

O-005-16

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3010407
IN THE NAME OF MARIAGE FRÈRES, SOCIÉTÉ ANONYME
FOR THE FOLLOWING TRADE MARK IN CLASSES 21 AND 30:**

CASABLANCA

**AND
AN OPPOSITION UNDER NO. 401219
BY
TWG TEA COMPANY PTE LTD**

BACKGROUND AND PLEADINGS

1. On 18 June 2013 Mariage Frères, Société anonyme (the applicant) applied for the trade mark shown on the cover page of this decision for the following goods:

Class 21

Household or kitchen utensils and containers; teapots; tea services; tea balls, strainers, tea measures, infusers, tea filters, tea cosy of metal; tableware of glass, porcelain, earthenware, synthetic resin, terracotta; tableware of precious metal or coated therewith (except cutlery); tea canisters, caddies and urns; candlesticks and candelabra (candlesticks) of precious metal or coated therewith; trays and boxes for household use of precious metal or coated therewith.

Class 30

Tea, blended teas and herbal teas (bulk or tea bag); tea based beverages.

2. TWG Tea Company Pte Ltd (the opponent) opposes the application under section 5(4)(a) of the Trade Marks Act 1994 ('the Act'). In summary the grounds are:

- Section 5(4)(a): The opponent owns a substantial goodwill and reputation under the name and trade mark WEEKEND IN CASABLANCA including in, and throughout, the United Kingdom. The said goodwill and reputation was established prior to the date of the Application, and at least as early as 2010.

3. The applicant filed a counterstatement requesting the opponent provide proof that it has made genuine use of the trade mark WEEKEND IN CASABLANCA in the UK since early 2010 on which to base its passing off claim. It states:

"4. In this regard, the adoption of the trade mark WEEKEND IN CASABLANCA by the Opponent has, in fact, been made in bad faith as it is believed that the Opponent would have been fully aware of the use, by the Applicant, of the trade mark CASABLANCA in France since 1994 in relation to tea, tea tins and glass bottles.

Furthermore, it is believed that the Opponent would have been familiar with use of the trade mark CASABLANCA in the UK in relation to tea and tea tins since at least 2006 which pre-dates the claimed date of first use by the Opponent of the trade mark WEEKEND IN CASABLANCA."

4. A hearing took place before me at which the opponent was represented by Mr Ian Bartlett for Beck Greener and the applicant by Mr Tom St Quentin of Counsel, instructed by Potter Clarkson LLP. Mr Sanjay Kapur was also in attendance for Potter Clarkson LLP. Both sides filed evidence and both parties filed skeleton arguments in advance of the hearing.

THE EVIDENCE

Opponent's evidence

5. The opponent's evidence comprises a witness statement by:

Taha Bouqdib and exhibits TB1- TB7

6. Mr Bouqdib is a director of the opponent, which is a Singaporean company. He has been the President & Chief Executive Officer since 2008. His statement is dated 2 June 2014.

7. Mr Bouqdib states that the opponent adopted its current name in December 2007 and opened its first teas salon in Singapore in August 2008.

8. At paragraph 9 of his witness statement Mr Bouqdib provides what he describes as a 'market analysis' of the business which he states he believes to be correct. The key fact from this are as follows:

- TWG [Tea] is a luxury tea brand created in 2007.
- As of 31 March 2013 it had 24 sales outlets (made up of 14 salons and 10 counters) and employed approximately 530 people.
- 22 of the sales outlets are in shopping malls.
- TWG [Tea] is mainly present in Asia (including, inter alia, Singapore, Japan, Malaysia, Thailand, China, Philippines, Indonesia and UAE).
- It operates an outlet at Harrods, London.
- TWG [Tea] products are distributed by partners in 33 other countries through specialist retail stores (for example, Dean & DeLuca in the USA).
- Other channels of distribution include hotels and airlines.
- In 2012 the turnover of the company was 27m SGD.
- 79% of the turnover was generated in Asia (89% of which relates to Singapore). The remaining 21% was mainly generated by sales to professionals such as hotels and airlines.
- One fifth of turnover for TWG salons is for sales of pastries and takeaway food.
- The development strategy of the company is centred on expansion in Asia where it has opened 13 establishments since 2011.

9. The last paragraph of the analysis describes the appearance and style of the TWG outlets:

"TWG Tea has positioned itself in the tea market as a luxurious tea house with a modern eye catching style. Its establishments are mainly situated in shopping malls, close to the major international luxury brands and the company presents a modern and resolutely Singaporean identity. The distinctive features of TWG Tea's point of sales are the prevailing use of the colour yellow, gilding, marble and brass. In this way TWG Tea creates a clear and luminous atmosphere which reflects Asian refinement."

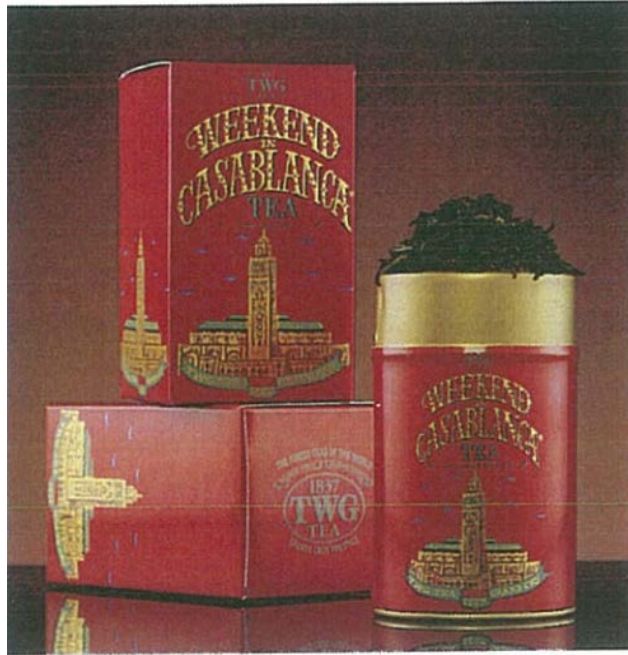
10. Exhibit TB3 is taken from the opponent's website and was printed on 27 February 2014. A list of the opponent's salons and boutiques is provided, one of which is in the UK at Harrods in Knightsbridge. Salons appear to be venues where tea is served, while boutiques are places where tea is sold. Some of the places on the list are described as both, the Harrods premises is described as a 'TWG Tea Boutique'.

11. Mr Bouqdib states that the opponent's use of 'WEEKEND IN CASABLANCA' dates back to at least 2009 for loose leaf tea and 2010 in respect of packaged tea. Further 'WEEKEND IN...' teas were added to the range in 2012. Exhibit TB4 is the opponent's tea list from 2009 which shows 'Weekend in Casablanca Tea' on page 8. The price is given as \$10.5.

12. Also included in this exhibit is a press release which Mr Bouqdib states is from a re-launch in 2012. The press release talks of five new teas being added to the range in June 2012 and provides a list of ten teas which will then be available. 'WEEKEND IN CASABLANCA' is second on the list. On the accompanying photograph twelve boxes of tea are shown. Whilst it does not reproduce well, one of the boxes is red with gold lettering and reads 'WEEKEND IN CASABLANCA TEA'.



13. In his witness statement at paragraph 13, Mr Bouqdib provides a photograph showing, "how the mark is used on tea and packaging and canisters for the teas", as follows:



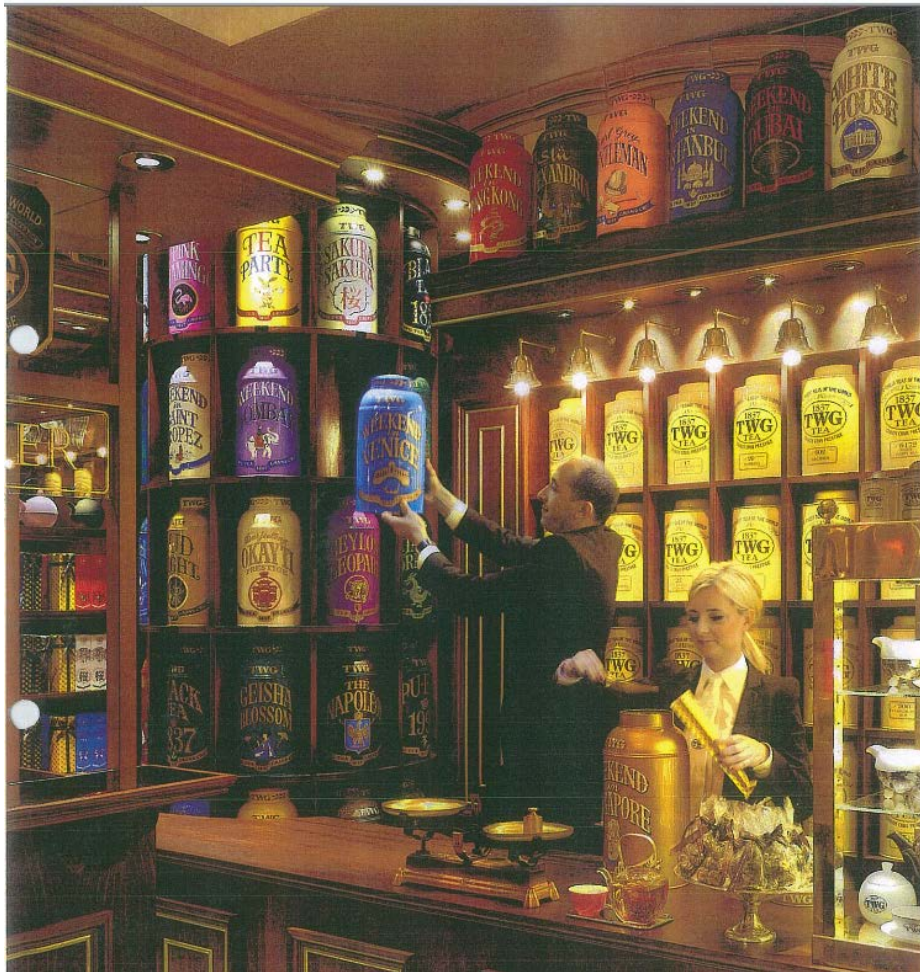
14. Exhibit TB5 is what Mr Bouqdib describes as, “mentions of our WEEKEND IN CASABLANCA tea in various international magazines, web sites and blogs”. Five articles are included within the exhibit, none of which are directed at the UK market. Rather, they are aimed at Singapore, Thailand, Malaysia, Vancouver and another location which I cannot determine as the exhibit is not in English and no translation has been provided. They are all dated between May and July 2012 and appear to relate to the re-launch of the ‘WEEKEND’ teas. Whilst three of the articles use the publicity photograph I have shown above at paragraph 12, the articles themselves make no mention of ‘WEEKEND IN CASABLANCA’ tea.

15. I note that the canister of tea on page seven of the exhibit TB5 which the opponent identifies as WEEKEND IN CASABLANCA tea, is fairly difficult to read but can be seen to be Earl Grey Fortune tea. The Earl Grey tea is also in a red canister but has an image of a woman in a blue dress, whereas ‘WEEKEND IN CASABLANCA’ is decorated with a gold building.

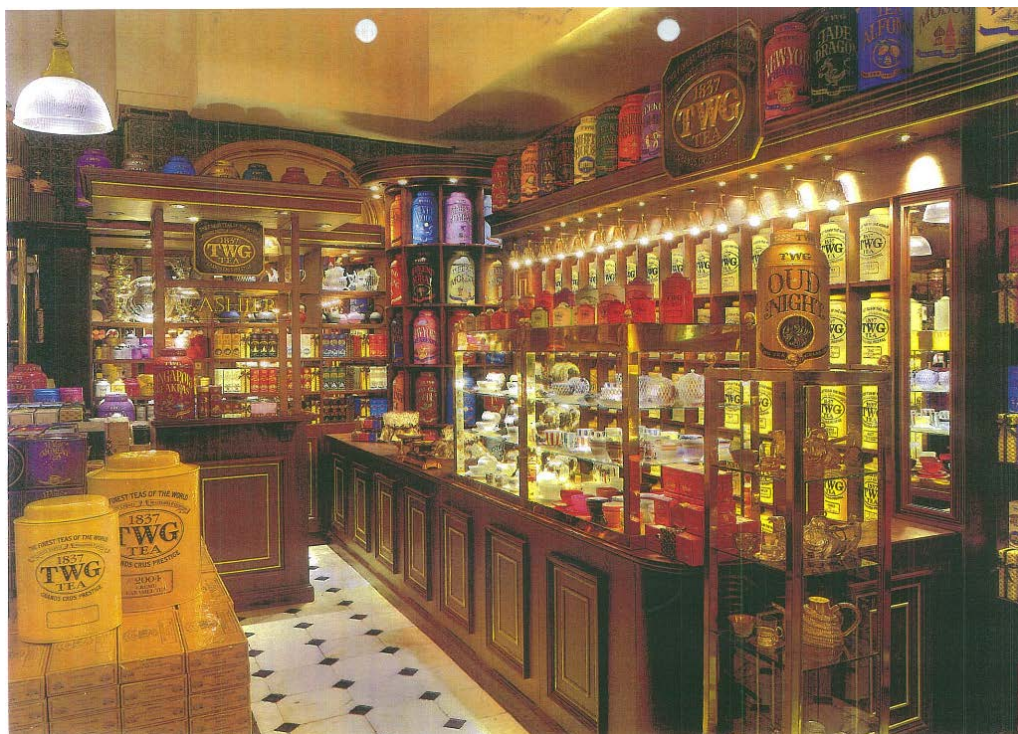
16. Exhibit TB6 is photographs of the opponent’s tea boutique in Harrods. Mr Bouqdib says of the store:

“Our TWG store in Harrods is open plan and has a high footfall of through-traffic. Indeed, I note from Harrods web site that 15 million customers per year visit Harrods flagship store in London every year. A significant proportion of those 15 million customers per year will come across our TWG store in Harrods. Our WEEKEND IN CASABLANCA tea products are on display in our store and are likely to be noticed by those who pass through or by our store”.

17. He also states that the WEEKEND IN CASABLANCA tea has been marketed and sold from the London store continuously since 2010. The photographs show a close up of the tea counter:



And several photographs from a greater distance, showing the whole counter.



18. I cannot see any WEEKEND IN CASABLANCA tea displayed, especially as a number of the opponent's teas are sold in red boxes and canisters and the wording is not clear.

19. Exhibit TB7 is what is said to be a tea book. Mr Bouqdib states that WEEKEND IN CASABLANCA tea has been promoted in the UK and other countries through these books. He states that the book was first published in March 2011 and has been on sale from the London store since that date. It sells for S\$25. Since its launch more than 8,000 copies have been sold internationally. It is not clear how many, if any, of these were in the UK.

20. Mr Bouqdib provides the following sales figures which he describes as "UK sales of our teas under our WEEKEND IN CASABLANCA trade mark":

Year	Sales - Sterling
2010	4662
2011	10638
2012	13662
2013	14842
2014 (1 Jan-31 May)	7205

21. In terms of sales volume he states:

"Our WEEKEND IN CASABLANCA tea retails for GBP37 and the above UK sales figures there represent a sales volume of approximately 1,377 pieces."

Applicant's evidence

22. The applicant's evidence comprises witness statements by:

Sanjay Kapur and exhibit SK1

Kittichat Sangmanee and exhibits KS1-KS17

23. Mr Kapur is a Partner at Potter Clarkson LLP. His statement is dated 4 August 2014. His witness statement comprises submissions which I will not detail here but will refer to as necessary below.

24. Kittichat Sangmanee is the President of the Board and CEO of the applicant, a position he has held since 1996. His statement is dated 4 August 2014.

25. The relevant facts from Mr Sangmanee's witness statement are as follows:

- The applicant first used CASABLANCA as a trade mark in 1984.
- First use of the trade mark CASABLANCA in the UK in relation to teas and tea tins was at least 2006.
- Total worldwide turnover for products sold wholesale and retail under the CASABLANCA trade mark between 30 June 2006 and 30 June 2014 total over €8,000,000.

- Casablanca teas are sold in the applicant's tea houses and tea rooms around the world as well as at Claridges, Selfridges and Harvey Nicholls in London, at Quat'Saisons in Oxfordshire and directly to a number of UK stockists.

26. In respect of the opponent's evidence, Mr Sangmanee states:

*"24. I note that in paragraph 10 of Mr Bouqdib's statement that he seems to be suggesting that he held only minor positions with Mariage Frères during his employment between 1993 and 2007. Whilst I can appreciate that in his early years, whilst working as a waiter, he was probably not involved in decision making or devising strategy for the business, but clearly as he was promoted within the business he became more and more associated with the decisions regarding, in particular, the sales policy in the business, given that he held the position of store manager and also project manager, prior to his resignation. It seems inconceivable that TWG would have appointed Mr Bouqdib as director immediately upon his employment, and as a shareholder within 12 months, without him having a well above average profile within Mariage Frères."*¹

27. At Exhibit KS8, Mr Sangmanee provides an article taken from asiaone.com dated 20 October 2009. He says of this exhibit:

*"25...Mr Bouqdib admits, and proudly reports, that whilst employed at Mariage Frères he took care of tea blending and business development. This seems to be inconsistent with paragraph 10 in his witness statement. Interestingly, he also comments in this article that he commenced work on the TWG tea project in 2003 and this is, of course, four years prior to him leaving the employment of Mariage Frères."*²

28. Mr Sangmanee concludes at paragraph 30 of his witness statement:

"During his employment as a waiter, Maitre d'Hôtel, assistant manager and store manager with Mariage Frères, Mr Bouqdib would have served or supervised the service of hundreds, if not thousands, of servings of CASABLANCA tea to patrons and customers of Mariage Frères tea rooms situated in Paris and sold or supervised the sale of thousands of CASABLANCA tea bags. I believe he would have known that CASABLANCA was one of my company's bestselling and most well-known teas and I believe that this knowledge would have been the inspiration for him, and the Opponent, to adopt the trade mark WEEKEND IN CASABLANCA."

29. Exhibit KS7 comprises photographs of the applicant's tea shops and counters. Of this exhibit the applicant says that the applicant's stores have dark panelled oak wood and hardwood materials with teas displayed in complementary canisters to, "give an impression of life in the mid-late 19th and 20th Centuries." Mr Sangmanee concludes that the opponent has emulated the applicant's style.

¹ Exhibit KS3 is a copy of Mr Bouqdib's letter of appointment with Mariage Frères. It is dated 27 July 1993.

² Exhibit KS4 is a copy of Mr Bouqdib's letter of resignation from Mariage Frères. It is dated 4 April 2007.

30. The photographs are blurry and it is not clear where these premises are located. The wood panelling and tea canisters can be seen, though any lettering on them cannot be made out. Mr Sangmanee states that most of the outlets were established prior to the establishment of the opponent's shops.

31. Exhibit KS9 is an extract from the GUIDE DU THÉ, dated November 1984. Page 2 of the guide shows an entry for CASABLANCA tea with a description of its flavour, though the exhibit is French and a translation has not been provided.

32. Exhibit KS10 is a copy of the applicant's publication, 'L'Art Du Thé'. It is dated January 1994 and has a listing for CASABLANCA tea on page 3.

33. Exhibit KS11 is an English language version of the applicant's publication, 'The French Art of Tea'. It is dated September 1989 and describes the tea as, 'A fine marriage of green tea with Moroccan mint and bergamot-flavoured tea. A refreshing surprise. 'Play it again.'"

34. At paragraph 29 of his witness statement Mr Sangmanee states that each year the applicant produces an export and wholesale tariff for its goods. Exhibit KS12 is a selection of these tariffs from 1984 to 2008. Examples are provided for 1988, 1998, 1999, 2000, 2001, 2002, 2005, 2007-08 and 2008. Each year has a listing for CASABLANCA tea with a price in Francs or Euros.

35. Exhibits KS13 and KS14 comprise instructions to a designer (which are in French and are not translated) and examples of packaging used by the applicant which I reproduce below:



36. Exhibit KS15 is an example of the opponent's packaging, about which Mr Sangmanee says:

"...they use a very similar font style to the font used in relation to my company's CASABLANCA tea canister and, furthermore, TWG Tea also use a banderole on its packaging."

37. Exhibit KS16 comprises articles and blogs which the applicant states shows its long standing use of CASABLANCA as a trade mark. They are dated between June 2003 and November 2009 and all refer to CASABLANCA tea favourably. However, none of them relate to the UK market.

38. Exhibit KS17 consists of copies of a number of invoices which are addressed to UK customers and are dated between 2006 and 2013. They are all headed 'MARIAGE FRERES INTERNATIONAL'. The prices of all of the goods have been redacted but the invoice total is shown. For ease of reference I show the relevant details in the following table:

Date:	Customer:	Goods and quantity:	Invoice total:
23.08.06	Harvey Nichols London	12.000 TIN CASABLANCA 3.5oz	€3723.42
12.11.07	REMUS AU/EIKONOCLAST Brighton	12.000 TIN CASABLANCA 3.5oz	€3048.67
29.10.08	The Grocer Ltd London	24.000 30 MUSLINS CASABLANCA 24.00 TIN CASABLANCA 3.5oz 1.000 200 MUSLINS CASABLANCA	€5872.78
02.10.09	Hams Hill Distribution Park Birmingham	12.000 TIN CASABLANCA 3.5oz	€2320.39
09.11.10	REMUS AU/EIKONOCLAST Brighton	24.000 TIN CASABLANCA 3.5oz	€1665.89
24.03.11	MA MAISON London	12.000 CASABLANCA BOITE 100GR	€2113.37
04.12.12	THE CONRAN SHOP London	24.000 TIN CASABLANCA 3.5oz	€3425.82
03.10.13	DESIGN AND HOME LTD London	12.000 30 MUSLINS CASABLANCA 12.000 TIN CASABLANCA 3.5oz	€5728.62

Opponent's evidence in reply

Second witness statement of Taha Bouqdib dated 21 October 2014 and exhibits TB8- TB11

39. Exhibit TB8 refers to other opposition proceedings before this Tribunal which concern the same parties and the same marks. TB10 and TB11 are documents relating to previous trade mark disputes between these parties in respect of different marks. I have not listed similar documents filed by the applicant and decline to list

those provided by the opponent. The matters before me must be decided on their own facts.

40. Exhibit TB9 is a copy of an email dated 13 October 2009 from Mr Bouqdib to the designer of the opponent's tea packaging. The beginning of the email is in French and a translation has not been provided. The body of the email describes each tea variety in the 'WEEKEND IN...' range, in English. Weekend in Casablanca is described as:

"A pure moment of happiness treasured in an unforgettable creation, this blend of green tea and black tea yields a complex fruity bouquet accented with notes of wild mints."

41. With regard to the nature of the market for these goods, Mr Bouqdib states:

"5. It should be remembered in this regard, that my company's products are specialised and expensive. They therefore have a limited market...It is obvious that my company's customers who have bought our WEEKEND IN CASABLANCA tea will use this name when they want to repeat the purchase...Our WEEKEND IN CASABLANCA TEA has been sold in the UK since 2009."

42. That concludes my summary of the evidence.

DECISION

43. Section 5(4) of the Act states:

"5(4) 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...

(b) ...

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

44. 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."

45. Parker J in *Burberrys v J C Cording & Co Ltd* [1909] 26 RPC 693 said:

"The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but the property in the trade or good-will which will be injured by its use. If the use of a word or a name be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business."

46. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

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

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

47. Commenting on *South Cone* in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

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

The relevant date

48. Whether there has been passing off must be judged at a particular point (or points) in time. In the decision of the Court of Appeal in *Roger Maier and Assos of Switzerland SA v ASOS plc and ASOS.com Limited* [2015] EWCA Civ 220 it was stated:

“165. ...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.”

49. The above related to a community trade mark, however, the same applies to a UK national trade mark.

50. The filing date of the subject trade mark is 18 June 2013. However, the applicant claims that it has used its mark since at least 2006. In the instant case I must assess whether use of the applicant's mark CASABLANCA was, as at the date of application, liable to be prevented by the law of passing off. The onus is on the opponent to make out a prima facie case. If he succeeds, in the circumstances of this case, I need to return to the applicant's own position in view of his claim to seniority of user. I say this because, although a Section 5(4)(a) claim has to be established at the date of the application, it is clear that an opponent could have had no such right if an applicant's use is protected in the UK from an earlier date or if, by the relevant date, an applicant had established his own actionable goodwill in the UK (*Habib Bank* [1982] RPC 1 at 24).

Goodwill

51. The first hurdle for the opponent is to show that it had the required goodwill at the relevant date. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), the Court stated:

"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."

52. 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."

53. 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)

54. In making a finding with regard to the proprietor’s evidence I bear in mind the decision of the General Court in *New Yorker SHK Jeans GmbH & Co KG v OHIM*:³

“53. In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (*COLORIS*, paragraph 24). However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07 *P Ferrero Deutschland v OHIM*, not published in the ECR, paragraph 36).”

55. I also note that in the decision of Mr Daniel Alexander QC (sitting as the Appointed Person) in *PLYMOUTH LIFE CENTRE*⁴, he stated:

“...it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

56. I also bear in mind the comments of Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd*,⁵ when he stated:

³ *Case T-415/09*

⁴ *BL O-236-13*

⁵ *BL O/404/13*

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. V. Comptroller-General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

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

57. The opponent’s witness statement, which has not been challenged in terms of sales figures, shows sales of WEEKEND IN CASABLANCA tea in the UK since an unspecified date in 2010. Sales in 2010 amounted to £4662, rising to £14,848 by 2013. This is supported by the commentary from Mr Bouqdib throughout the evidence. The sales have been made to a single store in the UK, namely Harrods in London.

58. I accept that it would have been better had the opponent to have given an indication of the amount spent on advertising and promotion of the brand in the UK and invoices for sales in the UK, which would also have assisted. I would assume that such figures are available to Mr Bouqdib. I note that the opponent has referred to the footfall at Harrods as being in the region of 15 million people per year. However, there is no evidence to show how many of these customers have been exposed to the opponent’s tea counter, nor how many of those were exposed to ‘WEEKEND IN CASABLANCA’ tea. The fact that the evidence could have been better marshalled, however, does not mean that I should simply dismiss it.

59. Taking all of the evidence into account, I find that the opponent's goodwill in respect of tea sold under the mark WEEKEND IN CASABLANCA was, at the relevant date, although extremely modest in terms of volumes of sales, sufficient to be protected under the law of passing off.

Misrepresentation

60. The opponent's goodwill is associated with the sign WEEKEND IN CASABLANCA. The manner of overall use means that the goodwill is associated with the words per se. The application is made for the word CASABLANCA solus.

61. The two signs share a medium degree of visual and aural similarity, due to the inclusion of CASABLANCA in both, it being the totality of the applicant's mark. Conceptually, evidently both signs bring to mind CASABLANCA which (in the absence of evidence on the point from either party) I find will be identified by the consumer as a place, though they may not be familiar with its specific location.

62. Turning to the issue of misrepresentation it is the applicant's position that, notwithstanding the opponent's goodwill, the applicant was the first to use CASABLANCA on the goods concerned and that they had built up their own goodwill in respect of tea and tea tins since it was used in the UK as early as 2006.

63. The following passage taken from "The Law of Passing-Off" by Christopher Wadlow⁶ deals with the issue of antecedent rights:

"The definition of passing-off in terms of misrepresentation makes it necessary to deal with the case where the defendant claims to have anticipated the plaintiff in the course of conduct complained of. As the tort was formerly understood, it would normally be said that the indicia in issue could not be distinctive of the plaintiff if they were already in use by another, but this is not necessarily true. If the senior user in time is a small or local business, and the junior user a large one advertising heavily, then the public may soon come to associate the indicia in question so strongly with the larger party as to lead to the belief that the senior user is the interloper. It is self evident that the senior user is entitled to continue with the conduct which was innocent at its inception notwithstanding it might later be said to convey a misrepresentation to the majority of the public. Thus, in *Stacey v. 2020 Communications* the evidence was that customers confused the plaintiff's small but longer established business for a branch of the defendants. Millet J., though refusing the plaintiff an interlocutory injunction, pointed out that the defendants plainly could not prevent the plaintiff from continuing to use the name 2020, nor could they complain about third-party recommendations intended for them, which accidentally benefited the plaintiff instead."

64. I also bear in mind the comments of Mr. Geoffrey Hobbs sitting as the Appointed Person in *Croom*⁷ when he said:

⁶ 2004, *Sweet & Maxwell, Third Edition, paragraph 9.88 at page 780-1.*

“45. I understand the correct approach [under section 5(4)(a)] to be as follows. When rival claims are raised with regard to the right to use a trade mark, the rights of the rival claimants fall to be resolved on the basis that within the area of conflict:

(a) the senior user prevails over the junior user;

(b) the junior user cannot deny the senior user’s rights;

(c) the senior user can challenge the junior user unless and until it is inequitable for him to do so.”

65. In his evidence on behalf of the applicant, Mr Sangmanee provides a number of invoices at exhibit KS17. Four of the invoices show sales of tea (and tea tins) before 2010. The first shows a sale to Harvey Nichols on 23 August 2006 for goods described as ‘TIN CASABLANCA 3.5oz’. There are also invoices to a company in Brighton on 12 November 2007, The Grocer in London on 29 October 2008 and a centre in Birmingham on 2 October 2009. These are for tins of CASABLANCA tea and for muslins of CASABLANCA tea.

66. Having considered all of the evidence and submissions put forward by both parties, I find that the applicant has established itself as the senior user of CASABLANCA for tea and tea tins. In such circumstances there could be no legitimate complaint of passing off by the junior user at the point that this application was made.

CONCLUSION

67. The opposition under section 5(4)(a) fails.

COSTS

68. Mariage Frères, Société anonyme has been successful and is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. I have taken into account that no hearing has taken place and award costs on the following basis:

Preparing a statement and considering the other side’s statement:	£300
Preparing evidence and considering the other side’s evidence	£500
Preparation for and attendance at the hearing:	£500
Total	£1300

⁷ *Croom’s Trade Mark Application [2005] RPC 23*

69. I order TWG Tea Company Pte Ltd to pay Mariage Frères, Société anonyme the sum of £1300. 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 7th day of January 2016

**Ms Al Skilton
For the Registrar,
The Comptroller-General**