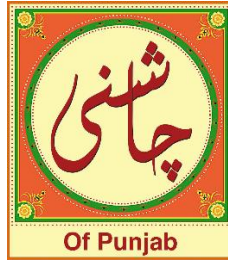


O/1207/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF REGISTRATION NO. UK00003570040
IN THE NAME OF CHASHNI SWEETS AND BAKERS UK LIMITED
FOR THE FOLLOWING TRADE MARK:



AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY UNDER NO. 503798
BY M ASHRAF

AND

IN THE MATTER OF REGISTRATION NO. UK00003249610
IN THE NAME OF M ASHRAF
FOR THE FOLLOWING TRADE MARK:

CHASHNI

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY UNDER NO. 505613

AND

AN APPLICATION FOR REVOCATION FOR NON-USE UNDER NO. 505653
BY CHASHNI SWEETS AND BAKERS UK LIMITED

BACKGROUND AND PLEADINGS

1. This decision deals with consolidated proceedings in respect of two invalidity actions and a revocation for non-use.

THE FIRST APPLICATION FOR INVALIDITY

2. CHASHNI SWEETS AND BAKERS UK LIMITED (“CSB”) is the registered proprietor of the UK trade mark no. UK00003570040 for the trade mark shown below:



3. CSB’s mark was filed on 18 December 2020 and completed its registration procedure on 23 April 2021. It stands registered in respect of goods and services in classes 29, 30 and 43. These are set out in full in the annex to this decision.

4. On 28 April 2021, Muhammad Ashraf filed an application to have CSB’s mark declared invalid under the provisions of Section 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”), which are relevant in invalidation proceedings under Section 47 of the Act. Mr Ashraf relies upon the following UK trade mark registration:

UK00003249610

CHASHNI

Filing date: 10 August 2017

Registration date: 08 December 2017

5. Mr Ashraf's mark stands registered in respect of goods and services in classes 29, 30 and 43, all of which are relied upon for the purpose of these invalidity proceedings. These are also set out in full in the annex to this decision.

6. Mr Ashraf argues that the marks are identical and that the goods and services are similar.

7. On 2 November 2021, CSB filed a counterstatement in which it denied the claims stating that the marks are "**entirely different**". In addition, it argued that:

- 'CHASHNI' is a generic name in Urdu. It is used in Pakistan, Afghanistan, Nepal and parts of Northern India to designate a sugary syrup. The word is devoid of distinctive character as it does not mean anything more than a sweet syrup.
- Another establishment named 'CHASHNI SWEET HOUSE & CAFÉ' has used a similar name and trade mark under classes 29, 30 and 43, which is not a mere coincidence as a sweet syrup is a staple for many Pakistani sweets.
- Mr Ashraf has not objected in the past to the use of the word 'CHASHNI' by any other establishment, implying that "*Mr Ashraf has not taken any action in the past to protect his trade mark due [to] objecting it [being] futile against other establishments that were clearly using a generic name*".
- 'Chashni Of Punjab' means 'Sweetness Of Punjab'. Consumers cannot confuse the parties' marks as one is generic name meaning sweet syrup and the other is a phrase meaning 'Sweetness Of Punjab'.
- Mr Ashraf does not have an exclusive right over the use of a generic word as sweets include the said syrup. Allowing Mr Ashraf's objection would be like allowing a company who has trade mark protection for the word 'cocoa' to prevent other chocolate manufactures to use it.

- CSB is an established business and is utilising its trade mark. Conversely, there is no evidence of Mr Ashraf trying to set up a business.
- Mr Ashraf is not someone who is genuinely trying to protect his trade mark or the reputation of his company and the application was filed with a view of obtaining a monetary gain.

8. Subsequently, CSB attacked the validity of Mr Ashraf's earlier mark on two different grounds by filing an application for a declaration of invalidity based on the claim that the word 'CHASHNI' is non-distinctive, descriptive or customary in trade (505613) and an application for revocation for non-use (505653). The details of these applications are as follows.

THE SECOND INVALIDITY ACTION AND THE REVOCATION ACTION

9. On 8 December 2022, CSB applied to have Mr Ashraf's earlier mark declared invalid under Section 47 of the Act. The application for invalidity is based upon Sections 3(1)(b), 3(1)(c) and 3(1)(d) of the Act and repeats the same claims made in the counterstatement of 2 November 2021. In addition, CSB claims that:

- A proportion of the population that comprises the average consumer for the registered goods would recognise 'CHASNI' (to note the registered mark is 'CHASHNI' not 'CHASNI') as the English transliteration of the Urdu word **چاشنی**.
- The word 'CHASNI' (and the equivalent Urdu word) has a recognised meaning in relation to the registered goods including being either a condiment, a sugary syrup or a variety of curry.
- In particular 'CHASNI' (and the equivalent Urdu word) is the name for a sweet syrup used as a staple for many Pakistani sweets. It is the equivalent of cocoa for chocolate.

- Mr Ashraf’s trade mark no. UK00003249610 consists solely of a **common English word** used either to describe the registered goods or to designate their kind or quality or other characteristic.
- Mr Ashraf’s trade mark no. UK00003249610 is therefore descriptive and/or devoid of distinctive character for the registered goods and should be invalidated under Sections 3(1)(b) and 3(1)(c). CSB will produce evidence that the word ‘CHASNI’ is commonly used in the food and catering industry including to describe a type of ingredient or the name of a dish.
- Further, and in the alternative, Mr Ashraf’s trade mark no. UK00003249610 consists exclusively of signs or indications that have become customary in the current language or in the *bona fide* and established practices of the trade and should be invalidated under Section 3(1)(d).

10. Shortly after it filed the second invalidity action, on 19 December 2022, CSB applied to have Mr Ashraf’s earlier mark revoked under Section 46(1)(a) of the Act on the basis of non-use within the period of five years following the date of registration, i.e. 9 December 2017 to 8 December 2022, with a revocation date of 9 December 2022.

11. Mr Ashraf filed counterstatements in response to both applications. In respect of the invalidity application, Mr Ashraf denies that its registration is non-distinctive, entirely descriptive and that it has become customary in the current language of the trade, although he admitted that the mark may be an **allusion** to “*pastries and confectionery; edible ices*” in class 30.¹ He also argued that CSB had failed to plead at what date the mark is alleged to have become customary. As for his defence to the revocation, Mr Ashraf admitted that he did not genuinely use his registration for *game* in class 29 and *temporary accommodation* in class 43, but otherwise claimed that he used the mark for all the other goods and services of the registration.

¹ See paragraph 5 of the counterstatement which states as follows: “Further and in the alternative, the meaning that the Applicant has ascribed to the Mark could not, at the time of filing the application, be understood as to designate any of the kind, quality, quantity, intended purpose, or other characteristics of the goods or services of the Application except to the extent that the Mark may be an allusion to “*pastries and confectionery; edible ices*,” in class 30.

12. CSB is represented by Sipara Limited. Mr Ashraf is represented by London IP Ltd. Both parties filed evidence in chief with Mr Ashraf also filing evidence in reply. A hearing took place before me on 2 July 2024 by video conference with Mr Robert Furneaux appearing for CSB and Mr Nick Zweck appearing for Mr Ashraf.

EVIDENCE

13. CSB's evidence-in-chief consists of two witness statements, one from Muhammad Ali dated 23 May 2022 and the other from Robert Furneaux dated 11 Sept 2023. Both of these witness statements were filed on 11 Sept 2023 and are merely a vehicle for introducing a number of exhibits as they contain no narrative. Mr Ali is the director of CSB and introduces 2 exhibits (enclosure A and B) showing definitions and examples of use of 'CHASHNI'. Mr Furneaux is the director of the firm representing CSB in these proceedings and introduces 5 exhibits (RF1-RF5) showing definitions, online articles and recipes of food referring to 'CHASHNI/CHASNI'.

14. Mr Ashraf's evidence-in-chief consists of a witness statement from Rana Ahmad dated 11 Sept 2023, accompanied by one exhibit (RA1). Mr Ahmad is the director of a third-party company called N Retail Ltd. The purpose of his witness statement is to show that he has used Mr Ashraf's trade mark with his consent. Mr Ashraf's evidence in reply consists of a witness statement from Mr Ashraf himself dated 29 September 2022 accompanied by one exhibit (MA1).

15. As it can be seen, the evidence-in-chief given by Mr Ali and that in reply given by Mr Ashraf are dated 23 May 2022 and 29 September 2022 respectively, whereas the evidence-in-chief given by Mr Ahmad and Mr Furneaux is dated 11 September 2023. The reason for this apparent discrepancy - the evidence-in-chief filed by CSB being dated more than one year apart and some of the evidence in reply being dated earlier than the evidence-in-chief - is that the proceedings against Mr Ashraf's trade mark (nos. 505613 and 505653) were consolidated with the proceedings against CSB's trade mark (no. 503798) on 10 July 2023, after the evidence rounds in the latter proceedings had been concluded; as a result, evidence filed prior to the consolidation has been absorbed into the consolidated proceedings. However, this has no consequences as to the outcome of this decision.

RELEVANCE OF EU LAW

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

MY APPROACH

17. The assessment I must make in respect of the second invalidity application is wholly distinct from the assessment I must make in the revocation application. Further, the success or failure of either application has no impact on the other.²

18. For the avoidance of doubt, if the revocation application is successful and Mr Ashraf's registration is revoked, I will still be required to consider the invalidity application. This is because, if revoked, the contested registration will still be deemed a valid registration up until the effective revocation date. However, if the invalidity application succeeds, Mr Ashraf's registration will be declared invalid and deemed as if it has never been applied for.

19. Indeed, if Mr Ashraf's registration is revoked but not invalidated, the revocation having effect from 9 December 2022, Mr Ashraf will still be able to rely on his registration in the invalidity proceedings against CSB's trade mark, as his registration would be deemed to be valid and in full force and effect at the filing date of CSB's trade mark (18 December 2020).

20. Given that the revocation application was discussed first at the hearing, I consider this to be an appropriate place to start.

² Although if Mr Ashraf's registration is deemed objectionable under Section 3(1) of the Act, then it may be possible for it to have acquired distinctive character as a result of the use made of it, Mr Ashraf did not plead that if the registration is invalid it can overcome the objection through acquired distinctiveness.

DECISION

THE REVOCATION APPLICATION

21. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) [...]

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as in referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the

making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date”.

22. Section 100 is also relevant, which reads:

“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.”

23. 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 Marken 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].”

24. Proven use of a mark which fails to establish that “*the commercial exploitation of the mark is real*” because the use would not be “*viewed as warranted in the economic*

sector concerned to maintain or create a share in the market for the goods and services protected by the mark” is not, therefore, genuine use.³

25. I set out the relevant period above when discussing the basis of the revocation action. For ease of reference, I remind myself that it is **9 December 2017** to **8 December 2022**.

The evidence of use

26. Mr Ashraf’s evidence of use comes from a third-party, Mr Ahmad, who claims to have used Mr Ashraf’s trade mark with Mr Ashraf’s consent.

27. Mr Ahmad’s evidence is very brief. His witness statement has only five short paragraphs devoted to the issue of genuine use. He states that he has sold a number of food products under Mr Ashraf’s trade mark since 26 August 2022 from his store in Luton⁴ and he estimates that the sale of goods under the mark ‘CHASHNI’ between **August 2022** (approximately 4 months before the end of the relevant period) and **July 2023**, is in the range of **£60,000 - £65,000**.⁵

28. Food sold under the mark is said to *include “rasmalai, gulab, jaman, rasgulla, laddo, barfi, halwa, biscuits, cakes, pastries, samosa and many more”*⁶ although Mr Ahmad did not expand on what “*many more*” means.

29. Whilst there is evidence of the mark ‘CHASHNI’ being used in relation to what appear to be desserts or sweet products, this is undated and consists of a few photos which Mr Ahmad says he took around the same time when he started selling the goods, examples of which are shown below:

³ *Jumpman*, Case BL O/222/16

⁴ See paragraphs 3, 4 and 5 of Mr Ahmad’s statement.

⁵ See paragraphs 6 of Mr Ahmad’s statement.

⁶ See paragraphs 5 of Mr Ahmad’s statement.



30. However, Mr Ahmad failed to produce a breakdown of sales or a single invoice showing that goods were sold under or by reference to the mark during the relevant period.

Conclusions on genuine use

31. In his skeleton argument, Mr Furneaux states that Mr Ashraf conceded that his evidence of use is limited to *milk products* in class 29 and *preparations made from cereals; pastries and confectionary* in class 30 and contended that the registration should remain on the register in respect of those terms. This concession of non-use is broader than the earlier concession that the registration has not been used in relation to *game* in class 29 and *temporary accommodation* in class 43.

32. Accordingly, Mr Ashraf's trade mark registration no. UK00003249610 is revoked with effect from **9 December 2022** in relation to the following goods and services for which Mr Ashraf has conceded non-use and has offered no proper reasons for non-use:

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

Class 30: *Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour; bread; edible ices; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.*

Class 43: *Services for providing food and drink; temporary accommodation.*

33. Turning to the goods in relation to which Mr Ashraf maintains that the mark has been put to genuine use, in his oral submissions Mr Furneaux criticised the evidence for lacking in fundamental ways. He referred not only to Section 100 of the Act (quoted above) but also to the case-law that discusses the need for clarity and precision in proof of use claims. Having noted that the burden of proof is on Mr Ashraf as the registered proprietor, Mr Furneaux emphasised that genuine use of a trade mark cannot be proved by means of probabilities or suppositions. In this connection, he relied on various decisions where the courts have repeatedly held that evidence of genuine use must be sufficiently solid. The first case is *Awareness Limited v Plymouth City Council*, Case BL O/236/13, where Mr Daniel Alexander Q.C. as the Appointed Person stated that:

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

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

34. Although Mr Furneaux did not rely on it, *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, is also a relevant decision for assessing evidence of use. In that case Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

35. Finally, Mr Furneaux noted Mr Alexander's comments in *Guccio Gucci SPA v Gerry Weber International AG* where it was stated that:⁷

"The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). [...] The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the best evidence first time round – or lose it"."

36. I agree with Mr Furneaux that the evidence filed contains a significant lack of specificity as to what proportion of the sales generated in the 12-month period between August 2022 and July 2023 falls within the relevant period. As I have said, Mr Ahmad provided an overall sales figure without any invoices at all. Consequently, I cannot know what proportion of the sales actually relates to the three-and-a-half-month period between August 2022 and 8 December 2022 which falls within the relevant period of 9 December 2017 to 8 December 2022.⁸ Further, Mr Ahmad did not say that the sales were concentrated in the months falling within the relevant period. The only concrete figure is the sales of £60,000 - £65,000 worth of goods from one single store over a 12-month period; however, over two-thirds of that period is outside the relevant period - this means that the sales achieved during most of the given 12-month period would not count towards genuine use.

37. At the hearing, Mr Zweck conceded that he does not know how much of the £60,000-£65,000 fell within that initial three-and-a-half-month period, but argued that *"if the total window was another six months, one could infer that it was, based on that evidence, somewhere in the region of £20,000-£25,000 in the first third of that period"* and that *"that would be a reasonable deduction based on the evidence"*. I reject the submission. The courts have consistently held that genuine use cannot be proven by means of probabilities or suppositions. In line with that guidance, I cannot accept Mr

⁷ Case BL O/424/14.

⁸ At the hearing Mr Zweck accepted that use started in late August, and that it is about three-and-a-half months before the end of the relevant period.

Zweck's tentative invitation to speculate about the value of the goods sold during the relevant period.

38. According to the case-law, there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered in order to create or preserve an outlet for those goods and services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. The analysis of whether use of a mark is genuine cannot be confined merely to establishing that the mark has been used in the course of trade since that use must also be genuine. Not all proven commercial use can therefore automatically be deemed to constitute genuine use of the mark in question.⁹

39. Proof of use must concern the place, time, extent and nature of use of the mark. As to the extent of the use to which the mark has been put, account must be taken in particular of the commercial volume of the overall use, as well as the length of the period during which the mark was used and the geographical spread and frequency of use.

40. In his oral submissions, Mr Zweck argued that "*real commercial use by a small business must be enough in order to satisfy the use requirements*". Whilst he conceded that it would have been preferable to have had invoices, Mr Zweck contended that Mr Ahmad's evidence is not evidence from a sophisticated trader and submitted that it "*is enough in terms of sales*". First, unfortunately for Mr Ashraf, this submission cannot overcome the observations I made that the burden of proving genuine use is through sufficiently solid evidence rather than probabilities or suppositions. Second, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel possible doubts about the fact that use of a mark is genuine.¹⁰ In this case, the sales are very small and the goods were sold in the limited time-window of three-and-a-half-months from one single shop in Luton. The extent and geographical area of use are, therefore, extremely limited, and there is no evidence of any other factor which is

⁹ *Reber* at [32]

¹⁰ T382/08 paragraph 31

capable of compensating for the (unclear) and low sales figures. For example, there is no evidence of advertising and Mr Ashraf did not provide evidence to the effect that he licensed use of the mark to other traders or made any plans to distribute the goods in other geographical areas.

41. For the reasons given above, I consider the evidence to be wholly and insufficiently solid because it is lacking; in addition, what has been filed is unclear and unsupported. In the absence of sufficient solid evidence, the use made cannot be deemed warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question.

42. Consequently, CSB's application to revoke Mr Ashraf's registration succeeds in its entirety. The mark is revoked with effect from 9 December 2022.

THE SECOND INVALIDITY APPLICATION

43. Section 3 of the Act has application in invalidation proceedings pursuant to Section 47 of the Act, which reads as follows:

"47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

Section 3(1) case-law and legislation

44. Section 3(1) states:

“3. Absolute grounds for refusal of registration.

(1) The following shall not be registered—

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

45. The relevant date for determining whether the contested registration is objectionable under Sections 3(1)(b), 3(1)(c) and 3(1)(d) is its filing date, being 10 August 2017.

46. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of Section 3(1)(c) but still be objectionable under Section 3(1)(b): *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P at [25]. In this case, Mr Furneaux conceded that CSB's claims under Section 3(1)(b) and Section 3(1)(c) are similar to the extent that they are both based on the alleged descriptive meaning of 'CHASHNI'. Mr Furneaux also confirmed withdrawal of the application in relation to *salt* and *yeast* in class 30 and *temporary accommodation* in class 43 for which, he conceded, the mark is not descriptive.

47. In normal circumstances, if a Section 3(1)(b) claim repeats the Section 3(1)(c) claim that the mark is descriptive, the former follows the outcome of the latter. However, since at the hearing Mr Furneaux also argued that the Section 3(1)(b) ground can succeed as a stand-alone ground, I will consider it separately.

Section 3(1)(c)

48. The case law under Section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods

or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by analogy, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

49. I also bear in mind that descriptiveness must be assessed through the perception of the relevant parties, including those in the trade. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, the Court of Justice of the European Union (“CJEU”) held that:

“24. In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 29; Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 77; and Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 50).”

50. In *Exalation v OHIM*, Case T-85/08, the General Court (“GC”) confirmed that, at least where technical terms are concerned, it is appropriate to take account of meanings known to those in the trade. The court stated that:

“38. In paragraph 18 of the contested decision, the Board of Appeal stated that the applicant had not submitted any substantiated evidence to invalidate the examiner’s observations to the effect that the element ‘lycopin’ (lycopene) designated a carotenoid with antioxidant properties.

39. For the first time at the hearing, the applicant challenged the Board of Appeal’s assessment that the term ‘lycopin’ is descriptive. The Court observes that the applicant has not given any details to support its claims and there is thus no need to consider whether such an argument may be raised at this stage in the proceedings. In particular, the applicant has put forward no argument capable of calling into question the meaning attributed to the term ‘lycopin’ by the Board of Appeal. In those circumstances, the Court must find that the applicant has not succeeded in challenging the meaning attributed to the element ‘lycopin’ by the examiner and by the Board of Appeal.

40 First, that technical term designates a food supplement necessarily known by some of the relevant public, in particular professionals dealing with dietetic, pharmaceutical and veterinary preparations.

41 Secondly, the Board of Appeal established in the contested decision that the meaning of the term 'lycopin' was easily accessible to consumers of all the goods covered by the application for registration. The meaning of the term 'lycopin' does in fact appear in dictionaries and on web sites. It is probable therefore that the substance designated by that term is also known by some of the consumers of all the goods listed in paragraph 3 above.

42 Thirdly, consumers of pharmaceutical, veterinary, dietetic and sanitary preparations for medical use who are not aware of the meaning of the term 'lycopin' will often tend to seek advice from the informed section of the relevant public, namely doctors, pharmacists, dieticians and other traders in the goods concerned. Thus, by means of the advice received from those who prescribe it or through information from various media, the less well-informed section of the relevant public is likely to become aware of the meaning of the term 'lycopin'.

43 The relevant public must therefore be regarded as being aware of the meaning of the term 'lycopin', or at least it is reasonable to envisage that the relevant public will become aware of it in the future (see paragraphs 25 and 26 above).”

51. Finally, as 'CHASHNI' is a foreign word, I bear in mind the case-law relating to the distinctiveness of words in foreign languages. In *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, in the context of the assessment of distinctiveness for the purposes of registration, the CJEU held that the distinctive character of a trade mark must be assessed from the perspective of the relevant public in the territory in which registration is sought.

52. In *Pooja Sweets & Savouries Ltd V Pooja Sweets Limited*, BL O-195-15, Ms Anna Carboni, as the Appointed Person, held that where goods are targeted at the general public the mere fact that they might be of greater interest to a particular sub-set of the

relevant public did not justify narrowing the assessment of distinctiveness to just that sub-set of the relevant public. See also, to similar effect, the judgment of the GC in *Aranynektar v OHIM*, Case T-503/15. However, in *Loutfi v AMJ Meatproducts NV and Another*, Case C-147/14, the CJEU held that:

“Article 9(1)(b) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that, in order to assess the likelihood of confusion that may exist between a Community trade mark and a sign which cover identical or similar goods and which both contain a dominant Arabic word in Latin and Arabic script, those words being visually similar, in circumstances where the relevant public for the Community trade mark and for the sign at issue has a basic knowledge of written Arabic, the meaning and pronunciation of those words must be taken into account.”

53. In this case the goods were halal foodstuffs, which the referring court held were mainly targeted at members of the Muslim religion. This must apply where specific goods, e.g. halal foodstuffs, are covered by broader descriptions of goods/services, e.g. meat products. Therefore, where it is shown that the goods or services at issue are mainly targeted at a particular section of the public in the UK because of the type of goods or services at issue, it is appropriate to take account of the perception of the trade marks amongst the section of the public who are likely to be the principal consumers of those goods/services.

54. In support of the claim that the mark is descriptive, CSB provided the following evidence:

1. Undated online definitions of the word ‘CHAHSNI’ from various sources including Collins online dictionary, Wikipedia, the websites www.spiceofindia.co.uk¹¹ and www.findwords.info.¹²

Significantly, the Collins online dictionary provides the meaning of ‘CHASHNI’ as the English transliteration of a word in Hindi and gives the following definition

¹¹ Exhibit RF1 of the Furneaux’s witness statement

¹² Enclosure A of Muhammad Ali’s witness statement

of syrup: *“Syrup is a sweet liquid made by cooking sugar with water or fruit juice”.*

The Wikipedia extract refers to ‘Chashni’ or ‘Chaashni’ having two meanings, one in Persian and one in Hindi, Urdu and Nepali. The Persian meaning is that of *“a condiment”, “a spice, sauce, or preparation”,* examples of which include *“saffron, barbecue sauce, teriyaki sauce, soy sauce, and pomegranate juice”.* The Hindi, Urdu and Nepali meaning is as follows:

“Chashni is the generic name in North Indian, Pakistani, Nepali and Afghan languages for a sugary syrup. [...] Chashni or sugar syrup is used in many Indian sweets and desserts in varying consistencies such as one-thread, two-thread or three-thread consistency (1 tar-chasni, 2 tar-chasni or 3 tar-chasni). Its preparation involves boiling of water with sugar and stirring till the desired consistency is reached. For foods in which chashni needs to be absorbed, a thinner consistency called single thread syrup is used [...].”

The website www.spiceofindia.co.uk lists ‘CHAHSNI, SHEERA’ in a glossary of Indian food terms and gives the meaning of *“sugar syrup”.*

The website www.findwords.info also refers to ‘CHASHNI’ as a word of Hindi and Urdu origin meaning the generic name for a sugar syrup in North India, Pakistani, Nepali and Afghan language.

2. Online articles containing a reference to ‘Chasni’ (it is to be noted that the articles refer to ‘Chasni’, whilst the registered mark is ‘CHASHNI’).¹³ These include:

- An online article titled **“CHASNI** *curries favour over tikka*” from the BBC website dated 12 May 2008. The article mentions a ‘CHASNI’ curry

¹³ Exhibit RF2 of the Furneaux’s witness statement

recipes that tastes like sweet and sour chicken and is popular in chain of Indian restaurant in Glasgow.

- An online article titled “*Glasgow butcher selling incredible **chicken tikka chasni** pies as foodies go wild*” from the Scottish Sun dated 3 September 2021. The article refers to a popular meat store in Glasgow having launched the new pastries and being in high demand.
- An online article titled “*5 ideal alternative curries to try next time you get a takeaway*” from the website www.idealmagazine.co.uk dated 25 October 2017. The article talks about some alternative curries and says: “*If you like a Masala, try the **Chicken Chasni** - a similar creamy dish which packs an extra punch with its unique sweet and sour taste.*”

3. Online recipes referring to ‘**chashni**’ or ‘**chasni**’ as a sugar syrup.¹⁴ These include:

- a YouTube video on “*How to make **Chasni** or suger (sic) syrup*” dated July 2012 which received 40,426 views. However, it is not clear how many views were from the UK.
- A screenshot from the website www.ruchiskitcken.com dated March 2016 showing a recipe about “*How to make **Chasni** for Indian sweets*”.
- Two screenshots from www.cookpad.com dated August 2018 and May 2020 showing two recipes for “*Crispy **chashni** bread*” and “*Crispy Sugar Syrup Bread (Bread **Chashni**)*”.
- A screenshot from www.vegetariantastebuds.com dated October 2022 showing a recipe for “*Sugar Syrup (**Chashni**) for Indian Sweets*”.

¹⁴ Exhibit RF3 of the Furneaux’s witness statement

- A screenshot from www.mamtaskitchen.com dated October 2006 showing a recipe for “*Sugar Syrup for Indian Sweets, How to make it? Chasni or Chashni?*”.
- A screenshot from www.inhouserecipes.com dated July 2022 showing a “*Chashni Recipe*” for a sugar syrup.
- A screenshot from www.slurrrp.com dated January 2022 about how to use leftover ‘**Chashni**’ which is described as the ‘Sugar Syrup’.

It is not clear whether any of the above websites target consumers in the UK.

4. Examples of online articles, screenshots from YouTube, menus, food available for sale and recipes demonstrating use of ‘CHASNI/CHASHNI’ in relation to curry.¹⁵ Most of this material shows use of ‘CHASNI’ as designating the flavour of a curry dish, including ‘*Chicken Chasni Balti*’, ‘*Ashoka Chicken Chasni*’, ‘*Chicken Chasni*’, ‘*Chasni Sauce*’, ‘*Chicken Tikka Chasni*’, ‘*King Prawn/Chicken Chasni*’. Once again, it is to be noted that the registered mark is ‘CHASHNI’ not ‘CHASNI’. Only one product refers to ‘CHASHNI’ (i.e. ‘*Chashni Tandoori Aubergines*’ which appears to be available in the UK from the website www.barbersbazaar.com), and three UK menus offering ‘CHASHNI’ as a “*creamy, sweet sauce with ground cashew nuts*”; however, they are all undated.

55. In his skeleton argument, Mr Furneaux submitted that the mark is “*descriptive of food products which could have a sweet flavour or be flavoured in cooking and restaurants or similar food and beverage outlets that may offer sweet-flavoured meals and drinks.*” He further stated (emphasis added):

“31. The word CHASHNI therefore carries a broad descriptive meaning as a term for ‘sweetness’ and so, when considering the Contested Goods, merely describes an attribute or characteristic of the goods. A consumer, on seeing or

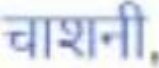

¹⁵ Exhibit RF2 of the Furneaux’s witness statement

hearing the word in relation to the Contested Goods, will expect that it is used to indicate that the products are sweet. Therefore, the mark consists exclusively of a sign or indication that designates a characteristic of the Contested Goods in classes 29 and 30.

32. Similarly in relation to class 43, a consumer, having been used to see CHASHNI as a descriptor to indicate sweetness (in particular of mithai products) or for a flavour of curry, will see the word CHASHNI as an indication of the type of cuisine being offered by the catering outlet in question. As the news articles at page 4 and 5 of the witness statement of Robert Furneaux (pages 1 and 2 of Exhibit RF2) demonstrates that CHASHNI will be seen as a similar descriptor to Tikka.”

56. There are many issues with these arguments and the evidence. I will address them in turn.

57. ‘CHASHNI’ is not an English word. The extract from Wikipedia indicates that

‘CHASHNI’ is how the word  (in the Hindi/Nepalese language) and  (in the Urdu language) are transliterated in English. Further, the meaning of ‘CHASHNI’ does not appear in English dictionaries, the only dictionary definition exhibited in evidence being from the Collins online dictionary in Hindi, not in English. Most of the evidence filed is also undated or dated after the relevant date and it is not clearly targeted at the UK consumers because many of the websites from which the screenshots are taken use a ‘.com’ domain name. Further, many of the examples of use shown in evidence refer to ‘CHASNI’; albeit it is possible that this is a spelling variation of ‘CHASHNI’ there is no evidence of it. Lastly, most of the use shown relates to curry dishes. In this connection, I observe that UK consumers who do know that ‘CHASHNI’ is a transliteration of a foreign word designating a sugar syrup are unlikely to understand the meaning of ‘CHASNI’ or ‘CHASHNI’ when the word is used in the name of a curry dish. They might understand it as designating a type of curry or a curry flavour, but they will not appreciate that ‘CHASHNI’ is the transliteration of a foreign word designating a sugar syrup and will not see ‘CHASNI’ as a misspelling of

'CHASHNI'. Mr Furneaux's starting point in claiming that UK consumers will understand 'CHASNI' (or 'CHASHNI') as a descriptor indicating sweetness for a flavour of curry, implies that consumers encountering the sign 'CHASNI' in relation to curry equates it to 'CHASHNI' and recognise that the latter designates a sugar syrup; hence, the argument becomes somehow circular when CSB attempts to rely on the evidence about 'CHASNI' curries in order to establish that the meaning of 'CHASHNI' as a sugar syrup is known in the UK.

58. The question of whether the mark is sufficiently descriptive that it should fall foul of Section 3(1)(c) is to be approached by considering the perception of the average consumer of the goods and services covered by the registration. In this case, the registration covers *Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; eggs; milk and milk products; edible oils and fats* (class 29), *Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; baking-powder; mustard; vinegar, sauces (condiments); spices; ice* (class 30) and *Services for providing food and drink* (class 43).

59. The goods in class 29 and 30 are foodstuff targeted at the general public and do not appear to be of greater interest to the UK consumers who speak Hindi, Urdu or Nepalese. The same goes for the class 43 services, which target English-speaking consumers who may be interested in drinking or eating out.

60. As the specification is not limited in any way, in order to establish whether the mark is descriptive, the assessment is to be based on the perception of the general population whose language is English.

61. In his oral submissions, Mr Furneaux relied on evidence given by Mr Ashraf about the proportion of non-British population in the UK. This consists of a ONS report showing that in 2021 there were 896,000 Indian nationals and 456,000 Pakistani nationals living in the UK. The main issue with this evidence is that it is not contextualised as it does not say what proportion of the UK population these figures amount to. At the hearing Mr Furneaux submitted that the UK population is around 60 million – this information is not to be found anywhere in the evidence filed and Mr

Furneaux did not seek leave to file additional evidence, hence, I disregard it. But, for the sake of the argument, I should say that if I were to attempt a calculation based on the UK population being 60million, the number of Indian and Pakistani nationals would translate into a tiny percentage of 2.25% which does not represent a significant proportion of the relevant public.

62. For all these reasons, I consider that the evidence is insufficient to establish that, at the relevant date, the meaning of 'CHASHNI' was necessarily known by a significant proportion of the relevant English-speaking consumers in the UK. That is sufficient to dismiss the argument that the mark is descriptive for the average consumers of the goods and services concerned who are English speakers residing in the UK.

63. Admittedly, the registered **confectionery** includes goods such as those shown in Mr Ahmed's evidence (that Mr Furneaux describes as Mithai sweets) and the registered **services for providing food and drink** include the offering of national cuisine which might target consumers who speak Hindi, Urdu or Nepalese. Insofar as these broad terms cover goods and services which are mainly targeted at a particular section of the public in the UK, namely those who speak Hindi, Urdu or Nepalese, I will proceed on the basis that, for those goods and services, the same relevant section of the public (who are likely to be the principal consumers of those goods and services) will appreciate the meaning of 'CHASHNI' as a sugar syrup.

64. Section 3(1)(c) prevents the following from being registered as trade marks:

"Trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service".

65. For the section to bite I must be satisfied that the average consumer would, at the relevant date, have immediately perceived, without thought or explanation, that the word "CHASHNI" designates a characteristic of the goods and services, which Mr Furneaux identifies as being sweetness (or, alternatively, the fact that goods contain

'CHASHNI') for the goods, and the offering of a certain type of cuisine for the services. Referring to Mr Ahmad's evidence, he stated (emphasis added):

"That is at paragraph 4. In that it says: "We sold the product that goes under the CHASHNI trade mark, rasmalai, gulab jaman," and then a bunch of others. Rasmalai, as I understand it, is a cottage cheese dumpling soaked in a milk syrup. We have examples there of where chashni would be descriptive, because that milk syrup will be sweetened with chashni. Gulab jaman are dumplings soaked in a sugar syrup, I believe. Again, the sugar syrup. There is every opportunity for that to be a chashni sugar syrup, and so the chashni is directly descriptive of those products. There are a couple of examples of how we see that the case for descriptiveness is made out. We say that it is reasonable to believe that it will be recognised by the consumer as a description. When they see it on the packaging of the product, they will see CHASHNI and they will think okay, that is telling me that it is has some sugary syrup in it and it is sweeter than the raw product.

As an alternative under non-distinctiveness, if it is not formally a characteristic, what we are saying is that the evidence we have provided shows that the average consumer will not see it as an indication of origin; there are too many people using it in too many contexts."

66. What Mr Furneaux refers to as a characteristic of the goods is a type of homemade sugar syrup that is prepared by boiling water with sugar and is used for making Indian sweets and/or desserts. The registration does not cover sugar syrup or goods which can be described as 'CHASHNI'. Further, there is no evidence that 'CHASHNI' is available to be purchased as a finished product; as Mr Zweck correctly pointed out at the hearing, the evidence does not relate to products on the market, and *"these are things that people are making at home by combining different products"*. However, for a product to be regarded as an ingredient, it does not have to be available on the market. Further, the evidence strongly suggests that 'CHASHNI' is an ingredient of the confectionary goods shown in evidence, and the packaging shown in Mr Ahmad's evidence lists sugar syrup as one of the ingredients.

67. In his oral submissions Mr Furneaux's argued that "taste" is a central characteristic of the goods, relying on the judgment of the CJEU in Case C-191/01 where the sign *DOUBLEMINT* was held to be descriptive for chewing gum because it would be associated with the mint-based composition and the mint flavour of the goods. Whilst I agree with Mr Furneaux that taste is a characteristic of the goods, 'CHASHNI' does not describe a taste and I prefer Mr Zweck's submission that 'CHASHNI' is not synonymous for sweetness. Nevertheless, I am of the view that it might describe one of the main ingredients of the goods, the term *confectionery* being sufficiently broad to cover Indian desserts and sweets which are made using 'CHASHNI'; this was one of the submissions made by Mr Furneaux at the hearing. In those circumstances, the word 'CHASHNI' applied to Indian confectionary goods will inform consumers without further reflection that the goods at issue contain in their composition a sugar syrup known as 'CHASHNI'. Consequently, the relevant consumers would perceive the sign as providing descriptive information about a characteristic of the goods in question.

67. This conclusion does not apply to *sauces (condiments)* because the evidence shows that 'CHASHNI' curries do not contain sugar syrup as their main ingredient (or as an ingredient). Conversely, the evidence indicates that the curry has a sweet and sour flavour and that the sweet flavour is achieved by adding honey or mango chutney/mango pulp. The same goes for the remaining goods in the specification in relation to which my primary finding is that they are mainly targeted at English-speaking consumers who will not appreciate the meaning of 'CHASHNI'.

68. Turning to the services, the fact that an item of food might be listed on the menu of a restaurant does not make it descriptive of restaurant services because restaurant services prepare and serve a variety of foods. This is unless the name of the food indicates a characteristic of the services in the sense that it describes the main type of food which a restaurant serves (i.e. its speciality) even though other items are available. For example, 'steaks' would be descriptive of a restaurant specialising in (or selling mainly) steaks, 'burgers' would be descriptive of a restaurant specialising in (or selling mainly) burgers, and 'sandwiches' would be descriptive of a sandwich bar that sells primarily sandwiches.

69. Mr Furneaux's argument in relation to the services is that "a consumer, having been used to see CHASHNI as a descriptor to indicate sweetness (in particular of mithai products) or for a flavour of curry, will see the word CHASHNI as an indication of the type of cuisine being offered by the catering outlet in question".

70. It is not completely clear to me whether the type of cuisine for which 'CHASHNI' is alleged to be descriptive is characterised by the offering of sweet food, or the offering of curry, CSB relying in their pleadings on the meaning of 'CHASHNI' as both a sweet syrup and a variety of curry. I will consider both scenarios in turn.

71. Whilst 'CHASHNI' curry might feature in some restaurant menus (only 3 examples were given but they are all undated), it is only used in the name of a few dishes and does not designate a food group that could represent the speciality of a restaurant. Further, the evidence is far from establishing that 'CHASHNI' curry is as well-known as other types of curries - using an example given by Mr Furneaux, 'CHASHNI' is not as well-known as Tikka Marsala. Consequently, when the word 'CHASHNI' is used on its own (without the word curry) in relation to restaurant services, the relevant consumer will not perceive it as descriptive of a flavour of curry, or of the restaurant offering curry.

72. Turning to the submission that the mark is descriptive of restaurants that may offer sweet-flavoured meals and drinks, even if the consumers of the services were to understand the meaning of 'CHASHNI' as that of a sugar syrup, that would not identify a type of cuisine. Whilst traders who provide food and drink might identify a national cuisine or the main type of food they serve in their branding (i.e. Indian, curry, etc), neither traders nor consumers are accustomed to identifying the cuisine being offered by reference to the flavour or taste of the food being served. I therefore reject Mr Furneaux's submissions that 'CHASHNI' will be perceived as a descriptor which indicates the sweetness of the food/drinks served by the catering outlet. It follows that 'CHASHNI' is not descriptive of the type of cuisine being offered when used in relation to *services for providing food and drink*. At most, the word might be understood as alluding to the offering of a regional cuisine, namely from the regions where the languages from which 'CHASHNI' is transliterated are spoken, although that would be no more than a vague allusion, not a description of a characteristic of the services.

73. In conclusion, with the exception of *confectionary*, I do not consider that consumers will immediately perceive the word 'CHASHNI' as describing a characteristic of the registered goods and services.

74. The objection under Section 3(1)(c) succeeds in relation to the registered term ***confectionary*** and fails in relation to the remaining goods and services. I will now turn to consider the Section 3(1)(d) and (b) ground in relation to the goods and services not caught up by the Section 3(1)(c) ground.

Section 3(1)(d)

75. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the GC summarised the case law of the CJEU under the equivalent of Section 3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40)."

76. Mr Furneaux's oral submissions on this ground were as follows:

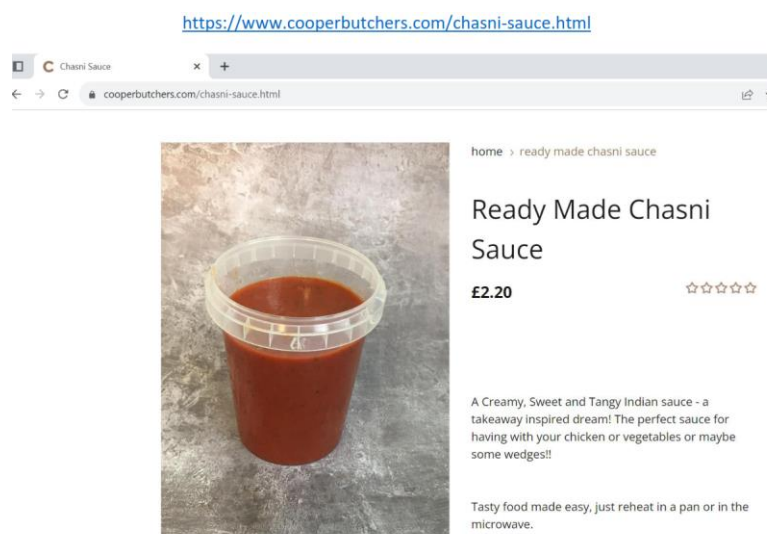
"Here we do not have to show that [the mark] it is descriptive, all that we have to show is that it is not capable of distinguishing the goods or services of one undertaking from those of other undertakings. Again, I am just going to refer you back to the exhibits that I just took you through. We can see there are multiple users, in multiple different contexts, showing that CHASHNI does not indicate one undertaking."

77. As it can be seen, the evidence relied upon under this ground is the same as that relied upon under Section 3(1)(c). This ground is pursued on the basis of current usage in trade sectors covering trade in the goods or services for which the mark is registered.

78. I have already discussed the evidence above. The majority of the examples of use provided in evidence relate to definitions and recipes for a sugar syrup or curry dishes; that is not use in trade in relation to the registered goods and services. Admittedly, the online articles from the BBC and the Scottish Sun refer to a chain of Indian restaurants and a butcher in Glasgow offering 'CHASNI' curry and 'Chicken Tikka Chasni'. Whilst this evidence is more arguably to be regarded as use in trade, it is still problematic

because, first, it refers to 'CHASNI' (not 'CHASHNI') and second, it is neither use in relation to the registered goods (the registered goods not covering pre-prepared curry meals) or services (as the name 'CHASNI' curry and 'Chicken Tikka Chasni' are used to designate the goods offered by the restaurant, not the restaurant services). The same problems arise in respect of the examples of use in relation to 'CHASHNI', which consist of a product called 'Chashni Tandoori Aubergines' and three menus offering 'CHASHNI' as a "creamy, sweet sauce with ground cashew nuts". Leaving aside for a moment the issue about this evidence being undated, such use is not use in relation to any of the registered goods (because the registration does not cover pre-prepared meals) or services (because the use is in relation to a dish, not the services of providing food and drink).

79. Finally, for the sake of completeness I should mention that the evidence includes one example of use of 'CHASNI' in relation to a ready-made curry sauce, consisting of the screenshot below:



80. Although the registration cover *sauces (condiment)* in class 30, one single undated example referring to a similar word ('CHASNI' rather than 'CHASHNI') is far from establishing that 'CHASHNI' is commonly used in trade for the presentation of the goods concerned.

81. The objection under Section 3(1)(d) fails.

Section 3(1)(b)

82. Section 3(1)(b) prevents the registration of a mark which is devoid of distinctive character.

83. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and Section 3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an

analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

84. Although Mr Furneaux argued that if the mark is not found to be descriptive, it is still devoid of distinctive character under Section 3(1)(b), his submissions appear to be based on the same arguments relied upon under Section 3(1)(c) and (d). He stated:

"In the alternative, if not found to be directly descriptive, the common usage of the word CHASHNI by both consumers and traders means the word is incapable of performing the essential function of guaranteeing the identity of the origin of the Contested Goods offered under the mark to the consumer or end-user. This is because CHASHNI does not enable the consumer, without any possibility of confusion, to distinguish the product or service from others which have another origin.

For example, in relation to the class 29 products, items such as eggs or meat are not always inherently sweet but can be flavoured in cooking. Similarly in relation to the name of a restaurant or other food outlet, the consumer might not see the word Chashni as directly descriptive but as a non-distinctive term, similar to Tandoori, which is used by others in the trade. The Word Mark is therefore invalid under sections 3(1)(b) [...] for the Contested Goods.

In the alternative the evidence shows that the word CHASHNI has “become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services”. The Word Mark is therefore invalid under sections 3(1)(d) for the Contested Goods.”

85. I have already found that Mr Ashraf’s mark is not descriptive of the registered goods and services (with the exception of *confectionary*) and that it has not become customary in trade, and I accept that this does not of itself mean that the mark cannot be objectionable under Section 3(1)(b). However, descriptiveness and use in trade are the only claims made under this ground, as to why the mark is devoid of distinctive character. As I have rejected both claims, I also reject the claim that the mark is devoid of distinctive character.

86. The invalidation based upon Section 3(1)(b) cannot succeed to a broader extent than that under Section 3(1)(c).

87. The invalidation based upon Sections 3(1)(c) and (b) partially succeed against the registered term *confectionary* but fails in relation to all of the other registered terms. The registration UK00003249610 is invalidated insofar as it covers *confectionary* and is deemed never to have covered this term.

THE FIRST INVALIDATION

Section 5(2)(b)

87. Section 5(2)(b) states:

“5. (2) A trade mark shall not be registered if because –

(a) ...

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

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

88. Section 5A states:

“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.”

89. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are taken from the decisions of the CJEU 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.

90. Mr Ashraf's mark is an earlier mark having a filing date that is earlier than the filing date of CSB's registered mark.

91. Since the registration of Mr Ashraf's mark was not completed five years or more before the application date of CSB's mark, Mr Ashraf can rely upon his mark in the invalidation proceedings against CSB's mark without having to show that he has genuinely used his mark.

92. I should also explain that although I have revoked Mr Ashraf's mark, the revocation takes effect from 9 December 2022. Consequently, at the filing date of CSB's mark (on 18 December 2020)¹⁶ Mr Ashraf's earlier mark was still validly registered, and the outcome of the revocation action does not prevent Mr Ashraf from continuing to rely on his now revoked mark for his application for invalidation of CSB's mark under Section 5(2)(b). However, the registration having been invalidated in relation to confectionary, this term cannot longer be relied upon.

Comparison of goods and services

93. In his skeleton argument, Mr Furneaux conceded that there is identity in relation to the majority of the goods and services. He then reiterated this concession in his oral submissions stating as follows:

“Based on the current specifications, which are very broad in both cases, we can clearly see there is some identity and similarity, so I was going to focus on the similarity of the marks.”

94. I will therefore proceed on the basis that most of the goods and services are identical and that where the goods and services are not identical, they are at least similar.

Average consumer

95. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst*

¹⁶ This is the relevant date for the assessment of the invalidity application under Section 5(2)(b).

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

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

96. The respective goods and services include a range of foodstuff, accommodation, catering services and services for providing food and drink as well as related booking services.

97. Both parties agree that the goods and services are ordinary consumer goods and services, which will be selected by members of the general public with a medium degree of attention.

98. The goods are likely to be self-selected from the shelves of a retail outlet, or an online equivalent. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants.

99. The selection of the services will be primarily visual, following inspection of the premises’ frontage on the high street or as a result of searches on websites or advertisements in print or online. That said, I do not discount the aural element, as word of mouth recommendations may also influence consumers’ decisions.


Comparison of marks

100. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its

various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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.”

101. 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. The respective marks are shown below:

The contested registration	The earlier mark
	<p data-bbox="1023 1514 1171 1545">CHASHNI</p>

Overall impression

The earlier mark

102. Mr Ashraf's mark is a word only mark consisting solely of the word 'CHASHNI' presented in capital letters. As there are no other elements present, it follows that the overall impression of the mark lies in the word itself.

The contested registration

103. CSB's mark is a figurative mark that consists of a combination of three elements. The first element is a figurative element consisting of a yellow square with orange borders that incorporates a smaller orange square with green borders. The orange square has a yellow flower in each corner and a yellow circle with a green outline in the middle. The second element is a large red figurative writing in an Arabic script, placed in the middle of the yellow circle. The third element are the words 'Of Punjab' presented in a smaller size below the Arabic script and within the yellow square.

104. Although the Arabic script in the mark is visually prominent, the English-speaking average consumer in the UK is unlikely to understand and recollect scripts written in non-Latin characters. Consequently, the Arabic script in the mark will be illegible for the relevant public in the UK and consumers will not try to pronounce it or link it to a specific meaning. In the case T 323/21, *Kasite v EUIPO*, at [47] the GC stated:

“In the third place, it must be borne in mind that the contested mark in its registered form is a figurative mark consisting of three characters from the Chinese alphabet. As the Board of Appeal correctly notes in paragraph 39 of the contested decision, the relevant public will not be able to verbalise or to memorise those Chinese characters, which will rather be perceived as meaningless, abstract signs or as decorative elements referring to China or to Asia. It is appropriate, therefore, to find that, with regard to the goods at issue, the Chinese characters forming the contested mark have a lower than average degree of distinctive character.”

105. Accordingly, the UK average consumer is likely to perceive the Arabic script in the contested mark as part of an abstract figurative element.

106. The word 'Punjab' is defined as “(formerly) a province in NW British India: divided between India and Pakistan in 1947 [...]” (Collins online dictionary). I agree with Mr Zweck that, irrespective of whether the average consumer is aware that Punjab is a geographical location, they are likely to perceive it as such, given the use of the preposition 'Of'. Whilst due to its size and position, 'of Punjab' has less impact than the other visual elements of the mark, it is the only recognisable verbal element of the mark; as such it has a stronger impact on the consumer than the figurative component since the public will more easily refer to the mark by its verbal element than by describing its figurative element.¹⁷ Consequently, considering that the majority of the verbal elements of the mark will not be legible for the public, it is likely that consumers will focus on the words 'of Punjab', regardless of its degree of distinctiveness.

Similarity of the marks

107. In his skeleton argument, Mr Zweck conceded that this is an unusual case, in that the alleged common element of the marks is the word 'CHASHNI' which is purportedly presented in an Urdu script in the contested registration. He also accepted that, for the average consumer who is not familiar with the Urdu script for the transliterated word 'CHASHNI', the respective marks are not similar.

108. As it will be recalled, Mr Zweck on behalf of Mr Ashraf conceded that the goods and services at issue are ordinary consumer goods and services. In this connection, I note that some of the registered terms have French origin (for example *andouillette* in class 29 which is defined as a type of small sausage popular in France), or designated food which is typical of other countries (for example *baklava* in class 30 which is defined as a sweet food popular in Turkey and the Middle East). However, I have not been referred to any goods or services in the specification of the contested mark which might be targeted at the public who speak the language in which the script is written, which is, allegedly, Urdu. Hence, there is no justification for finding that the registered goods and services are mainly destined to a public who have at least a basic knowledge of Urdu and will be able to decipher the Urdu script of the contested mark.

¹⁷ T-312/03, *Selenium-Ace*, at paragraph 37

109. Alternatively, Mr Zweck's submission was that, regardless of the nature goods and services, the proportion of the relevant consumers who would recognise the Urdu script as the transliterated word 'CHASHNI' (and for which, he claimed, the respective marks are highly similar), is "significant". In support of his proposition, Mr Zweck submitted that the following categories of consumers will be able to read and understand the Urdu script in the contested mark:

- a. Urdu speakers from ethnicities that speak Urdu – including Pakistan and Indian Urdu speakers.
- b. Other Urdu speakers (e.g. consumers with Arab, Iranian or white ethnicity who have learnt Urdu).
- c. Non-Urdu speakers who are familiar with British-Asian shops and restaurants, and who are therefore familiar with the Urdu script for 'CHASHNI' from their experience of food packaging or restaurant menus.

110. In addition, at the hearing Mr Zweck attempted to rely on an ONS report showing data from 2021 about the percentage of Urdu speakers in the UK. Having explained that he did not intend to make an application to rely on that document as late evidence, he invited me to take judicial notice of its content, which I refused. In any event, that evidence, even if had been filed, would not have been of great assistance to Mr Ashraf as (a) it showed that the percentage of Urdu speakers in the UK was 0.5% of UK residents which is hardly a significant proportion of the general public and (b) it is dated after the filing date of 18 December 2020 which is the relevant date in these invalidity proceedings. Hence, I should say no more about it.

111. Lastly, Mr Fureaux seemed to accept that the script in the contested mark is an Urdu word from which the word 'CHASHNI' has been transliterated. There was no challenge to this point. He stated:

"That, I suppose, is my critical point when it comes to the likelihood of confusion and the similarity of the marks, is how do we know that an Urdu speaker will

look at that and know what that meaning is, know what that word and what it means and then, therefore, makes that jump into the English version. If it is a very obscure culinary term, then we say that it is unlikely they will do so, and we just do not have the evidence on that point. That is the critical bit of evidence, to me, that we are missing here, and which hinders the ability to find that these marks are similar.”

112. I agree. First, Urdu is not an official language of the UK. Whilst I have concluded that ‘CHASHNI’ is descriptive for *confectionary* (insofar as the term covers Indian sweets containing ‘CHASHNI’ which might be of greater interest to a particular subset of the relevant public who speak Hindi, Urdu or Nepalese), the specification of CSB does not cover confectionary at large (or Indian sweets). It follows that there is no justification for finding that CSB’s goods and services might be of greater interest to consumers who speak Urdu. Second, the evidence also indicates that ‘CHASHNI’ is not a common word (such as, for example, ‘hello’, ‘thank you’, ‘please’, ‘you are welcome’, ‘yes’, ‘no’, etc) which one would expect anyone speaking Urdu to be familiar with. Conversely, it is a very specific culinary term referring to a sugar syrup used in many Indian sweets; whilst it is reasonable to conclude that consumers of Indian sweets might be familiar with the meaning of ‘CHASHNI’ because ‘CHASHNI’ is an ingredient of the goods, there is no logical reason to conclude that the average consumer of CSB’s goods and services (none of which cover Indian sweets) would be familiar with the Urdu word from which ‘CHASHNI’ is transliterated, or with its English transliteration ‘CHASHNI’, even if they had a basic knowledge of Urdu. One of the arguments put forward by Mr Zwack was that consumers will be familiar with the Urdu word for ‘CHASNI’ from their experience of the detail of food packaging, however, that does not apply to the consumers of the goods or services in question which do not cover Indian sweets.

113. For these reasons, I reject Mr Zweck’s submissions that a significant proportion of the average consumer would understand the Urdu script for the transliterated word ‘CHASNI’/ ‘CHASHNI’. It follows from this that the respective marks are not similar. In *Calvin Klein Trademark Trust v OHIM*, Case C-254/09 P, the CJEU found that:

“53. As regards the third part of the first ground of appeal, it should be noted, first, that, where there is no similarity between the earlier mark and the mark applied for, the reputation of or the goodwill attaching to the earlier mark and the fact that the goods or services concerned are identical or similar are not sufficient for it to be found that there is a likelihood of confusion between the marks at issue (see, to that effect, Case C-106/03 P Vedral v OHIM [2004] ECR I-9573, paragraph 54; Case C-234/06 P II Ponte Finanziaria v OHIM [2007] ECR I-7333, paragraphs 50 and 51; and the judgment of 11 December 2008 in Case C-57/08 P Gateway v OHIM, paragraphs 55 and 56).

54. In the judgment under appeal, the General Court found that there was no similarity between the marks at issue. It stated, at paragraph 52 of that judgment, that the visual, phonetic and conceptual examination of the marks shows that the overall impression created by the earlier marks is dominated by the element ‘ck’ whereas that created by the trade mark applied for is dominated by the element ‘creaciones kenny’, concluding that the lack of similarity between the signs at issue thus stems from their visual, phonetic and conceptual differences.

56. It must be observed in that connection that, contrary to what appears to be stated at paragraph 39 of the judgment under appeal, the existence of a similarity between two marks does not presuppose that their common component forms the dominant element within the overall impression created by the mark applied for. According to established case-law, in order to assess the similarity of two marks, it is necessary to consider each of the marks as a whole, although that does not rule out the possibility that the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (see OHIM v Shaker, paragraphs 41 and 42; the judgment of 20 September 2007 in Case C-193/06 P Nestlé v OHIM, paragraphs 42 and 43; and Aceites del Sur-Coosur v Koipe, paragraph 62). In that connection, it is sufficient for the common component not to be negligible.

57. However, it is clear that the General Court found, first, that the overall impression created by the mark applied for is dominated by the element 'creaciones kennya', on which the consumer concerned will to a very great extent focus his attention and, second, in particular at paragraph 44 of the judgment under appeal, that the element 'ck' occupies only an ancillary position in relation to that element, which, in essence, amounts to a conclusion that the element 'ck' in the mark applied for is negligible.

58. Thus, having ruled out, on the basis of a properly conducted analysis, any similarity between the marks at issue, the General Court correctly concluded, at paragraphs 53 to 57 of the judgment under appeal, that, notwithstanding the reputation of the earlier marks and the fact that the goods covered by the marks at issue are identical, there is no likelihood of confusion between the marks."

114. Accordingly, the application for invalidity under Section 5(2)(b) fails for wanting of any degree of similarity between the marks.

OUTCOME

115. The application for revocation for non-use against the registration no. UK00003249610 (under no. 505653) succeeds in its entirety. The registration no. UK00003249610 is revoked with effect from 9 December 2022.

116. The application for a declaration of invalidity against the registration no. UK00003249610 (under no. 505613) succeeds in relation to *confectionary* and fails in relation to the remaining goods and services.

117. The application for a declaration of invalidity against the registration no. UK00003570040 (under no. 503798) fails in its entirety.

COSTS

118. CSB's revocation for use has been successful. CSB's application for invalidity has also been successful, albeit only in relation to one term. Finally, CSB has been

successful in defending its registration. As the winning party, CSB is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the CSB the sum of £3,100 calculated as follows:

Preparing the applications for revocation and invalidity and considering the counterstatements: £600
Considering the notice of opposition and preparing the counterstatement: £300
Filing evidence and considering the evidence: £700
Attending a hearing: £700
Official fees: £400
Total: £3,100

119. I therefore order Muhammad Ashraf to pay CHASHNI SWEETS AND BAKERS UK LIMITED the sum of £3.100. 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 December 2024

TERESA PERKS
For the Registrar

Annex

UK00003570040

Class 29: *Abalones [not live]; Abalones, not live; Abura-age [pieces of fried tofu]; Acidophilus milk; Agar-agar for culinary purposes; Agar-agar for food; Air-dried sausages; Ajvar [preserved peppers]; Albumen for culinary purposes; Albumin milk; Algae prepared for human foods; Alginates for culinary purposes; Almond butter; Almond jelly; Almond milk; Almond milk for culinary purposes; Almond milk-based beverages; Almonds, ground; Almonds (Prepared -); Aloe vera prepared for human consumption; Anchovy; Anchovy fillets; Anchovy, not live; Anchovy paste; Andouillettes; Animal fats for food; Animal kidneys [offal]; Animal marrow for food; Animal oils for food; Antipasto salads; Apple butter; Apple chips; Apple flakes; Apple puree; Apple purée; Apple sauce (compote); Ark shells, not live; Ark-shells [not live]; Ark-shells, not live; Aromatized fruit; Arrangements of cut fruit; Arrangements of processed fruit; Artichoke paste; Artichokes, preserved; Artificial cream; Artificial cream (dairy product substitutes); Artificial fish roes; Artificial milk based desserts; Artificial sausage skins; Aspic; Aubergine paste; Bacon; Bacon bits; Bacon rinds; Baked beans; Banana chips; Bean curd; Bean dip; Beancurd sticks; Beans; Beans cooked in soy sauce (Kongjaban); Beans, preserved; Beef; Beef bouillon; Beef fat; Beef jerky; Beef meatballs; Beef slices; Beef steaks; Beef stew; Beef tallow [for food]; Beef tripe; Beefburgers; Berries, preserved; Berry soup; Beverages consisting primarily of milk; Beverages consisting principally of milk; Beverages having a milk base; Beverages made from milk; Beverages made from yoghurt; Beverages made from yogurt; Beverages made with yoghurt; Beverages made with yogurt; Birds eggs and egg products; Bisques; Black caviar; Black currants, processed; Black pudding; Black pudding [blood sausage]; Blackberry jam; Black-bone chickens, not live; Blackcurrants, processed; Blanched nuts; Blended butter; Blended cheese; Blended oil [for food]; Blended oil for food; Blended oils for food; Blended vegetable oils for culinary purposes; Blocks of boiled, smoked and then dried bonitos (katsuo-bushi).*

Class 30: *Acanthopanax tea (Ogapicha); Achar pachranga (fruit pickle); Acid drops [confectionery]; Adlay flour for food; Aerated beverages [with coffee, cocoa or*

chocolate base; Aerated chocolate; Aerated drinks [with coffee, cocoa or chocolate base]; Agave syrup for use as a natural sweetener; Agave syrup [natural sweetener]; Aioli; Alfredo sauce; Alimentary pasta; Alimentary paste [dough]; Alimentary seasonings; Allspice; Almond cake; Almond confectionery; Almond cookies; Almond flavorings, other than essential oils; Almond flour; Almond paste; Almond pastries; Almonds covered in chocolate; Angelica; Aniseed; Aniseeds for use as a seasoning; Aperitif biscuits; Apple cider vinegar; Apple flavoured tea [other than for medicinal use]; Apple fritters; Apple pies; Apple sauce [condiment]; Apple tarts; Aromatic preparations for cakes; Aromatic preparations for candies; Aromatic preparations for food; Aromatic preparations for ice-creams; Aromatic preparations for making non-medicated infusions; Aromatic preparations for making non-medicated tisanes; Aromatic preparations for pastries; Aromatic teas [other than for medicinal use]; Artichoke sauce; Artificial coffee; Artificial rice [uncooked]; Artificial tea; Artificial tea [other than for medicinal use]; Asian apricot tea (maesilcha); Asian noodles; Bacon buns; Bagels; Baguettes; Bakery goods; Baking powder; Baking powders; Baking soda; Baking soda [bicarbonate of soda for baking purposes]; Baking soda [bicarbonate of soda for cooking purposes]; Baking spices; Baking-powder; Baklava; Balsamic vinegar; Banana fritters; Baozi; Baozi [stuffed buns]; Baps; Barbecue sauce; Barley (Crushed -); Barley flakes; Barley flour [for food]; Barley flour for food; Barley for use as a coffee substitute; Barley (Husked -); Barley meal; Barley prepared for human consumption; Barley tea; Barley-leaf tea; Barm cakes; Bars based on wheat; Bars of sweet jellied bean paste; Bars of sweet jellied bean paste (Yohkan); Bases for making milk shakes [flavourings]; Basil, dried; Basting sauces; Batter for making crepes; Batter for making pancakes; Batter mixes; Batter mixes for okonomiyaki [Japanese savory pancakes]; Batter mixes for okonomiyaki [Japanese savoury pancakes]; Bavarian creams; Bean jam buns; Bean meal; Bean paste; Bean-jam filled wafers (monaka); Bean-starch noodles (harusame, uncooked); Bee glue; Beer vinegar; Beverages based on chocolate; Beverages based on coffee; Beverages based on coffee substitutes; Beverages based on tea.

Class 43: *Accommodation booking agency services [time share]; Accommodation bureau services; Accommodation bureau services [hotels, boarding houses]; Accommodation bureaux [hotels, boarding houses]; Accommodation bureaux*

services; Accommodation exchange services [time share]; Accommodation letting agency services [time share]; Accommodation (Rental of temporary -); Accommodation reservation services; Accommodation reservation services [time share]; Accommodation reservations; Accommodation reservations (Temporary -); Accommodation services; Accommodation services for functions; Accommodation services for meetings; Advice concerning cooking recipes; Agency services for booking hotel accommodation; Agency services for reservation of restaurants; Agency services for the reservation of temporary accommodation ; Animal boarding; Animals (Boarding for -); Appraisal of hotel accommodation; Arranging and providing temporary accommodation; Arranging holiday accommodation; Arranging hotel accommodation; Arranging of accommodation for holiday makers; Arranging of accommodation for tourists; Arranging of banquets; Arranging of holiday accommodation; Arranging of hotel accommodation; Arranging of meals in hotels; Arranging of temporary accommodation; Arranging of wedding receptions [food and drink]; Arranging of wedding receptions [venues]; Arranging temporary housing accommodations; Banqueting services; Bar and restaurant services; Bar information services; Bar services; Bars; Bartending services; Bed and breakfast services; Beer bar services; Beer garden services; Bistro services; Boarding for animals; Boarding for horses; Boarding for pets; Boarding house bookings; Boarding house services; Boarding houses; Boarding kennel services; Booking agency services for holiday accommodation; Booking agency services for hotel accommodation; Booking of accommodation for travellers; Booking of campground accommodation; Booking of hotel accommodation; Booking of hotel rooms for travellers; Booking of restaurant seats; Booking of temporary accommodation; Booking of temporary accommodation via the Internet; Booking services for accommodation; Booking services for holiday accommodation; Booking services for hotels; Brasserie services; Buildings [Rental of transportable -]; Business catering services; Café services; Cafe services; Cafés; Cafeteria services; Cafeterias; Cake decorating; Camp services (Holiday -) [lodging]; Campground facilities (Providing -); Canteen services; Canteens; Caravan park facilities (Provision of -); Carry-out restaurants; Carvery restaurant services; Catering; Catering (Food and drink -); Catering for the provision of food and beverages; Catering for the provision of food and drink; Catering in fast-food cafeterias; Catering of food and drink; Catering of

food and drinks; Catering services; Catering services for company cafeterias; Catering services for conference centers; Catering services for educational establishments; Catering services for hospitality suites; Catering services for hospitals; Catering services for nursing homes; Catering services for providing European-style cuisine; Catering services for providing Japanese cuisine; Catering services for providing Spanish cuisine; Catering services for retirement homes; Catering services for schools; Catering services for the provision of food.

UK00003249610

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

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

Class 43: *Services for providing food and drink; temporary accommodation*