

O/434/17

**TRADE MARKS ACT 1994
CONSOLIDATED PROCEEDINGS
IN THE MATTER OF TRADE MARK APPLICATION 3087631 BY ZENOBIA
KASSAM AND BABAR KHAN IN CLASSES 29, 30, 35, 41 AND 43**



AND THE OPPOSITION THERETO UNDER NO 404638 BY PUKKA PIES LTD

AND

**IN THE MATTER OF TRADE MARK APPLICATIONS 3109437, 3139755 AND
3139748 BY PUKKA PIES LTD IN CLASSES 9, 11, 25, 28, 29, 30, 35, 41 AND 43**

PUKKA, PUKKA BAKERY AND PUKKA FOOD

AND

**THE OPPOSITIONS THERETO UNDER NUMBERS 405248, 406396 AND 406397
BY ZENOBIA KASSAM AND BABAR KHAN**

AND

**IN THE MATTER OF REGISTRATIONS 1350917, 1350918 AND 2271175 IN
CLASSES 29 AND 30 OWNED BY PUKKA PIES LTD**

PUKKA

**AND THE APPLICATIONS FOR INVALIDITY THERETO UNDER NUMBERS
500981, 500982 AND 500983 BY ZENOBIA KASSAM AND BABAR KHAN**

Background and pleadings

1. Six of the opposition and cancellation proceedings listed on the title page of this decision have been brought by Zenobia Kassam and Babar Khan (hereafter “K and K”) against three trade mark applications and three trade mark registrations owned by Pukka Pies Ltd (hereafter “Pies”). Pies has also opposed a trade mark application made by K and K. The various proceedings are consolidated.

2. Pies’ three trade mark applications which are opposed by K and K are as follows:

(i) PUKKA: 3109437 (opposition number 405248), filed on 21 May 2015 for a wide range of goods and services in classes 9, 11, 25, 28, 29, 30, 35, 41 and 43.

(ii) PUKKA BAKERY: 3139755 (opposition number 406396), filed on 8 December 2015 for a range of goods and services in classes 29, 30 and 43.

(iii) PUKKA
FOOD

3139748 (opposition number 406397), filed on 8 December 2015 for a range of goods and services in classes 29, 30 and 43.

3. Pies’ three trade mark registrations which K and K have applied to cancel are as follows:

(i) PUKKA: 1350917 (cancellation number 500981), filed on 8 July 1988 and registered on 3 July 1992 for *Sausages; potato, cheese and onion slices; all included in Class 29.*

(ii) PUKKA: 1350918 (cancellation number 500982), filed on 8 July 1988 and registered on 3 July 1992 for *Meat and vegetable pies; meat and vegetable pasties; non-meat pies; pastry; sausage rolls; all included in Class 30.*

(iii) PUKKA: 2271175 (cancellation number 500983), filed on 26 May 2001 and registered on 9 November 2001 for *Meat; fish, poultry and game, none being live; all for human consumption; food products included in Class 29 containing the aforesaid goods; dairy products; food preservatives; pickles; cooked vegetables; soups; prepared salads; prepared meals and snack foods; sausages; potato, cheese and onion slices; all included in Class 29; and Meat and vegetable pies; meat and vegetable pasties; non-meat pies; pastry; sausage rolls; cheese and onion slices; kebabs; prepared meals and snack foods; all included in Class 30.*

4. K and K's opposition and cancellation actions are all based upon section 3(1)(b) and (c) of the Act. The claims against the application for PUKKA are:

- Under section 3(1)(b): "The term PUKKA does not serve to identify the products and services in respect of the registrations as originating from the Applicant. The average consumer would not be able to immediately perceive the mark PUKKA as originating from one single undertaking. The tem PUKKA is used in common parlance in the English Language making it incapable of indicating trade origin. Therefore, it is entirely unwarranted for the Applicant to have exclusive rights to a mark which cannot perform the origin function."
- Under section 3(1)(c): "The word PUKKA means authentic, genuine and good and is therefore entirely descriptive of the kind and quality of the Applicant's goods and services. The average consumer is likely to make an immediate link with the word PUKKA and the Applicant's goods and services without further contemplation. The Applicant therefore cannot have a monopoly over this term which should be free for other traders to use."

5. The claims against the four PUKKA marks are almost identical in wording. The claims against PUKKA BAKERY and PUKKA FOOD are also very similar; the opposition against the latter is pleaded like this:

- Under section 3(1)(b): The mark PUKKA FOOD does not serve to identify the products and services in respect of the application as originating from the

Applicant. PUKKA means something that is genuine or excellent. PUKKA FOOD is devoid of any distinctive character because it is descriptive of the Applicant's goods and services. The mark PUKKA FOOD therefore fails to perform its origin function as it is not capable of allowing the average consumer to ascertain the commercial origin of the Applicant's goods and services.

- Under section 3(1)(c): The trade mark for PUKKA FOOD clearly designates the kind and quality of the goods and services provided by the Applicant, namely that the food is of a genuine or excellent quality. This mark is highly indicative of the characteristics of the goods and services of the Applicant's trade mark, and shows that the Applicant's trade mark should not be registered as it is wholly descriptive. The average consumer is likely to make an immediate link with the mark PUKKA FOOD and the Applicant's goods and services without further contemplation. Descriptive marks should be left free for third parties to use, and the Applicant should not have a monopoly right over such a descriptive mark. The Applicant's mark is currently being used and will continue to be used in the future to describe the goods and services in issue.

6. Pies denies the grounds made against its applications and registrations. K and K filed their trade mark application (number 3087631) on 29 December 2014. It was published on 8 May 2015. The mark is shown here:



The application was made for a lengthy list of goods and services in classes 29, 30, 35, 41 and 43. I will set these out later in this decision. Pies opposes the application under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Pies bases its section 5(2)(b) ground on 20 earlier rights¹ and its section 5(3) ground on 7 earlier rights, some of which are for the mark PUKKA solus, some for PUKKA

¹ Reduced from an original pleading of 32 earlier rights.

PIES, and others which contain PUKKA with another element. Pies claims its marks constitute a family of PUKKA marks. The details for these earlier rights are summarised in the annex to this decision. The section 5(4)(a) claim is based on use of the sign PUKKA in the UK since 1964 in relation to:

Computer software; protective and safety equipment; advertising display apparatus, mechanical or luminous, electronic bulletin boards; illuminated bulletin boards; digital signage; display devices; downloadable electronic publications, image files, music files; graphics for mobile phones; ring tones for mobile phones, video game programs; DVD's; electric signs; games software; heaters; heating apparatus and installations; apparatus for lighting; chilling apparatus; cooling apparatus; freezing apparatus; refrigerated food display apparatus; disposable paper products; food wrappers; paper handkerchiefs; placards of paper; slate boards for writing; blackboards; printed matter; handbooks; manuals; display banners made of cardboard, paper and plastic; clothing; footwear; headgear; sports clothing; toys; games and playthings and novelties; foodstuff; savory snack products; baked goods; pastry; pastry products; musical instruments; commercial trading and commercial information services; business assistance, advertising, marketing and promotional services; compilation productions and distribution of advertising material; developing promotional campaigns for businesses; provision and updating of advertising packs; loyalty, incentive and bonus services; marketing the goods and services of others; product demonstration and product display services; promoting services of others; rental of coin and card operated vending machines; advertising, including promotion of products and services of third parties through sponsoring arrangements and license agreements relating to international sporting events; business advisory services in relation to the reduction of carbon footprint and charitable contributions to food banks; promoting the sale of goods and services of others; distribution and promotion for distribution of printed material; online advertising the goods of other vendors, enabling customers to conveniently review and compare the goods of these vendors; education; entertainment; sports and fitness; electronic publications; manuals, educational printed matter, educational teaching materials, brochures, periodicals, posters, printed matter and texts; sporting and recreational activities; provision of food and drink; catering; catering services; rental of cookery apparatus; rental of lighting apparatus; all information, advice and consultancy in relation to the aforesaid services.

7. At the hearing, for reasons of proportionality, Pies elected to make submissions on the section 5(2)(b) ground in relation to the following 8 earlier rights only:

*EU2729085 PUKKA	Classes 29 and 30	Filed 7 June 2002 Registered 23 September 2003
*UK1350917 PUKKA	Class 29	Filed 8 July 1988 Registered 3 July 1992
*UK1350918 PUKKA	Class 30	Filed 8 July 1988 Registered 3 July 1992
*UK2271175	Classes 29 and	Filed 26 May 2001

PUKKA	30	Registered 9 November 2001
*UK2165661 PUKKA PIES PUKKA-PIES (series of 2)	Classes 29 and 30	Filed 2 May 1988 Registered 26 March 1999
*UK2353051 PUKKA PIES DON'T COMPROMISE PUKKA PIES – DON'T COMPROMISE (series of 2)	Classes 29, 30, 35 and 43	Filed 9 January 2004 Registered 3 December 2004
UK2644327 PUKKA PIE DAY	Classes 29, 30 and 41	Filed 30 November 2012 Registered 19 April 2013
UK2649863 PUKKA CURRY SAUCE	Classes 29 and 30	Filed 25 January 2013 Registered 21 June 2013

8. Likewise, submissions in relation to section 5(3) were confined to the rights in the table which I have marked with an asterisk (in relation to the parts of their specifications for which a reputation is claimed).

9. In summary, Pies makes the following claims:

- Under section 5(2)(b) of the Act: that there is a likelihood of confusion between K and K's application and the earlier rights set out in the table above because the marks are similar and the goods and services are either identical or similar. As mentioned earlier, Pies claims its rights form a family of marks and that the opposed application will be assumed by the average consumer to be part of Pies' family of marks.
- Under section 5(3) of the Act: that, owing to the reputation in its marks enjoyed by Pies, the opposed application would take unfair advantage of or be detrimental to the distinctive character and repute of Pies' marks.
- Under section 5(4)(a) of the Act: that Pies has goodwill in its PUKKA sign and that use of the opposed application would constitute a misrepresentation and

damage to the Opponent. Use of the application is liable to be prevented under the law of passing off.

10. K and K deny the claims. They claim that Pies cannot have a monopoly in the word PUKKA because it is descriptive in relation to K and K's goods and services, meaning authentic and good. In this respect, K and K refer to the invalidity proceedings set out above and also invalidity proceedings which they commenced at the European Intellectual Property Office in relation to EU trade mark (EUTM) 2729085.

11. K and K request proof of use in relation to Pies' earlier marks which had been registered for five years or more on the publication date of K and K's application, 8 May 2015. Six of the rights set out in the table above fall into this category. K and K deny that the PUKKA marks enjoy goodwill or a reputation through their use, putting Pies to proof of the same.

12. At the hearing, K and K conceded that Pies has made genuine use of its PUKKA PIE registrations, UK2165594, 2165661 and EU980946, except in relation to burgers, kebabs, chips, pastry and pastry products, burgers contained in bread rolls and kebabs contained in pitta breads. Only one of these registrations appears in the table above: UK2165661, for PUKKA PIES/PUKKA-PIES (a series of two marks).

13. Both parties are professionally represented and have filed evidence. The matter came to be heard on 3 March 2017, by video conference. Mr Tom St Quintin, of Counsel, instructed by Marks and Clerk LLP Limited, represented Pies. Mr Jamie Muir Wood, of Counsel, instructed by Trade Mark Wizards Limited, represented K and K.

Evidence

14. The majority of Pie's evidence comes from Rachael Bouch, Pies' General Manager, and from John Ferdinand, its trade mark attorney. K and K's evidence comes from Babar Khan.

15. Ms Bouch’s witness statement is dated 29 February 2016. She states that Pies was incorporated in 1971, but has been trading in the UK since 1964 in relation to food products and related goods and services. Exhibit 21 is an obituary of Pies’ founder, Trevor Storer, dated 14 August 2013, published in the *Telegraph*. The article includes the following:

“In 1964, at Valerie’s [Mr Storer’s wife] suggestion, the company’s name was changed to Pukka Pies. “We thought Pukka, which was fashionable at the time, represented something that was top-notch”, she later said”.

16. Exhibit 1 includes a print from Pies’ website, which says that Pies makes over 60 million pies and pasties a year. Ms Bouch states that in 2015 approximately 69 million individual units of Pies’ products were sold, with approximately 500,000 packs of Pies’ products being sold in the UK each week. The table reproduced below gives turnover figures² for goods and services which Ms Bouch states have been provided under “The PUKKA marks”, which she defines as the mark PUKKA and marks featuring PUKKA.

Year	Turnover (£)	UK Sales (£)	EU Sales (£)	Other Jurisdiction (£)
2010	37.5 million	37.1 million	400,000	
2011	35.9 million	35.5 million	345,000	
2012	40.1 million	39.7 million	240,500	104,000
2013	40.3 million	39.9 million	268,000	107,000
2014	43.9 million	43.5 million	318,000	72,000
2015	46.5 million	46.1 million	396,000	16,000

17. Exhibit 3 contains product lists from two food product wholesalers, Brakes and Eric Twigg Foods. The Eric Twigg Foods product list bears a copyright date of 2016 and is headed ‘Pies and Savouries’. It lists a large number of Pies’ products, such as “Pukka Large All Steak Pies”, “Pukka Jumbo Sausage Rolls”, “Pukka Beef and Onion Pasty”, in addition to “Pukka Catering Sausage” and various packs of pastry, such as “Pukka Twin Pack Puff Pastry”. The Brakes product list also bears a

² The figures have been obtained from the audited official financial statements, shown in Exhibit 2.

copyright date of 2016, showing similar products to the Erig Twigg Foods list, and all identified by “Pukka” plus a description of the product. Some products are shown in their packaging, showing PUKKA-PIES like the top mark in the registered series mark 2165594 (which is pleaded, but not one of the selected marks in the table in paragraph 7 above to which Mr St Quintin chose to confine his submissions):



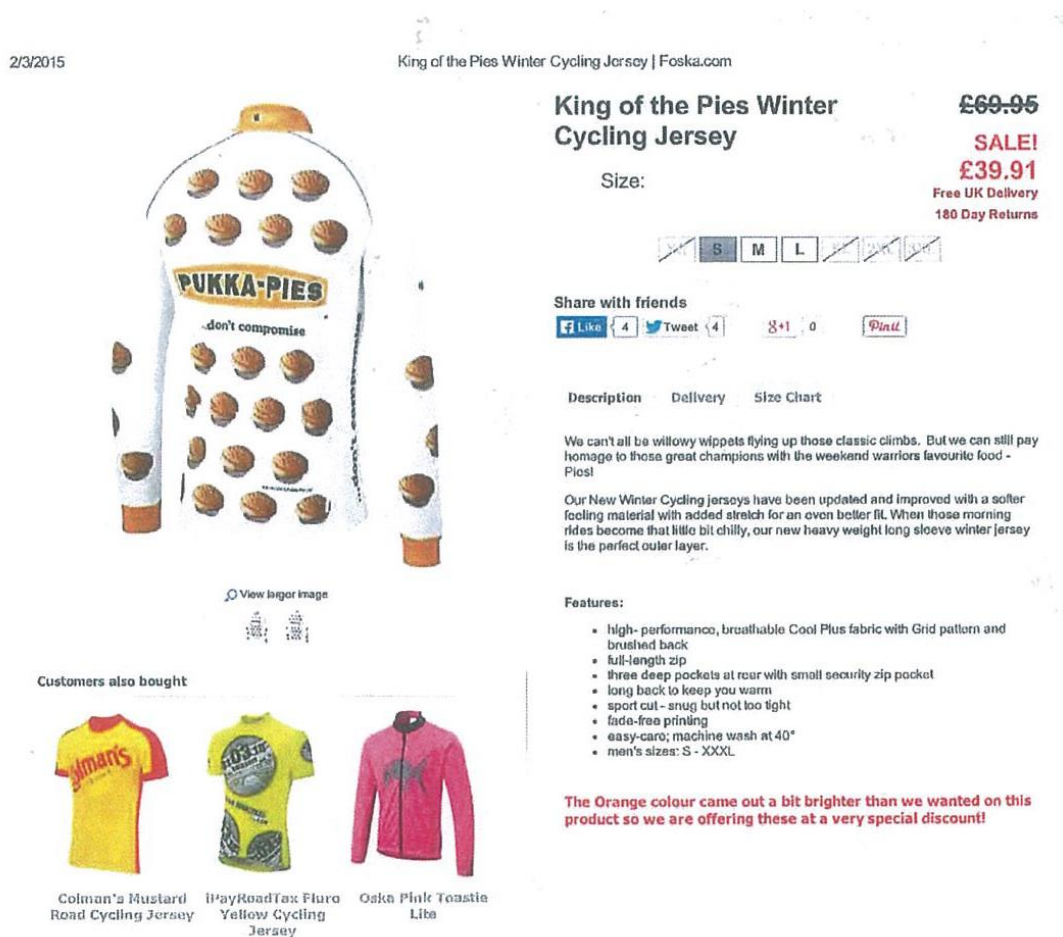
18. Exhibit 4 comprises invoices headed with the stylised mark shown above, underneath which it says “...don’t compromise”, dated 6 January 2010, 1 February 2010, 5 January 2011, 1 February 2011, 4 January 2012, 1 February 2012, 2 January 2013, 1 February 2013, 3 January 2014, 3 February 2014, 5 February 2014, 5 January 2015, 9 January 2015 and 1 February 2015 to Eric Twigg Foods, Grimsby Fisheries, Asda (Lutterworth), Mannin Fish (Stevenage), and a Tesco distribution centre in Didcot. The quantities sold vary according to the nature of the customer. One of the invoices for Eric Twigg Foods amounts to a value of over £4,000, another for Asda came to nearly £10,000, and the invoice to Mannin Fish, dated 9 January 2015, came to nearly £17,000. Products sold include various pies, pasties, sausages, sausage rolls and pastry sheets.

19. Ms Bouch states that all of Pies’ products are supplied in packaging which heavily features “The PUKKA marks”. Examples of packaging designs are shown at Exhibit 5. They chiefly show the stylised mark. I note that the ingredients, cooking and storage instructions say “Pukka Ingredients”, “Pukka Heating” and “Pukka Storage”. The words “...don’t compromise” appear some way from the stylised mark, and the slogan “Proud to be Pukka” also appears on some of the packaging. Some of the packaging designs are dated 2014, 2015 and 2016.

20. Ms Bouch states that “The PUKKA marks” are used in relation to merchandising goods. Exhibit 7 shows goods such as T-shirts, mugs, footballs, peaked caps,

beanies, sweatshirts, aprons, clocks, an English flag bearing the stylised mark, rulers, pens and a price list directing prospective customers to buy the goods either at reception or via Pies' online shop, at pukkapies.co.uk. Computer games were created by Pies, featuring some of "the PUKKA marks". These are shown in Exhibit 8, in the form of archived prints from Pies' website dating from 2012. There is no indication that they were for sale. The 'Pienalty Shootout' game shows a goalkeeper in front of a football net, with a PUKKA PIES pitch-side advertising hording behind the net. Exhibit 9 consists of evidence to show that Pies has a co-branding arrangement with FOSCA, who make cycling jerseys which bear third party logos, as below:

2/3/2015 King of the Pies Winter Cycling Jersey | Foska.com



King of the Pies Winter Cycling Jersey ~~£69.95~~
SALE!
£39.91
 Free UK Delivery
 180 Day Returns

Size: S M L

Share with friends
 Like 4 Tweet 4 +1 0 Pin It

Description Delivery Size Chart

We can't all be willow wippets flying up those classic climbs. But we can still pay homage to those great champions with the weekend warriors favourite food - Pies!

Our New Winter Cycling jerseys have been updated and improved with a softer feeling material with added stretch for an even better fit. When those morning rides become that little bit chilly, our new heavy weight long sleeve winter jersey is the perfect outer layer.

Features:

- high- performance, breathable Cool Plus fabric with Grid pattern and brushed back
- full-length zip
- three deep pockets at rear with small security zip pocket
- long back to keep you warm
- sport cut - snug but not too tight
- fade-free printing
- easy-care; machine wash at 40°
- men's sizes: S - XXXL

The Orange colour came out a bit brighter than we wanted on this product so we are offering these at a very special discount!

Customers also bought

Colman's Mustard Road Cycling Jersey
 Happy Road Tax Fluro Yellow Cycling Jersey
 Oskar Pink Toastie Liba

There is no information as to the sales figures achieved of any of these merchandising goods.

21. Ms Bouch states 55% of sales are made to trade customers and 45% of sales to end consumers through supermarkets and similar outlets. Pies sells its goods to businesses and to the general public; distribution channels include takeaways, pubs, restaurants, bakers, butchers, canteens, cafés/delis, mobile catering, in-house site catering, football stadia, sporting grounds and clubs, supermarkets, grocery stores and wholesalers. Pies' goods are sold by household names including Asda, the Co-Op, Londis, Morrisons, Nisa, Ocado, Sainsbury's, Spar, Tesco and Iceland. Ms Bouch provides a list of football stadia at which Pies has takeaway outlets, some of which are top flight clubs such as Southampton and Leicester City. Average turnstile figures per match are given, and photographs are shown of some of the outlets at Exhibit 13, for example at the Don Valley Stadium in Sheffield, where the sizeable kiosk shows the stylised mark all along the top. Exhibit 16 contains a print from the footballtradedirectory.com, dated 2011, in which it is reported that Pies supplied a record number of 700,000 pies to football clubs in the 2010-2011 season.

22. Ms Bouch states that quality assurance of Pies' products is recognised and accredited by various organisations. She provides a list of these, but they are mostly abbreviations or acronyms, without an explanation as to what the industry bodies are. She states that Pies has an extensive corporate social responsibility, evidenced by its fundraising and support of various charities, both local and national, such as The Duke of Edinburgh award, MacMillan Cancer Support and Alheimers Society (Exhibit 14, from Pies' website). Pies has also provided donations to the foodbank charities FareShare (60,000 pies in 2014, exhibit 15) and FoodCycle.

23. Ms Bouch states that Pies also extends its reach and recognition by sponsorship; for example, the UK Snooker Championship in 2009, shown on ITV; UK football Championship teams, shown in stadia with matches aired on SkySports TV; and England v Scotland and Scotland V New Zealand rugby, aired on the BBC in 2014.

24. Advertising spend has averaged approximately £1.5million per annum, with the level reaching £1.9million in 2015. Marketing has taken place via the channels already summarised above, and also through radio and television advertisements, and sponsorship of TV programmes, such as 'Who Wants to be a Millionaire (2008-

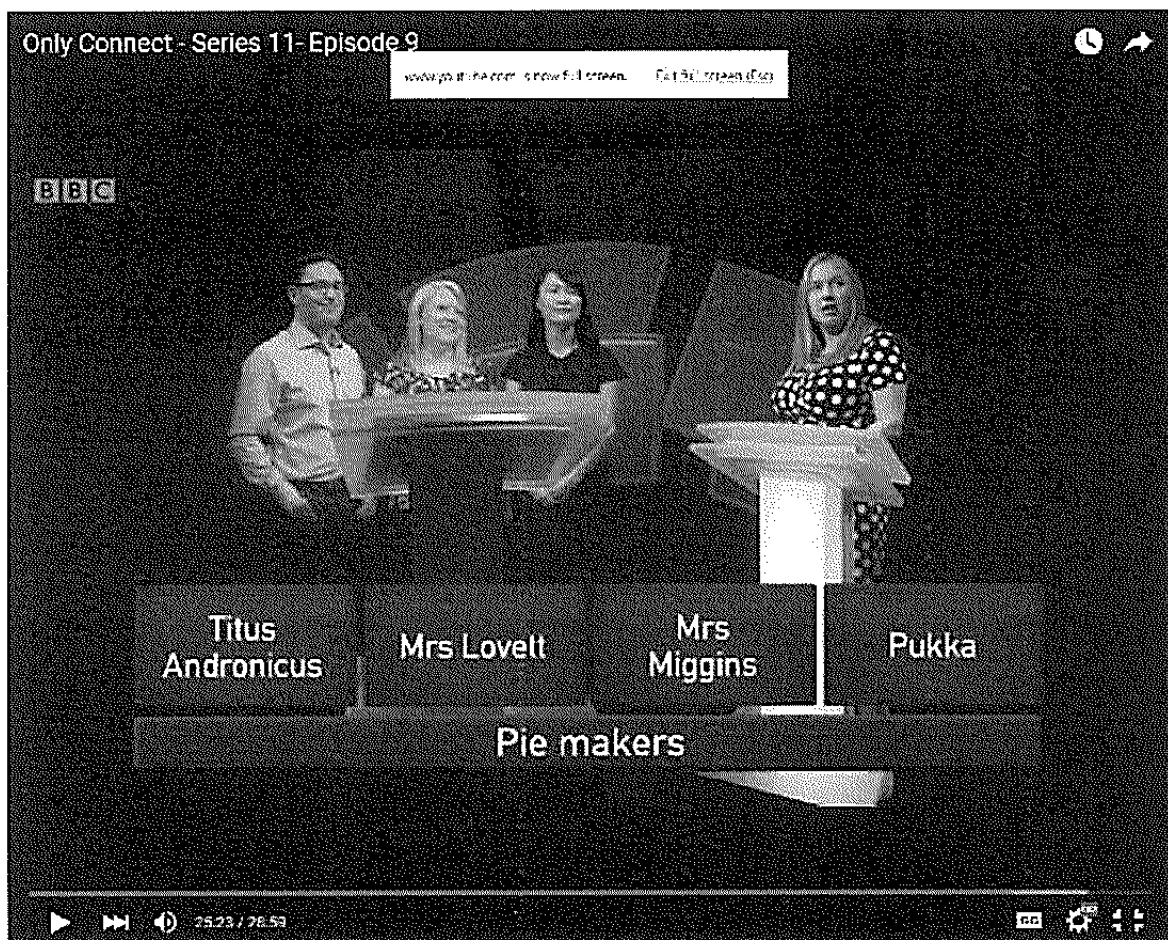
2009). A 5-week national television advertising campaign ran in early 2011: “Have a Pukka Pie Day”, and another in Spring 2014: “Next Time Pick a Pukka Pie”. In September 2015, PUKKA was used as a clue to identify the answer ‘pie makers’, connecting all the clues, in the BBC2 programme *Only Connect*. Ms Bouch states:

“As the last of four clues provided, ‘PUKKA’ was intended to be the easiest clue available to the contestants and again demonstrates that the mark PUKKA is widely recognised and reputed as an iconic British brand”:

BBC 2 Only Connect – Series 11 Episode 9 - 7 September 2015

Only Connect is a British quiz show presented by Victoria Coren Mitchell. It aired on BBC Four from 15 September 2008 to 7 July 2014 and then moved to BBC Two from 1 September 2014. In the series, teams compete in a tournament of finding connections between seemingly unrelated clues. (https://en.wikipedia.org/wiki/Only_Connect)

Episode No.	Airdate	Viewers	BBC Two Weekly Ranking
9	7 September 2015	2,417,000	4



25. Ms Bouch states that Pies' Twitter page has over 11,000 followers and its Facebook page has over 11,740 'likes'. Pies uses social media to promote its products (Exhibit 23).

26. Mr Ferdinand's witness statement is dated 22 March 2016. He exhibits excerpts from K and K's website, pukkahakka.co.uk. Exhibit JF2 consists of prints from a section of the website called 'The Story Behind The Food'. It says that HAKKA is a term commonly used to refer to Indo-Chinese fusion food, the Hakka people having originated in South-East China. The menu includes Hakka Squid and Hakka Noodles. Mr Ferdinand submits that HAKKA is a descriptive term for such food and that PUKKA would, therefore, be viewed by customers as the dominant and most distinctive part of the applicant's mark.

27. Mr Khan's first witness statement is dated 1 February 2016. His evidence is about the alleged descriptiveness of 'pukka'. Exhibit BK1 comprises prints of online dictionary references for 'pukka', obtained in 2016. The reference in oxforddictionaries.com gives three meanings: (i) that it is an informal word meaning genuine; (ii) it refers to appropriate (as in "it wouldn't be considered the pukka thing to do"); and (iii) it means excellent. The reference in dictionary.cambridge.org gives three meanings: (i) that it is an old-fashioned word meaning real; (ii) that it is slang for excellent quality and (iii) that it means extremely formal and educated. The reference in Collins Dictionary gives two meanings: (i) properly or perfectly done; and (ii) genuine.

28. Exhibit BK 2 is a copy of an article from prospect.magazine.co.uk entitled "How we got pukka". The article is dated 28 June 2013. The writer explains that the word was introduced into the English language during the days of British Colonial rule in India, and that the "present-day British English slang use of "pukka" is a true definition. People all over Britain use the word, all the time, to mean solid, trustworthy, sure", referring to the definition in the Oxford English Dictionary.

29. Mr Khan exhibits prints from Pies' website (Exhibit BK4, printed on 14 May 2015) which he states shows PUKKA being used descriptively to indicate the quality

of its pies. The prints are from the section of the website which relates to the quality of Pies' goods and they are entitled "Welcome to Pukka Pies- Pukka Quality". Exhibit BK5 is a copy of a newspaper article, dated 26 January 2016, which Mr Khan states was published on insidemedias.com. The article is entitled "Pukka Year for Pie Maker". An undated print which Mr Khan states is from the website called britishcornershop.co.uk says "The English word 'pukka' means genuine, and Pukka Pies really lives up to their name."

30. Exhibit BK7 is a copy of an article dated 19 May 2014 which Mr Khan states is from getwestLondon. The article is entitled "Jamie Oliver helps young record-breakers prepare some pukka food." The text of the article says "Pupils prepared some pukka food as they took part in a cooking lesson led by Jamie Oliver". Exhibit BK8 is an undated screenshot from a Nottingham Indian restaurant's website. The screenshot lists the types of food available and says "Pukka food to takeaway!" Exhibit BK9 is a print from a blog run by a man named Paul Helsby, who describes a visit to Jamie Oliver's restaurant in Cornwall (in 2006) as a 'Pukka evening', with 'Pukka food'. Exhibit BK10 is a copy of an article dated 21 February 2014 in thisiswiltshire.co.uk, entitled "Jamie's [Oliver] menus a pukka way to healthy meals". Exhibit BK11 is a copy of an undated restaurant review on Tripadvisor: "The most pukka food in Coleshill".

31. Exhibit BK12 is a copy of a page printed on 27 January 2016 from a website called yoganearby.com, giving details of a yoga class in London. The class is called Pukka Yoga. Exhibit BK13 is a copy of a page printed on 27 January 2016 from a website called pukatents.co.uk:



Superior Canvas Bell Tents...
Luxury Outdoor Living

Shopping Basket
0 item(s) - £0.00

Search

HOME

SHOP

WHY PUKKA?

NEWS/BLOG

FAQS

CONTACT US

What's Pukka?

Pukka, Pucka, Pukkah: an Anglo-Indian word meaning genuine, authentic, superior, first class, properly or perfectly done/constructed.

Tent: portable shelter or dwelling of canvas cloth, supported by poles and stretched by cords secured to pegs driven into ground.

A Pukka tent: a superior quality canvas tent that is easy to erect, durable - and great fun!

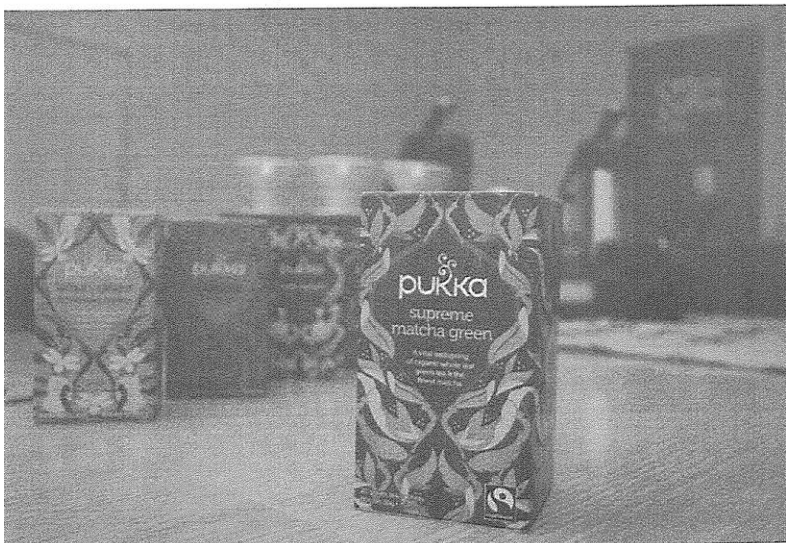
[see our range of tents](#)

32. Exhibit BK14 is a print from a website called Office Coffee Co., explaining that it will be selling Pukka herbal teas (the information was posted on the website on 6 January 2016):

The Office Coffee Company introduces Pukka Herbal Teas

Roll in the New Year when we traditionally make resolutions to detox and improve our health. Why not take a look at our 100% Organic range of Pukka Herbal Teas.

[BACK TO POSTS \(HTTP://WWW.OFFICE-COFFEE.CO.UK/BLOG/CATEGORY/TEA\)](http://www.office-coffee.co.uk/blog/category/tea)



33. Exhibit BK15 is a print from website called wildernessfestival.co.uk, which relates to an event in Oxfordshire from 4 to 7 August 2016. The page says:

“We are thrilled to be partnering up with the most pukka of all teas on the market. Pukka Herbs create delicious organic herbal teas and incredible health supplements that take you on a journey to a healthier, happier life. ‘Pukka’ means authentic and it’s at the heart of everything they do. Created by their master herbalist, Pukka Herbs only use the finest grade organic herbs sustainable sourced and fairly traded.”

34. Mr Khan’s second witness statement is dated 26 May 2016. It is identical to his first statement except that there is an extra exhibit, BK16. This comprises a page from the examination report for K and K’s application (for PUKKA HAKKA) which shows the refusal (under section 3(1)(b) of the Act) of the mark on the grounds that PUKKA is “non-distinctive for foods being authentic Hakka foods, or for services relating to the cooking or serving of pukka/authentic or excellent Hakka cuisine”. The report states that “Pukka would be readily understood to mean authentic/excellent.”³

35. Ms Bouch’s second witness statement is dated 4 May 2016. Some of it is the same as her first statement. Ms Bouch states that Pies sells to 775 fish and chip shops and other types of takeaway in the UK. Exhibit 24 provides a list of the outlets. She states that the number is actually in the thousands because Pies also sells its goods to 279 agents (listed in Exhibit 24) who then distribute them to more outlets.

36. Exhibit 25 is an email from Steven Evans, whom Ms Bouch states is a buyer at ASDA. The email is dated 4 May 2016 and has been solicited for the proceedings. It is not in evidential form and so is hearsay. Mr Stevens says Pies’ products are available in ASDA stores across the UK and he is unaware of other traders using PUKKA in relation to food products.

³ The objection raised *ex officio* was later waived and the mark accepted for publication (for opposition purposes).

37. Pies has also filed a witness statement, dated 29 April 2016, from Gregg Howard, President of the National Federation of Fish Friers Ltd (“NFFF”), which is the leading UK trade association for the fish and chip shop trade. Mr Howard states that Pies is an Associate Member of NFFF and is a regular supplier of pies and pasties to fish and chip shops throughout the UK under the trade mark PUKKA. This evidence also appears to have been solicited for the proceedings.

38. Mr Ferdinand’s second witness statement is dated 4 May 2016. Exhibit JF3 is a copy of the official IPO files for trade mark registrations 1350917 and 1350918 (both PUKKA). To overcome the examiner’s objection to the applications for these two trade marks, Pies filed evidence, which is included in Exhibit JF3. The evidence, which came from Pies’ founder, Trevor Storer, shows that PUKKA had been used for about 25 years by the time the applications were filed on 8 July 1988, with turnover figures between 1984 and 1988 of about £5 million per year. I note that the examiner said in correspondence with Pies’ attorneys that “although PUKKA is “in some way a laudatory term, it is no longer in current use”. The examiner allowed the applications to proceed to registration on the basis of the evidence (in what was then Part B of the register). By contrast, no laudatory objection was raised by the examiner in 2001 to 2271175 (PUKKA), although the Collins dictionary definition (1994 Edition) was identified, according to the copy of the official file in Exhibit JF4. Similar evidence is referred to in Mr Ferdinand’s third witness statement, dated 15 September 2016. Exhibit JF5 comprises the examination reports issued in respect of Pies’ trade mark applications which are opposed by K & K (PUKKA, PUKKA BAKERY and PUKKA FOOD). The reports shows that no absolute grounds objections to Pies’ applications were raised by the examiner and that the search reports flagged up other ‘Pukka’ trade marks have been accepted for registration by the IPO and the EUIPO. Mr Ferdinand also points out that K & K’s application for PUKKA HAKKA was initially refused on absolute grounds.

39. Ms Bouch’s third witness statement, dated 14 September 2016 repeats information contained in her first and second statements.

40. Pies has filed a witness statement dated 2 September 2016 from Neill Keen, a partner at Foska.com LLP, the company referred to in Ms Bouch’s first statement as

making cycling clothing. Mr Keen states that his company has produced cycling jerseys featuring well-known brands including Marmite, Heinz Baked Beans, Irn-Bru, Tyrrell's and Colman's Mustard, as shown in Exhibit NK1. Mr Keen's company signed an agreement with Pies in 2012 to use Pies' branding on its cycling clothing. Mr Keen states that his company approached Pies because Pies' PUKKA mark was so well-known in the market. He states that "to date" his company has sold about 1000 PUKKA-branded cycling jackets and jerseys (shown in Exhibit NK2).

41. Mr Ferdinand's fourth witness statement is dated 5 December 2016. He refers to an invalidity action filed by K & K against Pies' EUTM 2729085 PUKKA on absolute grounds, on the same as in the current proceedings. Mr Ferdinand exhibits a copy of the EUIPO cancellation division's decision, which dismissed the action (and which was not appealed). Exhibit JF6 contains a copy of the decision, from which I note that the application for invalidation failed by default because K & K filed no evidence to support their claims. The substance of the claims was not, therefore, considered.

42. Mr Ferdinand comments that K & K's evidence of third parties using 'Pukka' is trade mark use. Exhibit JF7 is an extract from the website of Pukka Tents, where Pukka Tents is used, as well as Pukka Canvas Awnings, and "More High Quality Products from Pukka". Exhibit JF8 contains an extract from the website of Pukka Herbs Limited, which shows website tabs called 'Pukka Planet' and 'Everything Pukka', in addition to the Pukka logo which is reproduced at paragraph 31 of this decision.

Decision

43. I will begin with K & K's applications for declarations of invalidity and their oppositions against Pies' three registrations and three applications for registration. The marks, their application dates, registration dates and specifications are shown below:

(i) PUKKA: 3109437 (opposition number 405248), filed on 21 May 2015 for a wide range of goods and services, as follows:

Class 9: *Computer software, computer hardware; data storage devices; educational apparatus and simulators; apparatus and instruments for accumulating, controlling and storing electricity; data processing equipment and accessories; audio visual and photographic devices; communications equipment; alarms and warning equipment; access control devices; signaling apparatus; protective and safety equipment; navigation, guidance, tracking, targeting and map making devices; measuring, detecting and monitoring instruments, indicators and controls; monitoring instruments; sensors and detectors; testing and quality control devices; measuring, counting, alignment and calibrating instruments; controllers; advertising display apparatus, mechanical or luminous; apparatus and instruments for weighing; apparatus, instruments and cables for electricity; articles of protective clothing for wear for protection against accident or injury; automatic cash registers; protective footwear; electronic bulletin boards; illuminated bulletin boards; calculators; cases adapted for smart phones and tablet computers; coin-operated mechanisms; communication equipment; compact discs; computer components and parts; computer discs; computer networking and data communication equipment; corrective eyewear; data loggers and recorders; optical and magnetic data media; databases; digital signage; digital media recorders; display devices; downloadable electronic publications, image files, music files; graphics for mobile phones; ring tones for mobile phones, video game programs; DVD's; electric signs; electronic blackboards; electronic data carriers; electronic indicating boards and panels; eye protection; face protection shields; fluorescent screens; games software; gloves for protection against injury and accidents; goggles; graphic display terminals; display screens; image capturing and developing devices; information technology and audio visual equipment; instruments for temperature control; machine readable data carriers; media content; measuring spoons; mobile data communication apparatus; monitors; mouse mats; headphones; noise cancelling apparatus; optical devices; optical data storage devices; optical data media, data carriers; ornamental magnets; peripherals adapted for use with computers, tablets and smart phones; protection masks; protective goggles; protective glasses; protective headgear; recorded content; reflective clothing for the prevention of accidents; remote control apparatus; safety caps; safety apparatus for the prevention of accident or injury; safety signals luminous and mechanical; smart phones; sport bags adapted to protect protective helmets; sports eyewear; sports helmets; sports training simulators; tablet computers; telecommunication apparatus; teaching apparatus and instruments; temperature controllers; temperature display units; temperature gauges; temperature indicators; temperature measuring instruments; temperature sensors; testing apparatus for diagnostic purposes; testing apparatus not for medical purposes; thermometers not for medical purposes; time measuring*

instruments not including clocks and watches; touch pads; pads, panels, screens; USB flash drives; flash drives; wireless computer peripherals; all parts, fittings, accessories for the aforesaid goods.

Class 11: Burners; boilers; heaters; convector heaters; electric cookers; electric heaters; electric stoves; electric heating elements; fittings, shaped for ovens; heating apparatus; heating apparatus and installations; hot air apparatus; apparatus for lighting; lightbulbs; lamps; lights; lighting apparatus; luminaires; torches; cookers; ovens; deep fryers; electric heating appliances; electric cooking appliances; food warmers; gas cooking appliances; heated cabinets for foodstuffs; heated display cabinets, cases, units, trays; microwave ovens; chilling apparatus; cooling apparatus; freezing apparatus; refrigerated food dispensing units; refrigerated food display apparatus; sanitary installations, water supply and sanitation equipment; lighting and lighting reflectors; food and beverage cooking, heating, cooling and treatment equipment; refrigeration and freezing equipment; igniters; all parts, fittings and accessories for the aforesaid goods.

Class 25: Clothing; footwear; headgear; hats; shoes; caps; boots; aprons; arm warmers; sports clothing; outerwear; underwear; cyclist clothing; gloves; scarves; neckwear; leisurewear; overalls; sleepwear; swimwear; waterproof clothing; wristbands; all parts and fittings of the aforesaid goods.

Class 28: (Sporting articles and equipment;) toys; games; playthings and novelties; apparatus for games; bean bags in the form of playthings; balloons; board games; cards; dartboards; dice; gaming machines; gaming tables; tables for indoor football; fancy dress clothing; model vehicles; nets and ball games, paper hats (party novelties); puzzles; sledges (playthings); video game apparatus; festive decorations; balls; apparatus for playing hockey; apparatus for playing basketball; apparatus for playing football; apparatus for playing rugby; protective padding for sports; punch bags; cases adapted for sporting articles; all parts, fittings and accessories of the aforesaid goods.

Class 29: Meats; fish; seafood; molluscs; dairy products; egg products; eggs; processed fruits, fungi and vegetables; nuts and pulses; jellies; jams; compotes; fruit and vegetable spreads; prepared meals; soups and stocks; snack and desserts; bacon; beef; burgers; chicken; poultry; game; ham; sausages; sliced meats; cheese; butter; milk; dairy substitutes; yoghurt; edible fats and oils; beans; seeds; nuts; lentils; prepared, processed and cooked fruit and vegetables; chilled food consisting predominantly of the aforesaid goods, cooked,

prepared and processed potatoes; vegetarian sausage; vegetarian burgers, stews; soups; fruit based snack foods; soya based snack foods; prepared salads; potato based snack foods; dairy based snack foods; meat based snack foods; cooked dishes consisting primarily of the aforesaid goods; pre packaged dinners consisting of the aforesaid goods; prepared meals consisting principally of the aforesaid goods; ready cooked meals consisting wholly or substantially of the aforesaid goods.

Class 30: Baked goods; starches and goods made thereof; baking preparations and convenience food and savoury snacks; cereals; doughs, batter and mixes thereof; dried and fresh pasta, noodles and dumplings; yeast and leavening agents; pastries; cakes; tarts; biscuits; cookies; puddings; pastries; pastry; pastry sheets; chilled or frozen pastry stuffed with meat, poultry, game, fish, vegetables or cheese; fruit filled pastry products; pies; pasties; pastries containing cream and/or fruits; pastry cases; pastry confectionery; pastry dough; pastry shells; puff pastry; prepared pastry desserts; shortcut pastry; bread; gluten free pastry; gluten free bread; essences for use in food preparation; savoury food flavourings; spices for use in food stuffs; savoury sauces; chutney and pastes; vinegars; cereal based snack foods; sandwiches; dry or liquid ready to serve meals, mainly consisting of pasta and rice; pizzas; filled rolls; hotdogs; meals consisting primarily of rice and pasta; pastries consisting of vegetables, fish, meat, poultry, game or cheese pies; pies containing meat, game, fish, poultry, vegetables and cheese; prepared foodstuffs in the form of sauces; pre-packed lunches consisting primarily of pastry and also including meat, poultry, game, fish, vegetables or cheese; quiches; rice based snack foods; sausage rolls; snack products made from cereals; rice or grain; snack foods consisting principally of bread; stuffed breads; wheat based snack foods.

Class 35: Retail services in relation to musical instruments, textile goods in particular furnishings, handkerchiefs, bedding, cushion covers, curtains and blinds, bean bags, hand tools, cutlery, household and kitchen utensils and containers, tableware, cookware, cleaning articles, bathroom articles, articles for animals, articles for clothing, footwear, headgear; brushes; commercial trading and commercial information services; business assistance, management and administrative services; advertising, marketing and promotional services; business management; business profession services; compilation productions and distribution of advertising material; developing promotional campaigns for businesses; electronic billboard advertising; hiring of advertising and publicity materials; provision and updating of advertising packs; loyalty, incentive and bonus services; marketing the goods and services of others; product demonstration and product display services; promotional services; promoting services of others; rental of coin and card operated vending machines;

advertising, including promotion of products and services of third parties through sponsoring arrangements and license agreements relating to international sporting events; business consultancy and advisory services; business advisory services in relation to the reduction of carbon footprint and charitable contributions to food banks; collection and systemisation of business data; database management; promoting the sale of goods and services of others; distribution and promotion for distribution of printed material; online advertising the goods of other vendors, enabling customers to conveniently review and compare the goods of these vendors; all information, advice and consultancy in respect of the aforesaid services.

Class 41: Education; entertainment; sports and fitness; publishing and reporting, electronic publications; electronic publications (non-downloadable); online publication of electronic books and journals (non-downloadable); provision of leaflets, magazines, manuals, educational printed matter, educational teaching materials, brochures, periodicals, posters, printed matter and texts; publishing by electronic means; conferences, exhibitions and competitions; education and instructions; sporting and recreational activities; recreational and training services; provision of sporting events, competitions, organising and arranging; all information, advice and consultancy in respect of the aforesaid services.

Class 43: Rental of furniture, linens and table settings; provision of food and drink; catering; bars; cafes; cafeterias; catering services; cookery; rental of cookery apparatus; corporate hospitalities; food preparation; rental of food service apparatus; hospitality services; mobile catering services; pubs; rental of cooking apparatus and utensils; rental of food service apparatus and equipment; restaurants; snack bars; tea rooms; takeaway services; rental of lighting apparatus; nurseries; guest houses; hotels; hostels; camp ground facilities; holiday accommodation; all information, advice and consultancy in relation to the aforesaid services.

(ii) PUKKA BAKERY: 3139755 (opposition number 406396), filed on 8 December 2015 and

(iii) PUKKA
FOOD

3139748 (opposition 406397), filed on 8 December 2015. Both of these applications were filed for the following goods and services:

Class 29: Meats; fish; seafood; molluscs; dairy products; egg products; eggs; processed fruits, fungi and vegetables; nuts and pulses; jellies; jams; compotes; pickles; fruit and vegetable spreads; prepared meals; soups and stocks; snack and desserts; bacon; beef; burgers; chicken; poultry; game; ham; sausages; sliced meats; cheese; butter; milk; dairy substitutes; yoghurt; edible fats and oils; beans; seeds; nuts; lentils; prepared, processed and cooked fruit and vegetables; cooked, prepared and processed potatoes; vegetarian sausage; vegetarian burgers; stews; soups; prepared salads; snack foods, cooked dishes, chilled food, pre packaged dinners, prepared meals and ready cooked meals consisting wholly or substantially of all the aforesaid goods.

Class 30: Baked goods; starches and goods made thereof; baking preparations and convenience food and savoury snacks; cereals; rice; grains; doughs, batter and mixes thereof; dried and fresh pasta, noodles and dumplings; yeast and leavening agents; sausage rolls; stuffed breads; pastries; cakes; tarts; biscuits; cookies; puddings; cereal bars and energy bars; desserts; pastry; pastry sheets; chilled or frozen pastry stuffed with meat, poultry, game, fish, vegetables or cheese; pies; pasties; pastry cases; pastry dough; pastry shells; puff pastry; fruit filled pastry products; pastries containing cream and/or fruits; pastry confectionery; prepared pastry desserts; shortcut pastry; bread; gluten free pastry; gluten free bread; savoury essences for use in food preparation; savoury food flavourings; spices for use in food stuffs; savoury sauces; chutney and pastes; vinegars; pastries consisting of vegetables, fish, meat, poultry, game or cheese; quiches; pies containing meat, game, fish, poultry, vegetables and cheese; sandwiches; dry or liquid ready to serve meals, mainly consisting of pasta and rice; pizzas; filled rolls; hotdogs; prepared foodstuffs in the form of sauces; prepared meals and snack foods consisting wholly or substantially of all the aforesaid goods; gluten-free snack foods and prepared meals consisting wholly or substantially of all aforesaid goods; pre-packed lunches consisting primarily of pastry and also including meat, poultry, game, fish, vegetables or cheese.

Class 43: Rental of furniture, linens and table settings; provision of food and drink; catering; bars; cafes; cafeterias; catering services; public houses; bakeries; rental of cookery apparatus; corporate hospitalities; food preparation; rental of food service apparatus; hospitality services; mobile catering services; pubs; rental of cooking apparatus and utensils; rental of food service apparatus and equipment; restaurants; snack bars; tea rooms; takeaway services; rental of lighting apparatus; all information, advice and consultancy in relation to the aforesaid services.

(iv) PUKKA: 1350917 (cancellation 500981), filed on 8 July 1988 and registered on 3 July 1992 for *Sausages; potato, cheese and onion slices; all included in Class 29.*

(v) PUKKA: 1350918 (cancellation number 500982), filed on 8 July 1988 and registered on 3 July 1992 for *Meat and vegetable pies; meat and vegetable pasties; non-meat pies; pastry; sausage rolls; all included in Class 30.*

(vi) PUKKA: 2271175 (cancellation number 500983), filed on 26 May 2001 and registered on 9 November 2001 for:

Meat; fish, poultry and game, none being live; all for human consumption; food products included in Class 29 containing the aforesaid goods; dairy products; food preservatives; pickles; cooked vegetables; soups; prepared salads; prepared meals and snack foods; sausages; potato, cheese and onion slices; all included in Class 29.

Meat and vegetable pies; meat and vegetable pasties; non-meat pies; pastry; sausage rolls; cheese and onion slices; kebabs; prepared meals and snack foods; all included in Class 30.

44. The grounds of opposition are sections 3(1)(b) and (c) of the Act. These are also the grounds in the invalidity actions, raised by way of section 47(1) of the Act:

“(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.”

45. Sections 3(1)(b) and (c) of the Act state:

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

- (a)
- (b) trade marks which are devoid of any distinctive character,
- (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.”

46. Both parties have filed evidence relating to the same third-party use of PUKKA, but for different purposes. K & K maintain that the evidence from the PUKKA TENTS and PUKKA HERBAL websites shows descriptive use of PUKKA, meaning genuine and/or excellent. I agree with Pies that some of the use filed in relation to the third parties appears to be trade mark use, which is not, of itself, evidence of descriptive use. This was explained in *Nude Brands Ltd v Stella McCartney Ltd*, [2009] EWHC 2154 Ch. Floyd J. stated that:

“29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in

trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c).”

Equally, the mere fact that other parties use PUKKA as a brand name or trade mark does not mean that the word is not descriptive. The parties’ evidence about third party use is equivocal. I also find Exhibit BK4 from Pies’ website – “Welcome to Pukka Pies – Pukka Quality” to be equivocal. One could equally read that as trade mark use; e.g. Tesco Quality.

47. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch):

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R.

9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-

2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article

7(1)(c) of Regulation No 40/94 , the terms ‘the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service’, the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word ‘characteristic’ highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

48. The evidence which relates to acceptances and refusals of various applications containing PUKKA is of little assistance. I must consider the matter at the various application dates for the registered and opposed marks, in the *prima facie* and on the basis of evidence of use.

49. There is no doubt that PUKKA appears in the dictionary and that the meanings given are consistent in the dictionary extracts that have been provided as evidence (genuine, excellent, proper/appropriate). It does not automatically follow, however, that because a word is in the dictionary the average consumer will be aware of the meaning(s): see the decision of Mr Iain Purvis QC, sitting as the Appointed Person in *Harlequin Shellac* BL O/500/14, at paragraph 31:

“(c) The presence of a word in a dictionary does not mean that the word would be known or recognised by the average consumer. A large number of words in dictionaries are completely unknown save to a tiny number of specialists or to Scrabble experts. Similarly, where a word has a number of definitions, it cannot be assumed that all such definitions are equally well-known.”

50. K and K have also filed evidence showing ‘pukka’ used in press articles. Context is important when considering such evidence. In *Wunderkind Trade Mark* [2002] R.P.C. 45, the High Court upheld the Registrar’s Hearing Officer, who had found that despite a small number of UK press articles using the word, the average consumer in the UK was unlikely to know what it meant (‘child prodigy’). The Hearing Officer said, at paragraph 28:

“It may be that by 2001 the word ‘wunderkind’ had entered the English language to a sufficient extent that some journalists felt confident that, when used in a suitable context, the meaning of the word would be apparent to their readers. I do not believe that it is safe to infer from these articles that four years before they were written the average consumer of clothing in the U.K. would have readily, and without analysis, attached the meaning of ‘child prodigy’ to the word WUNDERKIND when presented with that word out of a context that invited such a meaning.”

51. K and K have provided seven press and social media extracts which appear to use pukka descriptively. This is not a large number if the word is as descriptive as K and K claim. The print from britishcornershop.co.uk is undated, as is the screenshot from the Nottingham Indian restaurant. Seeing as the word has Anglo-Indian origins, this evidence is perhaps unsurprising. The Tripadvisor evidence is also undated.

52. Three of the press and social media extracts (two press articles from 2014 and a copy from a blog dated in 2006) refer to ‘pukka’ in connection with the celebrity chef, Jamie Oliver. This suggests to me that Jamie Oliver has affiliated himself to the word, which does not show that it is in common use, nor what the average consumer takes the meaning to be when he uses it. The ‘How we got pukka’ article (dated 28 June 2013) refers to the word in use as a British slang word and that people all over Britain use the word “all the time”. If so, I would have expected to see more examples in the evidence. I do not know how widespread the readership is of ‘prospectmagazine’. The article was written by someone with an interest in etymology, an enthusiast for words and their origins. In my view, it would be unsafe to project this person’s reaction to the derivation of words onto the average consumer for Pies’ goods.

53. Taking, at face value, the author’s statement that ‘pukka’ is British slang throws up an issue which is inherent with all slang – slang fashions come and go. I note that the obituary of Pies’ founder, which was published in the *Telegraph* in 2013, refers to his wife’s suggestion that the name be changed to Pukka because it was “fashionable at the time, represented something that was top-notch” (my emphasis). That was in 1964. That it was “fashionable at the time” suggests to me that it went out of fashion at some point, other than perhaps in the context of Jamie Oliver. The lack of evidence showing descriptive use reinforces this impression. The relevant dates for consideration are the application dates for Pies’ registrations and applications, falling in the years 1988, 2001 and 2015. I find that K & K’s evidence falls short of showing that pukka would have been immediately understood at the relevant dates to denote a laudatory characteristic of the goods and services of Pies’ contested registrations and applications. The section 3(1)(c) objection fails. I also find that the objection fails under section 3(1)(b) because it is pleaded on essentially the same basis as for 3(1)(c); no other reason has been identified why the marks are devoid of any distinctive character⁴.

⁴ The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P).

Outcome of K and K's oppositions and invalidation applications

54. K and K's oppositions against 3109437, 3139755 and 3139748 all fail. Pies' applications may proceed to registration. K and K's applications for declarations of invalidity against registrations 1350917, 1350918 and 2271175 all fail. Pies' registrations may remain on the register.

Pies' opposition to K and K's application

Proof of use

55. Section 6A of the Act states

“(1) This section applies where—

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions 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.

(4) For these purposes—

(a) 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

(b) 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.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects—

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

56. The enquiry under section 6A of the Act is identical to that set out under section 46, the part of the Act which deals with the issue of revocation on the grounds of non-use, because both sections 6A and 46 cover genuine use of a mark. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] 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 added references to Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

[218] ...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

57. Section 100 of the Act states:

“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.”

58. K and K concedes that Pies has made genuine use of its PUKKA PIE registrations, UK2165594, UK2165661 and EU980946, except in relation to burgers, kebabs, chips, pastry and pastry products, burgers contained in bread rolls and kebabs contained in pitta breads. Only one of these registrations was included in the more limited range of earlier rights in relation to which Pies made submissions at the hearing: UK2165661, for PUKKA PIES/PUKKA-PIES (a series of two marks). The specification for this mark is:

Class 29: *Sausages; burgers; kebabs; chips.*

Class 30: *Pies; meat, non-meat and vegetable pies; steak and kidney pies; chicken and mushroom pies; beef and onion pies; potato and meat pies; pasties; meat, non-meat and vegetable pasties; Cornish pasties; beef and onion pasties; potato, cheese and onion pasties; sausage rolls; pastry and pastry products; puff pastry; burgers contained in bread rolls; kebabs contained in pitta breads.*

59. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand,

protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

60. I agree with K & K that Pies’ evidence does not show use of its marks on burgers, kebabs, chips, burgers contained in bread rolls and kebabs contained in pitta breads. Pies conceded at the hearing that there has been genuine use only on puff pastry, in relation to the term ‘pastry’. However, I consider it pernicky to cut out ‘pastry’, which is not a large category. In relation to ‘pastry products’, whilst there is no use on sweet pastry products, K and K accepts there is use on pies, whether savoury or sweet, pasties and sausage rolls. Therefore, Pies may rely upon earlier mark UK2165661 PUKKA PIES/PUKKA-PIES for the following goods:

Class 29: *Sausages.*

Class 30: *Pies; meat, non-meat and vegetable pies; steak and kidney pies; chicken and mushroom pies; beef and onion pies; potato and meat pies; pasties; meat, non-meat and vegetable pasties; Cornish pasties; beef and onion pasties; potato, cheese and onion pasties; sausage rolls; pastry and pastry products; puff pastry.*

61. The relevant period for proof of use is 9 May 2010 to 8 May 2015. Pies’ use consists almost entirely of its mark as registered under 2165594 (the orange version in the series):



62. Pies is also relying upon its PUKKA marks (without the word 'pies'). K and K have not conceded use of PUKKA by itself, only of the mark in the form shown in the previous paragraph. In assessing whether Pies may rely upon PUKKA, under the terms of section 6A(4)(a) of the Act, I bear in mind the following authorities which give guidance when considering use of variant marks. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act, which mirrors that of section 6A(4)(a), as follows:

"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 sub-questions, (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."

63. In *Hypen GmbH v EU IPO*, Case T-146/15, the General Court ("GC") held that use of the mark shown on the left below constituted use of the registered mark shown on the right. The court held that the addition of a circle, being merely a banal surrounding for the registered mark, did not alter the distinctive character of the mark as registered.



64. The court set out the following approach to the assessment of whether additional components are likely to alter the form of the registered mark to a material extent.

“28. ..a finding of distinctive character in the registered mark calls for an assessment of the distinctive or dominant character of the components added, on the basis of the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see judgment of 10 June 2010, *ATLAS TRANSPORT*, T-482/08, not published, EU:T:2010:229, paragraph 31 and the case-law cited; judgments of 5 December 2013, *Maestro de Oliva*, T-4/12, not published, EU:T:2013:628, paragraph 24, and 12 March 2014, *Borrajo Canelo v OHIM — Tecnoazúcar (PALMA MULATA)*, T-381/12, not published, EU:T:2014:119, paragraph 30).

29 For the purposes of that finding, account must be taken of the intrinsic qualities and, in particular, the greater or lesser degree of distinctive character of the [registered] mark used solely as part of a complex trade mark or jointly with another mark. The weaker the distinctive character, the easier it will be to alter it by adding a component that is itself distinctive, and the more the mark will lose its ability to be perceived as an indication of the origin of the good. The reverse is also true (judgment of 24 September 2015, *Klement v OHIM — Bullerjan (Form of an oven)*, T-317/14, not published, EU:T:2015:689, paragraph 33).

30 It has also been held that where a mark is constituted or composed of a number of elements and one or more of them is not distinctive, the alteration of those elements or their omission is not such as to alter the distinctive character of that trade mark as a whole (judgment of 21 January 2015, *Sabores de Navarra v OHIM — Frutas Solano (KIT, EL SABOR DE NAVARRA)*, T-46/13, not published, EU:T:2015:39, paragraph 37 and the case-law cited).

31 It must also be remembered that, in order for the second subparagraph of Article 15(1)(a) of Regulation No 207/2009 to apply, the additions to the registered mark must not alter the distinctive character of the mark in the form in which it was registered, in particular because of their ancillary position in the sign and their weak distinctive character (judgment of 21 June 2012, *Fruit of the Loom v OHIM—Blueshore Management (FRUIT)*, T-514/10, not published, EU:T:2012:316, paragraph 38).”

65. These findings indicate that the relative distinctiveness of the registered mark and the components added to (or omitted from) it in use are relevant factors to take into account in the required assessment. In this instance the addition of a circle around the registered mark was not sufficient to alter the distinctive character of the registered mark. The absence of the non-distinctive background upon which PUKKA-PIES appears is not sufficient to alter the distinctive character of the registered mark. The absence of the word PIES, in relation to goods which are pies, also does not alter the distinctive character of the mark because PIES is non-distinctive and descriptive of goods registered under PUKKA which are pies, or very similar to pies (slices, pasties and sausage rolls), i.e.:

Potato, cheese and onion slices; meat and vegetable pies; meat and vegetable pasties; non-meat pies; sausage rolls; cheese and onion slices.

66. However, in relation to the other goods for which the PUKKA marks are registered, PIES is not devoid of any distinctive character. Its absence therefore alters the distinctive character of the mark. I find that Pies may rely upon use of PUKKA in relation to *potato, cheese and onion slices; meat and vegetable pies; meat and vegetable pasties; non-meat pies; sausage rolls; cheese and onion slices.*

67. Where there is use of ‘PUKKA PIES DON’T COMPROMISE’, this phrase often appears some way from ‘Pukka Pies’. However, there are examples of use in the following manner:



68. Although much of the exhibits showing this mark are undated, the mark appears at the top of all the invoices in Exhibit 4, which are dated between 2010 and 2015 and list the goods for which K and K has conceded use of mark 2165661. It is reasonable to infer that there was use within these dates of the mark on the same goods and also on potato, cheese and onion slices, which appear on the invoices, but not upon the other goods in classes 29 and 30.

69. In addition to classes 29 and 30, PUKKA PIES DON'T COMPROMISE (registration 2353051) is registered in classes 35 and 43 for:

The bringing together for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in retail grocery stores and supermarkets, restaurants, cafés, snack bars and convenience stores; and

Provision of food and drink; bar services; restaurant and café services; preparation of foodstuffs or meals for consumption off the premises; snack bars services and snack bars; restaurant services for the provision of fast food.

70. Although Pies sells its goods in grocery stores, supermarkets and convenience stores, it is not Pies which is providing the retail service to the customer. In *Tony Van Gulck v Wasabi Frog Ltd* (“Miss Boo”), BL O/391/14, Mr Geoffrey Hobbs, sitting as the Appointed Person, cautioned that “selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35”. The objective of retail services, as set out in *Oakley*, “includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction” and “those services play, from the point of view of the relevant consumer, an important role when he comes to buy the goods offered for sale.” Pies is not offering such a service in grocery shops. As Mr Evans from Asda and Mr Howard state, Pies is a supplier to Asda and to fish shops. Nor does a vending

machine or a display cabinet bearing the trade mark inside a chip shop which has a third party trading name qualify as a retail service under the mark for the reasons set out in *Miss Boo*. The photographs of the takeaway kiosks at the football stadia are undated and do not show the mark: they show the PUKKA-PIES mark for which K and K has conceded use. However, the latter mark is not registered in classes 35 or 43. I find, therefore, that Pies may not rely upon its PUKKA PIES DON'T COMPROMISE mark in relation to the services in classes 35 and 43.

Section 5(2)(b) of the Act

71. Pies does not have to prove use of its PUKKA PIE DAY and PUKKA CURRY SAUCE marks because these had been registered for less than five years on the date when K and K's application was published. Pies may, therefore, rely upon these two marks across the range of registered goods and services, in addition to the limited goods for which it has proven genuine use. Pies also relies upon EUTM 2729085, PUKKA, which is subject to proof of use. However, this mark does not put it in any better position than 2271175, for which I have found genuine use for some of the goods.

72. Section 5(2)(b) of the Act states:

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

(a) ...

(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.”

73. 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

74. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where 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.”

75. ‘Complementary’ was defined by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 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...”.

76. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

77. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

78. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [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.”

79. K and K’s application covers the following goods and services:

Class 29: Meat, fish, poultry and game; meat extracts; all types of preserved, dried, cooked, frozen and otherwise processed fruits and vegetables; cooked chicken on a stick; ready meals, namely ginger chicken, chicken soup, chinky jeera chicken, pepper chicken, fried chicken, tai pai chicken, kung pao chicken, chicken sapo, mixed vegetable sapo and baby lamb ribs; prawns; squid; preserved, frozen, dried and cooked vegetables; stir fried broccoli; vegetable chop suey; jellies namely meat, fish, fruit and vegetable jellies, calves' feet jelly; gelatines; jams, compotes, preserves, fruit preserve, fruit marmalades, lemon curd, fig jam, cranberry sauce, minced meats and vegetable spreads; eggs, cheese, milk, milk products and other dairy products namely butter, yogurt, powdered milk for nutritional purposes; edible oils and fats; prepared meals; soups and preparations for making soups, cream of asparagus soup, cream of celery soup, cream of green pea soup, cream of mushroom soup, cream of spinach soup, cream of tomato soup, cream of chicken soup, mockturtle soup, oxtail soup, vegetable soup, Julienne soup, bouillon, consomme; potato crisps; dairy spreads; tinned brisling, brisling in tomato, brisling in oil; edible oils and fats, preserved olives and olive oil, Spanish Manzanilla olives, stuffed Spanish Manzanilla olives; pimentos; conserves; preserves and preserved food products namely meat, fish, fruit and vegetable preserves, foods preserved with vinegar, namely meat and poultry preserved in vinegar; bloater spread, kipper spread, salmon and anchovy spread, salmon and shrimp spread, spreads for sandwiches; pickles, onion salad, canned vegetable salad, fruit salad, vegetable juices for cooking, dried or preserved horseradish, horseradish prepared for making sauce, pickled walnuts, chow-chow relish, relish having a base of processed cucumbers and of processed corn; tomato products; sauerkraut; kidney beans and cooked and prepared beans, baked beans, baked beans with pork and tomato sauce, baked beans vegetarian with tomato sauce, prepared green beans; pastes and spreads for sandwiches consisting wholly or mainly of meat or fish or vegetables; snacks and prepared meals; foods and beverages in Class 29 made wholly or principally of any of the foregoing, including ready cooked meals consisting mainly of meat and vegetables and pre-packed meals; fish and seafood spreads; low fat dairy spreads; meat spreads; cheese dips; hot and sour soup; mann chow soup; sweetcorn soup; banana fritters; none of the aforementioned being herbs, herbal extracts, herbal remedies, herbal preparations and food supplements.

Class 30: Sauces; ketchup, tomato ketchup, gravy and gravy browning, sauces, spicy sauces, spicy mushroom sauce, Worcestershire sauce; sauces (condiments); condiments, salad cream, thick whip salad cream; mayonnaise; mayonnaise with pickles; prepared meals; canned sauces; soya sauces; pepper sauces; pizza sauces; chocolate sauces; salad sauces; curry sauces; fruit sauces; cooking sauces; horseradish sauces; spicy sauces; satay sauces; sauces [condiments]; savoury sauces; ready-made sauces; sauces for food; sauces containing nuts; fruit coulis [sauces]; sauces for rice; sauces for pasta; vegetable purees [sauces]; food dressings [sauces]; vegetable pastes [sauces]; tomato based sauces; sauces for chicken; mixes for preparing sauces; vegetable pulps [sauces - food]; sauces for barbecued meat; sauces for ice cream; sauces flavoured with nuts; sauces for frozen fish; sauces for use with pasta; savoury sauces, chutneys and pastes; preparations for making

up into sauces; flavourings in the form of dehydrated sauces; flavourings in the form of concentrated sauces; prepared foodstuffs in the form of sauces; none of the aforementioned being herbs, herbal extracts, herbal preparations and food supplements.

Class 35: Business consultancy services relating to the establishment and development of franchise operations; business advice relating to franchising; business advisory services relating to franchising; advisory services for the establishment and operation of franchises; franchising consultancy, namely consultancy relating to the management and organisation of franchises; information and consultancy regarding commercial franchises; provision of business services relating to franchising services; professional consultations relating to franchising; professional advisory services relating to franchising; provision of information relating to franchising; advisory services relating to publicity for franchisees; business advertising services relating to franchising; business assistance relating to franchising; franchisee recruitment; management advisory services related to franchising; consultancy and advisory services in relation to franchising; assistance in franchised commercial business management; promotional services and market research services relating to franchising; commercial administration of the licensing or franchising of the goods and services of others; drawing up a calendar of negotiations and meetings with companies and organisations active in the field of franchises; business research and business consultancy regarding the social impact of economic and political decisions in the field of franchises; research services relating to franchising; preparation of reports relating to franchising; administration of the business affairs of franchises; organising and conducting trade shows and exhibitions in relation to franchising; provision of business assistance in the operation of franchises; provision of business assistance in the establishment of franchises; assistance in business management within the framework of a franchise contract; none of the foregoing relating to the fields of Ayurveda, teas, infusions, herbs, herbal extracts, herbal remedies, herbal preparations or food supplements; advertising, marketing, publicity and promotional services; business management; business appraisals; business management assistance; business research, business enquiry and business investigation services; business administration; office functions; assistance in product and service commercialisation, within the framework of a franchise contract; recruitment services; services for the provision of statistical information; commercial or industrial management assistance; economic forecasting; market research; writing of publicity texts; operational management; commercial administration; economic and commercial consultancy in the field of legislative and regulatory development; lobbying for commercial purposes; negotiating conditions for members' participation in trade fair and exhibition associations; economic study and research; market research, market surveys and market analyses; advising commercial enterprises in the conduct of their business; business advice; business consultancy; business management assistance; business management and organisation consultancy; consultancy relating to business planning; consultancy relating to the establishment and running of businesses; consultancy relating to the management of personnel; consultancy relating to the selection of personnel; research services relating to setting up and running a business; organising and conducting trade shows and exhibitions in relation to business skills; retail services in connection with meat, fish, poultry and game, meat extracts, all types

of preserved, dried, cooked, frozen and otherwise processed fruits and vegetables, chicken spring rolls, cooked chicken on a stick, ready meals, namely ginger chicken, chicken soup, chinky jeera chicken, pepper chicken, fried chicken, tai pai chicken, kung pao chicken, chicken sapo and baby lamb ribs, prawns, squid, preserved, frozen, dried and cooked vegetables, stir fried broccoli, vegetable chop suey, jellies namely meat, fish, fruit and vegetable jellies, calves' feet jelly, gelatines, jams, compotes, preserves, fruit preserve, fruit marmalades, lemon curd, fig jam, cranberry sauce, minced meats and vegetable spreads, eggs, cheese, milk, milk products and other dairy products namely butter, yogurt, powdered milk for nutritional purposes, edible oils and fats, prepared meals, soups and preparations for making soups, cream of asparagus soup, cream of celery soup, cream of green pea soup, cream of mushroom soup, cream of spinach soup, cream of tomato soup, cream of chicken soup, mockturtle soup, oxtail soup, vegetable soup, Julienne soup, bouillon, consomme, potato crisps dairy spreads, tinned brisling, brisling in tomato, brisling in oil, edible oils and fats, preserved olives and olive oil, Spanish Manzanilla olives, stuffed Spanish Manzanilla olives, pimentos, conserves, preserves and preserved food products namely meat, fish, fruit and vegetable preserves, foods preserved with vinegar, namely meat and poultry preserved in vinegar, bloater spread, kipper spread, salmon and anchovy spread, salmon and shrimp spread, spreads for sandwiches, pickles, onion salad, canned vegetable salad, fruit salad, vegetable juices for cooking, dried or preserved horseradish, horseradish prepared for making sauce, pickled walnuts, chow-chow relish, relish having a base of processed cucumbers and of processed corn, tomato products, sauerkraut, kidney beans and cooked and prepared beans, baked beans, baked beans with pork and tomato sauce, baked beans vegetarian with tomato sauce, prepared green beans, pastes and spreads for sandwiches consisting wholly or mainly of meat or fish or vegetables, snacks and prepared meals, foods and beverages in made wholly or principally of any of the foregoing, including ready cooked meals consisting mainly of meat and vegetables and pre-packed meals, fish and seafood spreads, low fat dairy spreads, meat spreads, cheese dips, sauces, hot and sour soup, mann chow soup, sweetcorn soup, banana fritters; none of the aforementioned being herbs, herbal extracts, herbal remedies, herbal preparations and food supplements; retail services in connection with ketchup, tomato ketchup, gravy and gravy browning, sauces, spicy sauces, spicy mushroom sauce, Worcestershire sauce, sauces (condiments), condiments, salad cream, thick whip salad cream, mayonnaise, mayonnaise with pickles, prepared meals, canned sauces, soya sauces, pepper sauces, pizza sauces, chocolate sauces, salad sauces, curry sauces, fruit sauces, cooking sauces, horseradish sauces, spicy sauces, satay sauces, sauces [condiments], savoury sauces, ready-made sauces, sauces for food, sauces containing nuts, fruit coulis [sauces], sauces for rice, sauces for pasta, vegetable purees [sauces], food dressings [sauces], vegetable pastes [sauces], tomato based sauces, sauces for chicken, mixes for preparing sauces, vegetable pulps [sauces - food], sauces for barbecued meat, sauces for ice cream, sauces flavoured with nuts, sauces for frozen fish, sauces for use with pasta, savoury sauces, chutneys and pastes, preparations for making up into sauces, flavourings in the form of dehydrated sauces, flavourings in the form of concentrated sauces, prepared foodstuffs in the form of sauces; none of the aforesaid services relating to luggage.

Class 41: Education services; instruction services; tuition services; providing of training; education and training relating to the hospitality and catering industry; training services for franchisees; training services for franchisees in relation to the hospitality and catering industry and services; educational services relating to cookery; organisation of events, exhibitions, cultural activities, competitions and stage shows; production, presentation, rental and distribution of television and radio programmes, interactive entertainment, films, sound and video recordings and educational and instructional materials, including but not limited to the hospitality and catering industry; publication of books; providing online electronic publications (not downloadable); electronic games services provided by means of the Internet; amusements; night club services; information, advice and consultancy in respect of the aforesaid services; publishing training material and manuals; publishing training material and manuals concerning the management of hotels and restaurants; training in the management and running of hotels, restaurants, establishments or facilities for others; cookery demonstrations; demonstrations involving the culinary arts; provision of education and training in relation to franchising; professional advice relating to training and education in the franchising industry; professional advice relating to training and education in business skills; training in relation to business skills; education and training services relating to business franchise management; services provided to a franchiser, namely providing of basic training to the franchiser, his personnel, or to franchisees or the personnel of franchisees; services of publishing of books and manuals, particularly on paper support, audio or video support or on Internet, said books and manuals dealing with franchising, franchisors, franchisees and trademark licenses, including but not limited to the hospitality and catering industry; education and training services, namely, courses of instruction in the fields of news, current events news, broadcasting, advertising, marketing, public relations, publishing, new media and franchising; training in relation to finance; training in relation to human resources; training in relation to people management; publishing services; publication services; publication of newspapers, magazines, newsletters; publication of printed and educational material; providing online electronic publications (not downloadable); publication of electronic books and journals online; provision of news; provision of news online; production, presentation, networking, syndication, distribution and recording services; providing online information in the field of current news events; publication services namely, publication of books, newspapers, newspaper inserts, magazines, newsletters, directories, pamphlets, almanacs and journals in the fields of news, current events news, broadcasting, advertising, marketing, public relations, publishing, new media and franchising; entertainment; entertainment services; entertainment services relating to cookery; television entertainment services; sporting and cultural activities; information, advice and consultancy services relating to the aforesaid services; information, advice and consultancy services relating to the aforesaid services provided online via a local or global communications networks, including the Internet, intranets, extranets, television, mobile communication, cellular and satellite networks or other communications or telecommunications network.

Class 43: Services for providing food and drink; provision of food and drink in restaurants; restaurant, bar and catering services; restaurant and take-away services specialising in the provision of Far

Eastern and Indian cuisine; wine tasting (provision of beverages) services; food tasting (provision of food) services; delicatessens [restaurants]; grill restaurants; fast-food restaurants; self-service restaurants; provision of information relating to restaurants; bars; snack-bars; salad bars; wine bars; snack bar services; wine bar services; restaurant services incorporating licensed bar facilities; booking and reservation services for mobile bar services; mobile bar and mobile catering services; consultancy services relating to food preparation; restaurant reservation services; provision of food and drink via a mobile truck; arranging of meals in hotels; corporate hospitality (provision of food and drink); arranging of wedding receptions (food and drink); arranging of food and drink at wedding receptions; pubs; hotel services; temporary accommodation; hotel services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; crèche services.

80. Pies has opposed all of the goods and services of the application. Taking into account the marks focussed upon by Mr St Quintin, including the two marks not subject to proof of use, and taking into account my findings in relation to proof of use, Pies' goods which are to be compared to K and K's goods and services are listed below. In relation to the marks PUKKA PIES/PUKKA-PIES, PUKKA, and PUKKA PIES DON'T COMPROMISE, these are:

Class 29: Sausages; potato, cheese and onion slices.

Class 30: Pies; meat, non-meat and vegetable pies; steak and kidney pies; chicken and mushroom pies; beef and onion pies; potato and meat pies; pasties; meat, non-meat and vegetable pasties; Cornish pasties; beef and onion pasties; potato, cheese and onion pasties; cheese and onion slices; sausage rolls; pastry and pastry products; puff pastry.

In relation to the PUKKA PIE DAY and PUKKA CURRY SAUCE marks, these are:

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams; eggs, milk and milk products; edible oils and fats; dairy products; salad dressings; prepared salads; preserves; pickles; soups; fillings for sandwiches; food spreads consisting principally of vegetables for sandwiches; pieces of chicken for use as filling for sandwiches; preparations for sandwiches; snack foods; snack foods containing meat or vegetables; burgers; hamburgers; prepared meals; sausages; potato, cheese and onion slices; kebabs; chips; crisps; cooked potato with fillings; foodstuffs consisting wholly or principally of potatoes; foodstuffs in the form of fillings for potatoes; french fried potatoes; fried potatoes; hashed brown potatoes; stuffed potatoes; preparations containing potatoes; preparations for making mashed potatoes; savouries consisting of potatoes; snack food products made wholly or principally of potatoes; potato based snack food; potato

crisps in the form of snack food; potato snack food; prepared meals and snack foods; kebabs contained in pitta bread; food products included in class 29 containing the aforesaid goods.

Class 30: Coffee; tea; cocoa; sugar; rice, tapioca; sago; artificial coffee; flour and preparations made from cereals; bread; pastry and pastry products; puff pastry; frozen pastry; confectionery; ices; honey; treacle; yeast; baking-powder; salt; mustard; vinegar; sauces (except salad dressings); spices; ice; prepared meals and snack foods all included in class 30; sandwiches; filled sandwiches; food spreads for sandwiches; hamburger sandwiches; ice cream sandwiches; open sandwiches; sandwiches containing meat, fish, salad or vegetables; toasted sandwiches; snack foods; savoury snack foods; fresh pasties; pasties; meat; non-meat, balti, game and vegetable pasties; cornish pasties; beef and onion pasties; potato, cheese and onion pasties; pies; meat and non-meat pies; vegetable pies; game pies; steak and kidney pies; chicken and mushroom pies; beef and onion pies; potato and meat pies; balti pies; non-meat pies; sausage rolls; cheese and onion slices; burgers contained in bread rolls; food products included in class 30 containing the aforesaid goods.

81. In addition, PUKKA PIE DAY also covers the following services in Class 41:

Entertainment services; organisation of events, shows, games, competitions and contests; games, shows, competitions and contests provided online.

82. The law requires that goods and services be considered identical where one party's description of its goods or services encompasses the specific goods or services covered by the other party's descriptions (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, the GC. I find the following goods in the application to be identical to the goods of the PUKKA, PUKKA PIE, and PUKKA PIE DON'T COMPROMISE marks:

Class 29: prepared meals; snack and prepared meals; foods in Class 29 made wholly or principally of any of the foregoing, including ready cooked meals consisting mainly of meat and vegetables and pre-packed meals.

Class 30: prepared meals.

83. The class 29 specification of the PUKKA PIE DAY and PUKKA CURRY SAUCE marks ends with "food products included in class 29 containing the aforesaid goods." This term is widely cast. Food products containing the aforesaid goods cover all of

the goods which K and K have applied for in class 29. The goods of the application in class 29 are identical to those in class 29 as covered by the PUKKA PIE DAY and PUKKA CURRY SAUCE marks.

84. Prepared meals in class 30 of the application are identical to Pies' 'prepared meals and snack foods' in class 30 of the PUKKA PIE DAY and PUKKA CURRY SAUCE marks. The remainder of the class 30 goods in the application are all sauces. Pies' specification contains "sauces (except salad dressings)". These are identical to all of the sauces in the application, except for salad cream and mayonnaise; and, in relation to the latter, sauces, except for salad dressings, are highly similar to salad cream and mayonnaise, which are sauces for salads.

85. Pies' specification in class 41 for its PUKKA PIE DAY mark is *entertainment services; organisation of events, shows, games. competitions and contests; games, shows, competitions and contests provided online*. Following the *Meric* principle, these services are identical to K and K's *organisation of events, exhibitions, cultural activities, competitions and stage shows; production, presentation of television and radio programmes, interactive entertainment, films, sound and video recordings; electronic games services provided by means of the Internet; amusements; night club services; entertainment; entertainment services; entertainment services relating to cookery; television entertainment services; sporting and cultural activities*.

86. I will now compare the other goods and services of the application (i.e. those which are not identical) with the limited range of goods covered by the earlier marks subject to proof of use.

87. In *Sainsbury's Top Dog* BL O/044/16, Ms Emma Himsworth QC, sitting as the Appointed Person said (my emphasis);

"23. Firstly, Class 29 is concerned with goods, mainly foodstuffs of animal origin that have been prepared for consumption or conservation. 'Meat, fish, poultry' form a part of the class heading for Class 29 and it seems to me that *'hot dogs; meat products; meat pies; sausages; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29' are, as*

stated by the Opponent, a subset of the goods identified within the wording of the class heading. It does not seem possible to me to suggest otherwise.

24. Secondly, it does not seem to me that the reasoning behind the distinction drawn by the Hearing Officer between '*hot dogs; meat products; meat pies; sausages; hamburgers; beef burgers; poultry products; snack foods in Class 29; prepared meals in Class 29*' being goods '*which [are] ready to eat*' and '*Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29*' being goods '*which need further processing*' or are to be regarded as '*the "raw" food goods*' can be drawn in the way that is suggested by the Hearing Officer.

25. All of the goods within Class 29 have been prepared for consumption or conservation. It seems to me that '*Meat, poultry and game; meat extracts; mincemeat; constituents for meals in Class 29*' do not necessarily require further processing or indeed cooking before they are '*ready to eat*.'

Consequently, I find that K and K's *Meat, poultry and game* (but not fish) covers Pies' sausages and so these goods are identical.

88. Neither side have made much in the way of submissions about why they consider the goods to be similar or not similar. At a very general level, all the goods are foods and are eaten by the general public. This is not enough for a finding of similarity. The goods of the application are many and varied. The closest of them to Pies' goods are *cooked chicken on a stick; ready meals, namely ginger chicken, chicken soup, chinky jeera chicken, pepper chicken, fried chicken, tai pai chicken, kung pao chicken, chicken sapo, mixed vegetable sapo and baby lamb ribs* because they could all be eaten as a quick and easy type of meal. There may be an element of competition. However, their natures are different and there is nothing to suggest that the goods will be located close to one another in a retail environment. The goods are not complementary. The goods are similar to no more than a low degree.

89. I cannot see any similarity between the remainder of K and K's class 29 goods and Pies' goods. K and K's class 30 goods (except for those which I have already

found to be identical) are all sauces. They are not of the same nature, their purpose is different, they will be located in different parts of a store, there is no competition, and the goods are not complementary in the sense described by the case law. There is no similarity within the parameters of the caselaw between the parties' goods. They are not similar to Pies' goods.

90. In relation to K and K's class 35 services, the only possible similarity with Pies' goods lies with retail services in connection with the goods which I found were identical or similar. I referred earlier to the *Miss Boo* decision. I also bear in mind that in *Oakley, Inc v OHIM*, Case T-116/06, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and are therefore similar to a certain degree. In *Major League Baseball Properties, Inc v Giant UK Limited* ("*Giant*"), BL O/264/14, Ms Anna Carboni, sitting as the Appointed Person, considered *Oakley* in the context of a case involving the comparison of the retailing of bicycles against clothes. She said:

"44. I reject Mr Onslow's suggestion that complementarity can only be found where there is identity of goods with the subject goods of retail services, and only in those circumstances can the relevant goods and retail services be found to be similar. In my view, it must be a question of fact to be assessed in each case, as the Courts have done in countless cases, including the General Court in *Oakley* itself.

...

54. So far as complementarity is concerned, the hearing officer did not find this to exist between clothing and retail services for bicycles and bicycle accessories. So the only feature of similarity that he found was "the potentially common retail environment". Here, I go back to my earlier comments about the need for care when considering overlaps in distribution channels and sales outlets, due to the possibility of finding all sorts of otherwise quite different products and services being provided in one place. When it is possible to find products and services together, it is worth delving a bit deeper

and considering, for example, whether they are usually purchased together or whether one is needed for the use of the other. In this case, as Mr Onslow submitted, the purchase of cycle clothing is not indispensable or important to the purchase of a bicycle; their purchase is optional. While of course clothing is generally necessary to be worn when bicycling, it is not necessary to buy clothes at the same time or through the same outlets as the bicycle, and in any event the same could be said for virtually any other activity. The connection between the two is therefore at a very general level.

55. In my assessment, the fact that cycle clothing covered by the Earlier Mark might be offered through the same outlet as retail services for bicycles and bicycle accessories, whether specialist or more general outlets, cannot be enough to reach an overall finding of similarity in circumstances where the other *Canon* factors point quite strongly in the other direction (in the case of nature, purpose and method of use) or are absent (in the case of competitiveness or complementarity). While the requirement of similarity of goods/services – just like that of similarity of marks – is not a high one, the bar must not be set at an unduly low level.”

91. I take from these authorities that, in comparing retail services against goods, there may be some similarity based upon complementarity and shared trade channels; the goods do not have to be identical to the subject goods of the retail service; and that the level of similarity may be weak depending on the presence or absence of the other *Canon* factors. I find that there is an average degree of similarity between Pies’ goods and K and K’s *retail services in connection with meat, poultry and game, prepared meals, snacks and prepared meals, foods made principally of any of the foregoing including ready cooked meals consisting mainly of meat and vegetables and pre-packed meals*. I found that there was only a low level of similarity between Pies goods and K and K’s *cooked chicken on a stick, ready meals namely ginger chicken, chinky jeera chicken, pepper chicken, fried chicken, tai pai chicken, kung pao chicken, chicken sapo and baby lamb ribs*. The similarity becomes even weaker when considered in the context of retail services. I find that there is, at best, a very low degree of similarity between Pies’ goods and *retail services in connection with chicken spring rolls, cooked chicken on a stick, ready*

meals namely ginger chicken, chinky jeera chicken, pepper chicken, fried chicken, tai pai chicken, kung pao chicken, chicken sapo and baby lamb ribs. There is no similarity between Pies' goods and any of the other retail services, and no similarity between Pies' goods and the other services in class 35, which are all in the nature of business services.

92. There is also no similarity between the services of the application in Class 41 and Pies goods. I note that the class 41 specification includes, for example, education and training relating to the hospitality and catering industry, and to cookery. Bearing in mind the caselaw, there is no possible level of similarity here with Pies' *sausages; potato, cheese and onion slices; pies; meat, non-meat and vegetable pies; steak and kidney pies; chicken and mushroom pies; beef and onion pies; potato and meat pies; pasties; meat, non-meat and vegetable pasties; Cornish pasties; beef and onion pasties; potato, cheese and onion pasties; cheese and onion slices; sausage rolls; pastry and pastry products; or puff pastry.*

93. Pies' pies and pasties can all be eaten as snacks or as prepared meals. The average consumer may choose either to purchase food products from a shop and cook them at home or, alternatively, to go out for such food. There is, of course, an inherent difference between the nature of any good and the nature of a service (and different methods of use), but the purpose is similar in terms of both the goods and the services relating to the consumption of food, the channel of trade is shared and there is complementarity. There is a medium degree of similarity between Pies goods and the following class 43 services of the application:

Services for providing food; provision of food in restaurants; restaurant services; delicatessens [restaurants]; grill restaurants; fast-food restaurants; self-service restaurants; snack-bars; snack bar services; catering and mobile catering services; provision of food via a mobile truck.

94. Although I note that Pies has shown some use of its marks on 'balti pies' there would not seem to be any meaningful similarity between K and K's 'restaurant and take-away services specialising in the provision of Far Eastern and Indian cuisine' since such services do not, to my knowledge, routinely provide customers with

sausages, pasties, pies or pastry. There have been no submissions about the other class 43 services as to why they are similar to sausages, pasties, pies and pastry. I decline to find any similarity.

95. I have found identity between the application in class 29 and the class 29 goods of the PUKKA PIE DAY and PUKKA CURRY SAUCE marks, and identity or high similarity between the application in class 30 and the class 30 goods of the PUKKA PIE DAY and PUKKA CURRY SAUCE marks. I will now compare the services of the application with the goods and services covered by the PUKKA PIE DAY and PUKKA CURRY SAUCE marks.

96. I considered retail services and goods in paragraph 91 above. Bearing in mind my comments therein and the cited caselaw, I find that there is an average degree of similarity between Pies' goods and the retail services (of a lengthy list of foods) in class 35 of the application. There is no similarity between the class 35 services of the application and the class 41 services in the PUKKA PIE DAY mark.

97. In paragraph 93 above, I considered the applicant's class 43 services against a limited range of Pies' food goods. The PUKKA PIE DAY mark covers a much larger range of foods, as the mark is not subject to proof of use, including tea and coffee. There is greater potential for similarity in relation to goods which are snack foods or prepared meals (as I found earlier). I find that there is an average degree of similarity between Pies goods, particularly those which are prepared meals, tea and coffee, and the following services in class 43 of the application:

Services for providing food and drink; provision of food and drink in restaurants; restaurant services; restaurant and take-away services specialising in the provision of Far Eastern and Indian cuisine; delicatessens [restaurants]; grill restaurants; fast-food restaurants; self-service restaurants; snack-bars; snack bar services; catering and mobile catering services; provision of food and drink via a mobile truck.

The average consumer and the purchasing process

98. 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.

99. The average consumer of the goods and services at issue is a member of the general public. Visual considerations will be an important part of the selection process; for example, after viewing packaging, promotional material, signage and menus. Services, in particular, may also be selected as a result of word-of-mouth recommendations; I, therefore, bear in mind that there may be an aural aspect to the purchasing process. The degree of care the average consumer will display when selecting such goods and services is likely to vary considerably, ranging from a quick purchase of a sausage roll in a corner shop, an impromptu visit to a café, or to dining in a restaurant to celebrate an occasion.


Comparison of marks

100. 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 CJEU 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.”

101. 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.

102. There is no need to compare PUKKA PIES DON'T COMPROMISE because Pies' other marks are closer to K and K's mark. The marks to be compared are:

The earlier marks	The application
<p style="text-align: center;">PUKKA</p> <p style="text-align: center;">PUKKA PIES/PUKKA-PIES</p> <p style="text-align: center;">PUKKA PIE DAY</p> <p style="text-align: center;">PUKKA CURRY SAUCE</p>	

103. All the marks contain PUKKA; the top earlier mark consists entirely of PUKKA. PIES, PIE DAY and CURRY SAUCE are all descriptive or lacking in distinctive character, and therefore carry less weight in the overall impression which the marks will make upon the average consumer. PUKKA dominates the overall impression of all of the earlier marks.

104. K and K's mark consists of two words which, although heavily stylised, are easily read as 'pukka hakka'. The two words are written in a different script to one another. Both words are equal in length and contribute roughly to the overall impression of the mark. That said, 'Pukka' is the first word which will be read by the average UK consumer and is presented in slightly bolder script, hence it is the more dominant of the two words. The background to the words does not add to the overall impression; it is there so that the words can be read. A further factor which contributes to the overall impression of the mark is the presentation, which is reminiscent of Indian (pukka) and Oriental (hakka) writing.

105. There is a low to medium degree of visual similarity between the earlier marks PUKKA PIES/PUKKA-PIES, PUKKA PIE DAY and PUKKA CURRY SAUCE and the application. Normal and fair use of the earlier marks does not cover use in the heavily stylised script of the application, which reduces the degree of visual similarity between them. Further, although the first word in all the marks is PUKKA, distance between the parties' marks is created by the additional (non-distinctive) words in the earlier marks and by HAKKA. There is a slightly higher level of visual similarity between the earlier mark PUKKA (solus) and the application, but no more than medium.

106. The stylisation of K and K's mark will not be apparent in oral use of the marks. HAKKA creates a point of difference, as do the additional words in the earlier marks. PUKKA will be pronounced identically and is the first word which will be spoken in all of the parties' marks. There is a medium level of aural similarity between K and K's mark and PUKKA PIES/PUKKA-PIES, PUKKA PIE DAY and PUKKA CURRY SAUCE. There is an above medium (but not much above) degree of aural similarity between PUKKA and K and K's mark.

107. Earlier in this decision, I found that K & K's evidence falls short of showing that pukka would have been immediately understood at the relevant dates to denote a laudatory characteristic of the goods and services of Pies' contested registrations and applications. Pies has filed evidence from K and K's website which says that HAKKA is a term commonly used to refer to Indo-Chinese food. I do not know how common the word is (I have not heard of it). There is no evidence other than from K and K's own website. Evidence from other sources would have supported Pies' claim. As it is, I am unpersuaded on the evidence which Pies has filed that the average consumer would know what HAKKA means. Putting all this together, I consider that K and K's mark will create the impression of two words which have no immediate meaning. One of those words, PUKKA, appears in all of the earlier marks. Other than the obvious descriptive meanings of PIE, PIE DAY and CURRY SAUCE, the earlier marks have no meaning. The net result of the comparison between them is that the parties' marks are conceptually neutral.

108. I will factor in the various aspects of the comparison of marks when I make the global assessment as to whether there is a likelihood of confusion.

Distinctive character of the earlier marks

109. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁵ the CJEU stated that:

“22. 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).

23. 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).”

110. In line with my findings under section 3(1)(c) of the Act, although not an invented word, there is a lack of evidence to suggest that the dictionary definitions of PUKKA are generally known. The marks have an above average degree of inherent distinctive character.

⁵ Case C-342/97

111. The evidence relating to PUKKA PIES, for pies, is impressive. PUKKA PIES is a trade mark which is found the length and breadth of the UK in supermarkets, shops, football stadia and chip shops. Approximately half a million products are sold in the UK every week, which appears to be sales of pies. The use of PUKKA PIES has enhanced its distinctive character to a high level for pies.

112. I note Pies' evidence shows that 'PUKKA' was used as the easiest clue in the 'Only Connect' television programme to connect all the clues to the answer, which was 'pie makers'. This evidence is not, of itself determinative, but it confirms my view that PUKKA (solus) has acquired a high degree of distinctive character in relation to pies as a result of it being used as part of the mark PUKKA PIES (see *Société des Produits Nestlé SA v Mars UK Ltd*, Case C-353/03). This is for two reasons: firstly, PUKKA PIES has a high degree of distinctive character; and, secondly, PIES describes the goods. PUKKA is the dominant and distinctive element.

113. There is no use shown of the marks PUKKA PIE DAY and PUKKA CURRY SAUCE. I think that, in relation to pies, pasties and sausage rolls there is likely to be a spill-over, to a degree, of the high level of distinctive character (as a result of the use of PUKKA PIES on such goods) which benefits PUKKA PIE DAY. The position is different for PUKKA CURRY SAUCE because Pies does not have a reputation for curry sauce, curry sauce is not a type of pie, PIE is absent from the mark, and this mark does not appear to have been used. This mark cannot claim an enhanced level of distinctive character through use. It has an above average degree of distinctive character.

Likelihood of confusion

114. Deciding whether there is a likelihood of confusion is not scientific; 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 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.*). A likelihood of confusion

presupposes that there is some level of similarity between goods and services (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*, paragraph 22). Therefore, the opposition under section 5(2)(b) of the Act must fail in respect of the goods and services of the application which I have found not to be similar to any of the goods or services covered by the earlier marks.

115. In *Bimbo*, the CJEU stated:

“19. As to the merits, according to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see Case C-334/05 P *OHIM v Shaker* EU:C:2007:333, paragraph 33, and Case C-193/06 P *Nestlé v OHIM* EU:C:2007:539, paragraph 32).

20. The existence of a likelihood of confusion on the part of the public must be assessed globally, account being taken of all factors relevant to the circumstances of the case (see, to that effect, Case C-251/95 *SABEL* EU:C:1997:528, paragraph 22; *OHIM v Shaker* EU:C:2007:333, paragraph 34; and *Nestlé v OHIM* EU:C:2007:539, paragraph 33).

21. The global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks at issue, must be based on the overall impression given by the marks, account being taken, in particular, of their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, to that effect, *SABEL* EU:C:1997:528, paragraph 23; *OHIM v Shaker* EU:C:2007:333, paragraph 35; and *Nestlé v OHIM* EU:C:2007:539, paragraph 34).

22. The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with

another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole (*OHIM v Shaker* EU:C:2007:333, paragraph 41).

23. The overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker* EU:C:2007:333, paragraphs 41 and 42, and *Nestlé v OHIM* EU:C:2007:539, paragraphs 42 and 43 and the case-law cited).

24. In this connection, the Court of Justice has stated that it is possible that an earlier mark used by a third party in a composite sign that includes the name of the company of the third party retains an independent distinctive role in the composite sign. Accordingly, in order to establish the likelihood of confusion, it suffices that, on account of the earlier mark still having an independent distinctive role, the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark (Case C-120/04 *Medion* EU:C:2005:594, paragraphs 30 and 36, and order in Case C-353/09 P *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraph 36).

25. None the less, a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately (see, to that effect, order in Case C-23/09 P *ecoblue v OHIM and Banco Bilbao Vizcaya Argentaria* EU:C:2010:35, paragraph 47; *Becker v Harman International Industries* EU:C:2010:368, paragraphs 37 and 38; and order in *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraphs 36 and 37)."

116. In *Deakins*, BL O/421/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated:

"24. It is not correct to proceed on the basis that an element of a composite mark retains an independent distinctive role if, together with the other

component or components of the mark, it *'forms a unit having a different meaning as compared with the meaning of those components taken separately'*: *Bimbo SA v. OHIM C-591/12P*, EU:C:2014:305 at paragraph [25]. And even if a component of a composite mark is found to be sufficiently 'unitary' to retain an independent distinctive role, it still remains necessary for any assessment of '*similarity*' to be made by reference to the composite mark as a whole in the manner summarised in *Bimbo SA* at paragraphs [34] and [35]:

[34] Indeed, as the Advocate General observed in points 25 and 26 of his Opinion, 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.

[35] The determination of which components of a composite sign contribute to the overall impression made on the target public by that sign is to be undertaken before the global assessment of the likelihood of confusion of the signs at issue. Such an assessment must be based on the overall impression produced by the trade marks at issue, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, as has been stated in paragraph 21 above. Therefore, this does not involve an exception, that must be duly substantiated, to that general rule."

117. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo* on the court's earlier judgment in *Medion*. In that case, Arnold J. considered the registrability of a composite word mark - JURA ORIGIN - which included the opponent's earlier trade mark - ORIGIN. The latter was registered for similar goods - wine - to those of the applicant - whisky. The opponent also had an earlier EUTM

consisting of the word ORIGIN and a device made up of vine leaves. This mark was registered for alcoholic goods at large and therefore covered identical goods to whisky. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of

confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

118. The judge found that the mark JURA ORIGIN formed a unit having a different meaning to those of the individual components. In my view, PUKKA HAKKA does not form a unit with a different meaning as compared to its components taken separately. The dominant and distinctive element in all the marks is PUKKA. PUKKA will be seen as an invented word. The earlier marks have an above average degree of inherent distinctive character and an enhanced degree for pies. There is no concept operating in either mark which might counteract the levels of visual and aural similarity. Even though these are no more than medium (visual) and above medium (aural), and are low to medium for the marks which contain elements additional to PUKKA, the additional elements in the earlier marks are lacking in distinctive character. Although Pies is able to rely for some of the earlier marks upon a limited range of goods, it can rely upon all of its goods and services for the PUKKA PIE DAY mark. I have found that the goods registered for this mark are identical to the goods of the application. Further, PIE DAY is lacking, or low, in distinctive character, merely connoting a day on which to eat pies. Taking into account the mitigating factor of the additional word HAKKA, I nevertheless find that there is a likelihood of indirect confusion, whereby the average consumer recognises that there are differences between the marks but puts the points of coincidence down to there being an economic link between them (another mark of the same undertaking or linked undertakings) in relation to the following goods and services of the application:

Class 29: Meat, fish, poultry and game; meat extracts; all types of preserved, dried, cooked, frozen and otherwise processed fruits and vegetables; cooked chicken on a stick; ready meals, namely ginger chicken, chicken soup, chinky jeera chicken, pepper chicken, fried chicken, tai pai chicken, kung pao chicken, chicken sapo, mixed vegetable sapo and baby lamb ribs; prawns; squid; preserved, frozen, dried and cooked vegetables; stir fried broccoli; vegetable chop suey; jellies namely meat, fish, fruit and vegetable jellies, calves' feet jelly; gelatines; jams, compotes, preserves, fruit preserve, fruit marmalades, lemon curd, fig jam, cranberry sauce, minced meats and vegetable spreads; eggs, cheese, milk, milk products and other dairy products namely butter, yogurt, powdered milk for nutritional purposes; edible oils and fats; prepared meals; soups and preparations for making soups, cream of asparagus soup, cream of celery soup, cream of green pea soup, cream of mushroom soup, cream of spinach soup, cream of tomato soup, cream of chicken soup, mockturtle

soup, oxtail soup, vegetable soup, Julienne soup, bouillon, consomme; potato crisps; dairy spreads; tinned brisling, brisling in tomato, brisling in oil; edible oils and fats, preserved olives and olive oil, Spanish Manzanilla olives, stuffed Spanish Manzanilla olives; pimentos; conserves; preserves and preserved food products namely meat, fish, fruit and vegetable preserves, foods preserved with vinegar, namely meat and poultry preserved in vinegar; bloater spread, kipper spread, salmon and anchovy spread, salmon and shrimp spread, spreads for sandwiches; pickles, onion salad, canned vegetable salad, fruit salad, vegetable juices for cooking, dried or preserved horseradish, horseradish prepared for making sauce, pickled walnuts, chow-chow relish, relish having a base of processed cucumbers and of processed corn; tomato products; sauerkraut; kidney beans and cooked and prepared beans, baked beans, baked beans with pork and tomato sauce, baked beans vegetarian with tomato sauce, prepared green beans; pastes and spreads for sandwiches consisting wholly or mainly of meat or fish or vegetables; snacks and prepared meals; foods and beverages in Class 29 made wholly or principally of any of the foregoing, including ready cooked meals consisting mainly of meat and vegetables and pre-packed meals; fish and seafood spreads; low fat dairy spreads; meat spreads; cheese dips; hot and sour soup; mann chow soup; sweetcorn soup; banana fritters; none of the aforementioned being herbs, herbal extracts, herbal remedies, herbal preparations and food supplements.

Class 30: Sauces; ketchup, tomato ketchup, gravy and gravy browning, sauces, spicy sauces, spicy mushroom sauce, Worcestershire sauce; sauces (condiments); condiments, salad cream, thick whip salad cream; mayonnaise; mayonnaise with pickles; prepared meals; canned sauces; soya sauces; pepper sauces; pizza sauces; chocolate sauces; salad sauces; curry sauces; fruit sauces; cooking sauces; horseradish sauces; spicy sauces; satay sauces; sauces [condiments]; savoury sauces; ready-made sauces; sauces for food; sauces containing nuts; fruit coulis [sauces]; sauces for rice; sauces for pasta; vegetable purees [sauces]; food dressings [sauces]; vegetable pastes [sauces]; tomato based sauces; sauces for chicken; mixes for preparing sauces; vegetable pulps [sauces - food]; sauces for barbecued meat; sauces for ice cream; sauces flavoured with nuts; sauces for frozen fish; sauces for use with pasta; savoury sauces, chutneys and pastes; preparations for making up into sauces; flavourings in the form of dehydrated sauces; flavourings in the form of concentrated sauces; prepared foodstuffs in the form of sauces; none of the aforementioned being herbs, herbal extracts, herbal preparations and food supplements.

Class 35: Retail services in connection with meat, fish, poultry and game, meat extracts, all types of preserved, dried, cooked, frozen and otherwise processed fruits and vegetables, chicken spring rolls, cooked chicken on a stick, ready meals, namely ginger chicken, chicken soup, chinky jeera chicken, pepper chicken, fried chicken, tai pai chicken, kung pao chicken, chicken sapo and baby lamb ribs, prawns, squid, preserved, frozen, dried and cooked vegetables, stir fried broccoli, vegetable chop suey, jellies namely meat, fish, fruit and vegetable jellies, calves' feet jelly, gelatines, jams, compotes, preserves, fruit preserve, fruit marmalades, lemon curd, fig jam, cranberry sauce, minced meats and vegetable spreads, eggs, cheese, milk, milk products and other dairy products namely butter, yogurt,

powdered milk for nutritional purposes, edible oils and fats, prepared meals, soups and preparations for making soups, cream of asparagus soup, cream of celery soup, cream of green pea soup, cream of mushroom soup, cream of spinach soup, cream of tomato soup, cream of chicken soup, mockturtle soup, oxtail soup, vegetable soup, Julienne soup, bouillon, consomme, potato crisps dairy spreads, tinned brisling, brisling in tomato, brisling in oil, edible oils and fats, preserved olives and olive oil, Spanish Manzanilla olives, stuffed Spanish Manzanilla olives, pimentos, conserves, preserves and preserved food products namely meat, fish, fruit and vegetable preserves, foods preserved with vinegar, namely meat and poultry preserved in vinegar, bloater spread, kipper spread, salmon and anchovy spread, salmon and shrimp spread, spreads for sandwiches, pickles, onion salad, canned vegetable salad, fruit salad, vegetable juices for cooking, dried or preserved horseradish, horseradish prepared for making sauce, pickled walnuts, chow-chow relish, relish having a base of processed cucumbers and of processed corn, tomato products, sauerkraut, kidney beans and cooked and prepared beans, baked beans, baked beans with pork and tomato sauce, baked beans vegetarian with tomato sauce, prepared green beans, pastes and spreads for sandwiches consisting wholly or mainly of meat or fish or vegetables, snacks and prepared meals, foods and beverages in made wholly or principally of any of the foregoing, including ready cooked meals consisting mainly of meat and vegetables and pre-packed meals, fish and seafood spreads, low fat dairy spreads, meat spreads, cheese dips, sauces, hot and sour soup, mann chow soup, sweetcorn soup, banana fritters; none of the aforementioned being herbs, herbal extracts, herbal remedies, herbal preparations and food supplements; retail services in connection with ketchup, tomato ketchup, gravy and gravy browning, sauces, spicy sauces, spicy mushroom sauce, Worcestershire sauce, sauces (condiments), condiments, salad cream, thick whip salad cream, mayonnaise, mayonnaise with pickles, prepared meals, canned sauces, soya sauces, pepper sauces, pizza sauces, chocolate sauces, salad sauces, curry sauces, fruit sauces, cooking sauces, horseradish sauces, spicy sauces, satay sauces, sauces [condiments], savoury sauces, ready-made sauces, sauces for food, sauces containing nuts, fruit coulis [sauces], sauces for rice, sauces for pasta, vegetable purees [sauces], food dressings [sauces], vegetable pastes [sauces], tomato based sauces, sauces for chicken, mixes for preparing sauces, vegetable pulps [sauces - food], sauces for barbecued meat, sauces for ice cream, sauces flavoured with nuts, sauces for frozen fish, sauces for use with pasta, savoury sauces, chutneys and pastes, preparations for making up into sauces, flavourings in the form of dehydrated sauces, flavourings in the form of concentrated sauces, prepared foodstuffs in the form of sauces.

Class 41: Organisation of events, exhibitions, cultural activities, competitions and stage shows; production, presentation of television and radio programmes, interactive entertainment, films, sound and video recordings; electronic games services provided by means of the Internet; amusements; night club services; entertainment; entertainment services; entertainment services relating to cookery; television entertainment services; sporting and cultural activities.

Class 43: Services for providing food and drink; provision of food and drink in restaurants; restaurant and catering services; restaurant and take-away services specialising in the provision of Far Eastern

and Indian cuisine; delicatessens [restaurants]; grill restaurants; fast-food restaurants; self-service restaurants; snack-bars; snack bar services; mobile catering services; provision of food and drink via a mobile truck.

119. The section 5(2)(b) ground succeeds in relation to the above goods and services and fails in relation to the remaining services of the application:

Class 35: Business consultancy services relating to the establishment and development of franchise operations; business advice relating to franchising; business advisory services relating to franchising; advisory services for the establishment and operation of franchises; franchising consultancy, namely consultancy relating to the management and organisation of franchises; information and consultancy regarding commercial franchises; provision of business services relating to franchising services; professional consultations relating to franchising; professional advisory services relating to franchising; provision of information relating to franchising; advisory services relating to publicity for franchisees; business advertising services relating to franchising; business assistance relating to franchising; franchisee recruitment; management advisory services related to franchising; consultancy and advisory services in relation to franchising; assistance in franchised commercial business management; promotional services and market research services relating to franchising; commercial administration of the licensing or franchising of the goods and services of others; drawing up a calendar of negotiations and meetings with companies and organisations active in the field of franchises; business research and business consultancy regarding the social impact of economic and political decisions in the field of franchises; research services relating to franchising; preparation of reports relating to franchising; administration of the business affairs of franchises; organising and conducting trade shows and exhibitions in relation to franchising; provision of business assistance in the operation of franchises; provision of business assistance in the establishment of franchises; assistance in business management within the framework of a franchise contract; none of the foregoing relating to the fields of Ayurveda, teas, infusions, herbs, herbal extracts, herbal remedies, herbal preparations or food supplements; advertising, marketing, publicity and promotional services; business management; business appraisals; business management assistance; business research, business enquiry and business investigation services; business administration; office functions; assistance in product and service commercialisation, within the framework of a franchise contract; recruitment services; services for the provision of statistical information; commercial or industrial management assistance; economic forecasting; market research; writing of publicity texts; operational management; commercial administration; economic and commercial consultancy in the field of legislative and regulatory development; lobbying for commercial purposes; negotiating conditions for members' participation in trade fair and exhibition associations; economic study and research; market research, market surveys and market analyses; advising commercial enterprises in the conduct of their business; business advice; business consultancy; business management assistance; business management and organisation consultancy; consultancy relating to business planning; consultancy

relating to the establishment and running of businesses; consultancy relating to the management of personnel; consultancy relating to the selection of personnel; research services relating to setting up and running a business; organising and conducting trade shows and exhibitions in relation to business skills; none of the aforesaid services relating to luggage.

Class 41: Education services; instruction services; tuition services; providing of training; education and training relating to the hospitality and catering industry; training services for franchisees; training services for franchisees in relation to the hospitality and catering industry and services; educational services relating to cookery; rental and distribution of television and radio programmes, interactive entertainment, films, sound and video recordings and educational and instructional materials, including but not limited to the hospitality and catering industry; publication of books; providing online electronic publications (not downloadable); information, advice and consultancy in respect of the aforesaid services; publishing training material and manuals; publishing training material and manuals concerning the management of hotels and restaurants; training in the management and running of hotels, restaurants, establishments or facilities for others; cookery demonstrations; demonstrations involving the culinary arts; provision of education and training in relation to franchising; professional advice relating to training and education in the franchising industry; professional advice relating to training and education in business skills; training in relation to business skills; education and training services relating to business franchise management; services provided to a franchiser, namely providing of basic training to the franchiser, his personnel, or to franchisees or the personnel of franchisees; services of publishing of books and manuals, particularly on paper support, audio or video support or on Internet, said books and manuals dealing with franchising, franchisors, franchisees and trademark licenses, including but not limited to the hospitality and catering industry; education and training services, namely, courses of instruction in the fields of news, current events news, broadcasting, advertising, marketing, public relations, publishing, new media and franchising; training in relation to finance; training in relation to human resources; training in relation to people management; publishing services; publication services; publication of newspapers, magazines, newsletters; publication of printed and educational material; providing online electronic publications (not downloadable); publication of electronic books and journals online; provision of news; provision of news online; production, presentation, networking, syndication, distribution and recording services; providing online information in the field of current news events; publication services namely, publication of books, newspapers, newspaper inserts, magazines, newsletters, directories, pamphlets, almanacs and journals in the fields of news, current events news, broadcasting, advertising, marketing, public relations, publishing, new media and franchising; information, advice and consultancy services relating to the aforesaid services; information, advice and consultancy services relating to the aforesaid services provided online via a local or global communications networks, including the Internet, intranets, extranets, television, mobile communication, cellular and satellite networks or other communications or telecommunications network.

Class 43: bar services; wine tasting (provision of beverages) services; food tasting (provision of food) services; provision of information relating to restaurants; bars; salad bars; wine bars; wine bar services; restaurant services incorporating licensed bar facilities; booking and reservation services for mobile bar services; mobile bar and consultancy services relating to food preparation; restaurant reservation services; arranging of meals in hotels; corporate hospitality (provision of food and drink); arranging of wedding receptions (food and drink); arranging of food and drink at wedding receptions; pubs; hotel services; temporary accommodation; hotel services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; crèche services.

120. The other marks relied upon for the opposition (set out in the annex), but not focussed on at the hearing, do not put Pies in any better a position because they are either duplicative or further away in terms of similarity between the marks.

Other grounds of opposition against K and K's application

121. The section 5(2)(b) ground having only partially succeeded, I move on to consider the other grounds of opposition in relation to those services which have survived the section 5(2)(b) ground (listed in paragraph 119 above).

122. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

123. The requirements to succeed in a passing off action are well established and are summarised in *Halsbury's Laws of England* 4th Ed. as being that:

i) the claimant's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

ii) there is a misrepresentation by the defendant (whether or not intentional) which is likely to deceive the public into believing that the defendant's goods or services are those of the claimant;

and iii) the claimant has suffered or is likely to suffer damage as a result of the erroneous belief created by the defendant's misrepresentation.

124. There is one possible difference between the position under trade mark law and the position under passing off law. In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that "a substantial number" of the relevant public are deceived, which might not mean that the average consumer is confused. As both tests are intended to be normative measures intended to exclude those who are unusually careful or careless (per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40), it is doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes.

125. Accordingly, Pies claims that this ground is similar to its ground under section 5(2)(b) but that it allows Pies to rely upon its goodwill in PUKKA for a wider range of goods than those for which the PUKKA word marks are registered. Mr St Quintin submitted that the section 5(4)(a) ground provides Pies with further argument in classes 35, 41 and 43 on the basis of goodwill attached, in particular, to advertising display apparatus; refrigerated food display apparatus; games software; advertising, including promotion and products of third parties through sponsorship arrangements; business advisory services in relation to the reduction of carbon footprint and charitable contributions to food banks; and provision of food and drink, catering and

catering services. I bear in mind that this is a narrower range of goods and services than that pleaded, but I did not understand it to be a limit to Pies' pleadings. The evidence shows that Pies has used PUKKA-PIES in relation to its takeaway outlets at various stadia and that it supplied 700,000 pies to football clubs in the 2010-2011 season. This fact, together with the sign that is used, PUKKA-PIES, strongly implies that the takeaway outlets sell pies (and pie-like goods such as pasties and sausage rolls). The claim to goodwill in 'provision of food and drink, catering and catering services' can only be sustained in relation to this limited range of takeaway services. The limited range of goodwill does not take Pies any further forward in relation to K and K's services in classes 35, 41 and 43 than under the section 5(2)(b) ground.

126. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margerine Ltd* [1901] AC 217 at 223 (my emphasis):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates.”

127. In relation to the claimed goodwill attaching to the other goods and services highlighted by Mr St Quintin, I make the following findings:

(i) advertising display apparatus and refrigerated food display apparatus

The evidence shows that these goods are for the purpose of advertising and displaying Pies' own goods (for example, outside and inside fish and chip shops). There is no evidence that Pies has a business selling advertising display apparatus or refrigerated food display apparatus. There is no attractive force bringing in custom for these goods. Consequently, there was no goodwill in advertising display apparatus or refrigerated food display apparatus at the date of K and K's application.

(ii) games software

The only evidence in relation to these goods dates from 25 May 2010 to 11 December 2012, from the Wayback Machine (the Internet archive). There are four games shown on Pies' own website, beneath which are weblinks which start with the words 'Play Now!' There is no information as to whether these were games accessible only via the weblinks or were for sale. There is no pricing information and no information in the evidence as to whether there were any sales of the games. There is no attractive force bringing in custom for these goods. Consequently, there was no protectable goodwill in games software at the date of K and K's application.

(iii) advertising, including promotion and products of third parties through sponsorship arrangements

Pies has not explained how sponsoring third parties, which then either wear or display the PUKKA sign, constitutes a business in advertising, rather than advertising its own goods. Ms Bouch states that sponsorship is to promote the PUKKA marks (paragraph 27 of her first witness statement). There is no attractive force bringing in custom for advertising services. Consequently, there was no protectable goodwill in advertising services at the date of K and K's application.

(iv) business advisory services in relation to the reduction of carbon footprint and charitable contributions to food banks

Ms Bouch states (at paragraph 26 of her first witness statement) that Pies "is perceived as having expertise in this field by its peers and accordingly my Company now offers advice and guidance to other firms in this matter and information on this is provided in Exhibit 15." Exhibit 15 is a print of an article from Foodmanufacture.co.uk, dated 2 November 2015. It reports that Pies was offering to help fellow food manufacturers understand how to overcome the bureaucratic obstacles in donating surplus stock to foodbanks. There is no indication that any

third party availed itself of the offer. There is no attractive force bringing in custom for business advisory services in relation to the reduction of carbon footprint and charitable contributions to food banks. Consequently, there was no protectable goodwill in business advisory services in relation to the reduction of carbon footprint and charitable contributions to food banks at the date of K and K's application.

128. The other goods and services in the original pleadings (shown in paragraph 6 of this decision) do not put Pies in any better a position under section 5(4)(a). The section 5(4)(a) ground, to the extent considered, fails.

Section 5(3) of the Act

129. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

130. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and

occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L’Oreal v Bellure*).

131. The conditions of section 5(3) are cumulative. Firstly, Pies must show that its earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between the marks, in the sense of the earlier marks being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

132. The first condition is reputation. The CJEU gave guidance in relation to assessing reputation in *General Motors*:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

133. When I assessed the distinctive character of the earlier marks under section 5(2)(b) of the Act, I said that the evidence was sufficient to find that the marks’ inherent distinctive character had been enhanced through use, but only in relation to pies. For the reasons I gave earlier, I find that the evidence is sufficient to support a claim to a *Chevy* standard of reputation, but only in relation to this narrow area. Would a link be made in relation to the services which survived the grounds of opposition under sections 5(2)(b) and 5(4)(a)? In my view, no link would be made between marks with a reputation attached to pies and the application in relation to the surviving services, even those relating in some way to food. If the marks were brought to mind, it would be too fleeting to have the effects envisaged in the three heads of damage. The section 5(3) ground fails.

Outcome of Pies’ opposition

134. The opposition partially succeeds. K and K’s application will be refused for:

Class 29: Meat, fish, poultry and game; meat extracts; all types of preserved, dried, cooked, frozen and otherwise processed fruits and vegetables; cooked chicken on a stick; ready meals, namely ginger chicken, chicken soup, chinky jeera chicken, pepper chicken, fried chicken, tai pai chicken, kung pao chicken, chicken sapo, mixed vegetable sapo and baby lamb ribs; prawns; squid;

preserved, frozen, dried and cooked vegetables; stir fried broccoli; vegetable chop suey; jellies namely meat, fish, fruit and vegetable jellies, calves' feet jelly; gelatines; jams, compotes, preserves, fruit preserve, fruit marmalades, lemon curd, fig jam, cranberry sauce, minced meats and vegetable spreads; eggs, cheese, milk, milk products and other dairy products namely butter, yogurt, powdered milk for nutritional purposes; edible oils and fats; prepared meals; soups and preparations for making soups, cream of asparagus soup, cream of celery soup, cream of green pea soup, cream of mushroom soup, cream of spinach soup, cream of tomato soup, cream of chicken soup, mockturtle soup, oxtail soup, vegetable soup, Julienne soup, bouillon, consomme; potato crisps; dairy spreads; tinned brisling, brisling in tomato, brisling in oil; edible oils and fats, preserved olives and olive oil, Spanish Manzanilla olives, stuffed Spanish Manzanilla olives; pimentos; conserves; preserves and preserved food products namely meat, fish, fruit and vegetable preserves, foods preserved with vinegar, namely meat and poultry preserved in vinegar; bloater spread, kipper spread, salmon and anchovy spread, salmon and shrimp spread, spreads for sandwiches; pickles, onion salad, canned vegetable salad, fruit salad, vegetable juices for cooking, dried or preserved horseradish, horseradish prepared for making sauce, pickled walnuts, chow-chow relish, relish having a base of processed cucumbers and of processed corn; tomato products; sauerkraut; kidney beans and cooked and prepared beans, baked beans, baked beans with pork and tomato sauce, baked beans vegetarian with tomato sauce, prepared green beans; pastes and spreads for sandwiches consisting wholly or mainly of meat or fish or vegetables; snacks and prepared meals; foods and beverages in Class 29 made wholly or principally of any of the foregoing, including ready cooked meals consisting mainly of meat and vegetables and pre-packed meals; fish and seafood spreads; low fat dairy spreads; meat spreads; cheese dips; hot and sour soup; mann chow soup; sweetcorn soup; banana fritters; none of the aforementioned being herbs, herbal extracts, herbal remedies, herbal preparations and food supplements.

Class 30: Sauces; ketchup, tomato ketchup, gravy and gravy browning, sauces, spicy sauces, spicy mushroom sauce, Worcestershire sauce; sauces (condiments); condiments, salad cream, thick whip salad cream; mayonnaise; mayonnaise with pickles; prepared meals; canned sauces; soya sauces; pepper sauces; pizza sauces; chocolate sauces; salad sauces; curry sauces; fruit sauces; cooking sauces; horseradish sauces; spicy sauces; satay sauces; sauces [condiments]; savoury sauces; ready-made sauces; sauces for food; sauces containing nuts; fruit coulis [sauces]; sauces for rice; sauces for pasta; vegetable purees [sauces]; food dressings [sauces]; vegetable pastes [sauces]; tomato based sauces; sauces for chicken; mixes for preparing sauces; vegetable pulps [sauces - food]; sauces for barbecued meat; sauces for ice cream; sauces flavoured with nuts; sauces for frozen fish; sauces for use with pasta; savoury sauces, chutneys and pastes; preparations for making up into sauces; flavourings in the form of dehydrated sauces; flavourings in the form of concentrated sauces; prepared foodstuffs in the form of sauces; none of the aforementioned being herbs, herbal extracts, herbal preparations and food supplements.

Class 35: Retail services in connection with meat, fish, poultry and game, meat extracts, all types of preserved, dried, cooked, frozen and otherwise processed fruits and vegetables, chicken spring rolls, cooked chicken on a stick, ready meals, namely ginger chicken, chicken soup, chinky jeera chicken, pepper chicken, fried chicken, tai pai chicken, kung pao chicken, chicken sapo and baby lamb ribs, prawns, squid, preserved, frozen, dried and cooked vegetables, stir fried broccoli, vegetable chop suey, jellies namely meat, fish, fruit and vegetable jellies, calves' feet jelly, gelatines, jams, compotes, preserves, fruit preserve, fruit marmalades, lemon curd, fig jam, cranberry sauce, minced meats and vegetable spreads, eggs, cheese, milk, milk products and other dairy products namely butter, yogurt, powdered milk for nutritional purposes, edible oils and fats, prepared meals, soups and preparations for making soups, cream of asparagus soup, cream of celery soup, cream of green pea soup, cream of mushroom soup, cream of spinach soup, cream of tomato soup, cream of chicken soup, mockturtle soup, oxtail soup, vegetable soup, Julienne soup, bouillon, consomme, potato crisps dairy spreads, tinned brisling, brisling in tomato, brisling in oil, edible oils and fats, preserved olives and olive oil, Spanish Manzanilla olives, stuffed Spanish Manzanilla olives, pimentos, conserves, preserves and preserved food products namely meat, fish, fruit and vegetable preserves, foods preserved with vinegar, namely meat and poultry preserved in vinegar, bloater spread, kipper spread, salmon and anchovy spread, salmon and shrimp spread, spreads for sandwiches, pickles, onion salad, canned vegetable salad, fruit salad, vegetable juices for cooking, dried or preserved horseradish, horseradish prepared for making sauce, pickled walnuts, chow-chow relish, relish having a base of processed cucumbers and of processed corn, tomato products, sauerkraut, kidney beans and cooked and prepared beans, baked beans, baked beans with pork and tomato sauce, baked beans vegetarian with tomato sauce, prepared green beans, pastes and spreads for sandwiches consisting wholly or mainly of meat or fish or vegetables, snacks and prepared meals, foods and beverages in made wholly or principally of any of the foregoing, including ready cooked meals consisting mainly of meat and vegetables and pre-packed meals, fish and seafood spreads, low fat dairy spreads, meat spreads, cheese dips, sauces, hot and sour soup, mann chow soup, sweetcorn soup, banana fritters; none of the aforementioned being herbs, herbal extracts, herbal remedies, herbal preparations and food supplements; retail services in connection with ketchup, tomato ketchup, gravy and gravy browning, sauces, spicy sauces, spicy mushroom sauce, Worcestershire sauce, sauces (condiments), condiments, salad cream, thick whip salad cream, mayonnaise, mayonnaise with pickles, prepared meals, canned sauces, soya sauces, pepper sauces, pizza sauces, chocolate sauces, salad sauces, curry sauces, fruit sauces, cooking sauces, horseradish sauces, spicy sauces, satay sauces, sauces [condiments], savoury sauces, ready-made sauces, sauces for food, sauces containing nuts, fruit coulis [sauces], sauces for rice, sauces for pasta, vegetable purees [sauces], food dressings [sauces], vegetable pastes [sauces], tomato based sauces, sauces for chicken, mixes for preparing sauces, vegetable pulps [sauces - food], sauces for barbecued meat, sauces for ice cream, sauces flavoured with nuts, sauces for frozen fish, sauces for use with pasta, savoury sauces, chutneys and pastes, preparations for making up into sauces, flavourings in the form of dehydrated sauces, flavourings in the form of concentrated sauces, prepared foodstuffs in the form of sauces.

Class 41: Organisation of events, exhibitions, cultural activities, competitions and stage shows; production, presentation of television and radio programmes, interactive entertainment, films, sound and video recordings; electronic games services provided by means of the Internet; amusements; night club services; entertainment; entertainment services; entertainment services relating to cookery; television entertainment services; sporting and cultural activities.

Class 43: Services for providing food and drink; provision of food and drink in restaurants; restaurant and catering services; restaurant and take-away services specialising in the provision of Far Eastern and Indian cuisine; delicatessens [restaurants]; grill restaurants; fast-food restaurants; self-service restaurants; snack-bars; snack bar services; mobile catering services; provision of food and drink via a mobile truck.

135. K and K's application may proceed to registration for:

Class 35: Business consultancy services relating to the establishment and development of franchise operations; business advice relating to franchising; business advisory services relating to franchising; advisory services for the establishment and operation of franchises; franchising consultancy, namely consultancy relating to the management and organisation of franchises; information and consultancy regarding commercial franchises; provision of business services relating to franchising services; professional consultations relating to franchising; professional advisory services relating to franchising; provision of information relating to franchising; advisory services relating to publicity for franchisees; business advertising services relating to franchising; business assistance relating to franchising; franchisee recruitment; management advisory services related to franchising; consultancy and advisory services in relation to franchising; assistance in franchised commercial business management; promotional services and market research services relating to franchising; commercial administration of the licensing or franchising of the goods and services of others; drawing up a calendar of negotiations and meetings with companies and organisations active in the field of franchises; business research and business consultancy regarding the social impact of economic and political decisions in the field of franchises; research services relating to franchising; preparation of reports relating to franchising; administration of the business affairs of franchises; organising and conducting trade shows and exhibitions in relation to franchising; provision of business assistance in the operation of franchises; provision of business assistance in the establishment of franchises; assistance in business management within the framework of a franchise contract; none of the foregoing relating to the fields of Ayurveda, teas, infusions, herbs, herbal extracts, herbal remedies, herbal preparations or food supplements; advertising, marketing, publicity and promotional services; business management; business appraisals; business management assistance; business research, business enquiry and business investigation services; business administration; office functions; assistance in product and service commercialisation, within the framework of a franchise contract; recruitment services; services for the provision of statistical information; commercial or industrial

management assistance; economic forecasting; market research; writing of publicity texts; operational management; commercial administration; economic and commercial consultancy in the field of legislative and regulatory development; lobbying for commercial purposes; negotiating conditions for members' participation in trade fair and exhibition associations; economic study and research; market research, market surveys and market analyses; advising commercial enterprises in the conduct of their business; business advice; business consultancy; business management assistance; business management and organisation consultancy; consultancy relating to business planning; consultancy relating to the establishment and running of businesses; consultancy relating to the management of personnel; consultancy relating to the selection of personnel; research services relating to setting up and running a business; organising and conducting trade shows and exhibitions in relation to business skills; none of the aforesaid services relating to luggage.

Class 41: Education services; instruction services; tuition services; providing of training; education and training relating to the hospitality and catering industry; training services for franchisees; training services for franchisees in relation to the hospitality and catering industry and services; educational services relating to cookery; rental and distribution of television and radio programmes, interactive entertainment, films, sound and video recordings and educational and instructional materials, including but not limited to the hospitality and catering industry; publication of books; providing online electronic publications (not downloadable); information, advice and consultancy in respect of the aforesaid services; publishing training material and manuals; publishing training material and manuals concerning the management of hotels and restaurants; training in the management and running of hotels, restaurants, establishments or facilities for others; cookery demonstrations; demonstrations involving the culinary arts; provision of education and training in relation to franchising; professional advice relating to training and education in the franchising industry; professional advice relating to training and education in business skills; training in relation to business skills; education and training services relating to business franchise management; services provided to a franchiser, namely providing of basic training to the franchiser, his personnel, or to franchisees or the personnel of franchisees; services of publishing of books and manuals, particularly on paper support, audio or video support or on Internet, said books and manuals dealing with franchising, franchisors, franchisees and trademark licenses, including but not limited to the hospitality and catering industry; education and training services, namely, courses of instruction in the fields of news, current events news, broadcasting, advertising, marketing, public relations, publishing, new media and franchising; training in relation to finance; training in relation to human resources; training in relation to people management; publishing services; publication services; publication of newspapers, magazines, newsletters; publication of printed and educational material; providing online electronic publications (not downloadable); publication of electronic books and journals online; provision of news; provision of news online; production, presentation, networking, syndication, distribution and recording services; providing online information in the field of current news events; publication services namely, publication of books, newspapers, newspaper inserts, magazines, newsletters, directories, pamphlets, almanacs and journals in the fields of news, current events news, broadcasting, advertising,

marketing, public relations, publishing, new media and franchising; information, advice and consultancy services relating to the aforesaid services; information, advice and consultancy services relating to the aforesaid services provided online via a local or global communications networks, including the Internet, intranets, extranets, television, mobile communication, cellular and satellite networks or other communications or telecommunications network.

Class 43: bar services; wine tasting (provision of beverages) services; food tasting (provision of food) services; provision of information relating to restaurants; bars; salad bars; wine bars; wine bar services; restaurant services incorporating licensed bar facilities; booking and reservation services for mobile bar services; mobile bar and consultancy services relating to food preparation; restaurant reservation services; arranging of meals in hotels; corporate hospitality (provision of food and drink); arranging of wedding receptions (food and drink); arranging of food and drink at wedding receptions; pubs; hotel services; temporary accommodation; hotel services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; crèche services.

Overall outcome of the consolidated proceedings

136. The outcome of Pies' opposition to K and K's application 3087631 is shown in paragraphs 134 and 135 above.

137. The outcome of K and K's oppositions against 3109437, 3139755 and 3139748 is that they all fail. Pies' applications may proceed to registration. K and K's applications for declarations of invalidity against registrations 1350917, 1350918 and 2271175 also all fail. Pies' registrations may remain on the register.

Costs

138. In relation to Pies' opposition to K and K's application, both sides have achieved a roughly equal measure of success in terms of specification coverage (rather than individual items). K and K initially had to consider Pies' 20 earlier marks, which were only narrowed down (but not formally withdrawn) at the hearing. However, K and K also put Pies to proof on goods for which it is famous. These two considerations cancel each other out as far as costs are concerned.

139. Pies was wholly successful in resisting K and K's oppositions and applications for invalidation. The grounds were the same in all six actions. Bearing this in mind, together with the consolidated evidence, I award Pies costs for the oppositions and invalidation applications against its marks on the following basis, following the scale published in Tribunal Practice Notice 4/2007:

Considering the oppositions and invalidation pleadings and filing defences:	£600
Considering evidence and filing evidence in response	£800
Preparing for and attending the hearing	£600
Total	£2000

140. I order Zenobia Kassam and Babar Khan to pay Pukka Pies Ltd the sum of £2000 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 13th day of September 2017

Judi Pike
For the Registrar,
the Comptroller-General

Annex summarising the marks not focussed upon at the hearing

- (i) EUTM 980946 PUKKA-PIES, classes 29 and 30. Registered 12 May 2000.
- (ii) UK 2165594 stylised PUKKA-PIES, classes 29 and 30. Registered 19 March 1999.
- (iii) UK 2649779 PUKKA FRITE, classes 29 and 30. Registered 26 July 2013.
- (iv) UK 2649781 PUKKA PEAS, classes 29 and 30. Registered 21 June 2013.
- (v) UK 2649860 PUKKA MASH, classes 29 and 30. Registered 21 June 2013.
- (vi) UK 3007587 PUKKA POCKETS, classes 29 and 30. Registered 30 August 2013.
- (vii) UK 3003008 PUKKA PICK UPS, classes 29 and 30. Registered 16 August 2013.
- (viii) UK 3003009 PUKKA POTATO PICK UPS, classes 29 and 30. Registered 16 August 2013.
- (ix) UK 2649778 PUKKA ON THE MOVE, classes 29 and 30. Registered 21 June 2013.
- (x) UK 2649862 PUKKA TO GO/PUKKA TO GO!, classes 29 and 30. Registered 21 June 2013.
- (xi) UK 3070281 PUKKA SUMMER PIE, classes 29 and 30. Registered 5 December 2014.
- (xii) UK 3041653 PICK A PUKKA PIE, classes 29 and 30. Registered 16 May 2014.