O/0748/25

TRADE MARKS ACT 1994

IN THE MATTER OF UK TRADE MARK APPLICATION NO. 3957846
IN THE NAME OF TARIQ MAJID
IN RESPECT OF THE TRADE MARK

IN CLASSES 29, 30 & 43

AND

THE OPPOSITION THERETO UNDER NO. 445404
BY CONVENIENCE FOOD INDUSTRIES (PVT) LTD

Background and pleadings

1. On 18 September 2023, Tariq Majid ("the applicant") applied to register trade mark no. 3957846 for the mark shown on the cover page of this decision, in the UK. It was accepted and published in the Trade Marks Journal on 20 October 2023 in respect of the following goods and services:

> Class 29: *Burgers; Chicken burgers; Meat burgers; Fried chicken; French fries; Potato fries; Fried meat; Chicken; Lamb products; Lamb skewers; Cooked meat dishes; Prepared meals consisting primarily of kebab; Potato fritters; Pre-cooked curry stew; Potato snack foods; Vegetable-based snack foods; Meat-based snack food; Fish-based snack food.*
>
> Class 30: *Bakery desserts, Mithai sweets, biscuits, Samosas; Prepared desserts; Cream cakes; Cakes; Pizza; Naan bread; Curry.*
>
> Class 43: *Catering for the provision of food and beverages; Coffee shop services; Delicatessens [restaurants]; Fast food restaurant services; Food cooking services; food takeaway service; Mobile catering services; Mobile restaurant services; Organisation of catering for birthday parties; Outside catering services; Restaurants; Serving food and drinks; Snack-bars; Tea room services.*

2. Convenience Food Industries (Pvt) Ltd ("the opponent") oppose the trade mark on the basis of sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). This is on the basis of its two UK trade marks as set out below:

1. UK trade mark application no. 2395618 ("the earlier '618 marks")

   LAZIZA / LAZIZA INTERNATIONAL (series of two)

   Filing date: 29 June 2005
   Registration date: 02 June 2006
   Relying on all goods, those being as follows:

Class 29: *Meat, fish, poultry and game; meat extracts; preserved, dried, canned, frozen and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals and snacks included in Class 29; mixes for meals and snacks; mixes for making desserts and sweets; prepared desserts included in Class 29; rice puddings; yoghurts, desserts made from yoghurt; beverages made from yoghurt; food products containing yoghurt; pickles, chutneys and preserves; dried herbs; ghee; barian.*

Class 30: *Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour, cereals and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; sauces and preparations for making sauces; ice; prepared meals and snacks included in Class 30; pasta; kheer mix, rasmalai mix, gulab jamun mix, gajar halwa mix, kulfa mix, mixes for making desserts and sweets; vermicelli; masala, qorma masala, biryani masala, nehrai masala, tandoori masala; red chilli powder and coriander powder; curry powder, chaat masala, pulses, papad; chutneys; food pastes and flavourings for food; prepared desserts included in Class 30; ice cream; sorbets; ice cream confectionery and confections; ice cream desserts; ice cream gateaux; mixtures for making ice cream and ice cream confections; custard; custard mixes; mixes for making desserts; frozen yoghurts; achar pachranga.*

2. UK trade mark application no. 2019550 (“the earlier ‘550 mark”)

Filing date: 3 May 1995
Registration date: 14 August 1998
Relying on all goods, those being as follows:

Class 29: *Prepared meals; prepared desserts; pickles, chutneys and preserves; dried herbs; ghee; achar pachranga.*

Class 30: *Spices; sauces and preparations for making sauces; food pastes and flavourings for food; pasta; kheer mix, rasmali mix, gulub jamun mix, gajar halwa mix, kulfa mix, mixes for making desserts and sweets; vermicelli; masala, qorma masala, biryani masala, nehari masala, tandoori masala; red chilli powder and coriander powder, curry powder, chaat masala, rice, pulses, papad and barian.*

3. By virtue of their earlier filing dates, the above registrations constitute earlier marks in accordance with section 6 of the Act.

4. In respect of the opposition under section 5(2)(b), the opponent argues that the respective goods and services are similar and that the marks are similar, and that as such there exists a likelihood of confusion including a likelihood of association between the marks.

5. In respect of the opposition under section 5(3) of the Act, the opponent argues it holds a reputation for all of its registered goods under both marks, particularly amongst persons of a Pakistani and/or Indian heritage in the UK. It argues that use of the contested mark would create a link with the earlier marks in the eyes of the relevant consumer, which would in turn result in an unfair advantage for the applicant, as well as cause detriment to the earlier mark by way of diluting the distinctiveness of the same.

6. The applicant filed a counterstatement, denying that the marks are identical or similar in a way that will cause confusion or an association between the same. The applicant does not deny that the opponent has built up a reputation for its “brand”. The applicant requested that the opponent provide proof of use in these proceedings.

7. Both parties filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.

8. A shortform Hearing took place before me via telephone conference on 24 June 2025. The opponent is represented in these proceedings by Beck Greener LLP and was represented at the hearing by Roland Buehrlen of the same. The applicant is represented in these proceedings by Versus Law Solicitors and was represented at the hearing by Asiya Kaleem of the same.

9. 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.

Evidence

10. The opponent filed its evidence in chief in the form of a witness statement in the name of Agha Irshad Khan, Director of the opponent. The witness statement introduces 16 exhibits, namely Exhibit AIK1 – Exhibit AIK16. It is dated 5 August 2024. The statement goes to the use of the opponent's marks, as well as the use of the applicant's mark.

11. The applicant filed his evidence in the form of a witness statement in his own name. The statement introduces ten exhibits, namely Exhibit 1/TM to Exhibit 10/TM, and primarily goes to the use of his mark. It is dated 10 October 2024.

12. The opponent filed evidence in reply in these proceedings. This is in the form of a witness statement in the name of Christian Rowland Buehrlen, Partner at the opponent's representative firm. This introduces three exhibits, namely Exhibit CRB1 to Exhibit CRB3. This goes to the use of both the opponent's and the applicant's marks. It is dated 14 January 2025.

Proof of use

13. As the earlier marks had been registered for a period of more than five years at the date on which the application was filed, they are subject to the use provisions as set out under section 6A of the Act.

14. However, in this instance, although proof of use was requested by the applicant in his TM8, the skeleton arguments provided by Ms Kaleem prior to the hearing made no reference to the opponent's evidence of use or its sufficiency. At the hearing, I asked Ms Kaleem if I should take from this that the applicant is not disputing the evidence of use filed. Ms Kaleem confirmed that that is correct, and the applicant is not denying that the opponent had used its mark.

15. However, whilst Mr Buehrlen for the opponent acknowledged the applicant's acceptance of the opponent's evidence of use at the hearing, he stated that he could not find all of the opponent's goods relied upon in the evidence filed, and proceeded to cut down the goods relied upon accordingly.

16. Considering the events that took place at the hearing and as outlined above, I accept that the final list of goods that may be relied upon by the opponent under each mark in these proceedings are those set out by Mr Buehrlen at the hearing. These are as follows:

Under the earlier '618 marks

Class 29: *Preserved, dried, canned, cooked fruits and vegetables; jellies, jams, fruit sauces; milk products; edible oils; prepared meals and snacks included in Class 29; mixes for meals and snacks; mixes for making desserts and sweets; prepared desserts included in Class 29; rice puddings; desserts made from yoghurt; food products containing yoghurt; pickles, chutneys and preserves; barian.*

Class 30: *rice, cereals and preparations made from cereals, confectionery, sauces (condiments); spices; sauces and preparations for*

making sauces; ice; prepared meals and snacks included in Class 30; kheer mix, rasmalai mix, gulab jamun mix, gajar halwa mix, kulfa mix, mixes for making desserts and sweets; vermicelli; masala, qorma masala, biryani masala, nehrai masala, tandoori masala; red chilli powder and coriander powder; curry powder, chaat masala, pulses, papad; chutneys; food pastes and flavourings for food; prepared desserts included in Class 30; custard; custard mixes; mixes for making desserts; frozen yoghurts; achar pachranga.

Under the earlier '550 mark

Class 29: *Prepared meals; prepared desserts; pickles, chutneys and preserves; achar pachranga.*

Class 30: *Spices; sauces and preparations for making sauces; food pastes and flavourings for food; kheer mix, rasmali mix, gulub jamun mix, gajar halwa mix, kulfa mix, mixes for making desserts and sweets; vermicelli; masala, qorma masala, biryani masala, nehari masala, tandoori masala; red chilli powder and coriander powder, curry powder, chaat masala, rice, pulses, papad and barian.*

17. It is on this basis that I intend to proceed.

Approach

18. I note the opponent's earlier marks relied upon include both a series of two word only marks, and a stylised mark. The applicant's mark is a stylised mark. In my view, the stylisation and additional elements featured in the opponent's '550 mark only serve to decrease the similarity between this mark and the applicant's; visually, aurally and conceptually. Further, the specification relied upon by the earlier '618 marks is slightly broader than that relied upon under the '550 mark and will in my view, contain a higher level of identity. In addition, having been through the evidence filed, not only do I note that this shows use of both the earlier '550 and at '618 marks, I also consider the use of the '550 mark to be an acceptable variant of the first '618 mark in line with

Colloseum.[1] With all this in mind, I intend to initially consider the opposition based on the earlier '618 mark, specifically the first in the series, and I will revert to consider what my findings mean for the second in the series of the '618 marks and the earlier '550 mark relied upon should it become necessary to do so.

Decision

Section 5(2)(b)

19. Section 5(2)(b) of the Act is as follows:

> *"5(2) A trade mark shall not be registered if because-*
>
> *(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".*

20. 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."*

The Principles

21. 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*

[1] *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12

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.

The principles

(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 great degree of similarity between the marks, and vice versa;

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

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

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

(k) if the association between the marks creates a risk that the public 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 and services

22. 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".*

23. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

24. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"… Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

25. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06, the General Court ("GC") stated that there is complementarity where:

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

26. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the GC 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 fur 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".

27. With this in mind, the goods and services for comparison are as follows:

Earlier goods	**Contested goods**
Under the earlier '618 marks Class 29: *Preserved, dried, canned, cooked fruits and vegetables; jellies, jams, fruit sauces; milk products; edible oils; prepared meals and snacks included in Class 29; mixes for meals and snacks; mixes for making desserts and sweets; prepared desserts included in Class 29; rice puddings; desserts made from yoghurt; food products containing yoghurt; pickles, chutneys and preserves; barian.*	Class 29: *Burgers; Chicken burgers; Meat burgers; Fried chicken; French fries; Potato fries; Fried meat; Chicken; Lamb products; Lamb skewers; Cooked meat dishes; Prepared meals consisting primarily of kebab; Potato fritters; Pre-cooked curry stew; Potato snack foods; Vegetable-based snack foods; Meat-based snack food; Fish-based snack food.* Class 30: *Bakery desserts, Mithai sweets, biscuits, Samosas; Prepared desserts; Cream cakes; Cakes; Pizza; Naan bread; Curry.*

Class 30: *rice, cereals and preparations made from cereals, confectionery, sauces (condiments); spices; sauces and preparations for making sauces; ice; prepared meals and snacks included in Class 30; kheer mix, rasmalai mix, gulab jamun mix, gajar halwa mix, kulfa mix, mixes for making desserts and sweets; vermicelli; masala, qorma masala, biryani masala, nehrai masala, tandoori masala; red chilli powder and coriander powder; curry powder, chaat masala, pulses, papad; chutneys; food pastes and flavourings for food; prepared desserts included in Class 30; custard; custard mixes; mixes for making desserts; frozen yoghurts; achar pachranga.*	Class 43: *Catering for the provision of food and beverages; Coffee shop services; Delicatessens [restaurants]; Fast food restaurant services; Food cooking services; food takeaway service; Mobile catering services; Mobile restaurant services; Organisation of catering for birthday parties; Outside catering services; Restaurants; Serving food and drinks; Snack-bars; Tea room services.*

28. At the hearing, the parties made a number of submissions comparing the goods and services currently being offered under the marks. However, I must conduct a notional assessment based on the applied for goods and services, and the terms to which the parties have agreed may still be relied upon by the opponent.

29. The earlier mark covers the goods *prepared meals and snacks included in class 29.* These are identical to the following contested goods in accordance with the principles set out in *Meric*:

> *Class 29: Fried chicken; French fries; Potato fries; Fried meat; Cooked meat dishes; Prepared meals consisting primarily of kebab; Potato fritters; Pre-cooked curry stew; Potato snack foods; Vegetable-based snack foods; Meat-based snack food; Fish-based snack food.*

30. Next, I consider the remaining contested goods in class 29 those being:

> *Lamb products; Lamb skewers; Burgers; Chicken burgers; Meat burgers* and *Chicken*.

31. It is my view that these categories of goods will all include those which are prepared and/or ready to eat. I note this finding is supported by the comments of Emma Himsworth QC (as she then was) sitting as the appointed person in *SAINSBURY'S TOP DOG*, BL O/044/16. In that decision, and in the context of comparing food goods with services for the provision of food in class 43, Ms Himsworth confirmed a distinction could not be made in respect of the broader categories of meat, poultry and game for example, and the prepared foods that clearly fall within those categories. I agree with this reasoning, and I find it applies to these goods. On this basis, I consider that goods falling under the above terms may include those which would be considered *prepared meals and snacks included in class 29* covered by the earlier mark. I therefore consider these identical in accordance with the principles set out in *Meric*.

32. However, if I am wrong to find identity with contested class 29 goods and the opponent's *prepared meals and snacks included in class 29*, it is my view that the goods would in any case be similar. They will comprise all include food goods which may already be prepared or have prepared elements, which if not strictly a snack or meal, will be used as a component of a meal or snack. They will therefore overlap in nature with the earlier goods which may include products comprising meat, and there will be a shared purpose, on the basis that they may all be consumed to satiate hunger in a quick and convenient way. There will be an element of competition between the goods where the consumer chooses between these and the opponent's *prepared meals and snacks included in class 29*, and depending on the ingredients used in the prepared meals and snacks, they may be placed in similar areas of a large supermarket, although they may not be directly next to each other. The method of use may be shared, trade channels may be shared and users will be shared, particularly by way of the general public. I do not however, consider it likely that the goods will be

complementary. Therefore, if I am wrong to find these goods identical, I nonetheless find them to be similar to a high degree.

33. The earlier mark also covers *prepared meals and snacks included in Class 30.* It is my view that all of the contested class 30 goods may all be considered to be prepared meals or snacks, and will therefore be identical to the opponent's earlier goods, in accordance with the principles set out in *Meric*.

34. However, I will also consider the position if I am wrong to find *all* contested goods in class 30 all fall within the meaning of the opponent's *prepared meals and snacks included in Class 30.*

35. Firstly, if I am wrong to find that *Naan bread* falls into the ordinary and natural meaning of *prepared meals and snacks,* it is instead my view that this will still be considered as a prepared component part of a meal. I consider that *Naan bread* may to an extent overlap in nature with a prepared meal, which may contain bread based elements. Further, it will share a purpose to the extent that it is for eating at mealtimes to satiate hunger. There may be an element of competition where the consumer chooses between purchasing prepared parts of meals individually or choosing a full prepared meal. The trade channels may well be shared, with entities likely responsible for selling both *prepared meals* such as readymade curries and *naan breads* for example. There may be an element of complementarity to the extent that the goods may be important to one another where sold as part of a meal deal for example, to the extent that the consumer may believe they derive from the same entity. Overall, I consider these goods to be similar to *prepared meals* in particular to a high degree.

36. Further, if I am wrong to find the goods *bakery desserts* to fall into the ordinary and natural meaning of *prepared meals and snacks* in class 30, on the basis that a dessert is typically eaten as only part of a meal, again, I still find these to be similar. They share a purpose with *prepared meals and snacks*, to be eaten both for enjoyment and to satiate hunger. They may also overlap in nature with prepared snacks, which may include sweet items of a similar texture. They will share users typically by way of the general public, and they share trade channels, likely being placed near sweet snacks in the supermarket. They will not, in my view, be complementary, but there may be an

element of competition between sweet snack items and bakery desserts, with both possibly being purchased to satisfy a sweet tooth after a meal. If there is no identity between these goods, I consider them to be similar to at least a medium degree.

37. The contested services include the following in class 43:

> *Catering for the provision of food and beverages; Coffee shop services; Delicatessens [restaurants]; Fast food restaurant services; Food cooking services; food takeaway service; Mobile catering services; Mobile restaurant services; Organisation of catering for birthday parties; Outside catering services; Restaurants; Serving food and drinks; Snack-bars; Tea room services.*

38. In his skeleton arguments and at the hearing, Mr Buehrlen referred me to General Court case no. T-555/19 concerning the mark GRILLOUMI. In that case, Mr Buehrlen pointed out that the General Court found that cheese should be found similar to *services for food and drink*, *restaurant services* and *coffee shop services* on the basis that:

> *"45 As is apparent from the case-law of the Court, it must be stated that the goods in Class 29, inter alia, cheese, are necessarily used in the serving of food and drink, with the result that those goods and those services are complementary. First, cheese may be offered to the clientele of many restaurants, or even of coffee shops, by being incorporated as an ingredient in dishes that are intended to be sold on the premises or to be taken away. Secondly, cheese, without being processed as an ingredient, may be sold as it is to consumers, in particular in restaurants in which the activity is not confined to the preparation and serving of cooked dishes, but also consists of selling food which is intended to be consumed away from the place in which it is sold. Such goods are therefore used in and offered by means of services for providing food and drink, restaurant services or coffee-shop services. Those goods are consequently closely connected with those services."*

39. I note firstly that I am not bound by the findings of fact from the General Court, and secondly that the earlier mark does not hold protection for the goods *cheese*. However, it is nonetheless the case that I agree with the reasoning set out by the General Court above, and I find that it applies here, where the earlier mark covers more general terms including *prepared meals and snacks* and *prepared desserts* in both classes 29 and 30, as well as goods such as *spices* and *sauces* in class 30. Clearly the nature and method of use of the opponent's goods and the applicant's services above will differ. However, I consider that prepared meals and snacks and/or spices and sauces are at least important to or essential to the above services for the provision of food and drink to varying extents. Further, I consider that the consumer will find it likely that the prepared food goods as well as spices and sauces may be offered by the same undertaking as the services for the provision of these goods, with it not being uncommon in my experience to find restaurants, coffee shops and other outlets offering food services, also offering their own ranges of prepared meals and snacks, sauces and spices. As such I find these to be complementary to all of the services. Further, there is a level of competition existing between all of the goods and services, for example where the consumer chooses between purchasing prepared food goods from the supermarket for example (or sauces and spices to make them), or engaging services to provide food for them. The users will clearly be shared, as will the ultimate purpose, for providing the consumer with something to eat or drink. Considering all of these factors, I find the goods and services to be similar to at least a medium degree.

Comparison of marks

40. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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."

41. It would be wrong, therefore, to dissect the trade marks artificially, 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.

42. The respective trade marks are shown below:

Earlier trade mark	**Contested trade mark**
LAZIZA	

43. The earlier mark comprises the simple word LAZIZA. It is in this element that the overall impression resides.

44. The contested mark includes the large red stylised word LAZEEZA, topped with a device of a spoon and fork and a chef's hat, and including the words MITHAI, CAKES and FOOD underneath the same. The words MITHAI, CAKES and FOOD are separated by a small vertical red line between each. Being the biggest and most distinctive element of the mark, the word LAZEEZA plays the largest role in its overall impression, followed by the device element and the stylisation of the mark. The descriptive wording underneath plays at best, a very minimal role in the same.

Visual comparison

45. Visually, the marks coincide though the use of the letters LAZ at the beginning of the marks and the letters ZA at the end of the marks. The earlier mark is filed as a

word mark which protects the words contained in the mark, whatever form, colour or typeface are used: see *LA Superquimica v EUIPO*, Case T-24/17, paragraph 39. This means the difference in stylisation and colour of the LAZEEZA element in the contested mark has less impact on the visual comparison. The earlier mark differs from the dominant element in the contested mark as it uses the letter 'I' between the 'Z's, whereas the contested mark uses 'EE' in the same position. Further, the very small writing below the contested mark acts as a minimal point of visual difference, and the device above the word in the contested mark makes a slightly larger but still relatively small visual difference. Overall, I find the marks visually similar to between a medium and high degree.

Aural similarity

46. At the hearing, Mr Buehrlen for the opponent submitted that the marks will be pronounced identically. Ms Kaleem for the applicant submitted that as there is no evidence on how the marks will be pronounced, it is open to interpretation, and the marks may be pronounced identically or differently. It is my view that at least a significant portion of consumers will pronounce the dominant elements of the marks identically, as LAH-ZEE-ZAH in both cases. I find it unlikely that the wording MITHAI CAKES FOOD in the contested mark will be verbalised, but I accept that if they are this will act as a point of aural difference, rendering the marks aurally similar to between a medium and high degree overall.

Conceptual similarity

47. Within her skeleton arguments, Ms Kaleem submitted for the applicant that the marks derive from a common root in Urudu/Arabic meaning delicious. I noted at the hearing that I had not been provided with any evidence on this point, and that I was minded to therefore give it no weight within my decision. I provided Ms Kaleem with an opportunity to make submissions as to why I should not take this view, but she opted not to. I will not, therefore, consider this argument any further. I note however, that even if I were to give weight to these submissions without evidence, I would undoubtedly find that this meaning would not be known by significant portion of UK consumers.

48. It is my view that the LAZIZA/LAZEEZA element of the marks will either be considered as a made up word, or possibly a word of foreign origin, the meaning of which is unknown. These elements are conceptually neutral on this basis. However, the use of the chef's hat, the spoon and fork and the wording underneath this element, all act as a point of conceptual difference between the marks overall, with the contested mark conveying the concept of food products and/or services.

Average consumer and the purchasing act

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

50. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

51. The food goods and the services for providing food and drink will be targeted primarily at the general public. I consider that flavour, quality, type of cuisine and possibly country of origin may be considered by the consumer when purchasing food or food services, and as such a medium level of attention is likely to be paid in respect of the same. I note that in respect of the food goods there will also be a group of professional consumers including retail store owners or restaurant owners for

example, and these consumers may pay a slightly higher level of attention (that being above medium but not necessarily high) when purchasing these items due to the increased liability involved in passing them onto their own customers, and the impact the goods purchased may have on their business.

52. The goods and services will likely be purchased visually, either being displayed on the shelves of retail stores, or advertised on the front of restaurants or coffee shops for example, or via websites and visual advertisements. However, I note that in respect of both the goods and the services there is the possibility of word-of-mouth recommendations as well as aural assistance being offered during the purchasing process. Whilst the visual considerations are therefore key, I cannot completely ignore the aural considerations in this instance.

Distinctive character of the earlier trade mark

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

> *"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 WindsurfingChiemsee v Huber and Attenberger [1999] ECR I-0000, paragraph 49).*
>
> *23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as*

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

54. As previously set out, the earlier mark will, in my view, be viewed either as a made-up word, or a word of foreign origin with an unknown meaning. I therefore consider it to be inherently distinctive to a high degree.

55. The opponent has filed evidence in these proceedings, and so I consider whether the inherent distinctiveness of the mark has been enhanced through use. When considering enhanced distinctiveness, it is the perception of the UK consumer at the relevant date that is key, that being the filing date of the contested mark of 18 September 2023.

56. In his witness statement, Mr Khan explains that the opponent has been in the business of selling its Asian food mixes, pastes and foodstuffs in the UK since 1989.[2] He explains that sales to the UK were “immediately successful” and that “exports expanded substantially within the first decade”.[3] Sales figures for the period 1989 – 2005 across the UK and Europe are provided at Exhibit AIK4. From 1997 onwards, figures are provided for the UK only as follows:

(B) **FROM 1997 - JUNE 2005**

YEAR	AMOUNT IN US$ (U.K.ONLY)	EUROPEAN SALES IN US$ (EXCLUDING U.K)
JULY 1997 - JUNE 1998	241,000.00	39,855.00
JULY 1998 - JUNE 1999	222,309.00	271,508.00
JULY 1999 - JUNE 2000	267,871.00	310,955.00
JULY 2000 - JUNE 2001	303,826.00	414,535.00
JULY 2001 - JUNE 2002	243,564.00	403,623.00
JULY 2002 - JUNE 2003	527,828.00	718,263 + EURO 58,157
JULY 2003 - JUNE 2004	773,694.00	1,063,700.00
JULY 2004 - JUNE 2005	1,396,302.00	1,754,128.00

57. Advertising spend for this period for the UK is also provided as follows:

[2] See paragraph 3 of the witness statement of Mr Khan
[3] See paragraph 5 of the witness statement of Mr Khan

(B) **AMOUNT SPENT ON ADVERTISING AND SALES PROMOTION IN THE U.K.**

YEAR	AMOUNT IN £
JANUARY 1989 - JUNE 2003	23,397.00
JULY 2003 - JUNE 2005	31,562.00
G.TOTAL :	£.54,959.00

58. Export sales figures for the UK for the last five years are provided in the statement as follows:[4]

YEAR / PERIOD	EXPORT SALES IN UK	
	PAK RS	GBP
JULY 2018 –JUNE 2019	644,867,928	3,093,634
JULY 2019 – JUNE 2020	585,882,542	2,838,440
JULY 2020 –JUNE 2021	548,609,235	2,511,142
JULY 2021 –JUNE 2022	641,344,657	2,562,918
JULY 2022 – JUNE 2023	862,184,069	2,367,727

59. Figures relating to its UK promotional spend are also provided as follows:[5]

YEAR / PERIOD	ADVERTISING, SALES PROMOTION & PUBLICITY MATERIAL IN THE UK
	GBP
JULY 2018 –JUNE 2019	38,983
JULY 2019 – JUNE 2020	63,571
JULY 2020 –JUNE 2021	83,888
JULY 2021 –JUNE 2022	99,988
JULY 2022 – JUNE 2023	57,316

60. Examples of the opponent's packaging, its brochure and a range of promotional materials showing the mark used on its goods are provided at Exhibit AIK11. These documents appear to be undated, although I note they state "purity, quality and taste

[4] See paragraph 13 of the witness statement of Mr Khan
[5] See paragraph 15 of the witness statement of Mr Khan

since 1985". They display the use of the word LAZIZA as well as the stylised mark below:

61. The brochures themselves provide a fairly extensive list of goods, including a list of sweet mixes, spice mixes, pickles, pastes, chutneys and jelly and custards. A selection of rice is also shown. Alongside these brochures, Exhibit AIK12 provides a number of commercial invoices dating between August 2018 – 31 May 2023 listing a large range of products with a final destination of the UK. The invoices feature the mark below on the top of each:

62. Further commercial invoices bearing the same mark and listing a large range of further goods with a final destination address of the UK are provided within Exhibit AIK14, this time dating between and 30 September 2019 - 20 March 2023. These also bear the mark shown above. This exhibit also provides further undated images of a wide range of food items also bearing the mark.

63. Whilst I have not listed every document in the evidence in great detail here, this has all been considered. Whilst I note the opponent has clearly made a good amount of use of its mark for a considerable number of years prior to the filing date, I consider that the sales figures whilst healthy, are not exceptional. Further, the evidence relating to the extent of the promotion and press relating to goods under the mark is somewhat limited. Considering I have already found the mark to hold a high level of distinctive character inherently, it is my view that this already strong position will not have been improved further through the use made of the same.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

64. Prior to reaching a decision under Section 5(2), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 21 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I must remember that the distinctiveness of the common elements is key.[6] I must keep in mind that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that how the goods and services are obtained will have a bearing on how likely the consumer is to be confused.

65. In respect of section 5(2)(b) of the Act, there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.[7]

66. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this

[6] See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.
[7] *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

67. In this case, I found the marks to be visually similar to between a medium and high degree, and to be aurally similar to at least between a medium and high degree (if not identical), to at least a significant portion of consumers. I found the marks dominant elements to be conceptually neutral, but that the additional elements of the contested marks create a point of conceptual difference. However, I consider at this stage this concept is not particularly unique or memorable, being that it simply serves as an indication of the goods and services offered under the mark. The goods and services themselves range from identical to similar to at least a medium degree, and I found the earlier mark to hold a high degree of inherent distinctive character, but that this had not been enhanced any further through use. I found the average consumer would include members of the general public as well as a number of professionals, with the level of attention ranging from medium for the former, to above medium for the latter.

68. I note at this stage, that the applicant has filed evidence of use of its own mark. One of the arguments Ms Kaleem sought to rely on at the hearing was that the applicant has been using the mark for over 20 years, and there has been no confusion to date. Ms Kaleem also submitted that the applicant is only using its mark in a small area of the north of England. The evidence filed by the applicant in these proceedings is not extensive, but I do note the witness statement filed by Mr Majid confirms at paragraph 2 that he runs a restaurant and takeaway business, and that his first "outlet" was opened in 1999.[8] I note the reference to the applicant's website, and the confirmation that the applicant has "outlets" in 3 locations in the North of England.[9] I also note the confirmation that food from these may be ordered for delivery via Deliveroo, Uber Eats and Just Eat.[10] Further, I note the reference to a Facebook page and to 80 reviews on Trip Advisor.[11]

[8] See paragraphs 2 & 5 of the witness statement of Mr Majid.
[9] See paragraphs 6 of the witness statement of Mr Majid.
[10] See paragraphs 7 of the witness statement of Mr Majid.
[11] See paragraphs 9 & 10 of the witness statement of Mr Majid.

69. In *Roger Maier and Another v ASOS,* [2015] EWCA Civ 220, Kitchen L.J. stated that:

> *"80. .....the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in Specsavers at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur."*

70. In *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

> *"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."*

71. Whilst I have considered the applicant's evidence in full, and the claimed use of the applicant's mark alongside the opponent's mark for a period of time, it seems to me that the extent of this is not entirely clear but likely relatively small, with outlets in three locations and an unknown turnover. Further, I note that the use is confined to a limited geographical location in the UK. I also note the opponent's mark is registered as a word mark, which provides protection for its use in whatever form, colour or typeface used, and as such I must make a notional assessment on that basis. It is my view in the circumstances, that the applicant's minimal evidence of use cannot be considered to really give weight to an argument that the use of the applied for trade mark on a national level, in relation to all of the goods and services filed, will not result

in confusion with the notional use of the opponent's registered word mark for the goods relied upon in this instance.

72. With the above in mind, and considering all of the factors of this case, I find there to be a likelihood of direct confusion between the marks. It is my view that it would be easy for the consumer to fail to recall or to not notice the omission or addition of the smaller elements of the contested mark, particularly considering these relate conceptually to the goods and services themselves. Further, considering the visual similarity and aural identity of the dominant elements of the marks, I also find it would be easy for the consumer to misremember or fail to notice the difference in spelling between Lazeeza and Laziza, neither of which has a clear concept that may have helped the differences stand out to consumers. I find this to be the case in respect of all of the contested goods and services.

73. However, if I am wrong to find that the small device and additional descriptive writing included in the contested mark will go unnoticed, it is still my view that there is a likelihood of indirect confusion based on the consumers imperfect recollection of the Lazeeza/Laziza elements of the marks. It is my view that even if the consumer remembers the device, which is clearly indicative of food-based goods and services, and/or the descriptive wording underneath the mark, this will simply be considered a more stylised or decorative variant of the earlier mark, with the use of a few additional elements simply indicating the type of goods or services offered under the same. I therefore find that even if these elements are recalled, there will be a likelihood of indirect confusion between the marks based on an imperfect recollection of the dominant elements.

74. The opposition based on section 5(2)(b) of the Act therefore succeeds in respect of all goods and services filed based on the first earlier "618 mark "LAZIZA". As the opponent has succeeded in full on the basis of this earlier mark, I see no reason to further consider the opposition based on the additional marks under this ground, as its position cannot be improved further by doing so.

Section 5(3)

75. Section 5(3) of the Act reads as follows:

> *"(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 and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".*

76. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case C-252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *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; G*eneral 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 Saloman*, 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) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) 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.

(h) 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.

(i) 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. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) 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 proprietor 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).*

77. An opposition based on section 5(3) of the Act can only be successful via the establishment of several individual elements. To be successful on this ground, the opponent must prove it holds a reputation for the earlier marks relied upon amongst a significant portion of the public. It must also be established that the marks are similar. If it is found both that the marks are similar and that the earlier marks holds a qualifying reputation, it must then be shown that this reputation, combined with the similarity between the marks, will result in the relevant public establishing a link between the marks. A link may be found on the basis that the later marks bring the earlier mark to mind. Importantly, if all three of these elements have been established, it must then be shown that the link made by the public will result in, or will be likely to result in, one of the pleaded types of damage.

78. The relevant date for consideration under section 5(3) of the Act is the filing date of the contested application, that being 18 September 2023. The opponent claims to hold a reputation in relation to all its goods relied upon under the earlier marks at that time.

79. For the same reasons set out in respect of section 5(2)(b) of the Act, I intend to initially consider the opponent's position based on the first in its series of two earlier "618 marks, and if necessary, come back to consider its position based on the additional marks relied upon at that stage.

Reputation

80. Within its counterstatement, the applicant responded to the opponent's claim of reputation as follows:

> "*Whilst it is not denied that the Opponent owns the trademarks for Laziza and Laziza International and has built up a reputation for their brand, it is denied that the applicant's brand is identical or similar enough to the opponents brand to cause confusion on the part of the general public into believing that the two brands are associates in any way*."

81. Within her skeleton arguments, Ms Kaleem for the applicant submitted:

> "*The Opponent has failed to meet the requirements necessary for a successful claim under Section 5(3) of the Trade Marks Act 1994. There is no sufficient evidence any of the elements required by law, namely*
>
> *•A reputation in the earlier mark within the relevant jurisdiction;*
>
> *• The existence of a mental link in the minds of the relevant public;*
>
> *• Any resulting unfair advantage or detriment.*
>
> *The Applicant submits that no meaningful reputation has been substantiated by the Opponent, and even if such a reputation were asserted, it has not been shown that the Applicant's mark would give rise to any association or perceived connection.*
>
> *Furthermore, there is no basis for concluding that use of the Applicant's mark would confer an unfair advantage or cause harm to the Opponent's brand.*
>
> *Accordingly, the legal threshold under Section 5(3) is not met, and the opposition should be dismissed in its entirety*."

82. At the hearing, I explained to Ms Kaleem that the statement in the TM8 appeared to me to be an acceptance that the opponent holds a reputation for its goods, and I asked if it was her intention to bring the opponent's reputation back into contention at this stage. Ms Kaleem replied explaining:

> "*It is not the fact that the opposition's reputation is disputed, we know that they have a reputation, but the argument here is that the reputation is in sort of dry mixes and products that you are going to use at home to cook the foods, whereas our reputation for the Applicant is in readymade cooked food, where you walk into his takeaway or restaurant, take the food and just eat it straightaway. That is the only issue."*

83. Not being entirely sure what was meant by the scope of *"dry mixes and products that you are going to use at home to cook foods",* I asked Ms Kaleem if she was therefore not disputing the pleaded reputation from the opponent, to which she replied that she was not. Later on in the hearing, Ms Kaleem submitted for the applicant:

> *"In relation to section 5(3), the reputation and unfair advantage, our submissions are that, yes, we do accept that the Opponent has some reputation but it is not enough to be able to say that there is definitely a mental link between the marks and unfair advantage being taken by the Applicant and any detriment to the distinctive character or reputation of the Opponent's mark. The bar under section 5(3) is high and we do not believe that the Opponent has fulfilled all three bars of that test.*
>
> *Even if there is some reputation existing in the Opponent's mark, which we are not denying, there is no mental link established due to the distinct visual identities, the brand messages and the commercial settings of the Applicant's brand. As I said, the Applicant's brand has been here since 1999, it has been here for 20 years. There is no evidence, so far, of the Applicant riding on the coattails of the Opponent's brand, nor any attempt to blur the distinctiveness or repute of the earlier mark."*

84. It appears from the above submissions that the question of whether the opponent holds a reputation for its goods is not in dispute. I therefore accept that the opponent holds a reputation for its mark in relation to those goods relied upon and which remain following the use assessment earlier in these proceedings. However, the extent of the reputation is clearly a matter that is left to be decided.

85. I note at this stage, that whilst it is my view the opponent does not exclude the UK population at large, it pleads:

> "*In particular, the Opponent's earlier marks have a reputation among persons of Pakistani and / or Indian heritage, which form a wide section of the public in the United Kingdom."*

86. However, the evidence does little to show that its reputation is particularly apparent among this section of the population. Whilst the opponent appears to sell food products which may be part of a more traditional Indian or Pakistani cuisine, I do not find this limits the sales of these goods to this sub-group in particular, or goes any way to show that it is this group that are particularly responsible for the sales of goods under its mark. Without further evidence on this point, it is my view that I must simply consider the reputation held by the opponent in the context of the UK population at large.

87. I have already summarised the key parts of the evidence when considering the whether the opponent holds an enhanced level of distinctive character under its mark. I do not intend to repeat this summary in full at this stage, but I note in particular the highlights of the evidence being the longstanding use of the mark, and the export sales figures in the UK of between approximately 2-3 million GBP in the five years prior to the relevant date. I note the advertising and promotional spend it fairly limited, as is the additional evidence provided. Overall, considering the sum of the evidence provided, it is my view the opponent has established it held a modest reputation for its goods under the mark in the UK at the relevant date.

Link

88. I will now move on to consider if I find there will be a link made between the marks, with consideration to the relevant factors as set out in *Intel.*

The degree of similarity between the conflicting marks

89. Earlier in this decision I found the marks to be visually similar to between a medium and high degree, and at least aurally similar to between a medium and high degree to at least a significant portion of consumers, but that the additional elements in the contested mark acted as a point of conceptual difference between the same.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

90. I have previously found the goods and services to range from identical to similar to at least a medium degree.

The strength of the earlier mark's reputation

91. I have found the opponent to hold a modest reputation for its goods relied upon.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

92. I found the opponent's earlier mark to hold a high degree of inherent distinctive character. I did not find this to have been enhanced any further through use.

Whether there is a likelihood of confusion

93. I have already found there to be a likelihood of direct and indirect confusion between the marks in the context of section 5(2)(b). It follows that I also find there to be a likelihood of confusion in the context of section 5(3) of the Act in this instance.

94. Considering I have found a likelihood of confusion between the marks, it is apparent there will be a link made between the same. However, even if I am wrong to find a likelihood of confusion, I nonetheless find there will be a link made between the marks. I find this on the basis that, considering all the factors present, including the opponent's modest reputation and high level of distinctiveness of the earlier mark, the high similarity of the marks, and the similarity and identity of the goods and services, the use of the contested mark is in my view very likely to bring the earlier mark to mind, even where consumers are not confused.

95. As I have found there to be a link between the marks in this instance, I will now go on to consider whether there is a likelihood that damage will result from the same.

Damage

96. In his skeleton arguments and at the hearing, Mr Buehrlen made reference to three heads of damage, those being unfair advantage, detriment to distinctive character and detriment to the reputation of the earlier mark. I noted at the hearing that it was my view detriment to the opponent's reputation had not been sufficiently pleaded, and Mr Buehrlen appeared to accept this. I will therefore go on to consider only the other two heads of damage, to the extent it is necessary to do so.

Unfair advantage

97. The opponent pleads unfair advantage in the following terms:

> *"The Applicant would further take advantage of the reputation of the earlier marks by facilitating the marketing and recognition of the Applicant's goods without the need for the usual marketing and word of mouth reputational gains. In the alternative, they would benefit from immediate and obvious comparison to a market leader. The Applicant's mark would convey the messages associated with the Opponent's marks without the need for the usual levels of marketing and promotional expenditure."*

98. In *L'Oréal SA & Ors v Bellure & Ors*, Case C-487/07, at paragraph 50, the CJEU said:

> *"The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation 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 proprietor of the mark in order to create and maintain the mark's image."*

99. At paragraph 41, the CJEU also said:

> *"As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It 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."*

100. It is clear in this instance that where there is a likelihood of confusion as to the economic origin of the goods and services, there will be an unfair advantage gained by the applicant, who will unfairly benefit from the investment made by the opponent in building its brand and its reputation for the same, thus attracting more UK consumers to the applicant's goods and services as a result. Further, even if I am wrong to find that consumers believe all of the applicant's goods and services derive from the opponent, I consider the applicant's mark will nonetheless benefit from the familiarity in the eyes of the consumer due to the opponent's reputation and the highly similar dominant element of the marks, thereby securing a commercial advantage as a direct benefit of the opponent's reputation.

101. I therefore agree with the opponent that the applicant will gain an unfair advantage from the use of its mark in respect of all of the goods and services filed.

102. As I have found for the opponent in respect of unfair advantage, there is no need to consider detriment to distinctive character at this stage.

Due Cause

103. I note here that the applicant has not pleaded that it has "due cause" to register its mark in this instance. However, it is my view that even if this had been pleaded, the very limited evidence filed in relation to its use in this instance, would not have been sufficient to establish a successful defence on this basis.

104. As the opponent's first earlier "618 mark leads to the opposition being successful in its entirety under section 5(3) of the Act, there is no need to consider the remaining trade marks upon which the opposition under this ground is based.

FINAL REMARKS

105. Subject to any successful appeal, the application no. 3957846 will be refused in its entirety.

COSTS

106. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £2100 as a contribution towards the cost of the proceedings, in accordance with tribunal practice notice 1/ 2023. The sum is calculated as follows:

Official fee:	£200
Preparing the TM7 and reviewing the TM8 and counterstatement:	£350

Preparing and filing evidence and considering the other side's evidence:	£800
Preparing for and attending the hearing:	£750
Total	**£2100**

107. I therefore order Tariq Majid to pay Convenience Food Industries (Pvt) Ltd the sum of £2100. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 11th day of August 2025

R. Le Breton
For the Registrar