O/0607/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3803163
BY MD FAURAHAD MEIA
TO REGISTER:

AS A TRADE MARK IN CLASS 30
AND

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO 437073
BY GRAVISS HOLDINGS PRIVATE LIMITED

BACKGROUND AND PLEADINGS

1. On 25 June 2022, Md Faurahad Meia ("the applicant") applied to register the trade mark shown on the cover of this decision ("the application") in the UK for the following goods:

Class 30: *Bakery goods; cookies; biscuits; toast biscuits; instant noodles.*

2. The application was published for opposition purposes on 22 July 2022, and it was opposed by Graviss Holdings Private Limited ("the opponent") on 24 October 2022. The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). The opponent relies on the following mark in relation to both grounds of opposition:

UK910051035[1]
Mark Description/Limitation
Colour Claimed : Azure, Blue, Gold, White, Black, Fuchsia
Filing date 16 June 2011; date of entry in register 17 November 2011.
Relying on the following goods:

Class 29: *Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.*

[1] 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 EU trade mark ("EUTM"). As a result of the opponent having EUTMs being 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 date.

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.*

3. Under its 5(2)(b) ground, the opponent claims that due to the similarity between the parties' marks and the identity and/ or similarity of the goods at issue, there exists a likelihood of confusion on the part of the relevant public, which includes the likelihood of association.

4. Under its 5(3) ground, the opponent claims that it has obtained a reputation in the UK in its marks and use of the application would take unfair advantage of, and/or be detrimental to, the distinctive character or the repute of the opponent's marks.

5. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of the earlier mark for all the goods relied upon.

6. The opponent is represented by D Young & Co LLP; the applicant is represented by Hubers Law. Only the opponent filed evidence in chief. The applicant filed submissions dated 3 July 2023. No hearing was requested. Only the opponent filed submissions in lieu of a hearing dated 7 August 2023. The decision is taken following a careful consideration of all of the papers.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

8. As mentioned above, the opponent filed evidence. The opponent's evidence in chief came in the form of the witness statement of Gaurav Goyal dated 1 May 2023. Mr Goyal is authorised to make his statement on behalf of the opponent. However, no

information has been provided explaining the role Mr Goyal occupies in the opponent's organisation. Mr Goyal's evidence is accompanied by 12 Exhibits.

9. I do not intend to summarise the evidence and submissions at this stage but will refer to the evidence and submissions where necessary throughout this decision.

DECISION

Proof of Use

10. Section 6A of the Act is as follows:

"(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in sections 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section 'the relevant period' means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his

consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form (the 'variant form') differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[(5) Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

…"

11. Paragraph 7 of Part 1 Schedule 2A of the Act reads as follows:

"(1)Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2)Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a)the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b)the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3)Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day—

(a)the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b)the references in section 6A to the United Kingdom include the European Union."

12. Section 100 of the Act is as follows:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

13. In *EasyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439, Case C-259/02 La Mer Technology Inc v Laboratories Goemar SA [2004] ECR I-1159, Case C-416/04 P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [2006] ECR I-4237, Case C-442/07 Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'[2008] ECR I9223, Case C-495/07 Silberquelle GmbH v Maselli-Strickmode GmbH [2009] ECR I-2759, Case C-149/11 Leno Merken BV v Hagelkruis Beheer BV [EU:C:2012:816], Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG [EU:C:2013:592], Case C-141/13 P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) [EU:C:2014:2089], Case C-689/15 W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 Ferrari SpA v DU [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a subcategory of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: Ansul at[36]; Sunrider at [70]; Verein at [13]; Centrotherm at [71]; Leno at [29]; Ferrari at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: Ansul at [36]; Sunrider at [70]; Verein at [13]; Silberquelle at [17]; Centrotherm at [71]; Leno at [29]; Gözze at [37], [40]; Ferrari at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: Ansul at [37]. Internal use by the proprietor does not suffice: Ansul at [37]; Verein at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: Silberquelle at [20]-[21]. But use by a non-profit making association can constitute genuine use: Verein at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: Ansul at [37]-[38]; Verein at [14]; Silberquelle at [18]; Centrotherm at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and

services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: Ansul at [38] and [39]; La Mer at [22]-[23]; Sunrider at [70]-[71], [76]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34]; Leno at [29]-[30], [56]; Ferrari at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72]; Leno at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: Reber at [32]."

14. Proven use of a mark which fails to establish that "the commercial exploitation of the marks is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark" is, therefore, not genuine use.

15. Given its filing date, the opponent's mark qualifies as an earlier trade mark under section 6 of the Act. The opponent's mark completed its registration process more than five years before the filing date of the application and, therefore, should be subject to proof of use conditions. The conditions of use, therefore, do apply to the earlier mark and, as I have already said, the applicant has put the opponent to proof of use. The relevant period for the purposes of the proof of use assessment is the five-year period ending with the date of application for the contested mark. It is therefore 26 June 2017 to 25 June 2022.

16. I am also guided by *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

> "22. The burden lies on the registered proprietor to prove use. […] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

17. I also note Mr Alexander Q.C.'s comments in *Guccio Gucci SpA v Gerry Weber International AG*, Case BL O/424/14. He stated:

> "The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. […] The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the <u>best evidence first time round</u> – or lose it"" [original emphasis]

18. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13*,* Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

> "21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita*

Electric Industrial Co. v. Comptroller- General of Patents [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

> [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.
>
> 22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

The opponent's evidence

19. Mr Gaurav Goyal states that the Kwality brand was founded in the 1950's and has been used in the UK since 2018. Mr Goyal states that the opponent's products have been distributed in the UK by its subsidiary company, Graviss UK Pvt Ltd.

20. The opponent has provided evidence in respect of invoices, product catalogues/portfolios, website extracts, in store sales of goods and advertising events. I note the following in regard to the evidence:

a) Exhibit 10 are a sample of 48 invoices that pertain to the sale of goods between August 2018 to July 2022. In most of the invoices the opponent's mark appears at the top of the document. One of the invoices is dated outside of the relevant period. I note that some of the invoices are unclear and unintelligible, subsequently, I have been unable to consider them in the figures. From what I can interpret, the invoices indicate sales figures of £2766.76 in dairy products (i.e., ghee, paneer, yoghurt, butter, cream) and £1434.62 in cakes, desserts and confectionary (e.g., kaju katli, rasmali and milk cake) in the relevant period in UK.

b) Exhibit 3 contains extracts from the representative supplier agreement between Graviss UK and the third-party suppliers that manufacture and supply the opponent's products under its mark in the UK.

c) Exhibit 2 contains snapshots from the opponent's website which demonstrate the use of the opponent's mark on paneer, ghee and flavoured milk. The narrative evidence states that this website has been active since 2021, however, I note from the date at the bottom of the snapshot the screenshots were taken on 30/3/23. Exhibit 4 is an internal presentation that demonstrates use of the mark on flavoured milk drinks, ghee, paneer and kulfi (a type of Indian ice-cream). Exhibit 5 contains example pages from the opponent's catalogue, that the opponent says was distributed in 2022. The mark is presented on ghee, paneer and ice-cream. The evidence shows that the opponent has used its mark in relation to ghee, paneer, ice-cream, flavoured milk, and ice-lollies. They appear as follows in the evidence:

[2]

[3]

[4]

[2] Exhibit 5 of the witness statement of Mr Goyal, pg 2
[3] Exhibit 5 of the witness statement of Mr Goyal, pg 2
[4] Exhibit 2 of the witness statement of Mr Goyal, pg 5

d) Exhibit 6 contains photographs the opponent states are dated April 2021 to September 2022 (some of which are outside of the relevant period) which demonstrate the use of the opponent's mark on ghee, paneer, ice-cream and ice-lollies at third party retailers in store and online – of which some are based in Manchester, Birmingham and London. I note that some of the items and prices of the goods are expressly displayed in this exhibit:

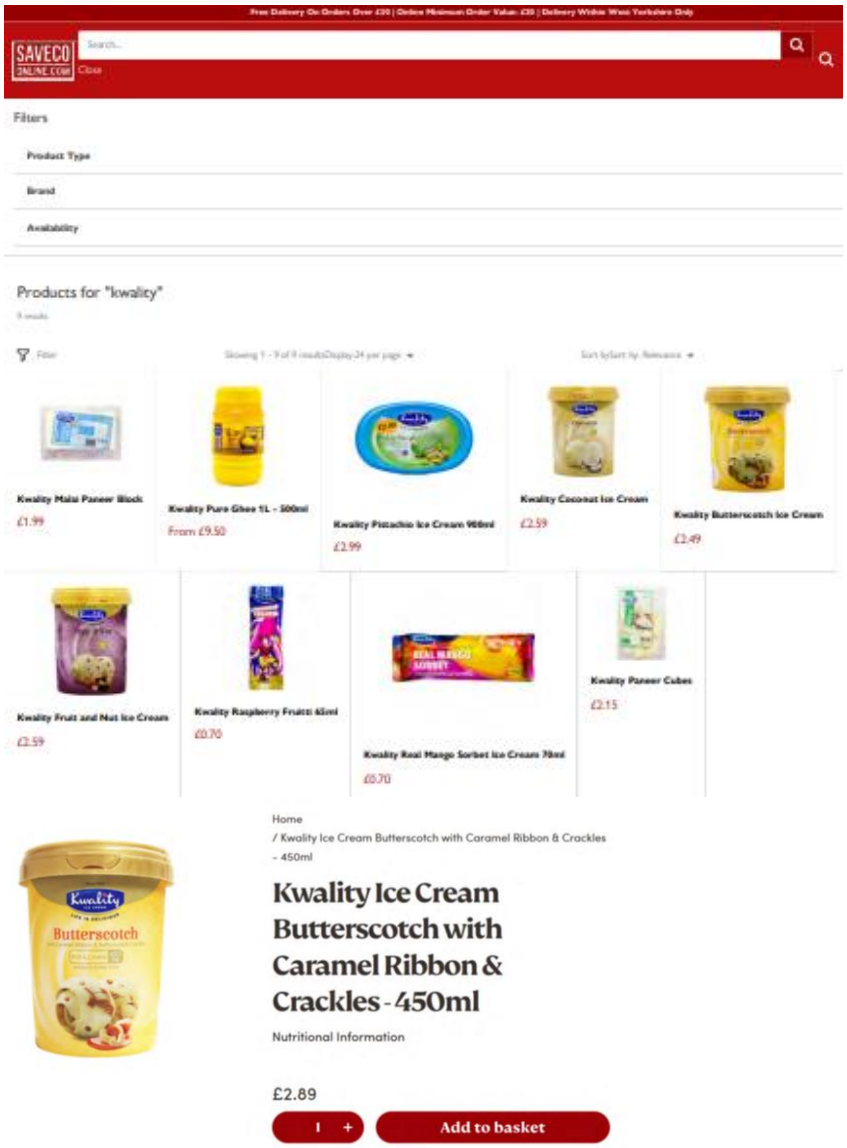
5

Kwality Real Mango Sorbet Ice Cream 70ml

£0.70

6

[5] Exhibit 6 of the witness statement of Mr Goyal, pg 10
[6] Exhibit 6 of the witness statement of Mr Goyal, pg 9



e) The opponent states that Exhibit 8 contains promotional flyers and store branded artwork used to promote the goods displaying the opponent's mark that were distributed in 2021 – within the relevant period. An example can be seen below:

f) Exhibit 11 contains excerpts of the promotional activities of the opponent. In its narrative evidence, the opponent states that it demonstrates food sampling stands at various locations in the UK in 2018 – which is within the relevant period. They appear in the evidence as follows:

g) The opponent has also provided examples of packaging of its paneer product in Exhibit 7 – which the opponent states were used on its products throughout

the UK in the relevant period, specifically, that the product label designs are dated from 2019. In addition, the opponent has provided a list of the goods it provides under its mark in Exhibit 9. The opponent states that the products were sold under its mark at UK retailers and the list is dated April 2019. Further, the opponent states that the goods were able to be purchased during the relevant period. The list can be seen below:

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Form of the mark

21. Before considering whether the opponent has made genuine use of the mark and, if so, for what goods, I shall deal with the question of the form of the mark. The opponent's registration can be seen below. In all instances throughout the evidence where the opponent has used the mark as registered – this is clearly use upon which the opponent can rely:

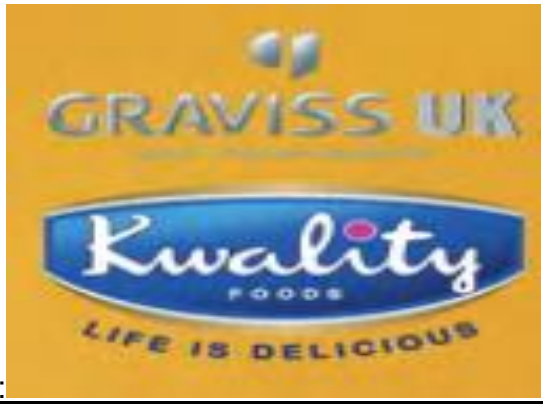
22. Throughout its evidence, the opponent has used its mark in a number of other ways. These are shown below:

Example 1: 

Example 2: 

Example 3: 

Example 4: 

Example 5: 

Example 6: 

23. As per the case of *Colloseum*, use of a mark generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark. As seen above, some of evidence shows the use of the mark with the additional words 'foods' and 'ice cream' under the word 'KWALITY', the words 'since 1995' or 'since 1960' and with the slogan 'LIFE IS DELICIOUS'. In the variants with the slogan, it is my view that the wording 'LIFE IS DELICIOUS' will be viewed as a promotional message, and I consider that the opponent's mark maintains its role as an independent indication of origin within the examples above. I consider that the wording 'since 1995' and 'since 1960' will be viewed as an indication of when the mark began being used and the words 'foods' and 'ice cream' are descriptive of the goods, and I consider that the opponent's mark maintains its role as an independent indication of origin within the examples above. Even taking into account the additional words and slogan, I do not consider that these alter the distinctive character of the mark to the point that it would not be considered use of the mark as registered.

24. In relation to example 5, where the opponent's mark appears below an additional mark, being 'GRAVISS UK' which appears in grey position between a device and the words 'Quality.Passion.Innovation'. As per the case of *Colloseum*, use of a mark generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark. Therefore, the

opponent's mark remains the primary indication for the goods. Throughout all uses shown above, the opponent's mark remains the primary indication of origin for the goods. As a result, and in accordance with *Colloseum*, I consider the marks shown above are all examples of use of the opponent's mark as registered.

Genuine use of the mark

25. For use to be genuine, it must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. In making my assessment, I am required to consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the goods for which use has been shown;
- the nature of those goods and the market(s) for them; and
- the geographical extent of the use shown.

26. I note that the applicant reiterated that it did not consider the evidence to show use of the mark in relation to the goods relied upon. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[7] I note that as the opponent's mark is a comparable mark it is possible for the opponent to rely on evidence of use in the EU as set out in Tribunal Practice Notice 2/2020. [8]

27. I note that the opponent has not provided evidence regarding its turnover during the relevant period other than the invoices referenced above, nor did they provide any summary of the invoices. I have calculated that the invoices demonstrate evidence of the sale in the UK of £2766.76 in dairy products (i.e., ghee, paneer, yoghurt, butter, cream) and £1434.62 in cakes/desserts (e.g., kaju katli, rasmali and milk cake). The invoices indicate sales of ghee, paneer, yoghurt, ice-cream, ice-lollies, cake, pastry, confectionary, savoury snacks (i.e., samosa), bread (i.e., paratha) and dosa mix throughout the UK to consumers in Leicester, Wigan, Leeds, Manchester, Sheffield,

[7] *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09

[8]https://www.gov.uk/government/publications/tribunal-practice-notice-22020-end-of-transition-period-impact-on-tribunal-proceedings/tribunal-practice-notice-22020-end-of-transition-period-impact-on-tribunal-proceedings accessed 1/2/2022.

and Edinburgh. When cross-referencing the invoices to the opponent's catalogue and online evidence, as referred to above in paragraph 20, some of the goods listed on the invoices appear with the opponent's mark throughout the evidence. Specifically, in my view, this evidence indicates that the ghee, paneer, ice-cream, flavoured milk and ice-lollies referenced in the invoices are products that bear the opponent's mark.

28. In relation to the promotional events, the opponent has provided images of promotional events,[9] vehicles bearing the mark[10] and promotional flyers.[11] However, I note that in relation to the promotional events, no mention has been made of where and when the events took place, the reach associated or the number of people in attendance. In relation to the promotional material, I note that there is no information on the scale of the audience nor the distribution or reach of the promotional material. Therefore, this evidence is of some assistance to the opponent in respect of advertising/ marketing, as I am shown some examples of marketing materials in the form on catalogues, in-store displays and promotional flyers. However, as discussed above there are some gaps in the evidence.

29. Although I do not have evidence or submissions from the parties to assist me on the matter of the size of the UK market for the goods concerned, I believe the market to be substantial, numbering in hundreds of millions of pounds per annum. In my view, when compared against the size of the relevant market, the total sales figures of £4201.38 is low. I note that I have not been given total sales figures by the opponent and have created these figures from the sample invoices that I have been provided which show sales for some of the opponent's products. However, the sales appear to have taken place over the entirety of the relevant period. Further, I have considered that the market for the goods across the UK is likely to be extremely competitive with a vast number of producers competing with one another.

Although the evidence is sufficient to establish that there have been some sales of the opponents' goods in the UK in the relevant periods, the relevant test is whether the use shown is sufficient to qualify as genuine. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. Proof of use is required to be shown in the EU for the period up to IP completion day (being 31

[9] Exhibit 11 of the witness statement of Mr Goyal
[10] Exhibit 12 of the witness statement of Mr Goyal
[11] Exhibit 8 of the witness statement of Mr Goyal

December 2020). In addition, I note that use of a mark in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.[12]

30. There are some clear deficiencies in the evidence provided by the opponent. There is a lack of evidence in relation to the distribution of marketing and advertising evidence. However, as noted above genuine use requires a global assessment of the evidence as a whole. The evidence has demonstrated sales of the opponent's goods to consumers in the UK. The consumers are situated in the North East, North West regions of England and in Scotland. The figures in relation to the sales from the opponent are far from overwhelming. Despite this, sales of £4201.38 constitute a genuine attempt to create a market for its goods under their mark, particularly when I consider this in the light of the evidence of promotional materials, catalogues. The sales are not simply attributable to a one-off sale but, instead, the opponent has demonstrated a consistent and repeated pattern of sales to consumers throughout the relevant period. Taking into consideration the above, I am of the view that the opponent has attempted to create and maintain a market for their goods under their mark. Therefore, I am satisfied that the opponent has demonstrated genuine use of its mark during the relevant period in the UK for *"ghee", "paneer", "ice-cream", "ice-lollies"* and *"flavoured milk drinks".* I will now go onto assess whether the terms used in the opponent's specification are fair in light of what use has been shown.

Fair specification

31. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification. He said:

> "244. As I described in Maier v Asos, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the

[12] The General Court restated its interpretation of *Leno Merken* in Case T-398/13, *TVR Automotive Ltd v OHIM,* 57

Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.

245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other categories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark."

32. I note that the opponent's goods are registered for the following goods:

Class 29: *Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.*

33. I shall begin with the specification for class 29. I do not consider that any use has been shown for "*Meat, fish, poultry and game", "meat extracts", " preserved, frozen, dried and cooked fruits and vegetables", "jellies, jams, compotes".* I accept that the general term *"eggs, milk and milk products"* would include *"paneer"* and *"flavoured milk drinks"*. However, it would also include many other goods, such as kefir, and so it would not be fair to allow the opponent to rely on this general term purely on the basis of the use shown in the evidence for paneer and flavoured milk. Similarly, I accept that the general term "*edible oils and fats"* would include *"ghee".* However, it would also include many other goods such as olive or flaxseed oil, and so it would not be fair to allow the opponent to rely on this general term purely on the basis of the use shown for ghee. Therefore, in my view, a fair specification for class 29 is "*ghee", "paneer"* and *"flavoured milk drinks"*.

34. Turning to class 30, I do not consider that any use has been shown for *"coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee", "honey, treacle", " yeast, baking-powder", " salt, mustard", "vinegar, sauces (condiments)"* and *"spices".*

35. I accept that there is mention on the invoices of goods that fall within the term of "*flour and preparations made from cereals, bread, pastry and confectionery, ices"* in the opponent's evidence, specifically milk cake. However, whilst I note that Milk Cake is referenced in the invoices bearing the opponent's mark – the total sales in the invoices amount to £80and are limited. Further, I note that there are no overall sales figures that have been provided. In addition, I have no corroborating evidence in the form of catalogues, websites and other promotional materials to show whether the opponent's mark has been used on packaging in relation to these goods. I remind myself that the burden of proof lies on the burden lies on the registered proprietor to prove use. Consequently, taking all these factors into account, I do not consider that the opponent has proved use in relation to these goods.

36. There is evidence of ice-cream and ice-lollies bearing the opponent's mark. I accept that the general term "*flour and preparations made from cereals, bread, pastry and confectionery, ices",* in particular *"ices",* would include "*ice-cream"* and *"ice-lollies".* I consider that it is fair for the opponent to rely on the term *"ices".*

Section 5(2)(b): legislation and case law

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

> "(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 or association with the earlier trade mark."

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."

38. 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 impression 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

COMPARISON OF GOODS

39. The goods to be compared are as follows:

The applicant's goods	The opponent's goods
Class 30: *Bakery goods; cookies; biscuits; toast biscuits; instant noodles*	Class 29: *ghee; paneer; flavoured milk drinks.* Class 30: *ices.*

40. 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 of its judgment 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".

41. Guidance on this issue has also come from Jacob J. (as he was then) 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."

42. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

"… there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking."

43. *"Bakery goods*", "*cookies"* and *"biscuits"* in the applicant's specification will include cakes and pastry-based products which fall within the dessert market. They may be selected by customers as a dessert course or a sweet snack. There will, therefore, be competition between the applicant's goods and *"ices"* in the opponent's specification. They will overlap in uses and users. In addition, I consider that they will share the same method of use, as they will both be consumed orally. However, whilst the goods may be sold in the same retail stores, they are offered on different shelves in shops or supermarkets, one originating in the frozen section and the other in the bakery section. Further, the nature is different, as the opponent's goods will be frozen and the applicant's goods will not. Finally, I do not consider that the goods are complementary to one another. Therefore, I consider that these goods are similar to a medium degree.

44. It is my understanding that *"toast biscuits"* in the applicant's specification is a traditional dried bread or cake, that is used as a snack or dessert option. I consider that the applicant's goods and the closest goods that I can find in the opponent's specification, being *"ices"* are similar. Applying the reasoning above, at paragraph 43, I consider the goods to be similar to a medium degree.

45. I do not consider that "*Instant noodles*" in the applicant's specification is similar to any of the goods in the opponent's specification. Although they are all foodstuffs, this is not enough for a finding of similarity. The mere fact that they are needed for the preparation of a foodstuff or are a foodstuff will generally not be sufficient in itself to show that the goods are similar, although they fall under the general category of

foodstuffs. Although the general purpose of consumption is the same and the goods may be sold in the same retail stores, they are offered on different shelves in shops or supermarkets. The nature of the goods is also different and so is their origin. Furthermore, they are neither in competition nor complementary. Therefore, I consider that the goods are dissimilar.

46. As some degree of similarity between the goods is necessary to engage the test for a likelihood of confusion, my findings above mean that the opposition aimed against those goods I have found to be dissimilar will fail.[13] For ease of reference, the opposition under section 5(2)(b) fails against the following goods in the applicant's specification:

Class 30: *Instant noodles*

THE AVERAGE CONSUMER AND THE PURCHASING PROCESS

47. As the law above indicates, it is necessary for me to determine who the average consumer is for the 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 (as he then was) described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

48. The average consumer of the goods at issue is a member of the general public and businesses such as restaurants. The goods at issue will typically be offered by retailers or their online equivalents. I consider that the selection process will be primarily visual, although I do not discount an aural element.

[13] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA

49. The average cost of the goods is relatively low, and the frequency of the purchase is high. When selecting the goods, I consider that the average consumer will consider factors such as whether they will enjoy it as well as calorific and nutritional contents. In addition, I consider that consumers with medical issues and/or dietary requirements will give more thought to the selection of the goods. Accordingly, the average consumer will pay a medium level of attention to the purchasing process of the goods.

COMPARISON OF THE MARKS

50. The marks to be compared are as follows:

The applicant's mark	The opponent's mark
	

51. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) 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 trade marks must be assessed by reference to all 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."

52. 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.

53. The applicant's mark contains two stylised words. The first of these, 'Natural', appears in yellow, on a green background, surrounded by a white border. This is presented over the text 'Kwaliti' which appears in stylised red text surrounded by white. The words appear on a green two-tone oval background, which is presented on a black rectangular background. I note that the word 'Kwaliti' is presented slightly larger than the word 'Natural'. The text will be viewed as a unit by the average consumer as they will be read by the top word first; I consider that the words will be pronounced 'Natural Kwaliti'. I am of the view that the average consumer would interpret the word 'Kwaliti' to be a misspelling of the word 'quality'. I consider that 'natural' will be viewed as an indication to the average consumer of what kind of 'Kwality' (quality) that they would find in the product. The phrase 'natural quality' would be descriptive, and I consider that it is the misspelling that plays the biggest role in the overall impression of the mark. The stylisation, colours and backgrounds all play a lesser role in the mark.

54. The opponent's mark consists of the white stylised text 'Kwality', with a purple tittle. The text is presented in a blue oval background which has a golden border. I consider that the text 'Kwality' has a greater impact on the overall impression of the mark, with the stylisation, colour and background all playing a lesser role.

55. Visually the marks share the letters 'Kwalit' – I note that the letter following the shared text differs and consists of 'I' and 'Y' respectively. Whilst both marks contain an oval shaped background, all of the other elements in the applicant's mark are not present in the opponent's mark, and vice versa. As mentioned above, 'Natural Kwaliti' will be seen by the average consumer as a unit. While the stylisation, colours and backgrounds all play lesser roles, they still constitute visual differences. Taking all of this into account, I am of the view that the marks are visually similar to a low to medium degree.

56. Aurally, the applicant's mark will be pronounced as 'NA-CHUH-RUL KWO-LUH-TEE' and the opponent's mark will be pronounced as 'KWO-LUH-TEE'. Whilst the marks differ in the pronunciation of the first word in the applicant's mark, they share the pronunciation of 'KWO-LUH-TEE'. The stylisation, colour and background will not be pronounced. Subsequently, I consider that the marks are aurally similar to a medium degree.

57. Conceptually, the opponent's mark will be perceived by the average consumer as a misspelling of the word 'quality'. Applying this, I consider that the word is descriptive of the goods being of high quality. In addition, I consider that the word is laudatory. I do not consider that the stylisation, colour, or background will impact the conceptual comparison. In relation to the applicant's mark, I consider that 'Kwaliti' will also be perceived as a misspelling of the word 'quality'. Similarly, I consider that the word 'quality' is allusive of the goods being of high quality and is laudatory. I consider that 'Natural' will be descriptive in relation to the goods at issue as the goods may be characterised by minimal processing, an absence of any artificial additives and originate from whole ingredients. Collectively the phrase will be perceived as something natural being of a high quality or denoting that the goods have a quality of naturalness. As above, I consider that the stylisation, colour, and background will not impact the goods conceptually. Therefore, I find that the goods coincide conceptually in relation to the perception of 'quality'. I find the marks to be conceptually similar to a high degree on this basis.

DISTINCTIVE CHARACTER OF THE EARLIER MARK

58. 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 1-2779, 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)."

59. 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 or services, to those with a high inherent distinctive character, such as invented words which have no allusive qualities.

60. The opponent has pleaded that its mark has acquired enhanced distinctive character through use. I have considered the evidence in support of a claim of enhanced distinctive character, however, firstly, I will consider the inherent position.

61. The earlier mark consists of the white stylised text 'Kwality', with a purple tittle. The text is presented on a blue oval background which has a golden border. As discussed above, I consider that the main contributing factor to the distinctive character is the misspelling of the word 'Quality' as 'Kwality' - which I consider to be laudatory and allusive of the goods at issue. I consider this word to be similar to a medium degree. As discussed earlier, the stylisation, colour and background play a lesser role in the overall impression of the mark – I do not consider these elements raise the distinctive character of the earlier mark any higher.

62. I shall now consider whether the inherent distinctive character has been enhanced through the use made of the mark. For the present circumstances, it is use in the UK that is relevant. While I found the evidence was enough to prove use, as there is no *de minimis* level, the assessment of enhanced distinctiveness requires sufficient use for the capacity of the mark to identify the goods as originating from a particular undertaking. This is a higher test and, in my view, the evidence falls short of what would be required to pass this test. These are relatively low figures, although I

accept that the goods are likely to be fairly cheap. For example, the paneer demonstrating the opponent's mark on a third party website is shown as costing £1.99.[14] Whilst I recognise that the opponent has provided evidence of the user base in the UK, I note that the evidence is not particularly widespread as it demonstrates sales in the North East, North West, and Scotland. Further, I am mindful that the opponent has not demonstrated expenditure on marketing to promote the market across the United Kingdom. I note that the user base evidence does not suggest that use of the mark has been intensive. In addition, the opponent has provided no evidence of the proportion of the relevant class of persons who, because of the mark, identify its goods as originating from a particular undertaking nor has it provided any evidence of the market share of the opponent's mark. Taking this all into account, it is my view that the opponent's evidence falls short of what would be required to show that the medium degree of inherent distinctive character has been enhanced through use.

LIKELIHOOD OF CONFUSION

63. 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 the marks 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 respective trade marks may be offset by a greater degree of similarity between the respective goods and services or vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be mindful of 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.

[14] Exhibit 6, pg 8

64. I have found the marks to be visually similar to a low to medium degree. I have found the marks to be aurally similar to a medium degree and conceptually similar to a high degree. I have found the opponent's mark to have a medium degree of inherent distinctive character. I have found the average consumer to be the general public and businesses and restaurants. I have found the goods are likely to be selected visually, although I do not discount an aural component. Where I have found goods to be similar, I have found them to be similar to a medium degree. I have found that the degree of attention paid during the purchasing process will be medium.

65. Taking all the above into account, I consider that the differences between the marks are sufficient to avoid confusion, even when the principle of imperfect recollection is considered. I do not consider that the average consumer will mistake one mark for the other. I recognise that the marks share the letters 'Kwalit' , which is in favour of the opponent. Despite this, I consider that the word 'natural' in the applicant's mark will not be overlooked and is sufficient to enable the average consumer to differentiate between them – despite me finding that the misspelling of 'Kwaliti' plays the biggest role in the overall impression of the mark. In my view, the visual and aural differences, in particular the presence of the word 'natural' which I have found will be read as a unit as 'Natural Kwaliti', will be sufficient to prevent the marks from being mistakenly recalled or misremembered as each other. Consequently, I do not consider there to be a likelihood of direct confusion between the marks.

66. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C.,(as he was then) sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

> "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.”

67. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

68. Mr Purvis Q.C.(as he was then) in *L.A Sugar Limited* sets out that there are three main categories of indirect confusion, and that indirect confusion ‘tends’ to fall in one of them. I note that the opponent hasn’t stated specifically what category this case would fall within.

69. Even if the differences are taken into account, I consider the presence in the applicant’s mark of the similar ‘Kwality’/’Kwaliti’ elements will lead the average consumer to think that the marks come from the same or related undertaking. As noted above, I found that the distinctive element in the marks is the misspelling of the words – the only remaining difference between the ‘Kwalkity’/’Kwaliti’ element is at the end of the words – which could be recalled imperfectly. Further, I am of the view that the word “natural” in the applicant’s mark, will be put down to a form of brand variation or alternative mark, particularly given its descriptive nature in relation to the goods at issue – potentially being a more health-conscious sub-brand producing goods free of artificial additives and made of wholefoods. Finally, in the event that the differences in stylisation and presentation of the marks (such as the stylisation, colours and backgrounds) are noticed, I am of the view that they will be seen as indicative of an alternative mark being used by the same or economically linked undertakings and consistent with a re-branding. Consequently, I find that there is a likelihood of indirect confusion for all the goods that I have found to be similar.

70. The opposition succeeds in part on the grounds of 5(2)(b). The opposition succeeds in relation to the following goods only:

Class 30: *Bakery goods; cookies; biscuits; toast biscuits.*

Section 5(3)

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

> "5(3) A trade mark which – is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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."

72. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel,* Case C-408/01, *Adidas Salomon,* Case C-487/07, *L'Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora,* Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows.

> (a)The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*
>
> (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
>
> (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon, paragraph 29 and Intel, paragraph 63.*
>
> (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34. 51*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40.*

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics

which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation *(Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).*

73. The conditions of section 5(3) are cumulative. First, the opponent must show that the earlier mark is similar to the application. I have already found the marks similar under section 5(2)(b). Secondly, it must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the application. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

74. The relevant date for the assessment under section 5(3) is the date of the application at issue, being 25 June 2022.

Reputation

75. In *General Motors*, Case C-375/97, the CJEU held that:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

Reputation

76. Under its 5(3) ground the opponent relies on the same mark as it did under section 5(2)(b) ground, being the mark below. In addition, it claims to have obtained a reputation in the same set of goods in classes 29 and 30 as relied upon in the same ground.

77. In determining whether the opponent has demonstrated a reputation for the goods at issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including *"the marks share held by the trademark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it".* The opponent's mark is a comparable mark, subsequently, I recognise that any evidence pertaining to the EU up to the IP completion date is relevant to consider concerning the reputation of the mark. Despite this, I note that all of the evidence provided pertains to the UK and therefore, there is no evidence pertaining to the EU for me to consider.

78. I can deal with this ground relatively swiftly.

79. Earlier in my decision, I found that the distinctive character of the opponent's mark had not been enhanced through use. I recognise that reputation is not the same

as enhanced distinctive character, but the same factors are to be taken into account in both assessments. Therefore, the evidence is, for the reasons set out in relation to enhanced distinctiveness, insufficient to establish a reputation in the UK. Consequently, the opposition based upon section 5(3) falls at the first hurdle.

80. The opposition based upon section 5(3) of the Act is dismissed.

CONCLUSION

81. The opposition is partially successful under section 5(2)(b) in respect of the following goods, for which the application is refused:

Class 30: *Bakery goods; cookies; biscuits; toast biscuits.*

82. The application can proceed to registration in respect of the following goods, for which the opposition has been unsuccessful under section 5(2)(b).

Class 30: *Instant noodles*

COSTS

83. The opponent has enjoyed a greater degree of success in the opposition and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £1150 as a contribution towards the costs of the proceedings.

The sum is calculated as follows:

Filing a notice of opposition and considering the applicant's counterstatement	£200
Preparing and filing evidence[15]	£500
Preparing and filing submissions in lieu of a hearing	£350
Official Fee	£100[16]

[15] The pay award for evidence is lower on the scale due to the opposition firstly being partially successful, and secondly, the evidence provided was limited and unhelpful in terms of establishing enhanced distinctiveness, reputation, and goodwill.

[16] The opponent is being awarded £100 of the £200 official fee as the section 5(3) opposition was unsuccessful.

Total **£1150**

84. I therefore order Md Faurahad Meia to pay Graviss Holdings Private Limited the sum of £1150. 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 27th day of June 2024

A KLASS
For the Registrar