O/1043/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3868844
IN THE NAME OF MOHASINKHAN PATHAN
TO REGISTER THE FOLLOWING TRADE MARK:

IN CLASSES 29, 30, 32, 39 & 43

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 441819
BY RAJESH RAJNI SOMAIYA

Background and pleadings

1. On 17 January 2023, Mohasinkhan Pathan ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK, under number 3868844 ("the applicant's mark"). Details of the application were published for opposition purposes on 7 April 2023. Registration is sought for the following goods and services:

Class 29: Meat, fish and poultry; meat extracts; preserved, dried and cooked fruits, nuts and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps; fruit bars, nut bars, seeded bars; milkshakes.

Class 30: Indian and English coffees, Indian and English teas, cocoa and hot chocolate, malt drinks, sugar, rice, tapioca, sago, artificial coffee, Indian masalas; flour and preparations made from cereals; honey, treacle; syrup; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; ready meals made predominately of rice and pasta; waffles; sandwiches; prepared meals; pizzas, pies and pasta dishes; yoghurt coated bars, sugar coated bars and chocolate bars containing a mixture of grains, nuts and dried fruit.

Class 32: Mineral and aerated waters; smoothies, slushes; fruit drinks and fruit juices; syrups for making beverages; de-alcoholised drinks, non-alcoholic beers and wines including mocktails.

Class 39: Delivery of food by restaurants; delivery of food; food delivery; delivery of hampers containing food and drink; delivery of food and drink prepared for consumption; food delivery services; packaging of food.

Class 43: Services for providing food and drink; restaurant, bar and catering services; takeaway services; takeaway food services; take-away

restaurant services; take-away food services; takeaway food and drink services; take-away food and drink services; take-away fast food services; take-out restaurant services; fast-food restaurant services; catering (food and drink -); food and drink catering; catering of food and drink; restaurant services for the provision of fast food; fast food restaurants; restaurants; serving food and drinks; restaurant and bar services; restaurant services; provision of food and beverages; providing food and drink in bistros; take away food and drink services; coffee shops.

2. On 7 July 2023, Rajesh Rajni Somaiya ("the opponent") opposed the application in full under ss.5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

3. Under s.5(2)(b), the opponent relies upon their UK trade mark number 3188283, **GupShup** ("the opponent's mark"). The opponent's mark was filed on 28 September 2016 and became registered on 30 December 2016. It stands registered for goods and services in classes 29 and 43. For the purposes of the opposition, the opponent only relies upon *restaurant services; takeaway services* in class 43.

4. The opponent's mark qualifies as an 'earlier trade mark' in accordance with s.6 of the Act. As it had been registered for more than five years at the filing date of the applicant's mark, it is subject to the use requirements specified in s.6A of the Act.

5. In their notice of opposition, the opponent contends that the competing marks are similar and that the parties' goods and services are identical or similar. On this basis, the opponent submits that there is a likelihood of confusion, including the likelihood of association. The opponent states that they have used their mark for the services relied upon.

6. Under s.5(4)(a), the opponent claims that they have goodwill in relation to which they have used the sign **GupShup** ("the opponent's sign") in Hale, Greater Manchester, since 2019. The sign is said to have been used in relation to *restaurant services; takeaway services*. The opponent argues that use of the applicant's mark would constitute passing off.

7. The applicant filed a counterstatement, denying the grounds of opposition. The applicant also indicated that they would require the opponent to provide proof of use of their mark.

8. Both parties are professionally represented; the opponent by Wilson Gunn and the applicant by Hawkins Law. Only the opponent filed evidence. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following careful consideration of all the papers before me.

Relevance of EU law

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

Evidence

10. The opponent's evidence is given in the witness statement of Shital Somaiya ("SS"), together with 18 exhibits (SS1-SS18). SS is the Managing Director of A Squared Eats Ltd ("the company"). They provide evidence as to the company's use of the opponent's mark.

11. The opponent also filed a witness statement, within which they confirm that (i) they are a shareholder of the company and (ii) the company's use of the opponent's mark is with their consent.

12. I have taken the evidence into account in reaching my decision and will refer to it below where necessary.

Proof of use

13. The relevant statutory provisions are as follows:

> "6A – (1) This section applies where
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> (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."

14. Moreover, s.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."

15. Pursuant to the above provisions, the relevant period for assessing whether, or the extent to which, there has been genuine use of the opponent's mark is the five-year period ending with the filing date of the applicant's mark, i.e. 18 January 2018 to 17 January 2023.

16. 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure

customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de*

minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

17. SS says that, since 2019, the company has operated an Indian food restaurant and takeaway business under the opponent's mark in Hale (near Manchester). A menu for the restaurant, dated March 2022, from its Google Maps account has been provided.[1] The company is said to have accrued the following turnover in respect of its restaurant and takeaway services:

Year	Turnover (£)
2020	748,842
2021	799,965
2022	723,988
Total	2,272,795

18. A printout from Tripadvisor shows that 'GupShup', Hale, had a rating of 4.5/5 from 150 reviews.[2] As the printout is undated, I infer that it shows the website as at the date of SS' statement (20 November 2023). Further printouts from Tripadvisor, dated between 6 October 2020 and 22 September 2022, show reviews from customers of the restaurant.[3] Some indicate that they are repeat customers. The restaurant also had a rating of 4.4/5 on Google.[4] SS says that the printout was obtained on 3 November 2023.

19. SS says that takeaway services account for around 15% of annual turnover. Based upon the above figures, this would have equated to around £340,000 from 2020-2022. They explain that the takeaway services are provided through Deliveroo and the restaurant's own software application. A printout of the 'GupShup' page on Deliveroo,

[1] Exhibit SS15
[2] Exhibit SS1
[3] Exhibit SS2
[4] Exhibit SS17

dated 19 October 2021, is in evidence.[5] At that date, it had a rating of 4.6/5 from 42 ratings.

20. According to SS, 'GupShup' is active on social media. A printout from its Instagram account is in evidence. The account has nearly 6,000 followers. Although SS confirms that the printout was obtained on 3 November 2023, their unchallenged narrative evidence is that the number of followers would have been no less than 5,000 at the relevant date.

21. SS says that 'GupShup' has a particularly high profile because of its co-owner, the opponent, appearing on television shows *Real Housewives of Cheshire*, *My Big Fat Asian Wedding* and *Ultimate Wedding Planner*. A printout from the 'GupShup' Instagram account dated 17 August 2022 shows a post announcing a forthcoming show on BBC2; the opponent, Sara Davies (*Dragons' Den*) and Fred Sirieix (*First Dates*) were set to be judges and mentors in a wedding planning competition.[6] Another Instagram post, dated 19 August 2022, shows the opponent and the other two judges/mentors at the 'GupShup' restaurant.[7] Both posts had over 200 likes.

22. The restaurant is said to benefit from its popularity amongst celebrities in that its reputation has been substantially enhanced and extended to cover a large geographical area. An article from *Manchester Evening News*, dated 26 July 2022, has been provided in support.[8] It is entitled 'Inside the curry house so popular even Molly-Mae Hague struggles for a seat in Hale'. The article describes how highly the reality star rates the restaurant and that she posted about it to her 6million Instagram followers. The article also says that the restaurant's head chef recently appeared on BBC's *Great British Menu*.

23. Further examples of press articles about the restaurant have been provided.[9] Those which are dated are from between 7 November 2019 and 14 June 2021.[10] The

[5] Exhibit SS16
[6] Exhibit SS4
[7] Exhibit SS5
[8] Exhibit SS6
[9] Exhibits SS7-SS13
[10] Three of the six articles are undated. However, SS provides the dates of two of these in their unchallenged narrative evidence.

articles are from *Manchester's Finest*, *Premier Hospitality*, *The Business Desk*, *The Cheshire Magazine*, *About Manchester* and *Viva*. In addition, SS says that 'GupShup' has been publicised on other social media channels. A post from the 'UK Gossip Girls – Cheshire and South Manchester' Facebook account, dated 24 January 2022, displayed a promotional offer for the restaurant.[11] SS says that the account had around 8,600 followers at the date of their statement.

24. SS says that the company regularly sends newsletters to contacts on a mailing list. They say that, as of January 2023, there were around 3,000 contacts on the mailing list. An example of a newsletter has been provided, which shows information about a 'festive menu showcase evening' that was set to be held on 13 October 2021.[12]

25. The evidence is not without its limitations. For instance, no details of the size of the relevant market have been provided and there is no evidence to that effect. Moreover, neither the opponent nor SS has provided any indication as to amounts spent on advertising the restaurant. It is also difficult to ascertain how significant the activities relating to television shows were, since it appears to relate to the opponent as an individual, rather than the restaurant. Nevertheless, an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole.[13] The evidence establishes that a restaurant and takeaway service has been in operation under the opponent's mark since 2019. That restaurant and takeaway business generated over £2.2million in turnover during the relevant period. Takeaway services accounted for around £340,000 of that turnover, with customers being able to order from the restaurant via Deliveroo. The restaurant received online reviews from customers during the relevant period and has a positive rating on multiple platforms. The restaurant's Instagram page had at least 5,000 followers at the end of the relevant period. The restaurant featured in several articles during the relevant period and was promoted by a third-party Facebook account. The restaurant was visited by a reality star who reportedly promoted it on Instagram. The company sent out newsletters to contacts on a mailing list. Taking all of this into account, it is clear that the company

[11] Exhibit SS14
[12] Exhibit SS18
[13] *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09

has attempted to create a market for *restaurant services; takeaway services* during the relevant period under the opponent's mark with their consent. As such, I am satisfied that the opponent has demonstrated genuine use of their mark.

Section 5(2)(b)

Legislation and case law

26. Sections 5(2)(b) and 5A of the Act read as follows:

> "5(2) A trade mark shall not be registered if because -
>
> […]
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."
>
> "5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

27. 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

28. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated, at paragraph 23 of its judgment, that:

> "In assessing the similarity of the goods or services concerned, […] 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."

29. The relevant factors identified by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited ('Treat')* [1996] RPC 281 for assessing similarity were:

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

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

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

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

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

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

30. 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 General Court ("GC") stated that "complementary" means:

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

31. 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. 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.

32. In *Gérard Meric v OHIM,* Case T- 133/05, the GC stated that:

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

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

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

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

34. In *Separode Trade Mark*, BL O/399/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, stated that:

> "The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."

Classes 29 and 30

Preserved, dried and cooked fruits, nuts and vegetables; prepared meals; soups and potato crisps; fruit bars, nut bars, seeded bars; rice; flour and preparations made from cereals; ready meals made predominately of rice and pasta; waffles; sandwiches;

prepared meals; pizzas, pies and pasta dishes; yoghurt coated bars, sugar coated bars and chocolate bars containing a mixture of grains, nuts and dried fruit

35. Clearly, the nature and method of use of the above goods is different from that of *restaurant services*. However, the ultimate purpose of the goods and services (providing the consumer with something to eat) is shared. Users are clearly shared. Moreover, these goods may reach the market through the same undertakings as *restaurant services*. Prepared food items such as these are important to the operation of a restaurant and consumers are likely to believe that responsibility for the goods and services lies with the same undertaking. As such, they are complementary. There is also an element of competition between them in that a consumer may choose between purchasing ready to eat food items or visiting a restaurant. Taking all of this into account, I find that the respective goods and services are similar to between a medium and high degree.

Meat, fish and poultry; meat extracts; eggs […] and milk products; edible oils and fats

36. These goods are not the same as the applied-for goods considered above because they cannot be fairly described as 'ready to eat' food items. However, not being 'ready to eat' and requiring further processing does not preclude a finding of similarity; moreover, no distinction can be made between these goods of the application and the prepared foods that clearly fall within these broad categories.[14] Whilst I do not consider the degree of complementary between these goods and *restaurant services* to be as pronounced as the goods compared above, the overlaps in user and trade channels described above remain. In addition, these goods and services have the same competitive relationship. Overall, I find that the respective goods and services are similar to a medium degree.

[14] See the comments of Ms Emma Himsworth QC, sitting as the Appointed Person, in *SAINSBURY'S TOP DOG*, BL O/044/16.

Indian and English coffees, Indian and English teas, cocoa and hot chocolate, malt drinks, artificial coffee; milkshakes; milk

37. The opponent's *restaurant services* clearly covers the provision of beverages in that setting. Whilst the goods and services have different natures and methods of use, there is an overlap in the ultimate purpose (to provide the consumer with something to drink). Users are also shared. Whilst, for example, some large café chains also sell their own branded coffee that the consumer can take away to make their own drinks at home, there is nothing before me which establishes that it is common in trade. In the absence of any evidence on the point, I do not consider it to be typical for the goods and services to reach the market through the same trade channels. Although the goods may, in some situations, be important to the provision of *restaurant services*, I do not consider the goods and services to be complementary. This is because the consumer is unlikely to believe that the restaurant is the producer of the actual coffee beans being used. The goods and services are in competition, however, since a consumer could choose to visit a restaurant for a drink over making one themselves at home, or vice versa. Balancing the similarities against the differences, I find that the there is a medium degree of similarity between the respective goods and services.

Sugar, Indian masalas; salt, mustard; vinegar, sauces (condiments); spices; honey, treacle; syrup; jellies, jams, compotes

38. It is my impression that these goods comprise those which are used as condiments or additives to food or drink. They are commonly provided to consumers in restaurants in order for them to adjust the taste of their food or hot drink. For example, salt may be added to food, whilst sugar may be added to hot drinks. Therefore, whilst the nature, method of use and intended purpose is clearly different when compared with *restaurant services*, there is an overlap in trade channels and user. There is no material competition between the goods and services. However, there is a degree of complementarity between them. This is on the basis that, for example, the provision of sugar is important to the service of providing drinks such as coffee or tea. In such circumstances, the consumer is likely to believe that the restaurant will also provide the sugar for their coffee or tea. Overall, I find that there is a low degree of similarity between the respective goods and services.

Tapioca, sago; yeast, baking-powder

39. It is my understanding that the above goods are not food products that will be consumed per se; rather, they are ingredients used in cooking. The nature and method of use of these goods is clearly different from *restaurant services* and *takeaway services*. Further, whilst these goods will ultimately be consumed as part of a finished dish or food item, the intended purpose of the respective goods and services is different. Moreover, whilst these goods may be used by restaurants in their cooking, that does not create any material overlap in trade channels. Users may overlap, though only on a level far too general to be significant. I do not consider the goods to be important or indispensable to *restaurant services* or *takeaway services* but, even if that is not correct, consumers are unlikely to believe that responsibility for the goods and services lies with the same undertaking. For instance, a consumer is unlikely to believe that a restaurant has made its own ingredients. This is certainly possible, though there is nothing establishing that this is typical in trade. As such, the respective goods and services are not complementary. Neither is there any material competition between them. Taking all of the above into account, I see no obvious similarity between the respective goods and services, particularly in the absence of any evidence or submissions on the point. I conclude that they are dissimilar.

Ice

40. In my experience, ice is commonly put into drinks in restaurants in order to keep them cool. It may also be used in the preparation of desserts. However, to my mind, these uses of ice by restaurants do not constitute a proper basis for finding any similarity between the applied-for goods and *restaurant services* or *takeaway services*. The respective goods and services differ in nature, method of use, intended purpose and trade channels. They are neither complementary nor in competition. Users may overlap. However, in the circumstances, I do not consider that to be sufficient in itself to result in any similarity between the goods and services, overall. They are dissimilar.

Class 32

Mineral and aerated waters; smoothies, slushes; fruit drinks and fruit juices; syrups for making beverages; de-alcoholised drinks, non-alcoholic beers and wines including mocktails

41. As previously outlined, the provision of *restaurant services* involves the provision of beverages to consumers in that setting. The rationale for similarity set out at paragraph 37 applies equally to these goods. There are overlaps in purpose and user, and there is an element of competition. I find that there is a medium degree of similarity between the respective goods and services.

Class 39

Delivery of food by restaurants; delivery of food; food delivery; delivery of hampers containing food and drink; delivery of food and drink prepared for consumption; food delivery services

42. Although the nature and method of use of the applicant's services differ from the opponent's *restaurant services; takeaway services*, there is an overlap in user. Moreover, in my experience it is not uncommon for restaurants to provide their own food and drink delivery service. This results in an overlap in trade channels. Whilst the core purpose of the respective services is different (preparing/providing the food on one hand and solely delivering the food on the other), there is a degree of competition between them. This is because a consumer may decide to have food or drinks delivered to their home over visiting a restaurant, or vice versa. Overall, I find that there is a medium degree of similarity between the respective services.

Packaging of food

43. The nature and method of use of the above services and *restaurant services; takeaway services* are different. Moreover, the respective services have different purposes. Although the providers of, for example, takeaway services commonly pack the food and drink items in order for them to be delivered, I do not consider there to

be an overlap in trade channels. This is because a takeaway restaurant packing its own food for delivery is not providing a packaging service per se. As a consumer, you are not accessing a packaging of food service. In my view, the ordinary and natural meaning of the applied-for service would be an undertaking which receives loose foodstuffs from the producer and packages it for them so that it can be sold on to end consumers. It is my view that these services are typically provided by entirely different undertakings than *takeaway services*. They are also likely to have different users. The opponent's services will be used by the general public (i.e. someone ordering a takeaway), whereas the applicant's services are more likely to be used by businesses such as food producers and supermarket chains. The respective services are not complementary, given that they are not important to one another, and consumers are unlikely to believe that they are provided by the same undertakings. Neither are they in competition. In light of all this, I find that the respective services are dissimilar.

Class 43

Restaurant services; takeaway services

44. These services appear in both parties' specifications. They are plainly identical.

Takeaway food services; take-away restaurant services; take-away food services; takeaway food and drink services; take-away food and drink services; take-away fast food services; take away food and drink services

45. The above services are all encompassed by the opponent's *takeaway services*. These services are to be regarded as identical in accordance with *Meric*.

Take-out restaurant services; fast-food restaurant services; restaurant services for the provision of fast food; fast food restaurants; restaurants; providing food and drink in bistros

46. The applied-for services fall within the scope of the opponent's *restaurant services*. These services are also identical under *Meric*.

Services for providing food and drink; serving food and drinks; provision of food and beverages

47. These services of the application are broad terms which would incorporate the opponent's *restaurant services*. They are identical under the principle outlined in *Meric*.

Coffee shops

48. Although the primary purpose of these services is the supply of coffee, such undertakings also commonly offer food items for consumption on or off the premises. Therefore, I consider that the nature, purpose and method of use of the applied-for services overlaps with the opponent's *restaurant services.* Moreover, the respective services are likely to share users. There is an element of competition between the services since a customer could choose a restaurant or a coffee shop in which to have food or drinks. For these reasons, I find that there is a high degree of similarity between the respective services.

Bar services

49. Restaurants do not only involve the provision of food services but also the provision of beverages. In my experience, restaurants tend to have their own bars from which drinks are provided. As such, I consider that the opponent's *restaurant services* and the applied-for services overlap in nature, purpose, method of use, users and trade channels. On this basis, I find that the respective services are highly similar.

Catering services; catering (food and drink -); food and drink catering; catering of food and drink

50. These services have a similar nature and intended purpose to the opponent's *restaurant services* in that they both involve preparing and serving food. Trade channels may overlap since undertakings offering restaurant services may also offer catering for events. The services also share users. There may be a degree of competition between them as a consumer seeking food or drinks for an event may

decide to visit a restaurant over having catering provided at another venue, or vice versa. In light of all this, I find that there is between a medium and high degree of similarity between the respective services.

51. Some degree of similarity between goods and/or services is necessary to engage the test for likelihood of confusion; if there is no similarity at all, there is no likelihood of confusion to be considered under s.5(2)(b).[15] My findings above mean that the opposition must fail in respect of the following goods and services:

Class 30: Tapioca, sago; yeast, baking powder; ice.

Class 39: Packaging of food.

The average consumer and the nature of the purchasing act

52. As the case law indicates, I must determine who the average consumer is for the parties' goods and services and the manner in which they are likely to select those goods and services. The average consumer has been described in the following terms:[16]

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

53. The goods and services which I have found to be identical or similar are available to the general public. They are likely to be purchased frequently. The associated cost is likely to vary considerably, from cheaper items such as salt or sugar to high-end

[15] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, paragraph 49
[16] *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), paragraph 60

restaurants. When purchasing the goods, the average consumer is likely to consider ordinary factors such as flavour, ingredients and nutritional content. When purchasing the services, the average consumer is likely to consider the range of food and drink on offer, dietary requirements and reviews. In my view, the average consumer is likely to demonstrate a medium level of attention during the purchasing process. However, I accept that some of the cheaper food and drink items are likely to be casual purchases which attract a lower level of attention.[17]

54. The goods are typically purchased from retail outlets and their online equivalents or from hospitality establishments such as restaurants and cafés. In shops, the goods will be self-selected by the average consumer from shelves. Online, a similar process will occur whereby the average consumer selects the goods after viewing information and imagery on a website. In hospitality settings, the goods are likely to be purchased aurally (such as verbal orders to staff), though this will occur following a visual inspection of the goods in display cabinets, on menus or price lists. The services will be selected after viewing information on signage on the high street, in promotional materials, on the internet or after receiving word-of-mouth recommendations. In light of all the above, I find that the purchasing process will be primarily visual in nature, though I do not discount an aural component playing a role.

Distinctive character of the earlier mark

55. In *Lloyd Schuhfabrik Meyer*, the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

[17] I should add that I do not discount that the goods and services may also be purchased by business owners such as restaurants. However, there is no requirement for all consumers to be confused (*Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41); a likelihood of confusion amongst the general public will be sufficient for the opponent's claim under s.5(2)(b) to succeed.

108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

56. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as invented words. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

57. The opponent's mark is in word-only format and consists of the word 'GupShup'. There is some evidence that this translates as 'conversation' in English.[18] Although it is possible that some individuals would understand this, I do not consider them to be sufficiently numerous to constitute a significant proportion of average UK consumers. Whilst the evidence suggests that the word has a meaning, it does not establish how widely understood this would be. Moreover, while the average UK consumer is considered to have some appreciation for the more commonly understood European languages, the word 'GupShup' is unlikely to be a term with which the average consumer would be familiar. Instead, it is my view that it is likely to be perceived as invented word with no meaning. It is possible that the average consumer would perceive it as a non-English term, though it will still have no (known) meaning. The

[18] Exhibits SS7-SS9 and SS12

mark is not descriptive or allusive of the services relied upon. Whichever way the mark is perceived by the average consumer, I find that it possesses a high level of inherent distinctive character.

58. The distinctive character of a mark may be enhanced as a result of it having been used in the market. Although the opponent has filed evidence, I will proceed on the basis that their mark did not have an enhanced distinctive character at the relevant date of 17 January 2023, not least because it is already highly distinctive inherently. I will return to consider the matter if it becomes necessary to do so.

Comparison of trade marks

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

60. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

61. The competing marks are as follows:

The opponent's mark	The applicant's mark
GupShup	

62. The opponent's mark is in word-only format and comprises the word 'GupShup'. As there are no other elements, the overall impression of the mark lies in this word.

63. The applicant's mark is figurative and consists of a number of elements. At the centre of the mark, in a large, slightly stylised font, appears the word 'GUPSHUP'. Below this word, in a much smaller, standard font, appear the words 'CHIT CHAT CHAI'. Above the word elements is a large device. To some consumers, the outline of the shape may appear to resemble the territories of India and Pakistan. To others, it will simply present as a random shape. Atop this shape appears a face, with eyes, moustache and mouth. In my view, the device and the word 'GUPSHUP' dominate the overall impression of the mark in roughly equal measure. This is due to their relative size and positions within the mark. The words 'CHIT CHAT CHAI' are much smaller and, as such, play a lesser role. The use of colour and font, whilst still contributing, play a much lesser role.

64. Visually, the marks coincide in their shared use of the identical word 'GupShup'/'GUPSHUP'. This is the only element of the opponent's mark and co-dominates the overall impression of the applicant's mark. The difference in letter case is not significant, since the registration of word-only marks provides protection for the words themselves, irrespective of whether they are presented in upper, lower or title

case.[19] The competing marks are visually different in that the applicant's mark contains additional elements which are not replicated in the opponent's mark, namely the device, the words 'CHIT CHAT CHAI', the font and colours. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the competing marks.

65. Consumers will make no attempt to articulate the device in the applicant's mark, and neither the font nor the colours impact the way in which it will be pronounced. Aurally, the competing marks coincide in the identical syllables "GUP-SHUP". These constitute the entirety of the opponent's mark and co-dominate the overall impression of the applicant's mark. The competing marks are aurally different in that the applicant's mark contains three additional syllables, i.e. "CHIT", "CHAT" and "CHAI". Overall, I find that there is between a medium and high degree of aural similarity between the competing marks.

66. As outlined above, the opponent's will be seen as an invented word or a non-English word. Either way, it will not convey any clear meaning to the average consumer. This also applies to the identical word 'GUPSHUP' in the applicant's mark. The device in the applicant's mark may be perceived in two ways. Firstly, it may be seen as an outline of India and Pakistan with a moustached face. In such circumstances, the device may bring to mind that part of the world. Alternatively, the device may be seen as a random shape with a moustached face. The face (whether it be atop an outline of India and Pakistan or a random shape) is absent from the opponent's mark. Moreover, the applicant's mark contains the additional words 'CHIT CHAT CHAI'. The first two words are likely to be understood as referring to informal conversation (i.e. chit-chat), whereas the last word is likely to be understood as referring to a type of tea-based drink. The common element is conceptually neutral, and the applicant's mark provides additional meanings. Taking all of this into account, to the extent that the competing marks convey any meanings, they are conceptually dissimilar.

[19] *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

Likelihood of confusion

67. 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. One such factor is the interdependency principle, i.e. a lesser degree of similarity between the competing marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be mindful 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 they have retained in their mind.

68. 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.

69. Earlier in this decision, I concluded that:

- The parties' goods and services are identical or similar to at least a low degree.

- The average consumer is likely to be a member of the general public, who will demonstrate between a low and medium level of attention.

- The purchasing process is predominantly visual in nature, though aural considerations have not been discounted.

- The opponent's mark possesses a high level of inherent distinctive character.

- The overall impression of the opponent's mark lies in the word 'GupShup'.

- The word ‘GUPSHUP’ and the device dominate the overall impression of the applicant’s mark in roughly equal measure, whilst the words ‘CHIT CHAT CHAI’, the colours and the font play lesser roles.

- The competing marks are visually similar to a medium degree and aurally similar to between a medium and high degree, but conceptually dissimilar.

70. I acknowledge that the competing marks coincide in their shared use of the word ‘GupShup’/‘GUPSHUP’. This is a dominant element in both marks; it is the only element of the opponent’s mark and co-dominates the overall impression of the applicant’s mark. Nevertheless, the applicant’s mark contains additional elements, namely the device, the words ‘CHIT CHAT CHAI’, the colours and the font. Although some of these elements play lesser roles in the applicant’s mark, they are not negligible and are unlikely to be overlooked by the average consumer. This is particularly the case with the device, which co-dominates the overall impression. The opponent’s mark being highly distinctive and at least some of the goods and services being identical are, of course, factors in the opponent’s favour. However, taking all the above into account, it is my view that the differences between the competing marks are likely to be sufficient for the average consumer, even paying a lower level of attention, to distinguish between them and avoid mistaking one for the other. As such, notwithstanding the principles of imperfect recollection and interdependency, I find that there is no likelihood of direct confusion.

71. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

> “16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental

process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

72. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach.[20]

73. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J (as he then was) considered the impact of the CJEU's judgment in

[20] As was confirmed by the Court of Appeal in *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, paragraph 12.

Bimbo, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson.* The judge said:

> "18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.
>
> 19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks – visually, aurally and conceptually – as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.
>
> 20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).
>
> 21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors."

74. I recognise that indirect confusion has its limits and that such a finding should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark.[21] It has also been emphasised that, where there is no direct confusion, there must be a proper basis for finding indirect confusion.[22] The average consumer tends to perceive trade marks as wholes and I am conscious not to artificially dissect the applicant's mark. However, the word 'GUPSHUP' plays an independent distinctive role within the applicant's mark, i.e. it has a distinctive significance which is independent of the significance of the whole. It is a dominant element of the applicant's mark and is identical to the opponent's mark. This element (and the opponent's mark as a whole) is highly distinctive. In my view, the average consumer may believe that only the opponent would be using it in a trade mark. Alternatively, the differences between the competing marks may appear consistent with a co-branding or collaborative exercise between the parties. To my mind, it is also possible that the average consumer may perceive the competing marks as variants, with one being used in plain text and the other, with additional decorative elements and a tag line, being used in marketing materials. Taking all of the above into account, I am satisfied that the average consumer, paying no more than a medium level of attention, would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the identical element 'GupShup'/'GUPSHUP'. Consequently, I find that there is a likelihood of indirect confusion, even in relation to the goods and services which are only similar to a low degree.

Conclusion

75. The opponent's claim under s.5(2)(b) is partially successful.

[21] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17
[22] See the Court of Appeal's comments in *Liverpool Gin Distillery*, paragraph 13.

Section 5(4)(a)

Legislation and case law

76. Section 5(4)(a) 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-
>
> > (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."

77. Subsection (4A) of s.5 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."

78. 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)."

79. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action".

80. There is no evidence that the applicant's mark was used before its filing date or the earliest claimed use of the opponent's sign. As such, the relevant date for assessing this ground of opposition is the filing date of the applicant's mark, namely 17 January 2023.[23]

Goodwill

81. The first hurdle for the opponent is to show that it had the necessary goodwill resulting from the trading activity relied on under its sign at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) in the following terms:

"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

[23] *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, paragraph 43.

business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

82. I have already found that the evidence is sufficient to demonstrate genuine use of a registered mark identical to the opponent's sign during the five years preceding the relevant date. Although the evidence is not without its limitations and is not, in my view, indicative of largescale use, I bear in mind that a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small.[24] Taking the evidence in the round, I would have been satisfied that the evidence establishes a small, but protectable, level of goodwill in the Greater Manchester area in *restaurant services; takeaway services* at the relevant date. I also would have been satisfied that the opponent's sign was distinctive of that goodwill.

83. However, the wording of s.5(4)(a) is clear that only the owner of an earlier right is entitled to bring a case under this ground. The opponent has brought the opposition in their own (individual) name. Whilst some of the articles in the evidence refer to the opponent in connection with the restaurant, given they also refer to the opponent's celebrity status, it is understandable that they would invoke their name as a reporting hook. SS states that it is the company which operates the restaurant and takeaway business. The restaurant's activities do not appear to have been conducted by the opponent personally, or for their personal benefit over that of the restaurant. Although use of the opponent's mark by the company with the opponent's consent was sufficient for the purposes of genuine use, the position under passing off is different in that it requires the goodwill to be owned by the entity bringing the claim. The opponent may be a shareholder of the company, but that does not establish, in and of itself, that any goodwill built up by the company accrues to the opponent as an individual. There is no evidence of this, such as, for instance, an agreement to that effect. In light of this, I am not satisfied that the opponent has demonstrated that they were the owner of the goodwill. On this basis, the opposition under this ground cannot proceed.

[24] See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

Conclusion

84. The opponent's claim under s.5(4)(a) is dismissed.

Overall outcome

85. The opposition, insofar as it is based upon s.5(2)(b) of the Act, has been partially successful. Subject to any appeal against this decision, the applicant's mark will be refused in respect of the following goods and services:

Class 29: Meat, fish and poultry; meat extracts; preserved, dried and cooked fruits, nuts and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps; fruit bars, nut bars, seeded bars; milkshakes.

Class 30: Indian and English coffees, Indian and English teas, cocoa and hot chocolate, malt drinks, sugar, rice, artificial coffee, Indian masalas; flour and preparations made from cereals; honey, treacle; syrup; salt, mustard; vinegar, sauces (condiments); spices; ready meals made predominately of rice and pasta; waffles; sandwiches; prepared meals; pizzas, pies and pasta dishes; yoghurt coated bars, sugar coated bars and chocolate bars containing a mixture of grains, nuts and dried fruit.

Class 32: Mineral and aerated waters; smoothies, slushes; fruit drinks and fruit juices; syrups for making beverages; de-alcoholised drinks, non-alcoholic beers and wines including mocktails.

Class 39: Delivery of food by restaurants; delivery of food; food delivery; delivery of hampers containing food and drink; delivery of food and drink prepared for consumption; food delivery services.

Class 43: Services for providing food and drink; restaurant, bar and catering services; takeaway services; takeaway food services; take-away restaurant services; take-away food services; takeaway food and drink services; take-away food and drink services; take-away fast food services; take-out restaurant services; fast-food restaurant services; catering (food and drink -); food and drink catering; catering of food and drink; restaurant services for the provision of fast food; fast food restaurants; restaurants; serving food and drinks; restaurant and bar services; restaurant services; provision of food and beverages; providing food and drink in bistros; take away food and drink services; coffee shops.

86. The applicant's mark may proceed to registration in the UK for the following goods and services, against which the opposition has failed:

Class 30: Tapioca, sago; yeast, baking powder; ice.

Class 39: Packaging of food.

Costs

87. Both parties have succeeded in part. However, the opponent has clearly enjoyed the greater measure of success. As such, they are entitled to a contribution towards their costs based upon the scale published in Tribunal Practice Notice 1/2023, with an appropriate reduction to reflect the applicant's degree of success. In the circumstances, I award the opponent costs on the following basis:

Preparing a statement and considering the applicant's counterstatement	£275
Preparing evidence	£575

Official fees[25]	£200
Total	£1,050

88. I order Mohasinkhan Pathan to pay Rajesh Rajni Somaiya the sum of £1,050. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 5th day of November 2024

James Hopkins
For the Registrar

[25] The official fees paid in connection with filing the Form TM7 are not subject to a reduction.