

O-382-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2379648**

**BY RAJ FOODS LIMITED**

**TO REGISTER IN CLASS 29 THE TRADE MARKS:**

**MASALA CORNER**



**(as a series of three marks)**

**AND**

**IN THE MATTER OF OPPOSITION NO 97563 BY**

**MASALA WORLD LIMITED**

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By Raj Foods Limited  
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**In the matter of opposition No 97563 by  
Masala World Limited**

### **Background**

1. Raj Foods Limited ("Raj") applied for the above series of three marks on 4 December 2004. Registration is sought for:

Class 29: Preparations being preserved, dried, cooked, processed or frozen, all for making meals; prepared meals, prepared Afro-Caribbean, African, Chinese and Gujarati meals, prepared ethnic meals, vegetarian meals, constituents for the aforesaid goods; halal meat, fillings, snack foods all included in Class 29; not including dairy products and products made wholly substantially from yoghurt.

2. Following publication in the *Trade Marks Journal*, Masala World Limited ("MW") filed an opposition to Raj's application under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). MW opposes all the goods of the application, relying for this purpose upon the following goods of its earlier UK trade mark registrations:

2315909 MASALA

Registered on 20 February 2004 for:

Class 29: *Fresh meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits; jellies, jams, compotes; eggs, milk and milk products; edible*

*oils and fats; herbs and pickles; preserves; croquettes, fruit, fruit salads, vegetable juices for cooking, lentils, milk-based beverages and mixes therefor, nuts, peanuts, peas, salads, vegetables, vegetable salads, yoghurt, drinking yogurt.*

Class 30: *Coffee, cocoa, sugar, tapioca, sago, artificial coffee; flour; bread, pastry and confectionery, ices; honey, treacle, yeast, baking powder; salt, mustard; vinegar; concentrates, flavourings and mixes for making beverages; chocolate-, coffee-, and cocoa - based beverages; condiments, farinaceous foods, flakes (maize), gravies, halvah, ice cream, meal, noodles, pastries, peanut confectionery, pizzas, puddings and desserts, sandwiches, sherbets and sorbets, tarts, turmeric for food.*

2315910 MASALA ZONE

Registered on 14 November 2003 for:

Class 29: *Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats, soups, stocks, bouillons and broths; soup, stock, bouillon and broth concentrates; preparations for making soups, stocks, bouillons and broths; herbs and pickles; salad dressings; preserves; potato crisps, croquettes, fruit, fruit salads, vegetable juices for cooking, lentils, milk-based beverages and mixes therefor, nuts, peanuts, peas, salads, vegetables, vegetable salads, yoghurt, drinking yogurt; foodstuffs comprising or made from any of the aforesaid goods.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread, pastry and confectionery, ices; honey, treacle, yeast, baking powder; salt, mustard; vinegar; sauces, spices, dressings, chutneys and curry powder; preparations made from rice; prepared savoury foodstuffs in the form of snack foods or meals; pies; concentrates, flavourings and mixes for making beverages; chocolate-, coffee-, and cocoa - based beverages, cereal based chips and crisps; condiments, curry (spice), essences for foodstuffs, farinaceous foods, flakes (maize), flavourings and essences for foodstuffs, gravies, halvah, ice cream, infusions, meal, noodles, pastries, peanut confectionery, pies, pizzas, puddings and desserts, sandwiches, seasonings, sherbets and sorbets, tarts, tea, tea-based beverages, turmeric for food; foodstuffs comprising or made from any of the aforesaid goods.*

2418544 MASALA EXPRESS

Registered on 22 September 2006 for:

Class 29: *Fresh meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; herbs and pickles; preserves; croquettes, fruit, fruit salads, vegetable juices for cooking, lentils, milk-based beverages and mixes therefor, nuts, peanuts, peas, salads, vegetables, vegetable salads, yoghurt, drinking yogurt; foodstuffs comprising or made from any of the aforesaid goods.*

Class 30: *Coffee, tea, cocoa, sugar, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread, pastry and confectionery, ices; honey, treacle, yeast, baking powder; salt, mustard; vinegar; concentrates, flavourings and mixes for making beverages; chocolate-, coffee-, and cocoa - based beverages; condiments, farinaceous foods, flakes (maize), gravies, halvah, ice cream, infusions, meal, noodles, pastries, peanut confectionery, pizzas, puddings and desserts, sandwiches, sherbets and sorbets, tarts, tea, tea-based beverages, turmeric for food; foodstuffs comprising or made from any of the aforesaid goods.*

Class 43: *Restaurant, cafe, bar and catering services.*

3. MW's trade marks all completed their registration procedures less than 5 years prior to the date when Raj's application was published in the Trade Marks Journal, on 11 April 2008. The consequence of this is that the proof of use provisions contained in section 6A<sup>1</sup> of the Act do not apply. MW's earlier trade marks must therefore be considered for their registered specifications, as set out above.

4. Raj filed a counterstatement, denying a likelihood of confusion. Both sides filed submissions but not evidence. Neither side requested a hearing. I will, of course, also take into account what has been said by the parties in the statement of case and counterstatement. Rather than summarise the submissions, I will refer to them in this decision as appropriate.

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<sup>1</sup> Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5<sup>th</sup> May 2004.

## Decision

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

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

(a) .....

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

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

6. In my consideration of whether there is a likelihood of confusion, I take into account the guidance from the case-law of the European Court of Justice (“ECJ”) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Matratzen Concord v OHIM* C-3/03 [2004] ECR I-3657, and *Shaker di L. Laudato & C. Sas v OHIM* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(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; *Sabel BV v Puma AG*, 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; *Shaker di L. Laudato & C. Sas v OHIM*

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

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective services, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

(g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of s.5(2); *Sabel BV v Puma AG*,

(i) if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

### **The average consumer**

7. Food is bought by the general public as well as catering establishments for use by chefs in preparing food; however, there is nothing about the specifications which suggests that the goods are aimed at professionals in food preparation. Restaurants, cafes and bars are frequented by the general public; catering services could be purchased by the general public or by commercial entities. I consider the average, relevant consumer of the goods and services to be the general public; with the rider that catering services could be purchased by a professional user group.

8. The goods are everyday consumer items which are, more often than not, purchased by self-selection from supermarket shelves or online. It is therefore likely that exposure to the marks during the purchasing process will be primarily visual, whether in a real or online retail environment. The services will also be encountered visually, although oral reference may play a part, e.g. when a recommendation is being made or an arrangement to meet at a restaurant.

9. The degree of care to be exercised in purchasing food items may vary according to the price of the goods and frequency of purchase. Brand loyalty may play a part, together with personal preferences in relation to e.g. additive levels, organic products and lifestyle image. Similar considerations apply to the services, which could vary in terms of price and frequency of purchase (as in a corner café compared to an expensive/exclusive restaurant). The potential for imperfect recollection may be increased in relation to low cost goods, but if

frequently purchased, that potential may be reduced. If items of high cost are infrequently bought, the higher level of attention may decrease the risk of imperfect recollection, but conversely the infrequency of purchase may lead to a greater potential for imperfect recollection.

**The pleaded case and comparison of goods and services**

10. MW’s opposition is founded upon the three earlier trade marks detailed in paragraph two of this decision. On its Form TM7, the notice of opposition, MW states that it is relying upon the class 29 and 30 goods covered by all three of its earlier marks. In relation to registration 2418544 (MASALA EXPRESS) MW also relies upon class 43. At question 4, MW states that all the goods in the application are identical or similar to the goods and services upon which it relies. As part of question 4, the Form TM7 says:

“Use this space to give any further information to explain why you consider that there is a likelihood of confusion e.g. why you consider the respective marks or goods and/or services to be similar?”

In response, MW refers to its attached statement of grounds. There is no reference in the statement of grounds to the class 43 services of 2418544, and no reference to them in any of the three sets of submissions subsequently filed by MW in these proceedings. MW’s statement of grounds states that the following goods are identical, but does not refer to the services:

<b>MW’s</b>	<b>Raj’s</b>
Fresh meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits, eggs, edible oils and fats, herbs and pickles, preserves, vegetable juices for cooking, lentils, nuts, peanuts, peas, salads, vegetables.	Preparations being preserved, dried, cooked, frozen or processed, all for making meals.
Fresh meat, poultry and game	Halal meat

and that the following goods are similar:

<b>MW’s</b>	<b>Raj’s</b>
Fresh meat, fish, poultry and	Prepared meals, prepared Afro-

<p>game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; herbs and pickles; preserves; croquettes, fruit, fruit salads, vegetable juices for cooking, lentils, milk-based beverages and mixes therefor, nuts, peanuts, peas, salads, vegetables, vegetable salads, yoghurt, drinking yogurt; foodstuffs comprising or made from any of the aforesaid goods.</p> <p>Coffee, tea, cocoa, sugar, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread, pastry and confectionery, ices; honey, treacle, yeast, baking powder; salt, mustard; vinegar; concentrates, flavourings and mixes for making beverages; chocolate-, coffee-, and cocoa - based beverages; condiments, farinaceous foods, flakes (maize), gravies, halvah, ice cream, infusions, meal, noodles, pastries, peanut confectionery, pizzas, puddings and desserts, sandwiches, sherbets and sorbets, tarts, tea, tea-based beverages, turmeric for food; foodstuffs comprising or made from any of the aforesaid goods.</p>	<p>Caribbean, African, Chinese and Gujerati meals, prepared ethnic meals, vegetarian meals, constituents for the aforesaid goods, fillings, snack foods.</p>
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11. The counterstatement from Raj states that the opposition has been made on the basis that the goods in the application are either identical or similar to the goods included in classes 29 and 30 of the opponent's MASALA marks, "as set out in its statement of claim". There is no mention of the services. I will make my comparison of goods as per MW's statement of grounds as detailed above, but will not consider the services of 2418544. The effect of MW's statement is to



define its pleadings; the above statement of grounds MW has set the parameters as to where it claims there is identity or similarity of goods. This is also an inter partes matter and my role is limited to the examination of the facts, evidence and arguments provided by the parties and to the relief sought<sup>2</sup>.

12. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* where the ECJ 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<sup>3</sup> and their method of use and whether they are in competition with each other or are complementary.”<sup>4</sup>

I will consider firstly the goods which MW claims are identical. The class 29 and 30 specifications for MW’s MASALA ZONE and MASALA EXPRESS are identically worded, but MASALA is registered for a more limited range of goods.

13. Raj’s specification contains the term ‘halal meat’. ‘Halal’ describes meat obtained from animals which have been slaughtered in accordance with Islamic law. Consequently, ‘halal’ meat comes within the ambit of MW’s wider term ‘fresh meat, poultry and game’ and is therefore identical with this term<sup>5</sup>.

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<sup>2</sup> The legal principle of *iudex judicare debet secundum allegata et probate partibus*.

<sup>3</sup> The earlier incorrect translation of ‘Verwendungszweck’ in the English version of the judgment has now been corrected.

<sup>4</sup> The criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 for assessing similarity between goods and services were:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

<sup>5</sup> As per the CFI decision *Gérard Meric v OHIM*, Case T-133/05: “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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

14. Raj qualifies 'preparations being preserved, dried, cooked, frozen or processed' as 'all for making meals'. These are to be compared with MW's 'fresh meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits, eggs, edible oils and fats, herbs and pickles, preserves, vegetable juices for cooking, lentils, nuts, peanuts, peas, salads, vegetables.' All the goods in MW's term could all be used in making meals. MW's 'preserved, dried and cooked fruits' is covered by Raj's wider term 'preparations being preserved, dried, cooked' and so are identical. Raj's specification includes the words 'frozen or processed', which are not present in MW's specification. However, MW's foods that are preserved, dried and cooked, pickled or are meat extracts have undergone processing and are therefore identical to Raj's processed preparations. This leaves Raj's term 'frozen'. Fruits that are preserved (MW's specification) could be frozen fruits and so could be said to be identical, coming within the wider ambit of Raj's specification. In addition, vegetables, peas and lentils in MW's specification are not specified as being fresh, dried, canned or frozen; being any or all of these they come within the ambit of Raj's specification (preserved, dried or frozen). Further, frozen meat (e.g. chicken pieces), if not identical to fresh meat, must be classed as highly similar, being bought as an alternative to fresh meat.

15. I find that Raj's 'preparations being preserved, dried, cooked, frozen or processed, all for making meals' and 'halal meat' are **identical or highly similar** to MW's 'fresh meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits, eggs, edible oils and fats, herbs and pickles, preserves, vegetable juices for cooking, lentils, nuts, peanuts, peas, salads, vegetables'.

16. I approach the remainder of Raj's goods on the basis that MW has claimed similarity, not identity, with its own goods.

17. Raj's specification includes 'snack foods', a term which covers a wide variety of items, from those in relatively unprocessed form to those which are highly processed. MW has cover for nuts, fruit salads, pastries, confectionery and sandwiches: all these are commonly available to purchase as something quick to buy and quick to eat – a snack food. There is **high similarity** between Raj's snack foods and the aforementioned goods in MW's specifications in classes 29 and 30.

18. Raj's specification includes 'fillings' while MW's specification in class 29 includes preserved, dried and cooked fruits and vegetables; jellies, jams and compotes which could all be used as fillings; these goods are consequently **highly similar**.

19. Raj's 'constituents for the aforesaid goods' refers back to its 'prepared meals, prepared Afro-Caribbean, African, Chinese and Gujerati meals, prepared ethnic meals, vegetarian meals'. There are several goods in MW's specifications

which could be constituents for prepared meals; for example, meat, vegetable juices for cooking, fruits and vegetables, noodles and farinaceous foods (which would include pasta). I note that in relation to MASALA ZONE and MASALA EXPRESS only, MW also has cover for 'foodstuffs comprising or made from any of [its] aforesaid goods], a qualification which is positioned at the end of its specifications and therefore refers to all the foregoing goods in both its specifications. 'Foodstuffs' appears to be a term which is similar to 'constituents for prepared meals, prepared Afro-Caribbean, African, Chinese and Gujarati meals, prepared ethnic meals, vegetarian meals. I find that the latter (Raj's goods) are **highly similar** with MW's goods which can be used as constituents or ingredients for prepared meals. This also applies to the MASALA specifications which, although they do not cover 'foodstuffs...' still cover goods which could be used as constituents for prepared meals.


20. Turning to the meals themselves, Raj precedes its more defined list of types of prepared meals – Afro-Caribbean, African, Chinese, Gujarati, ethnic and vegetarian – with the wider term 'prepared meals'. MW's class 29 specification includes 'vegetable salads', which could be classed as a prepared meal. Further, MW has cover for pizza, which could be described as an ethnic meal (if ethnic means something not historically native to UK shores) and/or a vegetarian meal. In my experience, prepared meals attributable to various types of ethnicity are easily obtainable from self-service shelves in supermarkets, where they are also sold in close proximity with one another. They are therefore in competition or complementary. I also bear in mind that MW's specifications cover the term 'foodstuffs' made from any of its itemised goods (e.g. 'instant' noodle or pasta meals). I conclude that Raj's 'prepared meals, prepared Afro-Caribbean, African, Chinese and Gujarati meals, prepared ethnic meals, vegetarian meals' are **highly similar** to MW's vegetable salads, pizzas and foodstuffs.

### **Comparison of the marks**

21. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant. I will discuss the distinctiveness of MASALA below since both parties have relied upon a decision of the registrar (BL O/019/08) in respect of an invalidation application by Raj in respect of MW's MASALA mark, brought under sections 3(1)(b)(c) and (d) of the Act.

22. It can readily be seen that the first mark in Raj's application for a series of three marks is for the plain words (word only) MASALA CORNER, while the second and third marks are written in script, MASALA being obliquely positioned in relation to CORNER. The words are in yellow and, in the third mark, they are superimposed on an orange rectangle, but I note that there is no claim to colour on the application form. MW's registrations are all word only.

23.

MW's	Raj's
<p>MASALA</p> <p>MASALA ZONE</p> <p>MASALA EXPRESS</p>	<p>MASALA CORNER</p> 

MW's mark is entirely composed of the word MASALA, which is the first word in Raj's mark, which consists of two words, both six letters in length. Neither word can be said to dominate the word only version of Raj's mark. In the stylised versions, MASALA is written in larger script than CORNER and is set at an oblique angle over CORNER; it has the edge as far as dominance goes over CORNER because of the presentation. The stylised words are easily legible and I would say that there is a good deal of both visual and aural similarity between the marks. Aurally, it is the common element MASALA which will be heard first in Raj's marks. In the decision referred to above, BL O/019/08, the Hearing Officer said:

“42. On my assessment there is ample evidence to show that at the time of filing the application, the word MASALA was in everyday use, both within industry and in the market in relation to spices, particularly spice mixtures, in powder, and paste form, and also in relation to sauces and prepared meals that have the MASALA spice mixture as a significant ingredient.”

Elsewhere in the decision, reference is made to 'garam masala' and 'chicken tikka masala'. Given the modern UK penchant for eating Indian food, I think that the majority of the general public would know that MASALA refers to an aspect of Indian cookery, although they may not know whether it is the name of a dish, sauce or spice mixture. This is the concept or meaning of MW's mark. The concept of Raj's is not simply MASALA because of the addition of CORNER. The combination is evocative of a corner location, the sort of name that might be given to a food outlet, café or restaurant specialising in Indian food (whether or not actually located on a corner).

24. In *Cardinal Place Trade Mark*, BL O/339/04, Mr Geoffrey Hobbs QC, sitting as the appointed person compared the trade mark application CARDINAL PLACE to the earlier mark CARDINAL. He said:

“15. The perceptions and recollections triggered by the earlier mark are likely to have been ecclesiastical whereas the perceptions and recollections triggered by the Applicant's mark are likely to have been locational as a result of the qualifying effect of the word PLACE upon the

word CARDINAL. A qualifying effect of that kind can be quite powerful as indicated by the examples cited in argument on behalf of the Applicant: SOMERSET as compared with SOMERSET HOUSE; COUNTY as compared with COUNTY HALL; CANARY as compared with CANARY WHARF.”

Mr Hobbs further referred to the ‘blend of meaning and significance produced by combining the word CARDINAL with the word PLACE in the designation CARDINAL PLACE”.

25. In the instant case, both marks share the common element MASALA, which in Raj’s mark is qualified by the locational connotations of CORNER. This puts a degree of conceptual distance between them. My conclusion is that there is an average level of conceptual similarity between MASALA and MASALA CORNER; although there is altered meaning and significance produced by the combination of MASALA and CORNER from Indian food to a location, there could still be a connotation of a corner location providing Indian food (distinguishable from Cardinal Place).

26. The locational concept also figures in MW’s MASALA ZONE mark, a zone being a designated area. Applying the above reasoning, there is a good deal of conceptual similarity between MASALA ZONE and MASALA CORNER, both having connotations of locations associated in some way with Indian food. I do not consider either MASALA or ZONE to be particularly dominant as the two words work together to produce a locational blend of meaning and significance; they are not two unassociated words. Both trade marks commence with the word MASALA and so have aural similarity in relation to this.

27. In contrast, MASALA EXPRESS does not send a clearly locational message. ‘Express’ denotes speed. In the context of food, this could be used to convey speed of preparation or a takeaway meal. It could also convey the takeaway outlet for the type of food. MASALA EXPRESS could trigger a perception of fast Indian food and/or an outlet for obtaining fast Indian food; if the latter, the sense would be more locational than the former. I consider that the conceptual similarities are therefore not as low as between MASALA and MASALA CORNER, but neither are they as high as MASALA ZONE and MASALA CORNER. There is a modest level of conceptual similarity. Neither MASALA or EXPRESS is dominant overall within the mark. There is a reasonable of visual and aural similarity because both marks consist of two words, the first of which is the same word, but the second words are very different to each other.

### **Likelihood of confusion**

28. The distinctiveness of the earlier marks is a factor to consider because the more distinctive they are (based either on inherent qualities or because of the

use made of them), the greater will be the likelihood of confusion. No use of the earlier marks has been filed so I have only their inherent qualities to consider.

29. Both parties have relied upon BL O/019/08, but for different reasons. Raj relies upon the decision to support its counterstatement that “the word ‘masala’ is wholly descriptive of and its use customary in the trade in relation to foodstuffs being capable of preparation in a masala sauce or style”. MW relies upon the decision to demonstrate that it must be distinctive for all the goods for which the invalidation attack failed, i.e. the goods for which it currently stands registered. The hearing officer found:

“42. On my assessment there is ample evidence to show that at the time of filing the application, the word MASALA was in everyday use, both within industry and in the market in relation to spices, particularly spice mixtures, in powder, and paste form, and also in relation to sauces and prepared meals that have the MASALA spice mixture as a significant ingredient. In relation to such goods the term must be considered to consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade. Even if I were found to be wrong in this, there cannot be any doubt that MASALA is a word that may serve in trade, to designate the kind, intended purpose, or some other characteristics of goods that are, or use MASALA in the forms I have described, but is this the case in relation to the goods covered by the registration?

43. Turning first to the statement of goods for Class 29 and Class 30 of the subject registration. The descriptions “cooked vegetables” in the Class 29 specification, and “foodstuffs comprising or made from any of the aforesaid goods” found in both the Class 29 and Class 30 specifications are all capable of encompassing foodstuffs prepared in a MASALA sauce or style, such as “chicken tikka masala”, “vegetable tikka MASALA”. The same is the case in relation to Class 30, where the description “preparations made from cereals” would encompass products that are substitutes for meat, for example, for consumption by vegetarians, and potentially, also MASALA prepared foods. That being the case, I consider the word MASALA to be wholly descriptive of a characteristic of such goods and open to objection under Section 3(1)(c).

44. It is also the case that the term MASALA is “exclusively a sign or indication which has become customary in the current language or in the bona fide and established practices of the trade” in relation to goods of the registration that are prepared in a MASALA sauce or style. The evidence contains a number of examples where the food industry and those associated can be seen to be using MASALA to describe a spice mixture in various forms, and also in relation to prepared meals. It may well be that these meals do not have MASALA spices as a constituent, but that is

immaterial (Merz & Krell GMBH & Co). Accordingly, the ground under Section 3(1)(d) also succeeds in respect of “cooked vegetables” in the Class 29 specification, and “foodstuffs comprising or made from any of the aforesaid goods” found in both the Class 29 and Class 30 specifications.

45. The applicants also allege that the term MASALA is a term used in connection with tea. This is borne out by the pages provided with the Statement of Case which refer to a type of tea called “MASALA CHAI”, the name being an indication of some form of spice content, albeit not necessarily the MASALA spice combination. I am conscious that this information is not evidence in the terms required by the UK Act. Nonetheless the registered proprietors did not challenge this claim. Accordingly, in relation to the “tea and tea-based beverages”, and also “infusions” (which would include MASALA tea) covered by the Class 30 specification, the word MASALA will be wholly descriptive, and open to objection under Section 3(1)(c). However, as there is no evidence of its use in the relevant trade, the ground under Section 3(1)(d) is dismissed.

46. This leaves the goods covered by Class 32 of the registration. On my assessment there is nothing that shows MASALA may serve in the trade to designate any characteristic of the goods listed, let alone any evidence that it has become customary in the current language or in the bona fide and established practices of the trade. I see no reason why, in relation to the goods in this class the word MASALA should be considered to be devoid of any distinctive character. Therefore, in relation to the goods listed in Class 32 the grounds under Section 3(1)(b), 3(1)(c) and 3(1)(d) are dismissed.

**47. In summary. In relation to “cooked vegetables” in the Class 29 specification, “preparations made from cereals” in the Class 30 specification, and “foodstuffs comprising or made from any of the aforesaid goods” in both the Class 29 and Class 30 specifications, the grounds under Section 3(1)(b), 3(1)(c) and 3(1)(d) are successful. In respect of “infusions” and “tea and tea-based beverages” covered by the Class 30, the ground under Sections 3(1)(b) and 3(1)(c) succeed, but the ground under Section 3(1)(d) is dismissed. Accordingly, these terms must be deleted from the statements of goods. For all other goods the grounds under Section 3(1)(b), 3(1)(c) and 3(1)(d) are dismissed.”**

30. The hearing officer thus found that the grounds were not made out in respect of the goods for which the registration currently stands. Under Section 72 the registration is prima facie evidence of its validity in these proceedings.

31. MW’s other two marks are MASALA ZONE and MASALA EXPRESS. EXPRESS denotes an easily obtained or prepared version of a good or service,

which in the case of the goods covered by MASALA EXPRESS includes the goods which the hearing officer deleted from the MASALA registration. The level of distinctiveness for these goods is low. In the case of MASALA ZONE, a zone is a designated area. I bear in mind that I am assessing distinctiveness for food goods rather than provision of food, so the distinctiveness of ZONE is greater for the actual goods than for a place where the goods may be purchased. There is a modest level of distinctiveness for the goods deleted from the MASALA registration which also exist in the MASALA ZONE specification, but a reasonably high level of distinctiveness in relation to the remaining goods.

32. MW submits that its family of marks (the marks it relies upon in these proceedings) means that the public are likely to consider that goods bearing the mark MASALA CORNER come from the same source as MW's marks. In *Miguel Torres SA v OHIM*, Case T-287/06, the CFI said, in relation to families of marks:

“81 However, according to the above case-law, the likelihood of confusion attaching to the existence of a family of earlier marks can be pleaded only if both of two conditions are satisfied. First, the earlier marks forming part of the ‘family’ or ‘series’ must be present on the market. Secondly, the trade mark applied for must not only be similar to the marks belonging to the series, but also display characteristics capable of associating it with the series. That might not be the case, for example, where the element common to the earlier serial marks is used in the trade mark applied for either in a different position from that in which it usually appears in the marks belonging to the series or with a different semantic content (BAINBRIDGE, paragraphs 125 to 127).”

MW has provided no evidence that any of its marks are present on the market and so this argument falls at the first of the two hurdles, both of which must be satisfied. I cannot take into account the family of marks argument. I also cannot take into account Raj's argument that MW only opposed the application because it was aggrieved that Raj had taken the invalidation action against its MASALA mark. This is not relevant to the assessment I must make on the basis of the marks before me and the merits of the case.

33. In considering the likelihood of confusion, I have to bear in mind the nature of the goods and services, the purchasing process and the relevant consumer. The average consumer is considered to be someone who is reasonably well informed, circumspect and observant, who perceives trade marks as a whole and who does not pause to analyse their various details. The average consumer rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them which has been remembered. I have to weigh the proximity of the goods and services against the relative distance between the marks - the interdependency principle – whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I



have found that the goods are identical or highly similar. I must consider the relative importance that the visual and aural similarities have in relation to the goods and services during the purchasing process. The purchasing process is primarily visual in relation to the purchase of food items. I must also appraise the distinctive character of the earlier mark, because the more distinctive it is (either *per se* or by reputation), the greater will be the likelihood of confusion (*Sabel*). The distinctive character of a mark must be assessed by reference to the particular goods or services to which it is attached and by reference to the relevant consumer's perception of the mark. I found that there is an average degree of conceptual similarity between the MASALA and MASALA CORNER, a modest level between MASALA EXPRESS and MASALA CORNER and a good deal between MASALA ZONE and MASALA CORNER

34. In the case of MASALA, there is more visual and aural similarity than there is conceptual similarity. MASALA CORNER sends a locational message to the purchaser which the earlier mark does not, mitigating the potential effects of imperfect recollection. Conceptual differences can counteract visual and aural similarities if at least one of the marks has a meaning which is immediately capable of being grasped<sup>6</sup> and provided that the meaning is different to the meaning of the other mark (if any). Notwithstanding the locational significance, I also found that the conceptual significance of Indian food is present in both marks.

35. MW submits that the beginnings of marks are more important. In case 402/07 *Kaul GmbH v OHIM* at paragraph 85, the court has also stated in case T-22/04 *Reemark Gesellschaft für Markenkooperation mbH v OHIM*, (at paragraph 37):

“It must also be borne in mind that the Court of First Instance has already held that, on an initial analysis, where one of the two words which alone constitute a word mark is identical, both visually and aurally, to the single word which constitutes an earlier word mark, and where those words, taken together or in isolation, have no conceptual meaning for the public concerned, the marks at issue, each considered as a whole, are normally to be regarded as similar (Case T-286/02 *Oriental Kitchen v OHIM – Mou Dybfrost (KIAP MOU)* [2003] ECR II-0000, paragraph 39).”

In this case, all the marks do have conceptual meanings. Beginnings of marks are important, but this is just one factor to be put into the global comparison mix; it is not a trump card. Raj argues that the descriptive nature of MASALA (and hence its low distinctive character) means that the addition of another word will negate risk of confusion. The fact that the earlier mark may only have a weak distinctive character does not preclude a finding that there is a likelihood of

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<sup>6</sup> *Devinlec Développement Innovation Leclerc SA v OHIM*, Case T-147/03

confusion; again, it is a matter of making a multifactorial assessment. In *L'Oréal SA v OHIM* Case C-235/05 P, the ECJ said:

“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.”

36. Comparing the marks as wholes<sup>7</sup>, I do not think that the marks will be directly confused. However, according to the jurisprudence cited above, I must also have regard to a scenario where, although the marks are not mistaken directly, there is a belief or an expectation upon the part of the average consumer that the goods or services bearing the individual marks emanate from a single undertaking because there are points of similarity which lead to association. If the association between the marks causes the relevant consumer, who is reasonably well informed and reasonably circumspect and observant, wrongly to believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion. Applying the interdependency principle and the various factors, I consider that there would be a likelihood of confusion between the earlier marks and the application, with the strongest likelihood of confusion existing between MASALA ZONE and MASALA CORNER.

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<sup>7</sup>As per the ECJ in *OHIM v Shaker di L Laudato & C Sas*, Case C-334/05 P: “41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42 As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.”

**Costs**

37. MW has been successful and is entitled to an award of cost on the following basis, as per Tribunal Practice Notice 6/2008:

Preparing a statement and considering the other side's statement:	£300
Official fee:	£200
Written submissions and considering the other side's written submissions:	£500
<b>Total:</b>	<b>£1000</b>

39. I order Raj Foods Limited to pay to Masala World Limited the sum of £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 9<sup>th</sup> day of December 2009**

**Judi Pike  
For the Registrar,  
The Comptroller-General**