



Trade Marks Act 1955

Decision of a Delegate of the Registrar of Trade Marks

Re: Opposition by Big Country Developments Pty Ltd to the registration of applications 435404 and 435405 in the name of Alan Weller

Background

Trade mark applications 435404 and 435405 are in the name of Alan Weller ("the applicant") and the services specified in the application are "a discotheque". The trade mark the subject of the two applications is the word Fridays, rendered in two different fancy scripts as below. When looked at critically the mark in application number 435405 is arguably the word FRIDAY'S, but the point is probably a moot one in practice and I will deal with the two applications without distinction. Both were lodged on 30.10.85

A cursive script of the word 'Fridays'. The letters are highly stylized and interconnected, with a large, decorative 'F' and 'S'.

435404

A decorative script of the word 'FRIDAYS'. The letters are tall and thin, with a large, decorative 'F' and 'S'. The letters are connected by a horizontal line.

435405

Registration of the applications has been opposed, as provided for by sub-section 49(1) of the Trade Marks Act 1955, by Big Country Developments Pty Ltd ("the opponent"), on grounds which are generalised and which I will not recite at length as at the hearing they were reduced to two only:

- . proprietorship under section 40 of the Act and
- . the claim that the use of the mark by the applicant would cause deception and confusion.

After the service of evidence in support on the applicant the matter was set down for hearing on 2.9.92. The opponent was represented by Mr Fred Schilling of the patent attorney firm of F.B.Rice and Co, while the applicant was represented by its patent attorney, Peter Fisher of Cullen and Co, attorneys. Having heard the parties I turn to the evidence.

Opponents Evidence in Support

This consists in the first instance of a statutory declaration by Peter Herman Hesky, a director of the opponent company, together with attached exhibits PHH1 to PHH8. That evidence has already been before the Registrar, as it was relied on by the opponent in opposition to an earlier application, made by T.G.I. Friday's Inc. The Registrar's (unpublished) decision was given under delegation by Ms Susan Farquhar, an Assistant Registrar. The opponent did not seek to show that there was any error in the decision (though it disagrees, no doubt, with the ultimate conclusion) so it is appropriate if I incorporate the relevant portion of the decision, below.

There is also a second declaration by Mr Hesky, in which the opponent attempts to address the failings of the former declaration. The second declaration is supported by exhibits PHH9 to PHH16

Previous Decision of the Registrar, in relation to the evidence served as the first declaration in the present matter

"Mr Schilling indicated that the opponent was pursuing the opposition on the ground that the applicant is not the proprietor of the subject mark, as required by section 40 of the Act. Rather, the opponent claims proprietorship in the mark, based on first use in Australia. This claim relies on the well-established principle, described and discussed on many occasions by the courts, and conveniently summarised by Mr Justice McGarvie in *Settef S.p.A. v. Riv-Oland Marble Company (Vic) Pty Ltd* (1988) AIPC 90-516 at page 38,435:

"The basic common law principle is that the first person who uses a trade mark of an appropriate type within a country becomes the proprietor of the mark there ... A person who becomes proprietor of a trade mark in this way is entitled at common law to restrain a person who later commences to use the trade mark ...

In considering who, within sec. 40(1) of the Act, was at the time of [the] application for registration the proprietor of the trade mark, one considers who at common law was the proprietor in Australia."

It is also well-established that the rights of the parties in proceedings such as these, including those of proprietorship, are to be "determined on the state of facts existing when the application is lodged": Dixon J, (as he then was), *The Shell Company of Australia Limited v. Rohm and Haas Company and Another* 78 CLR 601 at p624. The relevant date for these proceedings is therefore 19 December 1985, when the subject application was lodged. (*Ms Farquhar refers of course to an application other than the ones with which I am concerned.*)

...

There is nothing in the applicant's evidence to indicate that, at the relevant date, there had been any other activities involving the trade mark that could be found to constitute public use of that mark, in the sense discussed in *Sabra International Pty Ltd v. Sizzler Restaurants International Pty Ltd* (1991) AIPC 90-746 at pp37,184-37,185. Its claims in terms of section 40, as Mr Ellicott noted, are therefore based on the "combined effect of authorship of the mark, the intention to use it upon or in connection with the [services] and the applying for registration.": Dixon J, the *Shell* case, *supra*.

The opponent's case, as Mr Schilling submitted, rests on its use of the expression, T.G.I. Friday. In his declaration, Mr Hesky describes how the business name T.G.I. Friday was registered to the opponent company in March 1985, and states that "immediately following that registration the expression T.G.I. Friday was placed on the door of the lounge bar at the Raby Tavern." The Raby Tavern was constructed by the opponent company as part of the Raby shopping centre in the town of Raby near Campbelltown, New South Wales. Exhibits PHH6 and PHH7 are, according to Mr Hesky, copies of photographs of the Raby Tavern and the lounge bar of the tavern, respectively. Mr Hesky states that PHH7 shows "the manner of use of the name T.G.I. Friday as a trade mark in relation to services provided by that lounge bar." Exhibit PHH8 is a copy of a newspaper advertisement which, again according to Mr Hesky, shows the manner of use of T.G.I. Friday in relation to the lounge bar of the Raby tavern.

I must note at this point, as I did at the hearing, that I can conclude nothing from Exhibit PHH6 other than that it is a picture of some buildings. There are no discernible words from which I can determine that it is the Raby tavern. Nothing of any significance turns on this point, however.

Mr Ellicott argued that although Mr Hesky has stated that T.G.I. Friday was placed on the door of the lounge bar, this assertion of itself is insufficient to demonstrate the required use as a trade mark, since it provides no information as to how it was used, or in relation to what services. He noted that exhibit PHH7 is undated, so there is no factual indication of when use in this manner commenced. Mr Ellicott submitted that in any case this use of the expression would not be perceived by the public as being use of a trade mark, as "trade mark" is defined in section 6 of the Act and discussed by Kitto J in *The Shell Co.*

of Australia Ltd. v. Esso Standard Oil (Australia) Ltd. 109 CLR 407 at p424. Rather, he argued, it would be seen as use of the abbreviation of an ordinary expression, "Thank God it's Friday", in much the same way as "Merry Christmas" or "Happy New Year" may be used at the appropriate time of the year.

The provisions of the Act relevant to a consideration of what constitutes use as a trade mark are contained in the following:

Sub-section 6(1)

"Trade mark means ... a mark used or proposed to be used in relation to ... services for the purpose of indicating, or so as to indicate, a connexion in the course of trade between the ... services and a person who has the right, either as proprietor or as registered user, to use the mark, whether with or without an indication of the identity of that person."

Sub-section 6(2):

"(a) references to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark;"

Sub-section 107(2A):

"A trade mark shall be deemed to be applied to ... services if-

(a) it is used in a manner likely to lead to the belief that it refers to, describes or designates the ... services; or

(b) it is used in-

(i) a sign or advertisement, including a televised advertisement; or

(ii) an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document, and ... services [are] provided ... to a person in pursuance of a request or order made by reference to the trade mark as so used."

It was conceded by Mr Schilling that registration of the business name T.G.I. Friday is of no relevance to the matter to be decided here, so the opponent's case rests on whether the use of that expression illustrated in Exhibits HH7 and HH8 meets the criteria set out in the Act. In the *Yanx* case 82 CLR 199 at pp204-205 Williams J. said:

"On principle and as a matter of common sense ... it would seem that a mark is used as a trade mark in Australia if it is used here to designate the goods of a particular trader which are offered for sale in Australia under that mark ..."

Adapting that comment to the present circumstances, it would seem that the opponent has used T.G.I. Friday as a trade mark in Australia in respect of the relevant services if I can find that either or both of Exhibits HH7 and HH8 designate those services as being available under that mark.

Exhibit HH7 shows a doorway to a building, above which is painted or by some other means displayed (it is not possible from the representation provided to determine how), the expression T.G.I. Friday. It is not apparent from the exhibit what the building is or to what part of it the door provides access. There is what appears to be a blackboard

easel set alongside the door with what I take to be a daily meals menu set out on it. As Mr Ellicott noted, there is no date shown on this exhibit, nor is there any other means of determining when this use of T.G.I. Friday started.

Having considered this exhibit, I am not prepared to find that it constitutes use of T.G.I. Friday as a trade mark designating restaurant services and alcoholic beverage bar services provided by or on behalf of the opponent at a date prior to 19 December 1985.

Exhibit HH8 consists of a copy of an advertisement for weekly entertainment provided at the Raby Tavern, the name of which appears at the bottom of the advertisement, while the word or name FILLIES appears at the top. The days of the week are listed vertically on the left-hand side of the advertisement, and alongside or below each is the particular entertainment provided that evening. The form of nominating the days is as follows: WEDNESDAY THURSDAY TGI FRIDAY SATURDAY SUNDAY. There is no differentiation in form between TGI FRIDAY and any of the other days listed, and no indication of date on this exhibit.

Again, after consideration of this material, I cannot find that it constitutes the required use of T.G.I. Friday as a trade mark designating services provided by the opponent, at the relevant date.

It follows, therefore, that I cannot find that the opponent has made out a case for proprietorship in the mark T.G.I. Friday's in respect of the specified services, and thereby displaced the applicant's claims in this regard in terms of section 40 of the Act."

Matters for decision in the present instance.

Proprietorship.

In the present situation, as with the one decided by Ms Farquhar, there is no evidence of use by the applicant. The present applicant considered that the case put up by the opponent did not need any such answer.

I accept Ms Farquhar's assessment of the evidence forming the first declaration as correct, and it follows that the opposition stands or falls depending on the additional support of the evidence in the second Hesky declaration. I turn to that declaration and the exhibits.

PHH9 is a copy of an architect's drawing for the Raby Tavern as it was then proposed and as it now, according to the declaration, is. A sizeable area of the floor space is marked TGI FRIDAY'S, and that area is flanked by a bar (and adjoining snack-bar servery and barbeque), toilet facilities and a dance floor and stage with a diskjockey booth. I note that, of all the exhibits, it is only in this plan that the possessive form T.G.I. FRIDAY'S is used.

PHH10 is a photo of the roadside sign identifying the Raby Shopping Centre. In this photo there is also a smaller sign which refers to "live bands thurs nites", but no reference is made to TGI Friday.

PHH11 shows an entrance door, and the declaration makes it clear that the door is the main one shown in the floor plan at PHH9 as opening into the "TGI Fridays" (sic) area. One of the glass panels above the door is painted with the words T.G.I Friday, while in a window to the right of the door a neon sign reading TGI FRIDAY can be seen. On the wall beside the door is a sign identifying the Raby Tavern and supporting detail photos, in exhibits PHH12 to PHH14, also illustrate that what is depicted in these photos is a part of the Raby Tavern.

PHH15 is an invoice which shows that a Neon sign "TGI Friday" was installed at a tavern in the Raby Shopping Centre. There are other pieces of work also invoiced, so the date of installation is not certain either from the invoice or the declaration, but it was probably in May, and no later than July, 1985.

PHH16 is a photocopy of advertisements declared to have been placed in the *Macarthur Advertiser* newspaper on a weekly basis from mid 1985 through to the end of 1987 in relation to what the declarant calls "the T.G.I Friday lounge bar of the Raby Tavern".

I will note here that one of the advertisements making up this exhibit appears to be identical to the one previously annexed as exhibit PHH8, but folded to obscure the word FILLIES and the border around it. A small part of the elliptical border can still be seen just below the fold.

A second advertisement does not use the words TGI Friday. A portion of the advertisement is headed Thursday 20th. Below this are printed:

B.U. + Big Mike Video DJ
"T.G.I"

The same trace of an ellipse is just below the cut-off line at the top of this second advertisement and in one other, which is in terms much as those of the first. The fourth advertisement, again much like the first in content, is not quite so suspiciously cut off, but the cut-off line is somewhat closer to the remaining text. I must infer from this that all of the advertisements exhibited are incomplete, and that will reduce the weight I can give to them.

Even if that were not so, I would in any case accept Mr Fisher's argument that the advertisements, of which three are in much the same format as the one assessed by Ms Farquhar, are no more than a time-table of the events planned for the week at the Raby tavern. They may be trade mark use of the identifier Raby Tavern, but they are not use of TGI FRIDAY as a trade mark.

There is no doubt that a part of the Raby tavern is called TGI Friday, but as Mr Fisher argued, it would be no different if the same area was called "G'day Mate". There is simply no evidence that those words are used in a manner such that for the purposes of section 107(2A)b(i) "services [are] provided ... to a person in pursuance of a request or order made by reference to the trade mark as so used".

Mr Schilling relied on the *YANX* case 82 CLR 199 at 204 - 205. In that case Williams J noted that:

a mark is used as a trade mark in Australia if it is used here to designate the goods of a particular trader which are offered for sale in Australia under that mark ... Yanx had been used in Australia so as to designate the applicant's cigarettes in the minds (of buyers)

Williams J went on to indicate that the mark need not be used on the goods, but that it must be used in connection with the goods. However, as per *Moorgate Tobacco v Philip Morris* 3 IPR 545 at 557 this must be in the context that there needs to be an actual trade or offer to trade under the mark.

Mr Schilling argued that all that needs to be shown is use on or in relation to the opponent's services. This is at odds with the finding in *Yanx*, supra, and in *Shell Co. of Australia Ltd. v. Esso Standard Oil (Australia) Ltd* 109 CLR 407 at p425, that use was a matter of perception as much as of placement. The High Court has noted in *W.D. & H.O Wills* that "trade is a very wide word" (94 CLR 182 at 191), but in the final analysis no mark is used in trade if it is used only as something other than a trade mark. The term trade mark is defined in section 6(1) as follows:

(a) except in relation to Part XI, a mark used or proposed to be used in relation to goods or services for the purpose of indicating, or so as to indicate, a connexion in the course of trade between the goods or services and a person who has the right, either as proprietor or as registered user, to use the mark, whether with or without an indication of the identity of that person; ...

In the present case the connection is too remote. The opponent operates the Raby tavern, and part of that tavern is given the name TGI Friday, but the evidence stops short of showing that any custom has been generated or sought by an offer to trade in any services under the designation TGI FRIDAY.

There is a second issue in the proprietorship argument, one addressed by both attorneys. That is the extent to which any use of a trade mark can displace a claim to proprietorship in a non-identical trade mark. That matter did not concern Ms Farquhar in the decision from which I have quoted, as the marks there in competition were identical.

In the present opposition, Mr Schilling noted that in Shanahan's *Australian Law of Trade Marks and Passing Off* the author notes that:

In those cases where the High Court has upset a claim to proprietorship by reference to s. 40(1), the parties were claiming rights in the very same mark, while the greatest variations in other cases where prior use has been considered by the court under s 40(1) were between "7Up" in a circle and "8Up" in a square, and between "Polykin" and "Polyken".

That question has been recently considered by this office in *Jose v Karu* (1991) AIPC 90-844. The hearing officer there concluded that proprietorship is defeated only by use of an identical or almost substantially identical mark, but as that decision is under appeal I can give it no great weight. It is however a conclusion with which I agree.

Making the opponent's case, Mr Schilling argued that I could rely on my own knowledge of Australian idiom, particularly the obvious tendency of Australians to shorten names in common use. Mr Fisher replied that proprietorship was not to be displaced by claims of what might, perhaps, happen, but must focus on actualities. There is no evidence that anyone would equate the applicant's and opponent's marks, and uses such as "see you at Fridays" were not necessary ways of using the opponent's mark. Indeed, if the second of the newspaper advertisements relied on by the opponent in PHH16 is relevant at all, it suggests that the opponent has shortened its own mark to "TGI" rather than to "Friday", let alone "Fridays".

I find that the opponent's claim under section 40 fails.

Section 28 - Marks causing deception or confusion

Under this heading Mr Schilling chose to address section 28(a) in isolation, arguing that the applicant's use of the mark would be likely to deceive or cause confusion because of the evidenced use or reputation in the opponent's mark. I cannot accept this argument, as there is no evidence of the extent of circulation of advertisements in relation to the business of the Raby Tavern, nor any other evidence of the extent of the opponent's reputation. Likewise, as Mr Fisher argued, the manner of use itself would have acted to minimise any possibility of deception or confusion of the public.

These matters are so irrespective of the action of section 28 as a whole, discussed in *TITAN*, supra. Mr Schilling's argument under section 28 must thus fail.

Conclusion

The opposition fails and is dismissed. I award costs in accord with the scale to the applicant.

T. Williams
Hearing Officer
14 January 1993