

O/0581/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003612571

BY A. RAHIM FOODS (PVT.) LIMITED

TO REGISTER THE TRADE MARK:



IN CLASSES 29 AND 30

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 426265 BY

DAWN FOODS, INC.

## BACKGROUND AND PLEADINGS

1. On 18 March 2021, A. Rahim Foods (Pvt.) Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The trade mark was published for opposition purposes on 21 May 2021 and registration is sought for the following goods:<sup>1</sup>

Class 29      Chicken chapli kebab; chicken nuggets; chicken kofta; chicken shami kebab; chicken malai boti; chicken seekh kebab; chicken balls; breaded chicken pieces; chicken burger patties; frozen appetizers consisting primarily of chicken; frozen meals consisting primarily of chicken; chicken stuffed with herbs and spices; chicken stuffed with cheese or flavoured butter.

Class 30      Frozen paratha; plain paratha; butter paratha; chicken filled paratha; aloo paratha.

2. On 19 August 2021, the application was opposed by Dawn Foods, Inc. (“the opponent”) based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Under both grounds of opposition, the opponent relies upon the following trade marks:

DAWN

UKTM no. 1353554

Filing date 3 August 1988; registration date 24 June 1994

(“the First Earlier Mark”)

The logo for Dawn Foods, Inc. features the word "Dawn" in a bold, sans-serif font. The letter 'D' is significantly larger and more prominent than the other letters, and it has a stylized, curved shape that suggests a rising sun or a wave.

UKTM no. 2387377

Filing date 18 March 2005; registration date 18 August 2006

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<sup>1</sup> This is the specification as currently applied-for, following a restriction to the specification filed on a Form TM21B on 20 October 2023.

("the Second Earlier Mark")

The logo for 'Dawn' features the word 'Dawn' in a bold, sans-serif font. Above the letter 'a', there is a stylized graphic of a sun rising over a horizon, with the sun partially obscured by the top of the 'a'.

UKTM no. 903255684<sup>2</sup>

Filing date 4 July 2003; registration date 29 March 2005

("the Third Earlier Mark")

DAWN BALANCE

UKTM no. 918052747

Filing date 16 April 2019; registration date 12 September 2019

("the Fourth Earlier Mark")

DAWN EXCEPTIONAL

UKTM no. 918052750

Filing date 16 April 2019; registration date 12 September 2019

("the Fifth Earlier Mark")

3. The opponent relies upon all goods and services for which the earlier marks are registered, as set out in the Annex to this decision.

4. Under section 5(2)(b) of the Act, the opponent claims that the marks are similar, and the goods and services are identical or similar, with the result that there is a likelihood of confusion.

5. Under section 5(3) of the Act, the opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of, and/or be detrimental to, the distinctive character and/or repute of the earlier marks.

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<sup>2</sup> On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing European Union trade mark ("EUTM"). As a result of the opponent having EUTMs protected as at the end of the Implementation Period, comparable UK trade marks were automatically created. The comparable trade marks shown here are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and retain their original filing dates.

6. The applicant filed a counterstatement denying the grounds of opposition and requesting that the opponent provide proof of use of the First, Second and Third Earlier Marks.

7. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful consideration of all papers on file.

## **REPRESENTATION**

8. The opponent is represented by Forresters IP LLP.

9. The applicant is represented by Lewis Silkin LLP.

## **EVIDENCE AND SUBMISSIONS**

10. The opponent filed evidence in chief consisting of:

- a) The witness statement of Kathryn Louise Cruse dated 6 June 2023, which is accompanied by 1 exhibit (Exhibit KLC1). Ms Cruse is the trade mark attorney acting on behalf of the opponent in these proceedings.
- b) The witness statement of Scott Thayer dated 20 June 2023, which is accompanied by 9 exhibits (Exhibits ST1 to ST9). Mr Thayer is the Chief Legal Officer and Corporate Secretary for the opponent, a position he has held since January 2013.

11. The applicant elected not to file evidence, but did file written submissions during the evidence rounds, which are dated 21 August 2023.

12. Both parties filed written submissions in lieu dated 7 November 2023.

## RELEVANCE OF EU LAW

13. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## DECISION

### Section 5(2)(b)

14. Section 5(2)(b) of the Act reads as follows:

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

(a)...

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

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

15. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

16. Given their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the First, Second and Third Earlier Marks had completed their registration process more than 5 years prior to the filing date of the application, they are subject to the use provisions of section 6A of the Act; the Fourth and Fifth Earlier Marks are not. Consequently, I will begin my assessment on the basis of the Fourth and Fifth Earlier Marks, returning to the First, Second and Third Earlier Marks only if it is necessary to do so.

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

18. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p data-bbox="201 253 336 286"><u>Class 29</u></p> <p data-bbox="201 309 791 947">Fruit-based fillings for cakes and pies; toppings, namely, fruit topping, nut topping, peanut butter topping, whipped dairy and non-dairy based toppings for cakes and pies, excluding milk and milk powder; food-glazing preparations comprised primarily of fruit and/or fruit pectin for use in cooking and baking; shortening; hardened oils being hydrogenated oils for food; cooking oils; non-dairy based mix for making whipped icings; and mincemeat.</p> <p data-bbox="201 1021 336 1055"><u>Class 30</u></p> <p data-bbox="201 1077 791 1998">Bakery mixes and goods, namely, donuts; cake donut mixes, bases and concentrates being cake donut mixes; cake donut stick mixes, bases and concentrates being cake donut stick mixes; French donut mixes, bases and concentrates being French donut mixes; yeast raised donut mixes, bases and concentrates being yeast raised donut mixes; bread mixes, bases and concentrates being bread mixes; cake mixes, bases and concentrates being cake mixes; sweet roll mixes, bases and concentrates being sweet roll mixes; dinner roll mixes, bases and concentrates being dinner roll mixes; pizza mixes, bases and concentrates</p>	<p data-bbox="807 253 943 286"><u>Class 29</u></p> <p data-bbox="807 309 1391 835">Chicken chapli kebab; chicken nuggets; chicken kofta; chicken shami kebab; chicken malai boti; chicken seekh kebab; chicken balls; breaded chicken pieces; chicken burger patties; frozen appetizers consisting primarily of chicken; frozen meals consisting primarily of chicken; chicken stuffed with herbs and spices; chicken stuffed with cheese or flavoured butter.</p> <p data-bbox="807 909 943 943"><u>Class 30</u></p> <p data-bbox="807 965 1391 1111">Frozen paratha; plain paratha; butter paratha; chicken filled paratha; aloo paratha.</p>

being pizza mixes; muffin mixes, bases and concentrates being muffin mixes; bakery goods, frozen or fresh, namely, pastry; croissants; donuts; brownies, dough cakes; bagels; breads; pudding cakes; creme cakes; muffins; sweet dough cookies; rolls; pizza dough; pretzels; pie crust; biscuits; crackers; donut sugar; icings; sugar-based fillings, toppings and cremes for bakery goods; and starch-based stabilizers for bakery goods, namely, syrups for flavoring beverages; starch-based thickeners for whipped cream; non-dairy based mix for making fillings for baked goods; Bavarian cream; vanilla cream and white Holland cream fillings for use in cakes and pies, excluding milk and milk powder.	
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19. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

20. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

21. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

22. I have noted the applicant’s submissions that the opponent sells to businesses, rather than directly to the consumer of the goods and that this results in the parties’ goods having different users. The applicant also makes reference to the actual goods for which the opponent uses its marks in practice; no comment is made upon the specifications of the Fourth and Fifth Earlier Mark, which are not subject to the use

requirements of section 6A of the Act. For the avoidance of doubt, the assessment that I must undertake is a notional one based upon the parties' respective specifications. Consequently, I do not consider that these submissions assist the applicant.

### Class 29

23. The applicant's goods in class 29 are all types of meat products or meals consisting predominantly of meat. The opponent's goods can broadly be categorised as ingredients/decorations for bakery products and bakery products. The goods overlap in nature to the extent that they are all edible. However, their specific natures very clearly differ. The method of use may overlap to some extent in that they will all be consumed by the user (either in their complete form or after cooking). However, there will be significant differences in their methods of use, with the opponent's ingredients/decorations typically requiring some form of additional preparation before consumption (such as baking, adding to a cake, mixing with other ingredients etc.). Whilst this may also be true of some of the applicant's goods, such as where they are frozen and require cooking, this is a very general level of overlap. I recognise that some of the bakery products will be supplied in ready-to-consume form, which will place them closer in method of use to the opponent's goods. However, this is still a very general level of overlap. The purpose of the goods will overlap, again, at a very general level, to the extent that they will all be consumed for the nourishment/enjoyment of the user. However, their specific purposes differ, with the applicant's goods typically being a complete meal (or main protein element of a meal), whereas the opponent's goods would typically contribute towards an end product that is eaten as a side dish, snack or dessert. I consider it unlikely that the producers of these goods will overlap, although I recognise that they may be sold through the same trade channels (such as supermarkets). However, even where that is the case, they will be sold in distinct sections of those outlets. There is no competition (given the differing purposes) and no complementarity (as one is not important or indispensable for the other, nor would the average consumer consider the same undertaking to be

responsible for the goods).<sup>3</sup> I accept that the user may overlap, but that is not sufficient on its own for a finding of similarity. In my view, the goods are dissimilar.

24. In this regard, I note that the opponent has referred me to a previous decision of this Tribunal (a copy of which is provided under Exhibit KLC1) in which another hearing officer considered the similarity of the specifications of the earlier marks with various meat and fish products in class 29.<sup>4</sup> I am fortified in my finding by the fact that the hearing officer in that case also found those goods to be dissimilar.

25. As some degree of similarity between the goods is required for there to be a successful opposition under section 5(2)(b) of the Act, the opposition under this ground must fail in respect of those goods that I have found to be dissimilar.<sup>5</sup>

### Class 30

26. The applicant's goods are all types of flat bread. They are, therefore, identical on the principle outlined in *Meric* with "bread" in the opponent's specifications.

### **The average consumer and the nature of the purchasing act**

27. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the

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<sup>3</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

<sup>4</sup> BL O/1055/22

<sup>5</sup> *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

28. The goods are likely to be used by members of the general public. They are likely to be reasonably frequent purchases and will be relatively low cost. However, factors such as flavour and ingredients are likely to be taken into consideration when purchasing the goods. Consequently, I consider that a medium (or average) degree of attention is likely to be paid during the purchasing process.

29. The goods are likely to be self-selected from the shelves of a retail outlet, or an online equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants.

### **Comparison of trade marks**


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

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

31. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

32. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
<p style="text-align: center;">DAWN BALANCE (the Fourth Earlier Mark)</p> <p style="text-align: center;">DAWN EXCEPTIONAL (the Fifth Earlier Mark)</p>	

### Overall Impression

33. The Fourth Earlier Mark consists of the words DAWN BALANCE. The word BALANCE may allude to the fact that the goods are balanced in some way (such as being made of ingredients that are balanced for optimum nutrition or flavour). Consequently, the word DAWN is the more distinctive element of the mark.

34. The Fifth Earlier Mark consists of the words DAWN EXCEPTIONAL. The word EXCEPTIONAL is plainly laudatory and will be attributed little or no trade mark significance. Consequently, the word DAWN is the dominant element of the mark.

35. The applicant's mark consists of the word DAWN in large red font, above the word FOODS presented in a smaller blue font. Beneath the word FOODS is a green curved line and above the word DAWN is a yellow sun device. All of these elements are encompassed in a red border and presented on a pale peach-coloured background. The overall impression of the mark lies in the combination of these elements, with the word DAWN playing the greater role due to its size, the fact that the eye is naturally

drawn to the element of the mark that can be read and the fact that the other word element in the mark is descriptive.

### Visual Comparison

36. Visually, the marks overlap in that they all contain the word DAWN. They differ in the presence of the word BALANCE/EXCEPTIONAL in the Fourth and Fifth Earlier Marks and the word FOODS in the applicant's mark, as well as the other presentational/device elements that make up the application. I bear in mind that the Fourth and Fifth Earlier Marks are word only marks that could be used in any font/colour. Taking all of this into account, I consider the marks to be visually similar to between a low and medium degree.

### Aural Comparison

37. The word DAWN will be pronounced identically in all three marks. The words FOODS, BALANCE and EXCEPTIONAL will be given their ordinary English pronunciation and will act as points of aural difference. Taking all of this into account, I consider the marks to be aurally similar to a medium degree.

### Conceptual Comparison

38. The word DAWN will be understood as either a female forename or the time of day just before sunrise.<sup>6</sup> This meaning will be the same in all three earlier marks. The words BALANCE, EXCEPTIONAL and FOODS will be given their ordinary dictionary meanings and will act as points of conceptual difference. However, they are either not distinctive or not particularly distinctive. In my view, this results in the marks being conceptually similar to a high degree overall.

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<sup>6</sup> <https://www.collinsdictionary.com/dictionary/english/dawn>

## **Distinctive character of the earlier marks**

39. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

40. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

41. The Fourth Earlier Mark consists of the words DAWN BALANCE and the Fifth Earlier Mark consists of the words DAWN EXCEPTIONAL. As noted above, the word DAWN may be viewed as a female forename or a time of day. In either case, it has a

medium (or average) degree of inherent distinctiveness. The words BALANCE and EXCEPTIONAL are also ordinary dictionary words. Any contribution to the overall distinctiveness of the marks as a result of these words is limited due to their laudatory/allusive connotations and, in any event, it is the distinctiveness of the common element which is key. In my view, both earlier marks are inherently distinctive to a medium (or average) degree overall.

42. I must now consider whether the inherent distinctiveness of the earlier marks has been enhanced through use. The opponent has provided evidence that it (or its predecessors in title) first started operating in the UK in 1989. Mr Thayer has provided UK sales figures dating back to 1993; these amounted to over £56million in 2016, over £61million in 2017, over £64million in 2018, over £65million in 2019, over £48million in 2020 and over £57million in 2021. These figures are not broken down by product type. Invoices have been provided to support these figures.<sup>7</sup> However, none of the invoices show sales in relation to bread, which are the goods that I have found to be identical to those for which the applicant seeks protection. The opponent has invested over £200,000 per year in marketing/advertising in the UK. Again, this is not broken down by product type. Consequently, I do not consider the evidence filed to be sufficient to demonstrate that the distinctiveness of the earlier marks has been enhanced through use in relation to the relevant goods (being bread).

### **Likelihood of confusion**

43. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between them and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa. As I mentioned above, it is necessary for me to keep in mind

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<sup>7</sup> Exhibit ST4

the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

44. I have found as follows:

- a) The goods are identical.
- b) The average consumer for the goods is a member of the general public who will pay a medium degree of attention during the purchasing process.
- c) The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase.
- d) The marks are visually similar to between a low and medium degree and aurally similar to a medium degree. The word DAWN will convey an identical conceptual message in all three marks, with the words FOODS, EXCEPTIONAL and BALANCE acting as points of conceptual difference (albeit not distinctive or not particularly distinctive ones). The marks are conceptually highly similar overall.
- e) The Fourth and Fifth Earlier Marks are inherently distinctive to a medium (or average) degree.

45. Bearing in mind the predominantly visual purchasing process, and the visual differences between the marks, I do not consider it likely that one mark will be mistakenly recalled or misremembered as the other, even when used on identical goods. Consequently, I do not consider there to be a likelihood of direct confusion.

46. I will now consider whether there is a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)”.

47. In my view, the replacement of the words EXCEPTIONAL/BALANCE with the word FOODS is consistent with a brand extension or sub-brand. These are likely to be seen as indicating different marks used by the same undertakings. For example, the applicant's mark may be seen as the brand used for more general food-based product lines, whereas the Fifth Earlier Mark might be seen as indicating the premium range. Similarly, the Fourth Earlier Mark might be seen as indicating products which are 'balanced' in some way (such as being made of ingredients that are balanced for optimum nutrition or flavour). The other elements of the application are likely to be viewed as a logo version of the DAWN brand being used by the same or related undertaking. In my view, there is a likelihood of indirect confusion.

48. The opposition based upon section 5(2)(b) of the Act succeeds in relation to the class 30 goods of the application only.

### **Section 5(3)**

49. Section 5(3) of the Act states:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, [...] shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

50. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

51. I can deal with this ground relatively swiftly. The issue for the opponent in demonstrating the requisite reputation is the fact that they have not broken down their

sales figures to reflect the products sold. However, the invoices filed overwhelmingly show use in relation to bakery ingredients/mixes and some finished products (mainly, cookies, doughnuts and muffins). I consider it a reasonable inference to draw that, in light of that evidence, a significant proportion of the sales made by the opponent are also likely to relate to those goods. I would also have found proof of use for those goods to the extent that they are covered by the specifications of the First, Second and Third Earlier Marks. That being said, in the absence of more solid evidence from the opponent as to what proportion of those sales relate to the relevant goods (as opposed to, for example, the services for which it also claims use), I am not prepared to find that the opponent had any more than a reasonable reputation at the relevant date. In relation to the goods that survive the section 5(2)(b) opposition, being those in class 29, these are plainly dissimilar to the opponent's goods for the same reasons set out above. I have borne in mind that both are, ultimately, consumables. I also bear in mind that the First, Second and Third Earlier Mark share a greater degree of visual, aural and conceptual similarity with the application than the Fourth and Fifth Earlier Marks. However, in my view, the distance between the goods is too great for a link to be made, notwithstanding the similarity of the marks. In my view, no link would be made by the relevant public. If a link was made, it would be too fleeting to give rise to damage.

## **CONCLUSION**

52. The opposition is successful in relation to the following goods for which the application is refused:

Class 30      Frozen paratha; plain paratha; butter paratha; chicken filled paratha; aloo paratha.

53. The opposition is unsuccessful in relation to the following goods for which the application may proceed to registration:

Class 29      Chicken chapli kebab; chicken nuggets; chicken kofta; chicken shami kebab; chicken malai boti; chicken seekh kebab; chicken balls; breaded chicken pieces; chicken burger patties; frozen appetizers consisting

primarily of chicken; frozen meals consisting primarily of chicken; chicken stuffed with herbs and spices; chicken stuffed with cheese or flavoured butter.

## **COSTS**

54. As the applicant has enjoyed the greater degree of success it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I have applied what I consider to be an appropriate reduction to account for the only partial success. In the circumstances, I award the applicant the sum of **£1,100** calculated as follows:

Preparing a counterstatement and considering the Notice of opposition	£275
Considering the opponent's evidence	£475
Written submissions	£350
<b>Total</b>	<b>£1,100</b>

55. I therefore order Dawn Foods, Inc. to pay A. Rahim Foods (Pvt.) Limited the sum of **£1,100**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 20<sup>th</sup> day of June 2024**

**S WILSON**

**For the Registrar**



## ANNEX

### **First Earlier Mark**

#### Class 30

Mixes, bases and concentrates for baked products; all included in Class 30.

### **Second Earlier Mark**

#### Class 30

Mixes, bases and concentrates for baked products.

### **Third Earlier Mark**

#### Class 29

Fillings, icings, toppings and edible decorations for bakery products.

#### Class 30

Preparations for making bakery products; mixes for bakery products; flour; preparations made from cereals and used as an ingredient in making baking products; dough mixes, cake mixes, doughnut mixes, biscuit mixes, cookie mixes, muffin mixes, batter, bakery ingredients, fillings, icings, toppings and edible decorations for bakery products.

#### Class 43

Preparation and provision of advice, reports and information; technical support services; consultancy service; provision of recipe information; all the aforesaid services relating to baking and/or bakery products.

### **Fourth Earlier Mark**

#### Class 29

Fruit-based fillings for cakes and pies; toppings, namely, fruit topping, nut topping, peanut butter topping, whipped dairy and non-dairy based toppings for cakes and pies, excluding milk and milk powder; food-glazing preparations comprised primarily of fruit and/or fruit pectin for use in cooking and baking; shortening; hardened oils being hydrogenated oils for food; cooking oils; non-dairy based mix for making whipped icings; and mincemeat.

### Class 30

Bakery mixes and goods, namely, donuts; cake donut mixes, bases and concentrates being cake donut mixes; cake donut stick mixes, bases and concentrates being cake donut stick mixes; French donut mixes, bases and concentrates being French donut mixes; yeast raised donut mixes, bases and concentrates being yeast raised donut mixes; bread mixes, bases and concentrates being bread mixes; cake mixes, bases and concentrates being cake mixes; sweet roll mixes, bases and concentrates being sweet roll mixes; dinner roll mixes, bases and concentrates being dinner roll mixes; pizza mixes, bases and concentrates being pizza mixes; muffin mixes, bases and concentrates being muffin mixes; bakery goods, frozen or fresh, namely, pastry; croissants; donuts; brownies, dough cakes; bagels; breads; pudding cakes; creme cakes; muffins; sweet dough cookies; rolls; pizza dough; pretzels; pie crust; biscuits; crackers; donut sugar; icings; sugar-based fillings, toppings and cremes for bakery goods; and starch-based stabilizers for bakery goods, namely, syrups for flavoring beverages; starch-based thickeners for whipped cream; non-dairy based mix for making fillings for baked goods; Bavarian cream; vanilla cream and white Holland cream fillings for use in cakes and pies, excluding milk and milk powder.

### **Fifth Earlier Mark**

#### Class 29

Fruit-based fillings for cakes and pies; toppings, namely, fruit topping, nut topping, peanut butter topping, whipped dairy and non-dairy based toppings for cakes and pies, excluding milk and milk powder; food-glazing preparations comprised primarily of fruit and/or fruit pectin for use in cooking and baking; shortening; hardened oils being hydrogenated oils for food; cooking oils; non-dairy based mix for making whipped icings; and mincemeat.

#### Class 30

Bakery mixes and goods, namely, donuts; cake donut mixes, bases and concentrates being cake donut mixes; cake donut stick mixes, bases and concentrates being cake donut stick mixes; French donut mixes, bases and concentrates being French donut mixes; yeast raised donut mixes, bases and concentrates being yeast raised donut mixes; bread mixes, bases and concentrates being bread mixes; cake mixes, bases

and concentrates being cake mixes; sweet roll mixes, bases and concentrates being sweet roll mixes; dinner roll mixes, bases and concentrates being dinner roll mixes; pizza mixes, bases and concentrates being pizza mixes; muffin mixes, bases and concentrates being muffin mixes; bakery goods, frozen or fresh, namely, pastry; croissants; donuts; brownies, dough cakes; bagels; breads; pudding cakes; creme cakes; muffins; sweet dough cookies; rolls; pizza dough; pretzels; pie crust; biscuits; crackers; donut sugar; icings; sugar-based fillings, toppings and cremes for bakery goods; and starch-based stabilizers for bakery goods, namely, syrups for flavoring beverages; starch-based thickeners for whipped cream; non-dairy based mix for making fillings for baked goods; Bavarian cream; vanilla cream and white Holland cream fillings for use in cakes and pies, excluding milk and milk powder.