

Nando's vs Fernando's

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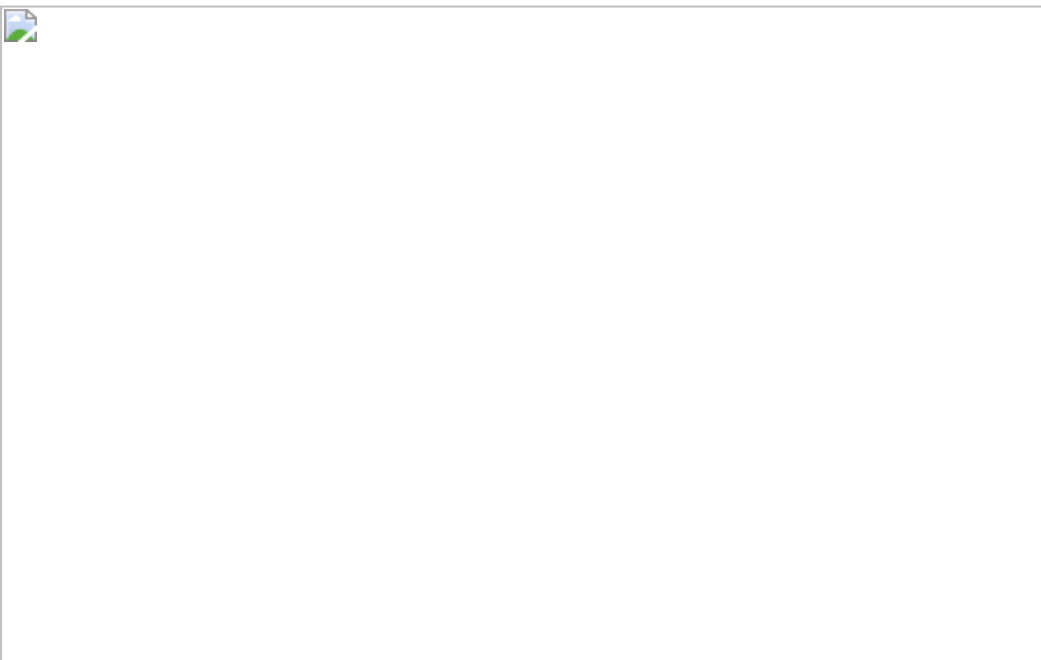
Nando's Chicken Limited is the proprietor of at least thirty nine UK trade marks and recently served a letter of demand on Fernando's restaurant which is in Reading in the UK.

Nando's is best known for its Portuguese Peri-Peri Chicken and Fernando's, also a Portuguese Peri-Peri Chicken restaurant, opened towards the end of 2017.

Originating in South Africa, Nando's has in the last thirty years grown to having no less than one thousand two hundred Nando's restaurants and take-aways worldwide, approximately four hundred of which are in the UK.

TRADE MARK INFRINGEMENT

An extract of the letter of demand published on the internet is below which asserts that Fernando's is infringing a number of Nando's Chicken's registered trade marks, notably it's Rooster device which is registered in the UK in classes 29, 30 and 43 for chicken and chicken products and the provision of food and restaurant related services.



Fernando's signage and menus include

Trade mark registration is both territory and class specific and grants the trade mark proprietor, or authorised user, exclusivity to the mark in respect of the goods and/or services for which it is registered. Any unauthorised use can constitute trade mark infringement.

It might be argued that it is not unusual to use a Rooster in relation to Portuguese Peri-Peri Chicken as it is indicative of the characteristics of the food offered. European case law does stipulate, however, that for this defence to succeed the use should accord with honest practice.

At this stage we will need to wait and see whether Fernando's will agree to Nando's demands and change its name and signage.

It should not be discounted that the manner of use of the name Fernando's and Rooster together with the stylised font also combining the colours red and green for Portuguese chicken could further lead to Nando's Chicken Limited relying on the common law remedy of passing off.

A successful passing off action requires evidence that there is an *"intentional or negligent misrepresentation that the goods or services are those of another or are associated with those of another and that the public is likely to be confused into believing that such goods or services are those of another or are connected with them"*.

SEARCHES AND MARKET RESEARCH

Registrability searches of the relevant registers are highly recommended when adopting a new name or mark. In this instance, class 43 is the relevant service class for restaurant related services while classes 29, 30 and 31 also require consideration since these are the food classes in terms of the International Nice Classification system. Classes 29, 30 and 31 are considered conflicting cross classes for registration and infringement purposes.

Should a trade mark search indicate that a mark is available for trade mark registration, your own market research requiring recognition of existing brands on the market is imperative so as to avoid any likelihood of confusion when the mark is used.

While one might argue that a discerning Nando's customer won't misleadingly believe that Fernando's is associated with Nando's, so too could it be said that steps should have been taken to sufficiently distinguish Fernando's from Nando's before going ahead.

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