

O-556-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION No. 3065683
BY MSR CATERING LIMITED TO REGISTER THE TRADE MARK**

Saj
Gourmet Mithai

IN CLASS 30

**AND OPPOSITION THERETO UNDER No. 403280
BY GOURMET BAKERS & SWEETS LONDON LTD**

Background and pleadings

1. On 24 July 2014 MSR Catering Limited (“the applicant”) applied to register the trade mark on the first page (“the application”) in the UK. It was accepted and published in the Trade Marks Journal on 22 August 2014 in respect of the following goods:

Class 30: Flour and preparations made from cereals; Bread, pastry and confectionery; Edible ices; Sugar, honey, treacle; Sweets; Biscuits; Cakes; Confectionery; Confectionery items (non-medicated-); Confectionery made of sugar; Confectionery products (non-medicated-); Desserts; Flour confectionery; Flour for baking; Flour for doughnuts; Flour for making dumplings of glutinous rice; Flour mixed with baking ingredients; Flour ready for baking; Fresh bread; Fresh pasties; Fruit cakes; Ice-cream cakes; Ice-cream confections; Paste (cake-); Pastry; Prepared desserts; Prepared desserts [chocolate based]; Prepared desserts [confectionery]; Prepared desserts [pastries]; Boiled sweets.

2. On 24 November 2014, Gourmet Bakers & Sweets London Limited (“the opponent”) opposed the application. The opposition is based on sections 3(1)(b), 3(1)(c), 3(3)(b), 3(6) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

3. In summary, the opponent claims that the application should be refused for the following reasons:

- Section 3(1)(b) – “the word ‘Saj’ appearing at the start of the mark, as well as the other individual elements of the mark, and the mark applied for in its entirety, individually and collectively describe and/or indicate or imply the nature and/or origin of the Class 30 food products applied for”.
- Section 3(1)(c) – the “mark consists exclusively of signs or indications which may serve in trade to designate the kind, nature, quality, and/or geographical origin of the goods applied for”. The opponent duplicated the wording of section 3(1)(c) but does not specify any particular characteristic.
- Section 3(3)(b) – “the mark would deceive the public as to the kind, nature, quality, and/or geographical origin of the goods applied for if not used upon/in relation to any of the goods applied for that are not of the highest quality and/or do not come within the description of ‘mithai”
- Section 5(2)(b) – the application is confusingly similar to the following earlier UK trade mark registrations:

Mark	No.	Filing date	Registration date	Publication date	Goods and services relied upon for this opposition
	2646565	18/12/12	05/04/13	25/01/13	Class 29: milk and milk products; prepared meals Class 30: prepared meals; pizza, pies and pasta dishes

					Class 43: services for providing food and drink, restaurant, bar and catering services
	2593103	29/08/11	09/12/11	30/09/11	Class 29: jellies, jams, milk and milk products; dried and cooked fruits Class 30: flour and preparations made from bread, pastry and confectionery Class 43: services for providing food and drink, restaurant, bar and catering services
	2654078	23/02/13	28/06/13	19/04/13	Class 29: jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; preserved, dried and cooked fruits Class 30: sugar, rice, tapioca, sago; flour and preparations made from cereals, bread, pastry and confectionery, ices, honey, treacle; yeast, baking-powder, ice, prepared meals; pizza, pies and pasta dishes Class 43: services for providing food and drink, restaurant, bar and catering services

- Section 3(6) – the application was filed in bad faith since, taking into account all of the circumstances, it is, 1) reasonable to assume that the applicant's choice of such a closely similar trade mark (including closely and conceptually similar font style, layout and word content) to that of the earlier mark it must have been filed in bad faith; 2) the application is another part of a series of bad faith activities including other similar trade mark applications; 3) the application is an attempt to misappropriate the intellectual property of the opponent, an effort to trade off the opponent's goodwill and reputation, mislead and confuse the general public, unfairly hamper the opponent's business and generally disrupt their commercial interest. Therefore, the application was filed in bad faith and registration should be refused.

4. The opponent argues that the respective goods/services are identical or similar and that the marks are similar.

5. The applicant filed a counterstatement denying the claims made, stating that the application is distinctive, not similar to the earlier marks and it put the opponent to proof that the application was filed in bad faith. Only the opponent filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.

6. Only the opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful consideration of the papers.

Evidence

Opponent's evidence

Witness statement of Rana Iftikar Ahmad

7. Mr Ahmad is the former sole director and owner of the opponent, a position he held since the company was incorporated on 30 November 2010¹ until 21 October 2011 when the company was taken over by the current owner, Mr Nizakat Ali.

8. Throughout the witness statement, Mr Ahmad refers to Mr Atta Sajid Khan who is a director of the applicant company. Mr Ahmad and Mr Khan have known one another for over twenty years. Mr Ahmad then outlines the history of their business endeavours and friendship which seems to have first become fractured in 1998 when he opened a restaurant called Shere Khan Chilli and Spice in which he introduced a halal Chinese and Indian menu. Mr Ahmad states that this was the first concept of its kind in London and that it proved to be very successful. Mr Khan visited the restaurant on numerous occasions, but then he allegedly opened a "copycat" restaurant called "Exsorma" and offered the same halal based menu. Mr Ahmad also states that Mr Khan "stole" a chef from his restaurant, though the business closed 2 to 3 years later. This was the start of their relationship becoming fractured.

9. When Mr Ahmad's restaurant was opened he launched a range of specialised Asian sweetmeats called Nirala Sweets. He states that Nirala became popular so in September 2009 he decided to close his restaurant to focus on the sweets. Then on 30 November 2010 he set up Gourmet Bakers & Sweets London Limited.

10. From December 2010 he began using the Original Gourmet of Lahore Sweets & Bakers (word and device) mark and he subsequently applied to register it on August 2011 (trade mark registration no. 2593103). In October 2011 Mr Nizakat Ali took over the Gourmet Bakers & Sweets London Limited. To ensure business continuity and maintain goodwill Mr Ali and Mr Ahmad decided not to publicise the sale of the business so that customers, clients or Mr Khan were not aware of the change of ownership. Mr Ahmad states that he stayed in contact with Mr Khan since his company, Nirala Sweets, supplies them with "specialised Asian Sweetmeats"². Further, he states that part of his supply arrangement with the opponent is that he is allowed to advertise his brand on the opponent's sign board.

11. Mr Ahmad then goes on to state that throughout 2012 Mr Khan aggressively pursued the Gourmet Bakers & Sweets London Limited and Nirala Sweets staff. He claims that this was under the belief that Mr Ahmad still owned the company.

¹ A certificate of incorporation was filed under exhibit NA1 of Mr Ali's witness statement discussed below.

² Paragraph 2

12. Mr Ahmad then states that Mr Khan has also been a director of two further companies, namely Gourmet of London Ltd and Gourmet Sweets & Bakers Ltd. Mr Ahmad claims that each of these names must be regarded as either very similar or identical to Gourmet Bakers & Sweets Limited.

13. It is then claimed that Mr Khan is using the “gourmet OF LONDON SWEETS & BAKERS” name and not only copied the “Gourmet Bakers & Sweets London” name but also the branding. Further, it is alleged that Mr Khan has filed a series of trade mark applications for marks which are closely and confusingly similar to the registered and unregistered marks of the opponent. Specific application/registration numbers or details about the marks have not been provided. Mr Ahmad states that through the various companies owned by Mr Khan he has sought to copy the opponent’s name and distinctive orange and white colours. He states that this is leading to a great deal of marketplace confusion. However, no instances of confusion have been provided.

14. Mr Ahmad also claims that in early 2013, Mr Khan’s Gourmet of London Limited Company continually tried to harass and poach other important employees of the opponent and Nirala Sweets. Further, he was “copycatting” the Nirala label. Once again, no evidence to support these claims has been provided.

Witness statement of Nizakat Ali and exhibits NA1 – NA8

15. Mr Ali is the sole director of the opponent company, Gourmet Bakers & Sweets London Limited. This is a position he has held since taking over the business from Mr Ahmad on 21 October 2011³.

16. Exhibit NA1 to the witness statement consists of extracts from Companies House website which show that the opponent’s date of incorporation was 30 November 2010 and initially set up by Mr Ahmad.

17. Exhibit NA2 are print outs from the UK Intellectual Property Office website for trade mark registration numbers 2646565, 2593103 and 2654078. Mr Ali states that the opponent has continually used the mark under registration no. 2593103 since December 2010 initially in Ilford and London, then across the UK.

18. Mr Ali then discusses the word “Gourmet” which is present in each of the respective marks in question. He accepts that the word “gourmet” is descriptive for the goods and services in question. However, he states that “as a result of the Opponent’s use of their various registered marks, the particular stylised marks including the stylised word ‘Gourmet’ have become distinctive of the Opponent’s particular goods and services, such that this stylised ‘Gourmet’ element in particular is now recognised by the public as denoting the Opponent’s goods and services”⁴.

19. Exhibit NA3 consists of the following:

³ The first paragraph of Mr Ali’s witness statement states that he became sole director from 21 October 2012 but later in the witness statement he states it is 21 October 2011. In Mr Ahmad’s witness statement he states that Mr Ali took over the company in 2011, so the first paragraph appears to be a typographical error.

⁴ Paragraph 3

- A Wikipedia entry for “South Asian sweets” which it is claimed confirms that the word ‘Mithai’ (a word used in the application) is a common Urdu/Hindi/Arabic word/generic term meaning “confectionery/sweets and sweet dishes”.
- A print out from a website which provides translations from English to Urdu. It states that “Mithai” means confection in Urdu.
- An extract from the online Oxford dictionary. It defines mithai as “Indian sweets, such as burfi or gulab jamun: large cartons of mithai”.
- An extract from Hamari website which refers to “Desserts (Mithai)”.

20. Exhibit NA4 consists of various print outs from websites, including Wikipedia, which makes reference to Saj as being a common nickname for the Indian/Pakistani name “Sajjad/Sajeed”. Reference is also made to Saj being associated with a large frying pan which is used to cook bread in South, Central and West Asia, in particular Pakistan.

21. Mr Ali then discusses the number of people of Indian and Pakistani descent in the UK, in particular East London/Ilford area. He states that the majority (if not all) of the Pakistani community, and much of the Indian community, will understand and speak Urdu and/or Hindi.

22. Exhibit NA5 comprises of extracts from the Office of National Statistics (ONS) 2011 results of the UK Census with regard to “Ethnicity and National Identity in England and Wales” confirming that when the application was filed 1.5 million residents of England and Wales are ethnically Indian, i.e. 2.5% of the population which is 56,024,844 of the total population and the third largest ethnic UK resident group. The extract also states that 1,125,000 residents of England and Wales are ethnically Pakistani, i.e. 2% of the population and the fourth largest ethnic group.

23. Exhibit NA6 is an article from the BBC website. It is dated 23 September 2013. The article states that Urdu is the official language of Pakistan and is spoken by a large number of people in India. It also states that Hindi is one of the official languages of India.

24. Exhibit NA7 is an extract from another BBC article headed “Arabic today”. It is dated 23 September 2014. Mr Ali highlights two particular quotes:

“Speakers of Arabic in the UK fall into a number of groups. Longer established communities include Yemeni in Birmingham, Newcastle and Cardiff, and Moroccans in the North Kensington and Ladbroke Grove areas of London..”; and

“Although no national statistics are available, a survey of London schoolchildren conducted in 2000 showed that Arabic was the seventh most commonly spoken language in the capital, used by 1.23 per cent of the school population”

25. Exhibit NA8 consists of print outs from various websites which supply company information, namely:

- “Company Check” and “Open Corporates”, which details the various current and former secretary and directorships Mr Khan has held. Mr Ali highlights that these include MSM Catering Ltd, Gourmet Sweets & Bakers Ltd and Gourmet of London Ltd.
- The Companies House website print outs also show that Mr Khan was a secretary of MSM Catering Ltd from its incorporation date of 18 March 2008 until 18 August 2013, and a director of the same company from incorporation until 18 August 2014.

26. Mr Ali states that registration of each of the above company registrations contribute to the opponent’s bad faith claim. Of course, company registration and trade mark registrations are entirely separate registers and both have entirely different purposes. Registration of a company is often compulsory and requires the recordal of directors, accounts etc. It does not offer any trade mark rights per se. Accordingly, the registration of company names which may be considered to be similar, it is not a trade mark issue. Of course, the actions of the applicant may assist in painting a picture of their applicant’s business intentions and motives so I will not discount the company registrations.

DECISION

27. Oppositions under section 3(1)(b) and (c) are independent and have differing general interests

28. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union stated at paragraph 25 that:

“Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C 457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

29. I shall begin with the grounds of opposition based on sub-sections of section 3.

SECTION 3(1)(c)

30. The relevant section of the Act states:

“3(1) The following shall not be registered –

(a)...

(b)...

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d)...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

31. The opponent’s claim is that the application should be refused registration since it is descriptive of the goods provided. The mark comprises of two foreign words and one English word. The use of words in foreign languages was discussed in *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04. The circumstances of that case were also in the context of assessing distinctiveness for the purposes of registration. The CJEU held that the distinctive character of a trade mark must be assessed from the perspective of the relevant public in the territory in which registration is sought.

32. The matter was also considered in *Pooja Sweets & Savouries Ltd V Pooja Sweets Limited*, BL O-195-15 by Ms Anna Carboni, sitting as the Appointed Person. In the *Pooja* case it was held that even if a small subset of the target public would perceive the mark of the application to be descriptive in respect of some of the goods and services this “would not be enough to block registration of the marks under section 3(1)(b)/(c), since they would not meet the relevant test, which is to assess the situation by reference to the average consumer”.⁵ Accordingly, the position must be considered from the perspective of “the relevant class of persons”, which in this case is composed primarily of consumers and end users of the goods listed in paragraph 1 above.

33. In this instance, evidence has been filed which shows that Mithai is a common Urdu/Hindi/Arabic word for confectionery and/or sweets. Given the large number of Urdu, Hindi and Arabic speaking members in the UK the opponent argues that a significant proportion of consumers would therefore understand this to be a descriptive term. With regard to the word “Saj”, the opponent’s have evidenced that it would be perceived as either a common nickname for the Indian/Pakistani name of “Sajjad/Sajeed”, or that “it is a large, flat or convex disc-shaped frying pan made from metal that is used in South, Central and West Asia (including in Pakistan, especially in rural areas), for cooking a variety of flatbreads and would be recognised as such by those in the UK who originate from or are descendents of families from the geographical region. The bread/flatbread is often referred to as ‘Saj bread’”.⁶

34. The remaining word is the easily understood English word, Gourmet. Both parties are in agreement that Gourmet is not distinctive for the subject goods since its meaning is defined as “a connoisseur of goods food and wines”.⁷

⁵ Paragraph 49 of *Pooja Sweets & Savouries Ltd V Pooja Sweets Limited*, BL O-195-15

⁶ Paragraph 4.1 of Mr Ali’s witness statement

⁷ Paragraph 2 of the Chamber Dictionary 12th Edition

35. Two of the words in the application would be known by Urdu/Hindi speakers. Therefore, they appear to be focussed on that section of the public. However, the inclusion of the word Gourmet is English and, therefore, focuses on the general UK public.

36. I am mindful that 1.2% of the UK population will understand the meaning of Mithai and recognise Saj as a name or bread but this is a very small proportion of the relevant public. Accordingly, I find that the relevant public will not recognise Mithai or Saj as being descriptive.

37. Even if I am incorrect that the relevant public would understand Saj and Mithai as being descriptive, I would still consider the unusual combination of two foreign and one English word to be distinctive and not descriptive.

38. In view of the above, I find that the application does not describe a characteristic of the goods and it does not fall foul of section 3(1)(c) of the Act.

SECTION 3(1)(b)

39. Section 3(1)(b) of the Act is as follows:

“3(1) The following shall not be registered –

(a) ...

(b) trade marks which are devoid of any distinctive character,

(c) ...,

(d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

40. The relevant question under section 3(1)(b) of the Act is whether the application is capable of distinguishing the applied for class 30 goods. The mere fact that any of the words within the application may individually describe or be viewed as non-distinctive for the goods does not necessarily mean that it is capable of distinguishing the goods.

41. In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union stated at paragraph 25 that:

“Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining

each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

42. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU at paragraphs 29 and 33 in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

Under that provision, marks which are devoid of any distinctive character are not to be registered.

According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public’s perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37).”

43. The applicant has not pleaded a case of acquired distinctiveness as a result of the use made of the mark. Therefore, I only have the inherent distinctiveness to consider.

44. It is well established in law that the absolute grounds for refusing registration must be examined separately, although there is a degree of overlap between sections 3(1)(b) and (c) of the Act: see *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] E.T.M.R. 57, the Court of Justice of the European Union (“CJEU”), paragraphs 67 to 70. That degree of overlap is reflected in the applicant’s pleadings in which, effectively, descriptiveness (i.e. section 3(1)(c)) is given as a reason for a lack of distinctive character under section 3(1)(b).

45. In my view, the opponent’s claim for opposition is no stronger under this ground of attack than section 3(1)(c). The lack of distinctive character is on the basis that “the mark applied for in its entirety, individually and collectively describe and/or indicate or imply the nature and/or origin of the Class 30 food products applied for”. I have already found that the application is not descriptive of the applied for goods since the relevant public will not recognise the meaning of the two foreign words. The opponent has not indicated any further reason as to why the mark should be considered devoid of distinctive character. Therefore, I find that the application does not fall foul of section 3(1)(b) so this claim is dismissed.

Section 3(3)(b)

46. Section 3(3)(b) reads:

“3. – (3) A trade mark shall not be registered if it is –

(a).....

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

47. Section 3(3)(b) of the Act derives directly from article 3(1)(g) of Directive 008/95/EC of the European Parliament and of the Council of 22 October 2008 (“the Directive”).

48. The opponent’s statement of case argues “the mark would deceive the public as to the kind, nature, quality, and/or geographical origin of the goods applied for if not used upon/in relation to any of the goods applied for that are not of the highest quality and/or do not come within the description of ‘mithai’.” Accordingly, the application should be refused.

49. In *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd* Case C-259/04 the Court of Justice of the European Union (“CJEU”) stated at paragraph 47:

“Nevertheless, the circumstances for refusing registration referred to in Article 3(1)(g) of Directive 89/104 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (Case C-87/97

Consorzio per la tutela del formaggio Gorgonzola [1999] ECR I-1301, paragraph 41).

50. There has been no evidence of the existence of actual deceit. I think it follows in this case that if the objection under section 3(1)(c) fails then the mark is free from objection under section 3(3)(b) as the relevant public (as assessed earlier) will not know of the meanings of the words which allegedly give rise to the deception. Therefore, I find that there is not a 'sufficiently serious risk that the consumer will be deceived'.

51. The section 3(3)(b) claim fails.

SECTION 5(2)(b)

52. Sections 5(2)(b) of the Act is as follows:

"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".

53. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

54. Some of the contested goods, i.e. flour and preparations made from cereals are identical to the goods on which the opposition is based. For reasons of procedural economy, the Tribunal will not undertake a full comparison of the goods listed above. The examination of the opposition will proceed on the basis that the contested goods are identical to those covered by the earlier trade marks. If the opposition fails, even where the goods are identical, it follows that the opposition will also fail where the goods are only similar.

Comparison of marks

55. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by

means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

56. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

57. The respective trade marks are shown below:

Earlier trade marks	Contested trade marks
<p><i>Mark one</i></p>  <p><i>Mark two</i></p>  <p><i>Mark three</i></p> 	<p style="text-align: center;"><i>Saj</i> <i>Gourmet Mithai</i></p>

58. The earlier marks all consist of the words “Original Gourmet of Lahore Bakers and Sweets”. All of the words in the earlier marks are descriptive, except for the place name Lahore. Even if Lahore is not immediately recognised as a place name (as many people will) since that it is preceded by “of” it would then be assumed to be a place name which indicates either where the goods originated from or possibly produced. Notwithstanding this, the most noticeable word within two of the earlier marks, given its size in relation to the other words and proximity, is the descriptive word “Gourmet”. With regard to the remaining mark, the word “Gourmet” is the same size as the other marks and it is not, therefore, the most recognisable aspect of the mark. Instead I am of the view that the overall impression of this mark is most strongly dominated by “gourmet of Lahore” which hangs together as being the most desirable bakers and sweets of Lahore. This also applies to the two marks whereby

“Gourmet” is more prominent. The other elements of the mark play a much weaker role.

59. The contested mark consists of three words, namely “Saj Gourmet Mithai”. The word Saj is placed above “Gourmet Mithai” which contributes to it being more noticeable than “Gourmet Mithai”. Further, since “Gourmet” is the second word, I consider that the average consumer may perceive “Saj” as being the brand with Gourmet being used as a laudatory term intended to promote Mithai as being the best. Therefore, I consider “Saj” to contribute slightly more to the overall impression of the mark than “Gourmet Mithai”, but only to a small extent.

60. Visually, the earlier marks consist of six words and the application three. The only shared element is the descriptive word Gourmet. Since the word Gourmet is given greater prominence in marks one and two there is an element of visual similarity, though I still consider the degree of similarity as being low.

61. Aurally, the earlier marks will be pronounced as “Original Gourmet of Lahore Bakers and Sweets”, whereas the application would be pronounced as “Saj Gourmet Mithai”. Whilst they both contain the word Gourmet, given the number of differing words in each mark and that Gourmet is in the middle, if there is any degree of similarity, it is low at best.

62. Conceptually, given the descriptive nature of each of the earlier marks I find that they will be remembered as originating or having some association with Lahore, with Saj and Mithai being remembered from the application but not having any particular meaning. Therefore, there is no conceptual similarity.

Average consumer and the purchasing act

63. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

64. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer at paragraph 60 in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

65. The goods in question are various food items which would be purchased and consumed by the general public. They are inexpensive goods which are bought

following a visual inspection of them on supermarket and shop shelves, or on a website for home delivery. Whilst they will predominantly be purchased following a visual inspection, I do not discount aural recommendations. Given the low cost of the goods, the level of care and attention paid when purchasing the goods will be low.

Distinctive character of the earlier trade mark

66. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

67. No evidence of use of the earlier marks has been filed. Therefore, the opponent has not claimed an enhanced level of distinctiveness due to the use made of the mark.

68. With regard to the inherent distinctiveness, all of the earlier marks consist of the words “Original Gourmet of Lahore Bakers & Sweets”. The positioning of the words and font size differ in each but this does not materially affect where the distinctive character in each mark resides. In my view, the distinctiveness resides in the combination of “Gourmet of Lahore”, though the distinctive character must be considered to be low.

69. For the avoidance of doubt, given the descriptive nature of the word gourmet, I do not consider there to be any distinctive character therein.

LIKELIHOOD OF CONFUSION

70. I must now determine whether there is a likelihood of confusion. This is not a scientific process and it is a matter of considering all the factors, weighing them and

looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). This is known as the interdependency principle.

71. In order to take into consideration all of the relevant factors, I summarise my findings below:

- The respective goods are identical.
- Given the size and proximity of the word Gourmet in two of the earlier marks it is noticeable and contributes to the overall impression along with “of Lahore”.
- The respective marks are visually and aurally similar to a low degree. There is no conceptual similarity.
- The average consumer is the general public and the goods would be purchased following a visual inspection, though I do not discount aural recommendations.
- The distinctive character of the earlier mark is low.

72. It is accepted that since the goods are identical, this may offset any lesser degree of similarity between the marks. Overall there is only a low (at best) level of similarity between the marks when considering the visual and aural aspects of the mark. However, as agreed by the opponent, they are only similar by virtue of the descriptive word Gourmet which given the descriptiveness of this word, it does not contribute to there being a likelihood of confusion.

73. Accordingly, I find that the opposition based on section 5(2)(b) of the Act fails.

SECTION 3(6)

74. Section 3(6) of the Act states:

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

75. The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch at paragraphs 130 to 138):

“A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C- 529/07 Chokoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

Eighthly, consideration must be given to the applicant's intention. As the CJEU stated at paragraphs 41 to 45 in *Lindt v Hauswirth*:

"...in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

76. A particular feature of this case is that the applicant has not filed any evidence. Consequently, if the opponent has established a *prima facie* case of bad faith, the case will succeed because the applicant has not answered it⁸. The first question is therefore whether the opponent has presented a *prima facie* case of bad faith.

77. The evidence provided repeatedly states that there is ill feeling between the respective parties. In Mr Ahmad's evidence he makes reference to Mr Khan filing a series of trade mark applications. However, details of these trade mark applications/registrations are not provided. He later then discusses the names of various company names which have been registered with Companies House. I suspect that Mr Khan was confused between a trade mark application and filing a new company name. As discussed in paragraph 26, company registration and a trade mark registrations are entirely different. Registering a company name does not provide the holder with any trade mark rights. One may have a company name registration yet trade under a different trade mark.

78. In essence, the opponent claims that the application was filed by Mr Khan as part of a series of bad faith activities intended to misappropriate the applicant's intellectual property, trade off the opponent's goodwill and reputations, mislead

⁸ I believe that this approach is consistent with that of Mr David Kitchen Q.C. (as he then was) in *Ferrero SpA's Trade Marks* [2004] RPC 29.

consumers, hamper the opponent's expansion plans and generally disrupt their business. Whether Mr Khan has filed company name registrations which the opponent considers to be similar, or poached his staff may paint a picture of the intentions of the applicant upon filing the trade mark application but in my view they have no bearing in these proceedings. In my view, since the trade mark application is not confusingly similar, I do not see how it can interfere with the opponent's business activities.

79. For the avoidance of doubt and for the sake of completeness, it is noted that the opponent claims that the applicant "has sought to copy the opponent's name and distinctive orange and white colours". Whilst the application is also in an italic font, it has not been applied for in orange and white colours, and even if this were the case the application would still not have been considered to be filed in bad faith.

80. The bad faith claim under section 3(6) fails.

Overall conclusion

81. The opposition fails in its entirety. The application, subject to appeal, shall proceed to registration for all of the applied for goods.

Costs

82. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £1300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the other side's statement and preparing a counterstatement	£400
Reviewing the opponent's evidence and filing written submissions	£900

83. I therefore order Gourmet Bakers & Sweets London Limited to pay MSR Catering Limited the sum of £1300. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of November 2015

**Mark King
For the Registrar,
The Comptroller-General**