

O-377-15

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF:

**i) TRADE MARK APPLICATION 3013482
BY PAPA SPICE LTD**

TO REGISTER THE FOLLOWING SERIES OF MARKS IN CLASSES 29, 30 & 43:

PaPa Spice, PaPa spice, PaPa-Spice & PaPaSpice

AND

**AN OPPOSITION THERETO (NO. 401194) BY
CROWN ORIENTAL FOODS LIMITED**

**ii) TRADE MARK REGISTRATION 1391905
IN THE NAME OF CROWN ORIENTAL FOODS LIMITED
OF THE FOLLOWING TRADE MARK IN CLASSES 29, 30 & 31:**

PAPA

AND

**AN APPLICATION FOR REVOCATION THEREOF (No. 500308)
BY PAPA SPICE LTD**

Background and pleadings

1. The trade mark application that gives rise to this dispute is as follows:

Trade marks: **PaPa Spice, PaPa spice, PaPa-Spice & PaPaSpice**

Specification¹: **Class 29:** Chilli; Chilli oil; Olive oil.

Class 30: Chili; Chili powders; Chili cooking sauce; Cooking essences; Dressings (salad-); Marinades; Pepper vinegar; Peppers [seasonings]; Processed herbs; Spice preparations.

Filing date: 11 July 2013

Publication date: 9 August 2013

Applicant: PaPa Spice Ltd (“the applicant”)

There is no material difference between the four marks in the series so I will, from this point on, refer to them in the singular, focusing on the mark **PaPa Spice**.

2. Registration is opposed by Crown Oriental Foods Limited (“the opponent”). Its grounds of opposition are under sections 5(2)(b), 5(3) & 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(2)(b) and 5(3), the opponent relies on the following trade mark registration:

Trade mark: **PAPA**

Filing date: 17 July 1989

Registration date: 29 November 1991

I will set out the specification of the above mark later because the opponent only relies upon certain goods and has made a statement of use for certain goods only.

3. Given its date of filing, the opponent’s mark qualifies as an earlier mark in accordance with section 6 of the Act. The earlier mark was registered more than five years before the publication of the applicant’s mark, the consequence of this is that the earlier mark is subject to the proof of use provisions contained in section 6A of the Act. Under section 5(4)(a), the opponent relies on the use of the sign **PAPA** and, also, a stylised version of that sign; the claim is that the use of the applicant’s mark would be preventable under the law of passing-off.

4. In response to the opposition, the applicant not only filed a counterstatement defending its application (and putting the opponent to proof of use), but it also applied (after the opponent had filed its evidence) to revoke (partially) the opponent’s

¹ The specifications in classes 29 & 30 were initially wider than this, but the applicant limited them during the course of the proceedings. Despite the limitation, the opponent elected to proceed with its opposition. The specification also includes services in class 43, however, the opponent no longer pursues its opposition against the services of the application.

earlier mark on the grounds of non-use. The opponent filed a counterstatement denying the revocation claim.

5. The proceedings were consolidated. During the proceedings certain issues arose relating to the scope of the pleadings (of both sides) in relation to the goods for which use had been claimed/challenged. I will return to this shortly. Both sides filed evidence. I will summarise the evidence when it is relevant to the issues that need to be determined. The matter was then heard before me on 10 July 2015 at which the opponent was represented by Mr Thomas St Quintin, of Counsel, instructed by Wildbore & Gibbons LLP. The applicant was represented by Dr Michael Spencer of Bromhead Johnson, instructed by McEvedys Solicitors and Attorneys Ltd.

6. Another pleadings point also arose at the hearing, Mr St Quintin submitting that because the key points of the applicant's defence in the opposition focused upon the lack of use/goodwill/reputation, the applicant had consequently accepted that if those points were made good then the other aspects of the relevant grounds should follow the event. I disagree. Although the applicant may not have specifically denied every aspect of the opposition, it does not follow that the various heads of damage (confusion under section 5(2)(b), misrepresentation and damage under section 5(4)(a) and the link and at least one of the three heads of damage under section 5(3)) are accepted. Therefore, I still need to be satisfied on those points. The applicant did put forward an amended counterstatement to remedy some of these points, but I do not consider it necessary for this to be introduced now.

Revocation/proof of use

Legislation and case-law

7. The provisions relating to revocation are contained in section 46 of the Act, the relevant parts of which read:

“46.-(1) The registration of a trade mark may be revoked on any of the following grounds –

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c)

(d)

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

8. Analogous provisions are contained in sections 6A of the Act in relation to proof of use in opposition proceedings, albeit the five year period in which genuine use must be shown is the five year period ending on the date of publication of the applicant’s mark. Section 100 is also relevant, which reads:

“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.”

9. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case-law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Case C-40/01 Ansul BV v Ajax Brandbeveiliging*

BV [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(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, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]"

10. Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

11. In relation to devising a fair specification to reflect the use made, I note that Mr Geoffrey Hobbs Q.C. (sitting as the Appointed Person), when deciding case *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* (BL O/345/10), stated:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

12. More recently, in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where a mark has not been used for all the goods/services for which it is registered; he said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32; and in *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the “fair description” is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection (“the umbra”) for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods (“the penumbra”). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to

the appropriate specification having regard to the use which has been made.”

64. Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65. It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.”

What is in issue?

13. The opponent’s earlier mark stands on the register for the following goods:

Class 29: Fruits and vegetables, all being preserved, dried, cooked, frozen or canned; edible oils and edible fats; preserves; pickles; salad dressings; edible (shelled) nuts; edible seeds; pulses; all included in Class 29.

Class 30: Flour; flour products for food; cereals; rice; sauces; vinegar, spices, flavourings, essences; all included in Class 30.

Class 31: Fresh fruits; nuts; fresh vegetables; seeds; all included in Class 31.

14. The opponent accepts that it cannot rely on/retain the earlier mark for the above specification. The opponent's own position² is that, at best, its specification should be cut down to:

Class 29: Mango pickle (if mango chutney is not in class 30); pulses

Class 30: Flour; flour products for food; mango chutney (if not as a pickle in class 29); rice

15. The applicant accepts that genuine use has been made in relation to some of the goods, but that there are complications which it feels impact on the outcome:

- i) The applicant considers the opponent's pleading in defence of the revocation to have been more limited than the opponent's statement of use in the opposition, so meaning that the revocation should succeed for everything other than what it believes to be the defended goods (pulses in class 29 and rice in class 30), goods for which it accepts genuine use has been made.
- ii) The opponent's wider statement of use in the opposition is redundant because the mark will already be revoked for everything other than pulses and rice. It should be noted that I wrote to the parties shortly before the hearing setting out what appeared to be the remaining issues between the parties and, additionally, highlighting that because the effective date of revocation claimed by the applicant in the revocation was after the relevant date in the opposition, the impact the applicant thought the revocation would have was not correct (because the earlier mark would still be extant at the relevant date). This was met with a request from the applicant to amend its pleaded date of revocation to a date before the relevant date in the opposition.
- iii) Subject to the above, the applicant accepts genuine use in relation to gram flour (a subset of flour), and poppodoms (a subset of flour products for food), but does not accept that such use entitles the opponent to rely on/retain the wider terms.
- iv) Subject, again, to the above, the applicant denies that there has been any use on mango pickle (and that mango pickle does not, in any event, fall in class 29). It accepts that genuine use has been made in relation to mango chutney, but that mango chutney is not covered by the opponent's registration in class 30. It does not agree with the opponent's view that mango chutney is a subset of sauces, a term which is covered by the opponent's specification in class 30.

Mango pickle/mango chutney

16. I will deal firstly with the classification points that arise with regard to these terms and what, as a matter of fact, the opponent has been selling, and whether what it

² As per its skeleton argument, and also confirmed by Mr St Quintin at the hearing.

has been selling falls within the scope of its registration. I will then deal with the pleadings point.

17. The first point to note is that the product shown in the evidence is specifically identified as mango chutney. It is only sold in large drums (marked with the words mango chutney) and is supplied to the trade as opposed to members of the general public. The Nice Classification places chutneys in class 30. The opponent's class 30 specification does not list mango chutney per se, or even chutneys per se. It does, though, include the term "sauces". The opponent's primary submission is that mango chutney is a type of sauce and, therefore, mango chutney can be relied upon/retained on account of this.

18. The opponent relies upon a Wikipedia (an online user generated encyclopaedia) entry for the term "sauces". The relevant information from this extract reads:

"In cooking, a sauce is liquid, cream, or semi-solid food served on or used in preparing other foods. Sauces are not normally consumed by themselves; they add flavor, moisture, and visual appeal to another dish. *Sauce* is a French word taken from the Latin *salsa*, meaning *salted*. Possibly the oldest sauce recorded is *garum*, the fish sauce used by the Ancient Greeks.

Sauces need a liquid component, but some sauces (for example, pico de gallo salsa or chutney) may contain more solid components than liquid. Sauces are an essential element in cuisines all over the world."

and

"Indian cuisines use sauces such as tomato-based curry sauces, tamarind sauce, coconut milk-/paste-based sauces, and chutneys. There are substantial regional variations in Indian cuisine, but many sauces use a seasoned mix of onion, ginger and garlic paste as the base of various gravies and sauces. Various cooking oils, ghee and/or cream are also regular ingredients in Indian sauces."

19. Mr St Quintin highlighted the above information at the hearing. He also highlighted a picture in the extract of samosas surrounded by four "sauces", one of which he assumed to be mango chutney. Additionally, Mr St Quintin noted the evidence of the opponent's witness, its managing director Mr Pagarani. In his third witness statement Mr Pagarani states that the product sold by the opponent could be correctly described as a number of things including a dipping sauce; he added that use as a dipping sauce is one of the product's most important uses and that it is quite liquid in nature.

20. Dr Spencer submitted that mango chutney is not a sauce, and that it is simply a chutney, a type of condiment. He argued that little weight could be placed on the Wikipedia entry as its source was not clear.

21. There are various definitions for “sauce” that can be taken from the leading dictionaries. For example, as a noun, the Collins Online English dictionary defines it as:

“1. Any liquid or semi-liquid preparation eaten with food to enhance its flavour.

2. Anything that adds piquancy.”

22. The same dictionary defines chutney as “a pickle of Indian origin, made from fruit, vinegar, species, sugar etc”. Chutney is not defined with reference to it being a type of sauce.

23. My initial view on the matter is that Dr Spencer is correct when submitting that it would be a strain of natural language to class mango chutney as a sauce. I do not consider that the average consumer would approximate the terms to each other. They may be similar, but they are distinct products. I also agree with Dr Spencer that the Wikipedia entry has little weight. Who wrote it is not clear and how representative it is of the views and understandings of the trade and/or average consumers in the UK is not clear. Better and more authoritative evidence should have been filed if the opponent wished to make this point good.

24. The evidence of Mr Pagarani has, of course, been borne in mind. However, whilst I have no reason to disbelieve the primary facts he gives, his evidence may have been somewhat skewed given that by the time he was giving evidence he was aware of the relevant issue. Mr Pagarani states that the opponent’s mango chutney is quite liquid in nature. However, this is difficult to assess because no examples of the product have been provided. If Mr Pagarani is trying to say that the product is more sauce-like than other mango chutneys then why is it still being described as mango chutney as opposed to mango sauce? Mr Pagarani also states that one of its most important uses is a “dipping sauce”. Whilst I am familiar with the concept of mango chutney being provided along with, say, poppodams, this does not make it a sauce, dipping or otherwise. It is still a chutney and would still be described as such. I come to the view that mango chutney does not fall within the ambit of sauces and, therefore, despite genuine use having been made (and accepted) of the mark in relation to mango chutney, such goods cannot be relied on/retained in class 30 as it is not covered by the opponent’s trade mark registration.

25. The opponent’s fall-back submission is that the use made enables the term “mango pickle” to be relied upon/retained in class 29 as a subset of the registered term pickles (or alternatively as a subset of “[fr]uits ..., all being preserved). It is difficult to see any real prospect for successfully arguing this point given that the goods set out in the evidence are specifically identified as mango chutney (a class 30 product). This submission seems nothing more than a hopeful attempt to shoehorn some form of term into its registration. The futility of its submission is further compounded by the fact that the term “pickles” in class 29 simply covers products such as pickled onions, pickled gherkins etc. They are forms of fruit or vegetables that have simply been pickled to increase their longevity. The term would not cover products which have been made into a pickle (in the sense of a condiment similar to chutney) as such goods would be classified in class 30, along with chutneys. The claim to rely on/retain the term mango pickle (as a subset of the

registered term pickles) is rejected. The same applies to any claim that the term can be retained on account of it falling within “[fr]uits ..., all being preserved...”; whilst a product such as preserved mango would fall within this term, this is not what is being sold.

26. Irrespective of the above, and in case of appeal, I will deal with the pleadings point. There is no dispute that in relation to the proof of use aspect of the opposition case, use was claimed to have been made in relation to “sauces” in class 30. Therefore, subject to the applicant’s submission about the impact of the revocation proceedings on the opposition, the opponent was entitled to argue that mango chutney could be relied upon as a subset of sauces.

27. I should add that during the course of the proceedings the opponent did seek to amend its statement of use to specifically include a reference to mango chutney, but I did not consider this to be necessary as to formally permit the amendment may have signalled an acceptance that the term did fall within sauces, a point which was something to argue at the hearing. The decision not to amend the pleaded case has had no real impact on the evidence or arguments because both parties knew what the opponent was attempting to argue.

28. The aspect which is disputed is the extent to which the opponent has defended the revocation proceedings. When filing its counterstatement in the revocation proceedings, and in answer to the question “Please specify the goods and/or services of the registration for which you are submitting this notice of defence”, the opponent stated:

“Pulses and rice”.

29. However, and as Mr St Quintin submitted, the answer to this question must be read in light of the applicant’s original non-use claim which related only to the following goods:

“All goods and services except flour and flour products including poppadoms (in class 30) and mango chutney (in class 29)”

30. Thus, measured from the perspective of the non-use allegation, mango chutney (even though the applicant erroneously stated that it was in class 29) was not the subject of the non-use claim so there was no need to include mango chutney in the notice of defence. That, though, is not the end of the matter because the applicant subsequently amended its non-use claim to read:

“All goods and services except pulses (class 29) and rice (class 30) and gram flour and poppadoms (in class 30)”

31. The above amendment, as I understand it, was put in to reflect the evidence that had been filed and the classification issues (surrounding mango chutney) that by that time had arisen. In other words, it had become apparent to the applicant that mango chutney was not actually covered by the opponent’s registration so there was no need to include it in the excepted goods. The opponent did make a request to amend its counterstatement to extend its defence (amongst other things) to:

“mango chutney (being a good within sauces) in class 30”

32. At the time, I did not consider it necessary to formally amend the counterstatement. The request was being considered at the same time as the request noted at paragraph 27 above (the amendment to the statement of use). The requested amendment was put to me simply as a clarification because the claims already took in sauces. Whilst this was the case for the statement of use in the opposition, it was not the case for the revocation counterstatement and it was not made clear to me that there was a resulting tension (as I have attempted to describe) with regard to the scope of the respective proof of use/revocation claims. Given the amendment the applicant had made to its revocation claim, and even though I did not consider it necessary at the time, I should have permitted the amendment to the defence. I do so now. There is no prejudice to the applicant, it has known for some time that the opponent is attempting to rely on mango chutney so it should have been in no doubt that it wished to retain that term as a result of the revocation.

33. My findings with regard to mango chutney/mango pickle are that:

- i) The opponent was entitled to argue that the term mango chutney (as a subset of sauces) should be relied on/retained in both the revocation proceedings and the proof of use assessment in the opposition.
- ii) But the opponent has failed to persuade me that the term mango chutney is a sauce so the term cannot be relied upon/maintained in class 30.
- iii) The goods sold by the opponent do not fall in class 29, so any argument that mango pickle can be relied upon/retained in class 29 is rejected.

Pulses and rice

34. Pulses and rice are specifically identified in the applicant's (amended) revocation claim as goods to which its non-use claim does not apply. The goods form part of the opponent's statement of use in the opposition proceedings, albeit, rice was added later by way of amendment (which I permitted) because it was only discovered later that genuine use had been made for rice in addition to the other goods that formed part of its statement of use. The applicant accepts that genuine use has been made. Therefore, these terms may be relied upon/retained in both the revocation proceedings and the proof of use assessment in the opposition.

Flour

35. Flour appears in the opponent's statement of use. It is also a good identified by the applicant as something which was not the subject of the non-use claim (hence why flour did not form part of the opponent's revocation defence). The applicant's claim was later amended so that “flour” read “gram flour”. The applicant accepts that genuine use has been made in relation to gram flour, but not flour more widely. The opponent accepts that use has been made in relation to just gram flour, but submits that a fair specification for such use would be flour generally. I accept that what has occurred here should have led to an amended notice of defence in the revocation specifying that that the opponent wished to defend in relation to flour generally,

however, I again consider it clear that this has been the understood position. The real question, though, is whether a fair specification for the accepted use on gram flour should be flour.

36. I have already set out the case-law regarding the devising of fair specifications. Mr St Quintin submitted that whilst there are various types of flour, they all form part of a clear sub-category “flour” and that the case-law calls for sub-categorisation as opposed to listing the exact products on which the mark has been used. Dr Spencer argued that gram flour was a specialist form of flour distinct from other flour (such as self-raising/plain flour) and is something specifically used in Indian cooking. Dr Spencer also highlighted that on the opponent’s poppodoms the main listed ingredient is gram flour (as opposed to just “flour”) which indicates the importance of this particular type of flour being used.

37. I accept that the case-law encourages the use of appropriate sub-categorisation. One should also avoid being pernicky in the fair descriptions one comes up with. However, I also bear in mind one of the points made by Jacob J in *Animal*, in that part of the consideration is whether the mark has been used on just one product, or, alternatively, a range of products. As was pointed out in the *Assos* case, one must be careful not to strip the mark of protection for things which are not in substance any different from other goods in the same category. Although this point alone may not be decisive, I have no evidence to show whether gram flour is sold alongside other types of flour. My own experience tells me that it is not. Gram flour does, I agree, have a more specific culinary purpose than plain/self-raising (and other) flour. It is made from milled chickpeas, which will no doubt give it a different taste and which will lead to the different purposes for which it may be utilised. The opponent has, by its own admission, sold just one type of flour. Bearing all this in mind, I consider it appropriate for a fair specification to read “gram flour”, gram flour being a sub-category of flour. This term may be relied upon/retained in both the revocation proceedings and the proof of use assessment in the opposition.

Flour products for food

38. In terms of the pleadings point, exactly the same situation applies as per gram flour so the findings I have made equally apply. The same question arises over the fair specification. The applicant accepts that genuine use has been made in relation to poppodoms. The opponent accepts that its use is limited to poppodoms, but argues that “flour products for foods” would be a fair specification. The position here is even starker than the position regarding flour. The term sought to be relied on is extremely wide when one considers the actual use that has been made. I reject the submission that “flour products for food” may be relied on/retained. Mr St Quintin did suggest a further sub-category, identified as something akin to Indian snack food products being flour products for food. I again reject this submission. The average consumer would describe use on poppodams as simply that. They would not extrapolate it to a category of goods which would cover a whole host of products which would, in substance, be quite different. Bearing all this in mind, I consider it appropriate for a fair specification to read “poppodoms”. This term may be relied upon/retained in both the revocation proceedings and the proof of use assessment in the opposition.

Resulting specifications

39. In view of the above, the earlier mark may only be relied upon in the opposition proceedings for the following goods:

Class 29: Pulses

Class 30: Gram flour; poppodoms, being flour products for food; rice

40. Furthermore, the revocation action is successful save in relation to the above goods.

Date of revocation

41. The date of revocation initially pleaded by the applicant was 20 December 2013³. As stated earlier, the applicant did seek leave to amend this date (and the relevant period) so that revocation would be effective from before the relevant date in the opposition. The request was made, essentially, so that the applicant could rely on what it considered to be the more limited scope of defence the opponent had put in. In view of my findings above, the scope is the same. Consequently, I see no need to make an amendment to the effective date of revocation now. It would serve no real purpose and would only succeed in complicating matters further.

Section 5(2)(b)

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

“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.”

43. The following principles are gleaned from the judgments 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.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

³ The pleaded period of non-use being 20 November 2008 to 19 November 2013.

(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

44. When making this determination, all relevant factors relating to the goods should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* 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.”

45. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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. 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.”

46. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 the General Court (“GC”) stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

47. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“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.”

48. I will go through the applied for specification term by term (albeit grouping them when it is practical to do so). I will start with the class 30 goods:

Chili

49. In class 30, the term “chilli” would, in my view, cover goods such as chilli powder and chilli sauce (including chilli cooking sauce). The earlier mark covers pulses (class 29), rice, gram flour and poppods. All the goods are types of food. However, any similarity on this basis alone would be at a very high level of generality. The nature of the competing goods is not the same. There is no competition between the goods. One would not make a competitive choice between chilli on the one hand and the goods of the earlier mark on the other. Generally speaking, chilli (powder or sauce) would not be located in particularly close proximity to the goods of the earlier mark. The goods could, for obvious reasons, be aimed at the same consumer, although this, again, is a very general point.

50. Much of what I have said so far suggests that the goods are not similar. However, I must also assess whether there is any complementarity between the goods which would give rise to similarity. Chilli (be it powder or a cooking sauce) is a principal component in chilli based meals. Two of the goods of the earlier mark are also staple products used to make such things. Pulses cover red kidney beans (a common ingredient in chilli) and rice is a common accompaniment. This introduces a degree of complementarity as the goods are mutually important to each other in terms of potential use. However, there is, effectively, a second limb to the test for complementarity. The type of relationship in play must be one where an average consumer may think that the responsibility for the goods lies with the same undertaking. I accept that simply because different food products could be used as ingredients in the same thing does not automatically make them similar on a complementary basis; flour may not be similar to milk even though they are both ingredients used to make pancakes. Something more would normally be required.

51. Neither party has filed evidence directed to this point. However, I am aware from my own experience, and I consider this to be common knowledge, that particular undertakings will often produce a range of co-ordinated products for the creation of particular dishes or styles of dish, including chilli dishes. This, in my view, is indicative of the second limb of complementarity in the sense that the relationship is one where the average consumer may think that the responsibility for the goods lies with the same undertaking. It also introduces a similarity in purpose. Overall, I consider the goods to be similar, but not highly so. I consider the degree of similarity to be low.

Chili powders; Chili cooking sauce

52. Given the above findings, the same applies here. There is a low level of similarity between these goods with both rice and pulses.

Spice preparations

53. Spice preparation would include chilli powder mixes for making chilli dishes. By parity of reasoning, there is a low level of similarity between these goods with both rice and pulses.

Cooking essences

54. There is no evidence showing what, exactly, a cooking essence consists of. It suggests to me some form of preparation to add flavour to something. For example, it could be vanilla essence used to add the flavour of vanilla to what is being cooked. This is perhaps the most obvious cooking essence. However, whilst I accept that it is possible for cooking essences to have a chilli flavour, I am less sure that the type of complementary relationship described above is in existence. The goods seem more of a quick flavour booster as opposed to something which constitutes a principal ingredient likely to form part of a co-ordinated range. I conclude that the goods are not similar.

Dressings (salad-)

55. A salad dressing is a particular product. It is used, as the name suggests, to dress a salad. Although it is possible for a salad dressing to have a chilli flavour (although there is no evidence on this), a salad dressing does not have the same type of complementary relationship with pulses and rice that I have described. The goods do not compete. The nature is quite different and there is nothing to suggest that they will be sold in particularly close proximity. As already stated, that the goods are for human consumption is a most superficial aspect of similarity. The real purpose is quite different, one being to dress a salad, the other(s) being to cook as an ingredient or accompaniment to a meal. I do not consider these goods to be similar.

Marinades

56. A marinade is a preparation in which things such as meat are soaked in order to impart into the meat the flavour of the marinade and/or for the purpose of tenderising it. I accept that it is possible for a marinade to have a chilli flavour. However, the same type of complementary relationship described earlier is not, in my view, in play. The goods do not compete. The nature is quite different and there is nothing to suggest that they will be sold in particularly close proximity. As already stated, that the goods are for human consumption is a most superficial aspect of similarity. The real purpose is quite different, one being to soak meat in (to impart flavour or to tenderise), the other(s) being to cook as an ingredient or accompaniment to a meal. I do not consider these goods to be similar.

Pepper vinegar

57. My own experience is limited to traditional malt vinegar. There is no evidence as to whether pepper vinegar has a different purpose to malt vinegar. I can only proceed on the basis that it does not. The same type of complementary relationship described earlier is not, in my view, in play. The goods do not compete. The nature is quite different and there is nothing to suggest that they will be sold in particularly close proximity. As already stated, that the goods are for human consumption is a most superficial aspect of similarity. The real purpose is quite different. I do not consider these goods to be similar.

Peppers [seasonings]

58. I come to the same view as above in that the same type of complementary relationship described earlier is not, in my view, in play. The goods do not compete. Their nature is quite different and there is nothing to suggest that they will be sold in particularly close proximity. The real purpose is quite different. I do not consider these goods to be similar.

Processed herbs

59. Whilst processed herbs could be used in a variety of dishes, there is nothing to suggest any particular relationship with the goods of the earlier mark. Therefore, the same type of complementary relationship described earlier is not, in my view, in play. The goods do not compete. The nature is quite different and there is nothing to suggest that they will be sold in particularly close proximity. As already stated, that the goods are for human consumption is a most superficial aspect of similarity. The real purpose is quite different, one being to add a herb like flavour to something, the other(s) being to cook as an ingredient or accompaniment to a meal. I do not consider these goods to be similar.

I now consider the goods in class 29.

Chilli

60. I discussed the classification of chilli (in class 29) with the parties at the hearing. My understanding is that the term covers the prepared meal (as in chilli-con-carne) and some form of preserved/dried (etc) chilli (as opposed to a fresh chilli which would be in class 31). Neither representative disagreed with that view. Given what I have said in paragraphs 50-51, I consider there to be a low degree of similarity. From the perspective of chilli (con-carne), rice is a key accompaniment and introduces the type of complementary relationship where an average consumer may think that the responsibility for the goods lies with the same undertaking. In relation to (preserved/dried etc) chilli, then the goods form part of the core ingredient of a chilli meal, along with pulses (specifically red kidney beans) and rice, and likewise gives rise to a type of complementary relationship where an average consumer may think that the responsibility for the goods lies with the same undertaking.

Chilli oil; olive oil

61. Both these goods are oils, something which is used to cook things in or, alternatively, could be used to dress other items. Chilli oil is oil which has simply been infused with chilli. Even in relation to chilli oil, I do not consider the same type of complementary relationship described earlier is in play. The goods do not compete. Their nature is quite different and there is nothing to suggest that they will be sold in particularly close proximity. As already stated, that the goods for human consumption is a most superficial aspect of similarity. The real purpose is quite different, one being to cook things in or dress other items, the other(s) being to cook as an ingredient or accompaniment to a meal. I do not consider these goods to be similar.

62. I should add the following points:

- i) Although I have already held that mango chutney may not be relied upon in the opposition proceedings, I add, in case of appeal on that point, that I would not have considered the opponent to be in any better position than that given above. One of Mr St Quintin's main submissions on the goods comparison was on the basis of the competing goods being classed as forms of world food which would form a part of a range of products sold in specialist stores or aisles. However, I agree with Dr Spencer that this is something of an artificial line to take as one must still consider the actual goods themselves. Looking at the actual goods, mango chutney does not give rise to any greater degree of similarity as I have already assessed. Where I have found the goods not to be similar, mango chutney is no closer.
- ii) Much of my analysis above is based on the pulses and rice of the earlier mark. I have considered the matter also on the basis of gram flour and poppods, but I do not consider the opponent's position to be improved.

Average consumer and the purchasing act

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

64. The average consumer is a member of the general public. The goods could also be purchased by those in the trade for catering purposes, but this is not the most common form of purchase. Either way, the goods will be selected with no more than an average level of care and consideration through primarily visual means. I should add that I reject the submission of Dr Spencer that the average consumer of goods such as rice and poppodoms should be limited to those with Indian sub-continent backgrounds. People from all sorts of backgrounds consume these goods.

Comparison of marks

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

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

PaPa Spice v PAPA

67. The opponent's mark is comprised simply of the word PAPA, thus, that is the only thing that contributes to its overall impression. In terms of the applicant's mark, this consists of the word PaPa (which despite its upper and lower casing, will be seen as a single word equivalent to Papa) and the word Spice. Whilst it is possible that the word Spice could be seen as a reference to the name of the PaPa in question, I consider that most average consumers would see it simply as a descriptor, indicating that the goods consist of spice, or are spiced in some way. Given such a perception, it seems to me, despite the two words being of the same size and visual prominence, that the word PaPa will play a greater relative role in the overall impression.

68. Visually, both marks contain the word PAPA/PaPa. It is the only element in the earlier mark and the first element in the applied for mark. There is a difference in the casing presented, but I do not consider this to be particularly significant because the actual difference this creates on the eye is not that great and, furthermore, the earlier mark could notionally also be used in upper and lower case. There is, of course, an

additional element to the applied for mark, the descriptive word Spice. This creates a difference, but the impact of such a difference must be tempered by the assessment of the mark's overall impression that I have made. I consider there to be a reasonably high degree of visual similarity.

69. Aurally, a similar analysis runs through the assessment. I consider that the elements PAPA/PaPa will be articulated in an identical manner. There is a difference overall, though, due to the addition of the word Spice. I consider, as above, that there is a reasonably high degree of aural similarity.

70. Dr Spencer submitted that the earlier mark, because its goods are targeted at consumers with an Asian sub-continent background, would conceptualise the mark on the basis of the word papu being Hindi for Dal. He contrasted this with the concept behind the applicant's mark which "references Father". I agree with Dr Spencer's submission regarding the applicant's mark, but not the opponent's mark. Firstly, if the Hindi word is "papu" I do not see why they would approximate the word PAPA with it. If I have in some way misunderstood Dr Spencer's submission then there is a more fundamental problem. I have assessed the average consumer as a member of the general public in the UK. This is not limited to those that speak Hindi. There will be a significantly greater proportion of average consumers that do not speak Hindi than those that do. Therefore, even if Dr Spencer was right with regard to Hindi speakers seeing a reference in the opponent's mark to the Hindi word papu, the fact remains that for the bulk of average consumers in the UK, the mark will be conceptualised in the same way as that of the applicant's mark, a reference to Father. The marks are conceptually similar to a very high degree.

Distinctiveness character of the earlier marks

71. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or

services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

72. From an inherent perspective, the word PAPA means Father. This is typical expression used in many continental countries, it is likely to be less used (but still understood) in the UK. The mark may invoke suggestions of homeliness when it comes to food. But the suggestive quality is quite mild. Dr Spencer’s skeleton argument refers to other marks on the register such as Papa John (two others are mentioned). However, there is nothing to show how common it is for Papa based marks to be used in the UK. The mark is not a highly distinctive one. I would pitch it between low and medium, what I will describe as a moderate level of inherent distinctive character.

73. There is then the question as to whether the use which has been made of the earlier mark enhances its distinctive character. In relation to this, Mr St Quintin took me to the witness statement of Mr Pagarani. In the last three years turnover under the mark has been between £3.36 million and £4million. Mr St Quintin went through some of the invoices in the evidence and highlighted that in a particular period (late 2011 to early 2012) the opponent sold 16 tonnes of mango chutney, just under 18 tonnes of poppods, 28 tonnes of gram flour and 1.4 tonnes of pulses. However, the difficulty that arises with such figures is that the true market context that they have is not clear and, thus, the impact any of this will have had on the average consumer is not clear. The problem is compounded by the fact that the goods are sold principally to the trade as opposed to members of the general public. It is possible that some of the goods (with the exception of mango chutney) may end up on the shelves of retail stores, but how much is not clear. Furthermore, whilst reference is made to attendance at exhibitions and to promotion via posters, brochures, promotional giveaway etc, the impact of all this is difficult to ascertain. All things considered, I am not persuaded that the use made of the mark will have any material impact upon the likelihood of confusion. There is no material enhancement of distinctive character.

Likelihood of confusion

74. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

75. For the following goods there is no likelihood of confusion because I found no goods similarity⁴:

Class 29: Chilli oil; Olive oil.

⁴ See, for example, the CJEU’s judgment in *Waterford Wedgwood plc v OHIM* - Case C-398/07.

Class 30: Dressings (salad-); Marinades; Pepper vinegar; Peppers [seasonings]; Processed herbs; Cooking essences

76. For the remaining goods, I have said that there is a low degree of similarity with the goods of the earlier mark (particularly rice and pulses). There is a reasonably high degree of visual and aural similarity and a very high degree of conceptual similarity. The earlier mark has a moderate degree of distinctiveness and the goods will be selected with no more than an average level of care through predominantly visual means. This case represents an archetypical multi-factorial balancing act. There is clearly greater similarity between the marks than there is between the goods, but I consider that this greater similarity will offset the low degree of goods similarity. The average consumer will believe that the respective goods are a same stable product. Even if the average consumer recalled that one mark had the additional word SPICE whereas the other did not, the fact that this additional word is descriptive will be appreciated by the average consumer and whilst the word may not be disregarded, it would do little to avoid confusion. The addition would be seen as a reference to a spiced part of the Papa range. The difference in casing is something that could easily be lost through imperfect recollection. There is a likelihood of confusion in relation to:

Class 29: Chilli

Class 30: Chili; Chili powders; Chili cooking sauce; Spice preparations.

This finding extends to all the applied for marks.

Section 5(4)(a)

77. Section 5(4)(a) of the Act reads:

“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.”

78. 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.”

79. 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

80. Whether there has been passing-off must be judged at a particular point (or points) in time. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Lord Justice Kitchen summarised the position thus:

“165. There is a further complication, however. Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc.*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the Community trade mark would have amounted to passing off. But if the Community trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

The above related to a community trade mark, however, the same applies, *mutatis mutandis*, to a UK national trade mark. The filing date of the subject trade mark is 11 July 2013. There is no evidence of any pre-filing use⁵ by the applicant so the matter need only be assessed as of that date.

Goodwill

81. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) the following was stated in respect of goodwill:

⁵ The applicant's evidence refers only to its present use.

“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.”

82. In *Hart v Relentless Records* [2003] FSR 36, 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.”

83. 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.”

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).

84. Mr St Quintin accepted that the opponent was no better off under section 5(4)(a) than it was under section 5(2)(b) unless I found, following my proof of use assessment, against the opponent on its ability to rely upon mango chutney. He submitted that if I did not permit mango chutney to be relied upon under section 5(2)(b) then it could be relied upon under section 5(4)(a) as the opponent had goodwill associated with the sale of such goods.

85. In terms of goodwill, and despite Dr Spencer’s submissions to the contrary, I accept that the opponent has goodwill in a business associated with the sale of mango chutney (and other goods such as rice, poppodoms and pulses). However, it must be observed that the goodwill exists with people in the trade. As stated earlier,

the opponent's mango chutney is sold in large drums and will likely only ever end up behind the scenes in Indian restaurants. Whilst goodwill certainly exists, the observations I made earlier about the size of the relevant markets means that I cannot assess it as a strong goodwill. One further point to note is that the mango chutney is packed by a separate entity called Natco. However, the packaging specifically indicates that this is being done for Crown Oriental Foods Ltd, so I do not consider that any issue with regard to ownership of goodwill arises. In any event, both Natco and Crown Oriental Foods are part of the same group (see Mr Pagarani's first witness statement) and the facts presented suggest that goodwill would, at the very least, be shared.

Misrepresentation

86. The relevant test was outlined by Morritt L.J. in *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473:

“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 *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.”

And later in the same judgment:

“.... 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.”

87. The following goods are those for which the opponent failed under section 5(2)(b):

Class 29: Chilli oil; Olive oil.

Class 30: Dressings (salad-); Marinades; Pepper vinegar; Peppers [seasonings]; Processed herbs

88. I found the above goods not to be similar to those of the earlier mark, including them not being similar to mango chutney on a fall-back basis. Of course, I bear in mind that goods do not need to be similar for a successful finding under section

5(4)(a), although, of course, the greater the relationship that does exist the greater the propensity for a misrepresentation to occur. The similarity of the marks under section 5(2)(b) is the same analysis for the similarity of the mark and the sign under section 5(4)(a).

89. Having taking into account the nature of the goodwill together with the similarity of the marks and the relationship between the goods, I come to the view that no misrepresentation will arise. The goodwill of the opponent is limited to a particular product aimed at Indian caterers and restaurateurs. Even taking into account the other goods it is has sold, the range is quite specific and limited. Even for those people aware of the opponent's goodwill, I do not consider that a substantial number would believe that the above goods sold under the applicant's mark were the responsibility of the opponent. The various factors suggest to me that such people will consider this to simply be a co-incidental use on different types of food products. The ground of opposition fails for the above goods.

90. It is academic to consider this ground in relation to goods for which the opposition has already succeeded. However, I briefly express the view that if my finding under section 5(2)(b) were successfully appealed, the opponent would be in no better position under section 5(4)(a). This is principally because the Indian-centric nature of its business, a business predominantly within the trade (which is not something I need to take account of under section 5(2)(b)), means the opponent is likely to be in a worse position under section 5(4)(a).

Section 5(3)

91. Section 5(3)⁶ of the Act reads:

“5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark,

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

Reputation

92. The earlier mark(s) must have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 the CJEU stated:

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

⁶ Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the CJEU in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (“Addidas-Salomon”) (C-408/01).

93. Given my earlier observations, my view is that the opponent has not proven the existence of a reputation. The ground of opposition is dismissed. In any event, I struggle to see, even if there had been a reputation, why any of the heads of damage would arise, particularly with regard to the goods for which the opposition has so far been unsuccessful. My findings under section 5(4)(a) suggest that there will be no unfair advantage on the basis of an assumption that the same undertaking is responsible for the goods. Mr St Quintin's primary submission was based on the pleadings point (see paragraph 6) and that he did not even need to argue why the heads of damage would arise. As a fall-back he simply referred back to the opponent's broad pleaded case. That case refers to the applicant benefitting from the power of attraction of the earlier mark, that the use by the applicant could damage the opponent's reputation or that the distinguishing capacity of the earlier mark is diluted. This consists of little more than simple assertion and I struggle to see how any of them are made out. There is no reason why the applicant's use would tarnish the opponent. There is no impact on the capacity of the opponent's mark to distinguish and I see no reason why the applicant's job of marketing its goods would be any earlier. The ground of opposition is dismissed.

Other evidence

94. Much more evidence has been filed in these proceedings than I have mentioned in this decision. However, such evidence either does not assist me in determining the matters that need to be determined, or it takes matters no further forward than the evidence I have mentioned. The evidence relied upon by the representatives at the hearing has been the evidence I have focused upon. I do note, though, that in the evidence filed by the applicant, examples of the present use by the applicant are set forth. This includes use on chili sauce in jars and stand-up pouches. I have considered whether the terms for which I have refused registration could be amended to avoid confusion. In my view, they cannot. There is no obvious way of limiting the specification to avoid the similarity between the goods I have identified.

Costs

95. Given the fairly chequered procedural history of these proceedings, I indicated at the conclusion of the hearing that I would give the parties an opportunity to make submissions in writing with regard to costs. A simultaneous period of 2 weeks is permitted for such submissions to be received, following which I will issue a supplementary decision on costs.

Dated this 6th day of August 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**