

O-572-17

TRADE MARKS ACT 1994

**TRADE MARK REGISTRATION NO. 3123559
IN THE NAME OF BALWINDER SINGH THUKRAL
AND
APPLICATION NO. 501305 BY CHARANJIT SAPAL
FOR A DECLARATION OF INVALIDITY**

AND

**TRADE MARK APPLICATION NO. 3153458
IN THE NAME OF PUNJABAN LTD
AND
OPPOSITION NO. 600000443
BY BALWINDER SINGH THUKRAL**

Background and pleadings

1. The first action to be considered in these consolidated proceedings is an application by Charanjit Sapal to invalidate trade mark registration number 3123559 in the name of Balwinder Singh Thukral. The trade mark is for the word **PUNJABAN**. It was applied for on 21 August 2015 and was registered on 20 November 2015. The mark stands registered for the following goods and services:

Class 29: Meat, fish, poultry, game; meat extracts; raw and cooked fish and fish products for food; sushi ingredients, namely edible seaweed, squids, octopus, shrimps, clams, prawns, scallops, ready meals; snacks and snack foods; pickles; pulses; dhals; food pastes; food pastes prepared wholly or principally from foodstuffs included in class 29, pickled vegetables and algae prepared for human foods; dried, boiled, frozen and cooked fruits and vegetables, including prepared, preserved, and processed fruit and vegetables and food products made from fruit and vegetables; vegetable and fruit spreads and pastes; mixtures of vegetables and herbs; snack foods containing vegetables; foodstuffs containing soya as the main constituent; dried soya beans, preserved soya beans, soya bean milk and oil for food, soya cream, compotes; eggs and food products made from eggs; milk and milk products; yoghurt; cheese, including Indian (ethnic) cheeses known as paneer, mava and khoa; edible oils and fats; roasted peanuts; peanut butter; peanuts, nuts, kernels, legumes, drupes, pods, all being prepared or processed; edible nuts and seeds, including those prepared as snack foods; mixtures of fruit and nuts; salted foods; chocolate nut butter; crystallised, frosted and frozen fruit; cooked, baked, dried, preserved, processed and stuffed potatoes; cakes, snacks, chips, crisps, croquettes, preparations, products, flakes, fries, fritters, puffs, salad and skins, all of potatoes; snack foods; snack food products; pickles; toppings for pizzas; beverages based predominantly on dairy products or yoghurt; flavoured milk drinks; cooked foods in this class; cooked meals in this class, including frozen cooked meals and prepared and preserved meals; prepared curry dishes with or without rice; ready-prepared meals; ready-prepared desserts, namely

dairy desserts, desserts made from curd with fruit or herb additives, desserts made from yogurts, fruit desserts, soya desserts; frozen food products in this class.

Class 30: Farinaceous foods; sugar, rice, tapioca, semolina, sago, couscous; biscuits, snacks, crackers, cakes, chips and puddings, all of rice; rice products for food, including rice-based snack food; frozen prepared rice with seasonings and vegetables; sauces for rice; rice dishes; samosas; sushi; flour, including wheat flour, potato flour and corn flour; preparations made from cereals; corn meal, oat meal, maize meal; noodles; bread and bread crumbs, rotis (Indian flat bread), nan breads, pitas, parathas, chappatis, unleavened bread; biscuits (cookies); pastry, including pastry consisting of fish; pretzels, gingerbread; cakes and edible decorations for cakes; buns, pancakes, tarts, waffles; confectionery, including mint-based and mint-flavoured confectionery and confectionery for decorating Christmas trees; sweetmeats; chewing gum, including mint-flavoured chewing gum; popcorn; puddings; quiches; royal jelly not for medical purposes; honey; treacle; indian (ethnic) sweets; yeast, baking-powder; salt; mustard; vinegar; sauces and gravies; spices; curry powders, curry pastes, pickles and curry sauces, food pastes, masala, saffron; cooking sauces and cooking pastes; preparations for making sauces; indian (ethnic) savouries and snacks; spring rolls; carbohydrate preparations for food; condiments; chutneys; capers; sweet and savoury spreads; flavourings in the form of concentrated and dehydrated sauces; flavourings made from fruits or vegetables; fruit sauces; ginger; glucose for food; non-medicinal infusions; gluten for food; custard; pizzas, pizza bases, sauces for pizzas; pastry, including frozen pastry, filled with fruits or vegetables; salad dressings; soya products in this class, namely soya bean paste soya-based ice cream, soya flour and soya sauce; ketchup; mayonnaise; dips; pasta; pies, including meat pies; thickening agents for cooking foods; frozen food products included in this Class; ice confectionery; ice cream products; ice cream powders; ice for refreshment; ice beverages; ices; starch for food; glucose syrups for food; thickeners; snack foods; snack food products; popcorn, peanut

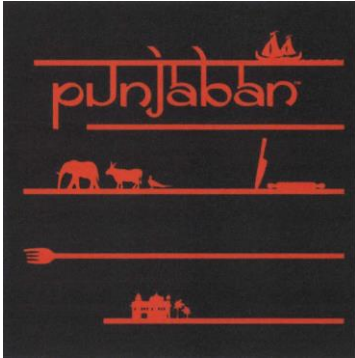
confectionery; spreads made from chocolate and from nuts, kernels, legumes, drupes, pods or peanuts; infusions; coffee, artificial coffee; tea; cocoa; coffee, tea and cocoa beverages with milk; beverages made from cereals; beverages made of tea or coffee; beverages containing ice-cream, chocolate, cocoa, coffee or tea; sherbets; flavourings, other than essential oils, for beverages; aromatic preparations for food; meat tenderisers; sandwiches; cooked meals in this class, including frozen cooked meals and prepared and preserved meals; desserts in this class.

Class 32: Beer, ale, porter, lager and stout; mixtures containing beer, ale, porter, lager and stout shandy, de-alcoholised drinks, non-alcoholic beers and wines non-alcoholic beverages; fruit drinks, fruit juices and vegetable juices; mineral and aerated waters; water; spring water; soft drinks, sparkling drinks; carbonated and sparkling waters, flavoring and unflavored bottled waters; soda beverages; syrups and other preparations for making beverages.

Class 43: Catering services; coffee bar services, sandwich bar services, cafe services, cafeteria services, snack bars, wine bar, bar, cocktail bars, cafe and bar services served in a cybercafé; ice cream parlour services, restaurant services, self service restaurant services; hotel services; hotel reservation, restaurant public house services; serviced apartments for temporary accommodation; information, consultancy and advisory services relating to the aforementioned services including all the aforesaid services provided via the Internet, the world wide web and/or via communications networks.

2. On 18 August 2016, Mrs Sapal applied to cancel Mr Thukral's trade mark. She claims that the mark is invalid under s. 47 of the Trade Marks Act 1994 ("the Act"). The grounds are founded on ss. 5(4)(a) and 3(6) of the Act and are directed against all of the goods and services in the registration. Under s. 5(4)(a), Mrs Sapal relies on the use throughout the UK of the following signs:

(i) **PUNJABAN** (since October 2013)



(ii) (“the figurative sign”) (since October 2013)

(iii) **PANJABAN** (since September 2011)

3. For all of the above, use is claimed in respect of:

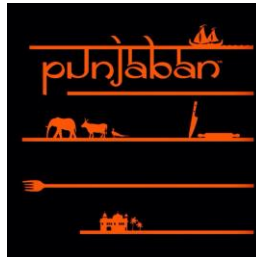
Sauces; curry sauces; curry pastes; curry mixes; prepared curry sauces; prepared meals; sauces; chutneys and pastes; chutneys; bread; naan bread; ready-made meals

4. Mrs Sapal claims that she owns a substantial goodwill in the above signs and that, due to the registration being “virtually identical to the Applicant’s sign visually and identical aurally in relation to identical and highly similar goods” there is likely to be confusion amongst the relevant public. She claims that use of the registration would constitute a misrepresentation, which would lead to damage to the earlier rights.

5. Under s. 3(6), Mrs Sapal submits that Mr Thukral “was aware prior to filing the registration of the Applicant’s sign and that the respondent acted in a manner below acceptable standards of practice to obtain an unfair advantage and in order to leverage a position with the Applicant”. Further, she claims that Mr Thukral “on obtaining the registration of the mark attempted to align [himself] with the Applicant’s business in order to benefit from the Applicant’s success in the brand”.

6. Mr Thukral filed a counterstatement denying the claims. I note in particular that it was denied that Mrs Sapal has made sufficient use of the rights relied upon to have acquired goodwill.

7. The second action is an opposition against trade mark application 3153458 for the trade mark shown below:



8. The application was filed by Punjaban Ltd (“the company”) on 7 March 2016 and the mark was published for opposition purposes on 29 April 2016. Registration is sought for a range of goods and services in classes 29, 30, 32 and 43.

9. The application is opposed by Mr Thukral under s. 5(2)(b) of the Act. The opposition was initially filed under the fast-track procedure but, following consolidation with the invalidation, was converted to a standard opposition. Mr Thukral relies upon his earlier trade mark 3123559 **Punjaban**, the details of which are given at paragraph 1, above. He relies upon all of the goods and services for which the trade mark is registered. Given its filing date, the mark qualifies as an earlier mark in accordance with s. 6 of the Act. As it had not been registered for five years at the date of publication of the opposed mark, it is not subject to the proof of use provisions contained in s. 6A and Mr Thukral can (subject to the outcome of the invalidity action) rely upon all of the goods and services for which the mark is registered.

10. Mr Thukral claims that:

“The Mark applied for is dominated by the word punjaban which is identical to the opponent’s earlier mark. Furthermore, it covers goods and services that

are either identical to, or at least highly similar, to those covered by the opponent's mark. Accordingly, there exists a likelihood of confusion on the part of the public such that registration should be refused under s. 5(2)(b) of the Trade Marks Act".

11. The company filed a counterstatement denying the basis of the opposition.

12. All three parties have been professionally represented throughout, the company and Mrs Sapal by Stephens Scown LLP and Mr Thukral by Withers & Rogers LLP. I note that there has been no request to join Mrs Sapal and the company as joint applicants in the two sets of proceedings; they have, however, confirmed that they stand collectively in respect of costs. Only the company and Mrs Sapal filed evidence. They did so collectively. Both parties filed submissions during the evidence rounds. Neither party requested a hearing but Mr Thukral filed written submissions in lieu. I will not summarise the parties' submissions but I have read them and take them into account, and will refer to them in this decision as I consider necessary. This decision is taken following a careful reading of all of the papers.

Evidence

The company's/Mrs Sapal's evidence

13. This consists of the witness statement of Mrs Charanjit Sapal, with accompanying exhibits CS1 to CS24, and the witness statement of Ms Rubinder Sapal, with one exhibit (RS1).

Charanjit Sapal's evidence

14. Mrs Sapal states that she was a sole trader from 2010 to 2015, starting her business after she identified a market as a result of making curry sauces for her son. Mrs Sapal states that within a year she had taken a professional unit to meet demand.¹

15. In 2013, Mrs Sapal traded under the name Desi UK then, in 2014 and 2015, under the name Punjaban.² She states that her products were initially sold under the name "PANJABAN".³ However, in late 2013, she decided to change the brand from PANJABAN to PUNJABAN.⁴ Mrs Sapal claims that, in relation to curry sauces and pastes, both PANJABAN and PUNJABAN remained associated with her at all times and that PUNJABAN has been used consistently since 2013.⁵ She states that:

"30. On 26th February 2015, I was made a Director of Punjaban Limited and am one of four Directors. However, the brand PUNJABAN and its associated goodwill has remained under my proprietorship and there is an implied licence to allow Punjaban Limited to use the brand in the course of trade.

31. I am closely associated with PUNJABAN and a number of the exhibitions stands carry my picture and PUNJABAN's history is intrinsically linked to me".

Sales and stockists

16. Mrs Sapal indicates that "the sales figures for PUNJABAN are approximately as follows":⁶

¹ Paragraph 3.

² Paragraph 1.

³ Paragraph 4.

⁴ Paragraph 6.

⁵ *Ibid.*

⁶ Paragraph 29.

2012 £120,050
2013 £221,683
2014 £312,148
2015 £357,704
2016 £441,668

17. I note that the figures shown above do not distinguish between PANJABAN and PUNJABAN, and that they are not broken down for the different goods relied upon.

18. A list of shops which are said to stock “PUNJABAN” products is provided.⁷ It is not particularly easy to follow but there are addresses throughout the UK. No other details, such as whether the list is current or the date(s) when the retailers stocked the goods, are given.

19. Mrs Sapal exhibits a purchase order from Holland & Barrett Retail Limited to Punjaban for a range of goods, such as “PUN CHILLI NAAN” and “PUN CURRY BASE MILD”.⁸ The order totals £397.24 and is dated 13 February 2015. Mrs Sapal explains that this was the first order placed by that company and that, since that date, it has placed orders worth approximately £33,300.

20. There are also 16 purchase orders, ten dated March to October 2014 and six dated February to July 2015.⁹ A further purchase order is dated September 2015 (i.e. after the application date). The word “PUNJABAN” is visible in the product descriptions of ten of the purchase orders (across the two periods), which include curry bases, various rice kits, naans and chapattis, pickles and chutneys. All except one are addressed to Desi UK; the exception is a purchase order from The Cress Company (Scotland) Ltd, which is dated 15 July 2015 and is made out to Punjaban Ltd. Of the ten invoices where the sign is visible, the amounts vary from £852.00 (Hider Imports, 10 April 2014) to £3,324 (The Cress Company).

⁷ CS22.

⁸ CS17.

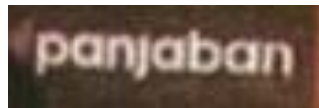
⁹ CS23.

Marketing spend, trade stands and shows

21. Mrs Sapal states that she has spent the following sums on marketing PUNJABAN and PANJABAN (again, she does not distinguish between the various signs):¹⁰

2011	£8,300
2012	£26,200
2013	£46,300
2014	£65,400
2015	£94,600
2016	£83,300

22. A number of the exhibits filed by Mrs Sapal show evidence that she has undertaken promotional activities in relation both to “PANJABAN” and “PUNJABAN”. At exhibit CS1 is a print from Facebook. Mrs Sapal states that it is “a still from a recording of a national British television shopping channel, Bid, where I demonstrate the use of my PANJABAN curry sauces in January 2013”. The date is supported by the dates of the comments displayed alongside the image. The following sign is visible on screens and on clothing worn by the presenters:



23. There are two prints from Facebook showing stands at the Ideal Home Show. The first is said to be an image from November 2013, which accords with the dates of the comments on the page.¹¹ It shows a stand for Desi UK “T/A PANJABAN”. The sign shown at paragraph 22, above, is displayed across the front of the stand, with a woman’s picture. The second print is dated November 2014 and is said to show a stand at the Show in Earls Court, London.¹² The figurative sign is visible on the stand, albeit interspersed with other text (at least some of this is descriptive, e.g. “gluten free”; the

¹⁰ Paragraph 26.

¹¹ CS4.

¹² CS16.

rest is too small to make out). Again, a woman's picture appears next to the sign. Large containers on the stands suggest that the goods are available to taste.

24. In addition, there are exhibited a number of invoices and contracts in relation to promotional space and stands. These are:

- an invoice from Weston Favell Shopping Centre to Punjaban Curry Sauce, dated 5 December 2013, in relation to promotional space for Punjaban curry sauce on 13 – 14 December 2013;¹³
- a contract between Clarion Events Limited and Panjaban dated 10 January 2014, for a stand at Scotland's Trade Fair (Spring) in Glasgow on 19-21 January 2014;¹⁴
- an invoice from an event company called Aztec to "Sapal Charlie Mrs, Punjaban", dated February 2014. It is for an exhibition stand, apparently at a Brentwood Craft fair, on 22 February 2014;¹⁵
- an invoice from River Street Events Ltd to Punjaban dated 20 February 2015.¹⁶ It is for a stand at the BBC Good Food Eat Well Show 2015 at Olympia in London, which appears to have been scheduled for 27 February to 1 March 2015. At p. 2, the booking form indicates that curry bases, chutneys, pickles and naan will be exhibited;
- invoices in relation to exhibition stands at the BBC Good Food Show Scotland (6- 8 November 2015), the BBC Good Food Show London (13- 15 November 2015) and the BBC Good Food Show Winter 2015 in Birmingham (26- 29 November 2015).¹⁷ These invoices post-date the relevant date.

¹³ CS7.

¹⁴ CS8.

¹⁵ CS10.

¹⁶ CS18.

¹⁷ CS20.

Branding

25. There are a number of invoices made out variously to Desi UK, “Panjaban” and “Punjaban” regarding activities such as website design, branded aprons and the printing of labels. They are:

- three invoices, dated February, October and November 2013, to Desi UK from Sira Concepts Limited, for the design and build for “Punjaban website”, along with services such as logo artwork and hosting;¹⁸
- an invoice to Desi UK from GBF, a printing company, dated 30 October 2013.¹⁹ Mrs Sapal states that it is for “jar and lid labels with the updated branding to PUNJABAN” but the sign is not visible on the invoice;
- a further invoice from GBF to Desi UK, dated 14 May 2014, in respect of 6,000 “supersize labels”.²⁰ Included in the exhibit is an image of a label, though the image itself is not dated and it is not clear whether this accompanied the invoice. The label is shown below:



The reproduction is not very clear but the text next to the image of a woman reads “No need to peel or fry onions, chop tomatoes, grind ginger/garlic, save time using my handmade Tadka... just add chicken to me!!!”. There is a signature but it is not legible;

- an invoice to “Panjaban” from APS Promotions Ltd dated 14 November 2013, for 8 aprons “printed company logo large to front”.²¹ The invoice is accompanied by

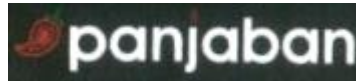
¹⁸ CS2.

¹⁹ CS6.

²⁰ CS12.

²¹ CS5.

an email dated 4 July 2016 from the same company, which states that “the attached logo of the Panjaban logo was supplied and printed in reference to invoice number 6780 [not exhibited] on the 4th November 2013”. The logo is shown printed on an apron as follows:



There is also a statement in the email to the effect that the invoice of 14 November 2013 “and all subsequent orders were printed with the new Punjaban logo as per the attached visual”. There is an image of an apron printed with the figurative sign;

- an email dated 29 May 2013 from addisonprint.co.uk to panjaban.co.uk about the printing of various labels.²² There is also an email from a panjaban.co.uk email to an individual at addisonprint.co.uk, dated 15 October 2014, for 50 turkey curry labels.²³ The labels are not shown;
- three invoices from Addison Print, the first for pre-Christmas labels, dated 21 April 2013 and made out to Desi UK Limited.²⁴ It is not clear what was on the labels. The remaining invoices are in relation to brochures and banners, both dated 24 February 2015 and addressed to Desi UK;²⁵
- an invoice from Soapbox Creative Marketing for “initial marketing elements”, dated 10 December 2014. It is addressed to Punjaban. Apart from in the address, none of the signs is visible;
- an invoice from A.P.S. Promotions to Punjaban dated 23 January 2015.²⁶ It is said to be “for the purchase of clothing bearing the PUNJABAN brand”. Various items of clothing are itemised in the exhibit;
- two letters addressed to Charanjit Sapal T/As Punjaban, about a vehicle finance agreement.²⁷ They are dated April and May 2014. In addition, there are two

²² CS15.

²³ Ibid.

²⁴ Ibid.

²⁵ CS21.

²⁶ CS9.

invoices from Signs Express (Northampton), dated 7 March 2014 and 10 June 2014, regarding vehicle graphics, as well as images of a vehicle bearing the figurative sign.²⁸

Articles and blogs

26. Mrs Sapal also exhibits various articles and blogs. These are:

- two articles from the *Northampton Chronicle and Echo*, dated 21 March 2013 and 17 June 2013.²⁹ The earlier article describes how “the whole idea of setting up the Panjaban food company had come about by chance” when Mrs Sapal began making curry bases for her son at university and recognised a business opportunity. It details how the business expanded and states that a “recent” appearance on Bid TV led to orders for 13,200 jars within two weeks. The second article is a review of the BBC Good Food Show in Birmingham’s NEC, which indicates that the “Panjaban curry sauce company” was represented at the show;
- a blog article from www.moadore.co.uk, dated 19 June 2014, about Punjaban curry sauces.³⁰ There are images of two jars of “curry base”. One label is reproduced below:



The other is similar but the typeface and lines are in yellow rather than green, and the type of curry differs. The blogger describes buying the two jars of sauce at the Ideal Home Show Scotland a few weeks previously;

²⁷ CS11.

²⁸ Ibid.

²⁹ CS3.

³⁰ CS13.

- an article from www.thegrocer.co.uk dated 6 July 2014, entitled “Curry supplier Punjaban sends Andy Murray some Ruby Murray”.³¹ Mrs Sapal is mentioned as having founded Punjaban in 2010;
- two blog articles, one dated 21 July 2015 from binnyskitchen.com, regarding the “Punjaban Bombay Potato Base” and another from pearliepumpkin.wordpress.com.³² Both include images of the products. The first article refers to the inception of the business by Mrs Sapal and states that “the sauce is handmade by Charanjit Sapal (Charlie)”. The second article appears to relate to the Chatsworth Country Fair 2015. It states: “Punjaban [...] are a small family run authentic curry company. The talented lady behind these wonder curries is called Charanjit Sapal”. Both show products bearing labels similar to that shown on the moadore blog, above, though the particular curry sauce and the font/line colours are different.

Bad faith

27. In relation to this ground, Mrs Sapal exhibits an email from Mr Thukral to the “Sapal family” dated 1 March 2016.³³ He gives his contact details and asks for “the director who deals with the Trade Mark issue” to call him back.

28. Mrs Sapal gives evidence in her statement about the events following Mr Thukral’s email. She claims that she, her son and her daughter met Mr Thukral to try to resolve the matter amicably. She states that Mr Thukral said “he wanted to use the name for a restaurant, food services and for a beer and that he had not used the sign PUNJABAN yet”. According to Mrs Sapal, “Mr Thukral was not willing to assign the registration to us but did propose that he become involved in my business by being a sleeping partner and investing into our brand. It struck me that he wanted to benefit from the success of PUNJABAN”. She claims that he reiterated that desire in June 2016 at the BBC Good Food Show.

³¹ CS14.

³² CS19.

³³ CS24.

Rubinder Sapal's evidence

29. Ms Sapal's witness statement is accompanied by one exhibit (RS1). Ms Sapal is Mrs Sapal's daughter and she has been a director of Punjaban Ltd since February 2015. Ms Sapal states that, prior to becoming a director of the company, she assisted her mother "in her business as a sole trader selling the PUNJABAN brand since 2012". She exhibits at RS1 a copy of the same email exhibited by Mrs Sapal at CS24.

30. Ms Sapal explains that she telephoned Mr Thukral in relation to his email. Her evidence regarding this telephone conversation is that:

"at first he explained how he had obtained the trade mark for PUNJABAN as he wanted to open a restaurant or some sort of fast food business with this name. He realised we had an existing business which was successful. He mentioned to me he saw us at the BBC Good Food Show (in 2015 but I don't remember the exact month he stated that he saw us there). He said he felt he needed to let us know that he had registered the name PUNJABAN as he thought there may be conflict. He suggested meeting to discuss a possible agreement".

31. As Mr Thukral filed no evidence, that concludes my summary of the evidence, insofar as I consider it necessary.

Decision

32. I will consider the invalidation under s. 5(4)(a) first, followed by the ground under s. 3(6) if necessary. If Mr Thukral's mark survives the invalidation, I will then consider his opposition.

Section 5(4)(a)- passing off

33. 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”.

34. Section 47 also applies, the relevant parts of which read:

“47. - (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).

[...]

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only”.

35. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously

expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House".

36. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action”.

The relevant date

37. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander Q.C., sitting as the Appointed Person, considered the matter of the relevant date in a passing off case. He said:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”.

38. The contested mark was filed on 21 August 2015. There has been no claim that it has been used prior to that date and there is no evidence to that effect. Consequently, I need only consider the position at the date of application.

Goodwill

39. I bear in mind the following guidance from the House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL):

“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”.

40. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back

to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark* [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation”.

41. However, a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off, even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience”.³⁴

42. In terms of what is required to establish goodwill, I note that in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of

³⁴ See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA)

reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur”.

43. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application”.

44. The first issue to be determined is whether goodwill exists, the second is whether the sign(s) relied upon are associated with the business/the goodwill and the third is whether it is Mrs Sapal or the company (the latter of which is not a party to the invalidity) who owns the goodwill and is entitled to rely upon it. I will deal with these in turn.

45. Mr Thukral submits that the evidence is insufficient to establish that there was a protectable goodwill at the relevant date. His submissions criticise the paucity of evidence relating to actual sales under the signs. Those criticisms are not without foundation. Indeed, the evidence as a whole is not well marshalled. Mrs Sapal claims to have spent not insubstantial sums on marketing, and has asserted that the business generated what appear to be reasonably healthy sales. However, whilst the truth of that evidence is unchallenged, much of it is unsupported. A good deal of the evidence that has been filed in support (such as invoices from third parties about, for example, website design or vehicle finance) is of limited assistance in demonstrating that the business was trading in the goods relied upon. The first documentary evidence of sales is dated March 2014 (CS23): there is no such evidence of any sales before that date. Nevertheless, the evidence relating to the period from March 2014 to July 2015, in particular the purchase orders at CS23 and the invoice at CS17, supports Mrs Sapal's evidence of overall turnover and shows a goodwill which, while not large, is more than trivial and demonstrates the operation of an ongoing business with a protectable goodwill.

46. To be relevant in these proceedings, the signs upon which Mrs Sapal relies must be associated with the goodwill. I am not satisfied that the sign PANJABAN as such was associated with the goodwill at the relevant date: there is no documentary evidence of any income in the period during which this sign was used. Further, according to Mrs Sapal, that sign had not been used for a couple of years prior to the relevant date. In contrast, the figurative sign has clearly been used in the period to which the evidence of income relates, with the sign being shown in use on, for example, product labels and exhibition stand banners. Although there is no evidence of the word "PUNJABAN" in use on its own, it is plainly an important element of the figurative sign and appears to be

distinctive of the applicant's goodwill. This is supported by the purchase orders from Hider Food Imports Limited and Tree of Life UK Ltd, in which the customers identify particular "Punjaban" goods.³⁵ I accept that the use began in late 2013 and that by March 2014 (the first documentary evidence of income), the sign was distinctive of a protectable goodwill in the business.

47. The next issue is who owned the goodwill at the date of the application, i.e. 21 August 2015. Both Mrs Sapal and Ms Sapal have given evidence, not disputed by Mr Thukral, that Mrs Sapal was operating as a sole trader in the period before February 2015. I accept that evidence. As the trade in this period pre-dates the formation of the company, the goodwill accruing between March 2014 and February 2015 must lie with Mrs Sapal personally, in her capacity as a sole trader.

48. Whether the goodwill continued to accrue to Mrs Sapal following the incorporation of the company in February 2015, or whether it accrued to the company, is more problematic. In considering the question of the ownership of the goodwill, I take into account the following passage from *The Law of Passing-Off: Unfair Competition by Misrepresentation*, 4th Ed, Wadlow. Although it relates to the ownership of goodwill as between manufacturers and distributors, it nonetheless provides helpful guidance in determining where the goodwill lies when there is no agreement covering the ownership of goodwill. It reads:

"3-136 The factors which influence the ownership of goodwill were encapsulated by Lord Reid in *Oertli v Bowman* [1959 RPC 1, 7, HL]:

"Bowmans made and marketed the *Turmix* machines without the appellants [plaintiffs] having controlled or having had any power to control the manufacture, distribution or sale of the machines, and without there having been any notice of any kind to purchasers that the appellants had any connection with the machines."

³⁵ CS23.

There are two distinct, and not necessarily consistent, standards in this passage. One is to ask who is in fact most responsible for the character or quality of the goods; the other is to ask who is perceived by the public as being responsible. The latter is (perhaps surprisingly) the more important, but it does not provide a complete answer to the problem because in many cases the relevant public is not concerned with identifying or distinguishing between the various parties who may be associated with the goods. If so, actual control provides a less decisive test, but one which does yield a definite answer.

3-137 To expand, the following questions are relevant as to who owns the goodwill in respect of a particular line of goods, or, *mutatis mutandis*, a business for the provision of services:

- Are the goods bought on the strength of the reputation of an identifiable trader?
- Who does the public perceive as being responsible for the character or quality of the goods? Who would be blamed if they were unsatisfactory?
- Who is most responsible in fact for the character or quality of the goods?
- What circumstances support or contradict the claim of any particular trader to be the owner of the goodwill? For example, goodwill is more likely to belong to the manufacturer if the goods are distributed through more than one dealer, either at once or in succession. If more than one manufacturer supplies goods to a dealer and they are indistinguishable, the dealer is more likely to own the goodwill”.

49. There is no presumption in law as to where the goodwill would lie: it is a factual matter, to be determined on the evidence.

50. Mr Thukral disputes that there is an implied licence between Mrs Sapal and the company.³⁶ He submits that if the goodwill remained under Mrs Sapal's ownership "it would seem incongruous that ownership of the registered rights would sit with Punjaban Limited", and he claims that "[the] assertion of an implied licence is therefore a mechanism of convenience by which [Mrs Sapal] seeks to rely on goodwill which has not accrued to her".³⁷ He also states that:

"Even where a brand markets itself by reference to a founding personality, consumers are not so naïve as to believe that every product produced by that company is manufactured by the hands of that founder".

51. The evidence shows that exhibition banners in November 2013 and November 2014 featured a picture of a woman.³⁸ Given Mrs Sapal's evidence that her image was used, it is probable that the image is of her. There is also evidence that the product labels in 2014 bore an image of a woman, which the accompanying text suggests is Mrs Sapal.³⁹ Moreover, the product label at CS12, although not dated, indicates that the products are handmade. It may be that a very cynical consumer would disbelieve the claim that the goods are handmade by the founder but there is no reason to think that that would be the prevailing assumption in the face of an explicit claim to the contrary on the products. Given that the goods at issue are foodstuffs, it is entirely plausible that the consumer would perceive an individual as producing, or at least overseeing the production of, her business's goods. That perception is even more likely in circumstances where the consumer is exposed to the product in venues such as food fairs or in smaller retailers, where it would be entirely usual to find the goods of artisan or small producers.

52. I acknowledge that the evidence which shows Mrs Sapal's picture on banners and labels is dated before February 2015. Indeed, one of the many criticisms that could be made of the evidence is that very little is dated between February 2015 and the relevant

³⁶ Paragraph 13.

³⁷ Paragraphs 14-15.

³⁸ CS4, CS16.

³⁹ CS12.

date, and that still less of it is helpful. However, the images of the branded products dated before February 2015 are consistent, to the extent that the label can be seen, with those appearing in the blogs at CS19, at least the first of which is dated July 2015 (the date of the other is in 2015 but not otherwise specified). Mr Thukral has neither suggested nor provided evidence to show that the product labels changed after the incorporation of the company. Both of the blog articles refer to Mrs Sapal in her capacity as creator of the brand. The July blog specifically informs its readers that the sauces are handmade by Mrs Sapal.

53. Mr Thukral notes that the invoice from Holland & Barratt is addressed to Punjaban and claims that this is an act “done in the name of the business”. However, the invoice is dated 13 February 2015 and Mr Thukral’s submissions themselves give the date of incorporation of the company as 26 February 2015.⁴⁰ With one exception, the other purchase orders dated in 2015 are addressed to Desi UK, rather than to Punjaban.⁴¹ Desi UK is one of the trading names under which Mrs Sapal operated as a sole trader. All of this reinforces my view that the incorporation of the company did not make a material difference to the way in which the products were branded or to the way in which the responsibility for the goods would be perceived by the relevant public. Indeed, the evidential picture suggests a business which continued to trade in the same way as it always had, with a seamless transition between sole trader and limited company. The strong association which Mrs Sapal maintained as creator of the products, in particular because of the presence of her image on banners and labels, and the emphasis on product labels that the goods are handmade by her, would result in the public perceiving her as being personally responsible for the goods. I find that the goodwill in the business continued to accrue to Mrs Sapal, even after incorporation of the company.

54. In case I am wrong, I will consider briefly the matter of residual goodwill. I have found that Mrs Sapal owned the goodwill in the business between at least March 2014 and February 2015. Although the goodwill generated in that period is modest, it is, in my

⁴⁰ Paragraphs 17-18.

⁴¹ CS23.

view, sufficient that it would not have been extinguished in the six months between Mrs Sapal ceasing to trade as a sole trader in February 2015 and the application date in August the same year. It is of particular note that the business activity did not cease, nor was the goodwill either impliedly or explicitly abandoned. In fact, the business continued and Mrs Sapal continued to be referred to as the creator and the person responsible for making the products. Even if the goodwill no longer accrued to her personally, the reinforcement of her role in the business, in particular by references in publicity such as blog articles, will, at the least, have kept alive the goodwill which had accrued to her as a sole trader. Mrs Sapal may therefore, at the least, rely on the 'residual' goodwill accruing to her personally in the period March 2014 to February 2015.

Misrepresentation

55. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“493. There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”.

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101”.

56. And later in the same judgment:

“494 [...] for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion”.

57. As far as the similarity between the marks is concerned, the registered mark consists of the word “Punjaban” solus. It is identical to one of the signs relied upon which is distinctive of Mrs Sapal’s goodwill. However, the word “Punjaban” is clearly suggestive of a characteristic of the goods, namely that they are from or belong to a style of cooking associated with the Punjab. The relatively low level of distinctiveness of that word makes misrepresentation less likely. Nevertheless, there is an obvious difference between ‘Punjab’ and ‘Punjaban’, and I see no reason why the relevant public would take the latter as anything other than a trade mark.

58. The parties have made limited comments on the similarity between the goods and services at issue. Mrs Sapal submits that all of the goods and services at issue fall within the same field of activity.⁴² Mr Thukral submits that:

“[...] manufacturers of Indian-style foods do not branch out into catering, alcoholic beverages, or other foods as appear in the specification of [Mr Thukral’s] registration. Moreover, Indian-style foods generally appear in dedicated parts of stores. Were [Mr Thukral] to use his mark in relation to pizzas or ice cream, for example, such goods would not be in the vicinity of

⁴² Paragraph 19.

Ms Sapal's goods, and it is unlikely that any consumer would consider them to have the same trade origin. Therefore, no deception would occur".⁴³

59. Taking into account the claims in Mrs Sapal's evidence regarding the goods on which the signs have been used, Mr Thukral asserts that a misrepresentation is only plausible where he uses his PUNJABAN mark in relation to curry sauces, curry bases, naan breads, rice and rice kits, chutneys, pickles and chappatis.⁴⁴

60. Given the breadth of the specifications at issue, more focused submissions would have been of assistance. Although all of the goods and services at issue are within the same general field of food and drink, the goodwill enjoyed by Mrs Sapal's business is modest in the context of the sector at large. The evidence shows trade in curry sauces/pastes, rice kits, naan bread and pickles/chutneys, with the emphasis firmly on curry sauces and bases. In the absence of evidence or submissions to the contrary, I take the view that "rice kits" are products which contain rice and other ingredients, such as spices, and which require further preparation by the consumer (such as the addition of water or other ingredients, and further cooking) before they are ready to eat. They are not, therefore, ready meals or even ready-made side dishes; rather they are ingredients with which to make a meal or dish. Neither rice kits per se nor rice at large are relied upon in the pleadings. I therefore find that, for the purposes of these proceedings, Mrs Sapal's goodwill is in curry sauces/pastes, naan bread and pickles/chutneys. Mrs Sapal's goodwill is, moreover, clearly within the field of Indian foods. Having said that, the registered specification contains broad terms which can be interpreted in a number of ways and which cover a wide range of goods. Bearing all of that in mind, I consider that the following goods covered by the registered trade mark are goods in the same field of activity as Mrs Sapal's business and that a consumer might think the goods are provided by the same undertaking (with brief reasons in brackets, except where obvious or the goods are the same):

⁴³ Paragraph 36.

⁴⁴ Paragraph 37.

Class 29: Meat, fish, poultry, game (these include prepared meats etc. and are similar to curry sauces/paste); cooked fish and fish products for food (these include prepared fish etc. and are similar to curry sauces/paste); snacks and snack foods (bread-based snacks are similar to naan bread and Indian snacks are similar to curry sauces/pastes); pickles; dhals (similar to curry sauces/pastes); food pastes; food pastes prepared wholly or principally from foodstuffs included in class 29, pickled vegetables prepared for human foods (similar to pickles/chutneys); dried, boiled, frozen and cooked fruits and vegetables, including prepared, preserved, and processed fruit and vegetables and food products made from fruit and vegetables; vegetable and fruit spreads and pastes; mixtures of vegetables and herbs; snack foods containing vegetables; foodstuffs containing soya as the main constituent (all similar to curry sauces/pastes and/or pickles/chutneys); food products made from eggs (curried eggs similar to curry sauces/pastes); yoghurt (accompaniment to curry sauces); cheese, including Indian (ethnic) cheeses known as paneer mava and khoa; edible fats (all savoury Indian foods in same field as pleaded goods and/or accompaniments to curry sauces); drupes, all being prepared or processed (similar to chutneys, e.g. mango chutney); salted foods (similar to curry sauces/pastes); cooked, baked, processed potatoes; preparations and products, all of potatoes (similar to curry sauces/pastes, e.g. Bombay potatoes); snack foods; snack food products (as above); pickles; toppings for pizzas (similar to curry sauces/pastes); cooked foods in this class; cooked meals in this class, including frozen cooked meals and prepared and preserved meals; prepared curry dishes with or without rice; ready-prepared meals; frozen food products in this class (all similar to curry sauces/pastes).

Class 30: Farinaceous foods (similar to naan bread); rice; snacks, all of rice; rice products for food, including rice-based snack food; frozen prepared rice with seasonings and vegetables; sauces for rice; rice dishes; samosas (all similar to or accompaniments to curry sauces); preparations made from cereals (all similar to naan bread); bread and bread crumbs, rotis (Indian flat bread), nan breads,

pitras, parathas, chappatis, unleavened bread (all similar to naan bread); pastry (includes samosas); sauces and gravies; spices; curry powders, curry pastes, pickles and curry sauces, food pastes, masala, saffron; cooking sauces and cooking pastes; preparations for making sauces (all similar to curry sauces/pastes); indian (ethnic) savouries and snacks (all similar to curry sauces/pastes); spring rolls (similar to naan breads); condiments; chutneys (similar to pickles/chutneys); sweet and savoury spreads (similar to pickles/chutneys); flavourings in the form of concentrated and dehydrated sauces; flavourings made from fruits or vegetables; fruit sauces (all similar to curry sauces/pastes or chutneys); ginger; pizza bases (similar to naan breads); sauces for pizzas (similar to curry sauces/pastes); pastry, including frozen pastry filled with vegetables (includes samosas); soya products in this class, namely soya bean paste and soya sauce; dips (all similar to curry sauces or chutneys); frozen food products included in this Class; snack foods; snack food products (all similar to curry sauces/pastes and/or naan breads); spreads made from drupes (similar to (mango) chutney); aromatic preparations for food; cooked meals in this class, including frozen cooked meals and prepared and preserved meals (all similar to curry sauces/pastes).

61. I do not consider that there would be a misrepresentation in relation to the remaining goods.

62. In terms of the services, while they are all in the same general field of providing food and drink, Mrs Sapal's strongest case is, in my view, in relation to catering services. These services may entail an outside caterer attending a venue and providing a buffet meal, which could include various curry dishes. Although the evidence suggests that Mrs Sapal's goods were available for tasting at two exhibitions, it goes no further than that and, indeed, there is no claim of goodwill in relation to any services. In circumstances where the sign is of lower than average inherent distinctiveness, I am not persuaded that the modest goodwill enjoyed by Mrs Sapal would result in a misrepresentation to the public if the similar registered sign were used in relation to

catering services. The consumer may wonder if the services are from the same undertaking but I do not consider that they would purchase Mr Thukral's services in the mistaken belief that they are provided by Mrs Sapal, on the basis of her trade in curry sauces and the like.

Damage

63. In *Harrods Limited V Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation”.

64. This is a case where the most obvious type of damage, namely a loss of sales, is applicable. There may also be damage to the reputation of the business. Damage is made out.

65. It follows that the application for invalidity under s. 5(4)(a) succeeds in relation to the goods and services identified at paragraph 60 but not otherwise.

Section 3(6)

66. The application having been only partially successful under s. 5(4)(a), I must now examine the ground under s. 3(6). Section 3(6) of the Act states:

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

68. The relevant date under s. 3(6) is the date of the application, i.e. 21 August 2015.

69. This ground can be shortly dealt with. Mrs Sapal submits that Mr Thukral knew of her sign before he filed the application and that he filed the application to obtain a benefit by aligning himself with her business. There is no evidence whatsoever to support the claim that Mr Thukral knew either of Mrs Sapal's business or of her use of the sign at the application date. Even if Mr Thukral had known of her business, mere knowledge of someone else's use of the sign would not be enough to make out the ground. The first contact which Mr Thukral had with Mrs Sapal was over six months after he filed the application. I can see nothing in the reported telephone conversation or meeting to suggest that, at the date of application, Mr Thukral was acting in a commercially unacceptable manner. I find that the evidence is wholly insufficient to support an allegation of bad faith and the invalidation under s. 3(6) is dismissed accordingly.

Conclusions on the invalidation

70. Given my conclusions, above, the mark will remain registered for the following goods and services, which will form the basis of the assessment under s. 5(2)(b):

Class 29: Meat extracts; raw fish; sushi ingredients, namely edible seaweed, squids, octopus, shrimps, clams, prawns, scallops, ready meals; pulses; algae prepared for human foods; dried soya beans, preserved soya beans, soya bean milk and oil for food, soya cream; compotes; eggs; milk and milk products; edible

oils; roasted peanuts; peanut butter; peanuts, nuts, kernels, legumes, pods, all being prepared or processed; edible nuts and seeds, including those prepared as snack foods; mixtures of fruit and nuts; chocolate nut butter; crystallised, frosted and frozen fruit; dried, preserved and stuffed potatoes; cakes, snacks, chips, crisps, croquettes, flakes, fries, fritters, puffs, salad and skins, all of potatoes; beverages based predominantly on dairy products or yoghurt; flavoured milk drinks; ready-prepared desserts, namely dairy desserts, desserts made from curd with fruit or herb additives, desserts made from yogurts, fruit desserts, soya desserts.

Class 30: Sugar, tapioca, semolina, sago, couscous; biscuits, crackers, cakes, chips and puddings, all of rice; sushi; flour, including wheat flour, potato flour and corn flour; corn meal, oat meal, maize meal; noodles; biscuits (cookies); pastry consisting of fish; pretzels, gingerbread; cakes and edible decorations for cakes; buns, pancakes, tarts, waffles; confectionery, including mint-based and mint-flavoured confectionery and confectionery for decorating Christmas trees; sweetmeats; chewing gum, including mint-flavoured chewing gum; popcorn; puddings; quiches; royal jelly not for medical purposes; honey; treacle; indian (ethnic) sweets; yeast, baking-powder; salt; mustard; vinegar; carbohydrate preparations for food; capers; glucose for food; non-medicinal infusions; gluten for food; custard; pizzas; frozen pastry, filled with fruits; salad dressings; soya products in this class, namely soya-based ice cream, soya flour; ketchup; mayonnaise; pasta; pies, including meat pies; thickening agents for cooking foods; ice confectionery; ice cream products; ice cream powders; ice for refreshment; ice beverages; ices; starch for food; glucose syrups for food; thickeners; popcorn, peanut confectionery; spreads made from chocolate and from nuts, kernels, legumes, pods or peanuts; infusions; coffee, artificial coffee; tea; cocoa; coffee, tea and cocoa beverages with milk; beverages made from cereals; beverages made of tea or coffee; beverages containing ice-cream, chocolate, cocoa, coffee or tea; sherbets; flavourings, other than essential oils, for beverages; meat tenderisers; sandwiches; desserts in this class.

Class 32: Beer, ale, porter, lager and stout; mixtures containing beer, ale, porter, lager and stout shandy, de-alcoholised drinks, non-alcoholic beers and wines non-alcoholic beverages; fruit drinks, fruit juices and vegetable juices; mineral and aerated waters; water; spring water; soft drinks, sparkling drinks; carbonated and sparkling waters, flavoring and unflavored bottled waters; soda beverages; syrups and other preparations for making beverages.

Class 43: Catering services; coffee bar services, sandwich bar services, cafe services, cafeteria services, snack bars, wine bar, bar, cocktail bars, cafe and bar services served in a cybercafé; ice cream parlour services, restaurant services, self service restaurant services; hotel services; hotel reservation, restaurant public house services; serviced apartments for temporary accommodation; information, consultancy and advisory services relating to the aforementioned services including all the aforesaid services provided via the Internet, the world wide web and/or via communications networks.

Section 5(2)(b)

71. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

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

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

72. 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 are:

(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 will wrongly 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

73. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“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”.

74. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

75. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

76. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

77. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“[...] 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”.

78. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes,”

whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

79. In addition, I bear in mind the guidance given by Mr Alexander in the same case, where he warned against applying too rigid a test when considering complementarity:

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

Class 29

Fish; steaks of fish

80. The earlier specification includes the term “raw fish”, which is encompassed by the above terms, or vice versa. The goods are identical on the principle outlined in *Meric*.

Rapeseed oil for food

81. This term is encompassed by the wider term “edible oils” in the earlier specification. The goods are identical.

Prepared meals consisting substantially of seafood

82. The earlier specification includes “sushi ingredients, namely ready meals”. To my mind, that is another way of describing the identical goods covered by the applicant’s “prepared meals consisting substantially of seafood”. The goods are identical. If that is not right, the goods are highly similar, both being prepared foods which may be eaten as a main meal, with at least a highly similar nature, identical users, methods of use and channels of trade and a potentially competitive relationship. However, the term applied for is much wider than that of the earlier specification and could, notionally speaking, cover goods which are neither identical nor similar to the goods of the earlier mark. As matters stand, no fall-back specification has been provided and I will proceed on the basis that the goods are identical, though I will return to this point when I address the likelihood of confusion.

Chicken; chicken balls; chicken breast fillets; deep frozen chicken; meat, poultry; steaks of meat; turkey meat

83. All of these goods are animal flesh, including uncooked meats, and there is, therefore, some similarity in nature with “raw fish” in the earlier specification. Their purpose, method of use and users may all be identical, whilst there is overlap in their channels of trade. The goods may also be in competition. They are similar to a high degree.

Chick peas

84. The earlier specification includes the term “dried soya beans”. Chick peas may be dried or tinned. There is some similarity in nature and purpose, as both are legumes to be prepared and/or eaten. They may be used as alternative and so are in competition, and both users and channels of trade will overlap. There is no complementarity between these goods. They are similar to a high degree.

Prepared meals containing [principally] eggs

85. The earlier specification includes “eggs”. There is some similarity in nature and purpose between a meal consisting principally of eggs and “eggs” in the earlier specification (which would include prepared eggs, e.g. boiled eggs), though one is a complete meal whereas the other is an ingredient, albeit a principal ingredient. The goods are unlikely to be in close proximity in a retail store and it is, therefore, unlikely that there would be any significant overlap in their channels of trade. They are similar to a medium degree.

Prepared meals consisting primarily of meat substitutes; prepared meals consisting principally of game; prepared meals containing [principally] bacon; prepared meals containing [principally] chicken; prepared meals made from meat [meat predominating]; prepared meals made from poultry [poultry predominating]

86. The earlier specification contains, in class 30, the term “pies, including meat pies”. The use of “including” does not act as a limitation: the specification covers all kind of pie (though it would not include goods such as shepherd’s pie, which is proper to class 29). Whilst a pie is not usually a meal in itself, there is some similarity in nature and purpose with the above prepared meals. The goods are in competition, as a pie could be chosen as an alternative to a prepared meal and the channels of trade are likely to coincide. They are similar to a medium degree.

Cooked meat dishes; prepared meat dishes; prepared meat

87. These goods include goods such as shepherd's pie and therefore have some similarity in nature with "pies", which may be meat-based, although pies per se are usually encased in pastry rather than having, for example, a potato crust. Their purpose is the same. They share methods of use and channels of trade. They are likely to be in competition, as the consumer may choose a prepared meat dish as an alternative to a pie. The goods are similar to a medium degree.

Fruit paste; jams; preserves

88. The earlier specification includes "peanut butter". The goods have little similarity in nature, peanut butter being a dense spread made mainly or entirely of peanuts, whilst the above goods are gelatinous in texture and are usually made from fruit and sugar. There is, however, an overlap in their purpose and method of use, as both may be used for spreading on, for example, toast. They will usually be sold in discrete areas in a retail environment and are not complementary but they may be in competition. I consider that they are similar to a medium degree.

Bombay mix

89. The earlier specification includes "edible nuts and seeds, including those prepared as snack foods", which includes, for example, salted peanuts. The goods only overlap in nature to the extent that Bombay mix usually includes peanuts but they share a purpose and method of use, all being snack foods and, in particular, snack foods which may be served as nibbles in restaurants and bars, or at parties. The goods may serve as alternatives and there is, therefore, competition between them. They are unlikely to be on the same shelf in a supermarket, though they may be in the same aisle, and they are not complementary. They are similar to a fairly low degree.

Burgers; vegetable burgers

90. There is some similarity between these goods and the earlier specification's "pies" to the extent that both may be ingredients in a main meal and they are, therefore, similar in purpose and in competition. The channels of trade may coincide but they are different in nature and are not complementary. They are similar to a low degree.

Pickles

91. I can see no meaningful similarity between these goods and those in the earlier specification. I acknowledge that they may be used for spreading on bread, as is the earlier specification's "peanut butter" but pickles are typically accompaniments to other foods (such as cheese) rather than used on their own. They are not similar in nature and one would not be substituted for the other. There is no complementarity and nor is there a material overlap in their channels of trade. In the absence of any submissions on the point, I find that they are not similar.

Class 30

Beverages based on tea; beverages made of tea; confectionery; noodles; pizza; pizzas; popcorn; pop-corn; salt

92. Although not identically worded, these terms all have equivalents in the earlier specification and are plainly identical.

Identical goods included within broad terms

93. The following goods are included in broader terms in the earlier specification, or vice versa, and are identical on the principle outlined in *Meric*:

- “Biscuits containing fruit”, “biscuits flavoured with fruit”, “biscuits for cheese”, “biscuits [sweet or savoury]” are included within the term “biscuits, all of rice” in the earlier specification, or vice versa;
- “Chai (tea)” and “chai tea” are included within “tea” in the earlier specification;
- “Coated nuts [confectionery]”, “confectionery bars”, “frozen confectionery”, “snack bars consisting of chocolate”, “snack bars containing a mixture of grains, nuts and dried fruit [confectionery]”, “snack bars containing dried fruits [confectionery]”, “snack bars containing grains [confectionery]” and “snack bars containing nuts [confectionery]” are included within “confectionery” in the earlier specification;
- “Condiments” includes salt in the earlier specification;
- “Corn starch flour” and “corn starch [for food]” fall within “thickeners” in the earlier specification;
- “Dressings for food” includes “salad dressing” in the earlier specification;
- “Dry seasonings” and “seasonings” include “salt” in the earlier specification;
- “Essences for beverages and flavourings”, “flavourings” and “flavourings for beverages” cover “flavourings, other than essential oils, for beverages” in the earlier mark, or vice versa;
- “Filled baguettes”, “snack foods consisting principally of bread” and “toasted sandwiches” are included within the earlier term “sandwiches” or vice versa;
- “Fresh pizza”, “frozen pizzas”, “pizzas [prepared]”, “prepared meals in the form of pizzas” are encompassed by “pizzas” in the earlier specification;
- “Meals consisting primarily of rice”, “prepared meals containing [principally] rice”, “prepared rice dishes”, “rice based dishes” and “rice-based prepared meals” all include, or are included in, “sushi” in the earlier specification. However, the applied-for terms are much wider and could potentially include goods which are not similar. As no fall-back specification has been provided, I proceed on the basis that the goods are identical, though I will return to this point when I consider the likelihood of confusion;
- “Meal” encompasses “corn meal” in the earlier specification;

- “Meals consisting primarily of pasta” and “snack foods consisting principally of pasta” are encompassed by the broad term “pasta” in the earlier specification;
- “Mixes for making bakery products” would include mixes of flour, for example for breads, which also falls within the wide term “flour” in the earlier specification;
- “Popped popcorn” is included within the earlier mark’s “popcorn”;
- “Salt (cooking-), “salt (Cooking -)” and “sea salt for cooking” are included within “salt” in the earlier specification;
- “Snack food (Cereal-based -)”, “snack food products consisting of cereal products”, “snack food products made from cereal flour”, “snack food products made from cereal starch”, “snack food products made from cereals”, “snack food products made from rice flour”, “snack food products made from soya flour”, “snack foods consisting principally of confectionery”, “snack foods consisting principally of grain” and “snack foods made from cereals” are all very wide terms, which could include sweet snack bars/cereal bars. These goods are encompassed by the term “confectionery” in the earlier specification.

Snack food products made from rice; snack food (Rice-based -); snack foods consisting principally of rice

94. For the same reasons as given above in relation to the other snack foods and snack food products in the application, these goods may be considered to be identical to “confectionery”. However, the applicant’s term includes goods which are potentially dissimilar to the earlier mark’s specification, such as savoury snacks of curry and rice. I have already indicated that no fall-back specification has been provided: I will return to consider these terms when I decide whether there is a likelihood of confusion.

Chili oil for use as a seasoning or condiment

95. In class 29 of the earlier specification is the term “edible oils”, which includes oils such as olive oil and sesame oil. The nature of the goods is highly similar and they may

share the same purpose, method of use and channels of trade. Moreover, they may be in competition, though they are not complementary. They are similar to a high degree.

Condiments in powder form

96. These goods are similar to “salt” in their purpose, which is to flavour food as a condiment. Whilst the nature of the goods differs slightly, salt being more granular than powdery, their method of use and channels of trade are likely to be identical. They may also be in competition. They are similar to a high degree.

Prepared pizza meals

97. It is not entirely clear to me what a “pizza meal” is, assuming that there is any difference between a “pizza meal” and pizza per se. However, it seems reasonable to assume that it consists of pizza with other foodstuffs such as, for example, a salad. Given that the earlier specification includes “pizzas”, which could be uncooked or ready to eat, there is a high degree of similarity with “pizza meals”, both having identical goods (pizzas) as their sole or main component, their nature and purpose being similar and the goods having a potentially competitive relationship.

Nachos; snack food products made from maize flour; snack food products made from potato flour; snack foods made from corn

98. These goods are identical in purpose, method of use, and channels of trade, and have a good degree of similarity in nature, to “crisps”. They may be in competition but they are not complementary. They are highly similar

Snack food products made from rusk flour

99. This term includes biscuits made of rusk. If not identical to “biscuits (cookies)” in the earlier specification, they are similar to a high degree, sharing a good deal of similarity

in nature and identical purpose, method of use and channels of trade. The goods are also in competition.

Burgers contained in bread rolls

100. These goods share a similar nature and purpose with “sandwiches” in the earlier specification, both being bread rolls filled with meat (among other things, in the case of sandwiches). Their method of use is the same and they may be in competition but they are not complementary. They are similar to a reasonably high degree.

Brown rice; cooked rice; frozen prepared rice; frozen prepared rice with seasonings; frozen prepared rice with seasonings and vegetables; prepared rice; rice; wholemeal rice

101. The closest term in the earlier specification is, to my mind, “couscous”, which includes prepared (fresh or frozen) and uncooked couscous. The nature of the goods differs but they may share the same purpose, method of use and users. There may be a competitive relationship between the goods, with one being purchased as an alternative to the other and, while they are unlikely to be on exactly the same shelf in a retail environment, it is likely that they will be in the same aisle. The goods are similar to a reasonably high degree.

Sauces [condiments]

102. This broad term includes goods such as Worcestershire sauce. The earlier specification includes “vinegar” and, as the goods are both thin sauces added to food as a condiment they are similar in nature and may be identical in both purpose and method of use. They will usually be found close to one another in a retail setting and are in competition. They are similar to a reasonably high degree.

Cooking sauces; concentrated sauce; mixes for preparing sauces; preparations for making up into sauces; prepared foodstuffs in the form of sauces; ready-made sauces; sauce mixes; sauce powder; sauce powders; sauce (tomato); sauce (Tomato); sauces; sauces for food; sauces for pasta; sauces for use with pasta; savory sauces

103. All of the above include pasta sauces or mixes for making pasta sauces. The earlier specification includes the term “pasta”. Although the nature of the goods differs, both are intended to be ingredients in pasta dishes and there is an overlap in their channels of trade, particularly as pasta and pasta sauces may be found on display in close proximity to one another. They are also complementary goods, as they are used together and because the consumer might assume that the same or connected undertaking is responsible for the goods. They are similar to a medium degree.

Popcorn seasoning

104. It is not entirely clear to me what “popcorn seasoning” is if it is not salt. I proceed on the basis that it is a mixture of salt and other ingredients, such as herbs, which may be added to popcorn. There is a medium degree of similarity with “salt” in the earlier mark, as the goods share a similar nature and purpose, as well as method of use. They may be sold in close proximity in a retail environment and may be in competition but they are not complementary.

Pizza sauce; pizza sauces; sauces for pizzas

105. The earlier specification includes the term “pizzas”. As the above are ingredients in a pizza rather than the finished article, there is some difference in nature, purpose and method of use. However, pizza sauces will be used with pizzas and the nature of the goods is such that it would not be unreasonable to expect a producer of pizzas also to sell their pizza sauces. The goods are, therefore, complementary and there is potential competition to the extent that a consumer may purchase individual ingredients for a

pizza so that they can make their own pizza, rather than purchasing a ready-made pizza. They are similar to a medium degree.

Vegetable-based seasonings for pasta

106. Again, I have no submissions from the parties to explain this term or any potential similarity with the goods and services in the earlier specification. I proceed on the basis that it may include goods such as mixtures of vegetables, potentially dried, which may be added to pasta/pasta sauces for flavouring. Whilst the goods are different in nature from “pasta” in the earlier specification, they have some degree of similarity in purpose, as both are used in the preparation of a pasta dish. They are used together and the average consumer is likely to think that responsibility for the goods lies with the same undertaking: they are complementary. The goods are similar to a fairly low degree.

Preparations for making pizza bases

107. The earlier specification includes the term “pizzas”. There is some difference in nature because, although a pizza will include a pizza base, the goods applied for are the ingredients for making the base (and will usually require the addition of, at least, water to make a dough). Whilst they may be sold in the same shops, it is unlikely that they would be in the same section as prepared pizzas. However, the users are likely to be the same and there may be some limited competition, as the consumer may purchase preparations for making a pizza base instead of purchasing a ready-made complete pizza. They are similar to a low degree.

Mixed spices; pizza spices; spice mixes; spices

108. The above terms are or include “pizza spices”. The earlier specification includes “pizzas”. Although the goods are different in nature, in their specific purpose and in their method of use, they are complementary as they will be used together and the consumer

may think that the same or a connected undertaking is responsible for the goods. They are similar to a low degree.

Chili; chili powders; chili seasoning; cloves; cloves [spice]; curry mixes; curry powder; curry powder [spice]; curry powders; curry [seasoning]; curry [spice]; dried chili peppers [seasoning]

109. The closest term in the earlier specification is “salt”. The nature of the goods is different, with salt being a mineral which is, even in its finest form, granular. Spices are organic (e.g. seeds and leaves) and, when ground, powdery in nature. The goods share a similar purpose and method of use at a high level of generality, as they are all used to flavour food. However, the specific flavouring purpose will differ. Although salt and spices may both be used in the cooking process, they are not complementary in the sense outlined in the case law and they are not alternatives to one another, so are not in competition. They may be sold in similar areas of a supermarket but there would normally be a distinct separation between salts and spices: they are unlikely to be on the same shelf. I find that there is no meaningful similarity between these goods.

Essences for cooking [other than essential oils]; essences for food [other than essential oils]; essences for foods; essences for foodstuffs, except etheric essences and essential oils; essences for use in cooking [other than essential oils]; essences for use in food preparation [other than essential oils]

110. There is some similarity in purpose between these goods and “flavourings [...] for beverages” in the earlier specification, but it is at a high level of generality and the specific purpose of the goods (to flavour food or to flavour beverages) differs. Although both may be liquids, flavourings for beverages tend to be both more viscous and sweeter than food essences. The goods are unlikely to be in competition and they are not complementary. Nor do I consider that there is any material overlap in their channels of trade. There is no meaningful similarity between these goods.

Chili paste for use as a seasoning; chili sauce; chutney; chutneys; chutneys [condiments]; curried food pastes; curry paste; curry pastes; curry sauces; food pastes; marinades; marinades containing herbs; marinades containing seasonings; marinades containing spices; naan bread; nan bread; popadoms; poppadoms; poppadums; sauces for barbecued meat; sauces for chicken; sauces for frozen fish; sauces for rice; seasoning marinade; tortillas

111. I can see no meaningful similarity between these remaining goods in the application and any of the goods or services in the earlier specification. In relation to the services, whilst some of these products (e.g. naan bread) may be served in, for instance, an Indian or Mexican restaurant, that is not sufficient, of itself, to engage overall similarity between the goods and the services. In the absence of any obvious similarity or any submissions on the point, I find that they are not similar.

Class 32

Beer; beers; beverages (non-alcoholic); beverages (Non-alcoholic); non-alcoholic beer; non-alcoholic beverages

112. These terms all have direct counterparts in the earlier registration and are self-evidently identical.

Alcohol free beverages; fruit-flavored beverages; fruit-flavoured beverages; non-alcoholic beer flavored beverages; non-alcoholic beverages containing fruit juices; non-alcoholic beverages with tea flavor; non-alcoholic cinnamon punch with dried persimmon (sujeonggwa); non-alcoholic cocktail bases; non-alcoholic cocktail mixes; non-alcoholic cocktails; non-alcoholic drinks; non-alcoholic fruit cocktails; non-alcoholic fruit drinks; non-alcoholic fruit extracts; non-alcoholic fruit extracts used in the preparation of beverages; non-alcoholic fruit juice beverages; still water

113. All of these goods fall within the term “non-alcoholic beverages” in the earlier specification. They are identical based on the principle outlined in *Meric*.

Beer-based beverages; beer-based cocktails

114. These goods are encompassed within the term “mixtures containing beer”. They are identical under *Meric*.

Class 43

Bar services; bars; café services; cafés; cafeteria services; cafeterias; catering (Food and drink); “catering for the provision of food and beverages”; “catering of food and drinks”, “catering services”; “catering services for the provision of food and drink”; providing hotel services; restaurant services; restaurants; restaurants (self service); restaurants (Self-service -); snack bar services; snackbars; snack-bars

115. Although not all are identically worded, these terms have direct counterparts in the earlier specification and the services are identical.

116. I consider that the following services are identical based on the principle identified in *Meric*:

- “Catering services for company cafeterias”, “catering services for conference centers”, “catering services for educational establishments”, “catering services for hospitality suites”, “catering services for hospitals”, “catering services for nursing homes”, “catering services for providing European-style cuisine”, “catering services for providing Japanese cuisine”, “catering services for providing Spanish cuisine”, “catering services for retirement homes”, “catering services for schools”, “catering services for the provision of food”, “food and drink catering for banquets”, “food and drink catering for cocktail parties”, “food and drink catering for institutions”, “food cooking services”, “food preparation”, “food preparation for

others on an outsourcing basis”, “food preparation services”, “hotel catering services”, “outside catering services”, “providing food and drink catering services for convention facilities”, “providing food and drink catering services for fair and exhibition facilities”, “providing food and drink for guests” and “serving food and drink for guests”, include, or are included within, “catering services” in the earlier specification;

- are encompassed by “catering services” in the earlier specification, or vice versa;
- “Self-service cafeteria services” are included within the broader term “cafeteria services” in the earlier specification;
- “Serving food and drink in bars” falls within the broad term “bar services” in the earlier specification, as it is usual for a bar service to include the provision of food (though perhaps in the form of snacks rather than meals) as well as drinks;
- “Carvery restaurant services”, “fast food restaurant services”, “fast-food restaurants”, “providing food and drink for guests in restaurants”, “providing food and drink in bistros”, “self-service restaurants”, “serving food and drink for guests in restaurants”, serving food and drink in restaurants”, “serving food and drinks” and “supplying of meals for immediate consumption” are encompassed by “restaurant services” in the earlier specification, or vice versa;
- “Providing food and drink in Internet cafés”, “serving food and drink in Internet cafés” are covered by the earlier “café services”;
- “Providing food and drink in doughnut shops”, “serving food and drink in doughnut shops”. A doughnut shop is, in my view, a type of snack bar. These services are included within the earlier mark’s “snack bars” services;
- “Providing hotel accommodation” is encompassed by “hotel services” in the earlier specification.

Coffee shop services; coffee shops

117. The earlier specification includes “café services”. In my experience as an average consumer of these services, the terms “café” and “coffee shop” are used interchangeably to describe identical services. The services are identical.

Canteen services; canteens

118. A canteen is a type of restaurant, usually self-service and located in a place of work such as a factory or office building. There is, to my mind, no material difference between a canteen and a cafeteria, as both terms could be used to describe the identical services provided in the same way to identical users. These services are identical to the earlier specification's "cafeteria services".

Tea room services

119. I can see no meaningful difference between tea room services and the café services in the earlier specification. Both provide beverages and, usually, a small selection of food such as cakes, with a seating area for consumers to use. There is identity of nature, purpose and method of use as well as in users and channels of trade. If the services are not identical, they are similar to the highest degree.

Providing motel services

120. These services are concerned with providing temporary, serviced accommodation, by the room. They share the same core nature and purpose as "hotel services" in the earlier mark, though I accept that "hotel services" is potentially wider. The users intersect, as do their methods of use. The services may be in competition, as one serves as an alternative to the other. They are similar to a very high degree.

Beer garden services

121. These services share a similar nature and purpose with "bar services" in the earlier specification, as both provide beer. Moreover, it is commonplace for bars (and restaurants and pubs) to have a beer garden attached to the indoor premises. The users, method of use and channels of trade overlap and they are in competition. The services are highly similar.

Juice bars

122. There is a high degree of similarity between these services and “coffee bar services” in the earlier specification: both are concerned with the preparation and provision of non-alcoholic beverages. The nature of the services coincide and, as most coffee bars also offer juices, the channels of trade overlap. The methods of use are the same and the services may be in competition.

Providing food to needy persons [charitable services]; supplying meals to the homeless or underprivileged

123. In the absence of any submissions to persuade me otherwise, these services include all types of provision of food, which would include canteen/cafeteria-type food provision, though it is likely that there would be no charge to the user of the service. Nonetheless, as the services may be otherwise identical, they are similar to cafeteria services to a high degree.

Food takeaway service; take-away fast food services

124. These services share the same intended purpose of providing food and drink, as well as some similarity in nature, with restaurant services. It is common for a restaurant to offer a take-away service in parallel to its eat-in services, so channels of trade may overlap. Whilst there is some difference in the method of use, there is competition between the services, as a take-away may be chosen instead of a meal in a restaurant. The services are similar to a reasonably high degree.

Providing exhibition facilities in hotels; providing facilities for exhibitions; providing facilities for fairs and exhibitions

125. It is common for hotels to offer additional services alongside the provision of sleeping accommodation, such as the provision of conference facilities and the letting

out of function rooms. There is therefore a clear overlap in users and channels of trade between the services in the application and the earlier “hotel services”, as well as potential competition. I consider that the services are similar to a medium degree.

126. If the goods or services are not similar, there can be no confusion.⁴⁵ Accordingly, the opposition against the following goods is hereby dismissed:

Class 29: Pickles.

Class 30: Chili; chili paste for use as a seasoning; chili powders; chili sauce; chili seasoning; chutney; chutneys; chutneys [condiments]; cloves; cloves [spice]; curried food pastes; curry mixes; curry paste; curry pastes; curry powder; curry powder [spice]; curry powders; curry sauces; curry [seasoning]; curry [spice]; dried chili peppers seasoning; essences for cooking [other than essential oils]; essences for food [other than essential oils]; essences for foods; essences for foodstuffs, except etheric essences and essential oils; essences for use in cooking [other than essential oils]; essences for use in food preparation [other than essential oils]; food pastes; marinades; marinades containing herbs; marinades containing seasonings; marinades containing spices; naan bread; naan bread; popadoms; poppadoms; poppadums; sauces for barbecued meat; sauces for chicken; sauces for frozen fish; sauces for rice; seasoning marinade; tortillas.

The average consumer and the nature of the purchasing act

127. It is necessary for me to determine who the average consumer is for the respective parties’ goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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

⁴⁵ *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik*.

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

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

129. Mr Thukral submits that the goods and services at issue “are aimed at a non-specialised and non-technical market, and so the average consumer in this instance will be the general public. The public are also accustomed to purchasing these goods”.⁴⁶ I agree that the average consumer of the goods at issue is a member of the general public. I also agree that the average consumer for the majority of the services will also be a member of the general public. However, in relation to catering services, in addition to the general public, there would be a second group of relevant consumer, namely business users. I also consider that the average consumer of exhibition facilities is more likely to be a professional than the general public.

130. The goods at issue are foodstuffs and both alcoholic and non-alcoholic beverages. They are likely to be self-selected from the shelves of retail premises, primarily supermarkets, and from their online equivalents. However, particularly in the case of alcoholic beverages, trade channels will also include bars, public houses and off licences, where the consumer will be exposed to the marks on menus, taps and bottles.

⁴⁶ Submissions dated 20 February 2017, paragraph 9.

For all of the goods, the purchase is likely to be dominated by visual considerations, although I do not rule out an aural component. The level of attention paid is likely to vary across the very wide range of goods in the specifications. However, the goods are all of the type which are bought often or which would appear reasonably frequently on a household shopping list. Some of the goods, such as snack foods, are likely to be bought with a fairly low level of attention, whilst others, such as alcoholic beverages, will be bought with an average degree of attention. Absent submissions to the contrary, I can see no goods which would be bought with level of attention that is higher than average.

131. For the services at issue, the purchasing process is also likely to be dominated by visual considerations, as the average consumer is likely to select the services at issue following inspection of the premises' frontage on the high street, a website or advertisements in magazines, or on posters. However, given that word-of-mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services.

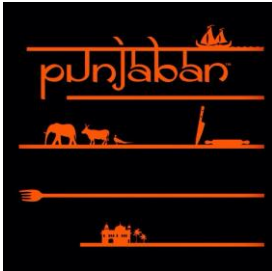
132. The average consumer's level of attention will vary across the services, depending on factors such as the type of the food and drink provided, the cost of the service offered and the nature of the establishment/event. However, generally speaking, the member of the general public purchasing the services at issue will do so with an average degree of attention. I consider that the position for catering and exhibition services is slightly different as, for the relevant average consumer, considerable sums may be laid out and the quality and efficiency of the service are likely to be of particular concern. As a result, I consider that the average consumer purchasing these services will pay a higher than average, though not the highest, degree of attention to the selection of the service.

Comparison of trade marks

133. It is clear from *Sabel* (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 *Bimbo*, 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”.

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

Earlier mark	Application
Punjaban	

135. I have no submissions from the company regarding the similarity between the marks. Mr Thukral submits that:

“[The company’s] mark is dominated by the word punjaban. This is also the distinctive element of [the company’s] Mark. The graphic elements of [the company’s] mark do not bestow the Mark with any distinctiveness and are negligible. When globally assessing the marks, these elements can be discounted. Therefore, the dominant and distinctive element of [the company’s] Mark is identical to the Earlier Mark, namely Punjaban. For this reason, the marks must be deemed highly similar”.

136. The earlier mark consists of the word “Punjaban”, presented in title case. There are no other elements to contribute to the overall impression, which is contained in the word itself.

137. The mark for which registration is sought is more complex. The word “punjaban” is presented in lower case, in a stylised orange typeface. In addition, there are five evenly spaced horizontal lines, also in orange. One horizontal line is above the word “punjaban”, the remainder are below it. There are also a number of small device elements. The first is a boat, which is presented on the uppermost horizontal line. On the left of the third line are an elephant, a cow and (possibly) a bird and, on the right, a knife and a rolling pin. The fourth line has at its end the tines of a fork, giving the impression of a fork with a very long handle. The fifth line features what appears to be a building but it is too small to make out clearly. All of these verbal and figurative elements are presented on a square black background. I consider that the position and relative size of the word “punjaban” are such that this verbal element will dominate the overall impression of the trade mark, though not overwhelmingly. Whilst the individual device elements are very small, and some (such as the knife) are relatively low in distinctive character, the horizontal lines and devices together, whilst secondary to the verbal element, still play an important part in the overall impression. The black background, by contrast, is likely to be given little or no trade mark significance.

138. In terms of the visual similarity between the marks, both share the same word “Punjaban”/“punjaban”. However, the mark applied for has a device element, absent in the earlier mark, which makes an important visual impact. The marks are visually similar to a medium degree.

139. As far as aural similarity is concerned, the device element in the mark applied for will not be vocalised. The word “Punjaban”/“punjaban” will be pronounced in the same way in both marks. They are aurally identical.

140. The device elements in the application are not, in my view, sufficiently pronounced to convey a clear conceptual message. I indicated at paragraph 57, above, that the word “Punjaban”/“punjaban” is allusive of a characteristic of the goods, bringing to mind an association with the Punjab. I consider that the marks are conceptually identical.

Distinctive character of the earlier trade mark

141. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, 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-2779, 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)".

142. Invented words usually have the highest degree of distinctive character, while words which are descriptive of the goods normally have the lowest. Distinctiveness can be enhanced through use of the mark but, no evidence having been filed by Mr Thukral, I have only the inherent position to consider. I indicated, above, that the mark is, in my view, allusive of a particular type of cuisine. In relation to goods and services which are associated with India, the mark has a lower than average level of inherent distinctive character; for other goods and services, the mark has an average degree of inherent distinctiveness.

Likelihood of confusion

143. The factors considered above have a degree of interdependency (*Canon* at [17]), i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. A global assessment of the competing factors must be made when determining whether there is

a likelihood of confusion (*Sabel* at [22]). It is a matter of considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]). Confusion can be direct (where the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). Indirect confusion was explained by Iain Purvis, Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*, Case BL-O/375/10, where he stated that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even

where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example”).

144. The marks are visually similar to a medium degree, and aurally and conceptually identical. I indicated, at paragraph 142, that the earlier mark has a lower than average level of inherent distinctiveness in relation to goods and services associated with India. That is a factor I will bear in mind, though I must also guard against giving it excessive weight in the global assessment. In *L’Oréal SA v OHIM*, Case C-235/05 P, the CJEU stated that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing

considerations and not that that difference denoted goods from different traders”.

145. The goods at issue are similar to varying degrees, from being identical to having only a low degree of similarity. The level of attention with which they will be purchased also varies, from a fairly low to a medium level of attentiveness. The position most favourable to the company is in relation to goods with only a low degree of similarity which will be purchased with a medium level of attention. However, notwithstanding the fairly low degree of inherent distinctiveness of the earlier mark for certain goods, I am of the view that there will be a likelihood of indirect confusion. The presence in both marks of the identical word element, in this instance, will result in a likelihood that the average consumer will consider that the mark applied for is a variant mark used by the same undertaking that uses the earlier mark. It follows that the same applies where the earlier mark has an average level of inherent distinctive character.

146. The services at issue range from identical to similar to a medium degree. They will be purchased with an average to a reasonably high level of attention. Even taking the company’s best case, namely that the services share a medium degree of similarity and will be bought with a higher than average level of attention, and the earlier mark has fairly low inherent distinctiveness, I consider that there will be a likelihood of confusion. The stylised and device elements in the application are insufficient, in my view, to offset the similarity created by the presence of the identical word in both marks.

Conclusion

147. I indicated, above, that the following terms in the application cover a wide range of goods, some of which are likely to be neither identical nor similar to the goods covered by the earlier mark: “prepared meals consisting substantially of seafood” (class 29); “meals consisting primarily of rice”, “prepared meals containing [principally] rice”, “prepared rice dishes”, “rice based dishes”, “rice-based prepared meals”, “snack food products made from rice”, “snack food (Rice-based -)” and “snack foods consisting

principally of rice” (class 30). Given that the application is to be refused in part, Tribunal Practice Notice (“TPN”) 1/2011 applies. The TPN reflects the comments of Mann J in *Giorgio Armani SpA v Sunrich Clothing Ltd* [2010] EWHC 2939 (Ch) in relation to partial refusals of registration, where he stated that:

“[...] the proper scope of registration [...] is the [potential area of dispute]. In some cases it will not be a real area of dispute because the answer is obvious - it might be possible to isolate the permissible part by blue pencilling that which is not admissible, or it might be obvious that a plain express qualification (“save for [the goods in respect of which the opposition succeeded]”) will do the trick, in which case there is no real area of dispute there either. On the other hand, it might be that the answer to that part of the case is more disputed - particular formulations might be objected to as falling on one side of the line or the other. Procedures ought to allow for all these possibilities”.

148. The tribunal’s letter of 4 July 2017 invited the parties to file a fall-back specification. No such fall-back specification was received. Bearing in mind the clearly defined area of interest which has been demonstrated by Mrs Sapal/the company, I consider that it is appropriate to limit the goods in question as follows:

“Prepared curry meals consisting substantially of seafood” (class 29)

“Curry meals consisting primarily of rice”, “prepared curry meals containing [principally] rice”, “prepared rice dishes containing curry”, “rice based curry dishes”, “rice-based prepared curry meals”, “snack food products containing curry made from rice”, “snack food containing curry (Rice-based -)” and “snack foods containing curry consisting principally of rice” (class 30)

149. The invalidation against UK trade mark registration number 3123559 has succeeded in part. The mark will be invalidated for the following goods:

Class 29: Meat, fish, poultry, game; cooked fish and fish products for food; snacks and snack foods; pickles; dhals; food pastes; food pastes prepared wholly or principally from foodstuffs included in class 29, pickled vegetables prepared for human foods; dried, boiled, frozen and cooked fruits and vegetables, including prepared, preserved, and processed fruit and vegetables and food products made from fruit and vegetables; vegetable and fruit spreads and pastes; mixtures of vegetables and herbs; snack foods containing vegetables; foodstuffs containing soya as the main constituent; food products made from eggs; yoghurt; cheese, including Indian (ethnic) cheeses known as paneer mava and khoa; edible fats; drupes, all being prepared or processed; salted foods; cooked, baked, processed potatoes; preparations and products, all of potatoes; snack foods; snack food products; pickles; toppings for pizzas; cooked foods in this class; cooked meals in this class, including frozen cooked meals and prepared and preserved meals; prepared curry dishes with or without rice; ready-prepared meals; frozen food products in this class.

Class 30: Farinaceous foods; rice; snacks, all of rice; rice products for food, including rice-based snack food; frozen prepared rice with seasonings and vegetables; sauces for rice; rice dishes; samosas; preparations made from cereals; bread and bread crumbs, rotis (Indian flat bread), nan breads, pitas, parathas, chappatis, unleavened bread; pastry; sauces and gravies; spices; curry powders, curry pastes, pickles and curry sauces, food pastes, masala, saffron; cooking sauces and cooking pastes; preparations for making sauces; indian (ethnic) savouries and snacks; spring rolls; condiments; chutneys; sweet and savoury spreads; flavourings in the form of concentrated and dehydrated sauces; flavourings made from fruits or vegetables; fruit sauces; ginger; pizza bases; sauces for pizzas; pastry, including frozen pastry filled with vegetables; soya products in this class, namely soya bean paste; soya sauce; dips; frozen food products included in this Class; snack foods; snack food products; spreads made from drupes; aromatic preparations for food; cooked meals in this class, including frozen cooked meals and prepared and preserved meals.

150. The opposition against UK trade mark 3153458 has been successful in part. The mark will proceed to registration for the following goods only:

Class 29: Pickles; prepared curry meals consisting substantially of seafood.

Class 30: Chili; chili paste for use as a seasoning; chili powders; chili sauce; chili seasoning; chutney; chutneys; chutneys [condiments]; cloves; cloves [spice]; curried food pastes; curry meals consisting primarily of rice; curry mixes; curry paste; curry pastes; curry powder; curry powder [spice]; curry powders; curry sauces; curry [seasoning]; curry [spice]; dried chili peppers seasoning; essences for cooking [other than essential oils]; essences for food [other than essential oils]; essences for foods; essences for foodstuffs, except etheric essences and essential oils; essences for use in cooking [other than essential oils]; essences for use in food preparation [other than essential oils]; food pastes; marinades; marinades containing herbs; marinades containing seasonings; marinades containing spices; naan bread; nan bread; popadoms; poppadoms; poppadums; prepared curry meals containing [principally] rice; prepared rice dishes containing curry; rice based curry dishes; rice-based prepared curry meals; sauces for barbecued meat; sauces for chicken; sauces for frozen fish; sauces for rice; seasoning marinade; snack food products containing curry made from rice; snack food containing curry (rice-based -); snack foods containing curry consisting principally of rice; tortillas.

The application will be refused for all of the other goods and services.

Costs

151. Both parties have enjoyed some success in classes 29 and 30 but Mr Thukral has been successful in relation to classes 32 and 43 in both actions. Mr Thukral is, therefore, entitled to a contribution towards his costs but the award below reflects the partial success and the fact that he filed no evidence. Awards of costs in proceedings

commenced before 1 July 2016 are governed by Tribunal Practice Notice (“TPN”) 4 of 2007, whilst for awards of costs commenced on or after that date Annex A of TPN 2 of 2016 applies. These proceedings straddle the material date. However, the only difference in the scales is at the upper end. I award costs to Mr Thukral on the following basis:

Considering the TM26(I) and
filing the TM7F and counterstatement: £200

Considering the other side’s evidence
and filing submissions: £500

Total: £700

152. I order Punjaban Ltd and Charanjit Sapal, jointly and severally, to pay Balwinder Singh Thukral the sum of **£700**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of November 2017

**Heather Harrison
For the Registrar
The Comptroller-General**