o/0978/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003865351

BY TEHZEEB (PRIVATE) LIMITED

TO REGISTER THE TRADE MARK:

Tehzeeb

IN CLASS 30

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 441637

BY RANA AHMAD

AND

IN THE MATTER OF APPLICATION NO. UK00003923747

BY RANA AHMAD

TO REGISTER THE TRADE MARK:

Tehzeeb
SWEETS & BAKERS

IN CLASSES 29, 30 AND 43

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 444581

BY TEHZEEB (PRIVATE) LIMITED

BACKGROUND AND PLEADINGS

1. This decision involves cross-consolidated proceedings wherein Tehzeeb (Private) Limited ("TPL") and Rana Ahmad ("RA") brought actions against one another. I will summarise the relevant proceedings below, beginning with RA's opposition on the basis that it was brought first.

RA's opposition

2. On 6 January 2023, TPL applied to register the **Tehzeeb** figurative mark ("**351 Mark**") shown on the cover page of this decision in the UK. The application was published for opposition purposes on 24 March 2023, and TPL seeks registration for the following goods:

Class 30 Bakery products, pastries, puff pastries, pies, fruit tarts, trifles, biscuits, biscotti, crackers, wafers, waffles, cookies, macaroon; Cakes, and cake products including fruit cakes, plain tea cakes, iced cakes, fresh cream cakes, butter cream cakes, mousse cakes and other customized cakes; Bakery products based on flour; bread and bread products including pitta bread, naan bread, bread rolls, filled bread rolls, breadsticks, gingerbread, garlic bread, buns, croissants; desserts based on flour and chocolate including muffins, scones, pancakes, doughnuts, bagels; Swiss rolls, cream packed rolls, brownies, cake rusks, crispy rusks; wheat flour which can be filled with the mix of vegetables, minced meat, minced chicken and minced beef; samosa; crusty rolls; spring rolls, Cerealbased snack food, breakfast cereals, muesli; processed wheat for human consumption, rice-based snack foods; salty snacks which consists of flour and cereals; snacks being grain-based snack foods; wheat based snack foods, corn chips; Prepared meals consisting of pasta, macaroni and noodles; pizzas, Pizza pies, hot and cold filled rolls, pasta and pasta products, sandwiches, Hot dog sandwiches, Panini, Burgers contained in bread rolls, Hamburgers in buns, Cheeseburgers [sandwiches], Tacos, Quesadillas, Pasta Salads, Macaroni Salads, Salad dressings, Salad sauces, Condiments for foodstuff including

spices, sauces, tomato sauce, food seasonings, Gravies, yeast, baking powder, sugar, sugar syrup, tea, ice tea, Honey and honey substitutes, vanilla (flavoring), Dessert puddings, Dessert souffles, Confectionery Products made of sugar, chocolate, toffees, Sweets, Candies, ice-cream, Coffee, cocoa, coffee or cocoa based beverages, chocolate based beverages, chocolate syrup, chocolate based ingredients for use in confectionery and bakery products, jelly confectionery, bakery desserts, Rice-based pudding dessert, Custards.

3. The application was fully opposed by RA on 29 June 2023, based upon section 5(4)(a) of the Trade Marks Act 1994 ("the Act").

4. RA relies upon its **TEHZEEB** sign which it claims to have used in London and Manchester since 2003. In its Form TM7, RA states that the goods on which the sign "has been used include inter alia biscuits, sweets, cakes [and] savoury foods". RA claims that they have developed goodwill in their earlier sign, and that use of the 351 mark amounts "to a misrepresentation that those goods are provided by or linked to those of" RA, which would result in confusion and RA's goodwill will be damaged. On this basis, RA states that "such use would be passing off" of RA's goodwill.

5. TPL filed a counterstatement denying the claims made.

TPL's opposition

6. On 16 June 2023, RA applied to register the **Tehzeeb SWEETS & BAKERS** figurative mark ("**747 Mark**") shown on the cover page of this decision in the UK.

7. The application was published for opposition purposes on 8 September 2023, and the RA seeks registration for the following goods and services:

Class 29 Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps.

Class 30 Coffee, tea, flour and preparations made from cereals, bread, pastry and confectionery, ices, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.

Class 43 Services for providing food and drink; restaurant, bar and catering services; booking and reservation services for restaurants.

8. The application was fully opposed by TPL on 8 December 2023, based upon sections 5(2)(b) and 5(4)(b) of the Act. Under section 5(2)(b), the TPL relies upon its 351 Mark, claiming that there is a likelihood of confusion because the marks are visually and aurally identical or similar to a high degree, the marks are conceptually neutral, and the goods are identical or highly similar.

9. Under section 5(4)(b), TPL claims that the "Tehzeeb logo" contained in its 351 Mark "is an artistic work under section 4(1)(a) of the Copyright, Designs and Patents Act 1988 ('CDPA') and consequently qualifies for copyright protection in the United Kingdom". TPL claims that they are the owner of the copyright in the Tehzeeb logo.

10. RA filed a counterstatement accepting that *flour and preparations made from cereals, bread, pastry and confectionary pizzas, pies and pasta dishes* were "similar to those of the earlier mark", but only to a "low degree". They denied the rest of the claims made.

11. TPL is represented by Wynne-Jones IP Limited and RA is represented by London IP Ltd. Both parties filed evidence in chief, and RA filed evidence in reply. Neither party requested a hearing but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

12. 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

13. TPL's evidence consists of the witness statement of Mr Khalil Ahmed Noon dated 29 April 2024. Mr Noon is the Director and CEO of TPL and his statement is accompanied by 5 exhibits (KN1-KN5).

14. RA's evidence in chief consists of the witness statement of Mr Rana Ahmad dated 29 April 2024. His statement is accompanied by exhibit 1.

15. RA's evidence in reply consists of the second witness statement of Mr Rana Ahmad dated 1 July 2024. His statement is accompanied by exhibit RA2.

16. Whilst I do not propose to summarise it here, I have taken all of the parties' evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

MY APPROACH TO THE OPPOSITIONS

17. RA's opposition could have an impact on TPL's opposition, in that the level of success (if any) will determine what goods TPL can rely upon in its opposition against RA's mark.

18. However, if TPL's 351 mark is successfully opposed in full, it will not constitute as an earlier mark for the purpose of its opposition against RA's mark. However, I bear in mind that the opposition will not fully fall away as TPL also relies upon section 5(4)(b).

DECISION

RA's opposition under Section 5(4)(a)

19. Section 5(4)(a) of the Act states as follows:

> “5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –
>
> a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
>
> aa)…
> b) …
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

20. Subsection (4A) of section 5 of the Act states:

> “(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

21. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

> “55. The elements necessary to reach a finding of passing off are the ‘classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.
>
> 56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per

Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21)."

Relevant date

22. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

> "43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: 'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'"

23. The prima facie relevant date is the date of TPL's application i.e. 6 January 2023. However, it is also necessary to consider what the position would have been at the start of the behaviour complained about.

24. In *Smart Planet Technologies, Inc. v Rajinda Sharma*, Case BL O/304/20, Mr Thomas Mitcheson QC, sitting as the Appointed Person, pointed out that "the start of the behaviour complained about" is the date that the user of that mark committed the first external act about which the other party could have complained (if it knew about it) as an act of actual or threatened passing off. Typically, this will be the date when first offer was made to market the relevant goods or services under the mark. However, it could also be the date the first public facing indication was made that sales were proposed to be made under the mark in future. I also note that the case of *CASABLANCA*, Case BL O/349/16 makes it clear that it is not necessary for the

applicant to have actually acquired goodwill in order for there to be an earlier relevant date.

25. In Mr Noon's witness statement, at paragraph 3 he states that the Tehzeeb logo was first published in Rawalpindi, Pakistan in 2011, and is "being published continuously since". **Exhibit KN1** contains a cover letter dated 8 November 2012 addressed to "The Registrar of copy Rights, Copyrights Office, Karachi", accompanied by two sets of "Daily News paper Asas" as evidence of publishing the artistic logo Tehzeeb. The first extract only shows the newspaper heading "DAILY ASAS", and the second extract headed as "advertisement for registration of copyrights", clearly depicts TPL's mark. I also note that the **exhibits KN3a** and **KN3b** contain Wayback machine screenshots dated 22 July 2013 and 18 October 2014 showing use of TPL's sign on the website Tehzeeb.com.

26. I bear in mind that the newspaper extract pertains to use in Pakistan and not the UK. Moreover, while TPL's .com website can be accessed all over the world, including the UK, I have not been provided with any supporting evidence showing the number of website views or users in the UK.

27. Therefore, taking all of the above into account, I find that there has been no compelling evidence of use in the UK which would amount to an external act the other party could have complained about, and as such, I only have the prima facie relevant date to consider, that being 6 January 2023.

Goodwill

28. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start."

29. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by BALI Trade Mark [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.
>
> 28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

30. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

> "[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the

application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

31. At paragraph 2 of RA's witness statement, Mr Ahmad states that he operates his business as a limited company, that being N Retail Ltd. He claims to have held the position of director of N Retail Ltd since its incorporation on 28 June 2016, and that "prior to this, our business was operating under Sweet Mahall Ltd which was incorporated on 17/04/1997". He states that all products sold under the "Tehzeeb" mark are "manufactured in our factory and then distributed using our vehicles", and that he has been selling goods under the "Tehzeeb" mark for 20 years, including the following products shown on display in **exhibit 1**:

32. I note that these photos are undated, and whilst Mr Ahmad has not provided me with any explanation as to what goods are contained in the above photographs, in his witness statement, he provides the following list of goods that are sold under the "Tehzeeb" mark:

> "**Sweets**
>
> Ajmeri Kalakand, Bhalo Shahi, Shakkar Para, Jalaibee, Habshi Halwa, and Walnut Halwa
>
> **Biscuits**
>
> Chocolate biscuits, Plain Ties, Heart Shaped ties, Coconut biscuits, Chocolate Vanilla biscuits, Cake Rusks, Plain Nozzle Line biscuits, Badam Khatai and Beson Khatai."

33. While Mr Ahmad also states that the aforementioned goods are packaged under the Tehzeeb mark, the 2 packaging invoices from "Print Leaflets Ltd" contained in **exhibit 1** are addressed to "Sweet Mahal T/A TAHZEEB", and only shows the purchase of "TAHZEEB" branded sweet and biscuit boxes (and therefore does not show use of the "TEHZEEB" mark). Nonetheless, I note that **exhibit RA2** contains 1 invoice, dated 9 January 2008 addressed to "Sweet Mahal T/A TEHZEEB", which shows the purchase of "TEHZEEB" branded boxes, sweet boxes, leaflets and packaging labels (and thus does show use Mr Ahmad's sign, albeit limited use).

34. In his witness statement, Mr Ahmad states that "*we do not keep sales record of individual brand, the reason behind not keeping the record is that we manufacture all products in our own factory ourselves. So, the turnover of a particular brand can only be estimated. I estimate the annual sales of "Tehzeeb" would be around £70,000 - £75,000*". I note that Mr Ahmad has not confirmed what years these annual sales pertain to, nor has he provided an approximate breakdown of the sales as per the aforementioned sweets and biscuit goods above. I have also not been provided with any supporting evidence such as invoices/receipts showing the sale of sweets and

biscuits to customers. On this point, I bear in mind that in the *PILLOW TALK* case,[1] Thomas Mitcheson KC, sitting as the Appointed Person, upheld the Hearing Officer's decision to reject as evidence of use of a trade mark the statement: "average annual turnover of the goods in Class 28, using the 'Pillow Talk' mark, during the relevant period, was £45,000" on the basis that additional material in support of this statement was non-existent. Applying this to the case before me, I find that all of the evidence above does not support Mr Ahmad's statement on the approximate sales made under the Tehzeeb mark (which nonetheless lacks the aforementioned details). I am therefore entitled to be sceptical of the approximate sales provided, and reject it as insufficiently solid.

35. I also note that the above evidence does not show use of the TEHZEEB mark by RA, but instead shows use by the companies Sweet Mahall Ltd and N Retail Ltd. While in his witness statement, Mr Ahmad confirms that he is the director of N Retail Ltd (formally known as Sweet Mahall Ltd), he has not provided me with, for example, any form of licencing agreement to show that Sweet Mahall Ltd/N Retail Ltd had permission to use his mark.

36. Therefore, taking all of the above into account, I find that the section 5(4)(a) case fails as I have not been provided with any evidence proving the existence of any protectable level of goodwill in RA and his sign at the relevant date.

37. The section 5(4)(a) claim has failed against TPL's mark. On this basis, TPL is entitled to rely upon all of its class 30 goods contained in paragraph 2 of this decision in its opposition against RA's mark.

TPL's opposition under Section 5(2)(b)

38. Section 5(2)(b) reads as follows:

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

[1] BL O/1160/23

(a)…

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

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

39. TPL's mark qualifies as an earlier mark in accordance with section 6(1)(a) of the Act as its filing date is earlier than the filing date of RA's mark. TPL's earlier mark has not completed its registration process more than five years before the relevant date (the filing date of RA's mark in issue). Accordingly, the use provisions at section 6A of the Act do not apply. TPL may rely on all of the goods it has identified without demonstrating that it has used the mark.

Section 5(2)(b) case law

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely

upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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

41. The competing goods and services are as follows:

TPL's goods	**RA's goods and services**
Class 30 Bakery products, pastries, puff pastries, pies, fruit tarts, trifles, biscuits, biscotti, crackers, wafers, waffles, cookies, macaroon; Cakes, and cake products including fruit cakes, plain tea cakes, iced cakes, fresh cream cakes, butter cream cakes, mousse cakes and other customized cakes; Bakery products based on flour; bread and bread products including pitta bread, naan bread, bread rolls, filled bread rolls, breadsticks, gingerbread, garlic bread, buns, croissants; desserts based on flour and chocolate including muffins, scones, pancakes, doughnuts, bagels; Swiss rolls, cream packed rolls, brownies, cake rusks, crispy rusks; wheat flour which can be filled with the mix of vegetables, minced meat, minced chicken and minced beef; samosa; crusty rolls; spring rolls, Cerealbased snack food, breakfast cereals, muesli; processed wheat for human consumption, rice-based snack	Class 29 Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps. Class 30 Coffee, tea, flour and preparations made from cereals, bread, pastry and confectionery, ices, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes. Class 43 Services for providing food and drink; restaurant, bar and catering services; booking and reservation services for restaurants.

foods; salty snacks which consists of flour and cereals; snacks being grain-based snack foods; wheat based snack foods, corn chips; Prepared meals consisting of pasta, macaroni and noodles; pizzas, Pizza pies, hot and cold filled rolls, pasta and pasta products, sandwiches, Hot dog sandwiches, Panini, Burgers contained in bread rolls, Hamburgers in buns, Cheeseburgers [sandwiches], Tacos, Quesadillas, Pasta Salads, Macaroni Salads, Salad dressings, Salad sauces, Condiments for foodstuff including spices, sauces, tomato sauce, food seasonings, Gravies, yeast, baking powder, sugar, sugar syrup, tea, ice tea, Honey and honey substitutes, vanilla (flavoring), Dessert puddings, Dessert souffles, Confectionery Products made of sugar, chocolate, toffees, Sweets, Candies, ice-cream, Coffee, cocoa, coffee or cocoa based beverages, chocolate based beverages, chocolate syrup, chocolate based ingredients for use in confectionery and bakery products, jelly confectionery, bakery desserts, Rice-based pudding dessert, Custards.	

42. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

44. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court ("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 für 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."

45. It is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

46. 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 OHIM,* Case T-325/06, the GC stated that "complementary" means:

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

47. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC (as he then was) noted, as the Appointed Person, *in Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes." Whilst on the other hand: "… it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

Whilst on the other hand:

> "… it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

Class 29

Prepared meals.

48. I find that RA's prepared meals in class 29 will encompass meat and vegetable meals which are sold in pre-cooked form, that would need reheating (either via the oven or microwave).

49. I therefore find that TPL's "spring rolls", "pizzas", "cheeseburgers [sandwiches]", "tacos" and "quesadillas" would fall within RA's broader category of "prepared meals", making the goods identical on the principle outlined in *Meric.*

Meat, […] poultry and game.

50. I find that TPL's "minced meat, minced chicken and minced beef" falls within RA's above broader category. The goods are identical on the principle outlined in *Meric.*

Milk products.

51. I find that TPL's "ice cream" and "custards" falls within RA's above broader category. The goods are identical on the principle outlined in *Meric.*

Potato crisps.

52. I consider that RA's above goods are similar to TPL's "corn chips". Whilst the nature of the goods differ, with TPL's goods being made from corn and RA's goods being made from potatoes, the goods are both types of snacks which can appear in the same form (crispy thin slices). I also find that these goods are likely to be produced by the same undertakings, and sold next to one another in the same aisle of a

supermarket. These goods are also likely to be in competition, as they are alternatives of each other. Consequently, I find that the goods are similar to a high degree.

Jellies, jams, compotes.

53. I find that RA's goods are similar to TPL's "honey". Whilst the nature of the goods differ (with TPL's goods deriving from bees, and RA's goods deriving from fruit), I find that the method of use and the purpose of the goods overlap as they are all typically used as sweet spreads on top of items such as toast. The goods would also be sold next to each other in the same aisle of supermarkets, and as they can be used for the same purpose, they may be, to some extent, in competition with one another. They will also overlap in user, but they are not complementary. Taking the above into account, I find that the goods are similar to a medium degree.

Meat extracts.

54. I find that "gravies" in TPL's specification are similar to "meat extracts" in RA's specification. They overlap to some extent in nature and purpose as they are both liquids made from meat and will both be used to add flavour to a dish. However, the method of use differs because meat extracts would normally be added during the cooking process to add flavour, whereas gravy is normally used as a sauce and poured onto the finished dish. The goods may be sold in close proximity in supermarkets, being placed in the same aisles. They are not in competition, nor complementary. I therefore consider that the goods are similar to between a low and medium degree.

Fish.

55. I consider that RA's above goods are similar to TPL's "minced meat, minced chicken and minced beef". Whilst the goods do not overlap in nature (fish vs meat), both the goods will be consumed by the general public, and eaten as the main protein element of a meal. I therefore consider that they are, to an extent, in competition with one another. The goods will not be produced by the same undertaking, however, there will be an overlap in distribution channels, being sold in close proximity to one another

in supermarkets (in the fridge or freezer aisles). I therefore consider that the goods are similar to between a low and medium degree.

Preserved, dried and cooked fruits and vegetables; soups.

56. I do not consider that the RA's above goods are similar to TPL's class 30 goods. I find that the parties' goods differ substantially in nature, such as texture, density and appearance. Although the goods are all intended to be and they will be consumed by the same users (the general public), I consider that these overlaps are at a very high level of generality which, without more, are insufficient to support a finding of similarity. The channels of trade will also coincide only at a superficial level: the goods will be sold in separate areas in supermarkets, normally in distinct aisles or sections. The goods are not in competition, nor are they complementary in the sense outlined in the case law above. Therefore, taking all of the above into account, I find that the parties' goods are dissimilar.

Eggs, milk; edible oils and fats.

57. As set out in *Les Éditions Albert René v OHIM*,[2] it is clear that just because a particular good is used as a part, element or component of another, it should not result in a finding of identity/similarity between those goods. However, it does not mean that there can never be similarity between such goods where there is overlap in the factors identified in *Treat*.

58. In this case, whilst TPL's "bakery products", "cakes", and "doughnuts" can be made using eggs, milk and edible oils and fats such as butter, it is clear that these components differ in nature and method of use with TPL's baked goods. Although the goods are all intended to be eaten and they will be consumed by the same users (the general public), I consider that these overlaps are at a very high level of generality which, without more, are insufficient to support a finding of similarity. The channels of trade will also coincide only at a superficial level: the goods will be sold in separate areas in supermarkets, normally in distinct aisles or sections. The goods are not in

[2] Case T-336/03

competition, nor are they complementary in the sense outlined in the case law above. Therefore, taking all of the above into account, I find that the parties' goods are dissimilar.

Class 30

Coffee; tea; bread; confectionery; sandwiches; pizzas; pies.

59. All of the above terms appear identically in both of the parties' class 30 specifications.

Sauces (condiments); spices.

60. Although expressed slightly differently, RA's above goods are self-evidently identical to "condiments for foodstuff including spices, sauces, tomato sauce, food seasonings" in TPL's specification.

Prepared meals; Pasta dishes.

61. I find that TPL's "prepared meals consisting of pasta, macaroni and noodles" fall within RA's above broader categories. The goods are identical on the principle outlined in *Meric.*

Flour and preparations made from cereals.

62. Although expressed slightly differently, RA's "flour" is self-evidently identical to TPL's "processed wheat for human consumption".

63. I also note that preparations made from cereals includes pasta, bread, cereals, cakes and biscuits. I therefore find that TPL's "bakery products", "biscuits", "cakes", "bread", "cerealbased snack food", "breakfast cereals" and "pasta and pasta products" fall within RA's broader category of "preparations made from cereals". The goods are identical on the principle outlined in *Meric.*

Ices.

65. RA's above goods would cover edible ices such as "ice-cream", a term which is contained in TPL's class 30 specification. On this basis, I find that the goods are identical on the principle outlined in *Meric.* However, if I am wrong in this finding, the goods overlap in trade channels, nature, purpose, method of use and user, making them similar to a high degree.

Pastry

64. I find that TPL's "pastries" are similar to RA's "pastry". The goods clearly overlap in nature, method of use and purpose. While the goods will be sold in supermarkets, they are unlikely to be sold in close proximity (with pastry needing to be refrigerated and pastries being located in the baked item aisle). I do not consider that the goods are complementary (as the users are unlikely to think that the goods originate from the same undertaking), however, I find that they are likely to be in competition (with the user either choosing to make pastries from pastry or purchasing the ready-made pastries). I find that that the parties' goods are similar to a medium degree.

Ice.

66. I note that RA's above goods would cover ice cubes, crushed ice or cooling ice. Unlike TPL's "ice-cream", ice is not a snack or dessert, but is mainly used in drinks or beverages in order to cool them. Whilst the goods at issue are all frozen, their nature is different because ice cream is a foodstuff whereas ice is an auxiliary product used for preserving and/or cooling foodstuffs and beverages. Accordingly, their purpose and nature is different and furthermore, they are neither in competition nor complementary. The channels of trade will also coincide only at a superficial level (being sold in supermarkets) and I do not find that this alone, along with an overlap in user, is enough to find similarity between them. On this basis, I find that they are dissimilar.

Class 43

Services for providing food and drink; restaurant, bar and catering services.

67. RA's above services and TPL's foodstuffs clearly differ in nature, method of use and purpose. However, I accept many of TPL's goods will likely be used as ingredients within the meals served at cafés, restaurants and bars (which is encompassed by "services for providing food and drink"). I consider that the user is likely to believe that the class 30 goods that TPL relies upon, including breads, cakes, coffee and sauces, for example, originate from the same undertaking as RA's services. For example, the user is likely to believe that restaurants make their own sauces as well as providing the restaurant services, coffee shops make their own coffee as well as providing bar services, and cafés make their own bread and cake as well as offering a service for providing food and drink. I also bear in mind that in paragraph 20 of *Foundation for the Protection of the Traditional Cheese of Cyprus named Halloumi v Fontana Food AB* [2024] EWHC 2311 (Ch) it was highlighted that undertakings such as Starbucks, Pizza Express and Nando's sell food products separately to providing coffee shop and restaurant services. I find that these goods could be sold from the premises of the coffee shop or restaurant, or they could be sold in the aisles of supermarkets. Nonetheless, I find that there could be an overlap in trade channels (with the same undertakings selling/providing all of the goods and services).

68. However, I find it unlikely that consumers will go to a restaurant or bar in lieu of the supermarket if they wanted pasta or cake, for example. Moreover, TPL's goods are likely to be purchased to stock the user's cupboards whereas RA's restaurant services are used for a singular sit-down meal (with included ambience). Taking these factors into account, I do not consider that the goods are a competitive choice with the services, and vice versa. Therefore, taking all of the above into account, I find that the goods and services are similar, but to between a low and medium degree.

Booking and reservation services for restaurants.

69. I do not consider that RA's above booking and reservation services for restaurants are similar to TPL's class 30 food goods. They clearly do not overlap in nature, method of use or purpose. RA's services would be provided by third party undertakings which allow users to book and reserve tables at restaurants and therefore I do not consider that these services overlap in trade channels with TPL's foodstuffs. The goods and services are neither in competition nor complementary in the way described by the

case law cited above. While there may be an overlap in user, this is not enough on its own to establish similarity. Taking all of the above into account, I find that TPL's goods and RA's services are dissimilar.

70. It is a prerequisite of section 5(2)(b) that the goods and services be identical or at least similar. The opposition will, therefore, fail in respect of the goods and services that I have found to be dissimilar.[3] The opposition under section 5(2)(b) fails for the following goods and services:

Class 29 Preserved, dried and cooked fruits and vegetables; eggs, milk; edible oils and fats; soups.

Class 30 Ice.

Class 43 Booking and reservation services for restaurants.

The average consumer and the nature of the purchasing act

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

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word

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

> “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

72. The average consumer for the goods will be members of the general public. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The majority of the goods will be purchased relatively frequently, most likely as part of a weekly food shop. Even where the cost of purchase is low, various factors will be taken into consideration such as the cost, taste, nutritional content and the ingredients, especially to reflect the users’ dietary requirements which could encompass a vegetarian or vegan lifestyle, or any allergens to avoid. Therefore, I consider that the level of attention paid during the purchasing process will be between a low and medium degree.

73. The average consumer for the services will also be members of the general public. The cost of the purchase is likely to be relatively low and the frequency is likely to vary. The average consumer will take various factors into consideration when selecting the services such as the cost, location, ease of access, availability of products and the inclusivity of dietary requirements. Therefore, I consider that the average consumer will pay a medium degree of attention during the purchasing process.

74. The goods are likely to be obtained by self-selection from shelves of a supermarket, food store, their online equivalents or via food/drink establishments such as cafés and restaurants. The services are likely to be provided by restaurants, bars or catering companies. The services will be selected having viewed street signage, promotional materials, or after undertaking internet searches. Visual considerations for both are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from sales assistants or word-of-mouth recommendations.

Comparison of the trade marks

75. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and

conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

76. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

77. The respective trade marks are shown below:

TPL's trade mark	RA's mark
Tehzeeb	Tehzeeb SWEETS & BAKERS

78. TPL's mark consists of a red circle device, which contains 7 yellow decorative lines starting from the outer part of the circle, curling near the centre. Underneath this device is the invented word "Tehzeeb", presented in red standard typeface. Although the eye is naturally drawn to the element of the mark that can be read, given the size and positioning of the circle device, I consider that it plays a roughly equal role in the overall

impression with the word “Tehzeeb”, with the stylisation of the word “Tehzeeb” playing a lesser role.

79. RA’s mark consists of a red circle device, which contains 7 yellow decorative lines starting from the outer part of the circle, curling near the centre. Underneath this device is the invented word “Tehzeeb”, presented in red standard typeface. Below this, in a smaller typeface, is the wording “SWEETS & BAKERS”, which I find to be descriptive of some of RA’s foodstuff goods and the provision of food services. Although the eye is naturally drawn to the element of the mark that can be read, given the size and positioning of the circle device, I consider that it plays a roughly equal role in the overall impression with the word “Tehzeeb”, with the stylisation of this word playing a lesser role alongside the wording “SWEETS & BAKERS”.

80. Visually, the marks coincide in the word “Tehzeeb” presented in the same standard typeface, albeit in a slightly different shades of red. The red circle device which contains 7 yellow curving lines is identical in both marks (again in slightly different shades of red and yellow), both of which are placed at the top of the mark, with the word “Tehzeeb" underneath. These all act as visual points of similarity. However, RA’s mark also consists of the wording “SWEETS & BAKERS” at the bottom of the mark. Albeit this element is descriptive of some of RA’s goods and services, it nonetheless acts as a visual point of difference. On this basis, I find that the marks are visually similar to a high degree.

81. Aurally, the circle device in both of the parties’ marks will not be articulated. I also find that the “Tehzeeb” element could be pronounced as TUH-ZEEB or TAY-ZEEB. Nevertheless, I will be given the same pronunciation in both marks by the average consumer. While I have noted above that the “SWEETS & BAKERS” element of RA’s mark is allusive, this does not mean that it is aurally invisible.[4] Consequently, this is will articulated at the end of RA’s mark. On the basis that the “Tehzeeb” element is aurally identical in both of the parties’ marks, I find that as a whole, the marks are aurally similar to a medium degree.

[4] *Purity Wellness Group Ltd v Stockroom (Kent) Ltd*, Case BL-O/115/22

82. Conceptually, I find that the word “Tehzeeb” in both of the parties’ marks will be recognised by the average consumer as an invented word with no conceptual meaning. This element is, therefore, conceptually neutral. I also find that the circle device in both of the parties’ marks does not evoke a meaning, however, the wording “SWEETS” and “BAKERS” in RA’s mark are ordinary dictionary words which will be assigned their usual meanings. I also note that the ampersand (&) will be recognised as meaning the word “and”. Therefore the “SWEETS & BAKERS” element, albeit descriptive of the goods, provides a conceptual point of difference.

Distinctive character of the earlier trade mark

83. 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 C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of 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).”

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

85. I will begin by assessing the inherent distinctive character of TPL's mark. As noted above, TPL's mark consists of a red circle device, which contains 7 yellow decorative curved lines. Underneath the circle device is the invented word "Tehzeeb" which is neither allusive nor descriptive of TPL's goods. I therefore find that TPL's mark is inherently distinctive to a high degree.

86. I will now assess whether the evidence filed by TPL is sufficient to demonstrate enhanced distinctiveness. Typically, parties would be expected to provide evidence of turnover figures, numbers of units sold and invoices showing the sale of its goods to customers geographically spread across the UK. I would also expect to see marketing figures and examples of advertising (including social media accounts and its following) in the UK. I have not been provided with any of this evidence, which is plainly information which should have been available and relatively easy to provide. I note that the majority of TPL's evidence pertains to its copyright claim, which I will assess in the relevant section later in this decision. I also bear in mind that the relevant market for assessing enhanced distinctiveness is the UK market, and therefore any evidence which pertains to Pakistan (the majority of which TPL's evidence does) is not relevant in this assessment. Consequently, the only evidence filed by TPL which is relevant is the following Wayback Machine screenshots of its website provided in **exhibit KN3a** and **KN3b**:

87. I bear in mind that these screenshots are dated 22 July 2013 and 28 October 2014, which clearly falls before the relevant date. However, whilst one of the screenshots depicts some food items, there is no clear list of goods that TPL sells (including prices and quantities available). There is also no option for the user to purchase these goods online, and whilst TPL clearly has stores (as indicated by the tab heading "Our Locations"), the website screenshots do not show me where these stores are located (and if they are even located in the UK). As noted in paragraph 26 above, the screenshots are of a .com website which can be accessed all over the world, and I have not been provided with any supporting evidence regarding the number of websites views or users of the website who are based in the UK.

88. Therefore, taking all of the above into account, I find that the screenshot website evidence on its own is not sufficient to establish enhanced distinctiveness.

Likelihood of confusion

89. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

90. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to a high degree.
- I have found the marks to be aurally similar to a medium degree.
- The invented word “Tehzeeb” in both marks to be conceptually neutral, but the “SWEETS & BAKERS” element in RA’s mark provides a conceptual point of difference.
- I have found the earlier mark to be inherently distinctive to a high degree.
- I have identified the average consumer as members of the general public, who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that a between a low and medium degree of attention will be paid during the purchasing process for the goods.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the services.
- I have found the parties’ goods to range from being identical to similar to between a low and medium degree.
- I have found the parties’ goods and services to be similar to between a low and medium degree.

91. Taking all of the above into account, considering the principle of imperfect recollection, I am satisfied that the parties’ marks are likely to be mistakenly recalled or misremembered as each other. This is on the basis that both marks consist of the invented word “Tehzeeb” presented underneath a red circle device with 7 yellow curving lines. While the marks are presented in slightly different shades of red and yellow, this would be easily overlooked by the average consumer. Moreover, whilst the wording “SWEETS & BAKERS” at the bottom of RA’s mark acts as a visual point of difference, as noted above, this is descriptive of some of RA’s goods and services. This wording would therefore be easily overlooked by the average consumer, especially as its plays a lesser role in the overall impression of the mark.

92. I find that there is a likelihood of direct confusion, even on the goods and services which are similar to between a low and medium degree, due to the effect of the interdependency principle.

93. I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis QC sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10:

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

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

95. I consider that the shared common use of the word "Tehzeeb" alongside the circle devices which contain the 7 yellow curved lines, will lead the average consumer to conclude that they originate from the same or economically linked undertakings. As noted above, "Tehzeeb" will be perceived by the average consumer as an invented word which evokes no conceptual meaning, and therefore the use of the invented word "Tehzeeb" (alongside the circle device) is so strikingly distinctive that the average consumer would consider only one undertaking to be using it. Furthermore, as the "SWEETS & BAKERS" element at the bottom of RA's mark is descriptive of some of RA's goods and services, I find that the average consumer will perceive the addition

of this element as being an updated presentation/version of TPL's mark, indicative of re-branding, or a sub-brand mark (TEHZEEB being the house brand and TEHZEEB SWEETS & BAKERS being the sub-brand mark). Consequently, I find there to be a likelihood of indirect confusion, even on the goods and services which are similar to between a low and medium degree, due to the effect of the interdependency principle.

96. The opposition based upon section 5(2)(b) partially succeeds.

TPL's opposition under Section 5(4)(b)

97. TPL's case under this ground of opposition is as follows:

> "The Tehzeeb logo was authorised by Mr. Khalil Ahmed Noon and Mr. Liaquat Ali Nood (Rawalpindi, Pakistan) in the year 2011 and was published (Rawalpindi, Pakistan) in the same year. Mr. Khalil Ahmed Noon is the Director/CEO of Tehzeeb (Pvt.) Ltd and the [TPL] became the owner of the copyright in the logo owing to an assignment which took place in the year 2017. Copyright in the Tehzeeb logo has been officially registered in the Pakistan Register of Copyrights under Registration No. 35887, with a registration date of 15 September 2017. A copy of the official Certificate of Registration is attached hereto in support of this claim.
>
> Pakistan is both a party to the Berne Convention and member of WTO. It follows that [TPL] has the same rights in the UK as would a UK company incorporated under the law of the UK. [TPL's] copyright in the work is therefore enforceable in the UK under the CDPA.
>
> Section 16(2) and 3 of the CDPA provides that the copyright in a work is infringed by a person who without the licence of the copyright owner does, or authorises another to do, any of the acts restricted by the copyright, which include copying, in relation to the work as a whole or any substantial part of it, and either directly or indirectly. Upon a visual comparison of the two logos, it is plain to see that the similarities are so extensive that they are be more likely to be the result of copying than of coincidence: what has been taken constitutes

the entirety of the copyright work. Further, it is submitted that [RA] had prior access to the copyright work. The burden therefore lies with [RA] to satisfy the Registrar that, despite the similarities, they did not result from copying."

98. TPL states that taking all of the above into account, RA's application should be refused.

Relevant law

99. Section 5(4)(b) of the Act states:

> "(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –
>
> […]
>
> (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) or (aa) above, in particular by virtue of the law of copyright or the law relating to industrial property rights.
>
> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

100. The law of copyright in the United Kingdom is governed by the Copyright, Designs and Patents Act 1988 ("CDPA"), and in accordance with this, I must assess whether:

1. Is the earlier mark a work that is capable of being protected by copyright?
2. Who is the owner of the work and when was it created?
3. Does the work meet the qualification criteria for copyright protection?
4. Would use of the contested mark constitute an infringement of any copyright?

Is the earlier mark a work capable of being protected by copyright?

101. Section 1 of the CDPA states that:

"Copyright is a property right which subsists in accordance with this Part in the following descriptions of work–

(a) original literary, dramatic, musical or artistic works,
(b) sound recordings, films or broadcasts, and
(c) the typographical arrangement of published editions."

102. Section 4 of the CDPA is as follows:

"(1) In this Part 'artistic work' means-

(a) a graphic work, photograph, sculpture or collage, irrespective of artistic quality,
(b) a work of architecture being a building or a model for a building, or
(c) a work of artistic craftsmanship.

(2) In this Part –

[…]

graphic work' includes –

(a) any painting, drawing, diagram, map, chart or plan, and
(b) any engraving, etching, lithograph, woodcut or similar work;

[…]"

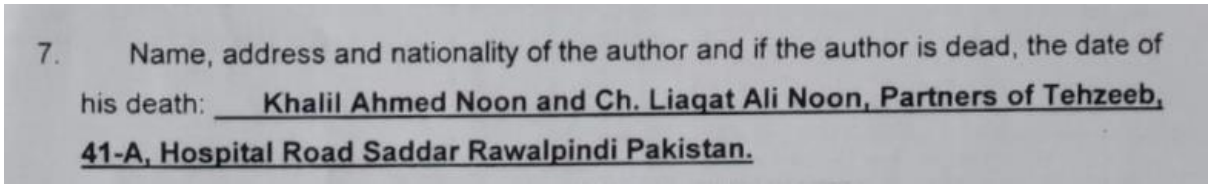
103. In *Griggs Group Ltd v Evans*, [2003] EWHC 2914 (Ch), Peter Prescott QC, as a deputy judge of the High Court, said:

"18. … a drawing is capable of being a 'work'. So if an artist uses his skill and labour to draw a word or phrase in a stylised way, as in the case of a logo, his drawing is capable of being an original work, protected by copyright law."

104. Taking all of the above into account, I consider that TPL's "Tehzeeb logo" is a graphic work capable of being protected by copyright.

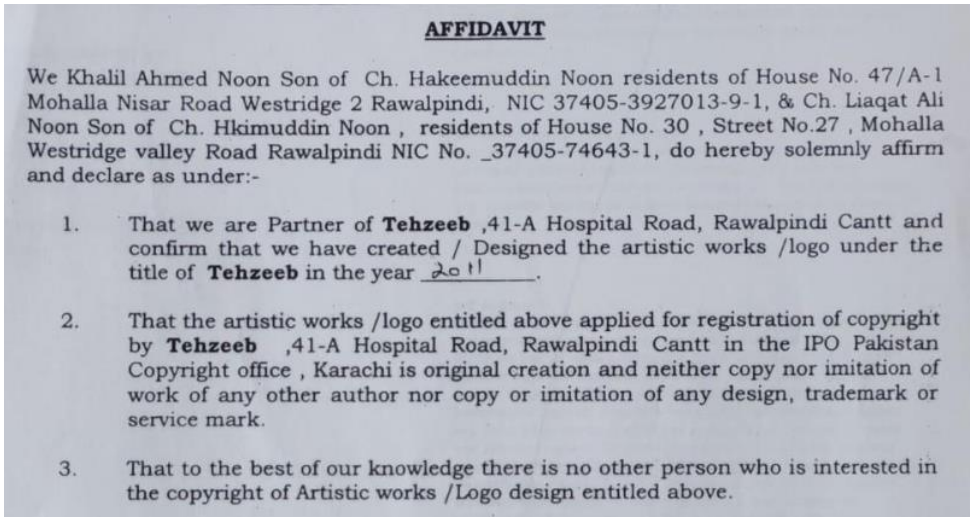
The creation and ownership of the work

105. In Mr Noon's witness statement, he confirms that the Tehzeeb logo was "designed and authored" by himself and Mr Liaquat Ali Noon in 2011, and it was also first published in Rawalpindi, Pakistan in 2011. The "copyright for the logo was first applied for at the Pakistan Intellectual Property Office" by himself and Mr Liaquat Ali Noon on 5 November 2012. The copyright filing application for the Tehzeeb logo and a screenshot from the Pakistan IPO database is provided within **exhibit KN2b**, which lists the authors of the copyright as follows:



7. Name, address and nationality of the author and if the author is dead, the date of his death: **Khalil Ahmed Noon and Ch. Liaqat Ali Noon, Partners of Tehzeeb, 41-A, Hospital Road Saddar Rawalpindi Pakistan.**

106. The application form also has an attached affidavit which states the following:



AFFIDAVIT

We Khalil Ahmed Noon Son of Ch. Hakeemuddin Noon residents of House No. 47/A-1 Mohalla Nisar Road Westridge 2 Rawalpindi, NIC 37405-3927013-9-1, & Ch. Liaqat Ali Noon Son of Ch. Hkimuddin Noon , residents of House No. 30 , Street No.27 , Mohalla Westridge valley Road Rawalpindi NIC No. _37405-74643-1, do hereby solemnly affirm and declare as under:-

1. That we are Partner of **Tehzeeb** ,41-A Hospital Road, Rawalpindi Cantt and confirm that we have created / Designed the artistic works /logo under the title of **Tehzeeb** in the year 2011.

2. That the artistic works /logo entitled above applied for registration of copyright by **Tehzeeb** ,41-A Hospital Road, Rawalpindi Cantt in the IPO Pakistan Copyright office , Karachi is original creation and neither copy nor imitation of work of any other author nor copy or imitation of any design, trademark or service mark.

3. That to the best of our knowledge there is no other person who is interested in the copyright of Artistic works /Logo design entitled above.

107. It is therefore clear that the copyright was applied for under the company name "Tehzeeb". I also bear in mind that a depiction of the artistic work, being the Tehzeeb logo, is shown as follows in the application:

108. On 28 August 2017, the partners of “Tehzeeb", including Mr Ahmed Noon and Mr Liaquat Ali Noon, assigned the copyright of its artistic work to TPL. This is evidenced in the Assignment Deed contained in **exhibit KN5**. I bear in mind that section 90 of the CDPA confirms that copyright is transmissible by assignment, and it must be in writing, signed by or on behalf of the assignor. In this instance, the Deed is clearly signed by Mr Khalil Ahmed Noon and Mr Liaquat Ali Noon, who are listed by the assignors, and the assignee is listed as “TEHZEEB (PVT) LIMITED”.[5] This evidence is supported by **exhibit KN4b**, which contains a Certificate of Registration of Copyright dated 15 September 2017, which shows that the artistic work entitled TEHZEEB was authored by “Mr Khalil Ahmed Noon & other” in 2011, and has been registered in the Registry of Copyrights in the name of “TEHZEEB (PVT) LIMITED, 41-A HOSPIITAL ROAD SADDAR, RAWALPINID”.

109. Taking all of the above into account, I find that TPL is the owner of the work and that it was created and published before the relevant date in these proceedings.

Whether the work meets the qualification criteria for copyright protection

110. Section 153 of the CDPA states that copyright does not subsist in a work unless certain conditions are met. These are set out in the following sections of the Act and relate to the citizenship or residence of the author at the time the work was created or published, or the place where it was first published. As noted above, the logo was first published in Pakistan.

111. Section 159(1) of the CDPA states that:

[5] While I note that TPL in these proceedings is Tehzeeb (Private) Limited, “PVT” is a common abbreviation in many jurisdictions to signify that it is a private limited company.

"Where a country is party to the Berne Convention or a member of the World Trade Organisation, this Part, so far as it relates to literary, dramatic, musical and artistic works, films and typographical arrangements of published editions-

[…]

(c) applies in relation to a work first published in that country as it applies in relation to a work first published in the United Kingdom."

112. Pakistan is a member of the World Trade Organisation and so the work qualifies for copyright protection.

Whether use of the mark would constitute an infringement of the copyright in the work

113. Section 16 of the CDPA is the relevant legislation and reads as follows:

"(1) The owner of the copyright in a work has, in accordance with the following provisions of this Chapter, the exclusive right to do the following acts in the United Kingdom –

(a) to copy the work (see section 17);

(b) to issue copies of the work to the public (see section 18);

(ba) to rent or lend the work to the public (see section 18A);

(c) to perform, show or play the work in public (see section 19);

(d) to communicate the work to the public (see section 20);

(e) to make an adaptation of the work or do any of the above in relation to an adaptation (see section 21);

and those acts are referred to in this Part as the 'acts restricted by the copyright'.

(2) Copyright in a work is infringed by a person who without the licence of the copyright owner does, or authorises another to do, any of the acts restricted by the copyright.

(3) References in this Part to the doing of an act restricted by the copyright in a work are to the doing of it –

(a) in relation to the work as a whole or any substantial part of it, and

(b) either directly or indirectly;

and it is immaterial whether any intervening acts themselves infringe copyright."

114. Section 17 of the CDPA provides that:

"(1) The copying of the work is an act restricted by the copyright in every description of copyright work; and references in this Part to copying and copies should be construed as follows.

(2) Copying in relation to a literary, dramatic, musical or artistic work means reproducing the work in any material form.

This includes storing the work in any medium by electronic means.

(3) In relation to an artistic work copying includes the making of a copy in three dimensions of a two-dimensional work and the making of a copy in two dimensions of a three-dimensional work.

[…]

(6) Copying in relation to any description of work includes the making of copies which are transient or are incidental to some other use of the work."

115. In *Designers Guild Ltd v Russell Williams (Textiles) Ltd (t/a Washington DC),* [2000] 1 WLR 2416, Lord Millett set out the approach to assessing whether artistic copyright has been infringed at [2425]-[2426]. He said:

"The first step in an action for infringement of artistic copyright is to identify those features of the defendant's design which the plaintiff alleges to have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied on are sufficiently close, numerous or extensive to be more likely to be the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are too commonplace, unoriginal or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying.

[…]

Once the judge has found that the defendant's design incorporates features taken from the copyright work, the question is whether what has been taken constitutes all or a substantial part of the copyright work. This is a matter of impression, for whether the part taken is substantial must be determined by its quality rather than its quantity. It depends upon its importance to the copyright work. It does not depend upon its importance to the defendant's work, as I have already pointed out. The pirated part is considered on its own (see *Ladbroke (Football) Ltd v William Hill (Football) Ltd* [1964] 1 WLR 273, 293, per Lord Pearce) and its importance to the copyright work assessed. There is no need to look at the infringing work for this purpose."

116. In its Notice of Opposition (Form TM7), TPL stated that "*upon a visual comparison of the two logos, it is plain to see that the similarities are so extensive that they are more likely to be the result of copying than of coincidence: what has been taken constitutes the entirety of the copyright work."*

117. I also bear in mind that the editors of *Copinger and Skone James on Copyright*, 18th edition, explained (with footnotes omitted) that:

> "7-53. The essential test is whether the defendant's work has been produced by the substantial use of those features of the claimant's work which, by reason of the knowledge, skill and labour employed in their production, constitute it an original copyright work. The test has been put in a number of similar ways. Has the infringer incorporated a substantial part of the independent skill, labour, etc. contributed by the original author in creating the copyright work? Has there been a substantial appropriation of the independent labours of the author? Has there been an appropriation of a part of the work on which a substantial part of the author's skills and labour was expended? Has there been an 'overborrowing' of the skill, labour and judgment which went into the making of the claimant's work? Has the defendant made a substantial use of those features of the claimant's work in which copyright subsists?"

118. The protected work is as follows:

119. In my view, the substantial part of the knowledge, labour and skill contributed by the original author to the protected work is expressed in both the red circular device which contains 7 yellow decorative curved lines, and the word "Tehzeeb" presented in a red standard typeface.

120. I bear in mind that RA's contested mark is as follows:

121. When viewed side-by-side, I find that the only differences between the protected work and the contested mark is the addition of the words "SWEETS & BAKERS" at the bottom of the contested mark, and that the marks appear to be presented in slightly different variations of the same colours (with the colours red and yellow appearing slightly brighter in the contested mark). However, it is my view that the design of the circular device containing the 7 yellow decorative curved lines, and the word "Tehzeeb", is where a substantial part of the author's labour would have been expended, rather than the specific shade of red and yellow used per se.

122. I also note that in its Form TM7, TPL submits that RA had "prior access to the copyright work". However, no evidence has been adduced to support this. Nonetheless, it is my view that, the similarities between the circular device and the words "Tehzeeb" (as well as the highly similar use of colours), and how they are presented (with the circular device at the top of the mark, and the word "Tehzeeb" presented underneath, central to the device), is more likely to be the result of copying than coincidence. The burden then passes to RA to satisfy me that the similarities did not result from copying.

123. RA has provided evidence alongside his first and second witness statement to show that they were using the "Tehzeeb" mark before the protected mark was authored in 2011. I note the following from RA's evidence:

1. **Exhibit EH1** contains an invoice from "PRINT LEAFLETS LTD" dated 18 February 2010. The invoice is addressed to "Sweet Mahal, T/A TAHZEEB", and contains an order for "Tahzeeb" sweet and biscuit boxes.

2. **Exhibit EH1** also contains a second invoice from “PRINT LEAFLETS LTD” containing an order for “Tahzeeb” sweet and biscuit boxes. However, I note that the invoice is again addressed to “N Retail Ltd T/A TAHZEEB” and it is dated 12 June 2023.
3. **Exhibit RA2** contains an invoice from “Printech Printers” dated 9 January 2008. The invoice is addressed to “Sweet Mahal, T/A TEHZEEB” and contains an order for “TEHZEEB” boxes, sweet boxes, leaflets and packaging labels.
4. **Exhibit RA2** also contains an invoice from “media east” dated 6 May 2003. The invoice is addressed to “Sweet Mahal Ltd”, but “ordered by: R Ahmad”. Under the invoice description it says that the invoice is for “Logo design Development ‘TEHZEEB’, three design options and then final development and final variations of one final design” which amounted to £150.

124. While Mr Ahmad in his first witness statement clarifies that he is the director of N Retail Limited, which was previously operating under Sweet Mahall Ltd, I have not been provided with any exhibited evidence to confirm if Sweet Mahall Ltd (and subsequently N Retail Limited) had permission to use the contested mark which is registered in the name of Mr Ahmad. Nevertheless, I also note the two following deficiencies with RA’s evidence:

1. Firstly, the invoice evidence contained in **exhibit EH1** pertains to the mark “Tahzeeb” not “Tehzeeb”.
2. Secondly, the invoice evidence in **exhibit EH2** does not show use of the contested mark. Only the “Tehzeeb” element is identifiable in the product description on the invoices, and whilst Mr Ahmad has provided photographic evidence of the mark being used on posters and boxes in **exhibit 1**,[6] this evidence is undated and therefore cannot be used to support and establish that the contested “Tehzeeb” mark was used by RA before 2011.

125. Consequently, taking all of the above into account, I do not consider that RA’s evidence is sufficient to explain the origin of the contested mark. I therefore find that use of this mark is liable to be prevented by the law of copyright.

[6] Shown at paragraph 28 of this decision

126. The opposition fully succeeds under section 5(4)(b).

CONCLUSION

RA's opposition

127. RA's opposition under section 5(4)(a) was unsuccessful and therefore TPL's UK00003865351 application may proceed to registration.

TPL's opposition

128. Subject to any successful appeal against my decision, the opposition under section 5(2)(b) was partially successful, and the opposition under section 5(4)(b) was successful in its entirety.

129. Therefore RA's UK00003923747 application is refused in its entirety.

COSTS

130. TPL has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023.

131. In the circumstances, I award TPL the sum of £1,750 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering RA's counterstatement	£250
Considering RA's Notice of opposition and preparing a counterstatement	£250
Preparing and filing evidence	£700

Preparing and filing submissions in lieu of a hearing	£350
Official Fee	£200
Total	**£1,750**

132. I therefore order Rana Ahmad to pay Tehzeeb (Private) Limited the sum of £1,750. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 20th day of October 2025

L FAYTER

For the Registrar