

**O-759-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3276898 BY  
KASHMIR CROWN BAKERIES LTD**

**TO REGISTER THE TRADE MARK:**



**FOR GOODS CLASS 30**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 60000855  
BY TAJ FOODS LTD**

## BACKGROUND AND PLEADINGS

1) On 13 December 2017 Kashmir Crown Bakeries Ltd. (“the Applicant”) applied to register the following trade mark:



The application was published for opposition purposes on 9 March 2018. Registration is sought for the following goods, all of which are opposed in these proceedings:

**Class 30:** *Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.*

2) The application is opposed by Taj Foods Ltd. (“the Opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Opponent relies upon the following UK and European Union trade marks:

3) UK registration No. 2248603 was filed on 13 October 2000 and completed its registration procedure on 20 April 2001 for the following sign:



In its notice of opposition the goods relied on by the Opponent under UK registration No. 2248603 are given as all those listed in Class 29 in its specification, though use of the mark is claimed only for *dry food stuffs*.

4) EU trade mark No. 7015795 was filed on 25 June 2008 and completed its registration procedure on 26 April 2012 for the following sign:



In its notice of opposition the goods relied on by the Opponent under EU trade mark No. 7015795 are given as all those listed in Classes 29, 30 and 31 in its specification, though use of the mark is claimed only for *coffee, tea, cocoa, sugar, coffee, bread, pastry and confectionery, ice cream, honey, treacle; yeast, baking powder, ice* in Class 30.

5) UK registration No. 2534509 was filed on 17 December 2009 and completed its registration procedure on 02 April 2010 for the following sign:

**TAJ**

In its notice of opposition the goods relied on by the Opponent under UK registration No. 2534509 are given as all those listed in Classes 29, 30 and 31 in its specification, though use of the mark is claimed only for *coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar honey treacle; yeast, baking powder; salt; mustard; vinegar, sauces (condiments); spices; ice* in Class 30.

6) The significance of the dates given above is that (1) the marks relied on by the Opponent constitute earlier marks in accordance with section 6 of the Act, and (2) they are subject to the proof of use conditions contained in section 6A of the Act, their respective registration procedures having been completed five years or more before the publication of the Applicant's mark. This means that only goods for which use of the respective marks has been claimed and proved may be relied on in the opposition.

7) The Opponent claims that the mark applied for is similar to the earlier marks and that the goods of the competing marks are identical or similar, so that there is a likelihood of confusion. In its counterstatement the Applicant denies the grounds of opposition and contends that the Opponent has failed to discharge the evidential burden placed upon it to prove on the balance of probabilities that the prior

registrations upon which it relies have been put to genuine use within the five year period leading up to the advertisement of the opposed application on 9 March 2018 (“the relevant period” – i.e. 10 March 2013 to 9 March 2018). The Applicant is represented in these proceedings by HGF Limited. The Opponent is not professionally represented.

8) Rules 20(1)-(3) of the Trade Marks Rules (“TMR” – the provisions which provide for the filing of evidence) do not apply to fast track oppositions such as the present proceedings, but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

The net effect of these provisions is that parties are required to seek leave in order to file evidence (other than the proof of use evidence, which is filed with the notice of opposition) in fast track oppositions. Neither side sought leave to file evidence in these proceedings.

9) Rule 62(5) (as amended) of the Trade Marks Rules 2008 (as amended by the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013) (“the Rules”) provides that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken. Neither side requested a hearing. Both parties filed written submissions in lieu of a hearing. I therefore give this decision after a careful review of all the papers before me.

### **Proof of use: the law**

10) Since the respective registration procedures for all the earlier marks were completed more than five years before publication of the opposed mark, in order to rely on the earlier marks for the purposes of its claims under section 5(2)(b) of the Act the Opponent needs to show genuine use of the earlier mark. The relevant provisions are as follows:

“6A. (1) This section applies where -

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if -

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

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

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

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

11) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

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

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29];

*Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

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

[22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

12) Whereas a national mark need only have been used in the Member State in question, in the case of an EU trade mark there must be genuine use of the mark “in the Union”. In this regard, the Court of Justice has laid down additional principles to those summarised above which Arnold J (at paragraph 118) summarised in the following additional three points:

9) The territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to genuine use in the Union: *Leno* at [44], [57].

(10) While it is reasonable to expect that a EU trade mark should be used in a larger area than a national trade mark, it is not necessary that the mark should be used in an extensive geographical area for the use to be deemed genuine, since this depends on the characteristics of the goods or services and the market for them: *Leno* at [50], [54]-[55].



(11) It cannot be ruled out that, in certain circumstances, the market for the goods or services in question is in fact restricted to the territory of a single Member State, and in such a case use of the EU trade mark in that territory might satisfy the conditions for genuine use of a EU trade mark: *Leno* at [50].

13) Section 100 of the Act is also relevant. It provides as follows:

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

**Use of the earlier marks in a form which does not alter their distinctive character**

14) I note at the outset that the sign covered by EU trade mark registration No. 7015795 consists of the word TAJ in mildly decorative font surrounded by a simple outline of an “onion dome” in the oriental style. The sign covered by UK trade mark registration No. 2248603 is identical but for the small and entirely descriptive word BRAND in very small letters at the bottom of the sign. This insignificant addition does not alter the distinctive character of the sign, so that I would consider use of the sign with or without this element as constituting use of both marks. For the sake of simplicity I shall refer to both simply as “the figurative TAJ sign”.

15) The test of when a mark can be regarded as used in a form differing in elements which do not alter its distinctive character, and the relevant case law, is discussed by Arnold J in *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) at paragraphs 119-123. He points out that it is possible in an appropriate case for use of the word element of a figurative mark on its own to constitute use of the trade mark. Nevertheless, although the figurative TAJ sign is dominated by the word TAJ, I consider that the onion dome outline of the figurative TAJ sign does also make some contribution to the distinctive character of the TAJ sign, and that use of the figurative sign would not therefore constitute use of the word sign covered by UK registration No. 2534509. As will be seen, however, in the event nothing turns on this.

## **Goods in respect of which use is claimed**

16) Under UK registration No 2248603 and EU trade mark number 7015795, which both cover what I have called the figurative TAJ sign, the Opponent claims use of *dry food stuffs* and of *coffee, tea, cocoa, sugar, coffee, bread, pastry and confectionery, ice cream, honey, treacle; yeast, baking powder, ice* “throughout the UK” and in “Austria, Belgium, Latvia, Cyprus, Malta, Netherlands, Denmark, Estonia, Portugal, Finland, France, Germany, Spain, Hungary, Sweden, Ireland and the United Kingdom” respectively in Class 30. Under UK registration No. 2534509 the Opponent claims use of *coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar honey treacle; yeast, baking powder; salt; mustard; vinegar, sauces (condiments); spices; ice* in Class 30 “throughout the UK”.

## **The evidence of use**

17) With regard to sales figures the Opponent has provided only the following brief and generalized statement for all three earlier marks:

*“£5.7m – 2017 Sales for Taj brand products, typical unit price is 1.99 for Taj Products.”*

In a statement appended to its notice of defence the Applicant submitted that the *“unsubstantiated statement claiming sales in 2017 of £5.7 million is wholly insufficient to substantiate the use claim made”*. In its further written submissions in lieu of attendance at a hearing it also asserts that this statement was not made under oath or by means of a statement of truth. This assertion is not accurate. In filing its notice of fast track opposition and statement of grounds the Opponent completed (under Q2-Q10 on form TM7F) for each of the earlier marks relied on a Statement of Use supplemented by information and exhibits, with a statement of truth signed and dated by Mr Devik Solanki as a director of the Opponent. Mr Solanki’s Statement of Use was thus given in proper evidential format, and the information covered by it constitutes evidence in these proceedings. If it had been the Applicant’s intention to question the veracity of this statement, it should have applied for leave to file evidence

undermining it or to test it by cross-examination; it should at least have particularised its reasons for doubt. I must make it clear that I accept completely the truthfulness of the statements made by Mr Solanki in his Statement of Use.

18) An important distinction must be drawn, however, between the truthfulness of these statements and their adequacy to establish genuine use to the required standard of proof. Q8 of form TM7F requests details of the number of sales achieved under the mark in the UK or EU during the relevant period. The Opponent is advised that these figures should, if possible, be provided on an annual basis and, if possible, be split in relation to each of the goods for which use of the mark is claimed; and that estimates should be provided if exact figures are not readily available. It is also advised that turnover figures may be provided to illustrate the level of sales under the mark if an indication of the typical price for the product is given.

19) Mr Solanki has not provided annual figures for years other than 2017 in the relevant period at issue in these proceedings (i.e. 10 March 2013 to 9 March 2018). Although I accept that “*sales for Taj brand products*” amounted to £5.7 million in 2017, this global figure has not been split to provide figures in relation to each of the goods for which use of the mark is claimed. Nor has it been indicated where these sales have been achieved – whether in the UK, the EU or in third countries. I note, for example, that exactly the same figure of £5.7 million has been given both for sales in the UK (in respect the UK registrations Nos. 2248603 and 2534509) and for sales in the EU (in respect of EU trade mark No. 7015795). This is puzzling in view of the fact that, as noted at paragraph 16 above, the Opponent claims use in 17 other EU countries in addition to the UK. I note further that under Q13 Mr Solanki refers to the Opponent’s clientele ranging “*globally*”, and to its trade mark protection in Australia. This all makes it difficult to attribute figures to the UK, the EU or third countries.

20) Under Q6 on form TM7F the Opponent is requested, as part of its statement of use, to provide a list of examples of the mark in use in the relevant period and to indicate against each such entry the goods for which use is claimed. The Opponent has provided the same answer, as follows, for each of the earlier marks relied on:

*“TV Advertisement - Exhibit 1*

*Logo Letter - Dated 1996 - Exhibit 2*

*Food Packaging Example - Dated 2005 - Exhibit 3*

*The marks are used within the same form since it's inception during the relevant periods. Reference to exhibit 1 - Which depicts our National TV Campaign for our bread products, the latest advert which has been marketed since February 2010."*

21) **Exhibit 1** contains three images showing what appears to be a chapatti product, what appears to be packaging for such a product featuring the figurative TAJ sign, and an image of the figurative TAJ sign with the slogan "TAJ Foods – The Taste You Can Trust" and the web address [www.tajfoods.com](http://www.tajfoods.com) followed by "Trade enquiries: 0208 594 1542". **Exhibit 2** reproduces a letter headed "Les White Artwork Designs", signed by a Les White and dated 12<sup>th</sup> January 1996, stating in connection with an image of the figurative TAJ sign that the signatory had "*transferred all copy rights and title interest of this mark and logo to Mr Anil Kumar Solanki who is the owner of this mark*". **Exhibit 3** consists of a design for a label, dated 24 October 2005. It is composed of the outline of an oriental building with an onion dome, containing a stylised representation of what appears to be a palm tree, with the TAJ figurative sign featured in the top corners of the label. The word "TROPICA" appears at the base of the tree, and below this the words "FROZEN CASSAVA YUCA", followed by the German "EINGEFRORENE YUCA", and then "Imported & Distributed by TAJ FROZEN FOODS" (with the Opponent's address in Essex), and finally "IMPORTED PRODUCT" and "NET WEIGHT 400g".

22) I accept that Exhibits 3 and 4 illustrate what sign Mr Solanki is referring to when he indicates that the sign has been used in the same form since its inception and during the relevant period (though Mr Solanki's reference to "periods" in the plural is confusing) and note that the sign corresponds to what I have termed the TAJ figurative sign; but beyond that they do not assist me further in assessing how far the requirements for genuine use of that sign in the relevant period at issue in these proceedings have been met.

23) I presume that the images in Exhibit 1 are intended to represent still screenshots from a TV advertisement, and on this basis I accept Mr Solanki's statement that Exhibit 1 "*depicts our National TV Campaign for our bread products, the latest advert which has been marketed since February 2010*". Reference to a "national TV campaign" is apparently intended to refer to the UK, though this is not explicitly stated. The telephone number for trade enquiries appears to be a UK number as dialed in the UK. No detail is provided, however, as to the broadcast dates and times, the television channel or channels involved, the number of television advertisements broadcast, the specific products advertised respectively in them, the geographical areas targeted by the channel or channels used, or consumer exposure and viewer numbers within the UK or EU. Before placing an order for television advertising an advertiser would wish to give itself at least a rough idea about all these matters, and the relevant information should be readily and easily available to it (even if only in the form of estimates in the case of viewing figures, for example).

24) Under Q10 in respect of UK registration No 2248603 the Opponent states:

*"The Taj brand is traded and protected in both European and International trading markets. We have heavily marketed the Taj brand on national TV Campaigns for many decades and including the most popular watched TV programs such as "Masterchef India" within the Asian community. Over the years, we have covered major marketing platforms including Billboards, Bus campaigns and Supermarket POS. This word "Taj" in the food industry has been heavily identified with the leading suppliers of frozen world food products for many years. The hardworking efforts of marketing "Taj" as a quality and leading brand makes it susceptible to new entry brands which may try to play off the reputation and trust we have built."*

Under Q10 in respect of EU trade mark No. 2248603 the Opponent states:

*"Please see exhibit 1 - Which depicts our National TV Campaign for our bread products, the latest advert was marketed since February 2010. Further bread products were TV advertised in earlier years as part of a national branding*

*campaign. Clearly identifying the Taj branding on the packaging as well as throughout the advert.”*

25) The statement that the TAJ brand is traded and protected in both European and international trading markets and the reference to “*national TV campaigns*” in the plural add a further element of uncertainty as to exactly where the advertising referred to took place or was targeted. While I accept Mr Solanki’s statement under Q6 to the effect that the TAJ figurative sign has been used “*during the relevant periods*” and that Exhibit 1 relates to an advertisement for bread products, the latest advert having been marketed “*since February 2010*”, I am unable to determine with any degree of accuracy and certainty what advertising of which specific goods took place where and on what scale during the relevant period at issue in these proceedings.

26) While I fully accept the sincerity of Mr Solanki’s statement that “*We have heavily marketed the Taj brand on national TV Campaigns for many decades and including the most popular watched TV programs such as "Masterchef India" within the Asian community*”, his references to heavy marketing and to the most popular TV programmes within the Asian community are value judgements. Mr Solanki’s judgement cannot be determinative. It would substitute his view for that of the Tribunal. His concept of what constitutes heavy marketing and his assessment of viewing popularity of may well differ significantly from those of the Tribunal (or the Applicant). The judgements on these points are ones for the Tribunal to make, and concrete, objective data on which to make them (such as UK or EU viewing figures or estimates) is lacking.

27) I must also reconcile references to “national TV” with “programmes such as ‘Masterchef India’” watched “within the Asian community”. Does the Asian community encounter these programmes on Asian TV channels? Are these channels available in the UK, or the EU, or other third countries, or all of these? What would be the exposure of viewers (and of consumers generally) in the UK or EU or other third countries to the Opponent’s advertising? What order of advertising expenditure would be attributable to the UK or the EU? Where were the billboards, buses and supermarket points of sale referred to by Mr Solanki located? What was the extent of

the marketing undertaken through those channels, and of which specific products? I have no specific data on these questions.

28) Under Q13 on the TM7F form in respect of UK registration No 2248603 and EU trade mark 7015795 the Opponent contends:

*“The Taj brand has been marketed since 1983. we are a family run business who have established ourselves as one the oldest & trusted world food companies. We have grown year on year to become leaders within the world foods category. TAJ is recognised as a leading frozen household brand, reaching millions of customers every year. Our clientele range from Cash & Carries to Independent Retailers and Supermarkets globally. As part of our product portfolio, we have been producing bakery bread based products since our inception which include Indian flat breads such as Paratha, Chapatti and Naans. We feel there is a very strong possibility of the confusion on the Taj name with Taj Bakery could pose our brand and reputation damage. For many years, we have in place several trademark protections in UK, Europe and Australia for the protection of the Taj Brand in the food and drink category classes 29,30 and 31.”*

29) In my view Q13 on the TM7F form does not form part of the statement of use covered by the statement of truth; I consider that information intended to prove use should be given in the part of the form covered by the statement of truth, which I consider to consist of the responses under Q2 – Q10. Nothing turns on this, however, because even assuming that the information given in Q13 is covered by the statement of truth and has evidential status, its references to a clientele ranging “*from Cash & Carries to Independent Retailers and Supermarkets globally*” (the underlining is mine) and to “*several trademark protections in UK, Europe and Australia*” do not assist me further in pinning down with any degree of accuracy what specific goods have been sold or advertised where, on what scale and with what frequency during the relevant period at issue in these proceedings.

30) In its written submissions in lieu of attendance at a hearing the Opponent attaches “an example invoice of TV Advertising Campaign in which our TAJ Breads/ Chapatti were featured as part of an Indian Master Chef program broadcasted as one of the most watched Asian cooking TV Shows in UK mainland”. The invoice, which bears UK VAT, is headed “Taj Foods Annual Campaign on Star TV - Mar 2016 - Mar 2017” and specifies:

*“Payment 1 of 6 of £16,800 + VAT for campaign within annual contract deal:*

- Powered by of Saathiya from Mar - Aug*
- Associate Sponsor of Multiplex from Mar - Aug*
- 180 x 30 sec spots or 300 x 15 sec spots on Star Plus*

*Remaining payment for annual campaign : £33.200 + VAT”*

31) Also attached is a screenshot downloaded on 23 July 2018 from the website groceries.asda.com showing the item “Taj Wholemeal Chapatti Pieces” with a representation of packaging showing the TAJ figurative mark and marked “Item unavailable”.

32) In choosing to file a fast track opposition the Opponent has elected to use a procedure which does not include the routine filing of evidence other than evidence of use of the earlier registered marks. It is therefore all the more important to ensure that the evidence initially filed is adequate. Accordingly, the parties were warned in letters of 18 July 2018 that it was not expected that they would be permitted to file further evidence. They were also advised, however, that any request for leave to file such evidence should be submitted on or before 1 August 2018. No such request was received. The material described in paragraphs 30-31 has not been provided in proper evidential format. It cannot therefore be taken into consideration in these proceedings.

33) Lest it be considered unfair to exclude this material, I should make clear that it would not in any case have been determinative in my decision. It shows that an annual Taj Foods Campaign on “Star TV” was planned for March 2016 to March 2017 – i.e. within the relevant period – that the deal was to include “180 x 30 sec spots or 300 x 15 sec spots on Star Plus”, and that a first payment instalment of six, in the amount of £2,800 net of VAT, was invoiced in March 2016. I do not consider that this takes us



significantly beyond the evidence already filed. This is surprising, since the material is provided in response to criticism by the Applicant in its notice of defence and counterstatement that the evidence initially filed was inadequate. The invoice was apparently issued by a UK-based company, but I still have no direct evidence as to the number of advertisements which were actually screened in 2017 or over the rest of the relevant period at issue in these proceedings, or of consumer numbers which would have viewed them in the UK, EU or elsewhere. Mr Solanki states that the campaign featured the Opponent's "Breads/Chapatti" as part of an Indian Master Chef programme broadcast as "one of the most watched Asian cooking TV shows in UK mainland". However, I do not consider that this significantly remedies the weaknesses in the evidence which I have outlined above, in paragraphs 23-29.

34) The fact that the screenshot from the groceries.asda.com website post-dates the relevant period would not necessarily preclude the drawing of inferences relating to the relevant period<sup>1</sup> if it were admitted in evidence. However, I do not consider that it would in fact redress the deficiencies in the evidence which I have detailed above.

35) I must take all the relevant facts and circumstances into account in determining whether there has been real commercial exploitation of the mark. I must bear in mind that though even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services, it is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use, and that the goods at issue in these proceedings are mass-market consumer foodstuffs. I must consider the scale and frequency and territorial extent of use of the mark, and whether the mark has been used for the purpose of marketing all the relevant goods or just some of them.

36) The most obvious and straightforward way of establishing that the requirements for genuine use have been met for the specific goods relied on is to provide data to show, at least in approximate terms, the scale and location of sales for each of those

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<sup>1</sup> The CJEU made clear in *La Mer (Laboratoires Goemar SA's Trade Marks, Case C-259/02)* that events subsequent to the relevant period are admissible as evidence to corroborate genuine use during that period.

goods. Similarly, where advertising is relied on, data from which the scale, frequency and location of consumers exposed to it can be adequately inferred should be provided for each of the goods. This could very easily have been achieved by means of brief, simple and straightforward statements. I have no explanation as to why this simple and obvious course was not taken, or why the evidence actually provided was so oblique and incomplete.

37) In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander, QC, sitting as the Appointed Person, observed that a “tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive”.

38) I have made clear that there is no question of my disbelieving anything in Mr Solanki’s evidence. The issue is simply that this evidence does not address the actuality of use of the earlier mark with the degree of specificity required to enable me to conclude with confidence that the earlier marks have been used in the required manner in relation to specific goods during the relevant period. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, stated that:

“22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

39) I have explained above the difficulties of inferring sales volumes for the individual goods relied on in the UK, the EU or third countries from the global figure of £5.7 million given for “sales for Taj brand products” in 2017. I have also outlined what I consider to be the deficiencies in the other items of evidence for the purpose assessing the scale and frequency and territorial use of the mark for each of the goods relied on. In

assessing the evidence I must not adopt what has been described as a “molecular” approach of considering each item of evidence individually<sup>2</sup>. I must step back and consider the evidence as a whole to see what facts it establishes, including whether individual items of evidence corroborate and reinforce each other.

40) Having done that, however, I have concluded that to make a finding of genuine use in the relevant period for “bread products” or “frozen world food products” – these being the only goods specifically mentioned by Mr Solanki in his Statement of Use – would simply involve taking too many conjectural steps on the basis of oblique and incomplete evidence. Still less is it possible to find genuine use for goods not mentioned at all in Mr Solanki’s comments. (I note, moreover, that although *frozen food stuffs*, *frozen vegetables* and *frozen food products* in Class 29 are relied on under Q1 of form TM7F for UK registration 2248603, EU trade mark 7015795 and UK registration 2534509 respectively, use is not claimed for corresponding products under the respective Q3 – a further example of the confusing and disjointed way in which the claims of use have been presented).

41) Stepping back and viewing the evidence as a whole, it falls short of the standard of solidity and cogency necessary to meet the standard of proof required in the circumstances of the case. In the absence of findings of use for specific goods, and the resulting determination of a fair specification for those goods, it is not possible to undertake a fair comparison with the goods of the Applicant’s specification. Accordingly, none of the earlier marks may be relied upon to support the Opponent’s claims under section 5(2)(b) of the Act, and the opposition must therefore fail.

## **Outcome**

**The opposition fails in its entirety.**

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<sup>2</sup> See the observations of Mr Richard Arnold (as he then was), sitting as the Appointed Person in EXTREME O/161/07 at paragraph 47.

## **Costs**

42) The Applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice (“TPN”) 2 of 2015. I hereby order Taj Foods Ltd. to pay Kashmir Crown Bakeries Ltd. the sum of £400. This sum is calculated as follows:

Preparing a statement and considering the other side’s statement	£200
Preparing written submissions	£200

The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful

**Dated this 27<sup>th</sup> day of November 2018**

**Martin Boyle**

**For the Registrar,**

**The Comptroller-General**