O/0788/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 4080365
IN THE NAME OF DAWOOD AMIR

TO REGISTER AS A TRADE MARK

SHAHI NAAN KEBAB

IN CLASS 43

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600003479
BY SHEKIO ASLAM

BACKGROUND AND PLEADINGS

1. On 26 July 2024, Dawood Amir ("the applicant") applied to register the trade mark shown on the cover page of this decision in the United Kingdom. The application was accepted and published for opposition purposes on 9 August 2024, in respect of "*Restaurant services*" in class 43.

2. The application is opposed by Shekio Aslam ("the opponent"). The opposition was filed on 4 November 2024 under the fast-track procedure and is based upon section 5(1), section 5(2)(a) and section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the services in class 43 of the application. The opponent relies upon the following mark:

UK trade mark registration number 2476734
Filing date: 8 January 2008
Registration date: 20 June 2008
Registered in Class 43
Relying on all services, namely, "*Providing restaurant, buffet and takeaway services*."

3. The opponent submits that the marks are the same for the same services.

4. The applicant filed a counterstatement denying the claims.

5. The trade mark upon which the opponent relies qualifies as an earlier trade mark under Section 6(1) of the Act. Rule 2(7) of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013 states that

> "(7) Where the earlier mark is subject to proof of use under section 6A of the Act, the proof of use that the opponent wishes to rely upon shall be provided with the notice of fast track opposition."

6. As the earlier mark became registered more than 5 years before the application mark was filed, the opponent made a statement of use, and states that the mark has been used at 108 South Road, Southall, UB1 1RB. As required under the fast-track procedure, proof of use evidence was filed with the Form TM7F.

7. Neither party requested leave to file further evidence or for an oral hearing in this fast-track opposition. Neither party elected to file written submissions in lieu of a hearing. Therefore this decision is taken following careful consideration of the papers on file.

8. In these proceedings, neither party is professionally represented.

Preliminary Issues

9. On receipt of the original Form TM7F filed by the opponent, the Tribunal wrote to him to highlight the deficiencies of the form, and invited him to file an amended form addressing the issues. Having been afforded several occasions to provide an acceptable TM7F, the Tribunal issued the preliminary view that the notice of opposition should be struck out, which would result in the opposed application being forwarded to registration.

10. The opponent requested to be heard and a joint hearing was appointed. The procedural hearing, which was attended by both parties, took place before me on 30 January 2025, whereby the preliminary view was overturned on the proviso that a sufficiently amended form be filed within 7 days of the date of the hearing.

11. Following the hearing, an amended Form TM7F was filed within the given deadline. I note that under Q5 of the form, the opponent still indicated that there were related proceedings between himself and the applicant. This was discussed at the procedural hearing where it was established that there were no relevant earlier proceedings between these two parties. As such, the details given at point 5 of the amended Form TM7F should have been removed, and I take no further account of them.

12. Having filed an otherwise suitably amended Form TM7F, the notice of opposition was served upon the applicant. I note that at point 5 of the counterstatement by the applicant, it refers to the procedural hearing and suggests that I indicated that the opponent does not have a monopoly on the words contained within the mark and that the opposing marks were two different marks. I refute that I made any comments at the hearing as to the merits of the substantive case and that I confined my direction to the parties in respect of the deficiencies of the notice of opposition (Form TM7F) only.

13. I also note that having already filed the accepted Form TM7F, the opponent then filed a Form TM8, being a notice of defence and counterstatement. In an official letter dated 28 April 2025, the Tribunal informed the parties that as the opponent is not required to file a defence, the opponent's Form TM8 would be disregarded. In the same letter, both parties were also invited to file written submissions in lieu of a hearing. However, both parties subsequently confirmed that they did not wish to file any written submissions.

14. I will now proceed with the decision accordingly, taking into account the evidence of use as attached to the Form TM7F.

EVIDENCE

15. The opponent's evidence consists of five exhibits, labelled Exhibit 1, Exhibit 2, Exhibit 3A, Exhibit 3B and Exhibit 4 respectively. I will consider these exhibits in further detail later in this decision.

DECISION

16. 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.

Proof of Use

17. The relevant statutory provisions under Section 6A of the Act are 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 section 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)-(5A) [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.

18. Section 100 of the Act states that:

"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".

19. The relevant period during which genuine use must be shown is the five years ending with the application date of the contested application, which was 26 July 2024. The relevant period is 27 July 2019 to 26 July 2024. As the opponent's mark is a UKTM, the territory in which use must be shown is the United Kingdom.

20. 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 I-9223, 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 sub-category 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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]."

Evidence of use

21. Under the Section 5 grounds, the opponent has claimed that use has been made of all of the services on which it relies under the earlier mark. I must consider whether, or the extent to which, the evidence shows genuine use of the earlier mark in relation to the services covered under class 43, being "*Providing restaurant, buffet and takeaway services*."

22. I note that at Q11 of Form TM7F, turnover generated by the services is stated as being approximately £350,000. However, it has not been specified whether this is annual turnover or if it covers the entire relevant period. At Q12, marketing costs are provided as £5000 in 2017, falling to £2500 in 2018 and to £2000 in 2021:

Q11. **Please provide details of the number of sales achieved under the mark in the UK (or in the EU if the earlier mark is registered or protected at Community level) during the relevant period. These figures should, if possible, be provided on an annual basis and, if possible, be split in relation to each of the goods/services for which use of the mark is claimed; estimates should be provided if exact figures are not readily available.**

Note: You may provide financial turnover figures to illustrate the level of sales under the mark, but if you do please also provide an indication of the typical unit price for the product or service.

Unit price £7.50
Turnover approximately £350,000

Q12. **If you consider that the information already provided clearly shows genuine use of the mark during the relevant period in relation to the goods/services for which use is claimed, please complete the statement of truth before continuing to Q14. If you wish to supplement the information already provided, please state how much was spent promoting the mark in the UK during the relevant period. Ideally, this should be broken down by year. Estimates may be provided if exact figures are not readily available.**

2017 cost of marketing £5000
2018 cost of marketing £2500
2021 cost of marketing £2000

The exhibits

23. Exhibit 1 shows an invoice (in the form of a till receipt) relating to take-away food services, dated 12 December 2024. The exhibit has been described as "invoice of opposition trademark being used". The invoice itself is headed "SHAHI NAAN KEBAB" and shows the 108 South Road address:

Exhibit 1 invoice of opposition trademark being used

INVOICE

SHAHI NAAN KEBAB
108, SOUTH ROAD
SOUTHALL
UB1 1RB
TEL: 020 8574 5888

CASHIER : STAFF
DATE : 12/12/2024 21:55:41
INVOICE NO : RP000116228

TAKE AWAY-073

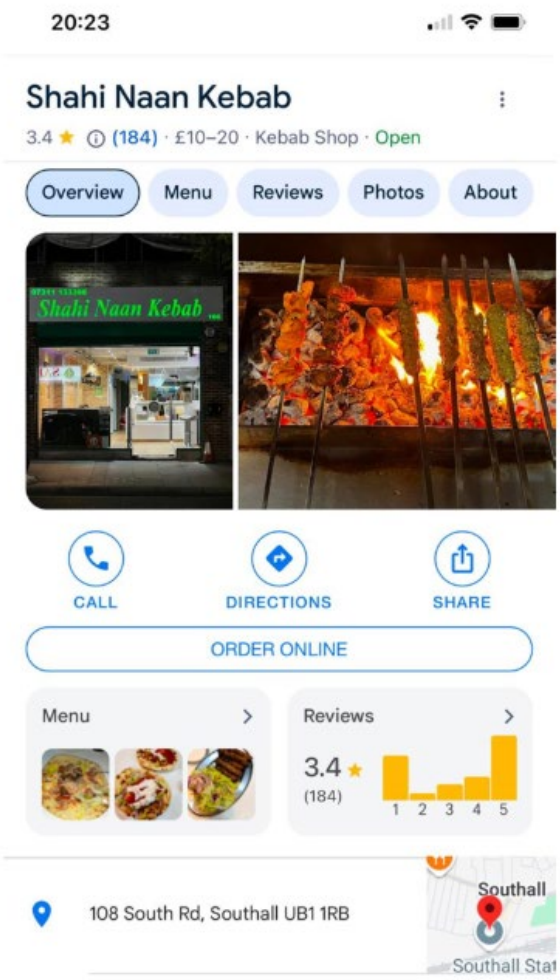
DESCRIPTION	QTY	UPRICE	AMOUNT
51. REGULAR CHIPS	1	2.00	2.00
SEEKH KEBAB	2	1.80	3.60
		SUBTOTAL	5.60
		NET	5.60

PAYMENT DETAILS
PAID BY Cash 5.60

THANK YOU FOR VISITING
WE LOOK FORWARD TO WELCOMING YOU BACK SOON.

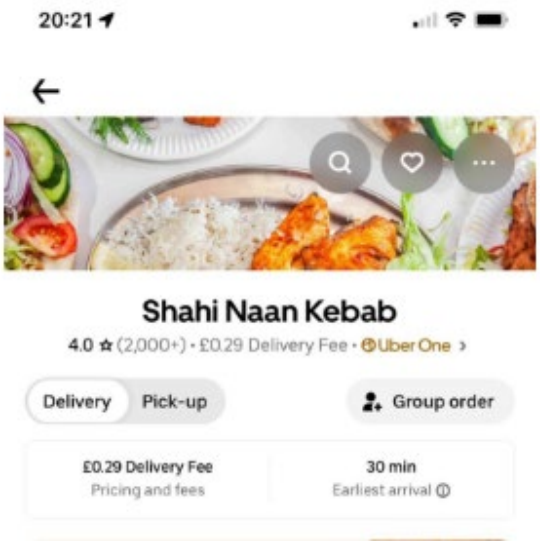
24. Exhibit 2 comprises a screenshot which the opponent has described as "oppositions google page":

Exhibit 2 oppositions google page

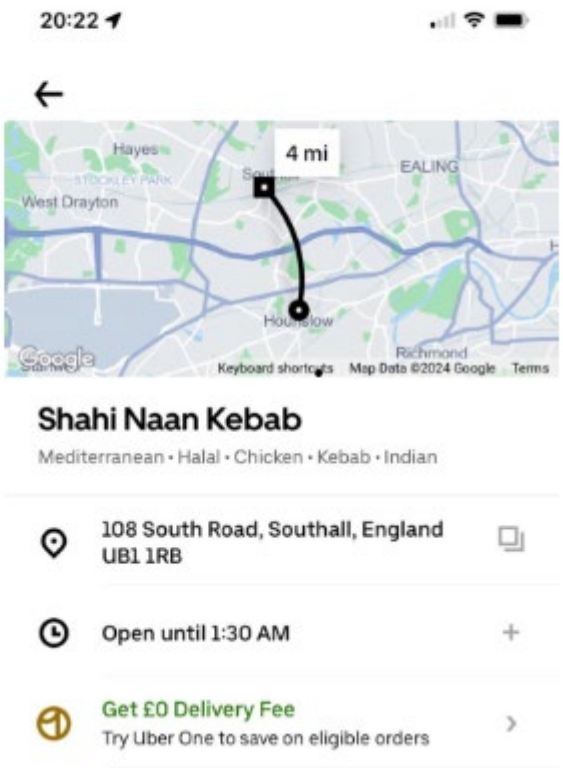


25. Exhibits 3A and 3B are described by the opponent as “proof of mark in use on Uber Eats:

EXIBIT 3A proof of mark in use on Uber Eats



EXIBIT 3B continuation of Uber Eats page



26. I note that exhibit 4 merely shows details of the opponent's trade mark registration, as can be found via the "Search for a trade mark" pages at the Intellectual Property Office section of the .Gov website.

Assessment on genuine use

27. Whether the use shown is sufficient to constitute genuine use will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the services at issue in the UK during the relevant five-year period. In making my assessment, I must 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.

28. 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. It is possible for an accumulation of evidence to show use, even if individual items of evidence would on their own be insufficient proof: see *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T- 415/09, paragraph 53. I acknowledge that, as per the principles outlined under paragraph 20 of this decision, use of the mark must be more than token, although that use need not always be quantitatively significant for it to be deemed genuine.[1] I also bear in mind that it is not for me to assess economic success or large-scale commercial use, and that there is no *de minimis* rule - even minimal use may qualify as genuine use if it is use warranted, in the economic sector concerned, to maintain or create market shares for the relevant goods.[2]

29. The opponent has filed extremely limited evidence in support of the use of his mark. It seems clear from the exhibits that aside from exhibit 4, they do not relate to the opponent's mark at all. Due to the descriptions attributed to exhibits 1, 2, 3A and

[1] *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].
[2] *Naazneen Investments Ltd v OHIM*, Case T-250/13 at [49].

3B by the opponent, as well as the dates (where provided) and the address as shown on the exhibits, I conclude that they pertain to what the opponent purports as being evidence of use of the applicant's mark and not evidence of use of the opponent's own mark. This is supported by the information provided by the opponent on the Form TM7F.

30. I note that at Q8 of Form TM7F, where it asks the opponent to indicate where the earlier mark relied upon has been used, the address is given as 108 South Road, Southall. At Q13, the opponent states that they were "leasing out the premises", (which I presume to mean 108 South Road), and that "we then moved further down the high street". This is reinforced at Q16, where the opponent states that they were initially operating from 108 South Road, but vacated the premises in 2018. As such, the address given as the location for the relevant territory of use for the earlier mark was actually vacated prior to the start of the relevant period. The opponent also states that "my opponent took over 108 South Road (same premises)", which I assume to be a reference to the applicant. At Q10 of the Form TM7F, the opponent has said that he has provided "the shop front picture of my opponent, please exhibits attached" (sic). I note that exhibit 2 is the only one which shows a shop front. Conversely, I note that in the counterstatement, the applicant has stated that he does not "have anything to do with the premises at 108 South Road".

31. The strongest evidence of use of the mark comes from the turnover figures as provided at Q11 of Form TM7F. This indicates that approximately £350,000 has been generated under the mark for the services at issue, which I take to be in total over the relevant five year period. Although I have not been provided with any details of the size of the take-away food market in the UK, or the percentage share enjoyed by the opponent, I would expect such a market to be substantial. In my view, the revenue generated by the opponent therefore seems quite low. That being said, I note that the services at hand are what are considered to be local services which seemingly are provided from a single premises situated in a specific location, rather than the type of services which may be provided throughout the UK. I also take into account the stated marketing spend, although it has not been substantiated as to how or to whom the opponent markets his services. Neither the turnover figures nor the marketing expenditure have been supported by any tangible evidence, such as

invoices relating to the provision of the opponent's services or those showing the promotional costs incurred. Neither is there any evidence of use of the mark on, for example, the likes of menus and price lists, nor of the signage which you would expect to see displayed on the premises from which the opponent operated his restaurant, buffet and takeaway business during the relevant period, the location of which is unknown.

32. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services protected by the mark" is not, therefore, genuine use. Where there is no use of the mark in respect of the services as registered, it follows there has been no genuine use of the mark: *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL 0/404/13.[3]

33. Case law does not specify particular types of documentation that must be adduced in evidence. When considering the evidence, I am 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": *PLYMOUTH LIFE CENTRE*, BL O/236/13, paragraph 22.

34. I have considered the evidence as a whole. Aside from the turnover figures and marketing spend, the opponent has not provided any evidence of use of his mark, in trade, during the relevant period. As already mentioned, the exhibits suggest that they relate to a different entity other than the opponent. It seems that this other entity provides take-away food services under the name Shahi Naan Kebab from the premises formerly used by the opponent. I conclude from the evidence, and given the opponent's comments that the applicant "took over" the South Road premises, that he has erroneously attempted to show use of what he perceives to be the applicant's mark, rather than his own. I note that the mark relied upon by the opponent is "The Shahi Nan Kabab". Meanwhile, the name shown in the exhibits is "SHAHI NAAN KEBAB" (my emphasis), being the same as the applied-for mark. This,

[3] At [22].

therefore, seems to corroborate my conclusion. Accordingly, it is my view that the evidence provided is insufficient to allow me to find that there has been genuine use of the mark for any of the services on which the opponent relies within the relevant period and within the relevant territory. Consequently, the earlier mark cannot be relied upon in these proceedings and so the opposition under section 5(2)(b) fails.

CONCLUSION

35. The opposition has failed. Subject to any successful appeal, the application by Dawood Amir may proceed to registration.

COSTS

36. As the applicant has been successful, he is, in principle, entitled to a contribution towards his costs. For parties without professional representation, as outlined in Tribunal Practice Notice ("TPN") 1/2023, such costs would be based on £19 per hour, reflecting the number of hours spent on the different stages of the opposition. In a letter to the parties dated 28 April 2025, the Tribunal invited the unrepresented parties to indicate whether they wished to make a request for an award of costs and, if so, to complete and return the attached costs pro-forma by **28 May 2025**. The letter stated that "If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs". As the pro-forma was not returned, and as no official fees have been incurred in defence of the application, I make no order as to costs in this case.

Dated this 28th day of August 2025

Suzanne Hitchings
For the Registrar,
the Comptroller-General