

O-277-14

TRADE MARKS ACT 1994

**CONSOLIDATED PROCEEDINGS INVOLVING:**

- 1) AN APPLICATION BY HUSSEIN AYYUB UNDER NO 2531996  
FOR REGISTRATION OF A SERIES OF FIVE TRADE MARKS:



and others

AND

OPPOSITION NO 100708 THERETO BY  
SHEZAN SERVICES (PRIVATE) LIMITED

- 2) REGISTRATION 2019696 OF SHEZAN SERVICES (PRIVATE) LIMITED  
OF THE TRADE MARK:



AND

APPLICATION NO 84535 FOR REVOCATION THEREOF BY HUSSEIN AYYUB

- 3) REGISTRATION 2029477 OF SHEZAN SERVICES (PRIVATE) LIMITED OF  
THE TRADE MARK:






AND

APPLICATION NO 84536 FOR REVOCATION THEREOF BY HUSSEIN AYYUB

## THE BACKGROUND AND THE PLEADINGS

1) The protagonists to this dispute are Mr Hussein Ayyub on the one hand and Shezan Services (Private) Limited (“SSP”) on the other. The trade marks they own are:

Mr Ayyub’s application	SSP’s registrations
<p>UK application 2531996 for a series of five marks, the first of which is:</p>  <p>Registration is sought for:</p> <p><b>Class 29:</b> Frozen meat, fish, poultry and game; frozen meat extracts; frozen meat and vegetable burgers; frozen food stuffs in the form of prepared meals or snacks; frozen prepared meals; frozen prepared cooked meals; frozen prepared curry; frozen curry; frozen prepared or cooked dishes based on vegetables, meat, fish, poultry or game; frozen prepared or cooked curry dishes based on vegetables, meat, fish, poultry or game; frozen kebabs; frozen burgers; frozen samosas; frozen spring rolls; frozen parathas; cooked meats; cooked sliced meat; chilled deserts; chilled ready meals; chilled foods consisting predominately of fish; chilled foods consisting predominately of game; chilled foods consisting predominately of meat; chilled foods consisting predominately of poultry; chilled kebabs; chilled cooked kebabs; chilled burgers; chilled cooked burgers; chilled samosas; chilled cooked samosas; chilled spring rolls; chilled cooked spring rolls; chilled parathas; chilled cooked parathas; chilled cooked meats; chilled sliced meat; chilled cooked sliced meat; chilled curry; chilled cooked curry; chilled chicken tikka; chilled cooked chicken tikka; cooked meat dishes; food products containing meat; meat products; cooked vegetable dishes; food products containing vegetables; prepared vegetable products; kebabs; cooked kebabs; burgers; cooked burgers; samosas; cooked samosas;</p>	<p>i) UK registration 2019696 for the mark:</p>  <p>The mark is registered for:</p> <p><b>Class 29:</b> Jams, jellies, marmalades, conserves; jams and conserves adapted for slimming purposes; pickles, chutney (pickle); preserves; kasundi; processed fruits and vegetables.</p> <p>The mark was filed on 28 April 1995 and it completed its registration process on 14 May 1999.</p> <p>ii) UK registration 2029477 for the mark:</p>  <p>The mark is registered for:</p> <p><b>Class 43:</b> Restaurant, bar and snack bar services.</p> <p>The mark was filed on 7 August 1995 and it completed its registration process on 17 October 1997.</p>

spring rolls; cooked spring rolls; parathas; cooked parathas; curry; cooked curry; chicken tikka; cooked chicken tikka.

**Class 30:** Rice; spices; curry sauces; samosas; spring rolls; burgers in bread rolls; food stuffs in the form of prepared meals, snack foods or snacks; frozen prepared meals; pre-packed prepared meals; prepared cooked meals; prepared curry; prepared frozen meals; prepared meals; prepared or cooked dishes based on vegetables, meat, fish, poultry or game (included in class 30); frozen prepared rice; prepared or cooked curry dishes; snack dips; dips for snack foods; potato based snack foods; vegetable based snack foods; rice based snack foods; snack foods made from cereal; wheat based snack foods; snack foods based on vegetables, meat, fish, poultry or game; bread; bread products; pastry; chapattis; frozen desserts; chilled desserts; desserts; chilled ready meals; chilled foods consisting predominately of vegetables; chilled samosas; chilled cooked samosas; chilled spring rolls; chilled cooked spring rolls; chilled parathas; chilled cooked parathas; chilled curry; chilled cooked curry; cooked samosas; cooked spring rolls; parathas cooked parathas; curry; cooked curry.

**Class 43:** Services for providing food and drink; restaurant services; takeaway services; café services.

The application was filed on 18 November 2009 and published in the trade marks journal on 9 April 2010.

2) SSP opposes the registration of Mr Ayyub's application under section 5(2)(b) of the Trade Mark Act 1994 ("the Act"), relying on its two trade mark registrations. Mr Ayyub denies the claim and puts SSP to proof of use in relation to its earlier marks. Proof of use (as per section 6A of the Act) is a feature of the opposition because the registration procedures of the earlier marks were completed more than five years before the publication of Mr Ayyub's mark. Mr Ayyub has also applied for the revocation of these marks; SSP denies the revocation claims on the basis that they have been put to genuine use.

3) Both sides filed evidence. The matter came to be heard before me on 3 April 2014 at which Mr Ayyub was represented by Graham Johnson of Appleyard Lees. SSP did not attend the hearing preferring instead to rely on the evidence and submissions it had filed earlier in the proceedings.

## **THE EVIDENCE**

### **SSP's evidence**

*Witness statement of S.M. Farooq*

4) Mr Farooq, SSP's company secretary, provides a short witness statement explaining that SSP has been established for sixty years. Shezan was first registered in Pakistan in 1958 and the "Shezan trade mark" was first used in the UK in 1978. Exhibit 1 consists of "documents envisaging export of goods under the Trade Mark shezan to UK". The documents in this exhibit are as follows:

- A bill of lading dated 28 November 2001. The shipment is from Shezan International Limited<sup>1</sup> to Khan International Trades in Birmingham. The goods in the shipment include mango drink, sherbet, rose syrup, jam, mango in syrup, jams, jellies, oils and pickles. Shezan is not referred to in this document (other than in the company name) nor in an accompanying invoice relating to this transaction.
- A bill of lading dated 8 February 2010. The shipment is from Shezan International Limited to A & M Corporation in Middlesex. The goods include mango drink and other fruit drinks, jams, chili sauces, tomato sauce, vinegar, pickles in oils, pickles, chutney, syrups, ice cream syrup, rose water, kewra water and fruit punch drink. Shezan is not used on the bill of lading, but it is used in the top left hand corner of the accompanying invoice in the stylised form of the earlier marks, but without any form of border.
- A bill of lading dated 4 November 2011. The shipment is from Shezan International Limited to Citi Traders (UK) Limited in Plaistow. The goods include fruit drinks and juices, chili sauces and vinegar. The mark is not used on the bill of lading, but it is used (as described above) on an invoice dated 31 October 2011 which appears to relate to the bill of lading.
- A document dated 30 December 1996. The context of this document is not clear, but it indicates that SSP were not carrying out advertising in the UK (nor Europe) but importers were doing so. Some figures are provided for the years 1989-1995 which range from 20,612, 200 to 31,690,000; the currency of these figures is not clear.
- An inter-office memorandum dated 7 January 1998 which provides export figures to the UK. Shezan is used at the top of the page in a similar manner to registration 2029477. The goods exported include juice, squash and syrups.

5) Exhibit 2 is described as the "sales figures of goods sold under the trade mark shezan in the UK". The figures are dated between July 2010 and "to date" (the date of the print is 16 June 2012). The figures relate to exports to three traders in the UK.

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<sup>1</sup> Although the invoices are not in the name of SSP, no issue has been taken by the other side in terms of use with consent. It seems logical to conclude that the company on the invoices is some form of related company which organizes exports for it.

A similar range of goods to that described above is referred to, although, there are some additional terms such as “all pure” and “tp” which are not explained. The figures show a reasonably consistent amount of sales for the effective two year period the data covers. The total sales to each trader are over \$100,000 per year.

6) Mr Farooq completes his evidence by stating that as Mr Ayyub is of Pakistani origin, he has applied for the trade mark SHAZANS with the full knowledge of his company’s shezan trade mark.

*Witness statement of Derek Moore*

7) Mr Moore is a senior partner in the firm Jenson & Son, the representatives of SSP in this matter. He states that he has been verbally informed by SSP’s trade mark attorney in Pakistan that SSP operates a restaurant in London under the SHEZAN trade mark. Mr Moore states that he has no further details about this.

*Second witness statement of Mr Moore*

8) Mr Moore states that the facts and information he gives were provided by Mr Farooq via SSP’s attorneys in Pakistan. Other information was taken from Google. Mr Moore states that when Shezan was registered in the UK in 1995 it was used in relation to a wide range of Pakistani food products. In exhibit DM1 he provides a selection of invoices regarding exports to UK wholesalers. They feature a similar range of goods to that already mentioned above. Some of the invoices relate to goods identified as other goods (other than Shezan). Such goods are third party branded. The invoices are headed as described earlier. A large number of invoices are provided to UK business between 2008 and 2013.

9) Exhibit DM2 contains a page from SSP’s website headed EXPORT. It identifies the goods it exports which, again, are similar to the goods already mentioned.

10) Exhibit DM3 are pages from an Internet search made on 29 April 2013 which make reference to SHEZAN goods being sold on the websites of [www.asiangrocersonline.co.uk](http://www.asiangrocersonline.co.uk) and [www.kingofspice.com](http://www.kingofspice.com). Some of these use the word Shezan along with a clickable link. The products are also shown, which appear to use the stylised version, sometimes with a border (of both types) sometimes without.

11) Mr Moore repeats what he said in his first witness statement regarding the restaurant, but he still has no more details. All he can provide is an email from what appears to be SSP’s attorneys in Pakistan in which it is stated that the client has informed them that they own a restaurant operating in London under the Shezan name (stylised). Someone else actually runs it, with SSP’s permission. Mr Moore completes his evidence by stating that Mr Ayyub should be aware of the SHEZAN mark since he understands that he is of Pakistani origin where it is well-known.

*Witness statement of Shafiq Piracha*

12) Mr Piracha is the managing partner of Shezan Restaurant in Montpellier Street, Knightsbridge, London. He has been in the restaurant industry for 30 years and a

manager of the Shezan restaurant for the same time. The restaurant has apparently been serving Indian and Pakistani food for over 40 years. It has won awards including a star rating by Egon Ronay's Good Food Guide in the 1970s and the Gold Plate Award and Restaurant of the Year Award in the same decade. Shezan has been used as the restaurant name since the 1970s with the permission of SSL.

*Witness statement of Damian Latif*

13) Mr Latif is a trade mark attorney at Jenson & Son. He has conducted some Internet research into the history of the Shezan Restaurant which he says has operated since 1969. Exhibit DL is a print from the British History Online website concerning the area of London where the restaurant is located. On the eighth page of this print there is a reference to the basement of a particular property being fitted up as the Shezan Restaurant in 1969. The document itself is dated from the year 2000. Also provided is a Way Back Machine extract showing that the website shezan.co.uk was in existence in 1998 and that the website has been updated a number of times since then. An archive print is provided showing the following image.



The date of this print is not clear, but the URL for the page suggests that it was from 1998.

**Mr Ayyub's evidence**

*Witness statement of Graham Pierssense*

14) Mr Pierssense is a Partner and Trade Mark attorney at Appleyard Lees. His evidence is about the restaurant. He provides a Google print showing a picture of the Shezan restaurant with similar imagery to that above. The print is dated 31 October 2011. A further, more recent search of Google (the search is from August 2013) is provided as well as a print from the under-pinning Shezan website. The print is very unclear, but, again, it appears to use the mark as above. Mr Pierssense highlights that the cloud device of the registered mark is not in use and the background/foreground emphasis is different.

15) Written submissions were also filed on behalf of Mr Ayyub. These will be borne in mind but not summarised here.

## **PROOF OF USE/REVOCATION**

16) I begin by considering the use issues that arise in these proceedings, namely, the proof of use of the earlier marks in the context of the opposition proceedings and the use of the earlier marks for the purpose of the revocation proceedings. Similar questions arise, although, I will bear in mind the different relevant periods that apply.

### **The relevant periods**

17) The relevant period for the proof of use assessment in the opposition proceedings is the five year period ending with the date of publication of Mr Ayyub's mark, namely: **10 April 2005 to 9 April 2010.**

18) In relation to revocation 84535 three periods are in issue:

- i) Under section 46(1)(a): **15 May 1999 to 14 May 2004;**
- ii) Under section 46(1)(b): **17 November 2004 to 16 November 2009;**
- iii) Under section 46(1)(b): **24 August 2007 to 23 August 2012.**

19) In relation to revocation 845365 three periods are also in issue:

- i) Under section 46(1)(a): **18 October 1997 to 17 October 2002;**
- ii) Under section 46(1)(b): **17 November 2004 to 16 November 2009;**
- iii) Under section 46(1)(b): **24 August 2007 to 23 August 2012.**

### **The legislation and leading case-law**

20) In relation to the opposition, the use conditions set out in section 6A(3) are met if

“(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.”

21) In relation to the revocations, the relevant parts of section 46 of the Act read:

“46.-(1) The registration of a trade mark may be revoked on any of the following grounds –

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

- (c) .....
- (d) .....

(2) For the purpose of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that –

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

- (a) the date of the application for revocation, or
- (b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

22) Section 100 is also relevant in these proceedings; it reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

23) In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case-law of the Court of Justice of the European Union (CJEU) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence



of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

"(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]"

## Registration 2019696

24) The mark and its goods are:



**Class 29:** Jams, jellies, marmalades, conserves; jams and conserves adapted for slimming purposes; pickles, chutney (pickle); preserves; kasundi; processed fruits and vegetables.

25) The best evidence in relation to this consists of the various invoices that have been provided, some by Mr Farooq, others (the majority), by Mr Moore. Mr Moore's witness statement contains hearsay evidence because certain of the facts he provides have been told to him by someone else. Indeed, there are instances of multiple hearsay. However, the invoices themselves are documentary in nature and have clearly come from the records of SSP. It would have been better for them all to have come from the "horse's mouth"; however, I do not consider their provenance to be undermined by the fact that they have been provided by Mr Moore rather than a relevant person at SSP. There are a good many invoices to a number of what would appear to be wholesalers in the UK. Not all fall within the relevant period(s), but they are nevertheless sufficient to show a real, non-token business being operated. Mr Johnson highlighted the nature of the mark used on these invoices i.e. it is not in the form of the registered mark. However, genuine use can be in a form "differing in elements which do not alter the distinctive character of the mark in the form in which it was registered" as per section 46(2) and section 6A(4)(a) of the Act. The Court of Appeal dealt with what I will describe as the use of a "variant mark" in *Bud/Budweiser Budbrau* [2003] RPC 25. Of relevance are the statements of Lord Walker of Gestingthorpe where he stated:

"43. ...The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?"

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry: 'Bare ruin'd choirs, where late the sweet birds sang' is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of 'whose eyes? -registrar or ordinary consumer?' is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgement, to analyse the 'visual, aural and conceptual' qualities of a mark and make a 'global appreciation' of its likely impact on the average consumer, who:

‘Normally perceives a mark as a whole and does not proceed to analyse its various details.’ The quotations are from para [26] of the judgement of the Court of Justice in Case C-342/97 *Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I-3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance.”

Also of relevance are the comments of Sir Martin Nourse; he stated at paragraph 12:

“Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements....”

26) I also take note of the comments of Mr Arnold QC (sitting as the Appointed Person) in *NIRVANA Trade Mark (O/262/06)* and in *REMUS trade mark (O/061/08)*. In these cases Mr Arnold (as he then was) undertook a thorough analysis of the relevant case law, including judgments of the CJEU and the GC, and he then put forward the following questions, the answers to which will assist in determining whether a variant form of use represents an acceptable variant (the text is from *NIRVANA* but it is also adopted in *REMUS*):

“33. .... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the subquestions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all....”

27) The form as registered compared to the (typical) form as used are set out below:



28) The script used is highly similar; indeed, I initially thought it was identical until an exceptionally close analysis was made. The other difference is the addition of a border and the fact that the registered mark is white on a black background as opposed to black on a white background. However, this second point is not pertinent because notional use of the registered mark would include a reversed out colour scheme. So the differences are an extremely minor (and virtually unnoticeable) change in the script and a lozenge border. The distinctive character of the registered mark subsists essentially in the word Shezan. Its stylisation adds some, but not a high amount of distinctiveness. The border contributes little or nothing. In my view, the differences as noted do not alter the distinctive character of the registered mark. The variant form of use may be relied upon. Furthermore, the fact that the mark as used reads into the company name likewise does not matter. The mark as used is distinct and stands alone and will be perceived in such a way.

29) However, not all of the invoices refer to the goods as Shezan goods. Some invoices (the minority) differentiate between Shezan goods and third party brands. However, the third party brands are identified by name and those which are listed as Shezan products are of the sort referred to in the other invoices where no differentiation is made. On the basis of the evidence as a whole, I am prepared to accept that, other than the goods which are specifically identified as third party/other branded goods, the rest of the items were either branded with some form of Shezan trade mark or were, at the very least, unbranded. If they were unbranded, Shezan (on the invoices) could be perceived simply as a retail or wholesale mark, but I bear in mind the guidance of the CJEU in *Céline* where it was stated:

“21. The purpose of a company, trade or shop name is not, of itself, to distinguish goods or services (see, to that effect, *Case C-23/01 Robelco* [2002] ECR I-10913, paragraph 34, and *Anheuser-Busch*, paragraph 64). The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being carried on. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being carried on, such use cannot be considered as being ‘in relation to goods or services’ within the meaning of Article 5(1) of the directive.

22. Conversely, there is use ‘in relation to goods’ within the meaning of Article 5(1) of the directive where a third party affixes the sign constituting his company name, trade name or shop name to the goods which he markets (see, to that effect, *Arsenal Football Club*, paragraph 41, and *Adam Opel*, paragraph 20).

23. In addition, even where the sign is not affixed, there is use ‘in relation to goods or services’ within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party.

[...]

26. [...] the unauthorised use by a third party of a sign which is identical to a registered mark in relation to goods or services which are identical to those for

which that mark is registered cannot be prevented under Article 5(1)(a) of the directive unless it affects or is liable to affect the functions of the mark, in particular its essential function of guaranteeing to consumers the origin of the goods or services.

27. That is the situation where the sign is used by the third party in relation to his goods or services in such a way that consumers are liable to interpret it as designating the origin of the goods or services in question. In such a case, the use of the sign is liable to imperil the essential function of the mark, since, for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the EC Treaty seeks to establish and maintain, it must offer a guarantee that all the goods or services bearing it have been manufactured or supplied under the control of a single undertaking which is responsible for their quality (see, to that effect, Arsenal Football Club, paragraph 48 and the case-law cited, and paragraphs 56 to 59)".

30) Jacob J considered a similar point in *Euromarket Designs Incorporated v Peters and Another* [2001] F.S.R. 201:

"57. In this connection it should be borne in mind that the Directive does not include an all-bracing definition of "use", still less of "use in relation to goods". There is a list of what may *inter alia* be specified as infringement (Article 5(3), corresponding to section 10(4)) and a different list of what may, *inter alia*, constitute use of a trade mark for the purpose of defeating a non-use attack (Article 10(2), equivalent to section 46(2)). It may well be that the concept of "use in relation to goods" is different for different purposes. Much may turn on the public conception of the use. For instance, if you buy Kodak film in Boots and it is put into a bag labelled "Boots", only a trade mark lawyer might say that that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign "in relation to" the goods. Perception matters too. That is yet another reason why, in this case, the fact that some goods were sent from the *Crate & Barrel* United States shops to the United Kingdom in *Crate & Barrel* packaging is at least arguably not use of the mark in relation to the goods inside the packaging. And all the more so if, as I expect, the actual goods bear their own trade mark. The perception as to the effect of use in this sort of ambiguous case may well call for evidence".

31) These cases, and others, were considered by Mr Daniel Alexander QC (sitting as the Appointed Person) in *The Light BL/O/472/11* and he summed up the position by stating that:

"25. The effect of these authorities, both at EU and at national level, is therefore that this aspect of the non-use provisions requires the tribunal to consider whether, having regard to all the facts and circumstances, the mark been used to identify to the average consumer the proprietor as the origin of, including, having responsibility for, the particular goods or services in question."

32) In my view, even if the goods were unbranded, the use of the variant mark on the invoices represents the required link between the goods and the provider of those goods. The position would be even clearer if the goods were branded with some form of Shezan mark. I cannot of course rely on any actual use of a mark on the goods themselves because the way in which the goods are branded is not set out clearly in the evidence, other than the two web page prints which cannot be placed within any of the relevant periods. However, the use on the invoices is sufficient to establish use in relation to the goods the subject of the invoices. That such use is to wholesalers is not fatal to the case as this is still a genuine business and is warranted in the economic sector concerned. I have fully borne in mind the different relevant periods and, at the very least, genuine use has been made in the proof of use period in play in the opposition proceedings and the latest period in the revocation proceedings. That I have found genuine use in the latter pleaded periods means that the earlier periods are not relevant as per section 46(3) of the Act.

33) Having picked through the invoices, the mark has been used in relation to the following goods:

Juice drinks, mango drink, jams, marmalades, garlic pickle in oil, mixed pickle in oil, pickles in oil, fruit punch, mango jam, berry pickle in oil, plum chutney, mango pickle in oil, apple drink, pineapple jelly, mango chutney, green chili sauce, ginger garlic chili sauce, Samarqand syrup, lime and chili pickle in oil, lime pickle in oil, lychee juice drink, lemon barley drink, grape juice drink, pineapple juice drink, mango kasundi, sandal syrup, anar syrup, white vinegar, mango nectar, lasoora pickle in oil, syrups, pickles, ice cream syrup, mixed fruit jam, strawberry (and other fruit) jam, apple jelly, soya sauce, kewra water, rose water, ispaghol, kasundi, tomato ketchup, mango chunks (invoices dated 19/8/2009, 16/8/2009 & 2/10/2009), brown vinegar, pomegranate syrup, anar shebet, mango chunks and pulp (in 2001), mixed vegetables in vinegar (2001)

34) However, a large number of these goods (the fruit drinks for example) do not fall within the goods for which the mark is registered, which reads:

**Class 29:** Jams, jellies, marmalades, conserves; jams and conserves adapted for slimming purposes; pickles, chutney (pickle); preserves; kasundi; processed fruits and vegetables.

35) The question that arises is what a fair specification should be for the range of goods sold? The fair specification cannot, of course, be wider than the registered goods. The fair specification must not be pernickety<sup>2</sup>. It is necessary to consider how the relevant public are likely to describe the goods<sup>3</sup>. The General Court ("GC") in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 held:

"45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be

<sup>2</sup> See *Animal Trade Mark* [2004] FSR 19.

<sup>3</sup> See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32.

possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

36) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods concerned"

37) It seems to me that save for "processed fruits and vegetables" the goods as registered have all been sold in a number of varieties, and so the terms as registered ought to be retained as acceptable categories or sub-categories of goods. In relation to the one remaining term, processed fruits and vegetables, this is a broad term covering a multitude of products which to a large extent have not been used. The only products other than those which are already retained which can be said to fall

within “processed fruits and vegetables” are mango chunks, a fruit. Whilst there is an entry for mango pulp and mixed vegetables in vinegar, this was only in 2001 so is not relevant to the proof of use considerations in the opposition proceedings, and would not save the registration from revocation. Mango chunks is a standalone one-off product. The fair specification should reflect just this. I come to the view that the fair specification for the purposes of the opposition should be:

**Class 29:** Jams, jellies, marmalades, conserves; jams and conserves adapted for slimming purposes; pickles, chutney (pickle); preserves; kasundi; processed mango chunks.

38) Furthermore, the registration should be revoked save for the above goods.

### **Registration 2029477**

39) The mark and its services are:



**Class 43:** Restaurant, bar and snack bar services.

40) The variant use question also arises with this registration. The evidence from the opponent shows the following mark used in relation to the restaurant:



41) As with the other registration, the distinctive character resides essentially in the word Shezan, but as observed already, the stylisation adds something. In this case, the cloud-like border also contributes to the mark’s distinctive character. The way in which Shezan is presented in the used form has a different manner of stylisation. Furthermore the cloudlike element is missing. Therefore, despite the same word being used, the differences do alter the distinctive character of the mark. In reaching this finding I have taken into account the guidance given in *Case C-252/12 - Specsavers v Asda Stores Ltd* and *Case C-12/12 Colloseum Holding [2012] ECR I-0000* neither of which alters my view. Consequently, the form of use may not be relied upon. In any event, the paucity of the opponent’s evidence causes further difficulties. Mr Moore’s evidence lacks detail and is, in any event, based upon hearsay. Mr Latif’s evidence, whilst establishing the existence of a webpage for the restaurant and that it was established in 1969 provides no real detail of the actual use that has been made. Mr Piracha’s evidence, despite the witness being the manager of the restaurant for 30 years, lacks detail. Whilst the evidence establishes that the restaurant exists, and that it won some awards in the 1970s, no details of the actual use is provided. Being the long-standing managing partner of the restaurant, Mr Piracha must have at his disposal a large body of evidence that could have been



filed. I note that in *Catwalk* BL O/404/13 Mr Hobbs QC, sitting as the Appointed Person stated:

“22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use. As to which see paragraphs [17] to [19] and [24] to [30] of the Decision of Mr. [Daniel] Alexander QC sitting as the Appointed Person in *PLYMOUTH LIFE CENTRE Trade Mark* (BL O-236-13; 28 May 2013).”

42) The evidence must establish that the use of the mark is warranted in the economic sector concerned in terms of establishing or maintaining a market share. The restaurant business is clearly a huge market. There is no evidence whatsoever as to the turnover, the customer numbers, the advertising spend, the number of average covers. Whilst I am sure that the operation of a single restaurant has the capacity to meet the genuine use test, without evidence of the sort I have described I do not consider that SSP has established genuine use. The mark may not be relied upon in the opposition and it should also be revoked.

### **SECTION 5(2)(b)**

43) Section 5(2)(b) of the Act reads:

5(2) A trade mark shall not be registered if because –

... (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

44) In reaching my decision I have taken into account the guidance provided by the CJEU in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

### **The average consumer and the purchasing process**

45) According to the case-law, the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

46) The average consumer in this case will be a member of the general public purchasing food products. The goods are not particularly costly, nor are they infrequent purchases. Certainly, no more than an average level of care and consideration will be deployed. Indeed, for certain staple products such as rice the degree of care and consideration may be lower than the norm. The purchase of the goods is a predominantly visual one, so the visual aspects of the marks take on more importance, although, the aural aspects will not be ignored completely. The applied for mark also includes food based services in class 43. Slightly different considerations apply, but the services are still consumed by members of the general public and whilst the cost may be slightly more than a food product per se, the services are still consumed reasonably frequently. A reasonable, but no higher than that, degree of care and attention will be deployed, with more emphasis, again, being placed on visual aspects, although aural aspects play a slightly increased role (compared to food products) when ordering and booking over the telephone are taken into account.

### **Comparison of the goods/services**

47) When comparing the respective goods and services, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05 – “Meric”*) even if there are other goods within the broader term that are not identical. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

48) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

49) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

50) In relation to complementarity, I also bear in mind the recent guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

51) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>4</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>5</sup>. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the

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<sup>4</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>5</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

52) The goods of the earlier mark, following my proof of use assessment, are:

**Class 29:** Jams, jellies, marmalades, conserves; jams and conserves adapted for slimming purposes; pickles, chutney (pickle); preserves; kasundi; processed mango chunks.

53) The applied for goods and services are:

**Class 29:** Frozen meat, fish, poultry and game; frozen meat extracts; frozen meat and vegetable burgers; frozen food stuffs in the form of prepared meals or snacks; frozen prepared meals; frozen prepared cooked meals; frozen prepared curry; frozen curry; frozen prepared or cooked dishes based on vegetables, meat, fish, poultry or game; frozen prepared or cooked curry dishes based on vegetables, meat, fish, poultry or game; frozen kebabs; frozen burgers; frozen samosas; frozen spring rolls; frozen parathas; cooked meats; cooked sliced meat; chilled deserts; chilled ready meals; chilled foods consisting predominately of fish; chilled foods consisting predominately of game; chilled foods consisting predominately of meat; chilled foods consisting predominately of poultry; chilled kebabs; chilled cooked kebabs; chilled burgers; chilled cooked burgers; chilled samosas; chilled cooked samosas; chilled spring rolls; chilled cooked spring rolls; chilled parathas; chilled cooked parathas; chilled cooked meats; chilled sliced meat; chilled cooked sliced meat; chilled curry; chilled cooked curry; chilled chicken tikka; chilled cooked chicken tikka; cooked meat dishes; food products containing meat; meat products; cooked vegetable dishes; food products containing vegetables; prepared vegetable products; kebabs; cooked kebabs; burgers; cooked burgers; samosas; cooked samosas; spring rolls; cooked spring rolls; parathas; cooked parathas; curry; cooked curry; chicken tikka; cooked chicken tikka.

**Class 30:** Rice; spices; curry sauces; samosas; spring rolls; burgers in bread rolls; food stuffs in the form of prepared meals, snack foods or snacks; frozen prepared meals; pre-packed prepared meals; prepared cooked meals; prepared curry; prepared frozen meals; prepared meals; prepared or cooked dishes based on vegetables, meat, fish, poultry or game (included in class 30); frozen prepared rice; prepared or cooked curry dishes; snack dips; dips for snack foods; potato based snack foods; vegetable based snack foods; rice based snack foods; snack foods made from cereal; wheat based snack foods; snack foods based on vegetables, meat, fish, poultry or game; bread; bread

products; pastry; chapattis; frozen desserts; chilled desserts; desserts; chilled ready meals; chilled foods consisting predominately of vegetables; chilled samosas; chilled cooked samosas; chilled spring rolls; chilled cooked spring rolls; chilled parathas; chilled cooked parathas; chilled curry; chilled cooked curry; cooked samosas; cooked spring rolls; parathas cooked parathas; curry; cooked curry.

**Class 43:** Services for providing food and drink; restaurant services; takeaway services; café services.

54) Before coming to the assessment and my findings on similarity, I make some preliminary observations. Simply because the various items all fall into the category of food, does not make them all similar. Thus, having the purpose of being for human consumption is too superficial a factor to result in the goods being similar. Similarly, that one product can be an ingredient in others does not necessarily result in similarity. In both scenarios, some closer link will be required, although I am conscious that, when considering whether there exists a likelihood of confusion, low degrees of similarity can lead to a positive finding, particularly if there is a higher degree of similarity between the marks. I will make my findings on the basis of the following groups of goods/services, firstly in class 29:

Frozen prepared curry; frozen curry; frozen prepared or cooked curry dishes based on vegetables, meat, fish, poultry or game; chilled curry; chilled cooked curry; chilled chicken tikka; chilled cooked chicken tikka; curry; cooked curry; chicken tikka; cooked chicken tikka

55) All the above goods are forms of curry dishes. Some of the goods of the earlier mark can be considered as Indian meal accompaniments, such as mango chutney (covered by the term chutney) and kasundi (a form of Indian tomato relish). The goods could, therefore, be sold through similar trade channels, in the parts of the store dedicated to Indian (or strictly speaking Indian sub-continental) food, so as to offer for sale a complete Indian meal. The users are the same. The goods are complementary in nature. The nature may not be exactly the same, but there is similarity in purpose on the basis that they are not only for human consumption, but for human consumption as part of the same dining experience. I consider there to be a reasonable, but not high, degree of similarity.

Frozen kebabs; frozen samosas; frozen spring rolls; frozen parathas; chilled kebabs; chilled cooked kebabs; chilled samosas; chilled cooked samosas; chilled spring rolls; chilled cooked spring rolls; chilled parathas; chilled cooked parathas; kebabs; cooked kebabs; samosas; cooked samosas; spring rolls; cooked spring rolls; parathas; cooked parathas

56) All of the above goods are forms of accompaniment for Indian meals, a role also played by some of the goods of the earlier mark. This creates an overlap in trade channels, users and purpose as per the above assessment. Whilst they are complementary to Indian meals, there is also a degree of complementarity with other accompaniments. I consider there to be a reasonable, but not high, degree of similarity.

Frozen food stuffs in the form of prepared meals or snacks; frozen prepared meals; frozen prepared cooked meals; frozen prepared or cooked dishes based on vegetables, meat, fish, poultry or game; chilled ready meals; chilled foods consisting predominately of fish; chilled foods consisting predominately of game; chilled foods consisting predominately of meat; chilled foods consisting predominately of poultry; cooked meat dishes; food products containing meat; meat products; cooked vegetable dishes; food products containing vegetables; prepared vegetable products

57) All of the above goods include within their ambits Indian (or similar) meals. As such, the assessment made at paragraph 55 is applicable. I consider there to be a reasonable, but not high, degree of similarity.

#### Chilled desserts

58) The earlier mark includes jellies, which could be prepared and eaten as a dessert. The term as it stands would therefore cover jellies and, as such, is identical. However, even for chilled desserts not made of jelly, there is still a reasonable degree of similarity as all are chilled dessert products, likely to be sold through the same or similar trade channels for the purpose of consumption as a sweet end a meal.

#### Frozen meat, fish, poultry and game; frozen meat; frozen meat extracts

59) The above goods do not strike me, on an ordinary meaning, as any form of prepared meal or processed meat product. It is meat (etc) per se or a meat extract. That meat (such as chicken) can be used in a curry (or other product) does not mean that they are similar to accompaniments for curry (and other dishes). The fact that meat may be an ingredient in a prepared meal or other product does not make them similar to the goods of the earlier mark. I conclude that these goods are not similar.

#### Vegetable burgers; frozen burgers; chilled burgers; chilled cooked burgers; burgers; cooked burgers

60) The above are all burgers. They are normally sold alongside other meat products such as sausages. They are not, as far as my experience informs me, sold alongside the goods of the earlier mark. The goods do not compete. The goods are not complementary as pickles are not an obvious complementary product and the other goods of the earlier mark are no closer. I conclude that these goods are not similar.

#### Cooked meats; cooked sliced meat; chilled cooked meats; chilled sliced meat; chilled cooked sliced meat

61) Cooked meat such as this has no obvious and clear link with the goods of the earlier mark. The nature is different and they do no compete. There is no obvious overlap in the proximity of sale. In terms of being complementary, the best one gets is that pickle can be used along with certain cooked meats (such as pickle in a beef sandwich). However, this is more down to the taste of the consumer as opposed to establishing a real complementary link that would give rise to an assumption “that

the responsibility for [the] goods lies with the same undertaking” as the other goods. I conclude that these goods are not similar.

62) I now consider the class 30 goods of the applied for mark:

Curry sauces; prepared curry; prepared or cooked curry dishes; chilled curry; chilled cooked curry; curry; cooked curry

63) As per the curry dishes in class 29, I consider the same issues to arise. I consider there to be a reasonable, but not high, degree of similarity.

Rice; frozen prepared rice

64) As per the other accompaniment goods in class 29, I consider there to be a reasonable, but not high, degree of similarity.

Samosas; spring rolls; chilled samosas; chilled cooked samosas; chilled spring rolls; chilled cooked spring rolls; chilled parathas; chilled cooked parathas; cooked samosas; cooked spring rolls; parathas cooked parathas;

65) As per the other accompaniment goods in class 29, I consider there to be a reasonable, but not high, degree of similarity.

Spices

66) Spices are more of an ingredient than an accompaniment. However, they are key to many forms of cooking including Indian cuisine. Thus, goods such as this may well be found in close proximity to other products that are sold for a consumer to create an Indian meal. The purpose has a degree of similarity beyond simply being food. There is a degree of complementarity in the sense described by the case-law. I consider there to be at least a moderate degree of similarity.

Food stuffs in the form of prepared meals, snack foods or snacks; frozen prepared meals; pre-packed prepared meals; prepared cooked meals; prepared frozen meals; prepared meals; prepared or cooked dishes based on vegetables, meat, fish, poultry or game (included in class 30); chilled ready meals; chilled foods consisting predominately of vegetables

67) All of the above could include Indian style meals and, I consider the same analysis as the class 29 prepared meals to be applicable. I consider there to be a reasonable, but not high, degree of similarity.

Snack dips; dips for snack foods

68) The nature of a dip can vary depending on constituent parts, but in comparison to chutneys and kasundi there are some obvious points of similarity. They could be used for similar purposes and could even compete. There is a reasonably high degree of similarity.



Potato based snack foods; vegetable based snack foods; rice based snack foods; snack foods made from cereal; wheat based snack foods; snack foods based on vegetables, meat, fish, poultry or game

69) Snack foods could include Indian and similarly styled products which could be used either as an accompaniment or even as an appetizer for main (Indian) courses. I consider there to be at least a moderate degree of similarity.

Frozen desserts; chilled desserts; desserts

70) As already observed, jellies (in the earlier mark) include those sold as desserts. Although the nature of these jellies is not the same, I still consider there to be at least a moderate degree of similarity.

Bread; bread products; chapattis

71) The goods could include those sold as accompaniments to Indian meals and, as such, I regard them in the same manner as the other accompaniment goods in class 29; I consider there to be a reasonable, but not high, degree of similarity.

Pastry

72) The goods are not pastry products (which would be called pastries) but pastry per se. I see no obvious points of similarity with the goods of the earlier mark. These goods are not similar.

Burgers in bread rolls

73) I come to same view here as per the class 29 burgers. The goods are not similar.



74) Finally, I consider the various food based services in class 43 which reads:

Services for providing food and drink; restaurant services; takeaway services; café services.

75) The nature of the goods of the earlier mark is inherently different from that of these services, as are the methods of use. The users are the same, but this can be said about many things. The fact that both provide sustenance to a human being is, as observed already, very superficial. The goods are not complementary. The goods do not compete; a consumer would not buy pickles etc instead of going to a restaurant. The goods/services are not similar.

### **Comparison of the marks**

76) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are shown below.

The Applicant's Mark	The Opponent's Mark
	

77) The opponent's mark, despite its border, is dominated by the word Shezan. Although in the applicant's mark the word Shazans is smaller in the overall impression it creates (in comparison to the impact Shezan plays in the opponent's mark), it is still likely to be seen as the dominant element. The other elements of the respective marks will not, though, be ignored in my assessment as it is a whole mark comparison that is to be made. In particular, the applicant's mark has what appears to be a rising sun or oriental dome and its background contributes more to its overall impression than the background of the opponent's mark.

78) From a visual perspective, the dominant elements of each mark are **Shazans** and **Shezan**. There are clear and obvious points of similarity between these words – the differences do not in my view negate this to any significant extent. However, I must factor in the various other elements of the respective marks. Having done so, I still consider that the degree of visual similarity is reasonably high.

79) From an aural perspective, the marks are highly similar, being articulated as Sha-zans and She-zan respectively. Indeed, some average consumers may pronounce the former with an UH sound (as Shu-zans) which makes the similarity even greater.

80) Conceptually, neither mark has a firm concept that the average consumer will be aware of (even though some may guess that it is a name), so the conceptual analysis is neutral.

### **The distinctiveness of the earlier mark**

81) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (on the basis either of inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). From an inherent perspective, the earlier mark is reasonably high in distinctive character. As I have already stated, it will have no firm meaning to the average consumer, even if some will guess that it is a name. In terms of the use made of the mark, whilst I have found that the earlier mark has been genuinely used, I am far from satisfied that the evidence establishes that the distinctiveness of the mark has been enhanced owing to any form of reputation in the UK.

### **Likelihood of confusion**

82) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment

of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

83) I must bear in mind the principle of imperfect recollection, the interdependency principle and the fact that the earlier mark is reasonably high in distinctiveness. The first of these factors is important because consumers rarely have the chance to make direct comparisons between marks meaning that the differences between the words **Shazans** and **Shezan** may not be recalled. Further, that there is only a moderate degree of similarity between some of the goods is offset by the closeness of the marks and the fact that the earlier mark is reasonably high in distinctive character. All these factors taken together will inform the average consumer that the respective goods come from the same or an economically linked undertaking. This is so despite the additional visual aspects in the applicant's mark. Although I have said that the visual aspects of the marks are more important, the visual differences are not of the type that lead to differentiation in a trade origin sense. They will be seen merely as a brand variation so will still lead to confusion in an indirect sense. My finding is that there is a likelihood of confusion in relation to all the goods I have found to be similar. There is no likelihood of confusion in relation to the goods I have found not to be similar<sup>6</sup>.

## **OUTCOME**

### **Opposition 100708**

84) The opposition succeeds, and the mark is to be refused, in respect of the following:

**Class 29:** Frozen food stuffs in the form of prepared meals or snacks; frozen prepared meals; frozen prepared cooked meals; frozen prepared curry; frozen curry; frozen prepared or cooked dishes based on vegetables, meat, fish, poultry or game; frozen prepared or cooked curry dishes based on vegetables, meat, fish, poultry or game; frozen kebabs; frozen samosas; frozen spring rolls; frozen parathas; chilled deserts; chilled ready meals; chilled foods consisting predominately of fish; chilled foods consisting predominately of game; chilled foods consisting predominately of meat; chilled foods consisting predominately of poultry; chilled kebabs; chilled cooked kebabs; chilled samosas; chilled cooked samosas; chilled spring rolls; chilled cooked spring rolls; chilled parathas; chilled cooked parathas; chilled curry; chilled cooked curry; chilled chicken tikka; chilled cooked chicken tikka; cooked meat dishes; food products containing meat; meat products; cooked vegetable dishes; food products containing vegetables; prepared vegetable products; kebabs; cooked kebabs; samosas; cooked samosas; spring rolls; cooked spring rolls; parathas; cooked parathas; curry; cooked curry; chicken tikka; cooked chicken tikka.

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<sup>6</sup> As per the CJEU's judgment in *Waterford Wedgwood plc v OHIM* Case C-398/07.

**Class 30:** Rice; spices; curry sauces; samosas; spring rolls; food stuffs in the form of prepared meals, snack foods or snacks; frozen prepared meals; pre-packed prepared meals; prepared cooked meals; prepared curry; prepared frozen meals; prepared meals; prepared or cooked dishes based on vegetables, meat, fish, poultry or game (included in class 30); frozen prepared rice; prepared or cooked curry dishes; snack dips; dips for snack foods; potato based snack foods; vegetable based snack foods; rice based snack foods; snack foods made from cereal; wheat based snack foods; snack foods based on vegetables, meat, fish, poultry or game; bread; bread products; chapattis; frozen desserts; chilled desserts; desserts; chilled ready meals; chilled foods consisting predominately of vegetables; chilled samosas; chilled cooked samosas; chilled spring rolls; chilled cooked spring rolls; chilled parathas; chilled cooked parathas; chilled curry; chilled cooked curry; cooked samosas; cooked spring rolls; parathas; cooked parathas; curry; cooked curry.

85) The opposition fails, and the mark is to be registered, in respect of the following:

**Class 29:** Frozen meat, fish, poultry and game; frozen meat extracts; frozen meat and vegetable burgers; frozen burgers; cooked meats; cooked sliced meat; chilled burgers; chilled cooked burgers; chilled cooked meats; chilled sliced meat; chilled cooked sliced meat; burgers; cooked burgers.

**Class 30:** Burgers in bread rolls; pastry.

**Class 43:** Services for providing food and drink; restaurant services; takeaway services; café services.

#### **Revocation 84535**

86) The registration is revoked with effect from 15 May 2004, save for the following goods for which the mark may remain registered:

**Class 29:** Jams, jellies, marmalades, conserves; jams and conserves adapted for slimming purposes; pickles, chutney (pickle); preserves; kasundi; processed mango chunks.

#### **Revocation 84536**

87) The registration is revoked in its entirety with effect from 18 October 2002.

#### **COSTS**

88) Mr Ayyub has succeeded with one revocation but has failed with the other (save for one term which was partially revoked). These balance each other out in terms of costs. The same applies to SSP's position, but it has successfully opposed Mr Ayyub's mark for the majority of its specification. The official fees for the successful opposition and the successful revocation off-set each other. In term of costs in relation to the opposition proceedings, I consider the opponent to be entitled to an

award in its favour, albeit reduced to reflect the partial nature of its success. My assessment is as follows:

*Preparing a statement and considering the other side's statement*  
£250

*Considering and filing evidence*  
£600

*Total*  
£850

89) I hereby order Hussein Ayyub to pay Shezan Services (Private) Limited the sum of £850 within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

**Dated this 20th day of June 2014**

**Martin Boyle**  
**For the Registrar,**  
**The Comptroller-General**