, but this is not listed as an expense that a costs award would cover.

68. I award Mr Harris the sum of £694 as a contribution to the costs of the proceedings.

69. I therefore order Mr Steve Gallagher and Mr Matthew Ayres to pay Mr Alvin Harris Jr the sum of £694, which should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 7th day of June 2021

Clare Boucher
For the Registrar,
Comptroller-General