

BL No: O/0107/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3641878 IN THE NAME
EVEREST DAIRIES LIMITED

AND IN THE MATTER OF OPPOSITION NO. OP427568 THERETO BY EVEREST
FOOD PRODUCTS PRIVATE LIMITED

DECISION

Introduction

1. This is an appeal against a Decision of Dr Stylianos Alexandridis, acting on behalf of the Registrar of Trade Marks, dated 23 September 2022 (O-825-22)(“*the Decision*”). In the Decision the Hearing Officer rejected the opposition brought by Everest Food Products Private Limited (“*the opponent*”) to Trade Mark Application No. 3641878 in the name of Everest Dairies Limited (“*the applicant*”).
2. The applicant applied to register the word EVEREST in respect of various good in classes 29 and 30.
3. The opponent opposed the application under section 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“*the 1994 Act*”) on the basis of two earlier marks namely:

- (1) Trade Mark No UK00909247065 (“*'065 mark*”) for:



- (2) Trade Mark No UK00002215357 (“*'357 mark*”) for:

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4. For the purposes of the opposition the opponent only relied upon its registrations in respect of *spices* in class 30.
5. Only the opponent filed evidence. Both parties filed written submissions. No hearing was requested and so the Opposition was decided by the Hearing Officer on the basis of the papers before him.

The Hearing Officer's Decision

6. Having found that the opponent had proved use of the marks with respect to spices in class 30 as required under section 6A of the 1994 Act, both marks having been on the register for more than five years on the date the application was filed, the Hearing Officer rejected the Opposition solely on the basis that he found that the goods in issue were dissimilar. On this appeal there is no challenge to the finding that the opponent had proved use of the earlier marks in respect of spices and I therefore say no more about this.
7. Having set out the principles of law applicable to the issue of the assessment of similarity of goods at paragraphs [40] to [43] of the Decision he went on to make the following findings:

44. The competing goods to be compared are shown in the following table:

Opponent's Goods Earlier Marks '357 & '065	Applicant's Goods
Class 30: spices	Class 29: Yogurt; coffee whiteners consisting principally of dairy products; cream [dairy products]; creams containing dairy products; dairy desserts; dairy food being wholly or substantially wholly of fromage frais; dairy produce; dairy produce containing nuts; dairy products; dairy products being half cream and half milk; dairy products containing milk; dairy products containing or flavoured with custard; dairy products containing or flavoured with fruit; dairy products flavoured with cheese; dairy products for foods; dairy products for making milk shakes; dairy products having a soft consistency; dairy products in powder form; dairy products made from goats' milk; dairy puddings; dairy spreads; dairy substances for use as food or as ingredients for food; desserts made wholly or principally of dairy products; drinks made from dairy products; flavoured dairy desserts in the form of mousse layered onto flavoured sauce; food products made from a mixture of dairy products and of edible oils; food spreads consisting principally of dairy products; foodstuffs containing dairy products [as the main constituent]; fruit based dairy products; low fat dairy

	<p>spreads; preparations for creaming coffee [dairy products]; preparations for use in creaming beverages [dairy based]; preparations for use in creaming coffee [dairy based]; preparations for use in creaming tea [dairy based]; preparations for use in whitening coffee [dairy based]; protein derived from soya beans for use as substitutes for dairy products; spreads consisting wholly or principally of dairy products; spreads made from dairy products; whiteners [dairy] for beverages; blended cheese; butter cheeses; cheese; cheese products; cheese spreads; cheese sticks; cheese wedges; combinations of cheese and fruit; combinations of cheese and meat; combinations of cheese and vegetables; cottage cheese; cottage cheese preparations; cream cheese; curd cheese; dairy products flavoured with cheese; foodstuffs flavoured with cheese [cheese predominating]; fresh cheese; imitation cheese; imitation cheese made from soya and casein; low fat cheese; preparations of cottage cheese; prepared foods consisting principally of cheese; prepared meals made principally of cheese; processed cheese; processed cheese products; ready grated cheese; savouries consisting of cheese; soft cheese; soft cheese preparations; toppings (Cheese) for pizzas; snack food (fruit-based).</p> <p>Class 30: Frozen yoghurt [confectionery ices]; frozen confectionery; frozen dairy confections; confectionery in frozen form.</p>
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45. In the notice of opposition, the opponent claims that “the goods listed in Classes 29 and 30 of the Application are complementary and highly similar to "spices" protected by the Opponent's Registration.” In addition, the opponent in its submissions asserts the following:

“Nature

The Applicant's Goods and the Registered Goods are all food products. The nature of the respective goods is thus identical.

Intended purpose

As food products, the Applicant's Goods and the Registered Goods are intended to be consumed. The intended purpose of the respective goods is thus identical.

Method of Use

As foods products, the Applicant's Goods and the Registered Goods are consumed. The method of use of the respective goods is thus identical.

Relevant public

Both the Applicant's Goods and the Registered Goods are aimed at the general public at large. The respective goods are aimed at a consumer intending to prepare and cook a meal.

Distribution channels

As foods products, the Applicant's Goods and the Registered Goods will be sold to the general public via food stores including supermarkets and independent shops.”

46. The applicant in its notice of defence, denies any identity between the respective goods, stating that “the Applicant submitted a TM21B to amend the specification to ensure that it only covers dairy related products.” I note that the applicant in its submissions provided a comparison based on the whole earlier specification which is not applicable here as the opponent in its notice of opposition only relied on the term “spices” in Class 30 for the purposes of this opposition.

47. The applicant’s goods in Classes 29 and 30 can be largely identified as dairy foodstuffs. The opponent’s goods are plant/vegetable-based substances used to flavour food. The opponent has not provided an analysis specific to each of the contested terms in question. Although the competing goods are all considered to be foodstuffs and could be sold via similar channels, it would be superficial to find similarity. Most of the contested goods are chilled or frozen products placed/stored in

chiller cabinets or freezers. Thus, the earlier goods, “spices”, would be sold in different areas/aisles of supermarkets or shops away from the contested goods. The same applies even for those contested goods that do not require chilling, for example, “snack food (fruit-based)”, as they will still be found in different parts of a shop. In addition, the mere fact that the earlier goods may be used together with some of the contested goods, e.g., yoghurt mixed with spices, does not justify similarity, particularly when they do not share nature (physical properties), uses and users. In this respect, the respective goods are neither in competition nor complementary, where consumers are likely to believe that the same commercial undertaking could offer the respective goods. In the absence of specific submissions or evidence to assist me, I do not consider the contested goods in Classes 29 and 30 to be similar to the earlier Class 30 goods.

48. The application’s goods are dissimilar to the earlier mark’s goods and, thus, likelihood of confusion does not arise in such a case. The opposition cannot succeed against dissimilar goods and, therefore, is dismissed.

The appeal

8. On 21 October 2022 a Form TM55P Notice of Appeal together with a Statement of Grounds of Appeal was filed on behalf of the Opponent. The relevant parts of the Grounds of Appeal stated as follows:

Grounds of Appeal

5. The Hearing Officer erred in their assessment of the comparison of the respective goods in paragraph 47 of the Decision and thus in concluding in paragraph 48 of the Decision that the respective goods are dissimilar. In particular, the Hearing Officer erred in finding that the respective goods do not have a common or similar nature, intended purpose, method of use, relevant public and distribution channel.
6. The Hearing Officer should have found that there was similarity between the respective goods and continued to assess the comparison of the respective trade marks. In that assessment, the Hearing Officer would no doubt have found that respective marks to be identical and/or highly similar.
7. The Hearing Officer’s incorrect judgement in respect of the comparison of the respective goods resulted in the Hearing Officer also erring in their conclusion in paragraph 48 of the Decision that there was no likelihood of confusion.

9. No Respondent's Notice was filed.
10. The hearing of the appeal took place via video link on 12 December 2022. At that hearing the opponent was represented by Ms Tania Clark of Withers & Rogers LLP and Mr Sam Carter instructed by Serjeants LLP appeared on behalf of the applicant. Both Ms Clark and Mr Carter filed skeletons of argument prior to the hearing.
11. At the hearing it was accepted by the parties that if I upheld the Hearing Officer then that would be the end of the proceedings; but that if I allowed the appeal then the Opposition would need to be remitted to a different Hearing Officer for a decision to be made under sections 5(2)(a) and 5(2)(b) of the 1994 Act on the basis that the goods in issue were not dissimilar.

The Standard of Review on Appeal

12. An appeal against decisions taken by the Registrar is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. See Reef Trade Mark [2003] RPC 5; and Actavis Group PTC v. ICOS Corporation [2019] UKSC 1671 at [78] to [81].
13. Moreover, where the decision below involves the making of a value judgment the decision maker on appeal must be especially cautious about interfering with that judgment on appeal: see Actavis (above) at [80]:

80 What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge's conclusions of primary fact but with the correctness of the judge's evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible:

Assicurazioni Generali SpA v Arab Insurance Group (Practice Note) [2002] EWCA Civ 1642; [2003] 1 WLR 577, paras 14-17 per Clarke LJ, a statement which the House of Lords approved in *Datec Electronic Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23; [2007] 1 WLR 1325, para 46 per Lord Mance.

14. In Fage UK Ltd v. Chobani UK Ltd [2014] EWCA Civ 5; [2014] E.T.M.R. 26 at paragraphs [114] and [115] Lewison LJ said:

114 Appellate courts have been repeatedly warned, by recent cases at the highest level, not to interfere with findings of fact by trial judges, unless compelled to do so. This applies not only to findings of primary fact, but also to the evaluation of those facts and to inferences to be drawn from them. The best known of these cases are: *Biogen Inc v Medeva plc* [1977] RPC 1; *Piglowska v Piglowski* [1999] 1 WLR 1360 ; *Datec Electronics Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23 [2007] 1 WLR 1325 ; *Re B (A Child) (Care Proceedings: Threshold Criteria)* [2013] UKSC 33 [2013] 1 WLR 1911 and most recently and comprehensively *McGraddie v McGraddie* [2013] UKSC 58 [2013] 1 WLR 2477 . . .

115 It is also important to have in mind the role of a judgment given after trial. The primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties and, if need be, the Court of Appeal the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted. These are not controversial observations: see *Customs and Excise Commissioners v A* [2002] EWCA Civ 1039; [2003] Fam. 55; *Bekoe v Broomes* [2005] UKPC 39; *Argos Ltd v Office of Fair Trading* [2006] EWCA Civ 1318; [2006] U.K.C.L.R. 1135.

15. The general principles are not in dispute and I will bear the above principles firmly in mind in considering the issues before me.

Decision

16. The one issue that I have to decide on this appeal is whether or not the Hearing Officer was correct to find that the goods in issue were ‘dissimilar’.
17. The Grounds of Appeal do not, as the applicant correctly submitted, identify any specific error that is said to have been made by the Hearing Officer. This is not satisfactory for the reasons identified by Iain Purvis KC sitting as the Appointed Person in GREYBOX TM (0-106-20) at paragraph [9].
18. In the skeleton of argument, the opponent’s position on this issue was set out as follows (evidence references excluded):

16. The [Hearing Officer] erred in his finding that the respective goods are dissimilar. The goods at issue are at least similar to a low degree.

17. As set out in the [opponent's] witness statement dated 18 April 2022, the [opponent] is an Indian company which manufactures spices for Indian dishes and international cuisines. The [opponent's] primary target audience is the Asian community within the UK and its products are sold to that public through stores which specialise in Asian food products. The [Hearing Officer] failed to take this evidence into consideration when assessing the similarity of the goods.

18. The [Hearing Officer] correctly summarised the [goods applied for] in Class 30 as dairy products. Such goods encompass dairy products that are used in traditional Indian cooking including ghee being an Indian clarified butter, paneer being an Indian cheese, butter milk and curd.

19. Had the [Hearing Officer] taken the above into consideration, he ought to have concluded that the respective goods:

- a. are aimed at the same relevant public, being the Asian community in the UK;
- b. are sold via the same distribution channels, being stores which specialise in Asian food products; and
- c. are complementary, in that they are essential ingredients in traditional Indian recipes.

20. Where respective goods are complementary and also share a common relevant public and distribution channel, it must follow that they are similar to at least a low degree of similarity.

19. Further in this connection it is to be noted that:

- (1) It was not suggested by the opponent on this appeal that the Hearing Officer failed to identify the correct legal principles that were applicable to the decision that he had to make.
- (2) It was not suggested by the opponent on this appeal that the Hearing Officer had not correctly identified in paragraph [45] of the Decision the way in which the opponent had put forward its case in its written submissions before him.

- (3) It was not suggested by the opponent on this appeal that the Hearing Officer was wrong to note in paragraph [47] of the Decision that ‘*The opponent has not provided an analysis specific to each of the contested terms in question*’.
 - (4) It was rightly accepted on behalf of the opponent at the hearing of the appeal that *no evidence on the issue of similarity* of the goods in issue had been included in the evidence filed on behalf of the opponent.
 - (5) As neither party had requested a hearing the Hearing Officer determined the Opposition on the basis of the papers that were before him.
20. It seems to me that against this background that what the opponent is inviting me to do is to simply consider matters afresh such that ‘*the Decision would end up being re-taken by this Tribunal under the guise of reviewing it for error*’: see the decision of Geoffrey Hobbs KC sitting as the Appointed Person in NICO LONDON Trade Mark (O-338-20) at paragraph [36].
21. As Geoffrey Hobbs KC sitting as the Appointed Person in TEDDYLICIOUS Trade Mark (O-0032-23) further explained at paragraphs [19] and [20]:

19. However, the case law is clear as to the way in which this Tribunal should approach an appeal against what was, in substance, a factual determination made from a legally correct perspective. I refer in that regard to paras [2] and [3] of the Judgment of the Court of Appeal in Volpi v Volpi [2022] 4 WLR 48; [2022] EWCA Civ 464:

Appeals on fact

[2] The appeal is therefore an appeal on a pure question of fact. The approach of an appeal court to that kind of appeal is a well-trodden path. It is unnecessary to refer in detail to the many cases that have discussed it; but the following principles are well-settled:

(i) An appeal court should not interfere with the trial judge’s conclusions on primary facts unless it is satisfied that he was plainly wrong.

(ii) The adverb “plainly” does not refer to the degree of confidence felt by the appeal court that it would not have reached the same conclusion as the trial judge. It does not matter, with whatever degree of certainty, that the appeal court considers that it would have reached a different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.

(iii) An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not mention a specific piece of evidence does not mean that he overlooked it.

(iv) The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must of course consider all the material evidence (although it need not all be discussed in his judgment). The weight which he gives to it is however pre-eminently a matter for him.

(v) An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable.

(vi) Reasons for judgment will always be capable of having been better expressed. An appeal court should not subject a judgment to narrow textual analysis. Nor should it be picked over or construed as though it was a piece of legislation or a contract.

[3] If authority for all these propositions is needed, it may be found in *Piglowska v Piglowski* [1999] 1 WLR 1360; *McGraddie v McGraddie* [2013] UKSC 58; [2013] 1 WLR 2477, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5; [2014] FSR 29, *Henderson v Foxworth Investments Ltd* [2014] UKSC 41; [2014] 1 WLR 2600, *Glencore Services (UK) Ltd v Elliston* [2016] EWCA Civ 407, *JSC BTA Bank v Ablyazov* [2018] EWCA Civ 1176; [2019] BCC 96, *ACLBDD Holdings Ltd v Staechelin* [2019] EWCA Civ 817; [2019] 3 All ER 429 and *Perry v Raleys Solicitors* [2019] UKSC 5; [2020] AC 352.

20. This does not mean that Registry decisions are immune from challenge. Nor does it mean that they will not be carefully reviewed on appeal. It does, however, mean that a decision must stand if it is not shown to be wrong by reason of some identifiable flaw in the Hearing Officer's treatment of the question to be decided (such as a gap in logic, a lack of consistency, or a failure to take account of some material factor) which renders the disputed conclusion rationally insupportable: see, for example, *Ras Al Khaima Investment Authority v Azima* [2021] EWCA Civ 349 at paras [66] to [70];

and In the matter of Sprintroom Ltd [2019] EWCA Civ 932 at paras [71] to [78].

22. As the parties and the Hearing Officer all correctly recognised factors that may be of relevance in determining ‘similarity’ of goods include the respective nature of the goods, their intended purpose, their method of use, the relevant public and the distribution channels. This is not surprising given the guidance from the case law identified by the Hearing Officer in paragraphs [40] and [41] of the Decision.
23. It is also clear from the case law that:
- (1) The fact that goods may fall under the same class under the Nice Classification does not mean that they are to be regarded as ‘similar’. Likewise, the fact that the goods may fall under a different class under the Nice Classification system does not mean that such goods should be classed as ‘dissimilar’. See Case T-118/07 P.P.TV v. OHIM [2011] ETMR 738; and the decision of Ms Anna Carboni sitting as the Appointed Person in SK.4 TM Application (O-176-08) at [31] to [40].
 - (2) It is the goods covered by the specifications of the marks in issue that must be considered by the decision taker and not the goods actually marketed under the marks. See Case T-66/11 Present-Service Ullrich GmbH & Co KG v. OHIM [2013] ETMR 29 at [45].
 - (3) The question of whether goods are ‘complementary’ is to be distinguished from use in combination, where goods are merely used together, whether for choice or convenience. Goods are ‘complementary’, as the Hearing Officer correctly identified from the case law in paragraph [43] of the Decision, where *‘there is a close connection between them, in the sense that once is indispensable of important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking’*.
24. It seems to me that the Hearing Officer’s assessment in the Decision was in accordance with the approach set out in the case law. In my view his conclusion cannot be regarded as unsupportable and indeed no *specific* flaw or flaws in the approach taken by the Hearing Officer in his Decision were identified by the opponent in their Grounds of Appeal.
25. I have also reviewed the Decision in the light of the submissions made both in writing and before me at the hearing of the appeal as to the evaluation made by the Hearing Officer. I am satisfied that none of the points relied upon establish that the finding of the Hearing Officer was vitiated by error having regard to the points set out above. It seems to me that it was open to the Hearing Officer to come to the view that he did on the basis of the materials that were before him.

Conclusion

26. To conclude, for the reasons set out above, it does not seem to me that there is any error of principle or material error in the Hearing Officer's decision. Moreover, it is not in my view appropriate to interfere with the evaluations that the Hearing Officer made in reaching the decision that he did. In the result the appeal fails and is dismissed.
27. Since the appeal has been dismissed the applicant is entitled to a contribution towards its costs. I will therefore make an order that the opponent pay to the applicant a contribution of £1,500 toward its costs of the appeal. This sum should be paid in addition to the costs of £1,200 below. I therefore order Everest Food Products Private Limited to pay to Everest Dairies Limited the sum of £2,700 by 4pm on Wednesday 22 February 2023.

EMMA HIMSWORTH KC

Appointed Person

1 February 2023