

O-422-19

TRADE MARKS ACT 1994

IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3233981  
IN THE NAME OF MITCHELL'S EUROPE LIMITED  
FOR THE FOLLOWING TRADE MARK (SERIES OF TWO):

**MITCHELL'S**  
**mitchell's**

IN CLASSES 29, 30 & 32

AND IN THE MATTER OF  
OPPOSITION THERETO  
UNDER NO. 410179  
BY MITCHELL'S FRUIT FARMS LIMITED

## Background and pleadings

1) This dispute involves a breakdown in a business relationship between a UK distributor and a supplier based in Pakistan leading to a trade mark application allegedly being filed in bad faith and also contrary to section 60 of the Trade Marks Act 1994 (“the Act”).

2) On 29 May 2017 Mitchell’s Europe Limited (“the applicant”) applied to register the trade mark **MITCHELL’S** and **mitchell’s** as a series of two in the UK. It was accepted and published in the Trade Marks Journal on 9 June 2017 in respect of the following goods:

Class 29: Preserved, frozen, dried and cooked fruits and vegetables; Jellies; jams; Milk and milk products; Edible oils and fats; pickles and fruit pickles; all ready cooked meals in class 29, prepared meals and snacks included in class 29; mixes for meals and snacks; mixes for making desserts and sweets; prepared desserts included in class 29; yoghurts, desserts made from yoghurt; beverages made from yoghurt; food products containing yoghurt; pickles and preserves; ghee; yoghurt drinks containing soda water; beverages containing milk, Recipe Spices; Dried lentils, Lentils, Lentils preserved; Garlic paste; pulses.

Class 30: All types of Bakery and morning goods & Nan bread, Indian chapatti Bread, Ready Made Asian Sweets and Deserts, Ginger puree, garlic puree, all ready cooked meals in class 30; achar pachranga, Curry sauces, Cooking sauces, Food dressings sauces, Pepper sauces, Fruit sauces, Sauces, Sauces for food, Spicy sauces, Tomato based sauces, Vegetable purees, Vinegar, sauces, Soya sauces, Mayonnaise, Mayonnaise with pickles, Mayonnaise with flavours, cooking pastes, Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour, cereals and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; sauces and preparations for making sauces; ice; prepared meals and snacks included in class 30; pasta; (asian deserts kheer mix, rasmali mix, gulub jamun mix, gajar halwa mix, kulfa mix),

mixes for making desserts and sweets; vermicelli; masala, qorma masala, biryani masala, nehari masala, tandoori masala; red chilli powder and coriander powder; curry powder, chaat masala, papad and barian; chutneys; food pastes and flavourings for food; ginger paste, prepared desserts included in class 30; ice cream; sorbets; ice cream confectionery and confections; ice cream desserts; ice cream gateaux; mixtures for making ice cream and ice cream confections; custard; custard mixes; mixes for making desserts, frozen yoghurts; fruit sauces. chapatti, Frozen Paratha and other use stated in class 30; rice puddings; sorbets; chutneys; dried herbs; Cooking spices.

Class 32: Mineral waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; beverages consisting of a blend of fruit and vegetable juices; beverages consisting of vegetable juices; beverages containing milk; extracts for making beverages; sherbet beverages; Vegetable juices.

3) The application is opposed by Mitchell's Fruit Farms Limited who are based in Pakistan. I shall refer to them as Mitchell's Pakistan.

4) The opposition is based on sections 3(6), 56(1) and 60<sup>1</sup> of the Act. The claims are:

- Under section 3(6), Mitchell's Pakistan appointed a company called MAK Enterprises UK Ltd ("MAK") as a UK distributor for them from 2004 and 2017 and during this time MAK had incorporated the applicant and registered the trade mark "Mitchell's" in bad faith. Mitchell's Pakistan claims that the applicant's conduct is unethical, unfair and unlawful.
- Under section 60, Mitchell's Pakistan claims that it is the rightful proprietor of the mark "Mitchell's" in a Convention Country and it is therefore entitled to protection under this section. Further, Mitchell's Pakistan "has reason to believe that MAK has acted in the same manner with at least one other company by

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<sup>1</sup> Section 60 has since been repealed under the Trade Marks Regulations 2018 (SI 2018/825) reg.28 effective from 14 January 2019. However, since these proceedings commenced prior to 14 January 2019 the Regulation does not apply.

registering well-known trade mark as its own and using forged agreement to claim its rights to do so. As MAK has acted as an agent/distributor/representative for Mitchell's Pakistan products, it had complete and proper knowledge of Mitchell's Pakistan's earlier trade mark right and it still went ahead to fraudulently register an identical trade mark in the UK under the new company Mitchell's Fruit Farms. (UK), clearly manifesting its mala fide intent."

- Under sections 5(1) and 5(2)(a) Mitchell's Pakistan claims that the application, the subject of the opposition, is identical to an earlier mark in the name of Mitchell's Pakistan in respect of identical or similar goods. Mitchell's Pakistan relies upon an earlier Pakistan registered trade mark no. 2914 for the mark MITCHELL'S that it claims qualifies as a well-known mark under section 56 of the Act and, consequently qualifies as a well-known mark under section 6 of the Act.

5) The applicant filed a counterstatement denying the claims made. It states that Mitchell's Pakistan has all along been aware of the applicant and "our registered trademark/s since their registration". It confirms that MAK is another legal entity of the applicant which has been successfully trading for 14 years in the UK and had a contract with Mitchell's Pakistan for food production/import of various goods. It then states that:

"This is the business model of MAK Enterprises Limited that we do not enter into business relations with any foreign company until we have the right to trademark within our territory of business operations. This is due to the reason that mostly Southern Asian companies want to breakthrough EU market and once established they want to take all the benefit and cut out companies whom work had for establishing brands." In other words, they wish to safeguard their position."

6) It goes on to state that in March/April 2017 MAK received shipments from Mitchell's Pakistan which were of poor quality insofar as they were not vacuum packed correctly and the cap seals were broken resulting in goods starting to lose their colour and

becoming distorted. The applicant states that the issues were reported to Mitchells Pakistan and this is when the relationship broke down.

7) Both sides filed evidence in these proceedings. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following careful consideration of the papers.

## **EVIDENCE**

### **Mitchell's Pakistan evidence**

#### *Witness statement of Mehdi Mohsin*

8) Mr Mohsin is the director of Mitchell's Pakistan. He states that Mitchell's Pakistan company was first registered in Pakistan in 1933<sup>2</sup> as Indian Mildura Fruit Farms Limited, but then changed its name in 1948. He states that Mitchell's Pakistan has been exporting its products to the UK since the 1960s, which he claims have been marketed "extensively"<sup>3</sup>.

9) Mitchell's Pakistan first registered its trade mark "Mitchell's" in Pakistan in 1943 and "continues to be proprietor of the trade mark after successive extensions in Pakistan"<sup>4</sup>. Exhibit MM1 consists of trade mark registration certificates for various "Mitchell's" registrations. They are all presented in the same format as shown at Annex A of this decision, though I set out the relevant details for each registration below:

Number: 2914

Mark: MITCHELL'S

Owner: Mitchell's Pakistan

Filing date: 8 June 1943

Registration date: 28 April 1951

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<sup>2</sup> The company details are confirmed in Exhibit MM4 which consists of a company incorporation certificate.

<sup>3</sup> Paragraph 11 of the witness statement

<sup>4</sup> Paragraph 1 of the witness statement

Goods: Class 29 Preserves fruits and jams

Status: Registered, expires 30 June 2021

Numbers: 74424 & 74425

Mark: MITCHELL'S

Owner: Mitchell's Pakistan

Filing date: 9 June 1981

Registration date: 15 March 1983

Goods: Class 32 Fruit drink products including squashes

Status: Registered – due for renewal on 9 June 2018

Number: 148850

Mark: MITCHELL'S

Owner: Mitchell's Pakistan

Filing date: 4 July 1998

Registration date: 17 April 2004

Goods: Class 30 Sweets and confectionery

Status: Registered, renewal due on 9 July 2015

10) Mr Mohsin claims that Mitchell's Pakistan has been distributing and selling its products under the registered trade mark "Mitchell's" not only in Pakistan but also in other countries such as the UK, USA, Europe, Canada, Australia, Middle East and Africa.

11) Mr Mohsin confirms that Mitchell's Pakistan appointed MAK as a distributor in 2004 and a distribution agreement was signed between the parties. Mr Mohammed Asif Choudhry was the sole shareholder of MAK. A copy of Mitchell Pakistan's version of the agreement has been filed under exhibit MM2 and the key points are summarised as follows:

- It is dated 30 April 2004.
- The "Distribution Agreement" is between Mitchell's Pakistan and MAK.
- It is agreed that Mitchell's Pakistan exports its products to M-A-K Enterprises with an estimated value of \$100,000.

- It is signed by Mr Amir Sattar of Mitchell's Pakistan and Mr Mohammad Ash Chaudhry of MAK.
- It covers one page and has 15 separate points.
- Point 15 states that the agreement will remain in force for 10 years from the date of signing, i.e. from 30 April 2004.
- There is no reference to trade marks or IP.

12) Exhibit MM3 consists of a witness statement from Mr Sattar. He confirms that he was employed by Mitchell's Pakistan from 6 March 1993 to 11 September 2005. He also confirms that he "negotiated and signed a distribution agreement with MAK Enterprises on behalf of Mitchell's Fruit Farms Limited"<sup>5</sup> but the parties never discussed or agreed the transfer of any rights in the trade marks of Mitchell's Pakistan to either MAK or any other entity. Mr Mohsin also states that no one at Mitchell's Pakistan approved or signed any such transfer of trade mark rights to MAK. Referring to exhibit MM2, Mr Sattar states that:

"This is the only agreement I signed on behalf of Mitchell's for distribution of Mitchell's products in the UK with MAK Enterprises. There was never any agreement or arrangement with MAK Enterprises to assign or in any way transfer any of Mitchell's trademarks or any rights thereto to MAK Enterprises or to any other entity."<sup>6</sup>

13) Mr Mohsin then states that on 28 June 2011 Mr Mohammed Asif Chaudhry incorporated a new company called Mitchell's Fruit Farms Limited in the UK and is its director and shareholder. Mr Mohsin describes this as a "blatant plagiarism and passing off using our company name which has been used by us since 1948"<sup>7</sup>. He then goes on to state that on 25 April 2018 Mr Chaudhry changed the company name to Mitchell's Europe Limited. Exhibit MM5 consists of a copy of the "Certificate of Incorporation on change of name" which states that on 25 April 2018 company number 7684968 changed its name from Mitchell's Fruit Farms Ltd to Mitchell's Europe

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<sup>5</sup> Paragraph 2 of the witness statement

<sup>6</sup> Ditto

<sup>7</sup> Paragraph 6 of the witness statement

Limited. Mr Mohsin states that “Since these revelations”<sup>8</sup> (no specific date was provided) Mitchell’s Pakistan stopped communication and business dealings with MAK, which included recalling the last consignment that was sent to the UK in April 2017.

14) Mr Mohsin states that the “cumulative sales amount for different Mitchell’s products in the UK since 2004 is PKR 226 million which is equivalent to GDP 1.45 million<sup>9</sup>”. He points that the figures are provided in PKR since Mitchell’s Pakistan is a Pakistan based company and has its accounts prepared in PKR.

15) With regard to advertising, Mr Mohsin states that at Mitchell’s Pakistan expense it provided MAK with advertising materials. Exhibit MM9 to the witness statement consists of invoices addressed to Mitchell’s Pakistan from ARY Digital. They relate to “Transmission Certificates” which cover the periods 16 May 2015 to 31 May 2015 and 1 October 2014 to 30 October 2014. They refer to Mitchell’s as the client and the products being “Sarson Ka Saag” and “Chilli Garlic Sauce”. They list around 300 individual advertisements which last around 25 to 35 seconds each. It is noted that each refer to the channel “ARY Digital USA” and the “Commercial Codes” also end with USA. Therefore, it appears that all of the advertisements appear to have been broadcast in the US.

16) The exhibit also includes various undated advertisements for various food and drink products such as ready to eat curry meals, real fruit squash, jam, chilli sauce and pickles. One of the advertisements is duplicated below and I note that it refers to Mitchells as “Celebrating 75 years of farm freshness” with the dates 1933-2008. It is therefore reasonable to date the advertisement in or shortly after 2008.

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<sup>8</sup> Paragraph 7 of the witness statement

<sup>9</sup> Paragraph 16 of the witness statement





17) Mr Mohsin states that Mitchell’s Pakistan works hard to provide customers with quality products. To demonstrate this, exhibit MM10 consists of ISO 9001:2008 certificates for Mitchell’s Pakistan. It states that “The scope of activities covered by this certificate is defined” as “Design, Manufacture of Sugar Confectionery, Chocolate Products and Processors of Fruit and Vegetables” with the date of issue as 17 November 2016. It also includes the original date of issue as being 1998. The exhibit also includes five certificates from Pakistan Standards and Quality Control Authority for Mitchell’s Pakistan for the period 1 January 2017 to 31 December 2018. They include references to various Mitchell’s brands, i.e. jams, marmalades, squash, jellies, vinegar and pickle in oil. Further Certificates of quality assurance are provided from the US authorities.

**Applicant’s evidence**

*1<sup>st</sup> Witness statement of Mohammed Asif Chaudhry plus exhibits AC1 – AC5*

18) Mr Chaudhry is a director and employee of the applicant. He states that the applicant is an associated company of MAK and that he is a director and owner of both companies. He states that the company MAK (company registration number 4741810) was registered on 23 April 2003, while the applicant company was registered in June

2011. In respect of the applicant's relationship with Mitchell's Pakistan, Mr Chaudhry states that:

"From my experience of dealing with Pakistani manufacturers of food products which had never previously been exported to the UK or European markets, I had found that it is expensive to introduce such previously-unavailable products to the UK or European markets. To ensure long-term business viability I concluded that the only satisfactory way to proceed was to agree with the manufacturer that MAK Enterprises Ltd should own the trade mark rights in the UK and Europe, so that the manufacturer was manufacturing in Pakistan on behalf of MAK Enterprises Ltd. I had previously agreed such terms with the Pakistani company Qarshi Industries (Pvt) Ltd, and I therefore negotiated equivalent terms with Mitchell's Pakistan in 2003."

19) He goes on to state that since Mitchell's Pakistan had not previously sold products into the UK, MAK would carry out sales of these products to the UK and European markets and agreed such an agreement with Mitchell's Pakistan in April 2004. He provides a copy of the applicant's version of the agreement at exhibit AC1. The key points can be summarised as follows:

- It is dated 30 April 2004.
- The "Distribution Agreement" is between Mitchell's Fruit Farms Limited, Pakistan and M-A-K Enterprises Limited.
- It is agreed that Mitchell's Pakistan exports its products to M-A-K Enterprises with an estimated value of \$100,000.
- It is signed by Mr Amir Sattar of Mitchell's Pakistan and Mr Mohammad Ash Chaudhry of M-A-K Enterprises Limited.
- It covers two pages and has 20 separate points.
- Point 18 states that the agreement will remain in force for 15 years from the date of signing, i.e. it would expire on 30 April 2019.
- In respect of the trade marks and IP, the Agreement states at paragraph 16 that:

"M-A-K or its associated companies will arrange to register Mitchell's trademark and CTM at their own expense and discretion. In the case of

trademark and CTM being registered successfully by M-A-K or its associated companies at their own expense, M-A-K or its associated companies will have the ownership of registered trademark/s and CTM/s within above mentioned territories.”

20) Mr Chaudhry states that following changes of management within Mitchell’s Pakistan, the “new staff” have on two separate occasions asked him to provide them with a copy of the Agreement. This occurred on 12 November 2012 when Haroon Asif (the current export manager) requested a copy and then the same email was sent to Athar Butt (“the current country head”<sup>10</sup>) on 25 April 2017. Mr Chaudhry states that he has filed copies of the email exchanges between him and the aforementioned people under exhibit AC1. I duplicate the entire email exchange below:

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<sup>10</sup> Paragraph 5 of the witness statement.

**Adnan Khan**

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**From:** Asif Chaudhry <[REDACTED]@yahoo.com>  
**Sent:** 25 April 2017 16:24  
**To:** Athar Butt; Zafar Khan  
**Subject:** Fw: Audit Requirement  
**Attachments:** MAK MIT AGREEMENT SCAN 15.11.20120001.jpg; MAK MIT AGREEMENT SCAN 15.11.20120002.jpg

For and on behalf of  
M-A-K Enterprises Limited  
London, United Kingdom  
Tel: + 44 (0) 20- 8577- 4348  
Fax: + 44 (0) 20- 8577- 4348  
Mob: + 44 (0) 7931-309 499

On Thursday, November 15, 2012 12:06 PM, Asif Chaudhry <[REDACTED]@yahoo.com> wrote:

Dear Haroon Bhai,  
Please find attached as requested.  
Best Regards  
Asif Chaudhry

For and on behalf of  
M-A-K Enterprises Limited  
4 Central Fire Station  
520 London Road  
Isleworth, Middlesex  
TW7 4HP  
London, United Kingdom  
Tel: + 44 (0) 20- 8577- 4348  
Fax: + 44 (0) 20- 8577- 4348  
Mob: [REDACTED]

--- On Mon, 11/12/12, Haroon <[REDACTED]@mitchells.com.pk> wrote:

From: Haroon <[REDACTED]@mitchells.com.pk>  
Subject: RE: Audit Requirement  
To: "Asif Chaudhry" <[REDACTED]@yahoo.com>  
Cc: "ANZAR MITCHELS" <[REDACTED]@mitchells.com.pk>, [REDACTED]@mitchells.com.pk  
Date: Monday, November 12, 2012, 10:24 AM

Dear Asif bahi,

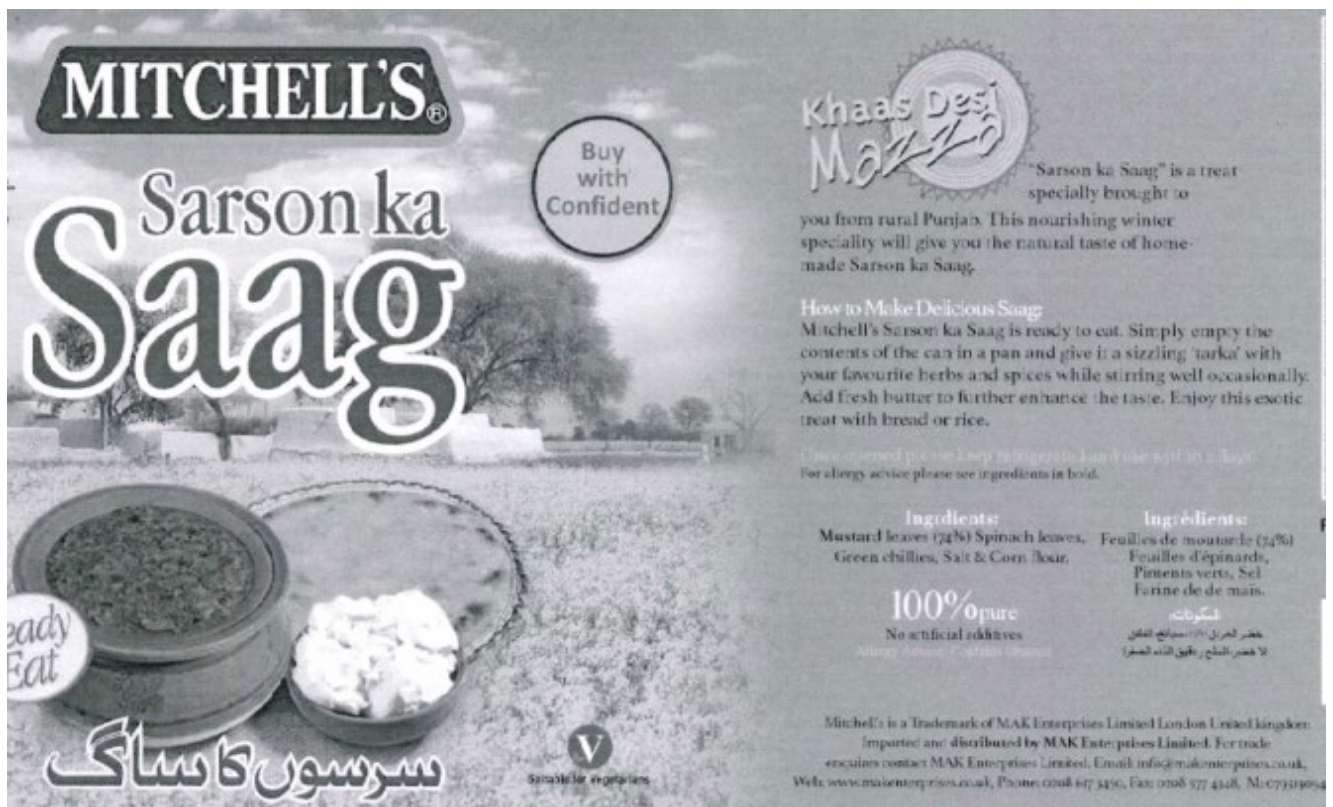
Thanks for your email, please try to send us by November 15<sup>th</sup>, 2012.

Best Regards,

Haroon Asif  
Export Manager

21) In respect of turnover, Mr Chaudhry agrees with Mr Mohsin's statement that sales of Mitchell's products in the UK since 2004 are in the region of £1.5m.

22) Mr Chaudhry states that between 2004 and 2011 Mitchell's Pakistan printed labels to a design provided by MAK and then applied them to the products that they were manufacturing for MAK. Exhibit AC2 consists of eight product labels for goods such as mixed fruit jam, saag, etc. Mr Chaudhry points out that the labels include the following statements "Mitchell's is a Trademark of MAK Enterprises Ltd London United Kingdom" and "Imported BY: MAK Enterprises Ltd".<sup>11</sup> I duplicate one of the labels below:



23) Exhibit AC3 consists of an email exchange between Mr Chaudhry and Haroon Asif, the "Export Manager" for Mitchell's Pakistan. The emails are dated 8 May 2013 from Mr Asif states "Boss please approve the attached label of saag 880gm", to which Mr Chaudhry replies to make various amendments thereto. Within the exhibit is a copy

<sup>11</sup> Paragraph 7 of the witness statement

of the product label that Mr Asif is referring to, which includes the trade mark statement as set out above.

24) Mr Chaudhry then details goods which were delivered in March and April 2017 which he describes as being “in an unacceptable state, and that therefore could not be sold”<sup>12</sup>. Exhibit AC4 to the witness statement consists of four undated photographs of boxes marked “Mitchell’s” which appear to be damaged. Mr Chaudhry then contacted Mitchell’s Pakistan by email and telephone to report the damaged goods. On 11 April 2017, Mr Zafar Khan (the Quality Assurance Manager) replied “suggesting that Mitchell’s Pakistan may need to increase the vacuum when capping the bottles to ensure that the pop-up is resolved”<sup>13</sup>. It is then claimed that Mr Khan admitted over the phone that the factory had made an error and the Mitchell’s Pakistan would compensate MAK Enterprises Ltd. Mr Chaudhry estimated the loss to be in the region of £50,000. However, Mitchell’s Pakistan then refused to communicate with MAK, despite its repeated attempts to speak to Mitchell’s Pakistan to resolve the matter. Exhibit AC5 to the witness statement includes a number of emails between MAK and Mitchell’s Pakistan. They include:

- 11 May 2017 from “MAK Enterprises” to various email addresses at “Mitchell’s Pakistan”. The email details the issues with the bottles in that “90% of caps are popped” and they have subsequently discoloured.
- 25 May 2017 from Mr Chaudhry to various email addresses at Mitchell’s Pakistan. The email states that Mr Chaudhry has “been trying to get in touch with yourselves for last 3 days” and that “I have also shown to Mr Zafar live stream as container was unloading, it was witnessed by Mr Zafar that boxes were coming out of container with caps popped on large glass sauce bottles. I have uploaded images and videos on <https://wetransfer.com/> for your reference again.” And “I would like a feedback related to this damaged stock and also I would like to know if this is ok to sell on to retailers?”
- 29 May 2017 from Mr Chaudhry to Mitchell’s Pakistan seeking a response to his emails.

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<sup>12</sup> Paragraph 9 of the witness statement

<sup>13</sup> Paragraph 10 of the witness statement

*Mr Chaudhry's 2<sup>nd</sup> Witness statement plus exhibits AC2-1 – AC2-2*

25) Exhibit AC2-1 is a copy of an email dated 4 July 2011 to Mohsin Hauri of Mitchell's Pakistan from Mr Chaudhry. The email states that Mr Chaudhry has already applied for the company name Mitchell's Fruit Farms Ltd and that "As per our contract I will apply trademark Mitchell's under this company ownership. If the trademark is registered successfully then I will amend all of my current labels and send them to you for printing with details of registered trademark. This will safeguard my business now and in the future and deter any of my competitor taking any advantage by using similar trademark within my business territory."

26) Exhibit AC2-2 to the witness statement from Mr Chaudhry is an email to Haroon Asif, copying in a generic "exports" email address for Mitchells Pakistan. It is dated 10 May 2013 and states:

"Please note that I have uploaded new label designs of our products. You must have got an email link from wetransfer.com to download these files. As discussed over the phone, these new designs include details of my UK registered Mitchell's trademark (UK00002619226) and my company details which is the owner of the trade mark Mitchell's Fruit Farms Limited. These are legal details hence have been applied to our labels. I know you have already applied required details to Saag, Peas and Sweet Corn labels which I have approved for printing. Please make sure that all of our products you will produce from hereon must have these designed labels. Included are PSD and AI files which are editable by your printer for margin settings."

27) The rest of the witness statement consists of submissions which I confirm that I have read and shall bear in mind when making my decision.

**Mitchell's Pakistan evidence in reply**

*Witness statement of Syed Muhammad Mohsin*

28) Mr Mohsin's second witness statement reiterates that Mitchell's Pakistan has never transferred any of its trade marks or IP rights to any of its distributors. He states that MAK and Mitchell's Pakistan had always only consented to a distribution agreement for the export and sales of Mitchell's Pakistan's various products in the UK and had never discussed any transfer of trade marks or IP rights. He states, in fact, that it is "incomprehensible" that either the Mitchell trade mark or any IP rights would be transferred.

29) Mr Mohsin also details a relationship his company had with L. Rose & Company in the 1960s and 1970s. This company was subsequently taken over by Schweppes and then merged with Cadbury. The relationship between Mitchell's Pakistan and these entities ended around 1986. It appears that the purpose of detailing this history is to demonstrate the historical relationship the Mitchell's Pakistan had with UK companies, albeit over 30 years ago.

*1<sup>st</sup> Witness statement of Zafar Khan plus exhibits ZK1 – ZK5*

30) Mr Zafir Khan is the Export Manager of Mitchell's Pakistan. He states that 84% of the PKR1.9billion<sup>14</sup> sales are in Pakistan and the rest are through sales in countries such as the UK, USA, Europe, Canada, Australia, Middle East and Africa. Exhibit ZK1 consists of Mitchell's Annual report for 2017 which he claims to be verification of the sales.

31) He states that Mitchell's Pakistan has been exporting its products to the UK since the 1960s which have been marketed in the UK under its registered trade mark "Mitchell's" much before Mitchell's Pakistan ever started using the applicant or its associated company as its distributor in the UK. Details of the aforementioned trade mark have not been provided.

32) Mr Khan explains that Mitchell's Pakistan never labelled any of its products with the markings "Mitchell's is a Trademark of MAK Enterprises Ltd London United

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<sup>14</sup> Mr Khan does not state how much this is in pounds sterling.



Kingdom”. Instead it only marks them “Imported by MAK Enterprises” since this is a legal requirement for all imported goods.

33) Mr Khan then states that:

“[Mitchell’s Pakistan] never labelled any of its products with the markings, ‘Mitchell’s is a Trademark of MAK Enterprises Ltd London United Kingdom’. Mitchell’s Pakistan has only labelled its products with the markings, ‘Imported by MAK Enterprises’ providing the importers details for trade enquiries, as providing the local importers details is a legal requirement for all imported products. [Mitchell’s Pakistan] did state in its labels that the Mitchell’s trademark belongs to Mitchell’s Fruit Farms Limited which is the registered company name of Mitchell’s Pakistan since 1948.”

34) Exhibit ZK3 consists of sample labels which are undated and make no reference to the trade mark Mitchell’s being in the name of MAK. I duplicate an example below:



35) In response to the claim that the goods supplied by Mitchell’s Pakistan were deficient, Mr Khan states that they have never provided any ‘damaged’ products to the applicant. It states that on 11 May 2017 the applicant raised issues regarding the quality but following an “internal enquiry”<sup>15</sup> Mitchell’s Pakistan concluded that “there

<sup>15</sup> Paragraph 5 of the witness statement

will be no issue in selling the product...”<sup>16</sup>. It was admitted that there were issues relating to the vacuum pressure but the product was still within “acceptable industry standard parameters”<sup>17</sup>. Moreover, Mr Khan refutes Mr Chaudhry’s claim that the alleged loss was £50,000 since the value of the entire shipment was less than £39,000.

36) Mr Khan states that the damaged goods were not the basis of the relationship breaking down. Instead the breakdown occurred in April 2017 when it came to Mitchell Pakistan’s attention that Mr Chaudhry had incorporated a new UK company on 28 June 2011, in the name of Mitchell’s Fruit Farms. In light of this, Mitchell’s Pakistan immediately stopped communication with MAK at all levels and suspended business activities which included recalling the last consignment that was sent to the UK in April 2017.

*2<sup>nd</sup> Witness statement of Zafar Khan plus exhibit ZK1 (filed as additional evidence)*

37) In Mr Khan’s second witness statement, he reiterates Mitchell Pakistan’s stance that it would never transfer any of its trade marks or any other IP rights.

38) Mr Khan states that the only agreement Mitchell’s Pakistan had signed and entered into was the one submitted by Mr Mohsin under exhibit MM2. He goes on to state that the agreement presented by Mr Asif Chaudhry is forged (as also claimed by Mr Sattar<sup>18</sup>). To support this serious allegation Mr Khan filed an expert forensic handwriting report (“the Report”)<sup>19</sup> which was prepared for separate invalidation proceedings but Mr Khan seeks to rely upon its findings for these proceedings. The Report is dated 5 March 2018 and carried out by The Radley Forensic Document Laboratory. It compares the agreement along with a similar agreement presented by Mr Chaudhry in separate proceedings. Mr Khan does not summarise the Report, its findings or refer to any of the 67-page document. I shall not review the Report here but I shall refer to its findings later in this decision.

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<sup>16</sup> Ditto

<sup>17</sup> Ditto

<sup>18</sup> Exhibit MM3 to Mr Mohsin’s witness statement

<sup>19</sup> Exhibit ZK1 to Mr Khan’s second witness statement

## DECISION – SECTION 60

39) It is convenient to begin with the section 60 of the Act claim. The relevant parts state:

**60.** - (1) The following provisions apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Convention country.

(2) If the proprietor opposes the application, registration shall be refused.

(3)...

(4)...

(5)... Subsections (2), (3) and (4) do not apply if, or to the extent that, the agent or representative justifies his action.”

40) In view of the above, there are two prerequisites for this ground to be successful. However, if the agent or representative can justify its actions then they do not apply<sup>20</sup>:

- (i) That Mitchell’s Pakistan is the holder of a mark in a Convention Country<sup>21</sup>, and;
- (ii) The applicant was an agent of Mitchell’s Pakistan at the time its application was filed to register its mark in May 2017.

*Was Mitchell Pakistan the holder of a mark in a Convention Country?*

41) Pakistan is a Convention Country and it has rightfully not been argued otherwise. Mitchell Pakistan’s evidence<sup>22</sup> includes numerous trade mark registration certificates issued by the Pakistani Registry. They provide details of the trade mark registrations for Mitchell’s in the name of Mitchell’s Pakistan covering, at least, class 29 “preserves fruits and jams”. I say “at least” since the status of the Pakistan trade mark registration number 148850 for class 30 sweets and confectionery was due for renewal on 9 July

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<sup>20</sup> Section 60(5) of the Act, as set out in paragraph 39.

<sup>21</sup> The Convention is the Paris Convention for the Protection of Industrial Property of March 20<sup>th</sup> 1883, as revised or amended from time to time.

<sup>22</sup> Exhibit MM1 to the witness statement of Mr Mohsin

2015 and confirmation that renewal took place has not been filed. However, for the immediate purposes registration for “preserves, fruits and jams” is sufficient (as covered by Pakistan trade mark registration number 2914).

42) In view of the above, I find that Mitchell’s Pakistan is the holder of the mark Mitchell’s in Pakistan, which is a Convention Country.

*Was the applicant an agent of Mitchell’s Pakistan? If so, were they still an agent at the time the application was filed in May 2017?*

43) In *Mouldpro ApS v EUIPO*, Case T-796/17, the General Court summarised the case law about when a party may be regarded as ‘agent’ or ‘representative’ of an opponent or application for invalidation. The court stated that:

“21. It is apparent from the wording of Article 60(1)(b) of Regulation 2017/1001 that, for an opposition to succeed on that basis, it is necessary, first, for the opposing party to be the proprietor of the earlier mark; second, for the applicant for the mark to be or to have been the agent or representative of the proprietor of the mark; third, for the application to have been filed in the name of the agent or representative without the proprietor’s consent and without there being legitimate reasons to justify the agent’s or representative’s action; and, fourth, for the application to relate in essence to identical or similar signs and goods. Those conditions are cumulative (judgment of 13 April 2011, *Safariland v OHIM — DEF-TEC Defense Technology (FIRST DEFENSE AEROSOL PEPPER PROJECTOR)*, T-262/09, EU:T:2011:171, paragraph 61).

22. As regards the terms ‘agent’ and ‘representative’ as used in Article 8(3) of Regulation 2017/1001, the Court has ruled that those terms must be interpreted broadly, so as to cover all kinds of relationships based on a contractual arrangement under which one party is representing the interests of the other, regardless of how the contractual relationship between the proprietor or principal, on the one hand, and the applicant for the EU trade mark, on the other, is categorised (judgments of 13 April 2011, *FIRST DEFENSE AEROSOL PEPPER PROJECTOR*, T-262/09, EU:T:2011:171, paragraph 64, and of 9 July

2014, *Moonich Produktkonzepte & Realisierung v OHIM — Thermofilm Australia (HEATSTRIP)*, T-184/12, not published, EU:T:2014:621, paragraph 58).

23. It is sufficient for the purposes of Article 8(3) of Regulation 2017/1001 that there be some agreement of commercial cooperation between the parties of a kind that gives rise to a fiduciary relationship by imposing on the trade mark applicant — whether expressly or implicitly — a general duty of trust and loyalty as regards the interests of the trade mark proprietor (judgments of 13 April 2011, *FIRST DEFENSE AEROSOL PEPPER PROJECTOR*, T-262/09, EU:T:2011:171, paragraph 64, and of 9 July 2014, *HEATSTRIP*, T-184/12, not published, EU:T:2014:621, paragraph 59). Nevertheless, some kind of agreement must exist between the parties. If the applicant acts completely independently, without having entered into any kind of relationship with the proprietor, he cannot be treated as an agent for the purposes of Article 8(3) of Regulation 2017/1001. Thus, a mere purchaser or client of the proprietor cannot be regarded as an ‘agent’ or as a ‘representative’ for the purposes of that provision, since such persons are under no special obligation of trust to the trade mark proprietor (judgment of 13 April 2011, *FIRST DEFENSE AEROSOL PEPPER PROJECTOR*, T-262/09, EU:T:2011:171, paragraph 64).”

44) It is not in dispute that the applicant was acting as an agent. This is supported by the fact that both parties agree that the cumulative sales for the various Mitchell’s products in the UK is in the region of £1.45m. Further, despite there being a dispute over which of the agreements is legitimate (I shall address this later in this decision), neither party claims that an agreement does not exist at all. Of course, the agreement is between the Mitchell’s Pakistan and MAK, however Mr Chaudhry himself admits that MAK is an associated company to the applicant. Accordingly, I find that the applicant was an agent of Mitchell’s Pakistan.

45) Whilst *Mouldpro* makes it clear that it is only necessary for the applicant have been an agent for the proprietor of the mark, I also consider it necessary to consider whether as a finding of fact whether that MAK was an agent of Mitchell’s Pakistan when the application was filed on 29 May 2017?

46) It is common ground that the relationship broke down around March/April 2017. From Mitchell Pakistan's perspective the breakdown arose since they discovered that the applicant had incorporated a UK company on 28 June 2011 in the name of Mitchell's Fruit Farms and it subsequently stopped communicating with the applicant, recalling the last consignment which was sent to the UK in April 2017.

47) The applicant's take on the relationship breakdown is that in March/April 2017 it received poor quality goods. Mr Chaudhry, on behalf of the applicant, had contacted Mitchell's Pakistan to report the alleged damaged goods. On 11 April 2017 Mr Khan (for Mitchell's Pakistan) suggested increasing the vacuum capping and a subsequent telephone call between Mr Chaudhry and Mr Khan allegedly resulted in Mitchell Pakistan's offering to compensate MAK (Mitchell's Pakistan subsequently deny this to be the case). The discussions continued right up until the application filing date when Mr Chaudhry sent a further email seeking a response to the delivery of the alleged damaged goods. This clearly evidences that he still considered himself to still be an agent/distributor of the Mitchell's Pakistan since on this date. Of course, at this stage, it may be that Mitchell's Pakistan did not consider MAK to be a distributor but this was not expressly acknowledged by either party.

48) In view of the above, I also find that the applicant was an agent/distributor at the time that the application was filed.

*Was there a legitimate reason for the applicant to file the application which would justify its actions?*

49) The applicant essentially relies upon two reasons why it was justified in filing the trade mark application. Firstly, that the "Agreement" between the parties expressly permits it to do so and, secondly, that Mitchell's Pakistan knew that it had already applied for similar trade marks. I shall deal with these in turn. Further, it states that it notified the applicant that it had filed other "Mitchell's" trade mark applications in the UK and had notified Mitchell's Pakistan about this.

## *The Agreement*

50) On 28 August 2018 Mitchell's Pakistan sought permission to submit expert evidence on the basis that it believed the applicant's version of the Agreement dated 30 April 2004<sup>23</sup> to be a forgery and a forensic handwriting report would verify this. Comments were sought from the applicant who objected to the request on the basis that there was no reason to incur the costs of such expert evidence and that the evidence submitted by the applicant sufficiently demonstrated that the version it filed was correct. Mitchell's Pakistan subsequently stated that it would bear the cost of the evidence and provided the name of the company that it was proposing to use. A preliminary view allowing the evidence to be submitted was issued. The applicant did not challenge the preliminary view and so the evidence was filed as an exhibit to the witness statement of Mr Khan (I shall address the consequence of this later in this decision).

51) The Report (hereafter the "Report") is dated 5 March 2018 and is headed "Qarshi Industries (PVT) Limited (TM Invalidation) and Mitchell's Fruit Farms Limited (TM Invalidation)". It is provided by a Forensic Document Examiner from The Radley Forensic Document Laboratory based in the UK. The report lists the following documents which have been questioned:

- a) A copy of Mitchell's Fruit Farm Limited Legally Binding Trade Agreement with MAK Enterprises Limited dated 30 April 2004 ("the Questioned Mitchell's Agreement");
- b) A copy of Qarshi Industries (Pvt) Ltd Legally Binding Trade Agreement signed by Mr Chaudhry with MAK Enterprises Limited said to be dated 2003 ("the Questioned Qarshi Agreement");

52) The Report also lists the following documents which have been proposed as being authentic:

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<sup>23</sup> Exhibit AC1 to the witness statement of Mr Chaudhry

- a) A copy of Mitchell's Fruit Farms Distribution Agreement with MAK dated 30 April 2004 ("the Proposed Authentic Mitchell's Agreement") signed by Mr Chaudhry;
- b) A copy of Qarshi Industries (Pvt) Ltd. Distributorship Agreement with MAK dated 10 June 2003 which is also signed by Mr Chaudhry ("the Proposed Authentic Qarshi Agreement").

53) In essence, the expert was asked to consider the authenticity of the Questioned Qarshi and Mitchell<sup>24</sup> Agreements, as evidenced under exhibit AC1 to Mr Chaudhry's witness statement. This was on the basis "that all contracts/agreements pertaining to business are drafted and prepared by Mitchell's and Qarshi respectively"<sup>25</sup>.

54) Prior to dealing with the various arguments raised by the respective parties regarding the Report's findings, I shall firstly deal with the evidential weight I must give the Report. Mitchell's Pakistan argues that "In order to discredit an expert's report, that report must be subject to countervailing evidence by an expert and/or the expert's evidence being challenged in cross-examination thereby giving the expert the opportunity of justifying their conclusions. An expert's report cannot be impeached by arguments and submissions alone."

55) It is true that if the applicant wishes to impugn the Report then it should have requested a hearing so that the expert could be called as a witness and cross-examined. However, in this instance the Report challenging the legitimacy of the Agreement was filed as an exhibit to a witness statement from a party who did not create the report. In other words, the witness, Mr Khan, did not produce the Report and therefore there would be no merit in calling him as a witness and cross-examining him on the Report. Moreover, since the Report was filed in this manner it is hearsay evidence.

56) The relevant part of the Tribunal Work Manual relating to hearsay states:

#### **"4.8.10 Hearsay**

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<sup>24</sup> Exhibit AC1 to Mr Chaudhry's witness statement

<sup>25</sup> Paragraph 4 of the Report



Hearsay evidence is oral or written statements made by someone who is not a witness in the case but which the Court or Tribunal is asked to accept as evidence for the truth of what is stated.

If a witness statement, affidavit or statutory declaration contains hearsay evidence, it should be filed in sufficient time and it should contain sufficient particulars to enable the other party or parties to deal with the matters arising out of its containing such evidence. If the provision of further particulars of or relating to the evidence is reasonable and practicable in the circumstances for that purpose, they should be given on request.

It is also to be borne in mind that in estimating the weight (if any) to be given to hearsay evidence in proceedings before the Tribunal, the Tribunal and those acting on its behalf shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence. In estimating the weight, if any, to be given to hearsay evidence attention is drawn to the provisions of section 4 of the Civil Evidence Act 1995, which states:-

“4(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following -

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

(c) whether the evidence involves multiple hearsay;

(d) whether any person involved had any motive to conceal or misrepresent matters;

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.”

57) Whilst the Report was prepared for separate invalidation proceedings, since the Report’s author is UK based, I see no reason why they could not have filed it under cover of a witness statement (point a, above). The company which produced the Report is an independent third party, so there is nothing to suggest that they would have had any motive to conceal or misrepresent matters (point d, above). Further, I do not see any reason to suggest that it was an attempt by Mitchell’s Pakistan to prevent its proper evaluation (point f, above). In fact, I think it was in contrary since they believe that the Report is strongly in its favour and would like as much weight attributed to it as possible. The Report was unedited and not produced in collaboration with another. Whilst it was produced for different proceedings, it was specifically requested to address whether the Mitchell’s Agreement was a legitimate version (point e, above).

58) Taking all these factors into account, whilst the evidence is hearsay, I still consider that it should be attributed reasonable weight.

59) I now turn to what the Report’s conclusions. Both parties filed differing versions of the same Agreement. Both versions of the Agreement are, 1) dated 30 April 2004, 2) between Mitchell’s Pakistan and MAK, 2) appoint MAK as being the exclusive distributor for the UK and Ireland, and 4) estimate the annual value of exports to be

approximately \$100,000. Each Agreement includes additional details, but these are not relevant to these proceedings and I shall therefore not summarise them.

60) Where the respective versions of the Agreement differ are Mitchell Pakistan's version<sup>26</sup> contains 15 points and is one page long, whereas the applicant's version<sup>27</sup> has 20 points and is two pages long. The key differences between the Agreements are:

- 1) Mitchell Pakistan's version makes no reference to trade marks or IP, whereas the applicant's version states that MAK, or its associated companies, will "arrange to register MITCHELL'S trademark and CTM"<sup>28</sup>.
- 2) Mitchell Pakistan's version of the Agreement includes a 10-year expiry period i.e. expires 30 April 2014, whereas the applicant's version has a 15 year expiry, i.e. 30 April 2019.

61) The applicant argues that since its version of the Agreement expressly permits it to file the trade mark application, then it was legitimate for it to do so. It also argues that applying for the trade mark is its practice when dealing with any foreign company and that it had adopted this practice with another supplier.

62) The Report's summary of its findings in respect of the Agreements are as follows:

- The signature in the name of Mr Sattar on the Questioned Mitchell's version<sup>29</sup> is the identical signature as appears on the Proposed Authentic Agreement, as filed by Mitchell's Pakistan in its evidence of Mr Mohsin at exhibit MM2. It states that "Consequently, these two signatures cannot be the result of independent signing processes and at least one of them is a transposition i.e. moved from document to document". Therefore, Mr Sattar signed one or other of these Agreements but not both.

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<sup>26</sup> Annex B

<sup>27</sup> Annex C

<sup>28</sup> Point 16 of the Agreement.

<sup>29</sup> Exhibit AC1 to the witness statement of Mr Chaudhry

- Comparing Mr Chaudhry's signature on the Questioned Qarshi Agreement with his signature on the Questioned Mitchell's version, the Report states that it is the identical signature and "Consequently, these two signatures cannot be the result of independent signing processes and at least one of them is a transposition." Therefore, Mr Chaudhry signed one or other of these Agreements but not both.
  
- Paragraph 16(vi) states that: "There is a very notable similarity both in wording, layout and idiosyncratic typographical characteristics between the Questioned Qarshi Agreement and the Questioned Mitchell's Agreement. I am of the opinion that the possibility of the two questioned documents being separately drafted in such similar style, by entirely different companies, by chance coincidence, to be so remote that it may be realistically disregarded. Consequently, when considered together, both of the Questioned Agreements cannot be genuine documents". However, this assumes that Qarshi and MAK drafted the Agreements.
  
- The Report also states that there are similarities in wording, layout and idiosyncratic typographical characteristics between the Questioned Agreements and the Proposed Authentic Mitchells Agreements. Since the Questioned Qarshi is earlier, this finding suggests that the "Authentic Mitchell's" Agreement is based on the Questioned Agreement.
  
- Paragraph 65 states that: "Given the similarity of incorrect grammatical consistencies and typographical idiosyncrasies between the two Questioned Agreements and the Mitchell's Proposed Authentic Agreement, the evidence supports the proposition that, in all probability, a soft copy of one of these documents was used as a precursor for the others....On the copy documents before me, I cannot definitively state which of the documents was the precursor for the creation of the others."

63) To summarise, the Report effectively states that given the similarities between the Questioned Qarshi Agreement and the Questioned Mitchell's Agreement, the possibility of them being drafted by separate entities is highly unlikely and therefore

both cannot be genuine documents. However, as highlighted by the applicant, the Report was instructed on the basis that “all contracts/agreements pertaining to business are drafted and prepared by Mitchell’s and Qarshi respectively”. The applicant legitimately questions this assumption and states that both Agreements were reached as a result of MAK being a party to the negotiations and therefore they are bound to include similarities. I accept this criticism. Assessing the legitimacy of a document based on an assumption that it was drafted by one of the parties does not appear to me to be the correct and fair starting point. Moreover, since MAK were a party to the negotiations then it is likely to have included clauses, phrases, etc that it had previously used and was accustomed to.

64) As previously stated Mr Khan did not provide a summary of the Report’s findings. In Mitchell Pakistan’s submissions it states that the Report “is expert in nature and concludes on the balance of probabilities (i.e. Satisfying the civil standard of proof) that the agreement sought to be relied upon by the Applicant is a forgery.” To support this contention, the submissions refer to paragraphs 12(ii) and 33 of the Report. The final two sentences of paragraph 12(ii) state: “I am therefore of the opinion that there is limited evidence to support the proposition that the signature in Mr Murad’s name on the Questioned Qarshi Agreement has not been written by Mr Murad but is a simulation of his general signature style. This opinion is far from conclusive but over the balance of probabilities.”

65) Paragraph 33 of the Report states: “I note a number and variety of differences between the known and questioned signatures. These, in accumulation, lead me to the opinion that there is limited positive evidence to support the proposition that Mr Murad did not write the signature in his name on the Questioned Qarshi Agreement but that it is a simulation of his general signature style. This opinion is far from conclusive but over the balance of probabilities.”

66) I take these paragraphs to effectively say the same thing, i.e. that the signature of Mr Murad in the questioned Qarshi Agreement was unlikely to be his. Whilst this may or may not be the case, these findings relate to the Qarshi Agreement rather than the Mitchell’s Agreement and Mitchell’s Pakistan has not explained what effect this has on determining which is the legitimate Mitchell’s Agreement. Therefore, I can only

conclude that Mitchell's Pakistan was either mistaken in its interpretation of the Report that paragraphs 12(ii) and 33 were referring to the Mitchell's Agreement or that there is some connection and the reasoning is not evident to me.

67) Having considered the criticisms raised by the applicant, and in the absence of submissions or commentary from Mitchell's Pakistan, I find the Report to be inconclusive and of little assistance.

*Mitchell's Pakistan knew of the existing trade marks*

68) In the applicant's submissions, it reaffirms that the version filed by Mr Chaudhry (on behalf of the applicant) under exhibit AC1 is the genuine version. It argues that 1) the Agreement is in conformity with the actions of the parties since 2004, i.e. there being an Agreement, existing trade mark applications and reference to the trade mark on the labels, and 2) if the Agreement filed by Mitchell's Pakistan under exhibit MM2 is the genuine version, then on its own terms it lapsed after 10 years, in April 2014, and so the application date (the subject of this opposition) is more than 3 years after the purported agreement had lapsed and it would be entitled to file the application.

69) The applicant specifically refers to two emails in support of its argument that Mitchell's Pakistan was aware of the trade mark applications for the mark Mitchell's and that it was referred to as such on the labels. The first is dated 4 July 2011<sup>30</sup> from Mr Chaudhry to Mr Hauri of Mitchell's Pakistan which states "As per our contract I will apply trademark Mitchell's under this company ownership. If the trademark is registered successfully then I will amend all of my current labels and send them to you for printing with details of registered trademark. This will safeguard my business now and in the future and deter any of my competitor taking any advantage by using similar trademark within my business territory." Mitchell's Pakistan states that it has never labelled the products in this manner and submits samples of labels which it considers to be the correct versions.<sup>31</sup> However, they are undated.

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<sup>30</sup> Exhibit AC2-1 to the witness statement of Mr Chaudhry

<sup>31</sup> Exhibit ZK3 to the witness statement of Mr Khan

70) The second email<sup>32</sup> is dated 10 May 2013 from Mr Chaudhry to Mr Haroon Asif of Mitchell's Pakistan. It specifically refers to UK trade mark application number 2619226. Pertinent details of this registration are below:



Mark:

Owner: Mitchell's Europe Limited<sup>33</sup>

Filing date: 27 April 2012

Registration date: 16 November 2012

Classes; 29, 30 and 32

71) The email states that "As discussed over the phone, these new designs include details of my registered Mitchell's trademark (UK0002619226) and my company details which is the owner of the trade mark Mitchell's Fruit Farms Limited. These are legal details hence have been applied to our labels". The applicant also states that the labels, which it claims were approved by Mitchell's Pakistan, include the statement that "Mitchell's is a Trademark of MAK Enterprises Ltd London United Kingdom"<sup>34</sup>. Mitchell's Pakistan has not made any comment in relation to these emails.

72) In essence, the applicant claims to have shown Mitchell's Pakistan that it was using the marks on the labels and, moreover, it specifically referred to it as being the owner of the Mitchell's mark in emails. There is conflicting evidence on this point insofar that the applicant has submitted numerous examples of labels which include references to Mitchell's being a trade mark belonging to MAK and Mitchell's Pakistan have submitted labels without this statement, though I must take into account that Mitchell Pakistan's labels are not dated.

73) The evidence does demonstrate that there is a UK Mitchell's registration in the name of the applicant, which was filed in April 2012. The evidence also includes unchallenged emails which 1) refer to the aforementioned trade mark application, and

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<sup>32</sup> Exhibit AC2-2 to Mr Chaudhry's witness statement

<sup>33</sup> The application was filed in the name of Mitchell's Fruit Farms Ltd but the owner details on the trade marks register states that it changed to Mitchell's Europe Limited on 21 May 2018.

<sup>34</sup> Exhibit AC2 of Mr Chaudhry's witness statement

2) state that “As per our contract I will apply trademark Mitchell’s under this company ownership”. Mitchell’s Pakistan now state that they would never assign or allow a third party to register its Mitchell’s trade mark. However, even when it receives emails referring to a trade mark application, an intention to file an application, labels which include statements about the applicant owning the trade mark (which on the balance of probability they would have seen), it took no action. Instead action was taken when, it says, it became aware of a change in the company name which led to this opposition.

74) The applicant argues that if Mitchell Pakistan’s version of the Agreement was the correct version then since it had a 10-year expiry, it would have expired approximately three years prior to the application being filed and it was therefore no longer bound by its terms. Whilst it may be the case that the Agreement may have expired, as I have already stated, both parties still considered themselves to be in a business relationship. Therefore, the applicant could not legitimately claim to be on the one hand acting as an agent/distributor but then seek to rely upon the expiration of an Agreement as a legitimate reason to apply for the UK trade mark. Accordingly, I reject this line of argument from the applicant.

75) I acknowledge that Mitchell’s Pakistan has filed a Report which it clearly believes to support its claim that the applicant’s version of the Agreement is forged. However, as I have already stated, I find it to be inconclusive and that it does not assist me in reaching a conclusion. The Applicant has countered these claims with what it claims to be the legitimate version of the Agreement and emails which it claims to include its version of the Agreement. Moreover, the applicant informed Mitchell’s Pakistan in an email that it was applying to register the trade mark Mitchell’s and in a subsequent email it even provided the application number. Further, it sent Mitchell’s Pakistan labels which clearly included reference to Mitchell’s being a trade mark in the name of MAK. Mitchell’s Pakistan has submitted an undated label which does not include reference to a UK trade mark. However, it has been silent on the emails. Taking all the evidence and submissions into account, the applicant’s claims are consistent with its actions and the terms of the Agreement that it seeks to rely upon. I therefore find that Mitchell’s Pakistan was aware of the existing trade mark application and that it was being referred to on the labels. Taking these conclusions into account it is likely that the applicant’s version of the Agreement was the legitimate version. The net effect of



this is that I find the applicant under section 60(5) of the Act to have a legitimate reason to apply for the trade mark application.

76) I am further supported in this conclusion since I do not consider Mitchell Pakistan's justification for there being a breakdown in their business relationship to be more plausible than the explanation, and evidence, provided by the applicant. The applicant argues that this was due to inadequate products received from Mitchell's Pakistan. The applicant provided evidence (pictures of the damaged goods) and Mitchell's Pakistan did acknowledge that there was an issue, albeit not to the extent claimed by the applicant, with the goods. However, Mitchell's Pakistan states that the breakdown was due to them becoming aware of the applicant applying for a company registration, but it has not provided any evidence to support this contention. If this was the case, then presumably there would be emails to the applicant bringing the relationship to an end or challenging the action taken.

### **DECISION – SECTION 3(6)**

#### *The law*

77) Section 3(6) of the Act states:

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

#### *The case law*

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

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

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

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

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

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

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes

of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

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

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

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

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

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

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

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

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

79) In *R82 A/S v ATO Form GmbH*, [2006] ETMR 8, OHIM declared a number of CTMs (now EUTMs) to be invalid on the basis that they had been filed in bad faith by an agent of the true proprietor. The Cancellation Division stated:

"27 In view of the above, and in the absence of any evidence to the contrary, the Office cannot but conclude that the CTM proprietor acted in bad faith when it filed the applications for all six CTMs. Indeed, having distributed the applicant's products in Germany, albeit through a different legal entity, the CTM proprietor knew perfectly well that the trade marks of the applicant did not belong to it. By filing trade mark applications for these marks the CTM proprietor acted in bad faith within the meaning of Art.51(1)(b) CTMR."

80) This decision indicates that where an agent or representative makes an application to register a trade mark which belongs to its principal, and does not justify its actions, it will be taken to have acted in bad faith. Therefore, although the principal may seek redress under other provisions of the Act, it may also, or instead, pursue a claim based on bad faith.

81) I have already found that the applicant, acting as a distributor, had a legitimate reason to file the application. One of the reasons for this was the Agreement which I found to be the legitimate version does not expressly permit the applicant to apply for

the trade mark MITCHELL'S in any territory, but it does have a ten-year expiry date rather than 15 years in the contested version.

82) It is common ground between the parties that the relationship began to break down in March/April 2017. However, the reasons given differ greatly with the applicant putting it down to poor quality products and Mitchell's Pakistan claiming that they had become aware of the applicant filing the trade mark application without its consent. In my view, the cause of the relationship breakdown is irrelevant to the matter to be decided. It is the applicant's intention at the time of filing the application which is the matter I must consider. On 11 May 2017 (18 days prior to the trade mark application filing date), Mr Chaudhry had sent Mitchell's Pakistan an email trying to resolve the matter. Another email, stating that he had "been trying to get in touch with yourselves for last 3 days", was then sent on 25 May 2017 and a further email seeking a response sent on 29 May 2017 (the application filing date). Mr Chaudhry appears to have been exasperated by the lack of response and I consider it likely that he filed the trade mark application to maintain his existing position as the trade mark rights holder for Mitchell's in the UK.

83) I have already found that the applicant, acting as the distributor, had a legitimate reason to file the trade mark application. For the same reasons, and in the absence of evidence to the contrary from Mitchell's Pakistan, I do not consider the application to have been filed in bad faith.

84) I should also add that whichever is the legitimate version of the Agreement is unlikely to impact the bad faith finding since if the applicant's version was correct then at the time of filing the application it had not expired and it provided express permission to file the application. If Mitchell's Pakistan's version is the legitimate copy, it had expired three years prior to the application being filed and so it was bound by the Agreement not to file the application. Therefore, whichever version of the Agreement was found to be legitimate is unlikely to alter my finding that the application was not filed in bad faith.

## **DECISION – SECTION 5(2), APPLICABLE BY VIRTUE OF SECTION 56**

85) Mitchell's Pakistan also opposes the application based on it having an "earlier mark" which is well-known and protectable under section 56 of the Act, which implements Article 6bis of the Paris Convention. The relevant parts of section 56 are:

86) Section 56(1) of the Act states:

### **Protection of well-known trade marks: Article 6bis**

56. - (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who-

(a) is a national of a Convention country, or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

This right is subject to section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any bona fide use of a trade mark begun before the commencement of this section.

87) Such well-known marks qualify as earlier marks in proceedings such as these by virtue of section 6(1)(c) of the Act which reads:

6. - (1) In this Act an “earlier trade mark” means -

[...]

(a) –

(b)

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well-known trade mark.

88) Consequently, the first consideration would normally be whether the applicant’s claim to an earlier mark is valid keeping in mind the guidance of Richard Arnold QC, sitting as the appointed person in *Le Mans Autoparts Limited v Automobile Club de l’Ouest de la France (ACO)* O-012-05 and when sitting as a high court judge in *Hotel Cipriani SRL et al v Cipriani (Grosvenor Street) Limited et al* [2008] EWHC 3032 (CH).

89) This means that the proprietor of a well-known mark is entitled to oppose the registration (and use) of a later conflicting mark in the UK, without having registered the earlier mark in the UK (or EU). A well-known mark is one that is known to (at least) a significant proportion of the relevant public in the UK<sup>35</sup>. The date of the application to register the contested mark is the relevant date for assessing the Mitchell Pakistan’s claim to be the owner of the earlier mark which are well known in the UK, as per section 56(1).

90) The date of the application to register the contested trade mark is 29 May 2017. This is therefore the relevant date at which to assess whether or not Mitchell Pakistan’s MITCHELL’S mark was well-known in the UK.

91) The goods in question are general food and drink stuffs. Therefore, the relevant public for the goods in question are the general public at large. I must assess the degree of recognition of Mitchell’s Pakistan MITCHELL’S mark for this public. It is clearly an enormous market. Both parties are in agreement that the total sales of

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<sup>35</sup> See the Opinion of the Advocate General in *General Motors v Yplon S.A.*, CJEU, Case C-375/97, which is consistent with the judgment of the CJEU in *Alfredo Nieto Nuno v Leonci Monello Franquet*, Case C-238/06





**ANNEX A**



**GOVERNMENT OF PAKISTAN**

**THE TRADE MARKS REGISTRY, KARACHI**

In the Matter of the Registered

Trade Mark No. 2914

( **For RECORD Purpose Only** )

It is hereby Certified that the annexure (s) herewith  
is/are a true copy / copies of the entry / entries in the  
Register of Trade Marks relating to the

Trade Mark **AS ANNEXED** (Word per se)  
(a representation of which is affixed hereto)

Registered under No. 2914

as of the date 08<sup>th</sup> June, 1943.

in class 29

Issued under Section 11 & 121 (2) of the Trade Marks Ordinance 2001 Rules 84.

13<sup>th</sup>

day of June

2017



*Zahid Rasool*  
(Zahid Rasool)

Asst Registrar of Trade Marks  
XXXXXXXXXXXXXXXXXXXX

~~Examiner of Trade Marks~~

Authorised U/S 7(2) of the Trade Marks Ordinance, 2001.

Application No.	2914
Filing Date	08-06-1943
Date of Actual Registration	28-04-1951
Mark	MITCHELL'S
Name, Address and Description	Mitchell's Fruit Farms Limited, Renala Khurd (Distt. Sahiwal), Pakistan, A Private Limited Liability Company Registered Under The Indian Companies Act As Adapted Of Pakistan, Manufacturers.
Goods Description	Preserves fruits and jams.
Registration Renewed 26-08-1952	Registration Renewed for 15 Years From 30-JUNE-1951 and Expires on 30-JUNE- 1966.
Registration Renewed 02-12-1966	Registration Renewed for 15 Years From 30-JUNE-1966 and Expires on 30-JUNE- 1981.
Address for Services Altered 01-02- 1982	Pursuant to a request on form TM-50 dated 23-Dec-1981, and Registrar orders thereon dated 01-02-1982, the address for service has been altered to read as Surrige & Beecheno, (Advocates) Finlay House, 11. Chundrigar Road, Karachi.
Registration Renewed 04-04-1982	Registration Renewed for 15 Years From 30-JUNE-1981 and Expires on 30-JUNE- 1996.
Registration Renewed	Registration Renewed for 15 Years From 30-JUNE-1996 and Expires on 30-JUNE- 2011.
Registration Renewed 15-03-2016	Registration Renewed for 10 Years From 30-JUNE-2011 and Expires on 30-JUNE- 2021.
Present Status	Registered

### Mitchell's Trade Marks Status

Sr.#	Trade Marks	Ref #	Application #	Class(es)	Dated
1	DISCOVEREE	M-2222	139729	30	02-02-97
2	DISCOVEREE (label)	M-2222	139729	30	02-02-97
3	Flying Bird within circle	M-1935	73155	30	24-12-80
4	Fruit Bon Bons	M-1935	73156	30	24-12-80
5	HAT TRIK (label)	M-2132	91933	30	10-05-86
6	HAT-TRIK (label)	M-1840	91933	30	10-05-86
7	JUBILEE (label)	M-1777	87881	30	16-10-85
8	Mitchell's (word)	M-2246	148850	30	07-04-98
9	Mitchell's (word)	M-1636	2914	29	06-08-43
10	MITCHELL'S (word)	M-1935	74424	30	06-09-81
11	MITCHELL'S (word)	M-1935	74425	32	06-09-81
12	Mitchell's Balance (label)	M-2710	187127	30	19-07-03
13	Mitchell's Butter Scotch (wrapper)	M-1964	103471	30	08-08-89
14	Mitchell's Festival (label)	M-2694	184211	30	25-03-2003
15	Mitchell's Golden Hearts (label)	M-2684	174335	30	17-10-2001
16	Mitchell's Luxuree (label)	M-2685	174334	30	17-10-2001
17	Mitchell's Mangoman (label)	M-2694	184217	30	25-03-2003
18	Mitchell's Milk toffee (label)	M-1826	90685	30	06-11-86
19	Mitchell's Milk Toffee (wrapper)	M-1965	103472	30	08-08-89
20	Mitchell's Silver Hearts (label)	M-2700	184805	30	18-04-2003
21	Mitchell's Since 1933	M-2701	184806	30	18-04-2003
22	Mitchell's Top Milk	M-2683	174336	30	17-10-2001
23	Mitchell's Twentee (label)	M-2694	184216	30	25-03-2003
24	Mitchell's Unitee (label)	M-2694	184218	30	25-03-2003
25	RECESS (word)	M-2087	113321	30	26-11-1991